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**Datasheet for the decision  
of 18 December 2012**

**Case Number:** T 0790/10 - 3.2.05

**Application Number:** 08159054.9

**Publication Number:** 2009342

**IPC:** F16N19/00

**Language of the proceedings:** EN

**Title of invention:**

Circulation lubrication system

**Applicant:**

Osakeyhtiö SKF Aktiebolag

**Headword:**

**Relevant legal provisions:**

EPC 1973 Art. 76(1)

**Keyword:**

Binding effect of a decision taken in the parent application  
Principle of 'res judicata' applied in the divisional  
application

Added subject-matter - all requests (yes)

**Decisions cited:**

T 1005/97, T 0051/08

**Catchword:**



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Case Number: T 0790/10 - 3.2.05

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.05**  
**of 18 December 2012**

**Appellant:** Osakeyhtiö SKF Aktiebolag  
(Applicant) Linnoitustie 11  
02601 Espoo (FI)

**Representative:** Tapio Lassi Paavali Valkeiskangas  
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**Decision under appeal:** **Decision of the Examining Division of the European Patent Office posted 4 December 2009 refusing European patent application No. 08159054.9 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman:** M. Poock  
**Members:** S. Bridge  
G. Weiss

## Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal against the decision of the examination division refusing European divisional patent application No 08 159 054.9.
- II. The examination division held that the application contains subject-matter which extends beyond the content of the parent application 01 947 493.1 (WO-A-01/98703) as filed (Article 76(1) EPC).
- III. The appellant requested in writing that the decision under appeal be set aside and that a patent be granted on the basis of the following documents:  
as main request: claims 1 to 3 as originally filed with the divisional application in suit; and  
as auxiliary request: claims 1 to 3 filed as auxiliary request on 9 November 2009.
- IV. In the annex to the summons to oral proceedings, the provisional opinion of the board was communicated to the appellant raising the issue of the *res judicata* effect of earlier decision T 1005/07 of 25 July 2008 with respect to added subject-matter in the parent application 01 947 493.1.
- V. On 9 November 2012, the representative filed further documents and arguments and informed the board that the appellant would not be represented at the oral proceedings scheduled.
- VI. Oral proceedings were held before the Board of Appeal on 18 December 2012 in absence of the appellant.

VII. Claim 1 as filed (main request) reads as follows (additions with respect to claim 1 forming the main request in decision T 1005/07 have been indicated by the rapporteur in bold and deletions in cross-out):

"1. A circulation lubrication system, including a pressure pipe line **(3)** configured to provide lubricant to at least one part to be lubricated and a return pipe line **(5)** configured to return lubricant from at least one part to be lubricated, an intermediate tank (1), **the intermediate tank (1) being configured to condition the lubricant before recirculation**, inlet channel means **(25a)** for feeding a lubricant into the intermediate tank (1), the inlet channel means **(25a)** being connected to the return pipe line **(5)**, outlet channel means **(3a)** for removing the lubricant from the intermediate tank (1), the outlet channel means **(3a)** being connected to the pressure pipe line **(3)**, discharge means **(56)** for emptying the intermediate tank, and measuring means **(6, 7, 8)** arranged to start the discharge means **(56)** when the level of the lubricant in the intermediate tank (1) rises to a predetermined upper limit and to stop the discharge means **(56)** when the level of the lubricant in the intermediate tank (1) falls to a predetermined lower limit, characterized in that the discharge means **(56)** comprise a pneumatic valve **(89)** arranged to open, controlled by the measuring means **(6, 7, 8)**, when the level of the lubricant is at the upper limit, and to let pressurized air flow into the intermediate tank (1), whereby the pressurized air is arranged to push the lubricant out of the intermediate tank (1) through the outlet channel means **(3a)** to the pressure pipe line **(3)**, and to shut and prevent the flow of pressurized air into the intermediate tank (1) when the level of the lubricant falls to the lower limit, and that a counter valve **(910)** is arranged in the inlet means

(25a) for the lubricant before the intermediate tank (1), seen from the direction of flow, the counter valve (910) being arranged to prevent the flow of the lubricant out of the intermediate tank (1) through the inlet channel means (25a) to the return pipe line (5)."

Claim 1 according to the auxiliary request differs from claim 1 according to the main request in that the text "*the intermediate tank (1) being configured to condition the lubricant before recirculation*" has been deleted.

VIII. In the written procedure, the appellant argued essentially as follows:

It is admitted that the feature of the return pipe line which returns lubricant from the part to be lubricated was discussed in decision T 1005/07. However, every case must always be judged from the basis of the grounds available at the moment, i.e. it is always possible that the decision made earlier is found later to be incorrect, for example in situations in which some earlier instance has interpreted the situation incorrectly. The appellant is of the opinion that decision T 1005/07 was not correct because no subject-matter extending beyond the content of the application was added and that the matter in question must be judged as a whole from what was presented in this appeal.

## **Reasons for the Decision**

1. *The principle of res judicata*

The present board agrees with the findings regarding the principle of *res judicata* set out in item 3 of appeal decision T 0051/08 of 7 May 2009 in the context of a parent and its divisional application. Thus subject-matter on which a final decision has been taken by a board of appeal in the parent application cannot be pursued in a divisional application.

2. *The decision in the parent application*

The application in suit's parent application 01 947 493.1 was refused by its respective examining division which held that that application contained subject-matter which extends beyond the content of 01 947 493.1 as filed (Article 123(2) EPC). This decision was maintained on appeal in particular with respect to the feature of the return pipe line which returns lubricant from the part to be lubricated for which there was no direct and unambiguous disclosure in the parent application 01 947 493.1 as filed (published as WO-A-01/98703) (Point 1 of the reasons of decision T 1005/07).

3. *The divisional application in suit*

- 3.1 One issue of added subject-matter concerns the feature "*a return pipe line (5) configured to return lubricant from at least one part to be lubricated*" of claim 1 (main and auxiliary request) with respect to European patent application 01 947 493.1, the parent of the divisional application in suit. This issue was raised

by the board in the annex to the summons to oral proceedings.

### 3.2 Main request

- 3.2.1 The subject-matter of claim 1 according to the main request differs from the subject-matter of claim 1 according main request in the parent application in the addition of the feature "*the intermediate tank (1) being configured to condition the lubricant before recirculation*" after the first mention of "*an intermediate tank (1)*" and in that the reference signs have been renumbered.

The changes in the reference signs are not of substantive significance.

The addition of the feature "*the intermediate tank (1) being configured to condition the lubricant before recirculation*" independent of, and does not affect, the feature of "*a return pipe line (5) configured to return lubricant from at least one part to be lubricated*".

Thus, insofar as the feature of a return pipe line configured to return lubricant from the part to be lubricated of claim 1 according to the main request of the present appeal is concerned, the facts are the same as to those for claim 1 according to the main request of the parent application in appeal case T 1005/07.

- 3.2.2 As already noted above, in appeal case T 1005/07 it was finally decided that the feature of "*a return pipe line configured to return lubricant from at least one part to be lubricated*" constitutes added subject-matter which extends beyond the content of European patent application 01 947 493.1 as filed. Therefore, the

present board is prevented from deciding on it a second time.

Furthermore, additional evidence provided by the appellant in the context of this appeal and concerning the use of return pipe lines in prior art cannot overcome a deficiency in the *direct and unambiguous* disclosure of such a feature as *part of the invention* in the parent application 01 947 493.1 as filed.

3.2.3 Thus, the issue of added subject-matter concerning the feature of a return pipe line configured to return lubricant from the part to be lubricated, as set out in point 1 of T 1005/07, renders the present main request unallowable under Article 76(1) EPC 1973.

### 3.3 Auxiliary request

Claim 1 according to the auxiliary request differs from claim 1 of the main request in that the text "*the intermediate tank (1) being configured to condition the lubricant before recirculation*" has been deleted.

This means that claim 1 according to the auxiliary request is, apart from changes in the reference sign numbering scheme, identical to claim 1 according to the main request decided in decision T 1005/07. Therefore, the subject-matter of claim 1 of the auxiliary request is the same as that of claim 1 according to the main request decided in decision T 1005/07.

Since a final judgement was already handed down on this subject-matter in that decision, the present board is prevented from deciding on it a second time.



Again, additional evidence provided by the appellant in the context of this appeal and concerning the use of return pipe lines in prior art cannot overcome a deficiency in the direct and unambiguous disclosure of such a feature as part of the invention in the parent application as filed.

Thus, the issue of added subject-matter concerning the feature of a return pipe line configured to return lubricant from the part to be lubricated, as set out in point 1 of T 1005/07, renders the present auxiliary request unallowable under Article 76(1) EPC 1973.

## Order

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

The appeal is dismissed.

The Registrar:

The Chairman:



D. Meyfarth

M. Poock

Decision electronically authenticated