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# D E C I S I O N
# of 17 July 2003

**Case Number:** T 0087/99 - 3.3.1

**Application Number:** 92913376.7

**Publication Number:** 0537338

**IPC:** C10M 163/00

**Language of the proceedings**: EN

**Title of invention:**
Thermally stable compositions and lubricants and functional fluids containing the same

**Patentee:**
The Lubrizol Corporation

**Opponent:**
Exxon Chemical Patents Inc.

**Headword:**
Lubricant additives/LUBRIZOL

**Relevant legal provisions:**
EPC Art. 114(2)
EPC R. 71(a)(1)

**Keyword:**
"Admissibility of a late-filed document (no) - refusal to admit in line with the relevant provisions of the EPC"

**Decisions cited:**
-

**Catchword:**
-

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

**Case Number:** T 0087/99 - 3.3.1

# D E C I S I O N
**of the Technical Board of Appeal 3.3.1**
**of 17 July 2003**

**Appellant:** (Opponent)
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**Representative:**
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**Respondent:** (Proprietor of the patent)
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**Decision under appeal:**
**Decision of the Opposition Division of the European Patent Office posted 26 November 1998 rejecting the opposition filed against European patent No. 0537338 pursuant to Article 102(2) EPC.**

**Composition of the Board:**

**Chairman:** P. P. Bracke
**Members:** J. M. Jonk
S. U. Hoffmann

## Summary of Facts and Submissions

I. The Appellant (Opponent) lodged an appeal against the decision of the Opposition Division rejecting the opposition against the European patent No. 0 537 338 (European patent application No. 92 913 376.7), the independent Claim 1 for the designated Contracting States except Spain reading as follows:

II. "A composition comprising:

(A) at least one basic alkali or alkaline earth metal salt of an acidic organic compound or mixtures thereof;

(B) at least one metal deactivator other than dimercaptothiadiazole or derivatives thereof; and

(C) at least one hydrocarbyl phosphite,

wherein the ratio of the equivalents of (A) based on total base number to the equivalents of (C) based on phosphorus atoms is at least one,

provided that the composition is free of zinc dithiophosphate and provided that when (A) is a basic magnesium salicylate then the composition contains (D) up to 0.40% by weight of a sulfur-, phosphorus- or sulfur- and phosphorus-containing antiwear agent."

III. The opposition was filed against the patent as a whole, and based on the grounds of lack of novelty and lack of inventive step as indicated in Article 100(a) EPC. It was supported by several documents including:

(5) WO 89/04358.

IV. The Opposition Division held that the subject-matter of the patent in suit was novel and also involved an inventive step. In this context, it decided not admit the late-filed document

(6) STLE LUBRICATION ENGENEERING, Volume 46, 8, 511 to 518,

to the proceedings, since this document was less relevant than document (5). Said document (5) had to be considered as the closest prior art, because it concerned the same technical problem as the patent in suit and disclosed compositions having the most features in common.

V. Oral proceedings before the Board were held on 17 July 2003. The Appellant, who had been duly summoned, did not attend the oral proceedings.

VI. The Appellant accepted that the claimed subject-matter of the patent in suit was novel over the cited prior art and that it involved inventive step in the light of document (5).

However, he argued that document (6), which was filed a little less than one month before the oral proceedings, was relevant in assessing inventive step and therefore had to be considered by the Opposition Division. In fact, the claimed subject-matter lacked inventive step in view of this document, since it disclosed zinc free compositions showing a good thermal stability for copper corrosion control and having the same alkaline earth metal to phosphorus ratios as exemplified in the patent in suit. Moreover, this document also suggested that basic calcium sulphonate was a suitable source of calcium and that phosphites were a proper source of phosphor.

VII. The Respondent (Patentee) argued with respect to the admissibility of document (6) to the proceedings that this document was not concerned with the same technical problem as the patent in suit, since it essentially related to a comparison of zinc containing and non-zinc automatic transmission fluids. Moreover, like document (5), it did not suggest the ratio of the equivalents of a basic alkali or alkaline earth metal salt of an acidic organic compound or mixtures thereof (component (A)) to the equivalents of a hydrocarbyl phosphite (component (C)) of at least one as claimed in Claim 1 of the patent in suit in order to achieve an improved thermal stability and consequently a reduced corrosion of the device components. Therefore, this document would not be detrimental to inventive step anyway.

VIII. The Appellant requested in writing that the decision under appeal be set aside and that the patent be revoked, or that the case be remitted to the Opposition Division for consideration of inventive step over document (6).

The Respondent requested that the appeal be dismissed and that the patent be maintained, or that the case be remitted to the Opposition Division for further consideration of document (6).

IX. At the conclusion of the oral proceedings the Board's decision was pronounced.

## Reasons for the Decision

1. The appeal is admissible.

2. Having regard to the decision of the Opposition Division and the submissions of the parties to this procedure, the Board firstly notes that it is not in dispute that the claimed subject-matter of the patent in suit is novel and involves an inventive step over document (5).

2.1 In this context, the Board agrees with the Opposition Division with respect to inventive step:

(a) that document (5) represents the closest state of the art,

(b) that the technical problem underlying the patent in suit in light of this closest prior art is the

provision of compositions useful as additives for lubricants and functional fluids, particularly hydraulic fluids, which do not contain zinc dithiophosphate, but nevertheless are not corrosive to system components due to their improved thermal stability,

(c) that the solution of this problem as claimed in the patent in suit involves, in particular, the condition that the ratio of the equivalents of a basic alkali or alkaline earth metal salt of an acidic organic compound or mixtures thereof (component (A)) to the equivalents of a hydrocarbyl phosphite (component (C)) has to be at least one,

(d) that this problem has been credibly solved in view of the test-report submitted by the Appellant by letter dated 15 July 1994 showing the advantageous effect of said ratio on the thermal stability of the compositions, and

(e) that this solution cannot be derived from document (5).

2.2 Moreover, the Appellant did not argue anymore that other prior art than the cited documents (5) and (6) would be relevant in this context.

3. Therefore, the substantial issue to be dealt with is whether or not document (6) should have been admitted to the proceedings by the Opposition Division in exercising its discretionary power governed by Article 114(2) and Rule 71a(1) EPC.

3.1 The purpose of Rule 71a(1) EPC is, in particular, to avoid that departments of the EPO entrusted with substantive examination and other parties in opposition proceedings are surprised by new facts or evidence, so that at the end of the oral proceedings a decision closing the case can be reached.

In this context, the Board notes that the power of the EPO to accept or refuse late filed new facts or evidence is in fact governed by Article 114(2) EPC, and that said Rule 71a(1) does not restrict the EPO's discretion under this Article, but supplements the line already developed by the Boards of Appeal to deal with abuse of procedure, i.e. to refuse to consider facts or evidence put forward late for no good reason (see the Explanatory Memorandum from the President of the EPO, OJ EPO 1995, pages 418 and 419).

Moreover, the Board notes that it is desirable that the procedures before the EPO be as efficient as possible. It would not be conducive to this end if the discretionary power conferred by Rule 71a(1) EPC was exercised in a purely formalistic way so that the European Patent Office refused to consider a late-filed document on the sole ground that it had not been filed by a final date stated in a summons to oral proceedings. The result would be that an appeal would be necessary, in which such a document had to be considered by a Board of Appeal on its relevance in order to examine whether the first instance had used its discretionary power in a proper way and, possibly, would then be allowed into the proceedings and, finally, the matter

would be remitted to the first instance, causing expense and delay.

3.2 In the present case, the Opposition Division refused to admit document (6), which was filed a little less than one month before the oral proceedings, for the reason that document (5) had to be considered as the closest prior art and as a consequence was more relevant than document (6).

However, the question of the admissibility of document (6) to the proceedings is not whether document (6) would be more or less relevant than document (5), but rather whether document (6) alone or in combination with said document (5) would be *prima facie* sufficiently relevant to potentially represent an obstacle to the maintenance of the patent in suit.

3.3 It is true, that document (6) suggests the use in closely related non-zinc compositions of (i) alkyl phosphite/phosphate for minimising wear (see Table 5), (ii) calcium in the form of overbased calcium sulphonate (see Table 8, fluid H, and the last paragraph under "Oxidative Stability"), and (iii) metal corrosion control inhibitors (see Table 5) having the same function as component (B) as claimed in the patent in suit.

However, like document (5), it clearly does not provide any incentive to the skilled person to the claimed solution of the technical problem underlying the patent in suit, which comprises as an essential feature the condition that the ratio of the equivalents of a basic alkali or alkaline earth metal salt of an acidic

organic compound or mixtures thereof (component (A)) to the equivalents of a hydrocarbyl phosphite (component (C)) has to be at least one.

In this context, the Board observes that the Appellant's submissions that document (6) discloses the use of alkyl phosphite/phosphate in non-zinc compositions (see Table 5), and that - as supported by calculations filed by him on 23 March 1999 - such compositions had the same alkaline earth metal to phosphorous ratios as exemplified in the patent in suit, are not relevant, since the ratio as claimed in the patent in suit does not relate to the total amount of equivalents of phosphate and phosphite but to the equivalents of a hydrocarbyl phosphite.

Therefore, the Board concludes that document (6) alone or in combination with document (5) indeed does not *prima facie* appear sufficiently relevant to potentially represent an obstacle to the maintenance of the patent in suit, and that in the clear-cut situation of the present case - although in view of the Board's considerations under points 3.1 and 3.2 above the reasoning in this respect was incomplete and the power of discretion to admit document (6) to the proceedings might have been applied in another way - the Opposition Division did not offend the provisions of Article 114(2) and Rule 71(a)(1) EPC.

4. In view of this conclusion, and in the light of the considerations under points 2 to 2.2 above, it is not necessary to deal with the alternative requests of the parties to the proceedings to remit the case to the

Opposition Division for consideration of inventive step over document (6).

## Order

## For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

P. Cremona P. P. Bracke