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**Datasheet for the decision  
of 14 November 2007**

**Case Number:** T 1407/04 - 3.3.01

**Application Number:** 98904797.2

**Publication Number:** 0968261

**IPC:** C10M 169/00

**Language of the proceedings:** EN

**Title of invention:**

Corrosion resistant lubricants, greases and gels

**Applicant:**

Elisha Holding LLC

**Opponent:**

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**Headword:**

Lubricant/ELISHA

**Relevant legal provisions:**

EPC Art. 113(1), 123(2)

EPC R. 71(2)

**Keyword:**

"Amendments - supported by the application as filed (no)"

**Decisions cited:**

G 0004/92

**Catchword:**

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Case Number: T 1407/04 - 3.3.01

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.01  
of 14 November 2007

**Appellant:** Elisha Holding LLC  
2000 U.S. Highway 63 South  
Moberly  
MO 65270 (US)

**Representative:** Bailey, David Martin  
Brookes Batchellor  
102-108 Clerkenwell Road  
London EC1M 5SA (GB)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 14 May 2004  
refusing European application No. 98904797.2  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** A. Nuss  
**Members:** P. Ranguis  
C.-P. Brandt

## Summary of Facts and Submissions

- I. This appeal lies from the decision of the Examining Division to refuse the European patent application No. 98 904 797.2 (European publication No. 0 968 261) for lack of inventive step (Article 56 EPC).
- II. The set of claims refused by the Examining Division contained twenty four claims. Claim 1 read as follows:
- "1. A lubricant, grease or gel composition comprising: a base oil comprising at least one member selected from polyalphaolefins, polybutenes, polyol esters, and polymerised 1-decene; a polymer comprising at least one polyurethane, epoxy, oil modified epoxy or oil-modified polyurethane and at least one silicate thickener."
- III. With a letter received on 3 August 2007, the Appellant submitted as sole request a set of seventeen claims. Claim 1 reads as follow:
- "1. A corrosion lubricant, grease or gel comprising:
- i) at least one base oil comprising at least one member selected from the group of polyalphaolefins and polybutenes,
  - ii) at least one polymer comprising at least one epoxy functional compound, and;
  - iii) at least one silicate-containing thickener."
- IV. The Appellant argued that whilst the wording of amended claim 1 did not expressly appear textually as such within the description as filed, there was nevertheless clear basis for this to be found in the statement of

the invention at page 4, lines 28-31, particularly lines 30-31, of the description. In this passage, so he argued, there was a clear and unmistakable disclosure that epoxy polymers could be added to the gel to reduce oil loss or migration from the gel. Additional support for the amendment made could be found in the detailed description at page 6, lines 26-32, particularly lines 28-30, in which the composition was further described as including an epoxy polymer to enhance the physical characteristics of the gel over an extended period. Yet further support could be found in the illustrative examples, particularly Example 9 which comprised, amongst other things, (i) a polyalphaolefin oil as a base oil, (ii) an epoxy resin, and (iii) sodium silicate; and Example 13 which comprised (i) a polybutene oil as base oil, (ii) an epoxy resin and (iii) calcium silicate.

V. In a communication sent on 16 August 2007 accompanying the summon to oral proceedings, the Board informed *inter alia* the Appellant that the feature "at least one polymer comprising at least one epoxy functional compound" might not be derived directly and unambiguously from the application as originally filed.

VI. Oral proceedings before the Board took place on 14 November 2007. The Board was informed by a letter received on 8 November 2007 that the Appellant would not be represented at these oral proceedings. The oral proceedings were thus held in the absence of the duly summoned Appellant in accordance with Rule 71(2) EPC.

VII. The Appellant requested that the decision under appeal be set aside and the patent be granted on the basis of

the set of claims filed before the Board with the letter of 3 August 2007.

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

### **Reasons for the Decision**

1. The appeal is admissible.

2. *Procedural matters*

The Appellant was duly informed by the Board's communication of the objection under Article 123(2) EPC (see point V) and have had, in accordance with Article 113(1) EPC, an opportunity to present his arguments in respect thereof. Although the Appellant duly summoned did not appear at these oral proceedings, the Board is, therefore, empowered to decide on this matter (see G 4/92, OJ EPO 1994, 149, Order 1).

3. *Amendments*

3.1 Claim 1 contains the feature "at least one polymer comprising at least one epoxy functional compound".

3.2 It is established jurisprudence of the Boards of Appeal that amendments under Article 123(2) EPC are only allowable if they can be derived directly and unambiguously from the application as originally filed by a person skilled in the art using common general knowledge.

3.3 The application as originally filed refers with respect to the component ii) of Claim 1 *inter alia* to polymers having the following definitions:

- "epoxy polymers" (see page 4, line 31)
- "polymer such as epoxy" (see page 6, line 29)
- "epoxy resins EPOTUF 690 and 692" supplied by Reichhold Chemical (see Example 9, page 16, lines 22 to 24)
- "epoxy resin EPO 8YF 692" supplied by Reichhold Chemical (see Example 13, page 19, line 13)
- "epoxy resin" (see Claim 19).

3.4 The Board observes that neither common general knowledge nor any evidence can establish an unequivocal correspondence between the definitions set out in the application as filed and the objected feature. Therefore, of these definitions none fits unambiguously the feature defined in Claim 1, i.e. "at least one polymer comprising at least one epoxy functional compound". The objected feature thus represents an unsupported redefinition of the epoxy resins or epoxy polymers such as mentioned in the application as originally filed.

3.5 In view of the above, the Board sees no reason to depart from the preliminary opinion expressed with its communication (see point V above).

3.6 Since Claim 1 contravenes the requirement of Article 123(2) EPC and since the Board can only decide on a request as a whole, the sole request of the Appellant is to be rejected.

**Order**

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

The appeal is dismissed.

The Registrar

The Chairman

N. Maslin

A. Nuss