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**Datasheet for the decision
of 27 June 2013**

Case Number: T 1618/08 - 3.3.03

Application Number: 97117585.6

Publication Number: 0839840

IPC: C08F 8/32

Language of the proceedings: EN

Title of invention:

Lubricating oil additive comprising succinimide compound, and its use for diesel engines

Patent proprietor:

Idemitsu Kosan Company Limited

Opponent:

Infineum International Ltd., IP Law Dept.

Headword:

-

Relevant legal provisions:

EPC Art. 123(2), 83

RPBA Art. 13

Keyword:

"Amendments - added subject-matter (no) "

"Late-filed argument - admitted (no) "

Decisions cited:

-

Catchword:

-



Case Number: T 1618/08 - 3.3.03

D E C I S I O N
of the Technical Board of Appeal 3.3.03
of 27 June 2013

Appellant: IDEMITSU KOSAN COMPANY LIMITED
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Decision under appeal: Decision of the opposition division of the
European Patent Office posted 18 June 2008
revoking the patent.

Composition of the Board:

Chairman: B. ter Laan
Members: D. Marquis
C.-P. Brandt

wherein R represents an alkenyl or alkyl group derived from a C2 to C15 olefinic polymer and having a number-average molecular weight of from 200 to 4000."

"3. Use of the lubricating oil composition as defined in claim 1 or 2 for diesel engines."

The remaining claims were dependent claims directed to embodiments of claim 1 (claim 2) and of claim 3 (claim 4).

- III. A notice of opposition against the patent was filed on 19 September 2005. The opponent requested the revocation of the patent in its entirety based on Article 100(a) EPC (novelty and inventive step) and Article 100(b) EPC. According to the opponent the patent in suit did not teach a skilled person how to produce a succinimide compound having an absorption peak (α -peak) at $1640 \pm 10 \text{ cm}^{-1}$ and an absorption peak (β -peak) at $1700 \pm 10 \text{ cm}^{-1}$ in the IR spectral pattern such that the ratio of the intensity of the α -peak to that of the β -peak is 0,15 or more. It was also stated that the position of the infrared absorption band and in particular the relative intensities were highly dependent on the measuring conditions. Therefore, it was not possible to determine the products used in the patent in suit.
- IV. At the end of the oral proceedings held on 04 June 2008, the opposition division revoked the European patent. The decision was based on a main request (claims as granted) and three auxiliary requests. The opposition division introduced the ground of opposition under Article 100(c) EPC of its own motion and decided that

the main and first auxiliary requests extended beyond the content of the application as filed because in the original disclosure only lubricating oil compositions "for diesel engines" were disclosed, which purpose related restriction was not present in claim 1 of both those requests. Also, only the use of the lubricating oil compositions as cylinder oil in 2-cycle diesel engines for ships was mentioned in the original disclosure; the expression "as the cylinder oil in" was not present in claim 4 of both requests.

Regarding Article 100(b) EPC, there was no indication in the patent specification how to prepare lubricating oil compositions comprising a succinimide being the reaction product of an acid compound of general formula (I) or (II) and a polyamine in a molar ratio of acid compound/polyamine of 2,0 or more, that had at the same time an α -peak/ β -peak intensity ratio (as measured by IR) of at least 0,15. The opposition division concluded that the claimed lubricating oil compositions with a ratio of the intensity of the α -peak to that of the β -peak of 0,15 or more were insufficiently disclosed when the molar ratio of acid compound/polyamine was comprised between 2,0 and less than 2,2 (point 14.5 of the decision) and were sufficiently disclosed when the molar ratio was 2,2 or more (points 14.4 and 14.7 of the decision). Therefore, the subject-matter set out in the second and third auxiliary requests was insufficiently disclosed.

- V. On 18 August 2008, the patent proprietor lodged an appeal against that decision; the prescribed appeal fee was paid on the same day. The statement setting out the grounds of appeal was filed on 27 October 2008. The

appellant requested to set aside the decision of the opposition division and to remit the case to the opposition division for continuation of the proceedings on the basis of a main request (claims 1-4 as granted) or any of five auxiliary requests.

The claims of the fourth auxiliary request filed with the statement setting out the grounds of appeal were restricted to compositions for which the ratio of the intensity of the α -peak to that of the β -peak was 0,15 or more and the molar ratio of acid compound/polyamine was 2,2 or more. In particular, claims 1 and 3 of the fourth auxiliary request read (additions compared to claim 1 as granted indicated in bold, deletions in strikethrough):

"1. A lubricating oil composition **for diesel engines**, which comprises a base oil for lubricating oil, and from 5 to 40 % by weight of (A) a metallic detergent-dispersant additive selected from over-based sulfonates, phenates and salicylates of alkaline earth metals, relative to the total weight of the composition and from 0,1 to 3 % by weight of (B) succinimide compound, relative to the total weight of the composition, which is the reaction product of an acid compound of the following general formula (I) or (II) and a polyamine in a molar ratio of acid compound/polyamine of 2,2 or more, and which give an absorption peak (α -peak) at $1640 \pm 10 \text{ cm}^{-1}$ and an absorption peak (β -peak) at $1700 \pm 10 \text{ cm}^{-1}$ in the IR spectral pattern with the ratio of the intensity of the α -peak to that of the β -peak (intensity of α -peak/intensity of β -peak) of being 0.15 or more,

Article 83 EPC was an issue to be discussed for the first and the second auxiliary request. Finally, the parties' attention was drawn to Articles 13(1) and (3) RPBA.

- VIII. By letter dated 22 May 2013, the respondent requested the revocation of the patent for lack of sufficiency of disclosure (Article 83 EPC) and requested not to remit the case to the opposition division for further prosecution. A test report was also submitted.
- IX. By letter of 31 May 2013, the appellant filed a new main as well as three auxiliary requests and requested not to admit the test report submitted by the respondent on 22 May 2013. The main request was identical to the fourth auxiliary request filed with the statement setting out the grounds for the appeal.
- X. Oral proceedings were held on 27 June 2013 in the presence of both parties.
- XI. The appellant's arguments may be summarised as follows:
- (a) The basis in the application as originally filed for the claims of the main request was indicated.
 - (b) The objection of lack of sufficiency of disclosure regarding what was now the main request was late filed as it had not been submitted with the reply to the statement of grounds of appeal. The appellant did not agree to admit the objection under Article 83 EPC to the proceedings.

- (c) The respondent had not provided any experimental data about the preparation of the succinimide mentioned in the test report of 22 May 2013 so that also for that reason it should not be admitted to the proceedings.
- (d) The case should be remitted to the opposition division for discussion of novelty and inventive step. The summoning of a witness was necessary to decide on the public prior use issue raised before the opposition division so that the case was too complex to be dealt with at the oral proceedings before the Board of Appeal.

XII. The respondent's arguments may be summarised as follows:

- (a) No objections under Article 123(2) EPC were raised against the claims of the present main request.
- (b) The subject-matter of the main request was not sufficiently disclosed. The objection under Article 83 EPC was admissible because it had already been raised in the notice of opposition and it had been mentioned in the reply to the statement of grounds of appeal. It had been pursued during the whole of the proceedings and also it was highly relevant. The Board in the summons to attend oral proceedings had also addressed the issue of sufficiency of disclosure.
- (c) The patent in suit did not disclose the reaction conditions necessary to prepare the succinimide used in the composition according to claim 1. The test report provided on 22 May 2013 showed that a

succinimide satisfying the requirements of claim 1 could not be prepared, although the instructions of the patent in suit had been followed.

Furthermore, the patent in suit did not provide essential information on the measurement of the α -peak/ β -peak intensity ratio, which was in fact a new parameter for a known compound.

- (d) The case should not be remitted to the opposition division since the patent would lapse in four years and a further delay in the prosecution of the case was not acceptable.

XIII. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the case be remitted to the opposition division for a discussion of novelty and inventive step of the claims on the basis of the main request or any of the three auxiliary requests all filed on 31 May 2013.

The respondent (opponent) requested that the appeal be dismissed and not to remit the case to the first instance.

Reasons for the Decision

1. The appeal is admissible.

Main request

2. Article 123(2) EPC

The respondent did not object to the amendments of the main request, nor does the Board see any reason to do

so in view of the disclosure in the application as originally filed, in particular claim 6 and the second full paragraph of page 7 (present claim 1), the last paragraph of page 11 (present claim 2) and the first paragraph of page 19 (present claims 3 and 4). The main request fulfils the requirements of Article 123(2) EPC.

3. Article 123(3) EPC

Compared to claim 1 as granted, the molar ratio of acid of formula (I) or (II) to polyamine in claim 1 of the main request has been limited to 2,2 or more. It is also specified that the lubricating oil composition is for diesel engines. Claim 4 now requires that the lubricating oil composition should be used as a cylinder oil. The claims of the main request therefore do not extend the scope of protection so that the requirements of Article 123(3) EPC are fulfilled.

4. Article 83 EPC

4.1 The claims of the present main request are identical to the claims of the fourth auxiliary request filed by the appellant with the statement of grounds of appeal on 27 October 2008, which were restricted to compositions comprising a succinimide obtained from a molar ratio of acid compound/polyamine of 2,2 or more and having a ratio of the intensity of the α -peak to that of the β -peak of 0,15 or more. An objection of lack of sufficiency of disclosure against the subject matter of those claims was not raised in the reply to the statement of grounds of appeal.

4.2 In both its reply to the statement of grounds of the appeal dated 30 April 2009 as well as in its letter dated 22 May 2013 the respondent consistently addressed the sufficiency of disclosure of those compositions for which the ratio of α -peak to β -peak was 0,15 or more, having at the same time a molar ratio of acid compound/polyamine of 2,0 or more. It is only at the very end of the argumentation regarding Article 83 EPC (letter of 22 May 2013, page 3), that a remark was made concerning the sufficiency of disclosure of compositions for which the ratio of α -peak to β -peak was 0,15 without mentioning molar ratio of acid compound/polyamine: "*EP 0 839 840 B1 fails to teach a skilled person how to make a succinimide compound having a ratio of intensity of the α -peak ($1640 \pm 10 \text{cm}^{-1}$) to that of the β -peak ($1700 \pm 10 \text{cm}^{-1}$) of 0,15 or more.*" Since the whole foregoing argumentation had been based on a lack of disclosure of the combination of a molar ratio of acid compound/polyamine of 2,0 in combination with a ratio of α -peak to β -peak of 0,15, it is not evident that that remark referred to a lack of disclosure for the succinimide compound regardless of the molar ratio of acid compound/polyamine and in particular to those having a molar ratio of acid compound/polyamine of 2,2 or more. Therefore, the respondent's argument that objections under Article 83 EPC other than those referring to the combination of a molar ratio of acid compound/polyamine of 2,0 in combination with a ratio of α -peak to β -peak of 0,15 had been pursued during the whole of the proceedings, cannot be followed.

4.3 Since the Board in its letter accompanying the summons, contrary to the respondent's argument, had not addressed

Article 83 EPC concerning the claims of what is now the main request, that argument, too, fails to convince.

- 4.4 The respondent's argument of high relevance in view of the test report filed with the letter of 22 May 2013 can also not be followed because that test report did not provide any information about the preparation or the origin of the succinimide presented therein so that it cannot be regarded as evidence for the lack of teaching concerning the preparation of the compositions of the main request.
- 4.5 The objection under Article 83 EPC against the present main request, based on other arguments than those referring to the combination of a molar ratio of acid compound/polyamine of 2,0 and a ratio of α -peak to β -peak of 0,15, came therefore as a surprise at the oral proceedings. It could in particular, on the basis of the arguments brought forward during the course of the written proceedings, not have been expected that an objection under Article 83 EPC would be raised based on a lack of information on the measuring methods of the α - and β -peak.
- 4.6 The Board can only come to the conclusion that the objection under Article 83 EPC put forward by the respondent at the oral proceedings constitutes a significant amendment of his case and raises issues which the appellant and the Board cannot reasonably be expected to deal with without adjournment of the oral proceedings. In view of the above, the objection under Article 83 EPC against the present main request is not admitted into the proceedings (Article 13(3) RPBA).

5. Article 111 EPC

5.1 Novelty and inventive step of the present set of claims have not been dealt with by the opposition division.

5.2 It is not apparent from the reply to the statement of the grounds of appeal how the arguments against novelty and inventive step of the claims raised by the respondent before the opposition division apply to the claims of the present main request.

5.3 The outcome of the assessment of the prior use which was not part of the appeal procedure and for which the appellant requested to summon a witness (letter dated 9 May 2008) or the relevance of the document filed by the respondent with the reply to the statement of the grounds of the appeal, may have consequences on the issue of novelty and inventive step.

5.4 Consequently, even if the patent is due to lapse in a few years' time, a remittal to the first instance is necessary.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance for further prosecution on the basis of the main request (claims 1-4) filed on 31 May 2013.

The Registrar

The Chairman

E. Görgmaier

B. ter Laan