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**Datasheet for the decision  
of 29 August 2018**

**Case Number:** T 2342/14 - 3.2.03

**Application Number:** 05809725.4

**Publication Number:** 1829625

**IPC:** B21B27/10

**Language of the proceedings:** EN

**Title of invention:**

METHOD FOR SUPPLYING LUBRICATING OIL IN COLD ROLLING

**Patent Proprietor:**

ArcelorMittal

**Opponent:**

Tata Steel IJmuiden BV

**Headword:**

**Relevant legal provisions:**

EPC Art. 123(2), 123(3), 84  
RPBA Art. 12(4), 13(1)

**Keyword:**

Amendments - added subject-matter (no)

Claims - clarity - main request (no) - clarity - auxiliary  
request (yes)

**Decisions cited:**

G 0003/14, G 0009/91

**Catchword:**



**Beschwerdekammern**

**Boards of Appeal**

**Chambres de recours**

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Case Number: T 2342/14 - 3.2.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.03**  
**of 29 August 2018**

**Appellant:** ArcelorMittal  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 27 October 2014  
revoking European patent No. 1829625 pursuant to  
Article 101(2) EPC.**

**Composition of the Board:**

**Chairman** G. Ashley  
**Members:** C. Donnelly  
M. Blasi

## **Summary of Facts and Submissions**

I. The appeal lies from the decision of the opposition division to revoke European Patent No. 1 829 625. In its decision the opposition division held that the subject-matter of granted claims 1 and 2 comprised added subject-matter (Articles 100(c) and 123(2) EPC).

II. The patent-proprietor (hereinafter: the "appellant") lodged an appeal against this decision.

In its reply to the appeal, the opponent (hereinafter: the "respondent") submitted its counter-arguments.

III. In a communication dated 24 May 2017, pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA), annexed to the summons to oral proceedings, the board informed the parties of its provisional opinion.

IV. Oral proceedings were held on 29 August 2018. At the end of the debate the parties confirmed the following requests:

The appellant requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the set of claims of the main request, filed as auxiliary request 1 with the statement of grounds of appeal, or alternatively, on the basis of the set of claims of auxiliary request 1 filed as auxiliary request 2 with the statement of grounds of appeal, or further alternatively, on the basis of the claim filed as auxiliary request 2 at the oral proceedings.

The respondent requested that the appeal be dismissed.

V. Claim 1 according to the main request reads:

"A method of supplying lubrication oil for supplying an emulsion of a lubrication oil and heated water mixed together to an inlet side of a rolling stand in cold rolling of a metal sheet, the method either comprising storing two or more types of lubrication oils of different compositions in separate tanks, selecting one of said stored lubrication oils in accordance with a friction coefficient between the rolled metal sheet and work rolls, and supplying an emulsion comprised of said selected lubrication oil and heated water mixed together to an inlet side of the rolling stand or the method comprising storing the two or more types of lubrication oil of different compositions and at least one type of lubrication oil and at least one type of additive in separate tanks, mixing two or more types of lubrication oil selected from said stored lubrication oils in accordance with the friction coefficient between the rolled metal sheet and work rolls, mixing at least one selected lubrication oil and at least one selected additive to obtain a mixed oil, and supplying an emulsion comprised of this mixed oil mixed with heated water to an inlet side of a rolling stand."

Auxiliary request 1 comprises claims 1 and 2 reading:

"1. A method of supplying lubrication oil for supplying an emulsion of a lubrication oil and heated water mixed together to an inlet side of a rolling stand in cold rolling of a metal sheet

comprising storing two or more types of lubrication oils of different compositions in separate tanks,

selecting one of said stored lubrication oils in accordance with a friction coefficient between the rolled metal sheet and work rolls, and supplying an emulsion comprised of said selected lubrication oil and heated water mixed together to an inlet side of the rolling stand.

2. A method of supplying lubrication oil in cold rolling as set forth in claim 1, wherein at least one of said lubrication oil includes an additive."

Auxiliary request 2 comprises a single claim corresponding to claim 1 of auxiliary request 1.

VI. The arguments of the parties relevant to the decision can be summarised as follows

*(a) Respondent's case*

*All requests, admissibility*

The main request should be considered inadmissible because it has already been presented during examination proceedings and dealt with by the examining division in its communication dated 23 July 2010. To allow the same claim back into the proceedings at the appeal stage would not be commensurate with the requirements of procedural efficiency. Similar objections also apply to the auxiliary requests. In particular, claim 1 of both auxiliary requests is diverging with respect to claim 1 as granted.

*Main request, Clarity, Article 84 EPC*

Claim 1 of the main request does not meet the requirements of Article 84 EPC as regards the features:

(i) - "mixing two or more types of lubrication oil... rolls, mixing at least one selected lubrication oil and at least one selected type of additive to obtain a mixed oil"; and

(ii) - "storing the two or more types of lubrication oil... and at least one type of lubrication oil and at least one type of additive in separate tanks".

Feature (i) is ambiguous since it is not clear how many mixed oils there are and whether the additive is present. Feature (ii) renders unclear the number of separate storage tanks required for the lubrication oils since it is ambiguous whether the "and at least one type of lubrication oil" is in addition to the "two or more types of lubrication oil".

*Auxiliary request 1, Clarity*

The request does not meet the requirements of Article 84 EPC since claim 2 specifies "wherein at least one of said lubrication **oil** includes an additive", therefore it is not clear how many of the lubrication oils could include an additive since "oil" is in the singular.

*Auxiliary request 2*

Claim 1 is broader in scope than claim 1 as granted since it specifies that the emulsion is actually supplied whereas granted claim 1 was directed to a method "suitable for supplying". Claim 1 of auxiliary request 1 therefore is in conflict with Article 123(3) EPC.

*Insufficiency of disclosure, Article 83 EPC*

There is nothing to add to the case presented during the written proceedings which referred to submissions raised before the opposition division.

*(b) Appellant's case*

*All requests, admissibility*

Claim 1 of the main request was submitted in response to the objections raised in the decision under appeal and is not identical to claim 1 referred to by the examining division in its communication of 23 July 2010 as alleged by the respondent.

Auxiliary request 1 was also submitted with the grounds of appeal and is converging with respect to the main request. Claim 1 of auxiliary request 2 submitted during the oral proceedings only differs from auxiliary request 1 in that claim 2 has been deleted.

*Main request, Clarity, Article 84 EPC*

Claim 1 is clear since if there were any any doubts as to what was meant the skilled person would refer to the description at paragraph [0051] of the application as published (or [0050] of the patent specification) reading:

"The method of supplying lubrication oil of the second aspect of the invention comprises mixing two or more types of lubrication oils selected from stored lubrication oils in accordance with a friction coefficient between a rolled steel sheet and work rolls **or** mixing at least one selected lubrication oil and at



least one selected additive to obtain a mixed oil" which clarifies how the claim should be understood. This passage indicates that there are two options which can be used to obtain a mixed oil. As regards the number of storage tanks, it is evident that it is only necessary to store two types of lubrication oil from which the two options of obtaining a mixed oil can be realised.

*Auxiliary request 1, Clarity*

The specification of "oil" in claim 2 is clearly a typing error and the skilled person would immediately see that the claim should read "oils".

*Extended scope of protection, Article 123(3) EPC*

The respondent's arguments are in contradiction to its position taken in the written proceedings in which it had objected that the granted claims should not be broader than the claims as originally filed. Claim 1 is any case of a narrower scope since it comprises the additional step of supplying an emulsion.

*Auxiliary request 2*

Claim 1 is identical to claim 1 of auxiliary request 1, thus the same arguments apply.

**Reasons for the Decision**

1. *Consideration of main request and auxiliary request 1, Article 12(4) RPBA*

Claim 1 of the main request is not identical to any amended claims filed during the proceedings before the

examining division. In particular, the problem created by the "or" in claim 1 referred to by the examining division in its communication of 23 July 2010 is no longer present; the current objection based on an "or" was not considered by the examining division. The main request was filed as auxiliary request 1 together with the statement of grounds of appeal and can, in the board's view, be considered as a legitimate response to the decision under appeal which revoked the patent solely on the grounds that it comprised added subject-matter. Under these circumstances, reversion to a combination of claims as filed is an option of last resort for a patent proprietor.

Similar considerations apply in relation to auxiliary request 1 which had been filed as auxiliary request 2 together with the statement of grounds of appeal and in which the second alternative method introduced by "or the method comprising" is deleted.

Therefore, the board sees no reason to exclude these requests from consideration under Article 12(4) RPBA.

2. *Main request, Article 84 EPC Clarity*

- 2.1 Claim 1 of the main request is based on a combination of independent claims 1 and 2 as filed. As such, in contrast to claims as granted, the requirements of clarity according to Article 84 EPC must be examined during the appeal proceedings (G 3/14, OJ EPO 2015, A102; G 9/91, OJ EPO 1993, 408, point 19 of the Reasons). The claim is effectively two independent claims since it maintains the separation between the two alternative methods specified in claims 1 and 2 as filed. However, the board agrees with the respondent

that the second of the two alternatives is not clear as regards the features reading:

(i) - "mixing two or more types of lubrication oil selected from said stored lubrication oils in accordance with the friction coefficient between the rolled metal sheet and work rolls, mixing at least one selected lubrication oil and at least one selected additive to obtain a mixed oil"; and

(ii) "storing the two or more types of lubrication oil... and at least one type of lubrication oil and at least one type of additive in separate tanks".

2.2 With respect to the meaning of feature (i), the appellant referred to the description at paragraph [0051] of the application as published which specifies that the mixed oil can be obtained either by:

"mixing two or more types of lubrication oils selected from stored lubrication oils in accordance with a friction coefficient between a rolled steel sheet and work rolls **or** mixing at least one selected lubrication oil and at least one selected additive to obtain a mixed oil".

This would tend to indicate that the word "or" has been unintentionally omitted in the claim. However, at this stage in the proceedings it is the appellant's task to ensure that the claims are clear in themselves and do not comprise any errors of drafting which could impact upon their clarity.

2.3 Further, the same passage renders feature (ii) ambiguous since it is unclear whether the further specification of storing "and at least one type of

lubrication oil" means "and at least one **further** type of lubrication oil" or whether at least one of the already stored lubrication oils is for mixing with an additive which is the interpretation of the claim implied in the above passage of the description. Thus, the number of separate tanks required for storing the different types of lubrication oil is ambiguous.

2.4 In conclusion, claim 1 of the main request is not clear pursuant to Article 84 EPC.

3. *Auxiliary request 1, Clarity, Article 84 EPC*

The request does not meet the requirements of Article 84 EPC since claim 2 specifies "wherein at least one of said lubrication **oil** includes an additive". Therefore, it is not clear how many lubrication oils are present since the singular is used. It is plausible that a typing error has occurred, however, as already reasoned above, at this stage in the proceedings it is the appellant's task to ensure that the claims do not comprise any errors of drafting which could impact upon their clarity.

4. *Auxiliary request 2,*

4.1 *Admittance, Article 13(1) RPBA*

4.1.1 Auxiliary request 2, comprising one single claim, was submitted by the appellant during oral proceedings before the board, which for the following reasons admitted it into the appeal proceedings pursuant to Article 13(1) RPBA.

4.1.2 Albeit submitted late, the amendment, i.e. deletion of the claim found non-compliant with the provisions

pursuant to Article 84 EPC, is straightforward. Also the request was filed in immediate response to an objection first raised against claim 2 of auxiliary request 1 (see point 3 above) at the oral proceedings.

4.2 *Article 123(2), (3) EPC*

4.2.1 The single claim of auxiliary request 2 is identical to claim 1 of auxiliary request 1 and corresponds to claim 1 as filed. Thus, the requirements of Article 123(2) EPC are met.

4.2.2 The requirements of Article 123(3) EPC are also met, since its subject-matter is of a narrower scope than claim 1 as granted. In particular, in contrast to claim 1 as granted, the step of supplying an emulsion comprised of said selected lubrication oil and heated water mixed together to an inlet side of the rolling stand, is explicitly specified.

5. *Article 83 EPC, Sufficiency of disclosure*

The respondent did not submit any arguments as to why the opposition division's decision was incorrect since it merely referred to its arguments presented during the opposition proceedings. Therefore, the respondent's case has not been substantiated at the appeal stage of the proceedings in accordance with Article 12(2) RPBA. The respondent also did not pursue the matter under Article 83 EPC during the oral proceedings with respect to any of the requests, hence there was no need to discuss the matter further. The board agrees with the reasoning of the opposition decision that the invention is sufficiently disclosed for it to be carried out by the skilled person.

6. *Remittal to the opposition division (Article 111(1) EPC)*

6.1 During the oral proceedings the respondent inferred that a continuation of the case before the opposition division would not be procedurally efficient. However, should the board decide on key issues for the first time at the appeal stage it would have the consequence that a party loses a review instance.

6.2 In the present case, the only grounds for opposition considered in the decision under appeal and which the board therefore considered in the present decision were those of Article 100(b) and (c) EPC. The board has taken note of the statement in the summons to oral proceedings before the opposition division that the claimed method of the patent as granted did not appear to be disclosed in the prior art cited by the respondent and that the "opposition division is thus of the preliminary opinion that the subject-matter of claim 1 is new and inventive". However, in the absence of any reasoning, it can only be speculated as to why the opposition division reached this conclusion, which is in any case of a provisional nature.

6.3 Given these circumstances, the board considers that remittal of the case to the opposition division for further prosecution is the most appropriate course of action (Article 111(1) EPC).

**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 on the basis of the claim of auxiliary request 2 filed at the oral proceedings before the board.

The Registrar:

The Chairman:



C. Spira

G. Ashley

Decision electronically authenticated