

Veröffentlichung im Amtsblatt	Ja/Nein
Publication in the Official Journal	Yes/No
Publication au Journal Officiel	Oui/Non

Aktenzeichen / Case Number / N^o du recours : T 59/87 - 3.3.1

Anmeldenummer / Filing No / N^o de la demande : 81 300 717.6

Veröffentlichungs-Nr. / Publication No / N^o de la publication : 0 036 708

Bezeichnung der Erfindung: Friction reduction additives and compositions
Title of invention: thereof
Titre de l'invention :

Klassifikation / Classification / Classement : C10M 1/54

ENTSCHEIDUNG / DECISION

vom / of / du 26 April 1988

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Mobil Oil Corporation

Einsprechender / Opponent / Opposant :

Chevron Research Company

Stichwort / Headword / Référence : "Friction reducing additive/Mobil II"

EPÜ/EPC/CBE Articles 54, 64, 69, 112, 123

Kennwort / Keyword / Mot clé : "Amendment in opposition proceedings - change of category (here: from "compound" and "composition" to "use of compound for a particular purpose") - Novelty of such a "use" claim over disclosure of same compound for different purpose - referral of questions concerning amendment and novelty to the Enlarged Board of Appeal.



Case Number : T 59/87 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 26 April 1988

Appellant : Mobil Oil Corporation
(Proprietor of the patent) 150 East 42nd Street
New York N.Y. 10017
USA

Representative : Jones, Alan John
Carpmaels & Ransford
43 Bloomsbury Square
London WC1A 2RA
GB

Respondent : Chevron Research Company
(Opponent) P.O. Box 7643
San Francisco
California 94120
USA

Representative : Kosmin, Gerald Emmanuel
HASELTINE, LAKE & CO.
Hazlitt House
28 Southampton Buildings
Chancery Lane
London, WC2A 1AT
GB

Decision under appeal : Decision of the Opposition Division of the European
Patent Office dated 18 December 1986 revoking
European patent No. 0 036 708 pursuant to
Article 102(1) EPC.

Composition of the Board :

Chairman : K.J.A. Jahn
Members : G.D. Paterson
J.W. Arbouw

Summary of Facts and Submissions

I. A notice of opposition to European patent No. 36 708 was filed on 4 December 1984, in which it was in particular alleged that the claimed subject-matter lacked novelty, or in the alternative, lacked an inventive step having regard to a number of documents, particularly:

- (1) US Patent No. 2 795 548
- (2) US Patent No. 3 117 089.

In response the patentee submitted amended claims.

In its Decision the Opposition Division held that the amended claims in the main request were admissible under Article 123 EPC, that these claims were novel, but that they lacked an inventive step.

II. An appeal was duly filed by the patentee. The Appellant maintained the main request, and during the appeal proceeding he also filed an auxiliary request.

III. The subject-matter of the patent is an additive for lubricating oil. The additive comprises borated hydroxyester compounds in accordance with generalised structural formulae set out in the description and claims. The main purpose of the additive is to reduce friction between sliding surfaces in engines, particularly automobile engines.

The patent as granted contained claims defining the compounds, and a claim defining a lubricant composition including such a compound.

The main claim of the main request defines "a lubricant composition" comprising:

- (a) a major portion of a lubricating oil;
- (b) at least 1 per cent by weight of the additive.

The Examples in the description disclose the use of 1, 2 and 4 per cent additive. The description as originally filed and granted states that the amount of additive may range from 0.1 to about 10 per cent, preferably from 0.5 to 5 per cent.

- IV. As to the prior documents, document (2) in particular discloses the use of the same and other related compounds as an additive for oil, including lubricating oil, for the purpose of inhibiting the formation of rust when the oil is in contact with ferrous metal. The Examples in document (2) disclose the use of 0.1 to 0.5 per cent additive. The description states that it is advantageous to use from about 0.001 to about 10 per cent, preferably to about 2 per cent additive, but that greater or lesser amounts may be used, the amount being varied as required for rust inhibition.
- V. At the conclusion of the oral proceedings, the Board of Appeal refused the main request of the Appellant. The Appellant argued that the claimed subject-matter in the main request was patentable as a "selection" from what is disclosed in document (2), following Decision T 198/84 "Thiochloroformates" (OJ EPO 7/1985, 209).

In the Board's judgement, the main claim of the main request lacks novelty having regard to the disclosure of a lubricant composition including at least 1 per cent by weight of the same compounds as additive in document (2).

A Decision to this effect has been made by the Board on 26 April 1988.

VI. The main claim of the Appellant's auxiliary request defines the matter for which protection is sought as:

"Use of at least 1 per cent by weight based on the total composition of (defined compounds in accordance with structural formulae), as a friction reducing additive in a lubricant composition comprising a major portion of a lubricating oil".

VII. In order to decide upon the auxiliary request, the Board has to determine the following matters:

- (i) whether such an amended claim, involving a change of category of claim, is admissible having regard to Article 123(3) EPC;
- (ii) whether the claimed subject-matter is novel having regard to Article 54 EPC;
- (iii) whether the claimed subject-matter involved an inventive step having regard to Article 56 EPC.

Reasons for the Decision

1. Article 112(1)(a) EPC empowers a Board of Appeal to refer any question to the Enlarged Board of Appeal of its own motion, if it considers that a decision is required on an important point of law which is raised by that question.
2. The first question to be decided in relation to the auxiliary request is whether such an amended claim,

involving a change of category of claim, is admissible having regard to Article 123(3) EPC, which provides that "The claims ... may not be amended during opposition proceedings in such a way as to extend the protection conferred".

It appears from Chapter III of the EPC, especially Articles 64 and 69 EPC, that the protection conferred by a European patent is to be determined primarily by the terms of the claims; furthermore, insofar as the protection conferred is the same as the rights conferred by a patent, it is to be determined in accordance with the national laws of the designated Contracting States.

It follows that a main object of Article 123(3) EPC appears to be to prevent an amendment to the claims of a European patent during opposition proceedings before the EPO, if the effect of the amendment is to make an activity an infringement of the patent after amendment which would not have been an infringement before the amendment.

Decisions of the EPO, including the Boards of Appeal, in relation to amendments involving a change of category of claim have generally so far been made on an "ad hoc" basis, and there is little clear jurisprudence on the proper interpretation of Article 123(3) EPC. In the view of this Board, this is an important point of law of general importance.

3. The second question to be decided in relation to the auxiliary request, that of novelty, only arises if the amendment is admissible having regard to Article 123(3) EPC.

With reference to the wording of the main claim of the auxiliary request as set out in paragraph V above, it is apparent from the summary of document (2) as set out in

paragraph III above that document (2) discloses the use of amounts greater than 1 per cent by weight of compounds as defined in the claim, as additive in a lubricant composition comprising a major portion of a lubricating oil. In document (2), as explained in paragraph III above, the additive was used to inhibit the formation of rust. In contrast, in the claims in suit the additive is required to be used "as a friction reducing additive".

The question to be decided is whether the claimed use of the defined additive "as a friction reducing additive" is novel having regard in particular to the disclosure of document (2).

4. In Decision T 231/85, a different composition of this Board decided that a claim to a new use (as a fungicide) of a known compound, which had been previously disclosed for use as a plant growth regulator, was novel for the purpose of Article 54 EPC, even though the new use did not involve any new means of realisation (spraying on plants).

If the principle underlying this Decision was applied to the present case, the claims in suit would be held to be novel.

On the other hand, according to the national laws of many Contracting States, the claims in suit would be held to lack novelty, primarily for the reason that the previously disclosed use of the additive in a lubricating oil composition, although specifically stated to be for the purpose of inhibiting rust formation, would inherently be a use as a friction reducing additive as well.

In Decision Gr 05/83 "Second medical indication" (OJ EPO 3/1985, 64), the Enlarged Board of Appeal referred to the fact that Article 52(1) EPC expresses "a general

principle of patentability", and stated that "it is clear that in all fields of industrial activity other than those of making products for use in surgery, therapy and diagnostic methods, a new use for a known product can be fully protected as such by claims directed to that use" (paragraph 21).

The Enlarged Board went on to refer to Article 54(5) EPC as an exception to this general rule so far as the first use of medicaments is concerned, in that the required novelty for the medicament is derived from the new pharmaceutical use; and by analogy it derived novelty for second or further medical uses from the new pharmaceutical use in each case. However, it also stated that "the application of this special approach to the derivation of novelty can only be applied to claims to the use of substances or compositions intended for use in a method referred to in Article 52(4) EPC" (paragraph 21).

5. Clearly, a new use of a known compound or composition may well constitute an inventive contribution to the art - and this is true whether or not the new use is a pharmaceutical use. Whether a claim to the use of a known composition for a new purpose constitutes novel subject-matter, even when the new use does not involve any new means of realisation, is an important point of law which affects industry generally.
6. In the present case, in relation to the issue of inventive step, the technical problem underlying the subject-matter claimed in the auxiliary request is to provide a further additive for a lubricant composition for directly reducing the friction between sliding surfaces in engines. In the Board's judgement none of the prior documents relied upon in the opposition are concerned with this problem, and a skilled man wishing to solve that problem and reading these

prior documents would receive no relevant teaching. In the Board's view, it is particularly relevant that the skilled man would know that lubricating oil for internal combustion engines normally comprised not only rust inhibiting additives and friction reducing additives, but also a number of other additives, such as anti-wear agents, ashless dispersants, surfactants, detergents, anti-oxidants, anti-corrosion agents and viscosity improvers. Thus, in the Board's judgement the claimed subject-matter of the auxiliary request is inventive for the purpose of Article 56 EPC.

For these reasons, it is decided that:

The following questions concerning important points of law shall be referred to the Enlarged Board of Appeal for decision:

- (i) When amended claims involving a change of category (here: from a "compound" claim to "use of that compound in a composition for specified purpose") are proposed in opposition proceedings, what considerations should be taken into account when deciding on the admissibility of such amendments having regard to Article 123(3) EPC? In particular, how far should the national laws of Contracting States relating to infringement be considered?
- (ii) Can a patent with claims directed to a "compound" and to a "composition including such compound" be amended during opposition proceedings so that the claims are directed to the "use of that compound in a composition" for a particular purpose?

(iii) Is a claim to the use of a compound for a particular non-medical purpose novel for the purpose of Article 54 EPC, having regard to a prior publication which discloses the use of that compound for a different non-medical purpose, so that the only novel feature in the claim is the purpose for which the compound is used?

The Registrar:

The Chairman:



01590



Veröffentlichung im Amtsblatt Ja / Nein
Publication in the Official Journal Yes / No
Publication au Journal Officiel Oui / Non

Aktenzeichen / Case Number / N° du recours : T 59/87 - 3.3.1

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Titre de l'invention :

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ENTSCHEIDUNG / DECISION
vom / of / du 26 April 1988

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet : Mobil Oil Corporation

Einsprechender / Opponent / Opposant : Chevron Research Company

Stichwort / Headword / Référence : "Friction reducing additive/Mobil I"

EPO / EPC / CBE Articles 54, 123

Kennwort / Keyword / Mot clé : "Novelty, Selection, Amendment"

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European Patent
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Office européen
des brevets
Chambres de recours



Case Number : T 59/87 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 26 April 1988

Appellant : Mobil Oil Corporation
(Proprietor of the patent) 150 East 42nd Street
New York N.Y. 10017
USA

Representative : Jones, Alan John
Carpmaels & Ransford
43 Bloomsbury Square
London WC1A 2RA
GB

Respondent : Chevron Research Company
(Opponent) P.O. Box 7643
San Francisco
California 94120
USA

Representative : Kosmin, Gerald Emmanuel
HASELTINE, LAKE & CO.
Hazlitt House
28 Southampton Buildings
Chancery Lane
London, WC2A 1AT
GB

Decision under appeal : Decision of the Opposition Division of the European
Patent Office dated 18 December 1986 revoking
European patent No. 0 036 708 pursuant to
Article 102(1) EPC.

Composition of the Board :

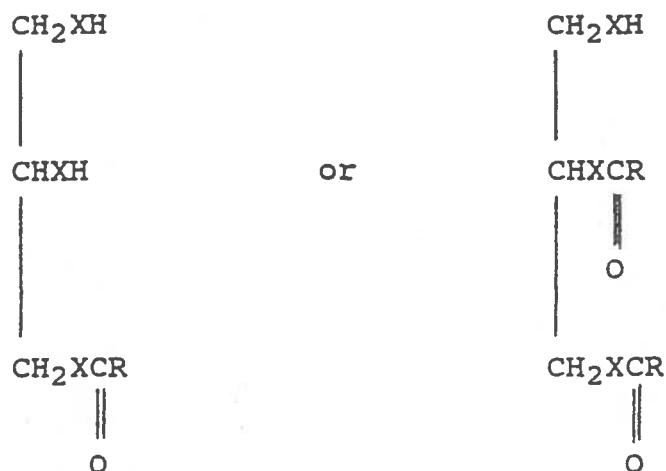
Chairman : K.J.A. Jahn
Members : J.W. Arbouw
G.D. Paterson

Summary of Facts and Submissions

- I. European patent No. 36 708, incorporating six claims, was granted on 21 March 1984 on the basis of European patent application No. 81 300 717.6, filed on 20 February 1981 and claiming a priority of 24 March 1980 (US 133 034).
- II. The Opponent filed opposition to the grant on 4 December 1984 and a later submission with additional arguments on the basis of new documents and requested that the patent be revoked in its entirety on grounds of Article 100(a) and (b) EPC.
- III. By its decision of 7 October 1986 posted on 18 December 1986 the Opposition Division revoked the patent.

This decision was based on the following independent claims (main request, filed 16 June 1986):

- "1. A lubricant composition comprising a major portion of a lubricating oil and as friction reducing additive at least 1% by weight based on the total composition of a borated glycerol mono- and/or dihydroxyester or borated thioglycerol mono- and/or dihydroxyester produced by borating a glycerol mono- and/or dihydroxyester or thioglycerol mono- and/or dihydroxyester of the formula:



wherein each X is S or O and R is a hydrocarbyl group of from 8 to 24 carbon atoms".

"5. A method of reducing fuel consumption in an internal combustion engine which comprises treating its moving surfaces with the lubricant composition of any preceding claim".

In Claim 1 according to an auxiliary request the following phrase was added to Claim 1 according to the main request:

"the borated glycerol mono- and/or dihydroxyester or thioglycerol mono- and/or dihydroxyester containing at least 1.49% by weight of boron".

The decision to revoke the patent was based on the ground that its subject-matter according to the main request is not inventive over the most relevant prior art document US-A-3 117 089 (2). This document teaches the man skilled in the art to use up to 10% of the additives according to the patent-in-suit in lubricating oils. The Opposition Division held that the use of at least 1% of these additives is not inventive, since the results obtained are

not new or unexpected. It was further considered that the examples according to the patent-in-suit are very close to the 10% additive as disclosed in (2).

The Opposition Division further decided that the claims according to the auxiliary request are not allowable under Article 123 EPC.

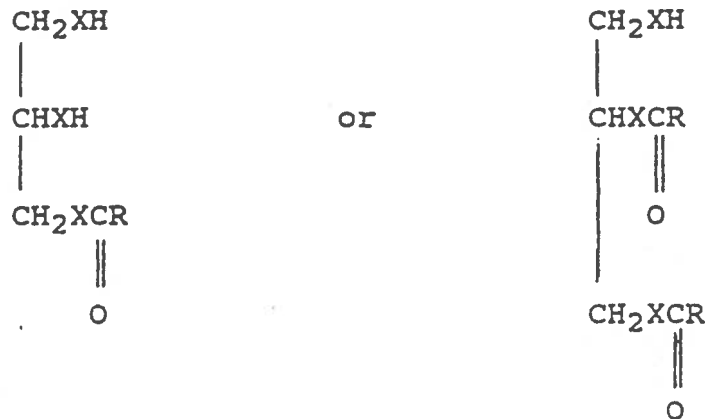
- IV. The Appellant filed an appeal on 2 February 1987 and the appeal fee was paid. The Statement of Grounds was filed on 21 April 1987.

The Appellant withdrew the claims according to the auxiliary request but maintained his main request.

The Appellant submitted that the claims are directed to a lubricant composition comprising at least 1% of the additive as a friction reducing agent, whereas document (2) concerns oil compositions where 0.001 to 10% of the additive is added as a corrosion inhibitor. It was further argued that the upper limit of 10% for anti-corrosive activity is not credible, because the Examples III and IV of document (2) show that perfect rust ratings are already obtained with amounts of 0.1% and 0.01% of the additive.

In a later submission (dated 5 April 1988) the Appellant filed further arguments and an auxiliary request of which Claim 1 reads as follows:

"Use of at least 1% by weight based on the total composition of a borated glycerol mono- and/or dihydroxyester or borated thioglycerol mono- and/or dihydroxyester produced by borating a glycerol mono- and/or dihydroxyester or thioglycerol mono- and/or dihydroxyester of the formula:



wherein each X is S or O, and R is a hydrocarbyl group of from 8 to 24 carbon atoms, as a friction reducing additive in a lubricant composition comprising a major portion of a lubricating oil."

- V. The Respondent submitted that the cited documents (1) US-A-2 795 548 and (2) clearly disclose the use of the compositions in small amounts as additives in lubricating oils. It was further argued that it is irrelevant whether the additives are called friction reducing additives or corrosion inhibiting additives, since the composition is still the same and therefore not novel.
- VI. In the oral proceedings held on 26 April 1988 the parties reaffirmed their points. The Appellant filed a further auxiliary request according to which the claims according to the main and auxiliary requests were further limited to 1 to 5 per cent of the borated compound.
- VII. The Appellant requested that the decision under appeal be set aside and that the patent be maintained
- (1) as the main request, with the description and claims as filed on 16 June 1986

- (2) as a first auxiliary request, with the above-identified description and with claims as filed by letter dated 5 April 1988;
- (3) as a second auxiliary request, with the above identified description and claims in accordance with (1) or (2) and further limited to "1 to 5 per cent" of the borated compound.

The Respondent requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. Claim 1 according to the main request is based on Claims 1 and 5 as filed in combination with page 1, paragraph 1 and page 10, lines 1 to 9 of the description and on Claims 1 and 5 in combination with page 2, lines 1 to 3 and page 5, lines 33 to 37 of the patent as granted.

Therefore these amendments are formally allowable.

The amendment according to the second auxiliary request - i.e. a further limitation to 1 to 5 per cent of the borated compound is also formally allowable since it relies on page 3, last two lines in combination with page 10, line 9 of the application and on page 2, line 58 in combination with page 5, line 37 of the patent-in-suit.

The Board does not accept the formal allowability of the proposed amendment in the chemical formula in Claim 1 - i.e. the replacement of a (thio)ether-group by a hydroxy- or thiol- group in the second formula for the reasons set out below.

The only place in which the alleged correct second formula was originally disclosed is page 2, first paragraph of the application as filed. However, this allegedly correct formula was not included in the patent as granted, but was amended.

The fact that the boric acid complexes comprised in the lubricating composition are described as "borated derivatives of glycerol hydroxyesters and borated derivatives of sulfur-containing glycerol hydroxyesters" (see the patent-in-suit, page 2, lines 19 to 20) is not sufficient for a correction because this definition is immediately afterwards more clearly defined by both formulae, of which the second one relates to an ether.

It was also submitted that only starting compounds having a free -OH or -SH group can be borated with boric acid. Therefore, the compounds with the second formula cannot be borated with this method. However, the patent-in-suit describes (see page 2, lines 43-45) that transesterification is one of the processes for producing the borated esters. Therefore, it will immediately occur to the skilled man that this method is applicable for the compounds having the second formula.

Because the submitted grounds are not sufficient for the amendments in the second formula the main request should fail only on the ground of not meeting the requirements of Article 123(3) EPC.

However, because the question of novelty was in the foreground in both the opposition and appeal proceedings the main request should not only fail for this reason.

3. According to the finding of the Board the closest prior art is represented by (2). This document is inter alia concerned with lubricating oil compositions (see e.g. column 1, lines 32-40, column 6, line 8) comprising borated triol monoesters (see e.g. column 2, lines 23-34 and Claim 1) in an amount from about 0.001-10 wt.%, preferably 0.001-2.0 wt.% (column 2, paragraph 3). Document (2) further exemplifies (see column 3, lines 70-75) triol monoesters usable in forming the borated complexes of which several fall under the claims of the patent-in-suit as acknowledged by the Appellant. In particular, oil compositions comprising 0.5, 0.1 and 0.001 wt.% of glycerol mono-oleate boric acid complex are disclosed (see column 9, lines 15-35 in combination with the Examples IV and IX).

This disclosure is detrimental to the novelty of the oil compositions of Claim 1 according to the main request and second auxiliary request.

- 3.1. The Board is unable to accept the Appellant's argument that the range claimed in the patent-in-suit - i.e. at least 1% by weight of the boric-acid complex - constitutes a novel selection from the prior art, for following reasons.
- 3.2. In the Board's view, a comparison of the disclosure in document (2) with the patent-in-suit indicates that the subject-matter claimed in the claims of the main request is not in reality a selection of a group of members from a known class having particular advantage for a particular purpose as submitted by the Appellant during oral proceedings; instead, in essence the claimed subject-matter is the use of merely the same group of compounds as

disclosed in document (2), in a similar small amount as an additive to lubricating oil, but for a different purpose. Thus, this subject-matter is by its nature not suitable for protection as a selection patent.

3.3. With reference to previous decisions referred to by the Appellant in this respect: .

In its decision T 98/84, "Thiochloroformates" (OJ, 1985, page 209, 213, 214, 215) the Board has decided that selection of a sub-range of numerical values from a broader range is possible when inter alia the following criteria are satisfied:

(i) the selected sub-range should be narrow;

(ii) the selected sub-range should be sufficiently far removed from the known range illustrated by means of examples;

The criteria given above are not satisfied here for the reasons given below.

3.3.1 The ranges claimed in Claim 1 of the present application do not as required single out small specimen from the known ranges but considerably overlap therewith (from 1 to 10%). Therefore, the selected sub-range is not narrow as compared to the state of the art.

3.3.2 In addition, there is not sufficient distance between the allegedly selected ranges of parameters and the known ranges illustrated by means of Examples. The Examples in (2) (see the table in column 9) demonstrate oil compositions comprising 0.01, 0.1 and 0.5 wt.% of a boric-

acid complex according to the patent-in-suit. It is true that none of the examples in (2) realises an oil composition comprising at least 1 wt.% of the boric acid complex.

However, the Examples are in general only specific embodiments of a broader teaching and must therefore be considered in context therewith. Although none of the Examples of (2) realises exactly the combination of reaction parameters as claimed, these Examples do not restrict, but support the general teaching laid down in (2), i.e. that the concentration of the boric-acid complex can be varied within certain ranges, particularly within the preferred range of 0.01 to 2 wt.% overlapping with the range as claimed (cf. T 17/85, "Filling material/PLÜSS-STAUFER", OJ 1986, page 406). Therefore, the selected sub-range is not removed sufficiently far from the known range as illustrated by means of Examples.

3.3.4 In its decision T 12/81, Diastereomers (OJ EPO 1982, pages 296-305) the Board of Appeal has indicated (see reason 13) that if two classes of starting substances are required to prepare the end products and examples of individual entities in each class are given in two lists of some length, then a substance resulting from the reaction of a specific pair from the two lists can nevertheless be regarded for patent purposes as a selection and hence as new.

The Appellant argues that this selection principle should also apply here where the starting substance from a list of four starting substances, i.e. a boric acid complex of a triol monoester, an alkanol ester thereof, a dialkanolamine salt thereof and a dialkyl dithiophosphate thereof (see (2), column 2, lines 27-30), is combined with one of the alternative process variants, i.e. the concentration.

The Board does not share this view. It is readily shown that a combination of two starting substances is quite a different matter from a combination between starting substances and process variants and that they are thus not comparable (see T 12/81, reason 14).

As already set out above (see point 3.3) is the teaching of document (2) that borated glycerol monoesters are useful additives for lubricating oils not limited to the concentrations indicated in the Examples, but it also comprises the disclosure of the concentration range and specifically the preferred range which is sufficiently supported by the Examples.

- 3.4. The Appellant further argues that the Guidelines for Examination in the European Patent Office (see C-IV, 9.8, (2)) indicate that a range for a reaction parameter, which previously had not been explored can provide a novel selection. Apart from the non-binding character of the Guidelines to the Board the Appellant is incorrect in applying this paragraph here. Firstly, this paragraph in the Guidelines relates to inventive step and not to novelty. Secondly, as set out in 3.4 above, discloses document (2) the addition of 0.01, 0.1 and 0.5 wt.% borated glyceryl mono-oleate. These examples form a good illustration of the preferred range of 0.01 to 2 wt.% leaving no room for selection within this area. The addition of at least 1 wt.% borated glycerol ester cannot be considered as a previously unexplored area.
- 3.5. Therefore, the oil compositions according to Claim 1 of the main request and the second auxiliary request lack novelty over document (2).

These arguments apply not only to Claim 1 of the main and second auxiliary request but equally to the dependent Claims 2 to 4, which merely represent preferred embodiments of the subject-matter according to Claim 1 and thus fall with it.

Because a request can only be decided upon as a whole, also independent Claim 5 must fail. However, the Appellant has kept open the option for the subject-matter of Claim 5 by including it in a claim of different form according to the first auxiliary request, on which the Board has not decided yet.

4. As regards the first auxiliary request the Board decided on 26 April 1988 to refer the case to the Enlarged Board of Appeal.

Reasons for that decision are issued concurrently with this decision.

Order

For these reasons, it is decided that:

1. The main request is rejected.
2. The second auxiliary request is rejected.

Registrar

Chairman

01588

GA *HTP*

