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**Datasheet for the decision
of 17 January 2018**

Case Number: T 1229/16 - 3.3.10

Application Number: 08768565.7

Publication Number: 2171011

IPC: C09K5/00

Language of the proceedings: EN

Title of invention:
HYDRAULIC FLUID COMPOSITIONS

Applicant:
Macdermid Offshore Solutions, LLC

Headword:

Relevant legal provisions:
EPC Art. 123(2), 54(2), 111(1)

Keyword:
Amendments - allowable (yes)
Novelty - after amendment (yes)
Remittal (yes)

Decisions cited:

Catchword:



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Case Number: T 1229/16 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 17 January 2018

Appellant: Macdermid Offshore Solutions, LLC
(Applicant) 245 Freight Street
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 2 December 2015
refusing European patent application No.
08768565.7 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman P. Gryczka
Members: R. Pérez Carlón
F. Blumer

Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal against the decision of the examining division to refuse European patent application No. 08 768 565.7.
- II. The documents forming part of the examination proceedings included the following:

D1	US 2007/0078068
D9	US 2006/0272550
- III. The examining division concluded *inter alia* that the composition of claim 1 of the main request then pending was not novel over those disclosed in paragraph [0038] of document D9.
- IV. The board informed the appellant with a communication dated 21 September 2017, in preparation for oral proceedings, that it was inclined to agree with the reasoning and conclusions of the examining division with respect to the novelty of claim 1 of the main request then pending.
- V. Under cover of a letter dated 13 November 2017, the appellant filed auxiliary requests 1 to 4 and withdrew any other auxiliary request then pending. Claim 1 of the first auxiliary request contained all the features of claim 1 of the main request before the examining division and, in addition, the feature specifying that the composition was "*for a blowout preventer device*".
- VI. In a communication dated 28 November 2017, the board informed the appellant *inter alia* that it tended to consider the compositions of claim 1 of the first auxiliary request then pending novel over D9, and that

it would be inclined to remit the case to the examining division for further examination on the basis of said request, provided that the lack of clarity arising from the presence of the wording "carboxylate(d)" in the claims could be solved.

- VII. In reply to the board's communication, the appellant filed a new main request, and first to third auxiliary requests, which corresponded to previously pending second to fourth auxiliary requests. It requested that the case be remitted to the examining division for further examination.

Claim 1 of the main request reads as follows:

*"An aqueous hydraulic fluid composition for a blowout preventer device, which composition comprises:
a first lubricant comprising at least one phospholipid;
and
a second lubricant comprising a salt selected from the group consisting of laurates, palmitates, oleates and stearates;
wherein the hydraulic fluid composition is free of an oil selected from the group consisting of mineral oils, synthetic hydrocarbon oils, and mixtures thereof."*

- VIII. With a communication dated 4 December 2017, the board cancelled the oral proceedings.
- IX. The arguments of the appellant relevant for the present decision were the following:

Claim 1 found a basis in the combination of claim 1, page 5, lines 3-8 of the application as originally filed, and the intended use for a blowout preventer device which could be found on page 1, line 16.

Deleting the word "alkoxylate" from the passage on page 4, lines 7-15, did not introduce any subject-matter not originally disclosed in the application as filed, as it was immediately apparent to the skilled reader that the claimed invention simply required the salts listed in claim 1, and not any derivative thereof.

The dependent claims found the required basis in the corresponding claims of the application as filed. Didecyl dimethyl quaternary ammonium chloride, added to the list of biocides in claim 8, could be found on page 7, lines 27-28, of the application as filed.

For these reasons, the main request did not extend beyond the disclosure of the application as originally filed.

Claim 1 of the main request was directed to hydraulic compositions suitable for a blowout preventer device. The hydraulic compositions of D9 were not suitable for a blowout preventer device, as they settled with time. For this reason alone, the compositions of claim 1 were novel over those of D9.

- X. The final requests of the appellant were that the decision be set aside and the case remitted to the examining division for further examination on the basis of the main request or, subsidiarily, on the basis of one of the first to third auxiliary requests, all requests having been filed under cover of a letter dated 30 November 2017.

Reasons for the Decision

1. The appeal is admissible.

Main Request

2. Amendments

- 2.1 Claim 1 of the main request finds a basis in the combination of claim 1 with the passage on page 5, lines 3-8, of the application as originally filed, and the intended use for a blowout preventer device which can be found on page 1, line 16.

The passage on page 4, lines 7-15, of the original description discloses "salts of *alkoxylates* selected from the group consisting of laurates, palmitates, oleates and stearates", whereas claim 1 does not contain the wording "alkoxylate".

Having regard to the whole content of the application, the skilled reader concludes that the second lubricant simply requires a salt of the fatty acids explicitly mentioned (laurates, palmitates, oleates and stearates), and not any alkoxylate thereof (see page 5, lines 5-6 and the examples).

For this reason, deleting the word "alkoxylate" from the passage on page 4, lines 7-15 does not lead to subject-matter not originally disclosed in the application as filed.

- 2.2 In the context of the first auxiliary request then pending, the examining division concluded that the water amount defined in claim 2 as originally filed was

not combined with the specific salts required by claim 1, which are the same as those required by claim 1 of the main request in these appeal proceedings (see point B-1 of the decision under appeal).

In order to carry out the claimed invention, the skilled reader would necessarily seek information on the required amount of water, and turn to the amount in claim 2 as originally filed, which is the sole passage of the application as originally filed with discloses any specific water amount.

For this reason, it is concluded that the water amount required by claim 2 as originally filed is disclosed in combination with the compositions of claim 1, and thus that claim 2 of the main request finds the required basis in the application as originally filed.

2.3 The remaining dependent claims 3 to 14 find the required basis in the corresponding claims of the application as filed. Didecyl dimethyl quaternary ammonium chloride, which has been added to the list of biocides in claim 8, can be found on page 7, lines 27-28 of the application as filed.

2.4 It is thus concluded that the claims of the main request find the required basis in the application as originally filed (Article 123(2) EPC).

3. Novelty over D9

3.1 Claim 1 of the main request is directed to an aqueous hydraulic fluid composition for a blowout preventer device, which comprises at least one phospholipid, at least a salt selected from laurates, palmitates, oleates and stearates, and which does not contain an

oil selected from the group consisting of mineral oils, synthetic hydrocarbon oils, and mixtures thereof.

- 3.2 The aqueous slurries disclosed in paragraph [0038] of D9 contain lecithin, which is a phospholipid, and calcium stearate (Table 1 in combination with Table 6), and do not contain any of the oils excluded from the composition of claim 1. These compositions further include a cement slurry (Table 6).

The examining division concluded that these compositions were an hydraulic fluid.

Claim 1 of the main request in these appeal proceedings is directed, however, to hydraulic compositions suitable for a specific type of device, i.e. for a blowout preventer device.

These type of units are well known in the art (D1, paragraphs [0002]-[0004]), work by means of hydraulic pressure, and contain a large hydraulic fluid reserve tank.

The hydraulic compositions of D9 are not suitable for a blowout preventer device, as they contain a cement slurry, which settles with time. For this reason alone, it is concluded that the compositions of claim 1 are novel over those of D9.

4. Remittal

The examining division had refused the application due to lack of novelty over document D9, and non-compliance with Article 123(2) EPC of requests which are no longer part of these appeal proceedings. None of the objections raised by the board during the written

appeal proceedings apply to the claims of the appellant's main request. The examining division had, however, not examined the claimed subject-matter at least with respect of inventive step.

The appellant requested that the case be remitted to the examining division for further prosecution. Under these circumstances, the board considers it appropriate to remit the case (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 examining division for further prosecution upon the basis of claims 1-14 of the main request, filed with a letter dated 30 November 2017.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated