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**Datasheet for the decision
of 12 October 2010**

Case Number: T 0528/08 - 3.3.06

Application Number: 01925400.2

Publication Number: 1263917

IPC: C10L 1/06

Language of the proceedings: EN

Title of invention:

Fuel composition

Patentee:

ExxonMobil Research and Engineering Company

Opponent:

BP Oil International Limited

Headword:

Improved lubricity fuel/EXXONMOBIL

Relevant legal provisions:

EPC Art. 123(3), 56

Relevant legal provisions (EPC 1973):

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Keyword:

"Prohibition of reformatio in peius"

"Extension of protection conferred - auxiliary request (yes)"

"Inventive step - main request, claims as maintained by the
Opposition Division (no)"

Decisions cited:

-

Catchword:

-



Case Number: T 0528/08 - 3.3.06

D E C I S I O N
of the Technical Board of Appeal 3.3.06
of 12 October 2010

Appellant: BP Oil International Limited
(Opponent) Chertsey Road
Sunbury-on-Thames, Middlesex TW 16 7BP (GB)

Representative: Perkins, Nicholas David
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Representative: Troch, Geneviève
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
16 January 2008 concerning maintenance of
European patent No. 1263917 in amended form.

Composition of the Board:

Chairman: P.-P. Bracke
Members: E. Bendl
J. Geschwind

Summary of Facts and Submissions

I. The appeals are from the decision of the Opposition Division to maintain the European patent 1 263 917 in amended form.

II. In this decision the Opposition Division concluded inter alia that, starting from document

D5 = WO-A-99/49003

as the closest prior art, the data provided by the Proprietor showed an improvement in lubricity when adding olefins to fuel compositions with less than 10 ppm per weight of sulphur, less than 25 vol% aromatics and no ethers. Due to this effect the claimed subject-matter was considered to involve an inventive step.

III. The only independent Claim 1 of the set of claims **as maintained** by the Opposition Division reads as follows:

"1. Method for improving lubricity of fuel composition comprising gasoline and having a sulfur content of less than 10 ppm by weight and an aromatic content of less than 25 % by volume by increasing the olefinic content to at least 5% by volume without recourse to the use of ethers, the resulting fuel composition being substantially free of any ethers."

IV. The Proprietor/Appellant, thereafter referred to as Proprietor, filed an appeal against this decision and submitted a main request and an auxiliary request.

- V. The **main request** filed with letter of 21 May 2008 contains two independent claims:
- Claim 10 being identical with Claim 1 as maintained by the Opposition Division and
 - Claim 1 referring to the fuel composition per se.

The only independent Claim 1 of the **auxiliary request** filed with letter of 15 December 2008 reads as follows:

"1. Method for improving lubricity of a base fuel having a sulfur content of less than 10 ppm by weight and an aromatic content of less than 25 % by volume without recourse to the use of ethers by increasing the olefins content of the base fuel to an amount of at least 5 % by volume and at most 25 % by volume of the total base fuel."

- VI. The Opponent/Appellant, thereafter referred to as Opponent, also filed an appeal against the decision of the Opposition Division and submitted two comparative tests.
- VII. Oral proceedings before the Board took place on 12 October 2010 in the absence of the Proprietor, as announced with Proprietor's letter of 10 September 2010.
- VIII. The main arguments of the **Opponent** were as follows:

Sets of claims under consideration

In the written procedure the Proprietor requested to set aside the decision of the Opposition Division. This is to be seen as a withdrawal of the claims as maintained by the Opposition Division.

Article 123(3) EPC - auxiliary request

The term "substantially free of any ethers" omitted in Claim 1 of the auxiliary request, but present in Claim 10 as granted, is not identical with the feature "without recourse to the use of ethers" of Claim 1 of the auxiliary request. Given this difference Claim 1 of the auxiliary request extends the protection conferred.

Inventive step - main request and claims as maintained by the Opposition Division

D5 is the closest state of the art. Alternatively the prior art described in the patent-in-suit may be taken as a starting point to discuss inventive step. Starting from either disclosure the claimed subject-matter is obvious.

- IX. The main arguments of the **Proprietor** submitted in writing were as follows:

Inventive step - main request and claims as maintained by the Opposition Division

The aim of the invention is to provide fuel compositions of ultra-low sulphur and low aromatic content, which have improved friction properties and hence adequate lubricity.

The tests submitted by the Proprietor in opposition proceedings show that the addition of olefins improves lubricity of the fuel compositions.

D5, as the closest state of the art, does not address the reduction of lubricity.

The claimed subject-matter is therefore inventive.

- X. The Opponent requests that the patent be revoked in its entirety.

The Proprietor requests in writing that the decision of the Opposition Division be set aside and that the patent be maintained on the basis of the main request filed with letter of 21 May 2008 or the auxiliary request filed with letter of 15 December 2008.

Reasons for the Decision

1. *Sets of claims under consideration*

1.1 The Opponent submitted, that the Proprietor has failed to file a formal request for maintenance of the patent on the basis of the set of claims as maintained by the Opposition Division. According to the Opponent this should be a proof that the Proprietor has renounced to this set of claims.

1.2 With his notice of appeal of 14 March 2008 and the corresponding grounds of appeal of 21 May 2008 the Proprietor requested the patent to be maintained on the basis of the main request as filed during the first instance procedure. With the letter of 15 December 2008 the Proprietor additionally filed an auxiliary request. None of these requests is identical with the set of claims as maintained by the Opposition Division.

No further submissions were made concerning the set of claims as maintained, neither did the Proprietor state that he was no longer interested in this set of claims.

The Board could not find any explicit indication of such an intention - neither in the grounds of appeal nor in any subsequent submissions filed by the Proprietor.

- 1.3 The purpose of the appeal in inter partes procedures is to examine the challenged decision of the first instance on its merits (G 9/91 OJ EPO 1993, page 408 point 18 of the reasons; T 26/88 OJ EPO 1991, page 30, point 12 of the reasons). Thus, the principal issue to be answered by the Board of Appeal in inter partes procedures is to decide whether a first instance decision should be upheld or overturned (T 369/91 OJ EPO 1993, 561, point 6.6 of the reasons).

The Board's power is determined by the principle of devolution effect of the appeal (*tantum devolutum, quantum appellatum*) and by the requests stated by the Appellants in their grounds of appeal (G 9/92 OJ EPO 1994, 875, points 1 and 3 of the reasons; T 1382 not published in the OJ EPO, point 8 of the reasons).

- 1.4 In the present case, as stated by the Proprietor, his request is to maintain the patent on the basis of the main request as filed during the first instance proceedings. It should be considered that filing an appeal was the only possibility for the Proprietor to defend the patent beyond the claims as maintained in amended form by the department of first instance (G 4/93 OJ EPO 1994, 875, point 10 of the reasons). Furthermore, the auxiliary request was only filed with the letter of 15 December 2008 as a reaction to the Board's communication of 04 June 2008 and the Opponent's statement of 02 December 2008.

Notwithstanding the fact that in the present case the Proprietor appealed the decision of the Opposition Division with the aim of requesting the maintenance of the patent on the basis of a higher ranking set of claims, this alone cannot lead the Proprietor to risk endangering the result which was achieved before the department of first instance (G 9/92 OJ EPO 1994, 875, point 11 of the reasons; G 4/93 OJ EPO, 1994, point 12 of the reasons), all the more that in the absence of a request or reply from the Respondent in appeal proceedings indicating that the decision of the opposition Division should not be amended or cancelled, a Board must still examine and decide whether the appeal is allowable in accordance with Articles 110 and 111 EPC (T 501/92 OJ EPO 1996, 261, point 1.9 of the reasons).

1.5 Consequently, if the situation occurs in which the Board does not contemplate revocation of the patent and also does not contemplate to grant a patent on the basis of the higher ranking request as filed by the Proprietor, the appeal of both the Opponent and Proprietor should be dismissed with the consequence that the patent is still maintained in amended form as by the Opposition Division.

2. *Article 123(3) EPC - auxiliary request*

2.1 Claim 10 of the set of claims **as granted** refers to a method for improving lubricity of a fuel composition being substantially free of any ethers.

2.2 Claim 1 of the **auxiliary request** relates to a method for improving lubricity of a base fuel and contains the proviso "without recourse to the use of ethers".

2.3 In the latter method the use of ethers **for improving lubricity** is to be avoided, which does not exclude per se the presence of ethers in the final fuel. This is in contrast to the substantial absence of ethers as required by Claim 10 as granted.

2.4 Thus, the wording of the auxiliary request extends beyond the protection conferred and the requirement of Article 123(3) EPC is not met.

3. *Novelty - main request and the claims as maintained by the Opposition Division*

Given the fact that the main request and the set of claims as maintained by the Opposition Division are not considered to be inventive, the Board's view with regard to novelty of the prior art cited by the Opponent will not be discussed.

4. *Article 56 EPC*

According to the problem and solution approach, which is used by the Boards of Appeal of the European Patent Office in order to decide on the question of inventive step, it has to be determined which technical problem the object of a patent objectively solves vis-à-vis the closest prior art document. It also has to be determined whether or not the solution proposed to overcome this problem is obvious in the light of the available prior art disclosures.

4.1 The patent-in-suit

The patent-in-suit concerns a method for improving lubricity of a fuel having a low sulphur and aromatics content and being substantially free of ethers, while showing at the same time good lubricity, good octane performance and attaining low vehicle emissions.

4.2 Main request

4.2.1 Document D5 or alternatively the prior art cited in the patent-in-suit were indicated by the Opponent as the closest state of the art.

According to the jurisprudence of the Boards of Appeal only those documents can be regarded as the closest prior art, which disclose means or processes serving the same purpose as the means or processes described in the patent-in-suit.

D5 concerns gasoline having a high octane number, but producing low emission on combustion.

Paragraph [0002] of the patent-in-suit describes the knowledge of the person skilled in the art leading to the present invention: due to environmental concerns sulphur and aromatics contents were lowered in gasoline; the reduction of the sulphur content was mainly done by hydrotreatment which lead also to a reduction of the olefins. This reduction of the olefins caused poor octane performance, which was in the prior art mainly compensated by the addition of methyl tertiary butyl ether. However, also this ether was called into question due to environmental reasons.

Thus, while D5 concerns high octane number and low emission, the question of lubrication is, if mentioned at all, only implicitly disclosed. The link between low sulphur content and lubrication is not described in D5.

In contrast thereto, the summary of the closest state of the art in the patent-in-suit refers to the link between sulphur content and lubrication as well as to low emissions and octane performance.

Thus, given the lack of more relevant documents, the state of the art as summarized in paragraph [0002] of the patent-in-suit is actually considered to describe the closest prior art.

4.2.2 In opposition procedure comparative tests were filed by the Proprietor which demonstrated that the addition of olefin resulted in improvements in lubricity in fuels according to the invention with less than 10 ppm by weight sulphur, whereas such an effect was not achieved with such fuels containing more than 10 ppm by weight sulphur.

In appeal procedure the Opponent filed data showing that the effect alleged by the Proprietor could not be achieved for specific blends of market gasoline and an alkylate fraction containing less than 25 vol% aromatics and less than 10 ppm by weight of sulphur.

Since market gasoline was part of the preparation, the results were disputed by the Proprietor because additives in commercial fuel allegedly influenced the results.

The Opponent filed further comparative tests on fuel blends without commercial fuel. These tests again showed that the addition of 15% 1-decene or 1-pentene does at least not cause an improvement in lubricity.

The Proprietor did not dispute the validity of these test results.

Therefore, at least from the further test of the Opponent it may be concluded that an alleged effect cannot be achieved for all methods covered by the wording of Claim 10 of the main request.

Consequently the problem underlying the patent-in-suit has to be defined in a less ambitious way, namely as the provision of a method alternative to the one defined in the introductory part of the patent-in-suit.

- 4.2.3 As the solution to this problem the Proprietor proposes the method for improving lubricity of a fuel composition according to Claim 10 of the main request.
- 4.2.4 The Board has no reason to contest that the problem of providing a method alternative to the one disclosed in the introductory part of the patent-in-suit is solved over the whole range claimed.
- 4.2.5 It still remains to be clarified whether the skilled person, when starting from the prior art described in paragraph [0002] of the patent-in-suit would have come to the claimed invention without an inventive step.

Paragraph [0002] of the patent-in-suit describes the need to avoid sulphur, aromatics and ethers due to environmental reasons. Furthermore the role of olefins for lubrication and their elimination due to hydrotreatment is also shown in this paragraph.

Being aware that the removed olefins particularly contribute to lubrication and also knowing that prior art gasoline with/without sulphur having suitable lubrication properties may contain high amounts of olefins (for instance up to 30 vol% in D5, e.g. page 1, line 23), the re-introduction of a compound known for its beneficial effects, but removed in the course of processing the fuel, is not considered to involve an inventive step.

4.2.6 Claim 10 of the main request therefore does not meet the requirement of Article 56 EPC.

4.3 *Inventive step - Claims as maintained by the Opposition Division*

Claim 1 of the set of claims as maintained by the Opposition Division is identical with Claim 10 of the main request. Therefore, identical considerations as for the main request apply.

Order

For these reasons it is decided that:

1. The decision of the Opposition Division is set aside.
2. The patent is revoked.

The Registrar

The Chairman

G. Rauh

P.-P. Bracke