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**Datasheet for the decision
of 2 February 2021**

Case Number: T 0347/17 - 3.3.02

Application Number: 06785653.4

Publication Number: 1910505

IPC: C10M163/00

Language of the proceedings: EN

Title of invention:
ZINC-FREE FARM TRACTOR FLUID

Patent Proprietor:
The Lubrizol Corporation

Opponent:
Afton Chemical Corporation

Headword:

Relevant legal provisions:
EPC Art. 123(2)
RPBA 2020 Art. 13(1), 13(2)

Keyword:
Amendments - allowable (no)
Late filed request - not admitted

Decisions cited:

G 0001/99, T 2635/16, T 1621/16, T 0249/12, T 1511/07,
T 1241/03

Catchword:



Beschwerdekammern

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Case Number: T 0347/17 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 2 February 2021

Appellant: Afton Chemical Corporation
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
23 November 2016 concerning maintenance of the
European Patent No. 1910505 in amended form.**

Composition of the Board:

Chairman M. O. Müller

Members: A. Lenzen
P. de Heij

Summary of Facts and Submissions

I. This decision concerns the appeal filed by the opponent (appellant) against the opposition division's decision (decision under appeal) according to which European patent No. 1 910 505 (patent in suit) in amended form meets the requirements of the EPC.

II. In the opposition proceedings, the appellant requested that the patent in suit be revoked in its entirety based on the grounds for opposition pursuant to Article 100(a) (lack of novelty and lack of inventive step), 100(b) and 100(c) EPC.

The decision under appeal is based on the patent as granted (main request) and auxiliary requests 1 to 4. The main request and auxiliary requests 1 to 3 were considered not to be in compliance with the requirements of Articles 100(c) and 123(2) EPC, respectively. Auxiliary request 4 was deemed to meet the requirements of the EPC.

III. The following document, admitted during the opposition proceedings, is referred to in this decision:

D25 declaration of William Abraham

IV. With its letter of 21 August 2017, the patent proprietor (respondent) filed:

A029 declaration of Dr Peter Miatt

V. The parties' final requests, where relevant to this decision, were as follows.

The appellant requested

- that the decision under appeal be set aside and that the patent in suit be revoked in its entirety
- that document A029 not be admitted into the proceedings
- that the opposition division's decision to admit document D25 be overturned.

The respondent requested

- that the appeal be dismissed (main request), implying that the patent in suit be maintained on the basis of auxiliary request 4 as held allowable by the opposition division, or, in the alternative,
- that the patent in suit be maintained in amended form based on the sets of claims in any of
 - auxiliary request 1, filed with its reply to the statement of grounds of appeal,
 - auxiliary requests 2 and 3, filed with its letter dated 12 June 2018,
 - new auxiliary request 2, filed during the oral proceedings before the board
- that document A029 be admitted into the proceedings
- that the opposition division's decision to admit document D25 into the proceedings be confirmed.

VI. The appellant's arguments, where relevant to the present decision, can be summarised as follows.

Allowability of the amendments

The combination of features (d) and (f) in claim 1 of the main request and the first to third auxiliary requests was not directly and unambiguously disclosed

in the application as originally filed. This was because selections were necessary for both of these features, namely the selection of calcium from the list of metals in paragraph [0048] and the selection of the narrower concentration range for the friction modifier from paragraph [0077]. Furthermore, the application as originally filed contained no pointers to this combination of features. In particular, the examples could not serve as pointers to calcium because it was not clear whether or not the detergents used were carbonated (main request and the second and third auxiliary requests) or whether or not the detergents used were monosulfonated (first auxiliary request). The main request and the first to third auxiliary requests therefore did not meet the requirements of Article 123(2) EPC.

Admittance of the new second auxiliary request

The new second auxiliary request amounted to an amendment to the respondent's appeal case. Since the new second auxiliary request was identical to auxiliary request 3 of the decision under appeal, the respondent could and should have filed this request much earlier and set out why the decision under appeal was defective in this respect. This request being filed only at the oral proceedings took the appellant by surprise. In any case, there were no exceptional circumstances in this case justifying its admittance. The fact that a board arrived at a conclusion adverse to a party only during the oral proceedings had to be expected by the parties involved.

VII. The respondent's arguments, where relevant to the present decision, can be summarised as follows.

Allowability of the amendments

Claim 1 of the main request and the second and third auxiliary requests was based, *inter alia*, on the combination of claims 1 and 7 as originally filed. The limitation to the metal calcium in the detergent of feature (d) was not a selection from the list of metals in paragraph [0048] of the application as originally filed but just the deletion of the three other metals, restricting the required protection. In addition calcium was implicitly preferred. The examples provided a pointer in this respect. Similarly, claim 1 of the first auxiliary request was based, *inter alia*, on claim 1 and paragraph [0051] of the application as originally filed. Again, a selection of calcium was not necessary because the examples clearly pointed in this direction.

Compared with claim 1 as originally filed, the concentration of the friction modifier was limited in claim 1 of the main request and the first to third auxiliary requests. The respective ranges were, however, directly and unambiguously disclosed in paragraph [0077] of the application as originally filed. The application as originally filed also provided a pointer in this regard because the word "preferred" was only used sparingly in the application as originally filed, but specifically also in connection with the amount of friction modifier. The main request and the first to third auxiliary requests therefore did meet the requirements of Article 123(2) EPC.

Admittance of the new second auxiliary request

The new second auxiliary request was identical to auxiliary request 3 of the decision under appeal. As

far as the detergent from feature (d) was concerned, said auxiliary request 3 lacked the word "carbonated" and it was thus broader than that of the claims held allowable by the opposition division; however, it became apparent only at the oral proceedings that the board had a different view on the word "carbonated". The patent in suit would be revoked if the respondent was not allowed to remove this word when filing the new second auxiliary request. This revocation would be the direct consequence of an inadmissible amendment held allowable by the opposition division in the decision under appeal. Therefore, the new second auxiliary request was an exception to the prohibition of *reformatio in peius*. The new second auxiliary request was also filed in response to the conclusion at which the board arrived only during the oral proceedings, namely that the examples could not serve as a pointer for calcium because of a lack of an indication of carbonation. The deletion of the word "carbonated" was a straightforward and simple amendment. Consequently, the new second auxiliary request should be admitted.

Reasons for the Decision

Main request - Amendments (Article 123(2) EPC)

1. Claim 1 as originally filed reads as follows:

"A method for lubricating the hydraulic system of a farm tractor, comprising supplying thereto a lubricating composition comprising:

- (a) an oil of lubricating viscosity;*
- (b) at least one amine salt of a phosphorus acid ester;*
- (c) at least one thiadiazole compound;*
- (d) at least one overbased metal detergent;*

(e) at least one boron compound other than an overbased metal detergent;
(f) at least one friction modifier other than a boron compound;
said composition being substantially free from zinc dialkyldithiophosphate."

2. In comparison with the above claim, claim 1 of the main request has been amended as follows:

"A method for lubricating the hydraulic system of a farm tractor, comprising supplying thereto a lubricating composition comprising:

- (a) an oil of lubricating viscosity, **having a kinematic viscosity at 100°C of 1 to 10 mm²/s;**
(b) at least one amine salt of a phosphorus acid ester **wherein the amount of said amine salt is 0.04 to 4 percent by weight;**
(c) at least one thiadiazole compound **wherein the amount of said thiadiazole compound is 0.01 to 5 percent by weight;**
(d) at least one **carbonated** overbased metal **calcium sulfonate** detergent **wherein the amount of said carbonated overbased calcium sulfonate detergent is 0.05 to 6 percent by weight;**
(e) at least one boron compound other than an overbased metal detergent **wherein the amount of component (e) is sufficient to provide 40 to 4000 ppm B to the composition;**
(f) at least one friction modifier other than a boron compound, **wherein the amount of said friction modifier is 0.2 to 2 percent by weight of the lubricating composition;**
said composition being ~~substantially free from~~ **containing less than 0.5 percent by weight zinc dialkyldithiophosphate."**

Claim 1 of the main request thus relates to a method for lubricating the hydraulic system of a farm tractor using a specific lubricating composition. The lubricating composition is characterised, *inter alia*, in that it comprises the compounds listed under features (a) to (f).

3. It is clear from the previous point that a number of amendments were made to claim 1 as originally filed in order to arrive at claim 1 of the main request. In the board's view, the combination of features (d) and (f) in claim 1 of the main request cannot be derived directly and unambiguously from the application as originally filed.

3.1 Feature (d)

Feature (d) of claim 1 as originally filed relates to the "*overbased metal detergent*" of the lubricating composition. Claim 7 as originally filed, which refers back to claim 1 as originally filed, further specifies the detergent as comprising a "*carbonated overbased metal sulfonate*". It is this combination of claims 1 and 7 as originally filed which served as the respondent's starting point when discussing the amendment in feature (d).

Compared with this combination of claims as originally filed, feature (d) in claim 1 of the main request has been further limited to a "*carbonated overbased **calcium sulfonate detergent***" (emphasis added), i.e. claim 1 now stipulates the metal of the detergent to be calcium. The detergent component of the lubricating composition is discussed in more detail in paragraphs [0048] to [0054] of the application as originally filed, and

paragraph [0048] gives more information about its metal component. It reads as follows (emphasis added):

*"Another component of the present invention is a detergent. Detergents as used herein are metal salts of organic acids and are well-known from such publications as US 2004-0102335 and references cited therein. [...] The metal portion of the detergent is typically an alkali or alkaline earth metal. Suitable metals include sodium, **calcium**, potassium and magnesium."*

It is immediately evident that, in order to arrive at feature (d) of claim 1 of the main request, the metal calcium has to be selected from the list of equally suitable metals given in the last sentence of paragraph [0048].

3.2 Feature (f)

Feature (f) of claim 1 as originally filed relates to the friction modifier of the lubricating composition. This feature has been amended in claim 1 of the main request by additionally specifying the amount of the friction modifier to be *"0.2 to 2 percent by weight of the lubricating composition"*. As a basis for this amendment, the respondent pointed to paragraph [0077] of the application as originally filed. It reads as follows (emphases added):

*"The amount of the friction modifier is generally 0.1 to 10 percent by weight of the lubricating composition, preferably **0.2** to 4 or 0.3 to **2** or 0.5 to 1.5 percent."*

The above paragraph recites a broad range for the friction modifier ("*0.1 to 10 percent*") and three narrower ranges, namely "*0.2 to 4 percent*", "*0.3 to 2 percent*" and "*0.5 to 1.5 percent*". In this case, the word "preferably" is placed in front of the three narrower ranges and these are connected by an "or". This means that the three narrower ranges are equally preferred. To construct the range now recited in claim 1, the upper limit of the penultimate range has been combined with the lower limit of the third-to-last range. Even if it is assumed that, as argued by the respondent based on T 249/12 (point 3.1.3 of the Reasons), the range recited in claim 1 of the main request was directly and unambiguously derivable from the application as originally filed, its inclusion in claim 1 nevertheless still amounts to a selection of a more specific range from the application as originally filed.

4. Therefore, with respect to features (d) and (f) in claim 1 of the main request, a selection is to be made in each case from the disclosure of the application as originally filed, namely the selection of the metal calcium for the detergent and the selection of the more specific range of "*0.2 to 2 percent by weight of the lubricating composition*" for the friction modifier. It is established case law of the boards of appeal that such a double selection results in subject-matter which extends beyond the content of the application as originally filed, contrary to the requirements of Article 123(2) EPC.

5. The respondent put forward the following counter-arguments as to why the requirements of Article 123(2) EPC were met.

5.1 It argued that no selection of calcium was required from paragraph [0048] of the application as originally filed. Instead, the amendment to feature (d) was the result of the deletion of three of the four metals mentioned. Such a deletion was allowable.

This cannot be accepted. The selection of one particular item from a list is tantamount to the deletion of all the other items from the same list. Both lead to a particular item in the list being singled out (i.e. the metal calcium in this case). Such a selection/deletion may be allowable e.g. if it is the only amendment made, in which case it would have to be considered as a 'single selection'. In combination with a further selection, such as the selection of the amount of the friction modifier, however, allowability depends on whether the application as originally filed contains a pointer to the combination that is ultimately claimed.

The respondent argued in this context that this was exactly the case, i.e. that the application as originally filed contained pointers to the combination of features (d) and (f) in claim 1 of the main request. The word "*preferably*" was used very sparingly in the application as originally filed, namely only in respect of the viscosity of the lubricating oil in paragraph [0020] and in respect of the amount of the friction modifier in paragraph [0077]. This word was a pointer and, as was clear from features (a) and (f), these preferred aspects had been included in claim 1 of the main request. Furthermore, the examples in the application as originally filed provided a pointer towards the specific combination of features (d) and (f) in line with T 1621/16 (point 1.7.3 of the Reasons). The lubricating compositions in the examples

always contained only a calcium-based detergent (indicating a preference for calcium) and the amount of friction modifier contained therein fell within the range given for it in claim 1 of the main request.

This is not convincing. As concluded above, the three narrower ranges for the friction modifier in paragraph [0077] of the application as originally filed are equally preferred. The word "preferably" therefore cannot be considered as a pointer to one of these three ranges which are disclosed explicitly, or to a (possibly) implicitly disclosed range formed from their boundaries (see in this respect also T 2635/16, point 4.7 of the Reasons).

Furthermore, while the compositions in the examples of the application as originally filed do indeed contain a calcium-based overbased detergent, the examples provide no information whatsoever as to which means/agents were actually used for overbasing, or in other words whether the detergents of the compositions in the examples were carbonated as required by claim 1. Although the application as originally filed, as argued by the respondent, only mentions carbonation as a means for overbasing, it is not conclusive in this respect (paragraph [0053]: "**typically** facilitated by the addition of carbon dioxide", emphasis added) and specifically leaves this issue open to other means/agents. It is therefore not possible to conclude from the application as originally filed in a direct and unambiguous manner whether or not some of the compositions in the examples are in accordance with claim 1 of the main request. The fact that it cannot be determined whether or not the compositions of the examples of the application as originally filed are in accordance with claim 1 of the main request, and

consequently that the examples cannot be regarded as pointers to the combination of features (d) and (f) of claim 1 of the main request, distinguishes this case from the case underlying decision T 1621/16, on which the respondent relied (see points 1.7.3 and in particular 1.8.7 of the Reasons).

For the sake of completeness it is mentioned that the respondent also pointed to two declarations (D25 and A029) in its written submissions. These declarations essentially state that the compositions in the examples of the application as originally filed are in accordance with claim 1 of the main request, in particular because the detergents are carbonated. In its communication pursuant to Article 15(1) RPBA 2020 (last paragraph on page 10), the board had indicated that it considered these declarations to be irrelevant with regard to the requirements of Article 123(2) EPC because they merely reflected what the inventors may have done in carrying out the examples but did not form part of the application documents as originally filed. This was not contested by the respondent during the oral proceedings, who in fact was not relying on these declarations any longer. Consequently, there was no need to decide on the parties' requests relating to these two documents.

- 5.2 The respondent also pointed to decision T 1241/03 (point 7 of the Reasons) which held that (emphasis added):

"In the light of this disclosure in the application as originally filed the Board comes to the conclusion that claims to formulations comprising the compounds in question in specific concentrations do not need to have a literal basis

in a single passage of the application as originally filed, as long as the exact concentrations and ranges claimed for the specific substances are disclosed as such in the original application."

The respondent argued that the main request was allowable when following this rationale.

The board does not agree. Following the above sweeping statement, amendments which restrict the concentration of compounds mentioned in the claims as originally filed would always have to be found allowable, as long as only the corresponding concentrations or ranges are disclosed (somewhere) in the application as originally filed. This would indeed be in favour of the allowability of the combination of feature (f) with e.g. features (b), (c) and (e); however, in this case, it is the limitation of the concentration of the friction modifier in combination with the selection of calcium as the metal component of the detergent which gives rise to non-allowability, and not a multitude of limitations of concentrations. The above statement is therefore not relevant to this case.

In addition, the above statement was reached only after a detailed analysis of the disclosure of the application as originally filed, including its examples (see the emphasised part of the statement above and also T 1241/03: page 10, last paragraph and page 11, first paragraph). This casts reasonable doubt on whether this statement was intended to be understood as sweeping, as suggested by the respondent. In any event it is the board's position that even if, in the case of a claim amendment, each of several concentration ranges finds a potential basis in the application as

originally filed, an assessment still needs to be made as to whether or not the application as originally filed contains a pointer to the combination of concentration ranges which is ultimately claimed (similarly: T 1621/16, point 1.7.3 of the Reasons and T 1511/07, point 2.1 of the Reasons).

6. In summary, claim 1 of the main request does not meet the requirements of Article 123(2) EPC and the main request is not allowable.

First auxiliary request - Amendments (Article 123(2) EPC)

7. Claim 1 of the first auxiliary request differs from claim 1 of the main request only in that the detergent in feature (d) reads differently, namely as follows:

"(d) at least one overbased calcium monosulfonated alkylated benzene detergent [...]"

8. In this case, paragraph [0051] of the application as originally filed, which states that

"[s]uitable compositions thus include overbased monosulfonated alkylated benzene",

served as the respondent's starting point when discussing the amendment in feature (d). Compared with paragraph [0051] of the application as originally filed, claim 1 of the first auxiliary request has been further limited to an "overbased **calcium** monosulfonated alkylated benzene detergent" (emphasis added), i.e. claim 1 of the first auxiliary request again stipulates the metal of the detergent to be calcium. By analogy with claim 1 of the main request, the metal calcium still needs to be selected from the list of metals

given in paragraph [0048] of the application as originally filed. Furthermore, feature (f) has the same wording in claim 1 both of the main request and the first auxiliary request. Consequently, the reasoning given above for claim 1 of the main request also applies to claim 1 of the first auxiliary request, i.e. a double selection is necessary to arrive at the combination of features (d) and (f) in claim 1 of the first auxiliary request. For similar reasons as those given above for the main request, there are no pointers to the combination of features (d) and (f). In particular, the examples cannot serve as a pointer to calcium because, as argued by the appellant and not contested by the respondent, they do not specify the detergents used to be **monosulfonated**. Consequently, it is not possible to conclude from the application as originally filed in a direct and unambiguous manner whether or not some of the compositions in the examples are in accordance with claim 1 of the first auxiliary request. Claim 1 does not meet the requirements of Article 123(2) EPC and the first auxiliary request is not allowable.

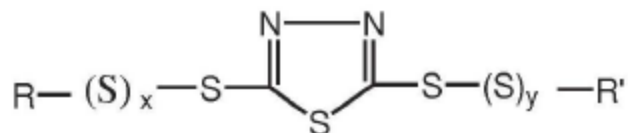
Second auxiliary request - Amendments (Article 123(2) EPC)

9. Claim 1 of the second auxiliary request reads as follows:

"A method for lubricating the hydraulic system of a farm tractor, comprising supplying thereto a lubricating composition comprising:

- (a) an oil of lubricating viscosity, having a kinematic viscosity at 100°C of 1 to 10 mm²/s;*
- (b) at least one amine salt of a phosphorus acid ester wherein the amount of said amine salt is 0.1 to 2 percent by weight;*

(c) at least one thiadiazole compound, wherein the thiadiazole compound has the following structure and the amount of said thiadiazole compound is 0.02 to 0.4 percent by weight:



wherein R and R' are the same or different hydrocarbyl groups, x and y are integers from 0 to 8 and the sum of x and y is at least 1, or wherien [sic] the thiadiazole compound is reacted with a nitrogen-containing dispersant, and the amount of said combined product is 0.2 to 2 percent by weight;

(d) at least one carbonated overbased calcium sulfonate detergent wherein the amount of said carbonated overbased calcium sulfonate detergent is 0.05 to 5 percent by weight;

(e) at least one boron compound other than an overbased metal detergent wherein the amount of component (e) is sufficient to provide 100 to 1000 ppm B to the composition;

(f) at least one friction modifier other than a boron compound, wherein the amount of said friction modifier is 0.2 to 2 percent by weight of the lubricating composition;

said composition containing less than 0.5 percent by weight zinc dialkyldithiophosphate."

Therefore, feature (f) of claim 1 of the second auxiliary request is identical to feature (f) of claim 1 of the main request. Furthermore, feature (d) still relates to a "carbonated overbased calcium sulfonate detergent". This means that two selections from the application as originally filed are still necessary, namely a selection of calcium for the metal component

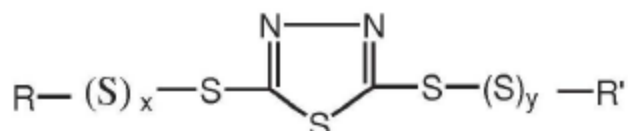
of the detergent (the fact that the concentration range for the detergent is slightly narrower when compared with that of claim 1 of the main request does not change this conclusion) and a selection of a narrower range for the friction modifier. For the reasons given above, without any pointers to this combination of features in the application as originally filed, such a double selection results in subject-matter which extends beyond the content of the application as originally filed. Claim 1 of the second auxiliary request does therefore not meet the requirements of Article 123(2) EPC and the second auxiliary request is not allowable.

Third auxiliary request - Amendments (Article 123(2) EPC)

10. Claim 1 reads as follows:

"A method for lubricating the hydraulic system of a farm tractor, comprising supplying thereto a lubricating composition comprising:

- (a) an oil of lubricating viscosity, having a kinematic viscosity at 100°C of 1 to 10 mm²/s;*
- (b) at least one amine salt of a phosphorus acid ester wherein the amount of said amine salt is 0.2 to 1 percent by weight;*
- (c) at least one thiadiazole compound, wherein the thiadiazole compound has the following structure and the amount of said thiadiazole compound is 0.03 to 0.1 percent by weight:*



wherein R and R' are the same or different hydrocarbyl groups, x and y are integers from 0 to 8 and the sum of x and y is at least 1,

or wherein the thiadiazole compound is reacted with a nitrogen-containing dispersant, and the amount of said combined product is 0.3 to 1 percent by weight;

(d) at least one carbonated overbased calcium sulfonate detergent wherein the amount of said carbonated overbased calcium sulfonate detergent is 0.1 to 2 or 1 to 5 percent by weight;

(e) at least one boron compound other than an overbased metal detergent wherein the amount of component (e) is sufficient to provide 200 to 800 ppm B to the composition;

(f) at least one friction modifier other than a boron compound, wherein the amount of said friction modifier is 0.3 to 2 percent by weight of the lubricating composition;

said composition containing less than 0.5 percent by weight zinc dialkyldithiophosphate."

11. Therefore, compared with claim 1 of the main request,

- feature (d) still relates to a "carbonated overbased calcium sulfonate detergent" (albeit in a narrower concentration range)
- in feature (f) the range for the friction modifier has been amended from "0.2 to 2 percent by weight" to "**0.3** to 2 percent by weight" (emphasis added).

This means that two selections from the application as originally filed are still necessary, namely a selection of calcium for the metal component of the detergent (again the fact that the concentration range for the detergent is slightly narrower when compared with that of claim 1 of the main request does not change this conclusion) and a selection of one of the

narrower ranges for the friction modifier mentioned in paragraph [0077] of the application as originally filed. For the reasons given above, without any pointers to this combination of features in the application as originally filed, such a double selection results in subject-matter which extends beyond the content of the application as originally filed. In view of this conclusion, it is irrelevant whether the concentration range in feature (f) is at the same level of preference as the concentration ranges in, for example, features (b), (c), (d) and/or (e), as submitted by the respondent. Therefore, claim 1 of the third auxiliary request does not meet the requirements of Article 123(2) EPC and the third auxiliary request is not allowable.

New second auxiliary request - Admittance (Articles 13(1) and 13(2) RPBA 2020)

12. During the oral proceedings before the board, the respondent filed a set of claims in a new second auxiliary request. The appellant requested that this request not be admitted into the proceedings.
13. Claim 1 of the new second auxiliary request reads as follows (shown below are the amendments compared with claim 1 of the main request, which is identical to auxiliary request 4 of the decision under appeal; see point V above):

*"A method for lubricating the hydraulic system of a farm tractor, comprising supplying thereto a lubricating composition comprising:
(a) an oil of lubricating viscosity, having a kinematic viscosity at 100°C of 1 to 10 mm²/s;*

(b) at least one amine salt of a phosphorus acid ester wherein the amount of said amine salt is 0.04 to 4 percent by weight;

(c) at least one thiadiazole compound wherein the amount of said thiadiazole compound is 0.01 to 5 percent by weight;

(d) at least one ~~carbonated~~ overbased calcium sulfonate detergent wherein the amount of said ~~carbonated~~ overbased calcium sulfonate detergent is 0.05 to 6 percent by weight;

(e) at least one boron compound other than an overbased metal detergent wherein the amount of component (e) is sufficient to provide 40 to 4000 ppm B to the composition;

(f) at least one friction modifier other than a boron compound, wherein the amount of said friction modifier is 0.2 to 2 percent by weight of the lubricating composition;

said composition containing less than 0.5 percent by weight zinc dialkyldithiophosphate."

Therefore, claim 1 of the new second auxiliary request differs from claim 1 of the main request and from claim 1 of auxiliary request 4 of the decision under appeal only in that the word "carbonated" has been removed from feature (d).

14. The respondent explained that the new second auxiliary request was identical to auxiliary request 3 of the decision under appeal.

According to the decision under appeal, auxiliary request 3 does not meet the requirements of Article 123(2) EPC because, contrary to claim 1 of auxiliary request 4, i.e. the main request on appeal, its claim 1 lacks the word "carbonated" in feature (d).

15. The respondent argued that it had not filed an appeal and that it was therefore limited as to the requests it could submit. The subject-matter of the new second auxiliary request was broader than that of the main request, at least as far as feature (d) of claim 1 was concerned. Therefore, had the respondent filed the new second auxiliary request earlier, it would probably have been objected to as violating the principle of prohibition of *reformatio in peius* and would probably not have been admitted.

However, the filing of the new second auxiliary request was in response to the conclusion at which the board arrived only during the oral proceedings. The board did not share the opposition division's view with regard to the word "*carbonated*" and came to the conclusion that the examples could not serve as a pointer for calcium because of a lack of an indication of carbonation. Not allowing the respondent to remove this feature on appeal would lead to the patent being revoked. This revocation would be the direct consequence of an inadmissible amendment held allowable by the opposition division in the decision under appeal. Therefore, the new second auxiliary request was an exception to the prohibition of *reformatio in peius* within the meaning of G 1/99 and the respondent should be allowed to remove the word "*carbonated*" from claim 1 of the main request. The deletion of the word "*carbonated*" was a straightforward and simple amendment. Consequently, the new second auxiliary request should be admitted.

16. The board does not accept these arguments. The summons to oral proceedings were issued on 8 May 2020. Therefore, pursuant to Article 25(1) and 25(3) RPBA

2020, Article 13 RPBA 2020 is applicable to this case. Article 13(1) and 13(2) RPBA 2020 stipulates that

"[a]ny amendment to a party's appeal case after it has filed its grounds of appeal or reply is subject to the party's justification for its amendment and may be admitted only at the discretion of the Board."

"[a]ny amendment to a party's appeal case made [...] after the notification of a summons to oral proceedings shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned."

- 16.1 The filing of a new auxiliary request during oral proceedings is to be considered as an amendment to the respondent's appeal case within the meaning of Article 13 RPBA 2020.
- 16.2 As stated by the respondent, the new second auxiliary request is identical to auxiliary request 3 before the opposition division. In its decision the opposition division concluded by back-reference to the main request that the feature "*overbased calcium sulfonate detergent*" in auxiliary request 3 extended beyond the content of the application as filed. Nothing would have prevented the respondent from filing the new second auxiliary request with its reply to the statement of grounds of appeal together with reasons as to why the decision under appeal was defective in this respect and why the auxiliary request was an admissible exception to the principle of prohibition of *reformatio in peius*. In fact, in view of Article 12(2) RPBA 2007 and 12(3) RPBA 2020, the respondent should have filed its

complete case, and thus a submission including the new second auxiliary request with its reply to the grounds of appeal.

16.3 Exceptional circumstances are not apparent in this case. The filing of a new claim request during the oral proceedings before the board cannot be excused with the fact that the board arrives at a conclusion which is adverse to a party (in this case the respondent) only at said oral proceedings, with the proviso of course that said conclusion is not based on facts or evidence submitted only during or shortly before the oral proceedings. This proviso does not apply in this case. More specifically, the amendment to feature d) to a carbonated overbased calcium sulfonate detergent has already been objected to by the appellant in the statement of grounds of appeal (points 5.7 to 5.9) and it was already pointed out there and throughout the written proceedings that the examples as originally filed were not according to the claims since, *inter alia*, they did not contain any information as to whether the detergent was carbonated (point 5.9).

16.4 With respect to the respondent's argument that it had not filed the new second auxiliary request earlier in order to avoid any violation of the prohibition of *reformatio in peius*, the board notes the following:

The new second auxiliary request either violates or does not violate the prohibition of *reformatio in peius*, and this is irrespective of the date it was filed. Whether such a violation exists does not have any bearing on the procedural requirement as laid down in Article 13(1) and 13(2) RPBA 2020. The board therefore does not see any reason why the prohibition

of *reformatio in peius* can justify the filing of the second auxiliary request only at the oral proceedings.

16.5 For the above reasons, the board decided not to admit the new second auxiliary request into the proceedings pursuant to Article 13(1) and 13(2) RPBA 2020.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated