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D E C I S I O N
of 1 March 2005

Case Number: T 0747/00 - 3.3.1

Application Number: 91906933.6

Publication Number: 0557279

IPC: C10M 105/38

Language of the proceedings: EN

Title of invention:

Refrigerant working fluids including lubricants

Patentee:

HENKEL CORPORATION

Opponents:

Imperial Chemical Industries PLC
RWE - DEA Aktiengesellschaft für Mineraloel und Chemie

Headword:

Refrigerant working fluids/HENKEL

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

"Amendments: disclaimer not allowable - excluded subject-matter not anticipated"

Decisions cited:

"G 0001/03

Catchword:

-



Case Number: T 0747/00 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 1 March 2005

Appellant: HENKEL CORPORATION
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Respondents:
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Representative: -

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Representative: -

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 19 May 2000
revoking European patent No. 0557279 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: A. J. Nuss
Members: P. P. Bracke
J. H. Van Moer

Summary of Facts and Submissions

- I. The appeal lies from the Opposition Division's decision to revoke European patent No. 0 557 279 on the grounds that the sets of claims underlying the decision under appeal either did not meet the requirements of Article 123(2) and (3) EPC or did not fulfil the requirement of novelty.
- II. At the oral proceedings before the Board on 1 March 2005, where only the Appellant (Proprietor of the patent) was represented, the Appellant filed sets of claims according to a main request and according to a first and a second auxiliary request.

Claim 1 of the **main request** read:

"1. A refrigerant working fluid comprising:

(A) a chlorine-free fluoro-group containing heat transfer fluid; and

(B) a moderate to high viscosity lubricant composition consisting of esters of (i) alcohols containing at least two -OH groups and (ii) organic carboxylic acids, wherein:

(a) at least 22 number percent of the acyl groups in the total of all the esters in said lubricant composition include no more than six carbon atoms;

(b) the ratio of the number percent of acyl groups in the total of all the esters in said lubricant composition that contain 8 or more carbon atoms

and are unbranched to the number percent of acyl groups in the total of all the esters in said lubricant composition that are both branched and contain not more than 6 carbon atoms is not greater than 1.56;

- (c) the number percent of acyl groups in the total of all the esters in said lubricant composition that contain nine or more carbon atoms is between 21 and 67 number percent; and
- (d) at least 62 number percent of the total of all the alcohol moieties in the ester in said lubricant composition contain moieties derived from alcohols selected from the group consisting of pentaerythritol and dipentaerythritol,

with the proviso that refrigerant working fluids comprising the following esters are excluded:

- (1) the ester of pentaerythritol and a mixture of isononoic acid and valeric acid in weight ratios of 35:65 and 61:39; and
- (2) a mixture of esters of
 - 30 parts by weight of a tetraester of pentaerythritol (1 mol) and 3,5,5-trimethylhexanoic acid (4 mol),
 - 40 parts by weight of a hexaester of dipentaerythritol (1 mol) and 3,5,5-trimethylhexanoic acid (6 mol), and

- 30 parts by weight of an octaester of tripentaerythritol (1 mol), 3-methylbutanoic acid (4 mol) and 3-methylpentanoic acid (4 mol)."

Claim 1 of the **first auxiliary request** was identical to Claim 1 of the main request, with the exception that also

"(3) the ester of pentaerythritol and a mixture of 25 mole% Neo 1214 acid and 75 mole% acetic acid."

was excluded by a third disclaimer.

Claim 1 of the **second auxiliary request** differed from Claim 1 of the first auxiliary request only in that the feature (c) was rephrased as follows:

"(c) between 21 and 67 number percent of acyl groups in the total of all the esters in said lubricant composition contain nine or more carbon atoms".

III. The Appellant submitted that the definition of the refrigerant working fluids by disclaimers was in agreement with the requirements specified in the order of G 1/03 (OJ EPO 2004, page 413). In particular, the Appellant submitted that disclaimer (1) was suitable for restoring novelty over document

(5) EP-A-0 458 584.

IV. The Appellant requested that the decision under appeal be set aside, that the subject-matter of the sets of claims filed during the oral proceedings be held to

comply with Article 123(2) and (3) EPC and Article 54 EPC and that the case be remitted to the first instance for further prosecution.

The Respondents requested in writing that the appeal be dismissed.

V. At the end of the oral proceedings the decision was pronounced.

Reasons for the Decision

1. The appeal is admissible.

2. Main request

2.1 Article 123(2) EPC

2.1.1 Since in the application as filed the refrigerant working fluids were not defined by using a disclaimer defining subject matter to be excluded from the patent protection, the question arises whether by the introduction in Claim 1 of disclaimers (1), (2) and (3) subject-matter was added extending beyond the content of the application as filed.

2.1.2 According to the decision G 1/03 an amendment to a claim by the introduction of a disclaimer may not be refused under Article 123(2) EPC for the sole reason that neither the disclaimer nor the subject-matter excluded by it from the scope of the claims have a basis in the application. However, in the order 2.2 of G 1/03 it is specified that, as an essential

requirement, a disclaimer should **not remove more than is necessary** either **to restore novelty** or to disclaim subject-matter excluded from patentability for non-technical reasons.

- 2.1.3 Disclaimer (1) in Claim 1 was incontestably intended to restore novelty by removing the first and the second blends described in example 3 of document (5), which were defined as

"Blend of Pe/iso C₉ acid with Pe/C₅ acid (61:39 wt%)"

and

"Blend of Pe/iso C₉ acid with Pe/C₅ acid (35:65 wt%)",

wherein Pe stands for pentaerythritol (see page 4, line 25).

- 2.1.4 The first question in deciding whether the requirement of order 2.2 of G 1/03 is effectively fulfilled is then, whether the disclosure of the first and the second blends described in example 3 of document (5) would have constituted a novelty destroying disclosure for Claim 1 without disclaimer (1), in particular, whether lubricant compositions (B) defined in Claim 1 without disclaimer (1) were directly and unambiguously derivable from those blends of esters.

In example 3 of document (5) it is not specified whether the esters of pentaerythritol with iso C₉ acid and of pentaerythritol with C₅ acid are fully esterified esters, i.e. whether all OH-groups of pentaerythritol are esterified, and there is nowhere a disclosure in

document (5) to the effect that the stated esters must be fully esterified. To the contrary is even the case, as from page 2, lines 44 to 47, it clearly follows that advantages can be gained from the use of **partially esterified** polyols.

In the absence of any information about the degree of esterification of the pentaerythritol in the esters of the blends described in example 3 of document (5), it is neither possible to find out by calculation the number percent of the acyl groups in the total of all the esters including no more than six carbon atoms nor the number percent of the acyl groups in the total of all the esters that contain nine or more carbon atoms.

As, thus, neither example 3 nor the general description of document (5) give sufficient information to find out whether the features (B) (a) and/or (B) (c) of the lubricant composition according to Claim 1 are fulfilled, the refrigerant working fluids of Claim 1, without taking disclaimer (1) into consideration, are not directly and unambiguously derivable from the first and the second blends described in example 3 of document (5) and the disclosure of both blends cannot be considered to be detrimental to the novelty of Claim 1, without taking disclaimer (1) into consideration.

- 2.1.5 Since in the absence of a novelty-destroying disclosure disclaimer (1) thus removes subject matter without any need to do so, that disclaimer necessarily removes more than is necessary to restore novelty, which is not allowable according to the order 2.2 of G 1/03.

Therefore, the subject-matter of Claim 1 is extended beyond the content of the application as filed, contrary to the requirement of Article 123(2) EPC.

- 2.1.6 The Appellant had made calculations in support of his submission that the first and the second blends described in example 3 of document (5) fulfilled all the features of Claim 1. The Appellant himself, however, had to agree at the oral proceedings before the Board that such calculations were made on the unsupported assumption that the said pentaerythritol esters were fully esterified.

Since, however, it is the consistent jurisprudence of the Boards of Appeal of the EPO that a disclosure is novelty-destroying only if all features of the claimed subject-matter are directly and unambiguously derivable from one prior art document, assumptions cannot be taken into consideration in assessing novelty.

- 2.2 First and second auxiliary requests.

Since Claim 1 in any of those requests contains the same disclaimer (1), for the reasons given in point 2.1 above, those claims also contravene Article 123(2) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

N. Maslin

A. Nuss