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**Datasheet for the decision
of 22 November 2016**

Case Number: T 0713/11 - 3.2.05

Application Number: 02803337.1

Publication Number: 1446603

IPC: F16L11/16

Language of the proceedings: EN

Title of invention:

A flexible pipe with a tensile reinforcement

Patent Proprietor:

National Oilwell Varco Denmark I/S

Opponent:

Technip France

Headword:

Relevant legal provisions:

RPBA Art. 12(2), 12(4), 13(1)

Keyword:

Late-filed requests - incomplete substantiation (not admitted)

Decisions cited:

R 0001/13

Catchword:



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Case Number: T 0713/11 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 22 November 2016

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 27 January 2011
revoking European patent No. 1446603 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman M. Poock
Members: P. Lanz
G. Weiss

Summary of Facts and Submissions

- I. The appeal by the patent proprietor is against the decision of the opposition division to revoke European patent EP-B-1 446 603 since the subject-matter of the claims as amended during the opposition proceedings extended beyond the content of the application as filed.
- II. During the opposition proceedings, the opponent had raised the grounds for opposition according to Articles 100(a) (lack of novelty and lack of inventive step) and 100(b) EPC 1973.
- III. Oral proceedings were held before the board of appeal on 22 November 2016.
- IV. The appellant's final requests were that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the claims filed with the letter of 16 November 2016 as main request bis and auxiliary requests 1 to 4 bis or, as a further subsidiary measure, on the basis of the claims filed on 4 January 2012 as first to fifth auxiliary requests.
- V. The respondent requested that the appeal be dismissed, that the appellant's main and auxiliary requests be held inadmissible or, as auxiliary measure, that the case be remitted to the department of first instance.
- VI. The documents are referred to by the parties included the following:

D5: US 4 273 160;

D15: "Recommended Practice for Flexible Pipe", API Recommended Practice 17B, Second Edition, 1998.

VII. Independent claim 1 of the main request bis has the following wording:

"A flexible pipe (1) for offshore use in the transport of fluids between installations above and/or below sea level in connection with the extraction with [sic] oil and gas, said pipe (1) comprising a tensile reinforcement wherein the tensile reinforcement comprises several tensile reinforcement layers (5, 6, 7, 8) which are not bonded to each other and where at least one of the tensile reinforcement layers (5, 6, 7, 8) is made of several tensile reinforcement elements, each of said tensile reinforcement elements consists of compound filaments and wherein the filaments are held together without the use of binding materials and without the use of retaining means surrounding some or all of the filaments, said tensile reinforcement element or elements being wound to form part of said tensile reinforcement layer (5,6,7,8)."

VIII. Compared with the main request bis, independent claim 1 of auxiliary request 1 bis is amended as follows:

"... and where at least one of the tensile reinforcement layers (5, 6, 7, 8) ~~is made~~ consists of several tensile reinforcement elements ..."

IX. Compared with auxiliary request 1 bis, independent claim 1 of auxiliary request 2 bis comprises the following addition:

"... said pipe (1) comprising a carcass (3) consisting of profiled steel strips and whose outer side has

arranged thereon an inner liner (4) which is surrounded by a tensile reinforcement wherein ..."

- X. Compared with auxiliary request 2 bis, independent claim 1 of auxiliary request 3 bis contains the following additional features:

"... each of said tensile reinforcement elements consists of compound filaments and wherein the filaments are held together without the use of binding materials and without the use of retaining means surrounding some or all of the filaments, these tensile reinforcement elements are mechanically locked to each other, said tensile reinforcement element or elements being wound to form part of said tensile reinforcement layer (5,6,7,8)."

- XI. Compared with auxiliary request 3 bis, independent claim 1 of auxiliary request 4 bis has the following addition:

"... these tensile reinforcement elements are mechanically locked to each other, each of the filaments in the tensile reinforcement layer intersects at least one of the other elements for each longitudinal unit of the filament corresponding to 50-500 times the diameter of the filament, wherein the filaments have diameters of between 0.001 and 10 mm, said tensile reinforcement element or elements being wound to form part of said tensile reinforcement layer (5,6,7,8)."

XII. Independent claim 1 of the first auxiliary request has the following wording:

"A flexible pipe (1) suitable for offshore use in connection with the extraction of oil and gas, said pipe (1) comprising a tensile reinforcement wherein the tensile reinforcement comprises several tensile reinforcement layers (5, 6, 7, 8) which are not bonded to each other and where at least one of the tensile reinforcement layers (5, 6, 7, 8) is made of several tensile reinforcement elements, each of said tensile reinforcement elements consists of compound filaments, said tensile reinforcement element or elements being wound to form part of said tensile reinforcement layer (5,6,7,8)."

XIII. Compared with auxiliary request 1, independent claim 1 of auxiliary request 2 comprises the following addition:

"... said pipe (1) comprising a carcass (3) whose outer side has arranged thereon an inner liner (4) which is surrounded by a tensile reinforcement wherein ..."

XIV. Compared with auxiliary request 2, claim 1 of auxiliary request 3 has the following additional features:

"... each of said tensile reinforcement elements consists of compound filaments, which are held together without the use of binding material or without the use of retaining means, said tensile reinforcement element or elements being wound to form part of said tensile reinforcement layer (5,6,7,8)."

XV. Compared with auxiliary request 3, independent claim 1 of auxiliary request 4 contains the following addition:

"... each of said tensile reinforcement elements consists of compound filaments, which are held together without the use of binding material or without the use of retaining means, that these tensile reinforcement elements being mechanically locked to each other, said tensile reinforcement element or elements being wound to form part of said tensile reinforcement layer (5,6,7,8)."

XVI. Compared with auxiliary request 4, claim 1 of auxiliary request 5 contains the following additional features:

"... that these tensile reinforcement elements being mechanically locked to each other, each of the filaments in the tensile reinforcement layer intersects at least one of the other elements for each longitudinal unit of the filament corresponding to 50-500 times the diameter of the filament, wherein the filaments have diameters of between 0.001 and 10 mm, said tensile reinforcement element or elements being wound to form part of said tensile reinforcement layer (5,6,7,8)."

XVII. The appellant's submissions on the admissibility of the pending requests may be summarised as follows:

The submission of the amended main request bis and auxiliary requests 1 to 4 bis after receipt of the board's communication should be held admissible. Apart from minor modifications, their substance was based on the third to fifth auxiliary requests filed with the statement setting out the grounds of appeal. Hence, they limited the granted claims and went in the same

direction as the requests filed previously in the appeal proceedings. The amendments were not directed to new matter but fully in line with what had always been said. The carcass of auxiliary request 2 bis was for example known from document D15 and the skilled person's common general knowledge and had only been included in view of the novelty objection based on document D5. The modifications also served procedural efficiency by clarifying claim features in order to avoid misunderstandings, e.g. regarding the reference to offshore use or concerning the wording "made of"/"consists of" and by replacing an "or" with an "and" in the penultimate feature. The appellant's case had not changed in the course of the appeal proceedings.

Moreover, the main request bis and auxiliary requests 1 to 4 bis met the criteria established by the case law (see Case Law of the Boards of Appeal of the European Patent Office, 8th edition 2016, chapter IV.E.4.2.5):

(i) they were occasioned by developments during the proceedings,

(ii) they did not extend the scope of discussion as determined by the grounds of appeal and the respondent's reply and

(iii) they were clearly or obviously allowable. In particular, the opposition division's objections against the wording "consists of" and the finding of a lack of novelty in view of documents D3 or D5 were clearly unfounded.

Finally, the substantiation for the main request filed with the grounds of appeal also applied to the

auxiliary requests filed at the same time. Since the main request bis and auxiliary requests 1 to 4 bis were, in substance, based on these auxiliary requests, they were sufficiently substantiated. The same was true for the first to fifth auxiliary requests.

XVIII. The respondent's submissions on the admissibility of the requests were essentially as follows:

All requests on file should be held inadmissible under Article 12(4) of the Rules of Procedure of the Boards of Appeal (RPBA). Attention was first drawn to the fact that, before the first-instance oral proceedings, the appellant as patent proprietor had not only replaced the claims then on file, but also announced that it would not attend the oral proceedings (see appellant's letter of 6 December 2010). With this course of action, the appellant waived an opportunity to defend its case and deliberately took the risk that the amended claims would be held unallowable and that the patent would be revoked. The appellant replaced all claims on file after having appealed the decision and again after having received the respondent's reply. Such a course of action went against the primary purpose of appeal proceedings, which was to have the correctness of the first instance decision reviewed (see G 9/91 and G 10/91, OJ EPO 1993, 408 and 420). This was equally true for the main request bis and auxiliary requests 1 to 4 bis filed on 16 November 2016. The appellant's argument that the latest amendment of the appellant's case was a reaction to the board's communication was not convincing since no new issues were raised in that communication.

As to the substance of the requests, it was observed that the limitations relating to offshore use and the

carcass were unforeseeable since they did not form part of the fallback positions defined in the granted dependent claims but were taken from the description. The situation was aggravated by the fact that the appellant had so far remained completely silent on the inventive merits of the pending requests. Thus, the respondent was confronted with new requests containing unforeseeable amendments and with an inventive step assessment to which it could not properly react because it would be presented for the first time during the oral proceedings at appeal stage. Besides the fact that it was impossible to conclude that the pending requests were clearly allowable, it was also evident that the appellant's overall handling of the case went against the principle of fair and expedite proceedings.

Consequently, the requests on file were inadmissible.

Reasons for the Decision

1. *Admissibility of the main request bis and auxiliary requests 1 to 4 bis*
 - 1.1 By letter dated 16 November 2016, the appellant submitted five additional sets of claims as main request bis and auxiliary requests 1 to 4 bis, based on which the patent should be maintained. According to the appellant, the substance of these requests is, apart from minor modifications, essentially based on the third to fifth auxiliary requests which had been filed with the statement setting out the grounds of appeal (and subsequently replaced).
 - 1.2 The respondent contests the admissibility of the main request bis and the auxiliary requests 1 to 4 bis *inter alia* based on the argument that they were neither

properly substantiated during the appeal proceedings nor *prima facie* allowable.

- 1.3 The filing of modified claims of the main request bis and auxiliary requests 1 to 4 bis only after the summons to oral proceedings constitutes an amendment to the appellant's case, the admission of which is at the board's discretion under Article 13(1) RPBA, this discretion to be "*exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.*"
- 1.4 The board notes that the list of criteria set out in Article 13(1) RPBA is not exhaustive ("*in view of inter alia*"). Thus, other well-established criteria relevant to the admissibility issue may also be taken into account, such as the question whether a claim request clearly overcomes the outstanding objections (see e.g. R 1/13 of 17 June 2013, Reasons 16.2) or whether it relates to the case under appeal and meets the requirements under Article 12(2) RPBA. Although this latter criterion is referred to in Article 12(4) RPBA, which applies to requests submitted along with the statement setting out the grounds of appeal, it is by analogy and indeed *a fortiori* also valid for requests submitted later in the appeal procedure.
- 1.5 According to Article 12(4) RPBA, everything presented by the parties under Article 12(1) RPBA shall be taken into account by the Board if and to the extent it relates to the case under appeal and meets the requirements in Article 12(2) RPBA.

Article 12(2) RPBA, in turn, codifies that
"[t]he statement of grounds of appeal and the reply shall contain a party's complete case. They shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on."

Taken as a whole, the Rules of Procedure of the Boards of Appeal make it clear that appeal proceedings are primarily written in nature, with Article 12(2) RPBA requiring that the parties' complete case be submitted at the outset. The purpose of this provision is to ensure fair proceedings for all concerned and to enable the board to start working on the case on the basis of both parties' complete submissions. It is therefore established case law that insufficiently substantiated requests are in general not considered in appeal proceedings (see Case Law of the Boards of Appeal of the European Patent Office, 8th Edition, 2016, IV.E. 4.2.4).

- 1.6 In its letter accompanying the contested requests, the appellant gives an explanation regarding the basis for the amendments of the claims and sets out briefly why the subject-matter of the independent claims of the main request bis and the first and second auxiliary requests bis are novel. On the issue of inventive step, the appellant confines himself to the following statement (see page 3):

"With respect to inventive step we refer to our grounds of appeal."

The grounds of appeal (see page 17, point 7) do not provide any further information regarding the inventive merits of the (then) third to fifth auxiliary requests, on which the requests now under consideration are based:

"Claim 1 of all of the Auxiliary Requests comprise [sic] all the features of claim 1 of the Main Request and the subject matter of these claims of the Auxiliary Requests are accordingly novel and [sic] inventive at least for the same reasons as claim 1 of the Main Request."

However, given the fact that, compared with the (then) main request, the (then) third to fifth auxiliary requests contain a plurality of additional substantial amendments partly originating from the description in order to delimit the subject-matter claimed from the cited prior art, such a general reference cannot be considered a sufficient reasoning. The board thus infers that, during the written appeal proceedings, the appellant did not present any reasons as to why it considered the subject-matter of the independent claims of the main request bis and the first to fourth auxiliary requests bis to be based on an inventive step, although it requested the patent to be maintained on that basis. It is added that, given the plurality of post-grant amendments and their interrelation in the various sets of claims, their potential inventive contribution is also not immediately self-evident. In this context, reference can be made for example to the appellant's own submission that the amendments were partly introduced only to establish novelty over the cited prior art, but were without bearing on inventive step. In summary, the main request bis and the first to fourth auxiliary requests bis have to be regarded as

insufficiently substantiated as to their inventive merits.

1.7 In the light of the lack of substantiation established above, the board cannot follow the appellant's argument that the newly filed requests were clearly or at least obviously allowable and thereby met the criteria established by the case law for late-filed requests.

1.8 The board concludes that the requirements of Article 12(2) RPBA that it must be set out clearly and concisely why it is requested that the decision under appeal be amended or upheld and that all the facts, arguments and evidence relied on should be expressly specified, are not met for the main request bis and the first to fourth auxiliary requests bis. Following the criteria of the last clause of Article 12(4) RPBA and the established case law, they cannot be taken into account by the board.

1.9 For these reasons, the board exercises its discretion under Article 13(1) RPBA not to admit the main request bis and the first to fourth auxiliary requests bis into the appeal proceedings.

2. *Admissibility of the first to fifth auxiliary requests of 4 January 2012*

2.1 After having received the respondent's reply to the appeal, the appellant submitted amended claims according to the first to fifth auxiliary requests on 4 January 2012. These requests equally constitute amendments to the appellant's case, the admission of which is at the board's discretion under Article 13(1) RPBA.

2.2 The board notes that the letter accompanying these amended requests remains silent on the questions of admissibility and inventive step, as does the statement setting out the grounds of appeal. Hence, the considerations set out above for the main request bis and the first to fourth auxiliary requests bis fully apply also to the first to fifth auxiliary requests of 4 January 2012.

2.3 The board therefore decides not to admit these further auxiliary requests into the appeal proceedings under Article 13(1) RPBA.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



D. Meyfarth

M. Poock

Decision electronically authenticated