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**D E C I S I O N**  
**of 3 November 2005**

**Case Number:** T 0739/05 - 3.3.06

**Application Number:** 00200406.7

**Publication Number:** 1050573

**IPC:** C10L 1/18

**Language of the proceedings:** EN

**Title of invention:**  
Fuel oil compositions

**Applicant:**  
Infineum USA L.P.

**Opponent:**  
-

**Headword:**  
Fuel oil/INFINEUM

**Relevant legal provisions:**  
EPC Art. 76(1), 123(2), 111(1)

**Keyword:**  
"Main request: Extension beyond parent application (no)"  
"Extension beyond application as filed (no)"  
"Suspension of the further prosecution of a case without a corresponding request by a party until a decision of the Enlarged Board of Appeal pertaining to a parallel point of law raised in another T-case is issued (no)"

**Decisions cited:**  
G 0005/93, G 0009/93, T 0905/90, T 0039/03, J 0027/94,  
J 0025/95

**Catchword:**

In a case where the principle of the protection of legitimate expectations in pending cases is applicable with regard to an established practice of the European Patent Office as published in the Guidelines for Examination in the European Patent Office and where there is no corresponding request by a party, there is no reason to suspend the further prosecution until a decision in a case pending before the Enlarged Board of Appeal is issued, even though the important point of law raised by the underlying T-case (referral) may concern the case under consideration.

This ensues from the above principle according to which in pending cases where existing long-standing practice laid down in publications of the European Patent Office might be overruled by a new decision of the Enlarged Board of Appeal the parties may rely on the previous practice until the new decision is made available to the public - and this is in line with consistent case law of the Boards of Appeal (point 6 of the reasons).



Case Number: T 0739/05 - 3.3.06

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.06  
of 3 November 2005

**Appellant:** Infineum USA L.P.  
1900 East Linden Avenue  
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**Representative:** UEXKÜLL & STOLBERG  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 25 January 2005  
refusing European application No. 00200406.7  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** G. Raths  
**Members:** G. Dischinger-Höppler  
U. Tronser

## Summary of Facts and Submissions

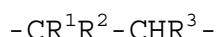
I. This appeal is from the decision of the Examining Division refusing European patent application No. 00 200 406.7 (European publication No. 1 050 573) which is a divisional application of European patent application No. 95 942 211.4 filed as an international application having the publication No. WO-A-96/18708 on the ground that the subject-matter of all the claims of the then pending single request extended beyond the content of the parent application contrary to the requirements of Article 76(1) EPC.

II. The decision under appeal was based on a description identical with that of the parent application and a set of 21 claims which differed from the claims of the divisional application as filed only in an amendment made to Claim 14. This set contained Claims 1 to 6, 8, 9, 11 to 14 and 16 to 21 (hereinafter old claims, see also point VII) reading:

"1. A composition comprising a major proportion of a petroleum-based fuel oil and minor proportions of a lubricity enhancer and at least one ethylene-unsaturated ester copolymer, wherein the lubricity enhancer comprises one or more carboxylic acids containing from 2 to 50 carbon atoms, the sulphur content of the composition being at most 0.05% by weight and the composition having a lubricity such as to give a wear scar diameter, as measured by the HFRR test at 60°C, of at most 500 µm.

2. The composition of claim 1 wherein the composition comprises two or more ethylene-unsaturated ester copolymers.

3. The composition of claim 1 or claim 2 wherein the or each copolymer is one having, in addition to units derived from ethylene, units of the



wherein  $R^1$  represents hydrogen or methyl;  $R^2$  represents  $COOR^4$ , wherein  $R^4$  represents an alkyl group having from 1 to 9 carbon atoms which is straight chain or, if it contains 3 or more carbon atoms, branched, or  $R^2$  represents  $OO CR^5$ , wherein  $R^5$  represents  $R^4$  or H; and  $R^3$  represents H or  $COOR^4$ .

4. The composition of any one of the preceding claims, wherein the or each copolymer is an ethylene-vinyl ester copolymer.

5. The composition of claim 4 wherein the or each copolymer is an ethylene-vinyl acetate, ethylene-vinyl propionate, ethylene-vinyl hexanoate or ethylene-vinyl octanoate copolymer.

6. The composition of any one of the preceding claims, wherein the or each copolymer has a number-average molecular weight of 1,000 to 5,000 as measured by vapour phase osmometry.

8. The composition of any one of the preceding claims wherein the lubricity enhancer comprises one or more polycarboxylic acids.

9. The composition of any one of claims 1 to 7 wherein the lubricity enhancer comprises one or more mono-carboxylic acids.

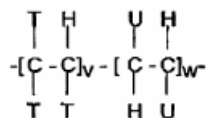
11. The composition of any one of the preceding claims wherein the lubricity enhancer additionally comprises an ester of an acid moiety which contains 2 to 50 carbon atoms and an alcohol moiety which contains one or more carbon atoms.

12. The composition of any one of the preceding claims wherein the composition contains two or more lubricity enhancers.

13. The composition of any one of the preceding claims additionally comprising one or more co-additives.

14. The composition of claim 13 wherein the or each, co-additive is selected from the following:

- a comb polymer
- a polar nitrogen compound;
- a hydrocarbon polymer of the general formula



wherein T = H or R<sup>21</sup> wherein R<sup>21</sup> = C<sub>1</sub> to C<sub>40</sub> hydrocarbyl, and U = H, T, or aryl, and v and w represent mole fractions, v being within the range of from 1.0 to 0.0, w being in the range of from 0.0 to 1.0;

a polyoxyalkylene compound; and

a compound containing a cyclic ring system, the ring system carrying at least two substituents of the formula



wherein A is a linear or branched chain aliphatic hydrocarbylene group, and R<sup>15</sup> and R<sup>16</sup> are each independently a hydrocarbyl group containing 9 to 40 atoms.

16. The composition of any one of the preceding claims also comprising a vegetable-based fuel oil.

17. The composition of claim 16 wherein the vegetable-based fuel oil is rapeseed methyl ester.

18. The composition of any one of the preceding claims wherein the petroleum-based fuel oil is diesel fuel.

19. A process for the manufacture of the composition of any one of claims 1 to 18, which comprises refining a crude oil to produce a petroleum-based fuel oil of low sulphur content, and blending with this refined product a lubricity enhancer and at least one ethylene-unsaturated ester copolymer, wherein the lubricity enhancer comprises one or more carboxylic acids containing from 2 to 50 carbon atoms, and optionally a vegetable-based fuel oil, to provide a composition with a sulphur content of at most 0.05% by weight and having a lubricity such as to give a wear scar diameter, as measured by the HFRR test at 60°C, of at most 500 µm.

20. The use of at least one ethylene-unsaturated ester copolymer to enhance the lubricity of a petroleum-based

fuel oil composition having a sulphur content of at most 0.0-5% by weight and also comprising a lubricity enhancer, wherein the lubricity enhancer comprises one or more carboxylic acids containing from 2 to 50 carbon atoms, and wherein the composition resulting from the use has a lubricity such as to give a wear scar diameter, as measured by the HFRR test at 60°C, of at most 500 µm.

21. The use of a combination of at least one ethylene unsaturated ester copolymer and a lubricity enhancer to enhance the lubricity of a petroleum-based fuel oil composition having a sulphur content of at most 0.05% by weight, wherein the lubricity enhancer comprises one or more carboxylic acids containing from 2 to 50 carbon atoms and wherein the composition resulting from the use has a lubricity such as to give a wear scar diameter, as measured by the HFRR test at 60°C, of at most 500 µm."

III. In its decision, the Examining Division held that the subject-matter claimed in the divisional application did not result directly and unambiguously from the content of the parent application since it was obtained by combining specific embodiments selected from various lists contained in the parent application for which combination there existed no pointer in the parent application. In particular, it was held that the definition of the lubricity enhancer in all the independent claims as comprising one or more carboxylic acids containing from 2 to 50 carbon atoms was a new embodiment obtainable only by choosing the non-preferred carboxylic acids in combination with the specific range of C<sub>2</sub> to C<sub>50</sub> from a plethora of lubricity



- enhancers which were taught in the parent application. The dependent claims contained further selections or combinations with other specific embodiments not disclosed in the parent application.
- IV. With its statement of grounds of appeal, the Applicant (hereinafter Appellant) filed amended sets of claims in a new main request and two auxiliary requests. Further, the Appellant requested accelerated proceedings and full consideration of the case.
- V. In a communication annexed to the summons to attend oral proceedings dated 11 August 2005, the Board drew attention to several objections under Article 76(1) EPC, and gave reasons why it did not intend to consider the merits of the case which were not yet assessed by the Examining Division.
- VI. With its letter dated 20 October 2005, the Appellant again filed amended sets of claims in a new main request and five auxiliary requests.
- VII. At the oral proceedings before the Board held on 3 November 2005, the Appellant submitted further amended sets of claims to replace its main and first two auxiliary requests.

The following amendments have been made to the claims (hereinafter new claims) of the main request (Set A-1) as compared with the claims considered unallowable by the Examining Division (hereinafter old claims, see also point II):

- old Claims 7, 10 and 15 have been deleted;

- old Claims 8, 9, 11 to 14 and 16 to 21 have been renumbered as new Claims 7 to 18;
- the dependency of the new claims has been changed so that
  - a) new Claims 4, 7 to 11, 13 and 15 depend only on new Claim 1,
  - b) new Claim 6 depends on any one of new Claims 3 to 5,
  - c) new Claim 12, 14 and 16 depend on new Claim 11, 13 and 1 to 15, respectively;
- in old Claim 7 the term "saturated" has been inserted between the terms "more" and "mono-carboxylic" to give new Claim 8;
- in old Claim 12 the term "two or more" has been replaced by "more than one" to give new Claim 10;
- in old Claim 13 the term "one or more" has been replaced by "two or more" to give new Claim 11;
- in old Claim 14 the term "a polar nitrogen compound" has been replaced by "an oil soluble polar nitrogen compound carrying one or more substituents of the formula  $>NR^{13}$ , where  $R^{13}$  represents a hydrocarbyl group containing 8 to 40 carbon atoms, which substituent(s) may be in the form of a cation derived therefrom" to give new Claim 12;

- at the end of old Claim 18 the term "or kerosene" has been added to give new Claim 15;
- in old Claim 20 the term "0.0-5%" has been replaced by "0.05%" to give new Claim 17.

VIII. The Appellant in writing and at the oral proceedings provided arguments and reasons why it held that the claims of Set A-1 satisfied the requirements of Article 76(1) EPC.

IX. The Appellant requested that the decision under appeal be set aside and a patent be granted on the basis of Claims 1 to 18 according to Set A-1 submitted during the oral proceedings or, alternatively, on the basis of the set of claims according to auxiliary requests B-1, C-1 submitted during the oral proceedings or auxiliary requests D, E or F filed with the letter of 20 October 2005.

## **Reasons for the Decision**

### 1. *Point of law*

The issue to be dealt with in this appeal is whether or not the claimed subject-matter complies with the requirements of the second sentence of Article 76(1) EPC which stipulates that a divisional application "may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed". In accordance with the established jurisprudence of the Boards of Appeal, the

relevant question to be decided is, therefore, whether or not a skilled person would directly and unambiguously derive from the parent application the technical information contained in the divisional application.

2. *Main Request*

2.1 The parent application contains a set of 11 claims directed in Claim 1 to a composition comprising a fuel oil, a lubricity enhancer and at least one ethylene-unsaturated ester copolymer and preferred embodiments of that composition according to Claims 2 to 8, inter alia, those having in accordance with Claim 2 a lubricity such as to give a wear scar diameter, as measured by the HFRR test at 60°C of at most 500 µm, in Claims 9 and 10 to a process for preparing the composition of Claims 2 to 7 and in Claim 11 the use of the at least one ethylene-unsaturated ester copolymer to enhance the lubricity of a fuel oil composition (page 2, line 22 to page 3, line 22). The independent Claims 9 and 11 of the parent application read:

"9. A process for the manufacture of the composition of any one of claims 2 to 7, which comprises refining a crude oil to produce a petroleum-based fuel oil of low sulphur content, and blending with this refined product a lubricity enhancer and at least one ethylene-unsaturated ester copolymer and optionally a vegetable-based fuel oil, to provide a composition with a sulphur content of at most 0.2% by weight and having a lubricity such as to give a wear scar diameter, as measured by the HFRR test at 60°C, of at most 500 µm.

11. The use of at least one ethylene-unsaturated ester copolymer to enhance the lubricity of a fuel oil composition having a sulphur content of at most 0.2% by weight and also comprising a lubricity enhancer."

- 2.2 It is apparent from a comparison that the independent process Claim 16 of Set A-1 which corresponds to Claim 19 of the set considered by the Examining Division (points II and VII above) differs from process Claim 9 of the parent application in that the lubricity enhancer comprises one or more carboxylic acids containing from 2 to 50 carbon atoms and in that the sulphur content of the composition produced is at most 0.05% by weight instead of 0.2% by weight.

The latter difference is derivable from Claim 3 of the parent application relating to a preferred embodiment of the composition of Claim 1 where the sulphur content is at most 0.05% by weight.

Thus, it remains to be assessed whether the specific lubricity enhancer has been originally disclosed as a particular embodiment of the invention.

The Examining Division was of the opinion that carboxylic acids were only casually mentioned on page 9, lines 6 to 10 of the parent application as non-preferred alternative but not in combination with the specific range containing from 2 to 50 carbon atoms. It was rather disclosed in this paragraph on page 9 that the acids were "of the types described above in relation to the ester lubricity enhancers" of which a variety was actually disclosed, so that a new embodiment was created by first selecting the

carboxylic acid lubricants and secondly selecting those having 2 to 50 carbon atoms.

The Board agrees insofar as the parent application mentions a variety of conventional types of lubricants including esters in which the acid moiety contains between 2 to 50 carbon atoms, and alcohols and acids having from 6 to 30 carbon atoms (page 1, line 33 to page 2, line 11) from which the ester lubricants are preferred, especially those of a polyhydric alcohol and a carboxylic acid and "in particular an ester of an acid moiety which contains from 2 to 50 carbon atoms", such as esters from dicarboxylic acid having between 9, especially 12, and 42 carbon atoms (page 6, lines 24 to 34 and Claims 6 to 8).

No broader class of carboxylic acids has been disclosed in the parent application than that containing between 2 and 50 carbon atoms which covers subclasses containing 6 to 30, 9 to 42 and 12 to 42 carbon atoms.

The Board, therefore, considers that no selection was made as far as the chain length of the carboxylic acids is concerned since the parent application discloses no other carboxylic acids to which the reference on page 9 (lines 6 to 8) might relate than those having between 2 and 50 carbon atoms.

Consequently, the only choice made with respect to the disclosure of the parent application is that the carboxylic acids mentioned on page 9 (lines 6 to 10) are selected from a group comprising several lubricity enhancers.

Considering that the disclosure of a patent document is not restricted to the preferred embodiments and since the information on page 9 concerning the carboxylic acid lubricants is not limited with respect to the other features of the process disclosed in the parent application, in particular the kind of fuel oil, the level of sulphur content or the wear scar diameter, the Board concludes that the subject-matter of independent process claim 16 derives its basis directly and unambiguously from the parent application.

- 2.3 The same applies to the other independent claims for the following reasons:

Independent Claim 1 correctly defines the product of the process of Claim 16 and corresponds, therefore, to an allowable limitation of the composition of Claims 1 or 2 of the parent application.

Independent Claim 17 derives its basis from the same selection of carboxylic acid lubricity enhancers as Claim 16 in combination with Claim 11 of the parent application relating to the use of at least one ethylene-unsaturated ester copolymer to enhance the lubricity of fuel oil composition comprising a lubricity enhancer, from the pointer in Claim 9 of the parent application to a preference for petroleum-based fuel oil and from the pointer in Claim 3 of the parent application to a maximum sulphur content of 0.05% by weight.

Independent Claim 18 relating to the use of a combination of at least one ethylene unsaturated ester copolymer and a lubricity enhancer to enhance the

lubricity of a petroleum-based fuel oil composition is based on the same disclosure of the parent application as Claim 17 in combination with page 9, lines 16 to 18 according to which the ethylene-unsaturated ester copolymer(s) and the lubricity enhancer may be incorporated in the fuel oil either separately or preferably in combination.

- 2.4 The Examining Division also found that the dependent claims were inadmissible under Article 76(1) EPC not only for the same reasons as the independent claims but also since they contained further selections or combinations not disclosed in the parent application.

The Board does not agree since the subject-matter of the dependent claims either corresponds to that of dependent claims in the parent application or is derived from the description of particularly preferred embodiments which are, however, not disclosed only in combination with specific lubricity additives.

Therefore, each of the dependent claims finds a specific pointer in the parent application, namely

- Claims 2 and 3: in Claims 4 and 5 to which they correspond;
- Claims 4 to 6: in the passage on page 5, line 34 to page 6, line 7, disclosing that the copolymer is advantageously ethylene-vinyl ester copolymer, preferably an ethylene-vinyl acetate, propionate, hexanoate or octanoate copolymer and has preferably a number average molecular weight of



1,000 to 5,000 as measured by vapour phase osmometry;

- Claim 7: on page 6, line 30 where polycarboxylic acid is pointed out as being advantageous;
- Claim 8: in the passage on page 9, lines 8 to 9, disclosing that the acids in the case of mono-carboxylic acids are saturated;
- Claims 9 and 10: in the passage on page 9, lines 6 to 8, in combination with that on page 6, lines 24 to 28, disclosing that more than one lubricity enhancer may be present and that the esters of a carboxylic acid having 2 to 50 carbon atoms may be used in combination with those acids;
- Claim 11: in the passage on page 9, line 20 in combination with page 16, line 26, indicating the addition of two or more co-additives;
- Claim 12: on page 9, line 26 to page 15, line 22, where all the different classes of co-additives referred to in the claim are mentioned;
- Claim 13: in process Claim 9 in combination with the passage on page 2, line 32, indicating that the fuel oil may be a mixture of petroleum- and vegetable-based fuel oil;
- Claim 14: on page 5, line 7, where rapeseed methyl ester is determined to be the most preferred vegetable-based fuel oil; and

- Claim 15: on page 1, line 4, indicating that the invention relates to additives for improving the characteristics especially of diesel fuel and kerosene.

2.5 For the reasons set out above and considering that the description of the divisional and parent application is the same, the Board comes to the conclusion that the present divisional application does not extend beyond the content of the parent application.

3. *Requirements of Article 123(2) EPC*

Insofar as amendments in the divisional application subsequent to its filing are concerned, the amended application has to comply with the requirements of Article 123(2) EPC. However, as the amendments made to the new claims are directly and unambiguously derivable from the description and the claims of the divisional application as originally filed (see above points II and VII in combination with point 2 insofar as the description is concerned which is identical with that of the parent application), no objections arise under the provisions of Article 123(2) EPC.

4. Since the claims as amended in Set A-1 (main request) do not violate either Article 76(1) EPC or Article 123(2) EPC, there is no reason to consider the auxiliary requests in this respect.

5. *Remittal to the first instance*

The application in suit was refused solely on the ground of Article 76(1) EPC for extension beyond the content of the parent application. Whether the application meets the other requirements of the EPC has not yet been established. Since it is the function of appeal proceedings to give a judicial decision upon the correctness of a separate earlier decision taken by a first-instance department (see Case Law of the Boards of Appeal of the European Patent Office, 4th ed. 2001, VII.D.2), the Board finds it appropriate to make use of its power under Article 111(1) EPC and remits the case to the first instance for further prosecution.

The Board takes the opportunity to draw the first instance's attention to the fact that minor clerical errors, such as the omission of the word "formula" in Claim 3, the term "hexonoate" in Claim 5 or the punctuation in Claim 12, already present in the claims as originally filed have been maintained in the version of Set A-1.

6. *Procedural issues*

The Board sees no reason to suspend the further prosecution and the final decision of this case until a decision of the Enlarged Board of Appeal in case G 1/05 is issued even though the important point of law raised by the underlying referral T 39/03 (i.e. whether a divisional application as filed not meeting the requirements of Article 76(1) EPC can still be amended in the course of the examination procedure in order to

meet these requirements) may be of importance for the case under consideration.

But apart from the fact that the Appellant has applied for accelerated prosecution of the appeal proceedings, the Board is of the opinion that the decision of the Enlarged Board of Appeal cannot affect the outcome of this appeal in a manner contrary to the decision now made by this Board of Appeal.

Because even if the Enlarged Board of Appeal should decide that a divisional application at its filing date offending against the provisions of Article 76(1) EPC relative to its subject-matter cannot be amended during the further examination procedure, the principle of the protection of legitimate expectations on pending cases is applicable. According to this principle, in cases where existing long-standing practice laid down in publications of the European Patent Office is being overruled by a new decision (i.e. of the Enlarged Board of Appeal), consistent case law (see G 5/93 OJ EPO 1994, 447; G 9/93 OJ EPO 1994, 891; T 905/90 OJ EPO 1994, 306; J 27/94 OJ EPO 1995, 831; J 25/95 not published) allows the applicants of pending cases a transitional period during which they may rely on the previous practice until the modifying decision is made available to the public.

In its decision T 39/03 underlying the referral, the Board of Appeal itself emphasises (see reasons for the decision point 3.1) that it "is well aware of the fact that in cases where, .... , a divisional application as filed offends against the provision of Article 76(1) EPC relative to its subject-matter, it is the

established practice of the European Patent Office to allow an applicant at any later stage of the examining procedure to amend the divisional application so that it meets the requirements of Article 76(1) EPC" and that the Guidelines for Examination in the European Patent Office imply that a divisional application not meeting the requirements of Article 76(1) EPC in its version as filed may be corrected in this respect at any later stage of the examination procedure.

Thus taking into consideration that the application in suit was filed on 7 February 2000 (as a European divisional application to the earlier European application No. 95 942 211.4), that on 11 August 2005 the Applicant/Appellant was summoned to oral proceedings before this Board of Appeal and that the decision T 39/03 was issued on 26 August 2005, the Board is of the opinion that the principle of legitimate expectations allows the Appellant in the case under consideration to rely on the established practice of the European Patent Office as published in the Guidelines for Examination in the European Patent Office.

In consequence, suspending the present appeal proceedings until the decision of the Enlarged Board of Appeal in case G 1/05 is issued is held to be inappropriate.

**Order**

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

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of claims 1 to 18 according to Set A-1 submitted during the oral proceedings.

The Registrar:

The Chairman:

G. Rauh

G. Raths