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D E C I S I O N
of 11 July 2002

Case Number: T 0196/00 - 3.3.1

Application Number: 91300798.5

Publication Number: 0449406

IPC: C10M 105/00

Language of the proceedings: EN

Title of invention:

Esters as lubricants for a haloalkane refrigerant

Patentee:

ExxonMobil Chemical Patents Inc.

Opponent:

RWE-DEA Aktiengesellschaft für Mineraloel und Chemie
NOF Corporation
Cognis Deutschland GmbH
The Lubrizol Corporation
Nippon Oil Co. Ltd.

Headword:

Lubricant/EXXON

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

"Amendment (not allowable) - fresh combination and
generalisation of structural elements"
"Auxiliary requests (not admitted) - late filed - clearly not
allowable - tactical abuse"

Decisions cited:

G 0009/91, G 0002/92, T 0153/88, T 0288/92, T 0680/93,

T 0396/97

Catchword:

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Case Number: T 0196/00 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 11 July 2002

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Decision under appeal: Interlocutory decision of the Opposition Division
of the European Patent Office posted
20 December 1999 concerning maintenance of
European patent No. 0 449 406 in amended form.

Composition of the Board:

Chairman: A. J. Nuss
Members: R. Freimuth
J. P. B. Seitz

Summary of Facts and Submissions

- I. The Appellants I to V (Opponents I to V) lodged appeals on 25, 15, 12, 11 and 14 February 2000, respectively, against the interlocutory decision of the Opposition Division, posted on 20 December 1999, which found that the European patent No. 449 406 in the form as amended during opposition proceedings according to the then pending main request met the requirements of the EPC.
- II. Notice of Opposition had been filed by the Appellants requesting revocation of the patent in suit in its entirety on the grounds of Article 100(a), (b) and (c) EPC, in particular on the grounds of extending the subject-matter beyond the content of the application as filed and of lack of sufficient disclosure, novelty and inventive step.
- III. The Opposition Division held that the subject-matter of the patent in suit as amended did not extend beyond the content of the application as filed, that the invention was sufficiently disclosed and that the documents cited neither anticipated nor rendered obvious the claimed subject-matter. With respect to the amendments made to claim 1 the Opposition Division found that the temperature range of -15°C to $+80^{\circ}\text{C}$ was supported by specimen 33 of the application as filed. The numerical limits indicated in claim 1 for the acid number, the moisture and ash content were found on page 4, lines 15 to 19 of the A1-publication and page 4, line 23 thereof supported the feature "organic" defining the carboxylic acid.
- IV. At the oral proceedings before the Board, held on 11 July 2002, the Respondent (Proprietor of the patent)

defended the maintenance of the patent in suit in amended form on the basis of a main request submitted on 10 June 2002 as "Auxiliary request B2" and subsidiarily either on the basis of a first or second auxiliary request, both requests submitted during those oral proceedings.

The main request comprised a set of twenty four claims, independent claim 1 reading as follows:

"1. The use as a lubricant with 1,1,1,2-tetrafluorethane refrigerant of an ester of one or more of pentaerythritol, dipentaerythritol and tripentaerythritol and one or more C₅ to C₁₂ organic carboxylic acids, which is miscible without separation from a 10 wt % solution of the ester in the refrigerant 1,1,1,2-tetrafluorethane at a temperature in the range of -15°C to 80°C and which has a viscosity range of 2 to 30 mm²/s at 100°C, an ash content of less than 10 ppm, a total acid number of 0.05 mg KOH/g or less and a moisture content of 500 ppm or less."

The first auxiliary request comprised a set of twenty one claims, independent claim 1 reading as follows:

"1. The use as a lubricant with 1,1,1,2-tetrafluorethane refrigerant of one or more ester of pentaerythritol, dipentaerythritol or tripentaerythritol and C₅ to C₁₂ straight or branched chain fatty acids, which is miscible without separation from a 10 wt % solution of the ester in the refrigerant 1,1,1,2-tetrafluorethane at a temperature in the range of -30°C to 100°C and which has a viscosity range of 2 to 30 mm²/s at

100°C, an ash content of less than 10 ppm, a total acid number of 0.05 mg KOH/g or less, a moisture content of 500 ppm or less, a peroxide number of 1 meq/kg or less, an aldehyde number of 1 mg KOH/g or less and a bromine number index of 10 mg/100 g."

The second auxiliary request differed from the first auxiliary request exclusively in that the upper limit of the moisture content in claim 1 was reduced to 200 ppm.

- V. The Appellants argued in essence that in the main request the fresh temperature range of -15°C to +80°C was an undue generalisation of an example and that this range was not originally identified as essential for the invention, thereby extending the subject-matter of claim 1 of the main request beyond the content of the application as filed. Furthermore the particular combination indicated in claim 1 of the parameters miscibility, viscosity, acid number, moisture content and ash content was not found in the original application. Claim 1 of the main request further specified an ester of a C₅ to C₁₂ organic carboxylic acid. However, this number of carbon atoms of the carboxylic acid was disclosed on page 5, lines 12 to 15 of the application as filed only for straight or branched chain fatty acids. That amendment of claim 1 thereby generated fresh subject-matter which extended beyond the content of the original application.

The Appellants objected to the fresh sets of claims submitted as auxiliary requests by the Respondent during the oral proceedings before the Board. These sets of claims should not be admitted into the

proceedings as they were filed at the very last moment of the appeal proceedings though the objections supposed to be met by these fresh sets had already been raised by the Appellants from the beginning of the proceedings on. Furthermore these fresh sets of claims gave rise to new objections under Article 123(2) EPC since the temperature range of -30°C to 100°C defining the miscibility in fresh claim 1 according to either auxiliary request was originally disclosed as being the operating temperature of the lubricating oil which latter temperature was different from the miscibility temperature.

VI. The Respondent argued that the amendments made to the claims of the main request did not extend beyond the content of the application as filed. The temperature range of -15°C to $+80^{\circ}\text{C}$ was found in specimen 33 of the application as filed. The limits of the parameters acid number, moisture and ash content indicated in claim 1 were found in original claims 7, 8 and 9. The feature "organic" defining the carboxylic acid was supported by page 4, line 11 of the application as filed and the number of carbon atoms of 5 to 12 comprised in these acids was based on page 5, line 15 thereof. Therefore claim 1 according to the main request was in keeping with the requirements of Article 123(2) EPC.

The fresh sets of claims submitted as auxiliary requests at the oral proceedings before the Board should be admitted into the proceedings. Though being filed late, the fresh amendments made in these claims reflected the Appellants' objection of adding subject-matter which was raised against claim 1 according to the main request. The fresh range for miscibility specified in claim 1 according to either auxiliary

request was found on page 1, line 32 of the application as filed.

- VII. The Appellants requested that the decision under appeal be set aside and that the patent be revoked.

The Respondent requested that the decision under appeal be set aside and that the patent be maintained on the basis of either claims 1 to 24 according to the main request submitted on 10 June 2002 as "Auxiliary request B2" or claims 1 to 21 of a first and second auxiliary request submitted during the oral proceedings.

- VIII. At the end of the oral proceedings the decision of the Board was given orally.

Reasons for the Decision

1. The appeals are admissible.

Main request

2. *Amendments (Article 123(2) EPC)*

- 2.1 The Respondent has carried out amendments to claim 1 in the course of appeal proceedings (see point IV above). In case of such amendments, they must be fully examined by the Board as to their compatibility with the requirements of the EPC, in particular with the provisions of Article 123 EPC (see decision G 9/91, *loc cit.*, point 19 of the reasons).

- 2.2 In order to determine whether or not an amendment

offends against Article 123(2) EPC it has to be examined whether technical information has been introduced which a skilled person would not have objectively and unambiguously derived from the application as filed (see decisions T 288/92, point 3.1 of the reasons; T 680/93, point 2 of the reasons; neither published in OJ EPO).

- 2.3 The Respondent has made several amendments to claim 1 as granted. One of the amendments consists in specifying the ester to be formed from "one or more of pentaerythritol, dipentaerythritol and tripentaerythritol and one or more C₅ to C₁₂ organic carboxylic acids".

However, the application as filed discloses on page 5, lines 12 to 15 an ester of pentaerythritol, dipentaerythritol or tripentaerythritol and a straight chain or branched chain carboxylic fatty acid having 5 to 12 carbon atoms. In the Board's judgement, the skilled person derives from that paragraph of the application as filed nothing more than the bare disclosure of the structural elements in their particular combination, namely a number of carbon atoms of 5 to 12 for straight/branched chain fatty acids. Therefore the original disclosure of that particular combination of structural elements cannot support the generalisation indicated in claim 1 as amended which results in claiming esters of a carboxylic acid wherein the number of carbon atoms of 5 to 12 defines any organic acid. To dismantle the definition of 5 to 12 carbon atoms from the particular group of straight/branched fatty acids and to generalise that definition to any other organic acid, provides the skilled person with technical information which is not

directly and unambiguously derivable from the application as filed.

2.4 The Respondent argued that the feature "organic" defining the carboxylic acid was supported by page 4, line 11 of the application as filed. While that passage of the original application contains this feature, it relates however to considerations on how to achieve a suitable lubricant oil for each type of refrigerant. That disclosure is not only silent about the number of carbon atoms of the carboxylic acid in the ester, but is also not in the context of a structural definition of the organic acid ester. Thus, the Respondent's argument cannot overcome the above objection that the combination of the structural elements defining the acid in claim 1 as amended, i.e. an acid being simply "organic" and "having 5 to 12 carbon atoms", generates fresh subject-matter.

2.5 The Board concludes that the amendment of claim 1 objected to in point 2.3 above already extends the subject-matter claimed beyond the content of the application as filed, thus, contravening the provisions of Article 123(2) EPC. Therefore there is no need for the Board to examine and to decide whether or not further amendments of claim 1 are in keeping with the requirements of Article 123(2) EPC. In these circumstances, the Respondent's main request is not allowable and must be rejected.

Auxiliary requests 1 and 2

3. *Admissibility*

3.1 The first and the second auxiliary request were filed

for the first time at the very last stage of the appeal proceedings, namely during the oral proceedings before the Board. Claim 1 according to either auxiliary request comprises fresh amendments; one of them found in both requests consists in specifying "a temperature in the range of -30°C to 100°C" for the miscibility without separation of the ester in the refrigerant 1,1,1,2-tetrafluorethane.

- 3.2 The purpose of the appeal procedure in *inter partes* proceedings is mainly to give a party being adversely affected the possibility of challenging the decision of the first instance. If the Opponents are the sole Appellants against an interlocutory decision maintaining the patent in suit in amended form, as in the present case, the Respondent-Patentee is primarily restricted during the appeal proceedings to defend the patent in the form in which it was maintained by the Opposition Division in its interlocutory decision. However, if the Respondent-Patentee wants other requests to be considered, admission of these requests into the proceedings is a matter of discretion of the Board of Appeal, and is not a matter of right of the non-appealing Proprietor of the patent (see decision G 2/92, OJ EPO 1994, 875, point 15 of the reasons). For exercising due discretion in respect of the admission of fresh requests by the non-appealing Patentee that were not before the Opposition Division, it is established case law of the Boards of Appeal that crucial criteria to be taken into account are whether or not the amended claims of those fresh requests are clearly allowable and whether or not there is proper justification for their late filing to forestall tactical abuse (e.g. decisions T 153/85, OJ EPO, 1988, 1, points 2.1 and 2.2 of the reasons; T 396/97, point 4

of the reasons, not published in OJ EPO).

3.2.1 The application as filed discloses on page 1, lines 30 to 32 a temperature range of -30°C to 100°C as normal operating temperature of a lubricating oil for a refrigerant, while Claim 1 according to either auxiliary request indicates that temperature range to define the miscibility without separation of the lubricating ester in the refrigerant 1,1,1,2-tetrafluorethane. Thus, the passage of the application as filed referred to by the Respondent addresses the temperature range at which the lubricant is normally to be operated and does not address the temperature range at which the lubricant is miscible without separation in the refrigerant. However, the operating temperature and the miscibility temperature are of a different nature. Therefore, defining in fresh claim 1 the temperature for the miscibility without separation of the lubricating ester in the refrigerant on the basis of a numerical temperature which is disclosed in the original application with respect to a temperature of different nature, namely the normal operating temperature of the lubricant, results in generating technical information which is not directly and unambiguously derivable from the application as filed.

Thus, the Respondent's first and second auxiliary request are clearly not allowable as claim 1 is not in keeping with the requirements of Article 123(2) EPC.

3.2.2 Further, the objections which may have prompted the first and the second auxiliary request were known to the Respondent from the beginning of the appeal proceedings, indeed even from the opposition proceedings. The Appellants-Opponents objected from the

beginning on to the temperature range defining the miscibility without separation of the lubricating ester in the refrigerant. While having had more than four years time after the filing of the opposition to consider appropriate amendments, the Respondent waited for the oral proceedings before the Board to present fresh requests comprising *inter alia* substantial amendments of the temperature range defining the miscibility. No reasons have been given for the filing of the auxiliary requests at the very last moment. In the absence of any proper justification the very late filing of those requests amounts to a tactical abuse also warranting their rejection.

- 3.3 For all these reasons, the Board, in exercising its discretion, has decided not to admit the first and the second auxiliary request into the proceedings.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

N. Maslin

A. Nuss