BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS

BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE

CHAMBRES DE RECOURS DE L'OFFICE EUROPEEN DES BREVETS

Publication in the Official Journal ~~Yes~~ / No

File Number: T 97/90 - 3.3.1

Application No.: 84 306 559.0

Publication No.: 0 145 150

Title of invention: Lubricating agents for processing synthetic yarns and method of processing synthetic yarns therewith

Classification: D06M 15/647

D E C I S I O N
of 13 November 1991

Proprietor of the patent: Takemoto Yushi Kabushiki Kaisha

Opponent: HOECHST Aktiengesellschaft Zentrale Patentabteilung

Headword: Lubricating agents/TAKEMOTO YUSHI

EPC Articles 54(1)(2), 56, 111(1), 114(1)(2)

Keyword: novelty (affirmed) - inventive step (yes) - function of appeal proceedings - late-filed fresh ground of opposition - admitted by way of exception.

Headnote

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number : T 97/90 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 13 November 1991

Appellant : (Opponent)
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Decision under appeal :
Decision of Opposition Division of the European Patent Office dated 18 December 1989 rejecting the opposition filed against European patent No. 0 145 150 pursuant to Article 102(2) EPC.

Composition of the Board :

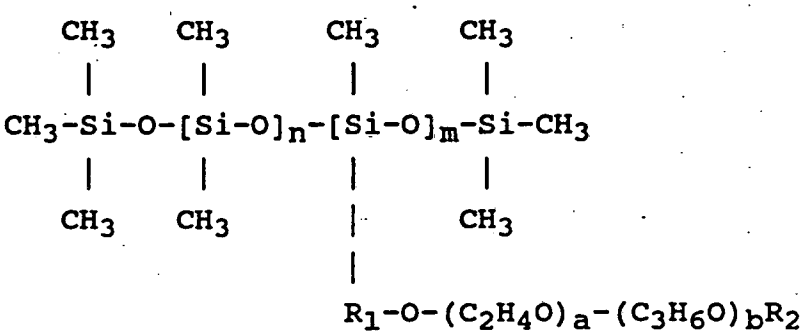
Chairman : K.J.A. Jahn
Members : J.M. Jonk
J.A. Stephens-Ofner

Summary of Facts and Submissions

I. The grant of European patent No. 0 145 150 in respect of European patent application No. 84 306 559.0 was announced on 13 January 1988 (cf. Bulletin 88/02). The patent was based on six claims, Claim 1 reading as follows:

"A lubricating agent for processing synthetic yarns, said lubricating agent comprising as a base oil thereof a lubricant comprising the following 3 constituents

(A) 0.05 to 10 weight % of a polyalkylene oxide modified polysiloxane which is shown by the general formula (1) and has average molecular weight greater than 2500:



(1)

(where n is an integer from 20 to 100; m is an integer from 1 to 9; R_1 is an alkylene group with 3 to 4 carbon atoms; R_2 is hydrogen, an alkyl group with 1 to 8 carbon atoms or an acyl group with 2 to 8 carbon atoms; a and b are integers satisfying $15 \leqslant a + b \leqslant 80$ and $2/8 \leqslant b/a \leqslant 8/2$, and the polymer repetition is either block or random repetition);

(B) 0.5 to 8 weight % of an anionic surface active ingredient agent;

and (C) 82-99.45 weight % of a polyether lubricant having a molecular weight of greater than 700 derived from an alkylene oxide with 2 to 4 carbon atoms, or of an

admixture thereof with a mineral oil and/or a lubricant ester."

II. A Notice of Opposition was filed on 15 October 1988 requesting revocation of the patent on the ground of lack of an inventive step and on no other ground. The opposition was supported by the following documents:

(1) Derwent Abstract 26 384 W/16, based on JP-A-48 053 093,
(1a) Translation of Table 1 of JP-A-48 053 093,
(2) US-A-3 234 252,
(3) DE-B-2 149 715,
(4) DE-A-2 502 155, and
(5) GB-A-1 371 956

which are relevant to the present decision.

III. By a decision dated 18 December 1989, the Opposition Division rejected the opposition, holding that the subject-matter of Claim 1 was novel since the lubricating agent according to Claim 1 differed from that of document (1) in that component (A) was a polysiloxane specified in formula (1).

It also held that the subject-matter of Claim 1 involved an inventive step. Although the polysiloxanes represented by formula (1) were known from documents (2) and (5) there was no suggestion in documents (1), (2) and (5) that by using these compounds in the present lubricating compositions, a reduction of the electrostatic charge on the yarn, a reduction of fuzz on the surface of the cheese of false twisted yarn and a reduction of heater deposits as shown by comparative examples 1 to 5 could be obtained.

In addition, documents (3) and (4), which relate to fibre lubricants containing silicones, do not suggest that the present polysiloxanes could provide such advantages.

IV. A Notice of Appeal was filed against this decision on 6 February 1990 and the appeal fee was paid on the same date.

A Statement of Grounds of Appeal was submitted on 26 April 1990.

V. The Appellant argued that it would be obvious to the skilled person to replace the polysiloxanes of the compositions according to document (1) by the present polysiloxanes of formula (1), because it was known to the skilled person, e.g. from:

(6) Walter Noll, Chemie und Technologie der Silikone, Seite 323 (1968),

that such compounds were only stable in aqueous compositions if the polyoxyalkylene moieties were linked to the silicon atoms of the polysiloxane moieties by an alkylene group. Moreover, it was disclosed in document (2) that such polysiloxane compounds could be used in lubricating compositions containing polyoxyalkylene compounds and optionally a phosphate, which were suitable as anti-static agents for organic textiles. Furthermore, it was known from document (5) that such compounds in compositions containing polyoxyalkylene compounds provided very stable band ply lubricants in the manufacture of tyres.

Additionally, it was pointed out by the Appellant that lubricating agents for processing of yarns on the basis of polyoxyalkylene compounds, polysiloxanes and surface

active compounds were known from documents (3) and (4) and that a certain improvement by the replacement of the polysiloxanes with those of formula (1) could be expected.

VI. The Respondent defended the presence of the requisite inventive step by referring to his letter of 19 April 1989. In this letter he submitted that the modified polysiloxane referred to in Table 1 of the Japanese patent publication (document 1a) did not contain any propylenoxy modifying groups and, presumably, was a conventional material in which the polyethylenoxy groups were attached to the silicon atoms of the polysiloxane chain via oxygen atoms instead of alkylene groups. Furthermore, he drew attention to the test results indicated in the opposed patent of the comparative composition containing polysiloxane A'-12 which only contained ethylenoxy units, and to further comparative tests provided in Annex B of the above-mentioned letter.

VII. During oral proceedings held on 13 November 1991 the Appellant introduced lack of novelty as a new ground of opposition (cf. point II. above), pointing out that the claimed compositions were made available to the public by means of the disclosure of document (2) cited by the Appellant in his Notice of Opposition.

Despite its strong disapproval of the Appellant's conduct in raising a new ground of opposition and mindful of its discretionary power to disregard all late-filed matter (cf. "General principles for opposition procedure in the EPO", OJ EPO 1989, 417, particularly paragraphs 2 and 13; and T 182/89 OJ EPO 1991, 391, as well as T 326/87, Headnote published OJ 1991, 09; and T 611/90 (to be published), the Board decided to admit the late-submitted matter, largely because the Board and the Respondent were

clearly in the position to deal with it, as well as for the reasons set out in paragraph 2 of this decision.

In relation to the novelty objection, the Respondent admitted that document (2) disclosed constituents in amounts falling within the scope of the claimed components A, B and C, but he nevertheless argued that the specific claimed compositions could only be deduced from this document by ex post facto analysis.

Furthermore, the Appellant argued that the claimed compositions did not involve an inventive step because, starting from document (1) as the closest state of the art, it would be obvious to replace the polysiloxanes of (1) by a polysiloxane disclosed in document (2) having anti-static properties, particularly, because it was common general knowledge (as evidenced by document (6)), that such polysiloxanes were more stable in water.

The Respondent argued that the skilled person, trying to improve heater deposit properties of lubricants for processing synthetic yarns, had no reason to take the disclosure of document (2) into account. Moreover, document (2) disclosed a large number of polysiloxanes, so that the selection of the specific claimed polysiloxanes would not have been obvious.

VIII. The Appellant requested the impugned decision to be set aside and that the patent be revoked.

The Respondent requested the appeal be dismissed and that the patent be maintained as granted, save the deletion of the words "preferably anionic" on page 5, line 18 of the published specification, and the insertion of the word "anionic" before the words "surface active agent" on the same page at the same line.

IX. At the conclusion of the oral proceedings, the Board's decision to dismiss the appeal was announced but subject to the Respondent's above request.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.

2. At the start of the oral proceedings the appellant sought to introduce a totally new ground of objection, namely that of prior publication. He freely admitted that this ground could well have been submitted and argued by him before the Opposition Division, but was unable to offer any explanation why he had not done this.

This late submittal of a new ground of objection, amounting to the raising of a totally fresh case, raises the question of the function of appeals under the EPC.

It is sometimes argued in this connection that the peremptory wording of Article 114(1) EPC:

"In proceedings before it the European Patent Office shall examine the facts of its own motion ..." means that the Boards of Appeal have to conduct what, in effect, are re-hearings of the first instance proceedings, with unfettered right, and indeed an obligation, to look at all fresh matter regardless of how late it was submitted. In the Board's judgment such an interpretation of Article 114(1) is out of the context not only of the remainder of the Article, namely Article 114(2), but also of the context of Article 111(1) EPC. When Article 114(1) is construed within its proper context, it becomes evident

that there is a clear limit to the scope of any new matter that may be introduced into an appeal by the parties or by the Board itself, because cases on appeal must be, and remain, identical or closely similar to those on which first instance decisions have been rendered.

There is clear support for the above interpretation in the Board's jurisprudence, in cases such as T 26/88, OJ EPO 1991, 030; T 326/87, Headnote published in OJ EPO 1991, 09; and T 611/90 (to be published), as well as in a number of unpublished cases e.g. T 137/90, T 38/89 and T 153/85. It follows that regardless of what arguments, facts, evidence or requests the Boards, in their judicial discretion, choose to admit into their proceedings, these proceedings must always remain appeal proceedings. A valid description of what appeal proceedings are is set out in paragraph 12 of the reasons of T 26/88 where it is stated: "... the essential function of an appeal is to consider whether a decision which has been issued by a first instance department is correct on its merits ... it is not normally the function of a Board of Appeal ... to examine and decide upon issues in the case which have been raised for the first time during appeal proceedings". This narrow interpretation of Article 114, and in particular of Article 114(1), finds further support in the wording of Article 111(1) EPC, last sentence, which clearly envisages that there will be cases which will need to be referred back by a Board of Appeal to the first instance, which reference would be totally nugatory were the Boards of Appeal enjoined to investigate all new matter, regardless of its time of introduction into their proceedings, or even to conduct a roving and exhaustive enquiry into matters not submitted at all to them by the parties. In other words, such a blanket obligation to look at all matter, however late filed, would render the function of the first instance departments either superfluous, or

delegate their role to merely providing a preliminary opinion for subsequent judicial review and decision by the Boards of Appeal.

Nevertheless, the course of action to be followed by the Boards of Appeal in dealing with late-filed matter is seldom clear cut. For example, in the above-mentioned case of T 326/87, the Board held that where fresh evidence, arguments or other matter filed late in the appeal raised a case substantially different from that decided by a first instance, that case should normally be referred back to the first instance in order to allow the parties two levels of jurisdiction. However, in its decision of T 611/90, also previously referred to, the Board of Appeal interpreted the criterion "normally" as meaning that such a reference back should be made only where this was demanded by fairness to the parties. In that case, the Board did decide to refer a totally new issue, never before argued, supported, let alone pleaded (one of prior public use) to the first instance, with an award of costs against the party responsible for its tardy introduction into the appeal proceedings. The reason for this decision is, of course, that the raising of a totally fresh ground of appeal, as is the case in the matter here under appeal, is the most extreme way of presenting a fresh case: late filed facts, evidence, requests and arguments may or may not erect such a new case, but the raising on appeal of a totally new ground of appeal must, of necessity, have this effect.

It does not, however, follow from T 611/90 that all cases where a new ground of objection is raised late in the appeal must be referred back to the first instance. On the contrary, in the Board's judgment such reference should be made only where the admittance of the new ground, into the

appeal proceedings would result in the revocation of the patent.

This approach is clearly consonant with the reasoning of decision T 416/87, OJ EPO 1990, 415, see paragraph 9 of the Reasons, where the Board stated "... a document which is relied upon by the Opponent for the first time during the appeal stage should ... normally be referred back to the first instance ... where the Board considers that a newly introduced document is so relevant that the maintenance of the patent is at risk." The reason for this approach, clearly, is that the Board's decision to revoke a patent would be final.

In cases where the maintenance of the patent would not be put at risk, the Board has two courses of action open to it: (a) refuse to admit the fresh ground of objection; (b) admit the fresh ground into the appeal proceedings, and decide it against the Opponent. In the Board's view, the latter course of action is generally preferable, because it leads to detailed reasons being made available (in the written decision), which may be of assistance in any subsequent litigation before the national courts. There may of course, as was the case in T 611/90, be situations where the very nature of the late-raised ground of objection is such as to make it impossible for the Board to arrive at even a preliminary decision, because the issue hinges totally on the credibility of evidence which the Patentee has had no time to consider, let alone attempt to rebut. In the present case, the fresh ground is one of prior publication, and although the Patentee was able to express only a preliminary view, and lead only outline arguments in response to those put forward by the Opponent, the Board has been able to come to a decision on the matter on the basis of those arguments, as well as of its motion pursuant to Article 114(1) EPC.

3. The issues to be dealt with are, therefore, whether the subject-matter of Claim 1 is novel and involves an inventive step.

4. The novelty of the subject-matter of Claim 1 has been disputed by the Appellant on the basis of document (2).

This document relates to lubricant compositions composed of a base fluid, which can be a mixture of water and a silicon-free polyoxyalkylene compound in an amount from 10 to 200 parts by weight (per 100 parts by weight of the water in the mixture), and a siloxane-polyoxyalkylene copolymer composed of a siloxane moiety linked to a polyoxyalkylene moiety by a silicon to carbon bond in an amount from 0.05 to 10.0 parts by weight per 100 parts by weight of the base fluid (cf. column 1, lines 51 to 67). Furthermore, the compositions can, if desired, contain various other additional additives in amounts from 0.1 to 5 parts per weight (per 100 parts per weight of the base fluid) (cf. column 11, lines 42 to 64).

The subject-matter of Claim 1 of the disputed patent concerns a composition which comprises three essential components:

(A) A particular polyalkylene oxide modified polysiloxane of formula (1),

(B) an anionic surface active compound and

(C) a polyether lubricant having a molecular weight of greater than 700 derived from an alkylene oxide with 2 to 4 carbon atoms.

4.1 The question is whether such a composition already forms part of the state of the art, having regard to the disclosure in document (2).

As to component (A) of the claimed composition, document (2) discloses as an essential lubricant constituent a siloxane-polyoxyalkylene copolymer wherein the siloxane moiety is linked to the polyoxyalkylene moiety by a silicon to carbon bond (cf. column 1, lines 63 to 66). Thus, this constituent comprises an unlimited group of siloxane-polyoxyalkylene copolymers. The disclosure that useful block copolymers contain at least one unit represented by the general formulae (3), (4) and (5) (cf. column 5, line 57 to column 6, line 73) neither restricts this unlimited group of copolymers, nor gives any hint in the direction of compounds falling under the scope of component (A) of the compositions claimed in the opposed patent, because these formulae are silent on how these units are bound to the rest of the molecule. These facts are not changed by the further disclosure that the copolymers can also contain at least one of the units represented by the formulae (6) to (12) (cf. column 6, line 74 to column 7, line 55), because these units do not introduce any delimitation of the disclosed polysiloxanes. Clearly defined block copolymers are shown in columns 7 and 8, wherein 16 copolymers are listed. Only one copolymer, namely copolymer XIV, falls under the definition of component (A) of the opposed patent. The only indication that these clearly defined block copolymers are representative for the unlimited group of useful copolymers - in the Board's judgment - does not disclose to the skilled person the relatively small group of compounds, represented by formula (1) in the opposed patent and having specific values for n, m, a, b, a + b and b/a, as suitable constituents of the claimed compositions.

As to claimed component (B), document (2) discloses as optional additional constituents of the lubricant composition an extensive range of additives, such as corrosion inhibitors, anti-oxidants, blooming agents, oiliness agents, anti-wear agents, solubilisers, metal deactivators, extreme pressure additives, viscosity index improvers, pour point depressants, viscosity modifiers, anti-foam agents, wetting agents, adhesive agents, cohesive agents, emulsifying agents, deemulsifying agents, break-in agents, sludge dispersants, anti-sludge agents, anti-coking agents, detergents and swelling agents (cf. column 11, lines 42 to 55). Furthermore, it is indicated that this list of additives is not an exhaustive list, and that other constituents such as bases and anti-microbacterial agents may also be present (cf. column 17, lines 31 to 48). For some of these additives fairly long lists of suitable compounds are indicated (cf. column 11, line 64 to column 13, line 39) and only a few compounds from these lists fall within the scope of component B now being claimed, namely the dibutylamine and diamylamine salts of lauric acid and alkali metal salts of alkenyl succinic acids, alkenyl succinic acid anhydrides and dialkyl acid phosphates (cf. column 12, lines 6 to 9 and lines 61 to 63). Therefore, the group of anionic surface active compounds of claimed component B, which is, contrary to the additional constituent of the compositions disclosed in document (2), an essential component of the lubricant composition, forms a very small group within the disclosed variety of additives. Moreover, the claimed anionic surface active compounds are, as a group, not indicated in document (2).

As to claimed component (C), document (2) discloses inter alia a mixture of a silicon-free polyoxyalkylene compound in general and water as one of five suitable base fluids

(cf. column 1, lines 53 to 61). This unlimited group is illustrated in column 10 by the formula $G'''(OG'')_nOG'''$. In respect of the definition of the three variables, reference is made to "the above defined meanings". In column 6, lines 13 to 14, n is defined as "at least 2" and specified in lines 17/18 as preferably "3 to 30". In view of this broad disclosure it can hardly be said that the group specified in Claim 1 under (C) of the patent in suit being clearly defined by its minimal molecular weight and by the narrow scope of the basic alkylene oxide, is disclosed in document (2). It is true that the three silicon-free polyoxyalkylene compounds indicated in column 10, lines 39 to 41, fall within the scope of claimed component (c). This, however, and the fact that, in contrast to the patent in suit, the silicon free polyether of document (2) is an optional component, which has to be selected from five alternative groups, makes it doubtful whether the skilled reader would consider component (C) of the patent in suit to be a mandatory component.

In these circumstances the Board holds that document (2) does not disclose the specific combination of the three mandatory components defined in Claim 1 of the opposed patent.

In this connection it is observed by the Board, that it must be borne in mind that document (2), and the particular constituents disclosed therein, have been mentioned by the Appellant with hindsight of the claimed compositions, and that the presence of the constituents mentioned in document (2) which fall within the scope of the claimed compositions, does not necessarily rule out a patentable selection from the vast range of possible combinations of these disclosed constituents.

4.2 The subject-matter of Claim 1 is, therefore, novel.

5. The remaining issue to be dealt with is whether the subject-matter of the claims involves an inventive step.

5.1 After consideration of the prior art documents cited during the proceedings, the Board finds that documents (1) and (1a), which are both based on JP-A-48 053 093, represent the closest state of the art.

Document (1) discloses the treatment of synthetic yarns with (75-99.5):(5-0.5):(20-0) compositions from at least one random or block copolymer (mol. wt. at least 300) from ethylene oxide and 3 to 6 C alkylene oxide (or alkyl ethers of the compolymers), a linear organopolysiloxan with viscosity 15 cSt, and a lubricant. In an example, a lubricant composition was prepared from 5 parts propylene oxide-ethylene oxide block copolymers (from polypropylene glycol with mol. wt. 3000 and 10 moles ethylene oxide), 40 parts polyethylene polypropylene glycol Bu ether, 30 parts polyethylene polypropylene glycol ether acetate, 10 parts polypropylene glycol (mol. wt. 2000), 10 parts polypropylene glycol Bu ether acetate, 1 part dimethyl-polysiloxane (viscosity 100 cSt) and 4 parts K isocetyl phosphate, i.e. a mixture comprising 1% of a polydimethyl-siloxane, 4% of an anionic surfactant and 95% of a mixture of polyether and polyester lubricants. Document (1a) discloses a methyl(polyethylene oxide) polysiloxane as another possible polysiloxane constituent.

However, it was argued by the Respondent that these known compositions have an insufficient heater deposit resistance on heaters used in heating processes. Moreover, the generation of static charge and of fuzz in processes using these lubricants was unsatisfactory.

5.2 Therefore, in the light of this closest prior art, the technical problem underlying the subject patent can be seen in providing a lubricating composition for processing synthetic yarns which is, in particular, capable of exhibiting higher levels of heater-deposit resistance and, moreover, shows improved properties in relation to the generation of static electricity and of fuzz (cf. also page 2, lines 4 to 8 and lines 21 to 26 and page 3, lines 7 to 17 and lines 24 to 32 of the printed patent specification).

5.3 According to Claim 1, this technical problem is solved by a lubricating agent comprising three components as defined under (A), (B) and (C).

In view of the undisputed test results indicated in the examples and the comparative examples, particularly comparative examples A'-1 and A'-12, the Board is satisfied that the above technical problem is credibly solved.

5.4 It remains to be decided whether, in view of the technical problem to be solved, the requirement of inventive step is met by the claimed lubricating agent.

5.5 As already indicated in section 5.1 above, paragraph 2, document (1) discloses a lubricant composition for the treatment of synthetic yarns comprising a polydimethyl-siloxane, an anionic surfactant and a mixture of polyether and polyester lubricants, whereas it can be deduced from document (1a) that the polydimethylsiloxane can be replaced by a methyl(polyethylene oxide) polysiloxane. These documents (1) and (1a), which are based on the same Japanese patent publication, do not provide any indication that would lead a skilled person to believe that lubricant agents containing the specific polyalkylene oxide modified

polysiloxanes defined in Claim 1 under (A) would provide improvements regarding heater deposit and generation of static charge and fuzz. On the contrary, these documents lead away from the use of polyalkylene oxide modified polysiloxanes because document (1), being the Derwent Abstract and disclosing the preferred composition, suggests instead the use of a polydimethylsiloxane instead of a polyalkylene oxide modified polysiloxane.

5.6 Document (2) discloses - as set out above - lubricant compositions containing a siloxane-polyoxyalkylene copolymer composed of a siloxane moiety linked to a polyoxyalkylene moiety by a silicon to carbon bond, a lubricating base fluid and, optionally, various additional additives. They are particularly suitable as lubricants for metal in cutting, forming and machining operations because of their improved carrying and anti-wear properties (cf. column 1, lines 40 to 45, column 13, lines 47 to 50 and the Examples I, II and III wherein tests are conducted to evaluate the compositions). Therefore, the skilled person faced with the existing problem to improve the properties of lubricants for the treatment of yarns would have disregarded the teaching of this document.

However, even if the skilled person would have taken the teaching of document (2) into consideration, it would not have provided him with the incentive to use the polysiloxanes as defined in Claim 1 under (A), let alone the combination of the constituents (A), (B) and (C). It is true that Copolymer XIV falls within the scope of the claimed polysiloxanes defined under (A), but the skilled person would have had no reason to select this copolymer or other closely related compounds falling under the claimed definition because, in the light of the examples showing the lubricating activity of the copolymers and

their preparation, such a copolymer would have already appeared less interesting than other Copolymers I to XVI listed in columns 7 and 8, because none of the examples is concerned with such a copolymer. Moreover, the list of Copolymers I to XVI, including Copolymer XIV, is disclosed in particular connection with their properties in lubricant compositions for metals, whereas the statement in this document that the siloxane-polyoxyalkylene copolymers are useful for other purposes, e.g. as anti-static agents for organic textiles, clearly relates to the whole large group of polysiloxanes per se and, particularly, to those copolymers containing organofunctional groups e.g. nitro, amino, halogen, amido and cyano groups (cf. column 13, lines 55 to 73).

5.7 Document (6), only mentioned by the Appellant in order to support that it was common general knowledge that siloxane-polyoxyalkylene copolymers according to document (2) containing silicon to carbon bonds between the siloxane moieties and the polyoxyalkylene moieties are more stable in water than analogous copolymers containing silicon to oxygen bonds between these moieties, also does not hold out any prospect that the envisaged technical problem could be solved by the specific siloxane-polyoxyalkylene copolymers defined in Claim 1 under (A), because no technically meaningful link can be seen between increased hydrolyic stability and improved heater-deposit resistance and the other improvements aimed at according to the existing problem (cf. point 5.2).

5.8 Documents (3) and (4) relate to fibre lubricants containing polysiloxanes and lubricating polyethers, but they do not suggest the use of the particular polysiloxanes defined in Claim 1 of the opposed patent. Actually, document (3) discloses the use of a mixture of an ethyleneoxide/propyleneoxide-copolymer and a poly-

methylphenylsiloxane having a phenyl content of at least 15 mol % in order to obtain aqueous compositions having improved heater deposit properties (cf. Claim 1, column 3, lines 45 to 55 and column 4, lines 21 to 42). This document leads away from the use of polyoxyalkylene modified polysiloxanes because these compounds showed in comparative tests insufficient properties (cf. column 12, line 64 to column 13, line 7). Document (4) refers to the possibility to use polyoxyethylene modified silicons in fibre lubricants (cf. page 5, line 7 from below) and is, therefore, not more relevant than document (1a).

5.9 Document (5) is related to a wholly different art, namely to band ply lubricants which are used in the manufacture of tyres, namely, as parting agents between the tyre carcas and the rubber bag (cf. column 1, lines 11 to 29). Whilst disclosing compositions which might contain polysiloxanes falling within the scope of Claim 1 under (A) (cf. page 1, lines 49 to 77, particularly lines 60 to 70, and the formula on page 2, line 85) it does not suggest their use in lubricants for the treatment of synthetic yarns.

5.10 Consequently, in the Board's judgment, the proposed solution to the technical problem underlying the patent in suit is inventive. Thus Claim 1 and independent Claim 4, related to a method of processing a synthetic yarn by using a lubricating agent as defined in Claim 1, which is based on the same inventive concept as Claim 1, are allowable.

Dependent Claims 2, 3, 5 and 6, which relate to preferred embodiments of the matter claimed in the independent claims, are likewise allowable.

Order

For these reasons, it is decided that:

1. The appeal is dismissed.

2. The Opposition Division's decision is set aside.

3. The case is remitted to the Opposition Division with the order to maintain the patent as granted but subject to the amendments contained in the Respondent's request.

The Registrar: The Chairman:

E. Görgmaier K.J.A. Jahn