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**Datasheet for the decision
of 8 November 2018**

Case Number: T 1008/14 - 3.3.05

Application Number: 07020020.9

Publication Number: 1900412

IPC: B01D33/03, B07B1/46, E21B21/00,
E21B21/06, B01D35/20, C09K8/00

Language of the proceedings: EN

Title of invention:
Apparatus and method for screening drilling mud

Patent Proprietor:
Axiom Process Limited

Opponents:
Openshaw, Paul Malcolm
National Oilwell Varco, L.P.

Headword:
Screening drilling mud/Axiom

Relevant legal provisions:
EPC R. 99(2)
EPC Art. 100(c), 76(1)

Keyword:

Admissibility of appeal - (yes)

Grounds for opposition - added subject-matter (yes)

Decisions cited:

T 0792/94, T 0005/14

Catchword:



Beschwerdekammern

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Case Number: T 1008/14 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 8 November 2018

Appellant: Axiom Process Limited
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted on 24 February
2014 revoking European patent No. 1900412
pursuant to Article 101(3) (b) EPC

Composition of the Board:

Chairman E. Bendl
Members: G. Glod
 P. Guntz

Summary of Facts and Submissions

- I. The appeal lies from the decision of the opposition division to revoke European patent EP 1 900 412 B1 for not meeting the requirements of Article 76(1) EPC in view of the parent application WO 2004/110589, thereafter referred to as PAR.
- II. With the statement of grounds of appeal, the **appellant (patent proprietor)** maintained the claims as granted as its main request and submitted seven auxiliary requests.
- III. After the summons to oral proceedings, opponent 2 withdrew from the proceedings.
- IV. In the communication according to Article 15(1) RPBA, the board was of the preliminary opinion that the appeal was likely to be dismissed.
- V. By letter of 8 October 2018, the appellant submitted auxiliary request 8.

Claim 1 of the main request reads as follows:

*"1. A method for recycling solids in a drilling mud fluid such that recycled solids have dimensions within a selected size range compatible with minimising formation damage during drilling of a specific formation, the method comprising the steps of:
a) screening a drill cuttings and drilling mud fluids mixture feed through a stack of at least three screen assemblies mounted in a vibratory screening apparatus, the said mixture feed being passed successively through the at least three screen assemblies with screen meshes*

of successively finer cut so as to produce a screened fluid; and

b) returning solids which have passed through a first screen assembly but are retained by a second screen assembly to the screened fluid."

Claims 1 of auxiliary requests 1 to 8 are based on claim 1 of the patent as granted and include further features. These features are not relevant to the present decision.

VI. The arguments of the **appellant** where relevant to the present decision may be summarised as follows:

The patent claims should be interpreted according to their own content with the aid of the description and drawings. The skilled person would immediately appreciate that the term "screened fluid" simply clarifies that the solids which have been retained by a second screen assembly are to be put back into fluid that had been passed (screened) through the vibratory screening apparatus rather than to fluid that had yet to be passed through the vibratory screening apparatus. The term "screened fluid" had been chosen for ease, and it would be immediately apparent that the term was used to refer generally to the drilling fluid downstream of the screen assemblies.

The fluid that had been screened through the vibratory screen machine was - irrespective of any subsequent further processing including dilution, addition of other materials or further screening operations - a constituent part of that recycling drilling fluid. The screened fluid could be considered to refer to the fluid downstream of the screen assembly.

The claim did not provide any language which would lead the skilled reader to limit the term "screened fluid" to only refer to fluid at a very specific location downstream of the screen assemblies. The fluid entering the borehole could still be considered a screened fluid within the meaning of the claim.

- VII. The arguments of **opponent 1 (respondent)** where relevant to the present decision may be summarised as follows:

The appeal was inadmissible, since it contained aspects that were not admissible.

The requirements of Article 76(1) EPC were not fulfilled, since the screened fluid, which had passed successively through the at least three screen assemblies, typically underwent further processing, so it was significantly changed and was no longer the screened fluid as defined in step a) of claim 1.

- VIII. The appellant requests that the impugned decision be set aside and that the patent be maintained as granted or, in the alternative, that the patent be maintained in amended form on the basis of one of auxiliary requests 1 to 7 as submitted with the statement of grounds of appeal or on the basis of auxiliary request 8 submitted with the letter of 8 October 2018.

The respondent requests that the appeal be dismissed.

Reasons for the Decision

1. Admissibility of the appeal

The appeal is clearly admissible, since the requirements of Rule 99(2) EPC are clearly met by the reasoning provided by the appellant. In particular, paragraphs 8 to 25 of the statement setting out the grounds of appeal deal with the reasoning relating to "screened fluid" set out in point 2 (2.1 to 2.10) of the impugned decision.

It is established jurisprudence that the notion of "partial admissibility" does not exist in the EPC (Case Law of the Boards of Appeal of the EPO, 8th edition, 2016, IV.E.2.6.9).

The appellant is in principle allowed to submit further requests with the statement of grounds of appeal. Whether they are admitted into the proceedings is not a question of the admissibility of the appeal under Rule 101(1) EPC, but rather a question under Article 12(4) RPBA. It is further at the board's discretion whether to deal with issues not dealt with at first instance or to remit the case (Article 111(1) EPC).

Main request - patent as granted

2. Article 100(c) EPC in combination with Article 76(1) EPC

The ground under Article 100(c) EPC is well-founded for the following reasons:

Step a) of claim 1 relates to the screening of a drill cuttings and drilling mud fluids mixture feed, wherein

the feed is passed through at least three screen assemblies **so as to produce a screened fluid**. One possible and technically reasonable understanding of this step is that the product of process step a) is called "screened fluid". Consequently, this product obtained by process step a) is a specific composition with specific properties. In particular, the particle size distribution is the one obtained immediately after process step a).

Step b) specifies that solids with a selected size range, i.e. those that have passed through a first screen assembly but were retained by a second screen assembly, are returned to the screened fluid. In view of the previous understanding of step a), this means that these solids are added to the product obtained by the screening process, which still has the specific properties such as particle size distribution.

The question is whether this understanding of claim 1 is directly and unambiguously derivable from PAR. There is no disclosure of "screened fluid" in PAR. As accepted by the parties, the only passage that could serve as a basis for said claims is page 4, lines 11 to 31.

It is unambiguous from the cited passage that solids of a smaller size than a first screen but greater than a second screen can be returned to the "drilling fluid mud system". The latter is the entire system that encompasses the drilling fluid that is pumped into/ comes from the borehole. This is also confirmed by the appellant in the grounds of appeal, page 3, point 13: "The proprietor agrees with the opinion that the term 'drilling fluid mud system' refers [...] to the total volume of the drilling fluid being circulated in a

drilling operation". The skilled person understands that some solids of a particular size are collected from the drilling fluid recovered directly from the borehole and are then returned to the drilling fluid prior to being pumped into the borehole again. PAR does not specify whether the specific solids are added to the screened fluid as defined above, or to the processed screened fluid, i.e. the fluid adapted for recycling the screened fluid into the borehole. As this processing includes the possibility of adding or removing particles from the screened fluid, the fluid's properties - such as particle distribution - change, and the skilled person would no longer consider the obtained product to be identical to the product of step a) of claim 1, i.e. the (unprocessed) "screened fluid".

This understanding is in line with the appellant's argument that screened fluid was a constituent of the recycled drilling fluid (point 23 of the statement of grounds), which means that the screened fluid - i.e. the product obtained in step a) of claim 1 - is not identical to the recycled drilling fluid. As a consequence it is not unambiguously derivable from PAR that the retained solids (those that have passed through a first screen assembly but were retained by a second screen assembly) are added to the product of step a) of claim 1.

The interpretation presented above makes technical sense and can therefore not be excluded. As a consequence the claim covers an option that is not directly and unambiguously derivable from the parent application (see also T 792/94, Reasons 2, and T 5/14, Reasons 13).

Auxiliary requests 1 to 8

3. The amendments introduced in auxiliary requests 1 to 8 do not overcome the objection made for the main request, since step b) always requires the addition of the solids to the screened fluid. This was not disputed by the appellant.

As a consequence, notwithstanding the question of admissibility, none of these requests is allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Vodz

E. Bendl

Decision electronically authenticated