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**Datasheet for the decision
of 3 July 2013**

Case Number: T 1709/11 - 3.3.01
Application Number: 97907118.0
Publication Number: 888422
IPC: C10M 105/38, C10M 169/04
Language of the proceedings: EN

Title of invention:

Hydraulic oil and method for its manufacturing

Applicant:

Voitelukeskus Tonttila Oy

Headword:

Hydraulic oil/VOITELUKESKUS TONTTILA OY

Relevant legal provisions:

EPC Art. 123(2)
EPC R. 115(1)(2)
RPBA Art. 15(3)

Keyword:

"Added matter - (yes) "

Decisions cited:

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Catchword:

-



Case Number: T 1709/11 - 3.3.01

D E C I S I O N
of the Technical Board of Appeal 3.3.01
of 3 July 2013

Appellant: Voitelukeskus Tonttila Oy
(Applicant) P1 45
FI-33311 Tampere (FI)

Representative: Hakola, Unto Tapani
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 13 January 2011
refusing European patent application
No. 97907118.0 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: A. Lindner
Members: J.-B. Ousset
L. Bühler

Summary of Facts and Submissions

- I. An appeal was filed against the decision of the examining division to refuse European patent application No. 97907118.0.
- II. The examining division found that claims 1 and 7 of the then pending main request were not novel in view of document (1) (FI-B-95367) and the corresponding family document WO-A-96/07632 in English. On the basis of the same documents, inventive step was also not acknowledged. Moreover, the amended set of claims contravened Article 123(2) EPC.
- III. With the statement setting out the grounds of appeal, an amended version of the single and main request had been filed. Claim 1 of this request reads as follows:
- "1. Hydraulic oil based on natural fatty acid esters, characterized in that its basic material is selected from the following esters of tall oil or their mixtures, which are end products of simple esterification of tall oil:
- ester of polyhydroxy compound of neopentane, such as
 - trimethylolpropane ester (TMP ester),
 - pentaerythritol ester,
 - trimethylolethane ester,
 - trimethylolbutane ester,
 - neopentyl glycol ester, and
 - poly(ethyleneglycol) ester,
- and that the hydraulic oil contains, for lowering the viscosity compared with the basic material, ester of tall oil obtained with alcohol being bivalent at most and having fewer carbon atoms than the above-listed

polyols, or ester of tall oil obtained with a monovalent alcohol, and that it further contains at least an oxidation inhibitor, a corrosion inhibitor, an antifoam agent and an EP lubricant, which are mutually different agents."

The appellant also argued that the amendments were supported by the description as originally filed.

- IV. In its annex to the invitation to oral proceedings, the board informed the appellant that it took the view that claims 1, 3, 5 and 7 as amended contravened Article 123(2) EPC.
- V. The appellant requested in writing that the decision under appeal be set aside and that a patent be granted on the basis of the set of claims submitted with the statement of grounds of appeal.
- VI. With a letter of 10 June 2013, the appellant notified the board that it would not be attending the oral proceedings scheduled on 3 July 2013.
- VII. At the end of the oral proceedings, the decision of the board was announced.

Reasons for the Decision

- 1. The appeal is admissible.
- 2. The appellant had been duly summoned to oral proceedings according to Rule 115(1) EPC and although it did not appear to these oral proceedings, they were

continued in its absence (Rule 115(2) EPC). Moreover, the board was not obliged to adjourn these proceedings due to the absence of a duly summoned party (Article 15(3) RPBA). For these reasons, the board was in a position to take a decision.

3. Added matter

3.1 In the description as originally filed, it is mentioned that the claimed hydraulic oil based on natural fatty acid esters can contain further substances such as an antifoam agent, a corrosion inhibitor, an oxidation inhibitor and an EP lubricant (see claim 1 as originally filed). However, as the board pointed out to the appellant in its annex to the invitation to oral proceedings, the board was unable to find in the entire description any indication that these further constituents had to be "mutually different agents" as claimed in claim 1 of the main request.

3.1.1 In its statement setting out the grounds of appeal, the appellant mentions a passage on pages 7 and 8 to support the said amendment.

This passage cannot represent an appropriate basis for justifying the amendment of claim 1. First of all, the expression "mutually different agents" is not mentioned in the description as originally filed. Furthermore, it appears from the content of the description as originally filed that an oxidation inhibitor also contains a corrosion inhibitor (see page 7, line 17 as well as page 6, lines 13 to 14 disclosing that a specific oxidation inhibitor is also a corrosion inhibitor). Moreover, the passages cited by the

appellant on pages 7 and 8 refer to specific types of additives whereas, according to the wording of claim 1, any corrosion inhibitor, any antifoam agent, any oxidation inhibitor and any EP lubricant can be present in the claimed hydraulic oil. Thus, the application as originally filed does not contain a teaching which discloses clearly and unambiguously that any corrosion inhibitor, any antifoam agent, any oxidation inhibitor and any EP lubricant embraced in the scope of claim 1 will be "mutually different agents".

Therefore, the passages on pages 7 and 8 of the description as originally filed cannot represent a basis for the claimed generalisation mentioned in claim 1.

- 3.2 In the absence of any further arguments from the appellant, the board concludes that claim 1 of the main request contravenes Article 123(2) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

M. Schalow

A. Lindner