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**Datasheet for the decision  
of 5 February 2010**

**Case Number:** T 1408/07 - 3.3.01

**Application Number:** 99939198.0

**Publication Number:** 1086195

**IPC:** C10M 169/04

**Language of the proceedings:** EN

**Title of invention:**

Marine cylinder oils containing high viscosity detergents

**Patentee:**

Chemtura Corporation

**Opponent:**

Infineum International Ltd., IP Law Dept.

**Headword:**

Marine cylinder oils/CHEMTURA CORPORATION

**Relevant legal provisions:**

RPBA Art. 13(3)(1)  
EPC Art. 123(3)(2), 100(a)(c), 84

**Relevant legal provisions (EPC 1973):**

EPC Art. 55(c)

**Keyword:**

"Admissibility of the opposition - (yes)"  
"Main request - Auxiliary requests 1-3 and 5-7 - added  
subject-matter - (yes)"  
"Auxiliary requests 4, 8 and 9 - clarity - (no)"

**Decisions cited:**

T 0260/85, T 0222/85, T 0728/98

**Catchword:**

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Case Number: T 1408/07 - 3.3.01

**DECISION**  
of the Technical Board of Appeal 3.3.01  
of 5 February 2010

**Appellant I:** Infineum International Ltd., IP Law Dept.  
(Opponent) Milton Hill Business Park, PO Box 1, Milton Hill  
Abingdon Oxon, OX13 6BB (GB)

**Representative:** Lewis, Pauline Therese  
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P.O. Box 1  
Milton Hill, Oxfordshire OX13 6BB (GB)

**Appellant II:** Chemtura Corporation  
(Patent Proprietor) Benson Road  
Middlebury, CT 06749 (US)

**Representative:** Schön, Christoph  
Kroher - Strobel  
Rechts- und Patentanwälte  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
14 August 2007 concerning maintenance of  
European patent No. 1086195 in amended form.

**Composition of the Board:**

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

## Summary of Facts and Submissions

- I. Both the opponent and the patentee appealed the decision of the opposition division to maintain the European patent 1 086 195 on the basis of the fifth auxiliary request filed during oral proceedings of 12 July 2007 and the corresponding amended version of the description.
- II. The following documents are relevant for the present decision:
- (1) US-A-4 420 407
  - (2) "Chemistry and Technology of Lubricants", page 245, (1992), edited by R.M Mortier et al, VCH Publishers, Inc,
  - (3) WO-A-97 46643
  - (7) US-A-4 997 584
  - (8) Letter dated 21 March 2000, reply to the written opinion of the US-PTO as PCT authority regarding the PCT application No. PCT/US99/04151 filed 25 February, 1999,
  - (14) Notice of opposition to the European patent 1 086 195, Form 2300 and statement setting out the grounds of opposition filed on 3 March 2005.
- III. Claim 1 of the main request before the board, which is the same as the granted version, reads as follows:
- "1. A marine cylinder oil composition comprising a lubricating base oil and an overbased detergent component, the composition having a TBN of 50-90, and the detergent component comprising an overbased calcium

sulfonate having a viscosity of at least 180 mm<sup>2</sup>/s (180 cSt) at 100°C and a TBN of about 400 or more."

Claim 1 of the fifth request reads as follows:

"1. A marine cylinder oil composition comprising no more than 35% by weight of a lubricating base oil having a viscosity of at least 431 mm<sup>2</sup>/s at 40°C (2000 SUS at 100°F) and an overbased detergent component, the composition having a TBN of 50-90 and a viscosity of 15 to 25 mm<sup>2</sup>/s (15 to 25 cSt) at 100°C, and the detergent component comprising an overbased calcium sulphonate having a viscosity of at least 180 mm<sup>2</sup>/s (180 cSt) at 100°C and a TBN of about 400 or more, and the composition further comprising greater than 40% by weight of the composition of a solvent neutral oil having a viscosity of no more than about 195 mm<sup>2</sup>/s at 40°C (900 SUS at 100°F)."

- IV. The opposition sought revocation of the patent in suit under Article 100 a) EPC for lack of inventive step. The ground of opposition under Article 100 c) EPC was introduced by the opposition division in the course of the opposition proceedings on the ground that it could prejudice the maintenance of the patent.
- V. The opposition division found that the opposition was admissible since three lines of argument starting respectively from documents (1), (2) or (3) could be identified. Facts, evidence and arguments would have been understood to be directed against independent Claims 1 and 14.

The main request did not contravene the requirements of Article 100 c) EPC and 123(2) EPC but was lacking inventive step vis-à-vis document (7).

The opposition division held, in particular, relying upon document (8), that the passage of the application as filed "wherein the weight percent of the lubricating oil is inversely commensurately proportional to the viscosities of the detergent and lubricating oil for a predetermined marine oil viscosity", deleted in the patent as granted (see Claim 1 above), could not be seen as defining one or more technical features of the invention as it could not be applied to individual formulations. Its deletion did not give rise to objection under Article 100 c) EPC.

The first auxiliary request contravened the requirement of Article 123(2) EPC. The second and third auxiliary requests were regarded as not inventive in view of the disclosure of document (7). The fourth auxiliary request contravened Article 123(2) EPC and was lacking in clarity. The patent was maintained on the basis of the fifth auxiliary request.

VI. In its annex to the summons to oral proceedings which took place on 5 February 2010, the board summarized the additional points to be discussed during oral proceedings. It was, in particular, pointed out that the board was of the preliminary opinion that the opposition was admissible.

VII. The sets of claims relevant for the present decision are:

The patent as granted (see point III above), and the first to ninth auxiliary requests (see below):

First auxiliary request filed with letter dated 5 January 2010. Claim 1 reads as follows:

"1. A marine cylinder oil composition comprising a lubricating base oil having a viscosity of at least 431 mm<sup>2</sup>/s at 40°C (2000 SUS at 100°F) and an overbased detergent component, the composition having a TBN of 50-90, and the detergent component comprising an overbased calcium sulfonate having a viscosity of at least 180 mm<sup>2</sup>/s (180 cSt) at 100°C and a TBN of about 400 or more."

Second auxiliary request filed with letter dated 5 January 2010. Claim 1 reads as follows:

"1. A marine cylinder oil composition comprising a lubricating base oil having a viscosity of at least 431 mm<sup>2</sup>/s at 40°C (2000 SUS at 100°F) and an overbased detergent component, the composition having a TBN of 50-90, and the detergent component comprising an overbased calcium sulfonate having a viscosity of at least 180 mm<sup>2</sup>/s (180 cSt) at 100°C and a TBN of about 400 or more, and the composition further comprising greater than 40% by weight of the composition of a solvent neutral oil having a viscosity of no more than about 195 mm<sup>2</sup>/s at 40°C (900 SUS at 100°F)."

Third auxiliary request filed with letter dated 5 January 2010. Claim 1 reads as follows:

"1. A marine cylinder oil composition comprising a lubricating base oil having a viscosity of at least 431 mm<sup>2</sup>/s at 40°C (2000 SUS at 100°F) and an overbased detergent component, the composition having a TBN of 50-90, and the detergent component comprising an overbased calcium sulfonate having a viscosity of at least 180 mm<sup>2</sup>/s (180 cSt) at 100°C and a TBN of about 400 or more, and the composition further comprising greater than 40% by weight of the composition of a solvent neutral oil having a viscosity of no more than about 195 mm<sup>2</sup>/s at 40°C (900 SUS at 100°F), wherein the overbased calcium sulfonate is a product prepared by overbasing a sulfonic acid, at least 50% of the sulfonic acid being natural sulfonic acid."

Fourth auxiliary request filed during oral proceedings.  
Claim 1 reads as follows:

"1. A marine cylinder oil composition comprising a lubricating base oil having a viscosity of at least 431 mm<sup>2</sup>/s at 40°C (2000 SUS at 100°F) and an overbased detergent component, the composition having a TBN of 50-90, and the detergent component comprising an overbased calcium sulfonate having a viscosity of at least 180 mm<sup>2</sup>/s (180 cSt) at 100°C and a TBN of about 400 or more, and the composition further comprising greater than 40% by weight of the composition of a solvent neutral oil having a viscosity of no more than about 195 mm<sup>2</sup>/s at 40°C (900 SUS at 100°F), wherein the overbased calcium sulfonate is a product prepared by overbasing a sulfonic acid, at least 50% of the sulfonic acid being natural sulfonic acid, wherein the weight percent of the lubricating oil in the marine cylinder oil composition is inversely commensurately

proportional to the viscosities of the detergent for a predetermined marine cylinder oil viscosity.".

Fifth auxiliary request filed with letter dated 5 January 2010. Claim 1 reads as follows:

"1. A marine cylinder oil composition comprising no more than 35% by weight of a lubricating base oil having a viscosity of at least 431 mm<sup>2</sup>/s at 40°C (2000 SUS at 100°F) and an overbased detergent component, the composition having a TBN of 50-90 and a viscosity of 15 to 25 mm<sup>2</sup>/s (15 to 25 cSt) at 100°C, and the detergent component comprising an overbased calcium sulfonate having a viscosity of at least 180 mm<sup>2</sup>/s (180 cSt) at 100°C and a TBN of about 400 or more, and the composition further comprising greater than 40% by weight of the composition of a solvent neutral oil having a viscosity of no more than about 195 mm<sup>2</sup>/s at 40°C (900 SUS at 100°F).".

Sixth auxiliary request filed with letter dated 5 January 2010. Claim 1 reads as follows:

"1. A marine cylinder oil composition comprising no more than 35% by weight of a lubricating base oil having a viscosity of at least 431 mm<sup>2</sup>/s at 40°C (2000 SUS at 100°F) and an overbased detergent component, the composition having a TBN of 50-90 and a viscosity of 15 to 25 mm<sup>2</sup>/s (15 to 25 cSt) at 100°C, and the detergent component comprising an overbased calcium sulfonate having a viscosity of at least 180 mm<sup>2</sup>/s (180 cSt) at 100°C and a TBN of about 400 or more, and the composition further comprising greater than 40% by weight of the composition of a solvent neutral oil



having a viscosity of no more than about 195 mm<sup>2</sup>/s at 40°C (900 SUS at 100°F), wherein the overbased detergent component is present in an amount of 2-25% by weight of the composition."

Seventh auxiliary request filed with letter dated 5 January 2010. Claim 1 reads as follows:

"1. A marine cylinder oil composition comprising no more than 35% by weight of a lubricating base oil having a viscosity of at least 431 mm<sup>2</sup>/s at 40°C (2000 SUS at 100°F) and an overbased detergent component, the composition having a TBN of 50-90 and a viscosity of 15 to 25 mm<sup>2</sup>/s (15 to 25 cSt) at 100°C, and the detergent component comprising an overbased calcium sulfonate having a viscosity of at least 180 mm<sup>2</sup>/s (180 cSt) at 100°C and a TBN of about 400 or more, and the composition further comprising greater than 40% by weight of the composition of a solvent neutral oil having a viscosity of no more than about 195 mm<sup>2</sup>/s at 40°C (900 SUS at 100°F), wherein the detergent component is present in an amount of 10 to 25% by weight of the composition and comprises said overbased calcium sulfonate and a calcium phenate having a viscosity of at least 250 mm<sup>2</sup>/s (250cSt) at 100°C."

Eighth auxiliary request filed during oral proceedings. Claim 1 reads as follows:

"1. A marine cylinder oil composition comprising no more than 35% by weight of a lubricating base oil having a viscosity of at least 431 mm<sup>2</sup>/s at 40°C (2000 SUS at 100°F) and an overbased detergent component, the composition having a TBN of 50-90 and a viscosity of 15

to 25 mm<sup>2</sup>/s (15 to 25 cSt) at 100°C, and the detergent component comprising an overbased calcium sulfonate having a viscosity of at least 180 mm<sup>2</sup>/s (180 cSt) at 100°C and a TBN of about 400 or more, and the composition further comprising greater than 40% by weight of the composition of a solvent neutral oil having a viscosity of no more than about 195 mm<sup>2</sup>/s at 40°C (900 SUS at 100°F), wherein the weight percent of the lubricating oil in the marine cylinder oil composition is inversely commensurately proportional to the viscosities of the detergent for a predetermined marine cylinder oil viscosity, wherein the overbased detergent component is present in an amount of 2-25% by weight of the composition.".

Ninth auxiliary request filed during oral proceedings.  
Claim 1 reads as follows:

"1. A marine cylinder oil composition comprising no more than 35% by weight of a lubricating base oil having a viscosity of at least 431 mm<sup>2</sup>/s at 40°C (2000 SUS at 100°F) and an overbased detergent component, the composition having a TBN of 50-90 and a viscosity of 15 to 25 mm<sup>2</sup>/s (15 to 25 cSt) at 100°C, and the detergent component comprising an overbased calcium sulfonate having a viscosity of at least 180 mm<sup>2</sup>/s (180 cSt) at 100°C and a TBN of about 400 or more, and the composition further comprising greater than 40% by weight of the composition of a solvent neutral oil having a viscosity of no more than about 195 mm<sup>2</sup>/s at 40°C (900 SUS at 100°F), wherein the weight percent of the lubricating oil in the marine cylinder oil composition is inversely commensurately proportional to the viscosities of the detergent for a predetermined

marine cylinder oil viscosity, wherein the detergent component is present in an amount of 10 to 25% by weight of the composition and comprises said overbased calcium sulfonate and a calcium phenate having a viscosity of at least 250 mm<sup>2</sup>/s (250cSt) at 100°C."

VIII. The arguments of appellant I (opponent) as far as they are relevant for the present decision can be summarized as follows:

Claim 1 of main request and auxiliary requests 1-3, 5-7 contravenes the requirements of Article 100(c) and 123(2) EPC. The expression "*...wherein the weight percent of the lubricating oil is inversely commensurately proportional to the viscosities of the detergent and lubricating oil for a predetermined marine oil viscosity*" was presented as an essential feature of the invention in the application as originally filed but this feature was absent in claim 1 of the set of claims found patentable by the examining division. This feature was to be considered as an essential feature, since nowhere in the description was it referred to as a preferred and/or an optional feature. Decision T 260/85 (OJ EPO 1989, 105, point 12) recited that a feature presented as an essential feature cannot be deleted from the subject-matter of an independent claim.

The alleged absence of meaning for the feature "*...wherein the weight percent of the lubricating oil is inversely commensurately proportional to the viscosities of the detergent and lubricating oil for a predetermined marine oil viscosity*" was not founded. Even if the feature was regarded as devoid of meaning,

there was no legal basis to delete it. On page 10 of the statement of grounds of appeal of the patent proprietor, a meaning was given and it could thus not be considered as meaningless. The reintroduction of the said feature (see auxiliary requests 4, 8 and 9) would contravene the requirements of Article 84 EPC, because contrary to the decision of the first instance, this feature had a meaning but this meaning was not clear.

IX. The arguments of appellant II (patent proprietor) as far as they are relevant for the present decision can be summarized as follows:

The opposition should be considered as inadmissible, because the person skilled in the art would have difficulties to understand the notice of opposition. There were no sufficient arguments presented by the opponent in support of its allegation of lack of inventive step. The closest prior art was not defined and the problem-solution approach was not used by the opponent. The opponent neither explained the difference between the claimed invention and the prior art, nor why the claimed invention was obvious. The requirements as set out in decision T 222/85 (OJ EPO 1988, 128, point 8) to be met by the notice of opposition for an opposition to be deemed admissible were not fulfilled.

The feature: "*wherein the weight percent of the lubricating oil is inversely commensurately proportional to the viscosities of the detergent and lubricating oil for a predetermined marine oil viscosity*" was not a technical essential feature. This feature is to be used to compare different compositions with each other. In such a case, a relationship between

the viscosity and the amount of lubricating oil could be found for a group of compositions. This relationship was not valid for individual compositions but only relevant for a group of formulations. Since Claim 1 of the main request and of auxiliary requests 1-3, 5-7 relate to individual formulations, the feature at issue was meaningless and could be deleted without extending the content of the application as filed. More particularly, the wording of Claim 1 of the auxiliary request 5 renders the presence of this feature superfluous, since the viscosities of the lubricant oil, the marine cylinder oil and the detergent component are fixed, and the amount of the lubricating oil will automatically be fixed in view of the other fixed parameters. The feature reintroduced in auxiliary requests 4, 8 and 9 was to be regarded as a functional feature to clarify how the weight percent of the lubricating oil has to be selected and represented the inherent result of the other technical features.

X. Appellant I (opponent) requested that the decision under appeal be set aside and that the European patent No. 1 086 195 be revoked.

XI. Appellant II (patent proprietor) requested that the decision under appeal be set aside and that

- 1) the opposition be rejected as inadmissible; or
- 2) that the patent be maintained as granted; or
- 3) that the patent be maintained on the basis of one of the auxiliary requests 1-3, 5, 6 or 7 all filed with a letter dated of 5 January 2010; or

- 4) that the patent be maintained on the basis of one of the auxiliary requests 4, 8 or 9 filed during the oral proceedings.

XII. At the end of the oral proceedings, the decision of the board was announced.

## **Reasons for the Decision**

### 1. Admissibility

1.1 Rule 55(c) EPC 1973 stipulates that a notice of opposition shall contain a statement of the extent to which the patent is opposed and of the grounds on which the opposition is based, as well as an indication of the facts, evidence and arguments presented in support of these grounds.

1.2 According to the established case law (see case law of the board of appeal of the European patent office, 5<sup>th</sup> edition 2006, chapter VII. C. 4.5.1), it is not required for an opposition to be admissible that the arguments brought in support are conclusive or that the opponent's statements are true. What is required is that the patentee and the opposition division are put in a position of understanding the nature of the objections and the evidence and arguments in support.

1.3 It is apparent from the EPO form 2300 (document (14)) that the opponent sought revocation of the patent in suit in its entirety and that the opposition is based on the grounds of Article 100(a) EPC, namely lack of inventive step. In support of this ground documents (1)

to (6) are indicated and the statement of grounds of opposition contains arguments why the claimed subject-matter was held to lack inventive step.

- 1.4 As noted by the opposition division (see page 14 of the decision), and by the board in its preliminary communication, this statement contains three lines of argument against the inventive step of the patent:

Document (2), in combination with documents (4) to (6)  
Document (3) in combination with document (2)  
Document (1), in combination with documents (2), (4)-  
(6).

For each document, the relevant passages are clearly identified.

- 1.5 More precisely, in its notice of opposition, the opponent (now appellant I) cited six documents to contest inventive step (see document (14)). On page 1, it was stated that the patent in suit was opposed on the ground that it was obvious to a person skilled in the art. Under the title "Inventive step", the opponent defined the problem to be solved as well as the solution proposed by the patent in suit. It also defined the background of the invention as recited in the patent in suit and in document (1). Moreover, the opponent cited document (2) and explained that a marine cylinder oil has a typical viscosity of 19 cSt (19 mm<sup>2</sup>/s) at 100°C. Since overbased calcium sulfonates having a viscosity of at least 180 mm<sup>2</sup>/s (180 cSt) at 100°C and a TBN of about 400 or more were allegedly recommended for use in marine cylinder oils from documents (4) to (6), it would have been obvious to adapt the amount of the

base oil to keep the required viscosity if overbased calcium sulfonates were to be used.

The opponent also cited document (3) and explained that the overbased calcium sulfonate detergents described therein (see examples 1, 5 and 13 in Table 2), having a viscosity of at least 180 mm<sup>2</sup>/s at 180°C and a TBN of about 400 or more were available at the filing date of the patent in suit for use in marine cylinder oil (see page 28 of this document). If the skilled person were to use such overbased calcium detergents, it would need less high viscosity base oil to produce a marine cylinder lubricant having a viscosity of around 19 mm<sup>2</sup>/s (cSt) at 100°C as recommended by document (2).

The opponent also cited document (1) which discloses a 70 TBN marine cylinder oil including an overbased calcium sulfonate having a TBN of 400. If a skilled person were to replace the overbased calcium sulfonate with one having a higher viscosity as disclosed in documents (4) to (6), to achieve the typical viscosity of around 19 mm<sup>2</sup>/s (cSt) at 100°C for a marine cylinder oil as taught by document (2), it would have been obvious to reduce the amount of high viscosity bright stock.

- 1.6 Therefore, document (14) fulfils the requirements of Rule 55(c) EPC 1973, since at least one ground of appeal is mentioned (in the present case lack of inventive step) and evidence and arguments have been presented in support of the ground based on lack of inventive step.



1.7 Document (14) contains sufficient information allowing the person skilled in the art to understand how and on the basis of which evidence the patent in suit should be revoked. The present case is different from the one dealt with in the decision T 222/85 referred to by the appellant II. In the "fact and submissions" of the said decision, reference is made to a mere assertion of the opponent stating that the combination of the features of claim 1 were conventional and known from the state of the art. This assertion was supported by a list of 16 documents of the prior art without any citation of specific passages in the said documents, which could justify the assertion of obviousness. This is not the case here. Thus, the decision T 222/85 relates to a different set of circumstances and cannot be decisive for assessing the admissibility of the present opposition.

1.8 The opposition is thus admissible.

*Main request and auxiliary requests 1-3*

2. Amendments

2.1 Claim 1 of the main request as well as claims 1 of the auxiliary requests 1 to 3 and 5 to 7 do not contain the expression "*wherein the weight percent of the lubricating oil is inversely commensurately proportional to the viscosities of the detergent and lubricating oil for a predetermined marine oil viscosity*" present in claim 1 as originally filed.

It should thus be assessed whether the omission of this phrase amounts to an extension of the content of the

application as filed (Article 100(c) EPC) as contended by appellant I.

2.1.1 The said feature is consistently mentioned in the description as originally filed in conjunction with the marine cylinder oil compositions (see pages 2, "Summary of the invention", lines 27 to 29 and page 3, lines 28 to 31). This condition of inverse commensurate proportionality also appears in a second "broad aspect" of the invention between a first oil having a high viscosity and the overbased detergent (see Claims 10 and 21 as filed and page 2, lines 32 to 34). Therefore, for the person skilled in the art it is clear that this feature is essential to characterize the lubricating oil, because it is nowhere mentioned as an optional and/or preferred feature of the invention in the description as originally filed. Moreover, this sentence establishes an additional condition for defining the claimed compositions by linking the weight percent of the lubricating oil in the marine cylinder oil composition to the viscosity of the detergent and the lubricating oil. Contrary to the appellant's II arguments, the subject-matter of claim 1 of the main request as well as claims 1 of the auxiliary requests 1 to 3 do not relate to individualized compositions in the sense that for each of them all the components of the composition and their respective proportions and/or amounts are defined. The subject-matter of the different claims 1 represents a group of compositions where no specific composition can be individualized and for which the feature of "inverse commensurate proportionality" at issue is an essential feature.

Compositions generically claimed cannot be considered as a list of individualized compositions.

2.1.2 In view thereof, the deleted feature represents an essential technical feature of the invention and its deletion amounts therefore to an unallowable extension of the content of the application as originally filed (see T 260/85, OJ EPO 1989, 105, point 12).

2.2 Therefore, main request and auxiliary requests 1 to 3 contravene the requirements of Article 100(c) EPC.

*Auxiliary requests 5 to 7*

3. The previous issue (see point 2 above) still arises with these requests. Indeed, Claims 1 of those requests remain a **group** of non individualized compositions and for this reason the deletion of the feature: "wherein the weight percent of the lubricating oil is inversely commensurately proportional to the viscosities of the detergent and lubricating oil for a predetermined marine oil viscosity" represents an unallowable extension of the content of the application as filed (see point 2 above).

*Auxiliary requests 4, 8 and 9*

4. Admissibility of the late filed requests

4.1 These requests were submitted during oral proceedings and are thus regarded as late filed in accordance with Article 13(1) and 13(3) RBPA (see OJ EPO 11/2007). Their admission into the proceedings is thus left to the discretion of the board.

4.2 Appellant I argued that these requests were presented at a very late stage of the procedure and instead of one single request, appellant II filed three new requests. It was thus requested that these requests be refused as late filed.

4.3 Although these requests are late filed, in accordance with Article 13(1) and (3) RBPA, the board exercising its discretionary power may admit them on condition that these requests do not raise new issues, which cannot be dealt with without postponement of the oral proceedings.

In the present case, the expression "*...wherein the weight percent of the lubricating oil is inversely commensurately proportional to the viscosities of the detergent and lubricating oil for a predetermined marine oil viscosity ...*" in claim 1 as filed has been replaced by the expression "*...wherein the weight percent of the lubricating oil in the marine cylinder oil composition is inversely commensurately proportional to the viscosities of the detergent for a predetermined marine cylinder oil viscosity...*". Hence, the difference between these two expressions lies only in the deletion of the expression "and lubricating oil". This amendment does not change the issue at stake and is thus considered as an amendment which can be dealt by the parties and the board without requiring the postponement of the oral proceedings. It should also be added that it does not extend the granted scope, since the granted version of the patent did not contain this limitative feature. In view thereof, the requirements of Article 123(3) EPC are also met.

- 4.4 As a consequence, the board decides to admit these three late filed requests into the proceedings.
5. Clarity
- 5.1 Claims 1 of each request all comprise the additional feature: "wherein the weight percent of the lubricating oil in the marine cylinder oil composition is inversely commensurately proportional to the viscosities of the detergent for a predetermined marine cylinder oil viscosity".
- 5.2 Although Article 84 EPC is not a ground of opposition, when amendments take place during an opposition or an appeal, it must be verified whether the so amended claim fulfils the requirements of this article.
- 5.3 Given that Claim 1 of each request relates to marine cylinder oil compositions defined structurally and by the added feature (see point 5.1 above), for the clarity requirement to be met, the group of compositions according to these claim 1s must be defined in such a way that the skilled person can unambiguously distinguish the compositions which belong to the claimed compositions from those which do not.
- 5.4 Contrary to the Appellant's II view, the added feature cannot be seen as the inherent result of the other features mentioned in Claim 1 of the auxiliary requests 4, 8 and 9 respectively. This would not be consistent with the submission of the Appellant II according to which this feature has to be understood as a functional feature merely clarifying that the amount, and

therefore the weight percent, of the lubricating oil has to be **selected** (emphasis added by the Board), in order to achieve a certain desirable marine cylinder oil viscosity.

This added feature is an essential functional feature which limits the kind of compositions claimed among those defined structurally in Claim 1 of those requests (see point 2.1.1 above).

5.5 For this reason it must be examined whether this added feature defines clearly the scope of the claims 1 at issue as required by Article 84 EPC.

5.6 The expression "... inversely commensurately proportional..." renders the claim unclear because it does not allow an understanding of the technical relationship between the weight percent of the lubricating oil and the viscosity of the detergent.

Indeed, "commensurately proportional" means that the weight percent of the lubricating oil and the viscosity of the detergent vary in the same direction in a group of compositions, whereas "inversely proportional" means that the same features vary in the opposite direction. There is no part of the description which could help the skilled person to clarify that point.

5.7 As a conclusion, the Board notes that the deletion of an essential feature broadens the content of the application as filed. However, the introduction of this feature may render the claim unclear (see by analogy decision T 728/98, OJ EPO 2001, 319, points 3 and 4.3).

**Order**

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

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar

The Chairman

B. Atienza Vivancos

P. Ranguis