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**D E C I S I O N**  
**of 1 September 2005**

**Case Number:** T 0985/03 - 3.3.01

**Application Number:** 99307410.3

**Publication Number:** 0994174

**IPC:** C10M 101/02

**Language of the proceedings:** EN

**Title of invention:**

Automatic transmission fluid composition comprising low viscosity index naphthenic oil

**Applicant:**

Chevron U.S.A. Inc.

**Opponent:**

-

**Headword:**

Lubricating composition/CHEVRON

**Relevant legal provisions:**

EPC Art. 54, 84, 111(1), 123(2)

**Keyword:**

"Amendments allowable (yes) - directly and unambiguously disclosed"

"Novelty (yes) - process not specifically disclosed"

"Remittal (yes) - fresh process claims"

**Decisions cited:**

-

**Catchword:**

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Case Number: T 0985/03 - 3.3.01

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.01  
of 1 September 2005

**Appellant:** Chevron U.S.A. Inc.  
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California 94583-4289 (US)

**Representative:** Nash, David Allan  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 24 April 2003  
refusing European application No. 99307410.3  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** R. Freimuth  
**Members:** P. Ranguis  
J. Van Moer

## Summary of Facts and Submissions

I. The appeal lodged on 2 July 2003 lies from the decision of the Examining Division posted on 22 April 2003 refusing European patent application No. 99 307 410.3 (European publication No. EP-A-0 994 174).

II. The decision under appeal was based on a set of seventeen claims filed at the oral proceedings before the Examining Division which took place on 31 March 2003. Independent Claim 1 was directed to a lubricating composition *per se*.

III. The Examining Division found that the subject-matter of this request was novel over document

(1) US-A-5 520 832

on the ground that this document did not disclose a lubricating composition comprising, as component (2), a mineral oil having a naphthenes content of at least 33 wt.%.

The claimed subject-matter lacked, however, inventive step over document (1) since there was no demonstration that the naphthenes content of the naphthenic mineral oil affected the viscosity properties of the claimed lubricating composition.

IV. The Appellant, annexed to the statement of the grounds of appeal, submitted by a letter received on 2 September 2003, an amended set of seventeen claims.

V. By a communication dated 3 June 2005 accompanying the summons to oral proceedings, the Board informed the Appellant that novelty of the claimed lubricating composition over document (1) and document

(2) US 3 915 871

would be discussed at the oral proceedings. Although, document (2) was not considered by the Examining Division, it formed part of the examining/appeal proceedings since it was cited in the European search report in the category "X".

VI. Oral proceedings before the Board took place on 1 September 2005. At the oral proceedings, the Appellant submitted as sole request a set of sixteen claims, directed to the preparation process of the lubricating composition. The only independent Claim 1 read as follows:

"1. A process for preparing a lubricating composition having

(1) an unsheared kinematic viscosity at 100°C of at least 0.065 Stokes (6.5 centistokes);

(2) a sheared kinematic viscosity at 100°C of at least 0.065 Stokes (6.5 centistokes), wherein shear is measured by the 20 hour KRL method; and

(3) a Brookfield viscosity at -40°C of no greater than 175 Poise (17,500 centipoise);

the process characterised by blending:

(1) a first mineral oil selected from a high viscosity index mineral oil, a conventional low viscosity index mineral oil, and mixtures thereof;

(2) a second mineral oil consisting of a hydrocracker-derived, low viscosity index mineral oil having a naphthenes content of at least 33 wt.% prepared by:

(i) passing a first bottoms portion comprising not more than 67 wt.% of a fuels hydrocracker bottoms recycle stream to a dewaxing zone; and passing a second bottoms portion comprising at least 33 wt.% of said recycle stream back to said feed hydrocracker for additional processing; and wherein said recycle stream has a viscosity at 100°C of less than 0.04 stokes (4.0 centistokes);

(ii) contacting said first bottoms portion with a dewaxing catalyst under catalytic dewaxing conditions, wherein at least a portion of said hydrocracker bottoms is substantially dewaxed;

(iii) contacting at least a portion of said substantially dewaxed hydrocracker bottoms with a hydrofinishing catalyst under hydrofinishing conditions, thereby producing a hydrofinished, dewaxed hydrocracker bottoms; and

(iv) removing from said hydrofinished, dewaxed hydrocracker bottoms at least one light fraction comprising diesel or jet fuel range material, thereby leaving a heavy fraction consisting of said hydrocracker-derived, highly naphthenic, low viscosity index mineral oil having a naphthenes content of at least about 33 wt.%;

(3) at least one polymethacrylate polymer; and

(4) a performance additive package comprising at least one lubricating composition additive; and

wherein components (1) and (2) are comprised from 0 to 90 wt% of component (1) and from 10 to 100 wt% of component (2) in a base oil mixture which constitutes a major amount of the lubricating composition;

wherein component (3) is present in the composition in an amount of from 2 to 14 wt%;

wherein component (4) is present in the composition in an amount of from 2 to 14 wt%;

wherein "high viscosity index" mineral oil means (1) a viscosity index of at least 90 for a mineral oil having a viscosity of 0.03 Stokes at 100°C; (2) a viscosity index of at least 105 for a mineral oil having a viscosity of 0.04 Stokes at 100°C; (3) a viscosity index of at least 115 for a mineral oil having a viscosity of 0.05 Stokes at 100°C; and (4) a viscosity index of at least 120 for a mineral oil having a viscosity of 0.07 Stokes at 100°C and where "high" viscosity indices for other viscosities can be determined by conventional interpolation;

and wherein "low viscosity index" mineral oil means mineral oils having viscosity indexes lower than as set forth above for "high viscosity index" mineral oils."

VII. With respects to novelty of the now claimed process, the Appellant argued that document (1) did not disclose a process for preparing a lubricating composition involving the blending of a first mineral oil (1) as defined in Claim 1 with a naphtenic mineral oil (2) having a naphtenes content of at least 33 wt %, derived from hydrofinished, dewaxed hydrocracker bottoms. Document (1) was, in particular, silent regarding the naphtenes content of the naphtenic mineral oil used therein and furthermore did not disclose the process to obtain it.

Regarding document (2), it was pointed out that this document disclosed a process for preparing a lubricating oil involving the use of an unhydrorefined naphtenic mineral oil which was different from the mineral oil (2) as defined in Claim 1 since said oil (2) was hydrorefined and dewaxed. Furthermore, this document did not unambiguously disclose a process for preparing a lubricating composition comprising blending a first mineral oil as defined in Claim 1, a naphtenic mineral oil and a polymethacrylate.

VIII. The Appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the sole request filed at the oral proceedings before the Board.

IX. At the end of the oral proceedings the decision of the Board was announced.

## Reasons for the Decision

1. The appeal is admissible.

2. *Amendments*

2.1 Regarding Claim 1, the category of claim was changed, i.e. switched from a product claim as filed to a claim directed to a process for its preparation. Such an amendment is directly and unambiguously derivable from the application as filed (see page 7, lines 18 to 21 and page 16, lines 17 to 19).

In the definition of the second mineral oil the term "comprising" was replaced by "consisting of" (see definition of oil (2) in Claim 1 of the application as filed versus present Claim 1, point VI above).

The Board observes that in the original examples related to lubricating compositions having the required viscometric properties defined in Claim 1, i.e. Examples Nos. 2 and 3, Table 5; No. 1, Table 7; Nos. 3 and 4, Table 9 and Nos. 2 to 4, Table 10, the mineral oils (2) used, i.e. low VI base oils A<sub>1</sub> and A<sub>2</sub>, **consist of** a hydrocracker-derived, highly naphthenic, low viscosity index base oil prepared from a hydrocracker bottoms such as defined in Claim 1 (see page 16, lines 21 to 23). For this reason, the Board concludes that the person skilled in the art derives directly and unambiguously the term "consisting of" from the application as filed.

The definitions of the "high viscosity index" and "low viscosity index" now included find support in the



application as originally filed (see page 5, line 14 to page 6, line 1 and page 13, line 24 to page 14, line 3).

2.2 Apart from the shift from product claims to process claims, the subject-matter of Claims 2 to 16 corresponds to that of Claims 2, 3, 5 to 17 as originally filed, respectively.

2.3 It derives from the above that the European patent application was not amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. There is, therefore, no objection under Article 123(2) EPC.

### 3. *Clarity*

The clarity of the claims was not objected to in the decision under appeal. Nor does the Board see any reason to take a different view. Hence, the claims satisfy the provisions of Article 84 EPC.

### 4. *Novelty*

4.1 Document (1) specifically discloses various lubricating compositions, in particular, tractor hydraulic fluids blends prepared from the following components:

- a paraffinic mineral base oil having a viscosity of 3.6-3.9 cSt at 100°C,
- a naphthenic mineral base oil having a typical viscosity of about 2.2 cSt at 100°C,
- polymethacrylate having a weight average molecular weight of 750,000, shear stability index of about 45,

- polymethacrylate having a weight average molecular weight of 100,000, a shear stability index of about 1 and
- commercially available additive packages containing antiwear agent, detergent, antirust agent, copper corrosion inhibitor, antioxidant, friction modifier, pour point depressant and antifoam.

These various components were blended (see col. 3, lines 11 to 14 and col. 4, lines 1 to 13).

In view of the silence of this document regarding the naphtenes content of the naphtenic mineral oil, the particular range of naphtenes content of at least 33 wt.% of the second mineral oil as defined in Claim 1 distinguishes the claimed subject-matter from the process of document (1). Furthermore, document (1) is also silent regarding whether or not the naphtenic mineral oil used is hydrofinished and dewaxed whereas the mineral oil (2) as defined in Claim 1 is derived from hydrofinished and dewaxed hydrocracker bottoms. Both characteristics constitute technical features of the mineral oil (2) used in the claimed process which are not disclosed in document (1).

A claimed invention lacks novelty unless it includes at least one technical feature which distinguishes it from the state of the art. Since the claimed subject-matter as defined in Claim 1 and dependent Claims 2 to 16 differs from the disclosure of document (1) by the above mentioned technical features, it is novel over this document.

4.2 Document (2) discloses a lubricating composition comprising a major amount of hydrocracked paraffinic lube oil, an unhydrorefined naphthenic distillate and a minor amount of an oxidation inhibitor (see col.1, lines 43 to 56, Claims 1 and 3). The lubricating composition can additionally contain a high molecular weight polymer of the viscosity index "builder" class, such as among others polymethacrylates, or mixtures of two or more of such polymers (col. 2, lines 3 to 9).

The claimed process differs from document (2) in that the mineral oil (2) as defined in Claim 1 is derived from hydrofinished, dewaxed hydrocracker bottoms. The hydrofinishing and dewaxing constitute technical features of the mineral oil (2) which features distinguish the oil from the disclosure of document (2) wherein the naphthenic distillate is unhydrorefined. Furthermore, document (2) does not specifically disclose to add to the naphthenic distillate and the hydrocracked paraffinic lube oil a polymethacrylate dispersant. In that respect, Example V, which is the sole example relating to a lubricating composition comprising an unhydrorefined naphthenic distillate, does not mention any polymethacrylate.

Since the claimed subject-matter as defined in Claim 1 and dependent Claims 2 to 16 differ from the disclosure of document (2) by the above mentioned technical features, it is novel in view of this document.

4.3 There is, therefore, no objection under Article 54 EPC over the prior art cited.

5. *Remittal*

5.1 Having so decided, the Board has not taken a decision on the complete case, since substantial amendments to the subject-matter claimed have been made, namely by dropping any product claim and by submitting exclusively fresh process claims which were only presented at the oral proceedings before the Board.

Such amendments are substantial in the sense that in the present case the examination has to be carried out on a new basis as it results in a subject-matter never examined by the Examining Division.

The decision under appeal did not consider the fresh process claims with the consequence that the Board is faced with a fresh case never examined before. Although the EPC does not guarantee the parties an absolute right to have all the issues considered by two instances, it is well-recognised that the Board may exercise its discretion under Article 111(1) EPC to remit the case to the first instance in order not to deprive the Appellant of the possibility of being heard by two instances.

5.2 Under these circumstances, the examination not having been concluded, the Board finds it appropriate to exercise the power conferred on it by Article 111(1) EPC to remit the case to the Department of first instance for further prosecution.

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
  
2. The case is remitted to the department of first instance for further prosecution on the basis of Claims 1 to 16 filed at the oral proceedings before the Board.

The Registrar:

The Chairman:

N. Maslin

R. Freimuth