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**Datasheet for the decision
of 20 December 2011**

Case Number: T 1182/09 - 3.3.05

Application Number: 04777649.7

Publication Number: 1648830

IPC: C02F 1/36, C02F 1/74,
C02F 103/16

Language of the proceedings: EN

Title of invention:

DEVICES AND PROCESSES FOR USE IN ULTRASOUND TREATMENT

Applicant:

Ashland Licensing and Intellectual Property LLC

Headword:

Ultrasound treatment/ASHLAND

Relevant legal provisions:

EPC Art. 84

Relevant legal provisions (EPC 1973):

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Keyword:

"Clarity (no): absence of tests or procedures for verifying a feature defined as a result to be achieved"

Decisions cited:

T 0578/03

Catchword:

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Case Number: T 1182/09 - 3.3.05

D E C I S I O N
of the Technical Board of Appeal 3.3.05
of 20 December 2011

Appellant: Ashland Licensing and Intellectual Property LLC
(Applicant) 5200 Blazer Parkway
Dublin, OH 43017 (US)

Representative: Gervasi, Gemma
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 14 January 2009
refusing European patent application
No. 04777649.7 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: G. Raths
Members: J.-M. Schwaller
C. Vallet

Summary of Facts and Submissions

- I. This appeal lies from the decision of the examining division refusing European patent application No. 04 777 649.7 on the grounds that both requests then on file lacked the requirements of Article 56 EPC.
- II. As an obiter dictum to the decision, the examining division also put into question the clarity of the feature "*wherein the treatment does not deteriorate the lubricity characteristics or pH of the fluid*" defined in the independent method claims of both requests then on file.
- III. With the grounds of appeal dated 20 May 2009, the applicant (hereinafter "the appellant") submitted a single amended set of claims in replacement of the previous claims then on file, with an independent claim 1 reading as follows:
- "1. *A method of treating a cutting fluid comprising:*
- *collecting cutting fluid from a cutting device;*
 - *simultaneously exposing said cutting fluid to ultrasound of a frequency of 200kHz or higher while injecting gas into the ultrasound field, wherein the treatment does not deteriorate the lubricity characteristics or pH of the fluid; and*
 - *recirculating the treated cutting fluid to the cutting device, wherein the cutting fluid is an emulsion.*"
- IV. In a communication dated 17 March 2011, the board expressed its preliminary opinion that the above claim

lacked the requirements of Articles 123(2), 84 and 56 EPC. The board in particular expressed reservations upon the clarity of the feature "*wherein the treatment does not deteriorate the lubricity characteristics [...] of the fluid*".

V. With a letter dated 15 July 2011, the appellant submitted an amended set of claims as the sole new main request, with claim 1 thereof reading as follows (amendments in bold):

- "1. A method of treating a cutting fluid comprising:
- collecting cutting fluid from a cutting device **in a compartment**;
 - simultaneously exposing said cutting fluid to ultrasound of a frequency of 200kHz or higher while injecting gas **microbubbles having an average diameter of less than 1 mm** into the ultrasound field **in the compartment collecting the cutting fluid**, wherein the treatment does not deteriorate the lubricity characteristics or pH of the fluid; and
 - recirculating the treated cutting fluid to the cutting device, wherein the cutting fluid is an **rolling oil emulsion**."

As an auxiliary request, the appellant requested oral proceedings in case the board would not allow the main request.

VI. On 4 August 2011, the board summoned to oral proceedings. It also informed the appellant of its preliminary opinion that the subject-matter of claim 1 of the main request annexed to the letter dated 15 July

2011 did not meet the requirements of Articles 56 EPC and 84 EPC.

- VII. By telefax dated 19 December 2011, the appellant informed the board that it would not be represented at the oral proceedings.
- VIII. Oral proceedings took place on 20 December 2011 in the absence of the appellant.
- IX. The appellant requested in writing that the contested decision be set aside and that a patent be granted on the basis of the claims 1 to 7 according to the main request filed on 15 July 2011.

Reasons for the Decision

Main request - Article 84 EPC

1. The feature "*wherein the treatment does not deteriorate the lubricity characteristics [...] of the fluid*" (hereinafter "the disputed feature") had been proposed as an amendment to claim 1 of the main request in the course of the examining proceedings with the purpose to further define the subject-matter claimed.
2. The disputed feature defines the claimed subject-matter in terms of a desideratum or as "a result to be achieved" and the question arises whether the claim bearing this feature is clear and so meets the requirements of Article 84 EPC.

3. In this respect, the board observes that the disputed feature has no well-known recognised meaning in the technical field concerned. The appellant did not provide any evidence that the disputed feature does have a well-known recognised meaning.

4. It follows that it has to be checked whether the claimed "result to be achieved" is one which can be directly and positively verified by tests or procedures adequately specified in the description or known to the person skilled in the art and which do not require undue experimentation according to the jurisprudence of the boards of appeal (e.g. T 0578/03, point 2. of the Reasons).

5. The board observes that neither the claims nor the description of the application in suit describes any test or procedure which would allow the person skilled in the art to verify whether the lubricity characteristics of a cutting fluid have been deteriorated by the treatment claimed.

6. In its written submissions the appellant did not refer to any such test or procedure. It nevertheless argued that a person skilled in the art would understand that a treatment which did not deteriorate the lubricity characteristics of a cutting fluid was one which did "not impact the friction-reducing capabilities of the fluid". The skilled person would also understand that the lubricity characteristics of a cutting fluid were not deteriorated if the rate of wear or other damage to the cutting tool was not affected after the cutting fluid had been treated by the claimed process. The appellant also argued that the rolling oil emulsion had

to be selected from the known rolling oil emulsions which were not deteriorated when exposed to a treatment as claimed.

7. The board cannot accept these arguments, because none of them tackles the question at issue, namely whether the claimed "result to be achieved" was one which could be directly and positively verified by tests or procedures known to the person skilled in the art.
8. In this context, the board judges that the disputed feature is not clear and so does not satisfy the requirements of Article 84 EPC.
9. In the absence of a set of claims satisfying all the requirements of the EPC, a patent cannot be granted.

Order

For these reasons it is decided that:

The appeal is dismissed

The Registrar:

The Chairman

C. Vodz

G. Raths