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**Datasheet for the decision
of 7 November 2014**

Case Number: T 1802/12 - 3.3.01

Application Number: 04750783.5

Publication Number: 1658358

IPC: C10M159/24, C10M169/06

Language of the proceedings: EN

Title of invention:

USE OF CALCIUM SULFONATE BASED THREADED COMPOUNDS IN DRILLING
OPERATIONS AND OTHER SEVERE INDUSTRIAL APPLICATIONS

Applicant:

Jet-Lube, Inc.

Headword:

Method for protecting threaded connections/JET-LUBE Inc.

Relevant legal provisions:

EPC Art. 84, 94(3)
RPBA Art. 12(4)

Keyword:

Main request - clarity (no) -

No means to determine the presence of the function mentioned
in the claims.

Auxiliary request - not admitted -

No reaction to repeated objections of the examining division.

Decisions cited:

R 0010/09, T 1178/08, T 0893/90

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

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Case Number: T 1802/12 - 3.3.01

D E C I S I O N
of Technical Board of Appeal 3.3.01
of 7 November 2014

Appellant: Jet-Lube, Inc.
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 29 February
2012 refusing European patent application No.
04750783.5 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman A. Lindner
Members: J. Ousset
O. Loizou

Summary of Facts and Submissions

- I. An appeal was filed against the decision of the examining division refusing European patent application No. 04 750 783.5.
- II. The examining division found that the then pending main request did not fulfil the requirements of Articles 123(2) and 84 EPC. In particular, the examining division considered that the expressions "thread protecting additive", "contacting surface protecting system" and "active fluid" lacked clarity.
- III. With a letter of 10 July 2012, the appellant submitted its statement setting out the grounds of appeal and annexed to this letter a new main request and an auxiliary request.

Claim 1 of the main request reads as follows:

"1. A method for protecting threaded connections comprising the steps of:
applying to the contacting surfaces of the threaded connections prior to engaging the threaded connections, an amount of a thread composition comprising a calcium sulfonate complex grease comprising from about 10 wt.% to about 30 wt.% calcium sulfonate and from 90 wt.% to 70 wt.% base oil based on the total weight of the grease and a thread protecting additive system comprising one of more boundary lubricant and one or more contacting surface protecting agent including metal powders or flakes, and/or finely divided non-metallic fibers sufficient to form a film on the surfaces of the threaded connections, and
engaging the threaded connections, and

exposing the threaded connections to an active fluid on a continuous, periodic and/or intermittent basis, where the active fluid has a pH greater than or equal to 7 and the thread compound reduces or prevents active fluid contamination, removal, erosion, and/or ablation of the thread compound from the contacting surfaces of the threaded connections reducing galling, seizing and direct-metal-to-metal contact of the contacting surfaces of the threaded connections."

Claim 1 of the auxiliary request reads as follows:

"1. A method for reducing galling, seizing or direct metal-to-metal contact of the contacting surfaces of threaded connections in contact with fluids having a pH greater than or equal to 7, the method comprising the steps of:

- a) applying to the contacting surfaces of the threaded connections prior to engaging the threaded connections, an amount of a thread composition comprising a calcium sulfonate complex grease comprising from about 10 to about 30 wt.% calcium sulfonate and from 90 to 70 wt.% base oil based on the total weight of grease; and a thread protecting additive system consisting of one or more boundary lubricants selected from the group consisting of graphites, calcium carbonates, calcium sulfates, calcium acetates, calcium fluorides, nonabrasive silicates, nonabrasive acetates, nonabrasive carbonates, nonabrasive sulfates, nonabrasive fluorides, or mixtures thereof, and one or more contacting surface protecting agent selected from the group consisting of metal powders or flakes, finely divided non-metallic fibers or mixtures thereof;
- b) engaging the threaded connections, and

c) exposing the threaded connections to a fluid on a continuous, periodic and/or intermittent basis, where the fluid has a pH greater than or equal to 7."

The appellant mainly argued that the claimed subject-matter was novel over D1 and inventive in view of D1 and D2 and that the expression "contacting surface protecting agent" has been clarified.

IV. With a communication of 22 May 2014, the board notified the appellant that claim 1 of the main request still lacked clarity and that it was of the preliminary opinion not to admit the appellant's auxiliary request in the proceedings.

V. With its response of 21 July 2014, the appellant mainly argued as follows:

- The wording of the claims must be interpreted as it would be understood by the person skilled in the art.
- Illogical interpretations as well as interpretations which did not make sense should be ruled out. Numerous decisions were cited in which the content of the description was taken into account to interpret the claims as to their clarity and conciseness.
- The terms "active fluid", "thread protective additive system" and "contacting surface protecting agent", although being functional terms, remained clear per se and quite understandable by the person skilled in the art.

- As to the the goal to be achieved by the claimed method, namely that the thread compound used reduces or prevents active fluid contamination, reduces galling, seizing and direct metal-to-metal contact, it was referred to decision T 893/90.
- The auxiliary request was filed as soon as possible with the statement setting out the grounds of appeal, because the detailed reasons of the refusal given in the decision of the examining division made it necessary. This was done in order to facilitate the appeal proceedings.
- The examining division invited to oral proceedings after having issued only one communication.
- Since another representative was in charge of the procedure before the examining division, nothing could be said as to why this request was not submitted during examination.

VI. The appellant (applicant) requested that the decision under appeal be set aside and that a patent be granted on the basis of the main request, or alternatively on the basis of the auxiliary request as well as the remittal of the case to the Examining Division for further prosecution, all requests filed with the grounds of appeal dated 12 July 2012.

VII. At the end of the oral proceedings, the decision of the board was announced.

Reasons for the Decision

1. The appeal is admissible.

Main request - Article 84 EPC

2. According to Article 84 EPC, the claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description.

2.1 The terms "active fluid", "thread protective additive system" and "contacting surface protecting agent" define the different components used in the claimed method of claim 1 by their function and not by their specific name or molecular formula. The presence of these terms in the wording of claim is not objectionable as long as the wording of said claim fulfils the requirements of Article 84 EPC. In this context it has to be noted that, although the description refers to oilfield drilling (see page 3, [0010] and [0011]), the scope of the method of claim 1 is not limited to this specific use but includes any protection of threaded connections and depending on the technical field in which said threaded connections are used, said functional terms (e.g. active fluid) may take very different meanings. Furthermore, it has to be noted that the feature "contacting surface protecting agent" is further defined in claim 1 by additional compounds which, in principle, could contribute to the clarity of said functional features. However, firstly, the contacting surface protecting agent is not limited to these additional compounds (including...) and secondly, these additional compounds are themselves defined in functional language ("finely divided non-metallic fibers sufficient to form a film on the surfaces of the threaded connections"). As a consequence, these additional compounds do not render said functional features clear. The same reasoning applies to the feature "thread protective additive system" which also comprises additional components

defined in functional language (boundary lubricant and contacting surface protecting agent) without being limited thereto. The content of the description also further specifies these functional terms (see [0015] to [0019], [0022], [0038] to [0041]). However, claim 1 is not limited to these definitions but has to be clear *per se* (see T 454/89, point 4.1 (vii), third paragraph). Moreover, the description does not contain any test allowing the person skilled in the art to verify whether or not the claimed functions have been obtained so that the scope of claim 1 cannot be clearly defined.

A similar reasoning can be applied to the properties of the thread compounds as mentioned in the last part of claim 1. No test is mentioned in the originally filed application for verifying under which conditions the desired effects are to be obtained or whether they are obtained at all. The board is not aware of any conventional testing method to that avail and the appellant did not provide any evidence showing that such a method is part of the common technical knowledge. As a consequence, said functional features cannot be interpreted by the skilled person without ambiguity.

2.1.1 The numerous decisions cited by the appellant to justify the reference to the description in order to interpret the objected terms of claim 1 concern *inter partes* cases. These decisions are not pertinent for the present *ex parte* case in which the requirements of Article 84 EPC must be met in order for a patent to be granted.

2.1.2 Decision T 893/90 relates to a functional feature defining a technical result to be achieved by a pharmaceutical formulation. There, the board concluded

that the criterion of clarity was met by the claim containing this feature, because, although bothersome, a test was available allowing the person skilled in the art to verify that the said functional feature was met (see point 3). Claim 1 of the current case also contains such functional features to be met by the thread compound used in the claimed process (see last part of claim 1). However, a test to verify whether these functional features are present after having applied the claimed method is not mentioned in the description as originally filed. Moreover, the appellant did not provide any evidence that such a test lies within the skilled person's general knowledge. Therefore, this argument is moot.

- 2.2 In view thereof, the board concludes that claim 1 of the main request contravenes Article 84 EPC.

Auxiliary request - Admissibility

3. Article 12(4) of the RPBA reads as follows:

"Without prejudice of the power of the Board to hold inadmissible facts, evidence or requests which could have been presented or were not admitted by the first instance proceedings, everything presented by the parties under (1) shall be taken into account by the Board if and to the extent it relates to the case under appeal and meets the requirements of (2)."

In Article 12(4) RPBA, (1) and (2) refer to Articles 12(1) and 12(2) respectively.

The board in an ex parte case has discretion over whether to admit requests which could have been presented to the first instance, but were not. It must exercise that discretion having regard to the particular

circumstances of the individual case (T 1178/08, point 2.3).

- 3.1 On 13 August 2009, the examining division issued a communication according to Article 94(3) EPC in which the features "active fluid", "thread protective additive system", "anti-degradant system", "contacting surface protecting agent" and "anti-seize thread compound" were objected to for lack of clarity. Moreover, claim 1 was defined by a result to be achieved and a test to verify whether the desired result was obtained was not mentioned.

After having requested and obtained an extension of time to a total of seven months by the examining division for providing its reply, the applicant (now appellant) sent a letter dated 23 March 2010 arguing that the objected terms were clear, had a basis in the description and annexed to it a new version of the main request in which the features objected to by the examining division in the above mentioned communication were maintained.

Since the applicant's explanations did not convince the examining division, the latter invited the applicant to oral proceedings to be held on 25 November 2011. In the annex to the summons to oral proceedings, the examining division explained in detail as to why the claimed subject-matter lacked clarity (see points 2.1 to 2.4).

With its letter of 1 September 2011, the applicant requested the postponement of the oral proceedings scheduled on 25 November 2011. This request was granted by the examining division and the oral proceedings were postponed to 14 February 2012. The annex to the summons containing the same objections was once more sent to the applicant. On 9 January 2012, the applicant requested

once more a change of the date of the oral proceedings. This request was again granted by the examining division and the holding of the oral proceedings was set on 13 February 2012.

With letter of 2 February 2012, thus 11 days before oral proceedings, the applicant submitted a new main request comprising all the features objected to by the examining division in its previous communications.

Oral proceedings were held on 13 February 2012 in the absence of the applicant which had been duly summoned but had not informed the examining division of its intention not to attend. The examining division refused the application mainly on the basis of the lack of clarity as mentioned in its communication dated 13 August 2009 and in its annex to the summons to oral proceedings sent twice to the applicant, namely on 3 August and 28 September 2011.

The present auxiliary request was filed with the statement of the grounds of appeal. Therein, for the first time, the objections of lack of clarity as set out in the appealed decision and which had been repeatedly raised by the examining division, are being dealt with.

- 3.2 Bearing in mind that the facts of the present case as stated above, regarding substantive issues when the appellant filed the auxiliary request with its statement of grounds of appeal were the same as that of the first instance, the board concludes that the auxiliary request could and should have been submitted during the first instance proceedings. In the present case, the applicant had been given several opportunities to file amended claims in the first-instance proceedings. Although the examining division issued only one communication

pursuant to Article 94(3) EPC, the clarity objections raised therein had been reiterated in great detail in the annex to the summons to oral proceedings sent on 3 August 2011 and again on 28 September 2011. In reply to the summons to oral proceedings which had been postponed twice as requested by the appellant, the appellant reacted by not attending them. No new arguments were put forward and the application was ultimately refused by the examining division.

- 3.2.1 The appellant argued that this auxiliary request was filed with its statement of grounds of appeal, because it has waited for the detailed reasons of the decision and in order to present a complete case before the board. For these reasons, this request should be admitted. In the current case, the outstanding objections with regard to the lack of clarity of claim 1 were known from the beginning of the proceedings and the content of the decision did not add anything new which was not already mentioned by the examining division. This argument does therefore not hold.
- 3.2.2 That another representative was in charge of the file before the department of first instance has no effect on the board's conclusion as to the admissibility of the auxiliary request. According to the jurisprudence of the Boards of Appeal a change of representative does not constitute unforeseeable developments lying outside the sphere of responsibility of the appellant (Case Law 7th Edition IV.C.1 page 830).
- 3.3 In view of all of the above, the board, exercising its discretion, decides not to admit into the proceedings the auxiliary request filed with the statement of grounds of appeal (Article 12(4) RPBA).

3.4 In view thereof, a discussion of the appellant's request for remittal of the case for further prosecution is superfluous.

Order

For these reasons it is decided that:

1. The appeal is dismissed

The Registrar:

The Chairman:



M. Schalow

A. Lindner

Decision electronically authenticated