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**Datasheet for the decision
of 15 May 2012**

Case Number: T 0257/10 - 3.3.01

Application Number: 01925970.4

Publication Number: 1319702

IPC: C10M 111/00, C10M 173/00,
B21C 9/02, B21C 9/00, B21J 3/00

Language of the proceedings: EN

Title of invention:
Aqueous lubricant for plastic working of metallic material and
method of lubricant film processing

Applicant:
Henkel AG & Co. KGaA

Opponent:
-

Headword:
Lubricant/HENKEL

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
"Amendment (allowable) - supported by original claims -
subsequently introduced unsupported feature deleted"
"Remittal"

Decisions cited:
-

Catchword:
-



Case Number: T 0257/10 - 3.3.01

D E C I S I O N
of the Technical Board of Appeal 3.3.01
of 15 May 2012

Appellant: Henkel AG & Co. KGaA
(Applicant) Henkelstrasse 67
D-40589 Düsseldorf (DE)

Representative: Kuhnert, Oliver
Henkel AG & Co. KGaA
VTP Patente
D-40191 Düsseldorf (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 3 September 2009
refusing European patent application
No. 01925970.4 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: P. Ranguis
Members: G. Seufert
D. S. Rogers

Summary of Facts and Submissions

- I. The Appellant lodged an appeal against the decision of the Examining Division refusing European patent application No. 01925970.4.
- II. The decision under appeal was based on the set of claims filed with letter of 29 March 2007. The Examining Division held that the subject-matter of claim 1 did not meet the requirement of Article 123(2) EPC, because the feature "which does not contain any other synthetic resin than the wax (C)" was not supported by the application as originally filed.
- III. With the statement of grounds of appeal the Appellant filed a main request and first to third auxiliary requests.
- IV. In a communication accompanying the summons to oral proceedings, the Board expressed its preliminary opinion. In particular, the Board indicated that it agreed with the Examining Division's finding that the "negative" feature still present in the Appellant's main request had no basis, either explicitly or implicitly, in the application as originally filed. The same applied to the "negative" feature present in the second auxiliary request. Concerning the amendments in the third auxiliary request, the Board requested the Appellant to provide a clear basis for the combination of features in the application as filed. The Board's only objection with regard to the first auxiliary request was the deletion of the expression "or dispersed" in claim 1. The Board also informed the Appellant that it intended to remit the case for

further prosecution to the department of first instance, if it came to the conclusion that at least one of the Appellant's requests complied with Article 123(2) EPC.

- V. In response to the Board's communication, the Appellant filed a new main request as well as two new auxiliary requests replacing the previously filed requests.

The main request consists of 5 claims with independent claims 1 and 3 reading as follows:

"1. Aqueous lubricant used for plastic working of metallic material which contains (A) water soluble inorganic salt being selected from a group of sulfate, silicate, borate, molybdate and tungstate, (B) one or more than one lubricative agent being selected from molybdenum disulfide and graphite, and (C) Wax, and these components are dissolved or dispersed in water and weight ratio of (B)/(A) in solid state is in the range of 1.0 to 5.0 and weight ratio of (C)/(A) in solid state is in the range of 0.1 to 1.0."

"3. Method of lubricative film processing wherein aqueous lubricant according to any of claim (1) to (2) is applied to the cleaned surface of the metallic material and is dried, and produce the lubricative film of 0.5 to 40 g/m² on the surface of the metallic material."

- VI. The Appellant withdrew its request for oral proceedings in reply to a communication by the Board informing it that its main request was considered to comply with the requirements of Article 123(2) EPC.

VII. The Appellant requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution on the basis of the main request.

Reasons for the Decision

1. The appeal is admissible.

Main request

2. Amendments

The amendments in claim 1 of the main request are based on claims 1 and 2 as originally filed. Claims 2-5 find their basis in claims 3-6 as originally filed.

The subsequently introduced "negative" feature which was objected to in the decision under appeal and the Board's communication of 6 February 2012 (see points II and IV above) was removed.

The Board therefore concludes that the main request complies with Article 123(2) EPC.

3. Remittal

Since the Examining Division in the decision under appeal refused the patent application solely for the reason of non-compliance with Article 123(2) EPC, the Board considers it appropriate to exercise its discretion according to Article 111(1) EPC and not to examine any further issues during the appeal

proceedings but to remit the case to the department of first instance for further prosecution.

4. Since the Board has come to the conclusion that the Appellant's main request is supported by the application as filed and has decided to remit the case to the department of first instance, there is no need to decide on any of the Appellant's auxiliary requests.

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.

The Registrar

The Chairman

M. Schalow

P. Ranguis