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**Datasheet for the decision
of 4 February 2009**

Case Number: T 0674/06 - 3.3.01

Application Number: 95302545.9

Publication Number: 0678569

IPC: C10M 141/12

Language of the proceedings: EN

Title of invention:

Lubricating compositions with improved oxidation resistance
containing a dispersant and an antioxidant

Patentee:

The Lubrizol Corporation

Opponents:

Exxon Mobil Research & Engineering Company
Infineum International Ltd.

Headword:

Lubricating compositions/THE LUBRIZOL CORPORATION

Relevant legal provisions:

EPC Art. 123(2)

Relevant legal provisions (EPC 1973):

-

Keyword:

"All requests - added matter (yes) - unallowable combination
of two features from the description"

Decisions cited:

T 0680/93, T 0288/92

Catchword:

-



Case Number: T 0674/06 - 3.3.01

DECISION
of the Technical Board of Appeal 3.3.01
of 4 February 2009

Appellant: The Lubrizol Corporation
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 9 March 2006
revoking European patent No. 0678569 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: P. Ranguis
Members: J.-B. Ousset
D. S. Rogers

Summary of Facts and Submissions

- I. The appellant (patent proprietor) lodged an appeal against the decision of the opposition division revoking the European patent No. 0 678 569 on the basis of the main request and auxiliary requests 2 to 8 filed with the patent proprietor's letter of 22 December 2005, on auxiliary requests 9 (corresponding to a corrected version of auxiliary request 1) to 14 filed with letter of 14 February 2006 and auxiliary requests 9a and 9b filed during oral proceedings.
- II. In its decision, the opposition cited inter alia the following document:
- (1) EP-A-0620 267
- III. In its decision, the opposition division considered that claim 1 of the main request was not in agreement with the requirements of Article 123(2) EPC, because in the sentence "(A) one or more ashless antioxidants selected from amine antioxidants, dithiophosphoric esters, phenol antioxidants, dithiocarbamates and aromatic phosphites" of claim 1 of the main request, only dithiocarbamates can be ashless (see page 16, line 15 of the patent) and there was no basis in the description disclosing that the other antioxidants listed could be ashless. The same reasoning applied to auxiliary requests 2-8 and 10-14, since they all contain in claim 1 at least one antioxidant not referred to in the description as being ashless. The opposition division further decided that auxiliary request 9 was infringing the requirements of Article 123(2) EPC, since the presence of the

expression "substituted aromatic groups" to define the amines of formula $Ar^1-NR_1-Ar^2$ could embrace compounds having a metal-substitution; these amines not being qualified as ashless in the description. The opposition division found that the disclaimer present in this request rendered it unclear (Article 84 EPC). Auxiliary request 9a was not regarded as patentable by the opposition division, because the requirement of novelty was not fulfilled in view of the content of example 1 of document (1). Auxiliary request 9b did not fulfil the requirements of Article 84 EPC due to an inconsistency between the scope of claim 1 of this request and the corresponding dependent claim 2.

IV. In order to clarify its requests, the appellant filed at the beginning of oral proceedings, the following requests:

- Main request A;
- Auxiliary requests 1A to 9A;
- Main request B;
- Auxiliary requests 1B to 5B.

By way of explanation, the "A" requests are for the contracting states DE, FR, GB, IT and SE, and the "B" requests are for the contracting states BE and ES.

Claim 1 of the main request A reads as follows:

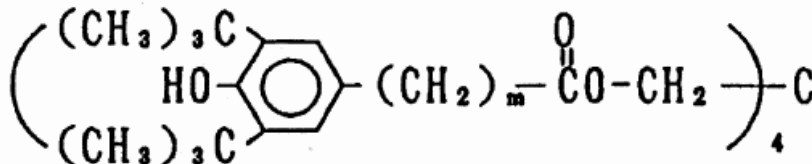
"1. A lubricating oil composition comprising a major amount of an oil of lubricating viscosity with an iodine number less than 4,
(A) one or more ashless antioxidants selected from hindered phenols, alkyl phenol sulfides, sulfur-coupled

phenols, dithiocarbamates and alkylated aromatic amines wherein the alkylated aromatic amines are represented by the formula $R_2\text{-Ar-NH-Ar-R}_3$ wherein Ar represents an aromatic group which may be mononuclear or polynuclear, R_2 and R_3 are independently hydrogen or hydrocarbyl groups having from 1 to 50 carbon atoms,

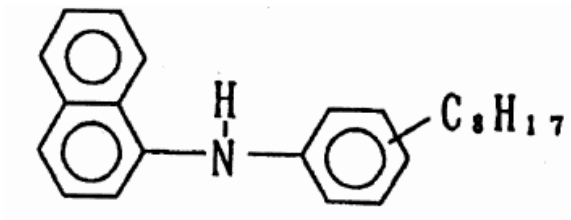
(B) from 0.01% to 3% by weight of at least one boron-containing dispersant or detergent, and optionally,

(C) at least one additive selected from (i) a sulfur containing antiwear or extreme pressure agent, (ii) a phosphorus or boron antiwear or extreme pressure agent, and (iii) mixtures thereof, provided that (C) is different from (A), and wherein the total amount of antioxidant is from 2 to 10% by weight and (A) is present in an amount of at least 2% by weight and with the proviso that the composition is not the following composition:

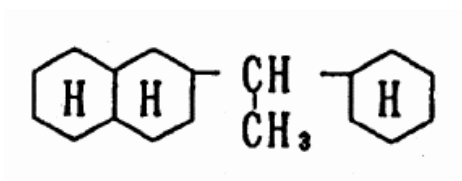
2.5 wt% borated succinic acid imide replaced with a polyisobutenyl group having a molecular weight of 2000, 3.0 wt% polymethacrylate (Mw: 36000), 0.5 wt% tricresyl phosphate, 0.05 wt% alkenyl succinic acid half ester, 0.001 wt% dimethylsiloxane and 1.0 wt% of a compound (Mw=1178) represented by the formula



and 1.0 wt% of a compound represented by



with the balance made up with a synthetic oil represented by the formula



Auxiliary request 1A, 3A to 6A and 8A, 9A contain all the expression "wherein the total amount of antioxidant is from 2 to 10% by weight and (A) is present in an amount of at least 2% by weight" and all recite that the component (A) is made out of one or more **ashless** specific antioxidants.

In auxiliary requests 2A and 7A, the total amount of antioxidants ranges from 2.5 to 10% by weight instead of 2 to 10% by weight.

Claims 1 of main request B and auxiliary requests 1B to 5B for the contracting states BE and ES all contain the expression " wherein the total amount of antioxidant is from 2 to 10% by weight and (A) is present in an amount of at least 2% by weight" and all recite that the component (A) is made out of one or more **ashless** specific antioxidants.

The appellant argued that a basis for the amendments was present in the description. He pointed out that concerning the values given for the group (A), namely

ashless antioxidants, the basis could be found on page 13, line 26; on page 15, lines 28 to 29; on page 16, lines 24 to 25; on page 8, lines 11 to 14 and on page 7, lines 20 to 22 of the application as originally filed. In view of the amount of antioxidant (A) (at least 2% by weight), the basis was mentioned on page 44, lines 25 to 26 of the application as originally filed. The appellant also pointed out that if in one embodiment (see page 44, lines 26 to 27), it is mentioned that the "total amount of antioxidant (A) is equal to the sum of all the antioxidants in the lubricant", this statement applying to (A) as defined in the description, that is to ashless or non-ashless (A), this expression, however, is not to be applied to all embodiments. This is because it is qualified in the description as being but one embodiment. Therefore, this makes clear that other antioxidants than (A) can be present. Antioxidants not being antioxidants defined as sulphur-containing antiwear or extreme pressure agent or phosphorus or boron antiwear or extreme pressure agent (C) may also be present in the composition. The appellant emphasized that a clear basis for the total amount of antioxidants comprising between 2 to 10% by weight can be found in the description (see page 7, lines 9 to 10). Concerning the lower value "2.5%" of the range, the appellant argued that it was supported by the description as originally filed (see page 7, line 10). The appellant also contended that the antioxidants listed in the group (A) are all ashless (see page 7, lines 11 to 13; page 13, lines 25-26; page 15, lines 28-29 and page 16, line 20). The appellant did not depart from this line of argument for the other requests submitted at the beginning of the oral proceedings.

V. The respondents (opponents) argued that in the description as originally filed, the double requirement concerning the antioxidants, that is to say, "wherein the total amount of antioxidant is from 2 to 10% by weight and (A) is present in an amount of at least 2% by weight" was not mentioned. They also further emphasized that six independent features were added in claim 1 of the main request when compared with claim 1 as originally filed, namely:

- the iodine number was changed from 9 into 4
- the antioxidants (A) must now be ashless
- a specific class of antioxidants was selected for the antioxidants (A)
- the total amount of antioxidants has now a maximum of 10% by weight
- the minimum amount for the antioxidants (A) is now 2% by weight
- components (B) must now be a boron-containing compound

and although these features are mentioned in different parts of the description as originally filed, their combination was neither disclosed in the description nor in the subclaims. This line of argument was maintained by the respondents not only for the main request but also for all the requests submitted by the appellant at the beginning of oral proceedings. Moreover, the respondents withdrew their objections concerning the admissibility of the appeal and the alleged abuse of procedure based on the number of requests submitted by the appellant.

- VI. After an extensive discussion during which each party was given the possibility to express its view concerning the admissibility of the requests in relation with the requirements of Article 123(2) EPC, the board, before adjourning the oral proceedings for deliberation on this point, informed the parties that if the board came to a positive view on Article 123(2), oral proceedings would be continued. Otherwise, if the board came to a negative view on Article 123(2) EPC, the debate would be closed and the board would deliver a decision dismissing the appeal.
- VII. The appellant requested that the decision under appeal be set aside and that the patent be maintained upon the basis of either main requests A and B or alternatively on one of the auxiliary requests 1A to 9A and auxiliary requests 1B to 5B; all the above being submitted at the oral proceedings.
- VIII. The respondents requested that the appeal be dismissed.
- IX. At the end of oral proceedings, the decision of the board was announced.

Reasons for the Decision

1. The appeal is admissible.

Main requests A and B

2. *Amendments*

- 2.1 Claim 1 of each request (A and B) contains the following features: (A) is one or more ashless dispersant and the total amount of antioxidant is from 2 to 10% by weight and (A) is present in an amount of at least 2% by weight. The expression "(A) is present in an amount of at least 2% by weight" is mentioned in the description of the application as originally filed (see page 44, lines 25 to 26 and page 7, lines 8 to 9 and claim 1 as originally filed). However, in these three passages, no specific limitation on the nature of the antioxidants (A) is mentioned (e.g. ashless or non-ashless), since in claim 1 as on page 44, lines 25 to 26 or on page 7, lines 7 to 9, the limitation of 2% by weight was associated with the expressions antioxidant (A) or (A) antioxidant. On the other hand, the word ashless (i.e. metal free) is mentioned in the description as originally filed in combination with specific types of antioxidants (A) (see page 13, line 26; page 15, lines 28 to 29 and page 16, lines 24 to 25).
- 2.2 Article 123(2) EPC prohibits amendments generating "subject-matter which extends beyond the content of the application as originally filed". In order to determine whether or not the subject-matter of an amended claim satisfies this requirement it has to be examined whether that amended claim comprises technical information which a skilled person would not have objectively, or as it is also expressed in the case law, "directly and unambiguously", derived from the application as filed (see decisions T 288/92, point 3.1 of the reasons and T 680/93, point 2 of the reasons, both not published in the OJ EPO).

2.3 Assuming that ashless antioxidants of the group (A) as well as the amount of antioxidants (A) being not lower than 2% by weight have been disclosed in the application as originally filed, the question remains whether this feature can be found to be directly and unambiguously disclosed in combination with the other condition that the total amount of antioxidant is from 2 to 10% by weight. The passages cited by the appellant, namely that "generally, the antioxidant (A) is present in an amount of at least about 2% by weight" (see page 44, lines 25-26 or page 7, lines 8-9) do not provide an unambiguous basis for such a combination of different amounts of antioxidants. If it might be assumed from the content of the description as originally filed that if (A) is selected from an ashless antioxidant, then its amount is higher than 2% by weight, the combination of this feature with the other condition that the total amount of antioxidant is from 2 to 10% by weight does not emerge directly and unambiguously from the content of the application as originally filed.

2.4 In consequence thereof, the board regards this specific combination of features as defining a subject-matter, which cannot be deduced directly and unambiguously by the person skilled in the art from the original disclosure. This amendment contravenes therefore the requirements of Article 123(2) EPC.

Auxiliary requests 1A to 9A and 1B to 5B

2.5 Since all the auxiliary requests 1A to 9A and 1B to 5B submitted by the appellant before the board contain

this specific combination of features, they, therefore, all contravene the requirements of Article 123(2) EPC.

2.6 In the absence of any further requests, the appeal must thus be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

M. Schalow

P. Ranguis