

Veröffentlichung im Amtsblatt	Ja/Nein
Publication in the Official Journal	Yes/No
Publication au Journal Officiel	Oui/Non



Aktenzeichen:
Case Number: T54/82
N° du recours :

ENTSCHEIDUNG / DECISION

vom / of / du 16 May 1983

Anmelder:
Applicant: Mobil Oil Corporation
Demandeur :

Stichwort:
Headword: Disclosure/Mobil Oil
Référence :

EPÜ / EPC / CBE Article 123(2), Rule 86

"Disclosure - Combining separate features"

Leitsatz / Headnote / Sommaire

An objection under Article 123(2) does not necessarily arise when an amendment is proposed which involves combining separate features of the original subject matter of an application. When considering whether different parts of the description in an application may properly be read together, the state of the art may also be taken into account.

Europäisches
Patentamt

Beschwerdekammern

European Patent
Office

Boards of Appeal

Office européen
des brevets

Chambres de recours



Case Number: T 54 / 82

DECISION

of the Technical Board of Appeal 3.3.1

of 16 May 1983

Appellant: MOBIL OIL CORPORATION
150 East 42nd Street
New York New York 10017
U S A

Representative: A.J. Jones
CARPMAELS & RANSFORD
43 Bloomsbury Square
London WC1A 2RA
England

Decision under appeal: Decision of Examining Division 006 of the European Patent
Office dated 26 October 1981 refusing European patent
application No 78300423.7 pursuant to Article 97(1)
EPC

Composition of the Board:

Chairman: D. Cadman
Member: H. Robbers
Member: L. Gotti Porcinari

I Summary of facts and submissions

1. European patent application 78 300 423.7 filed on 27 September 1978, published on 18 April 1979 (publication number 0 001 492) and claiming priority of 3 October 1977 on the basis of an American application Serial No. 838591, was refused by decision of Examining Division 006 of the European Patent Office, dated 26 October 1981. That decision was based on claims 1-2 received on 21 May 1980.

The ground for refusal was that the proposed amendment in claim 2 offended against the terms of Article 123(2) in that it introduced subject matter which extended beyond the content of the application as filed.

2. On 14 December 1981 the appellant lodged an appeal against the decision. On 10 February 1982 the appellant submitted a Statement of Grounds. The appeal fee was duly paid.

The claims filed on 21 May 1980 and the original description as amended on that date were still effective at the date of lodging of the appeal. On 17 November 1982, a small amendment was made by the applicant on page 1, line 8 and page 5, line 6 of the description and in claim 1, line 5, to the effect that "a C₁₈₋₂₄ dimer alkenylsuccinic mono-oxazoline" was replaced by "an alkenylsuccinic mono-oxazoline in which the alkenyl group contains from 18-24 carbon atoms". By telephone call on 21 February 1982 it was agreed that the amendment on page 5, line 6 has to be reversed.

The present claims read as follows:

1. A lubricant composition comprising a major amount of an oil of lubricating viscosity or a grease of lubricating viscosity and a minor amount of an oxazoline additive characterized in that the oxazoline additive is an alkenylsuccinic mono-oxazoline or an alkenylsuccinic bis-oxazoline in which the alkenyl group contains from 18-24 carbon atoms, and is present in a load-carrying amount.

2. The composition of Claim 1 wherein the additive is an isooctadecenylsuccinyl bis-oxazoline.

The original claims were:

1. A lubricant composition comprising a major amount of an oil of lubricating viscosity or greases thereof and a load-carrying amount of an additive selected from the group consisting of a naphthenyl oxazoline, an alkenylsuccinic mono-oxazoline and an alkenylsuccinic bis-oxazoline.

2. The composition of Claim 1 wherein the additive is a naphthenyl oxazoline.

3. The composition of Claim 1 wherein the additive is an isooctadecenylsuccinyl bis-oxazoline.

4. The composition of Claim 1 wherein the additive is a C₁₈₋₂₄ dimer alkenylsuccinyl mono-oxazoline.

3. The appellant has requested that the decision of the Examining Division be cancelled and the appeal fee refunded.

II Reasons for the decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC. It is therefore admissible.

2. The decision of the Examining Division is based upon the consideration that it is not permissible to combine the disclosure at page 1 of the specification as initially filed, that the oxazolines were made by reacting one mole of the acid with one or two moles of the amino-methane, and the disclosure in original example 3 of the use of a C₁₈₋₂₄ acid. This consideration is based on the assumption that the test for additional subject-matter corresponds to the test for novelty and that in considering novelty, it is not permissible to combine separate items of information, including separate parts of the same document.

The appellant contests both assumptions. In certain circumstances, he argues, it should be permissible to combine separate items of information, even if originating from different documents. The interpretation that it would not be permissible to combine separate parts of the same document is not countenanced by the Convention and is contrary to the basic rules for the interpretation of documents which rules include that documents must be read fairly and as a whole.

3. The Board of Appeal agrees with the appellant that there is nothing in the Convention which prohibits in all circumstances the reading together of different parts of a single document. Indeed the Examining Division itself stated in its decision (page 2, lines 22-27):

"An amendment is regarded as introducing subject matter which extends beyond the content of the application as filed if the overall change in the content of the

application results in the skilled person being presented with information which differs from that previously presented in the specification". This necessarily means that it depends upon the view of the skilled person whether or not it would be permissible to combine the disclosure of two separate parts of the specification. An absolute prohibition of such a combination therefore cannot be seen as a consequence of the aforementioned statement.

4. The characterising part of the pending claim 1 is that a C_{18-24} alkenylsuccinic mono-oxazoline or a C_{18-24} alkenylsuccinic bis-oxazoline is present in a lubricant composition. The argument is about the C_{18-24} alkenylsuccinic bis-oxazoline.

In the original specification alkenylsuccinic mono-oxazolines as well as alkenylsuccinic bis-oxazolines are disclosed in general. According to page 1, lines 13-16, they are prepared by reacting one mole of a C_{10-50} alkenylsuccinic acid with one mole (which gives rise to a mono-oxazoline) or two moles (which gives rise to a bis-oxazoline) of tris(hydroxymethyl)aminomethane (or THAM).

There is a specific disclosure of isooctadecenyl succinic bis-oxazoline, a C_{18} alkenylsuccinic bis-oxazoline; in the original example 2 (now example 1) and the original claim 3 (now claim 2). In example 3 (now example 2) the reaction 1 mol C_{18-24} dimer alkenylsuccinic anhydride with 1 mol THAM is disclosed, which leads to a C_{18-24} dimer alkenylsuccinic mono-oxazoline. According to page 1, lines 13-16 of appellant's letter from 17 November 1982, this product is a

mixture of individual C₁₈₋₂₄ compounds, the C₁₈₋₂₄ moiety originating from a commercially available mixture and the term "dimer" denoting the source thereof. In claim 1 a C₁₈₋₂₄ alkenylsuccinic mono-oxazoline is claimed, which includes all individual C₁₈₋₂₄ members involved as well as mixtures thereof. Example 3 (now example 2) is considered to be a sound basis for this part of the claim. The question whether or not the disclosure of a C₁₈₋₂₄ alkenylsuccinic mono-oxazoline implicitly discloses a C₁₈₋₂₄ alkenylsuccinic bis-oxazoline, in this case should be answered taking into account whether or not a distinction was made between the mono- and bis-oxazolines. On the basis of the original specification, such a distinction cannot be said to exist.

5. In his statement of grounds, the appellant, rightly in the view of the Board, states that in answering the aforementioned question, the state of the art may be taken into account, too. From this state of the art, the only conclusion that can be drawn is that alkenylsuccinic mono- and bis-oxazolines go hand in hand. French patent specification No. 2 281 423 discloses the reaction of one mole of an alkenylsuccinic anhydride and one mole of THAM to provide a mono-oxazoline in example 2, and with two moles of THAM to provide a bis-oxazoline in example 3. According to page 2 lines 27-28, the quantity of THAM can even vary from 0,05 to 5 moles. US patent specification No. 4 035 309 discloses the preparation of a mono- and bis-oxazoline (claim 1, column 3, lines 55-59). A mono-oxazoline derived from THAM (column 3, lines 49-50) is disclosed in claim 8 (see also column 5, lines 16-20), and an equivalent bis-oxazoline in claims 2, 6 and 10.

6. Only the appellant's argument that disclosure of C_{10-50} implicitly discloses C_{18-24} fails. Disclosure of C_{10-50} discloses a summation of all individual members $C_{10} \dots C_{11} \dots C_{50}$ indeed. However, the difference is that C_{18-24} discloses a summation of the members $C_{18} \dots C_{19} \dots C_{24}$ disregarding all members outside this area whereas C_{10-50} discloses a summation of all individual members comprised without disregarding any of them.
7. As a matter of fact claim 1 is broader than the claim 1 effective at the date of lodging of the appeal since the term "dimer" in "a C_{18-24} dimer alkenylsuccinic mono-oxazoline" is deleted. This is accepted by the Board as an admissible correction of an obvious error. As stated in the appellant's letter of 27 November 1982, page 1, lines 13-16, the term "dimer" denotes the composition's derivation rather than its final structure. Since the mono- and bis-oxazolines go hand in hand, a distinction of this kind between them is not logical.
8. Reimbursement of appeal fees may be ordered where a Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation: Rule 67 EPC. Since the decision of the Examining Division is based only upon an incorrect consideration such a violation cannot be said to exist. It follows that the request for reimbursement of the appeal fee made in the statement of grounds of 10 February 1982 must be rejected.

ORDER

The Board rules that the amendment in claim 1 does not violate Article 123(2) EPC and considers the appeal allowable. It is decided that:

1. The decision of Examining Division 006 of the European Patent Office dated 26 October 1981 is set aside.
2. The case is remitted to the first instance, with the order to reconsider it on the basis of the decision of the Board. The documents to be valid are:

pages 1 and 5 filed on 19 November 1982, pages 2-4 filed on 21 May 1980, with the one and only difference that the term "dimer" on page 5, line 6 has to be restored.

3. The request for reimbursement of the appeal fee made in the appellant's statement of grounds of 10 February 1982 is rejected.

The Registrar:

J. Rbe

The Chairman:

D. Cadman