

**Case Background:**

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.

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.

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.

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.

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.

#### Questions:

mention that the person is skilled in making the product;

1. Who is the skilled person mentioned in the final paragraph? skilled in using the product
2. What made the second 'invention' patentable? slide 13
3. How is the decision for this case justified?

#### References:

T 0059/87 (Friction reducing additives/MOBIL IV) of 14.8.1990

<https://www.epo.org/law-practice/case-law-appeals/recent/t870059ex2.html>