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Aktenzeichen / Case Number / N° du recours : T 59/87 - 3.3.1

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Veröffentlichungs-Nr. / Publication No / N° de la publication : 0 036 708

Bezeichnung der Erfindung: Friction reducing additives and compositions
Title of invention: thereof.
Titre de l'invention :

Klassifikation / Classification / Classement : C10M 1/54

ENTSCHEIDUNG / DECISION

vom / of / du 14 August 1990

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Mobil Oil Corporation

Einsprechender / Opponent / Opposant :

Chevron Research Company

Stichwort / Headword / Référence : Friction reducing additives/MOBIL IV.

EPO / EPC / CBE Article 54

Schlagwort / Keyword / Mot clé :

"Novelty of a second non-medical use with same technical means of execution" - "Compounds disclosed for use as rust inhibitors in oil compositions" - "No disclosure of the use of such compounds as friction reducing additives for oil compositions" - "Claimed invention not made available to the public".

Leitsatz / Headnote / Sommaire

Headnote follows

Europäisches
Patentamt

Beschwerdekammern

European Patent
Office

Boards of Appeal

Office européen
des brevets

Chambres de recours



Case Number : T 59/87 - 3.3.1

DECISION
of the Technical Board of Appeal 3.3.1
of 14 August 1990

Appellant : Mobil Oil Corporation
(Proprietor of the patent) 150 East 42nd Street
New York N.Y. 10017 (US)

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Respondent : Chevron Research Company
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San Francisco
California 94120 (US)

Representative : Kosmin, Gerald Emmanuel
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Decision under appeal : Decision of Opposition Division of the European Patent
Office dated 18 December 1986 revoking European patent
No. 0 036 708 pursuant to Article 102(1) EPC.

Composition of the Board :

Chairman : K.J.A. Jahn
Members : R.W. Andrews
G.D. Paterson

Summary of Facts and Submissions

- I. In response to a notice of opposition, the Opposition Division revoked the European patent on the ground that the subject-matter of the claims in accordance with the main request did not involve an inventive step. The Opposition Division also held that the claims in accordance with the auxiliary request were not allowable under Article 123 EPC.

- II. An appeal was filed against this Decision, and during oral proceedings in the appeal which were held on 26 April 1988, the Board decided to reject the Appellant's main and second auxiliary requests and to refer certain questions of law to the Enlarged Board of Appeal under Article 112(1) EPC. The other requests of the parties (namely, the Appellant's first auxiliary request and the Respondent's request that the appeal be dismissed) were stayed pending the decision of the Enlarged Board. Two interlocutory written decisions dated 26 April 1988 (Friction reducing additives/MOBIL I and II) were subsequently issued giving reasons for the Board's decisions.

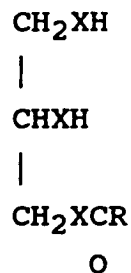
- III. In its Decision G 2/88 (Friction reducing additive/MOBIL III) of 11 December 1989 (OJ EPO 1990, 93), the Enlarged Board of Appeal held that an amendment of granted claims directed to "a compound" and to "a composition including such compound" so that the amended claims are directed to "the use of that compound in a composition" for a particular purpose is not open to objection under Article 123(3) EPC. It was also decided that a claim to the use of a known compound for a particular purpose should be interpreted as including the disclosed technical effect as a functional technical feature, and is accordingly not open to objection under

Article 54(1) provided such technical feature has not previously been made available to the public.

- IV. Subsequently, observations were filed on behalf of both parties. In particular, the Respondent contended that the claimed invention did not recite a new technical effect which could be regarded as a technical feature of the invention and, therefore, lacked novelty. Furthermore, the claimed invention lacked inventive step.

Finally by a communication filed on 3 August 1990, the Appellant requested that the patent be maintained on the basis of Claims 1 to 3, the only independent claim of which corresponds to the main claim of the first auxiliary request filed on 6 April 1988 but amended as a consequence of the Board's previous findings and reads as follows:

"Use of at least 1% by weight based on the total composition of a borated glycerol ester or borated thioglycerol ester produced by borating a glycerol ester or thioglycerol ester of the formula:



wherein each X is S or O, and R is a hydrocarbyl group of from 8 to 24 carbon atoms, as a friction reducing additive in a lubricant composition comprising a major portion of a lubricating oil."

Reasons for the Decision

1. In view of the Decision G 2/88 previously referred to, there are no formal objections under Article 123 EPC to the present claims.
2. The present claims are directed to the use of known borated glycerol or thioglycerol esters for use as friction reducing additives in lubricant compositions.

According to the above-mentioned decision of the Enlarged Board of Appeal, the claimed subject-matter may be considered to be novel provided that the originally disclosed friction reducing properties of the borated glycerol or thioglycerol esters had not been previously made available to the public.

- 2.1 Document (1), which is concerned with lubricant compositions having improved antioxidant and anticorrosion properties comprising complexes of boric acid with glycols and polyhydroxybenzenes, is wholly silent with respect to borated glycerol or thioglycerol esters. Therefore, the claimed subject-matter is novel having regard to the disclosure of this document.
- 2.2 Document (2) discloses rust inhibited lubricating oil compositions comprising 0.001 to 10% by weight of borated triol monoesters (cf. Claim 1 in combination with column 1, lines 32 to 40, column 2, lines 23 to 34 and lines 39 to 48 and column 3, lines 70 to 75). In particular, oil compositions comprising 0.5, 0.1 and 0.001% by weight of a borated glycerol monooleate are described (cf. column 9, lines 15 to 35 in combination with Examples IV and IX). Thus the use of a composition within Claim 1 of the present patent as set out above is disclosed in this prior document.

2.3 The Respondent has relied upon the fact that the use of the composition disclosed in document (2) in the manner also disclosed therein for the purpose of inhibiting rust would inevitably reduce friction as well and would therefore have been a use of the composition as claimed in the opposed patent. On this basis he has contended that document (2) inherently discloses the claimed invention and thereby destroys its novelty.

However, in Decision G 2/88 it was emphasised in paragraph 10.1 that the question to be decided is what has been made available to the public, not what may have been inherent in what was made available to the public. Furthermore, as emphasised in paragraph 10, when considering how far the teaching in a written description also makes available to the public the inevitable result of carrying out such teaching, in each case "a line must be drawn between what is in fact made available and what remains hidden or otherwise has not been made available". Thus, whether a previously undisclosed technical effect which in fact inevitably occurs when a previously disclosed technical teaching in a written description is carried out has been made available to the public by reason of the teaching in the written description is a question of fact which has to be decided in the context of each individual case.

2.4 In the present case document (2) does not contain any technical teaching to the effect that the disclosed composition will reduce friction. Thus, the test described in the paragraph bridging columns 8 and 9 of this document to evaluate the ability of additives to aid in preventing the rusting of ferrous metal parts in the presence of water would not allow the skilled person to draw any conclusion with respect to their friction reducing capacity. Furthermore, the statement in document

(2) that the rusting of ferrous metal parts and the presence of the resulting rust particles in the lubricating oil may create uneven contact of moving parts with resulting increased friction (cf. column 1, lines 33 to 40) would not make available to the skilled person the use of rust inhibitors to reduce friction since, in the Board's judgment, prevention of an increase in friction cannot be equated with a reduction in friction.

- 2.5 Additionally, in the absence of any tests such as the one described in the disputed patent to measure the friction of test lubricants, the skilled person would remain unaware that borated glycerol or thioglycerol esters not only prevent rust formation in lubricant compositions but also serve as friction reducing additives.

Therefore, in the Board's judgment, the use of at least 1% by weight based on the total composition of borated glycerol or thioglycerol esters produced by borating the compounds of the formula in Claim 1 as a friction reducing additive in lubricant compositions has not been made available to the public before the claimed priority date of the disputed patent. Consequently, the claims of the request currently before the Board are novel.

3. In paragraph 6 of its Decision of 26 April 1988 (Friction reducing additive/MOBIL II), the Board held that the use of borated glycerol or thioglycerol esters as a friction reducing additive was inventive in the light of the cited prior art for the reasons there set out. The only issues which were not decided by the Board in its previously issued Decision, were those concerning amendment and novelty, the subject of the referred questions. In this circumstance, and in light of what is set out above, the ground of opposition under Article 100(a) EPC is rejected.

Order

for these reasons, it is decided that:

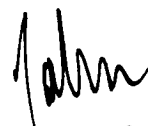
1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division with the order to maintain the patent on the basis of Claims 1 to 3 filed on 3 August 1990 and a description to be brought into agreement with the amended claims.

The Registrar:



M. Beer

The Chairman:



K.J.A. Jahn

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