

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [] To Chairmen
(D) [X] No distribution

**Datasheet for the decision
of 30 April 2012**

Case Number: T 1344/10 - 3.2.03

Application Number: 99913750.8

Publication Number: 1068403

IPC: E02D 7/28, B63B 21/27

Language of the proceedings: EN

Title of invention:
Marine structure

Patentee:
Suction Pile Technology B.V.

Opponent:
Technip France

Headword:
-

Relevant legal provisions:
EPC Art. 100(c)

Keyword:
"Added subject-matter (no)"
"Remittal to the first instance for further prosecution"

Decisions cited:
-

Catchword:
-



Case Number: T 1344/10 - 3.2.03

D E C I S I O N
of the Technical Board of Appeal 3.2.03
of 30 April 2012

Appellant: Suction Pile Technology B.V.
(Patent Proprietor) Korenmolenlaan 2
NL-3447 GG Woerden (NL)

Representative: Assendelft, Jacobus H.W.
Keukenhofdreef 20
NL-2161 AZ Lisse (NL)

Respondent: Technip France
(Opponent) 6-8, Allée de l'Arche
Faubourg de l'Arche
ZAC Danton
F-92400 Courbevoie (FR)

Representative: Bertrand, Didier
S.A. Fedit-Loriot
38 Avenue Hoche
F-75008 Paris (FR)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 29 April 2010
revoking European patent No. 1068403 pursuant
to Article 101(3)(b) EPC.

Composition of the Board:

Chairman: U. Krause
Members: E. Frank
K. Garnett

Summary of Facts and Submissions

I. The appeal lies from the decision of the Opposition Division dated 15 April 2010 and posted on 29 April 2010 to revoke the European patent No. 1 068 403 pursuant to Article 101(3)(b) EPC for reasons of extended subject-matter, Article 100 (c) EPC. The Opponent II withdrew its opposition on 31 March 2010, and is not party to the appeal proceedings as of right.

II. The Appellant (Proprietor) filed a notice of Appeal on 23 June 2010, paying the appeal fee on the same day. The statement of grounds of appeal was submitted on 30 August 2010.

III. The Appellant requested that the decision under appeal be set aside and the patent be maintained as granted, or, alternatively, on the basis of the claims according to the first, second, third, or fourth auxiliary requests (as filed with the grounds of appeal). The Appellant further requested that oral proceedings be held, and that the case be remitted to the Opposition Division for deciding on the objections based on Articles 100 (a) and (b) EPC.

The Respondent (Opponent I) requested that the appeal be dismissed.

IV. The claims of the main request (as granted), insofar as they were objected to, read as follows:

"1. Self floating and self-foundating marine structure floating in a body of water and comprising:

a foundation part with one or more suction piles (1) for embedment into the subsea bottom (2); and
a construction above said foundation part, said construction having insufficient buoyancy to keep itself floating, said construction being configured to bear on said foundation part when the marine structure is installed into the subsea bottom, buoyancy means providing buoyancy such that the overall structure has buoyancy sufficient such that the structure as a whole can be transported over water independently floating, particularly in an upright position, whereby the required buoyancy is at least partly provided by the suction piles."

"9. Method of installing a marine structure onto the subsea bottom by providing: a foundation part with one or more suction piles (1) for embedment into the subsea bottom (2); a construction above said foundation part, said construction having insufficient buoyancy to keep itself floating in a body of water, said construction being configured to bear on said foundation part when the marine structure is installed into the subsea bottom; buoyancy means providing buoyancy such that the overall structure has buoyancy sufficient such that the structure as a whole can be transported over water independently floating, particularly in an upright position; whereby the suction piles provide at least a part of the required buoyancy; allowing the overall structure to independently float into a body of water; and together lowering said foundation part and said construction by decreasing its buoyancy while floating

in said body of water such that the suction piles are lowered onto the subsea bottom."

"11. Suction pile (1), comprising at least one floating space (1) being part thereof containing a floating substance, said one or more floating spaces (11) being designed to provide in combination the required buoyancy such that the suction pile (1) is able to float independently in a body of water."

V. In respect of the main request, the parties submitted the following arguments:

(a) The Respondent argued that the word "construction" in claim 1 was nowhere used in the description as filed. Although the word "body" could be found in the description, it was not clearly and unambiguously derivable for the skilled person whether the term "construction" in claim 1 corresponded to such a "body", or had to be understood in a broader sense. Moreover, based on the repeatedly used word "foundation" in the original description, it was impossible to determine the existence of a "foundation part" and its shape. Apart from that, "self founding" was referred to only once, on page 1 of the application as filed: to this end, the (marine) structure was provided with one or more suction piles. Thus, any sort of "foundation parts" according to claim 1, ie other than the described suction piles, were not initially disclosed. Even if the skilled person recognized, based on the original description, a "foundation part" together with a "construction" above, then it would still not be derivable that such a "construction" had insufficient buoyancy to keep itself floating. On the contrary, the

description indicated that the construction had buoyancy of its own, cf. page 11. Furthermore, since no exact boundaries between such a "foundation part" and "construction" could be determined from the application as filed, it was impossible to know clearly and unambiguously which of these two parts actually contributed to sufficient buoyancy, and which one to insufficient buoyancy. As indicated in the example under point 9.1.3 of the impugned decision, an object, formed by a floating suction pile and a steel chain above, now fell under the scope of protection of claim 1 and, therefore, its subject-matter was extended beyond the application as filed.

With regard to claim 11, a "floating substance" was only described in association with floating spaces delimited at all sides with respect to the water environment, cf. page 4 as filed. If the existence of a "floating substance" (within a floating space) was self evident, then there arose the question why it had to be mentioned in claim 11. As was indicated by way of example under point 9.1.6 of the Opposition Division's decision, claim 11 now encompassed floating substances contained in floating spaces not delimited to the surrounding water, which went beyond the disclosure of the application as filed.

Since claim 9 also described the features of claim 1, the reasons for claim 1 not being allowable applied to claim 9 *mutatis mutandis*.

Therefore, the main request was not allowable. Finally, it was pointed out that in the event that the (Appellant's) request(s) were not rejected by the

Board, the Opposition Division had not yet considered all objections under Article 100 (c) EPC, eg as to claim 9 the Opposition Division was satisfied to refer to the non-allowable claim 1, although Opponent II had also brought forward substantive arguments, such as lack of support for "feature 9.9".

- (b) The Appellant submitted that since the (marine) structure of claim 1 was self founding, it was self-evident that the structure had to have a "founding part". Although the term "construction" was not originally mentioned, the (marine) structure thus comprised some arrangement above its "founding part" to be founded, which arrangement had to be named some way or another, eg by a term such as "construction", although it could equally have been named "body", etc. Such interpretation did not contravene the description on page 1 and 11 (as filed). Moreover, it was at least questionable whether the example of the Opposition Division under point 9.1.3 of its decision was covered by the scope of claim 1. In the opinion of the Opposition Division, the buoy apparently did not form part of the marine structure, which in turn implied that the marine structure as a whole was not independently floating. Consequently, this example was outside the scope of claim 1, and thus incorrect.

In respect of claim 11, it was self-evident that a floating space should contain a "floating substance", otherwise the required buoyancy could not be provided by the floating space. Thus, the term "floating substance" did not have to be originally mentioned, since it was implicit. Again, as with the example referring to claim 1, the Opposition Division was

wrong, since each styrofoam pellet could be regarded as a floating space delimited by reference to the surrounding water according to claim 11, such that again the value of this example was questionable.

As to claim 9, the Opposition Division was wrong for the above reasons.

Reasons for the Decision

1. The appeal is admissible.
2. Amendments of claims - main request
(Article 100(c) EPC)

Claim 1

- 2.1 As argued by the Appellant with respect to claim 1 as granted, it is indeed self-evident that the broadly claimed marine structure of claim 1 as filed with its one or more suction piles for embedment into the subsea bottom, ie with its foundation, necessarily must comprise a "foundation part with one or more suction piles" and some sort of "construction" above this foundation, eg, a production platform with appliances, cf. original claim 1; page 1, lines 34 to 38; page 2, lines 20 to 24; page 11, lines 9 to 13; page 12, line 33 to page 13, line 11; and figures (as published).
- 2.2 Moreover, the existence of other foundation parts in claim 1 as granted not being initially disclosed, ie other than the described one or more suction piles (and their implicit and inherent disclosure of connection parts, such as girder elements, struts, etc., cf. page 8, lines 19 to 24; figures (as published)), in the

opinion of the Board, does not form a technically meaningful construction of the claim.

However, given that original claim 1 directly and unambiguously describes a marine structure with a foundation not consisting only of one or more suction piles, the presence of other parts of such a generally described foundation would then have also been recognized by the skilled person based on the application as filed. Although not explicitly present in the original application documents, the broadly formulated functional term "foundation part" does not, therefore, provide the skilled person with additional, technically relevant information which was not contained in the original application documents.

- 2.3 Thus, contrary to the Respondent's view, and also contrary to the Opposition Division's view under point 9.1.1 of its decision, a distinction between a "foundation part" and an arrangement above, ie a "construction above", is implicitly made in the application as filed. Furthermore, based on the original description, "insufficient buoyancy to keep itself floating" as described in claim 1 as granted can be clearly attributed to the construction above the foundation part, since apart from the suction piles, the marine structure has (preferably) no floating bodies or floating structures if the suction pile offers at least part of the required buoyancy, cf. page 2, lines 24 to 27 and 33 to 37 (as published).

Claim 9

2.4 The subject-matter of granted method claim 9 is, therefore, also based on the application as filed, for the same reasons stated above.

Claim 11

2.5 As to the basis of claim 11 as granted, the Board shares the Appellant's view that it is again self-evident for the skilled person that a "floating space" of the originally claimed suction pile inevitably must contain a "floating substance", since otherwise the required buoyancy of the suction pile would not be provided by the floating space, cf. claim 10 as published. Hence, based on the disclosure of broadly formulated original claim 10, the term "floating space" already implies any technically meaningful medium within the floating space for providing buoyancy of the pile (in water). Contrary to the Respondents view, and also contrary to the Opposition Division's view under point 9.1.4 of its decision, the feature "floating substance" of the application as filed does not, therefore, have to be associated with particular floating spaces being delimited at all sides with respect to the water environment, ie with obviously closed spaces according to the embodiment on page 4, lines 14 to 18, as published.

Conclusion

2.6 For the sake of completeness, the Board refers to the examples cited by the Opposition Division under point 9.1.3 and 9.1.6 of its decision, to underline its reasoning as to extended subject-matter. The Board firstly notes that these hypothetical examples do in fact fall within the subject-matter of claims 1 and 10

as originally filed. Moreover, the very specific features and their combination making up the alleged embodiments created by the Opposition Division, did not need to have been originally disclosed in the application, since they are also not specific subject of amended claims 1 and 11. Thus, the Opposition Division's choice of artificial examples, said to fall under the amended claim's scope of protection, but not originally disclosed, is not considered to be an appropriate test for assessing the allowability of claim amendments, certainly not in the present case. Article 123(2) EPC and the corresponding Article 100(c) EPC refer to the general disclosure of the newly claimed subject-matter in the application as filed, which does not mean that all specific embodiments which might fall under the terms of the amended claim must also be described.

2.7 The Respondent's reference in its reply to remaining arguments possibly on file with respect to Article 100(c), thereby vaguely referring to objections raised by the Opponent II prior to the withdrawal of its opposition, such as lack of support for a "feature 9.9" of present claim 9, cannot be accepted by the Board. Article 12(2) RPBA requires that the statement of grounds of appeal and the reply shall contain a party's complete case.

2.8 Summing up, the subject-matter of claims 1, 9 and 11 can be derived from the original claims 1 and 10 and the original description and figures. No further objections under extended subject-matter were raised by the Respondent (or the Opposition Division), nor has the Board any of its own. The Board is, therefore,

satisfied that the subject-matter of the patent as granted according to the main request does not extend beyond the content of the application as filed, in compliance with Article 100(c) EPC.

3. *Oral proceedings*

Since the Board intends to allow the Appellant's main request, there has been no need to appoint oral proceedings, which were only requested by the Appellant on an auxiliary basis. In its reply to the grounds of appeal, the Respondent did not request oral proceedings, and the Board can, therefore, directly decide on the question of Article 100(c) EPC.

4. *Remittal to the Opposition Division
(Article 111(1) EPC)*

The patent in suit was revoked solely on the ground of extended subject-matter, Article 100(c) EPC. The opposition was, however, also based on the grounds that the subject-matter of the patent was not patentable (Article 100(a) EPC) and insufficiently disclosed to carry out the invention (Article 100(b) EPC). Since these grounds were not addressed by the parties during the appeal proceedings, and also the Opposition Division did not decide on them in the first instance proceedings, the Board therefore intends to exercise its discretion under Article 111(1) EPC and remit the case to the Opposition Division, in accordance with the further request of the Appellant.

Since the main request complies with Article 100(c) EPC, there is no need for the Board to consider the auxiliary requests.

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 for further prosecution on the basis of the main request.

The Registrar

The Chairman

D. Hampe

U. Krause