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**Datasheet for the decision
of 28 July 2017**

Case Number: T 0557/13 - 3.3.06
Application Number: 98203458.9
Publication Number: 0921183
IPC: C10L10/04, C10L1/22, C10L1/18,
C10L1/14
Language of the proceedings: EN

Title of invention:

Use of cold flow improvers in fuel oil compositions

Patent Proprietor:

Infineum USA L.P.

Opponent:

Clariant Produkte (Deutschland) GmbH

Headword:

Partial priority II / Infineum

Relevant legal provisions:

EPC Art. 54(3), 87, 88, 111(1)

Keyword:

Entitlement to partial priority (yes)
Novelty - (yes)
Remittal (yes)

Decisions cited:

G 0001/15, T 0557/13

Catchword:



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Case Number: T 0557/13 - 3.3.06

D E C I S I O N
of Technical Board of Appeal 3.3.06
of 28 July 2017

Appellant:
(Patent Proprietor)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 18 December
2012 revoking European patent No. 0921183
pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman B. Czech
Members: G. Santavicca
 J. Geschwind

Summary of Facts and Submissions

- I. The appeal lies from the decision of the Opposition Division to revoke European patent No. 0 921 183.
- II. The patent in suit was granted on European patent application No. 98203458.9, which is a divisional application of European patent application No. 95923299.2, hereinafter "parent application". The latter was published as WO 95/33805 A1 (hereinafter D1). The patent in suit and the parent application both claim priority from national patent application GB 9411614.2 (hereinafter D16) filed on 9 June 1994.
- III. The patent had been opposed on the grounds of Article 100(a) EPC (lack of novelty and lack of inventive step) and 100(c) EPC (non-compliance with the requirements of Articles 123(2) and 76(1) EPC). Novelty objections were raised in view of some of the examples contained in D1 considered as prior art pursuant to Article 54(3) EPC.
- IV. In the decision under appeal, the Opposition Division came to the following conclusions:
 - The claims as granted were not objectionable under Article 123(2) or 76(1) EPC.
 - The subject-matter of use Claim 1 as granted lacked novelty under Article 54(3) EPC in view of a use disclosed identically in both D16 and D1 (Example 1). The embodiment described in example 1 of D1 was held to be "entitled to the claimed priority date of 09.06.1994", whereas granted Claim 1 was held to be "only entitled to the filing date of 08.06.1995".
- V. This decision was appealed by the Patent Proprietor. The Board entrusted with the case decided (interlocutory decision T 557/13 of 17 July 2015)

- that the claims as granted were not objectionable on the grounds of Article 100(c) EPC (see Reasons, 2),

and

- to refer questions of law (see Order) regarding the proper assessment of partial priority to the Enlarged Board of Appeal, as the decision regarding novelty would depend on the answer to these questions.

VI. In Decision G 1/15 of 29 November 2016, the Enlarged Board of Appeal came to the following conclusion (see Order):

"Under the EPC, entitlement to partial priority may not be refused for a claim encompassing alternative subject-matter by virtue of one or more expressions or otherwise (generic "OR"-claim) provided that said alternative subject-matter has been disclosed for the first time, directly, unambiguously and in an enabling manner in the priority document. No other substantive conditions or limitations apply in this respect."

VII. In a communication dated 23 February 2017 (see point 7), the Board *inter alia* expressed its provisional opinion that "it appear[ed] that D1 cannot be novelty-destroying under Article 54(3) EPC, as its (invoked) subject-matter does not appear to have an earlier effective filing date than the (attacked) subject-matter encompassed by Claim 1 at issue, also enjoying the priority date of D16."

VIII. In its letter dated 21 April 2017, the Appellant (Patent Proprietor) argued that according to decision G 1/15 "the claim of the (divisional) patent in suit benefit[ed] from partial priority to the extent that it

encompass[ed] the subject-matter disclosed in the common priority document [D16]. Lack of novelty over that same subject matter in the parent [application D1] should not arise."

- IX. With letter dated 16 May 2017, the Respondent (Opponent), aware of the content of the Board's communication (VII, *supra*), requested a decision on novelty by the Board according to the state of the file as it stands, without submitting further arguments. Oral proceedings were explicitly not requested.
- X. With its further letter dated 30 May 2017 the Appellant (Patent Proprietor) withdrew an earlier auxiliary request for oral proceedings and maintained its further requests as set out in its letter of 21 April 2017, namely that
- the decision under appeal be set aside;
 - the present appeal be allowed; and
 - the case be remitted to the Opposition Division.

Reasons for the Decision

Novelty

1. The only novelty objections raised by the Opponent are based on the parent application D1. More particularly, the Opponent had argued that some specific examples of D1 disclosed uses falling within the ambit of Claim 1 at issue (notice of opposition, page 4, three first paragraphs).
2. According to G 1/15, entitlement to partial priority may not be refused for Claim 1 at issue to the extent that alternative subject-matter encompassed has been

disclosed for the first time, directly, or at least implicitly, and unambiguously, and in an enabling manner, in the priority document (here D16).

3. Subject-matters, which are

- disclosed in the priority document D16 and in the parent application D1

and which are

- encompassed by (generic "OR") Claim 1 of the (divisional) patent at issue as (non spelt-out) alternatives, i.e. displaying all the cumulative features of the claim, thus benefiting of partial priority,

can thus not be novelty-destroying for Claim 1 of the (divisional) patent, the effective filing date of such subject-matters being the same.

3.1 Example 1 of D1 undisputedly discloses such an alternative use encompassed by the generic "OR"-Claim 1 at issue and has undisputedly been disclosed for the first time, directly, or at least implicitly, and unambiguously, and in an enabling manner, in priority document D16 (see decision T 557/13 of 17 July 2015 (Reasons, 4.6, 7.2.3 and 7.3)).

3.2 Even assuming (*arguendo*) that the other examples of D1 invoked by the Opponent indeed disclose further alternative uses also encompassed by Claim 1 at issue, and are indeed also disclosed for the first time, directly, or at least implicitly, and unambiguously, and in an enabling manner, in the priority document as alleged by the Opponent (notice of opposition, page 4,

third paragraph), these examples could also not be novelty-destroying as regards Claim 1 at issue for the same reasons.

Remittal

4. Inventive step objections (Article 100(a) EPC) that had also been raised by the Opponent are not dealt with in the decision under appeal. In the exercise of its discretion under Article 111(1) EPC, the Board finds it appropriate to remit the case to the Opposition Division for further prosecution, in accordance with the Appellant's request to this end.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division for further prosecution.

The Registrar:

The Chairman:



D. Magliano

B. Czech

Decision electronically authenticated