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**Datasheet for the decision
of 25 February 2019**

Case Number: T 1763/15 - 3.2.05

Application Number: 09785373.3

Publication Number: 2304293

IPC: F16L1/20

Language of the proceedings: EN

Title of invention:

Method of spooling a bi-metallic pipe

Patent Proprietor:

Technip France

Opponent:

Subsea 7 Limited

Relevant legal provisions:

EPC Art. 54, 111(1)

RPBA Art. 12(4)

Keyword:

Late-filed requests - admitted (yes)

Novelty - main request (yes)

Remittal to the department of first instance - special reasons
for remitting the case (yes)

Decisions cited:

T 0056/87



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Case Number: T 1763/15 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 25 February 2019

Appellant:
(Patent Proprietor)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 9 July 2015
revoking European patent No. 2304293 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman M. Poock
Members: S. Bridge
 D. Rogers

Summary of Facts and Submissions

- I. The patent proprietor lodged an appeal against the decision of the opposition division revoking European patent No. 2 304 293.
- II. An opposition was filed against the patent as a whole based on Article 100(a) EPC (lack of novelty, Article 54 EPC, and lack of inventive step, Article 56 EPC) and Article 100(b) EPC.
- III. Oral proceedings were held before the board of appeal on 25 February 2019. The decision was announced at the end of the oral proceedings.
- IV. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request or one of the 1st to 8th auxiliary requests.
- V. The respondent (opponent) requested that the appeal be dismissed and that the 2nd to 8th auxiliary requests not be admitted into the proceedings.
- VI. Claim 1 of the patent in suit as granted (main request) reads as follows:

"A method of spooling a marine pipeline (90) comprising a plurality of bi-metallic pipe sections (10, 66) onto a reel (60) comprising at least the steps of:

- (a) filling a first pipe section (10) with a fluid (12), and pressurising the fluid (12) in the first pipe section (10);
- (b) spooling the first pipe section onto the reel;

- (c) filling a second pipe section (66) with a fluid (78), and pressurising the fluid (78) in the second pipe section (66);
- (d) joining the first pipe section with the second pipe section wherein at least one of the first and second pipe sections maintains the pressurised fluid therein; and
- (e) spooling the second pipe section onto the reel."

VII. Claim 1 according to the 1st auxiliary request only differs from claim 1 according to the main request in that feature (d) has been amended to read (amendments indicated in strike-through by the board):

"(d) joining the first pipe section with the second pipe section wherein at least ~~one of the first and~~ second pipe sections maintains the pressurised fluid therein; and".

VIII. Claim 1 according to the 2nd auxiliary request only differs from claim 1 according to the main request in that the following text has been added at the end of feature (d):

"comprising the steps of

- (i) enclosing the fluid (12) in the two marine pipeline bi-metallic pipe sections (10, 66) by first and second plugs (18, 24, 64, 68) at respective ends of the pipe sections,*
- (ii) connecting the opposing plugs of the first and second pipe sections;*
- (iii) joining the first and second pipe sections;*
- (iv) filling the first and second pipe sections beneath the join (80) with a fluid; and*
- (v) moving one of the connected plugs across the join"*.

IX. Claim 1 according to the 3rd auxiliary request reads as follows:

"A method of spooling a marine pipeline (90) comprising a plurality of bi metallic pipe sections (10, 66) onto a reel (60) comprising at least the steps of:

- (i) locating a plug (18) at one end of the first pipe section (10);
- (ii) filling the first pipe section with a fluid (12), preferably water;
- (iii) locating a second plug (24) at the other end of the first pipe section;
- (iv) pressurising the fluid in the first pipe section;
- (v) locking the second plug to maintain the pressurised fluid in the first pipe section;
- (vi) spooling the first pipe section onto the reel (60);
- (vii) locating a first plug (64) at one end of the second pipe section (66);
- (viii) filling the second pipe section with a fluid (12), preferably water;
- (ix) locating a second plug (68) at the other end of the second pipe section;
- (x) pressurising the fluid in the second pipe section;
- (xi) locking the second plug to maintain the pressurised fluid in the second pipe section;
- (xii) joining the first pipe section beyond its first or second plug with the second pipe section beyond its first or second plug to provide a join;

- (xiii) filling the first and second pipe sections beneath the join (80) with a fluid, preferably water;
- (xiv) moving at least one plug of the first pipe section across the join;
- (xv) moving one plug of the first pipe section to the location of one plug of the second pipe section, and optionally withdrawing the first and second plugs of the second pipe section from the second pipe section;
- (xvi) spooling the second pipe section onto the reel; and
- (xvii) repeating steps (vii) to (xvi) with another second pipe section."

X. The following document is referred to in the present decision:

D1: WO 2008/072970 A1.

XI. The arguments of the appellant in the written and oral proceedings can be summarised as follows:

Admissibility of the 2nd and 3rd auxiliary requests

The 2nd and 3rd auxiliary requests are based on granted dependent claims 12 and 13 and were thus already in the scope of the opposition proceedings. The use of plugs is neither new for the opponent nor is it complex. It serves to overcome the issues raised in the opposition decision.

The 2nd and 3rd auxiliary requests should be admitted into the proceedings.

Novelty of claim 1 as granted - document D1

The skilled person is a mechanical engineer with experience in the oil and gas industry. The passage on page 4, lines 12 to 20 of document D1 teaches that welding of pipeline lengths on board the laying barge should be avoided. In the second sentence of this passage it is unclear how the pipeline and the reels are arranged. If a section of pipe is welded onto the end of the pipeline offshore, it does not make sense to spool the resulting pipeline onto a reel. Instead the skilled person would lay the resulting pipeline off the barge and onto the seabed, so that there is no subsequent reeling step, unlike step (e) of claim 1 as granted.

The passage on page 2 of document D1 does not anticipate claim 1 as granted, because in step b) the pressure is relieved every time prior to joining. In step c) this pressure is re-established in the now joined sections prior to reeling. The passages on pages 2 and 4 of document D1 cannot be combined, because they relate to different embodiments. The subject-matter of granted claim 1 differs from the disclosure of page 2 of document D1 in that at least one of the first and second pipe sections maintains the pressurised fluid therein during joining.

Therefore, the subject-matter of claim 1 of the patent in suit is new with respect to document D1.

XII. The arguments of the respondent in the written and oral proceedings can be summarised as follows:

Admissibility of the 2nd and 3rd auxiliary requests

The 2nd and 3rd auxiliary requests involve new subject-matter such as the use of movable plugs from the dependent claims and in addition claim 1 of the 3rd auxiliary request replaces wording from granted claim 1 potentially giving rise to new issues. These requests go beyond a review of the opposition division's decision. The new requests raise new issues not dealt with at the opposition stage - specifically, the novelty and inventiveness of the steps relating to the use of the plugs. The opponent has not raised any new patentability issues or prior art documents since the original grounds of opposition, so there have been no new issues to consider. There is no reason that such requests could not have been submitted during the first instance proceedings.

The 2nd and 3rd auxiliary requests should not be admitted into the proceedings.

Novelty of claim 1 as granted - document D1

The appropriate skilled person is a mechanical engineer with experience of pipeline engineering and reeling. In document D1, the relief of the overpressure in step b) of page 2 must be considered optional so that step b) does not present any instruction to relieve the overpressure established in step a). Step c) only relates to the filling of the added pipe sections after joining since in step d) several sections are reeled. In addition, page 4, line 16, suggests to maintain overpressure with ice plugs during joining. The second sentence

of the passage on page 4 is not relevant to the novelty of claim 1 as granted.

Therefore, the subject-matter of claim 1 of the patent in suit lacks novelty over document D1.

Reasons for the Decision

1. *Admissibility of 2nd and 3rd auxiliary requests*

1.1 According to article 12(4) of the Rules of Procedure of the Boards of Appeal (RPBA) the board has the power to hold inadmissible requests which could have been presented in the first instance proceedings.

1.2 The main request (patent as granted) and 1st to 3rd auxiliary requests were filed with the grounds of appeal. The main request and the 2nd and 3rd auxiliary requests do not correspond to any of the requests presented during the opposition proceedings.

1.3 With the letter of 21 January 2019 (page 2, beginning of the second paragraph after the table) the respondent no longer contested the admissibility of the main request or of the 1st auxiliary request.

1.4 Claim 1 according to the 2nd auxiliary request comprises a combination of claims 1 and 13 of the patent as granted.

Claim 1 according to the 3rd auxiliary request comprises replacing the steps of claim 1 with the more numerous steps of claim 12 of the patent as granted.

The 2nd and 3rd auxiliary requests are thus *prima facie* based on granted dependent claims and thus cannot come as a surprise to the respondent even though the subject-matter of these dependent claims was not discussed in detail during the opposition proceedings. Although these requests could have been filed during the opposition proceedings, they were filed early in the appeal proceedings, namely with the grounds of appeal. The respondent had an opportunity to respond to these requests, which they did. In addition, since the appellant is adversely affected by the decision of the opposition division, the board - at present - considers it legitimate for a losing patent proprietor that they attempt to save their patent by introducing subject-matter from dependent claims into claim 1. In consequence, the board uses its discretion to admit the 2nd and 3rd auxiliary requests into the proceedings.

2. *Novelty of claim 1 as granted (Article 54 EPC)*

2.1 According to established case law, it is a prerequisite for the acceptance of lack of novelty that the claimed subject-matter is "*directly and unambiguously derivable from the prior art*". In other words, it has to be "*beyond doubt - not merely probable - that the claimed subject-matter was directly and unambiguously disclosed in a patent document*" (Case Law of the Boards of Appeal of the European Patent Office, 8th edition 2016, page 102). In addition, according to the boards' settled case law, the technical disclosure in a prior art document must be considered as a whole (see T 56/87, OJ 1990, 188).

2.2 Document D1 concerns a method for laying a pipeline having an inner corrosion proof cladding onto a seabed from a laying drum on the lay barge (title, page 1,

lines 6 to 11). The method on page 2, lines 15 to 29 of document D1 involves the following steps a) to e):

- "a) a section of the pipeline is reeled onto a pipe laying drum, whilst an overpressure of 5-25 bar is maintained within the section by means of a pressurised fluid inside the section,
- b) a further pipeline section is joined to the section already reeled onto the pipe laying drum, whilst the pipeline is motionless without mechanical movement, as the overpressure can be relieved as long as the sections are without mechanical movement,
- c) an overpressure of 5-25 bar is applied within the sections and the further section is reeled onto the pipe laying drum,
- d) several sections are joined together and reeled onto one or several pipe laying drums by repeating step b) and c) until the predetermined pipeline length is achieved,
- e) the pipeline is laid from the lay barge onto the seabed using conventional method, whilst an overpressure of 5-25 bar is maintained within the pipeline by means of a pressurised fluid until the pipeline is correctly placed onto the seabed".

2.3 In the context of this method, the parties only differed with respect to whether in step b) the overpressure from step a) is maintained during joining or not.

2.4 In step c) the overpressure is applied within the sections and the further section is reeled onto the pipe laying drum. If the overpressure were to have been maintained during joining, there would be no need to apply the overpressure again "to the section already reeled onto the pipe laying drum" and in step c) only

the singular "section" would have been used instead of the plural "sections". The board also cannot accept that the plural "sections" is used in step c) in anticipation of the repetition of steps b) and c) indicated in step d): Why would this only apply to step c), but not to step b) where only "a further pipeline section is joined to the section already reeled onto the pipe laying drum"?

- 2.5 In addition, document D1 considers it to be a feature of importance, "*that the pipeline or pipeline sections shall have no mechanical movement when the prescribed overpressure is not applied within the pipeline or sections thereof. The term "without mechanical movement" means no reeling onto or unwinding from the pipe laying drum; or lowering of the pipeline from the lay barge onto the seabed, without the prescribed overpressure*" (page 2, line 30 to page 3, line 3).

Document D1 thus emphasises that overpressure is mandatory during any movement of the pipe. Against this context, the fact that joining occurs "*whilst the pipeline is motionless without mechanical movement, as the overpressure can be relieved as long as the sections are without mechanical movement*" from step b) is understood by the skilled person both as an indication that the overpressure is relieved and as an explanation of why this is possible, namely, because "*the pipeline is motionless without mechanical movement*". It is only when "*the pipeline is motionless without mechanical movement*" that the overpressure can be relieved without the inner cladding buckling or wrinkling (page 1, lines 28 to 34).

- 2.6 It was advanced on behalf of the respondent that the relief of the overpressure is to be considered optional

in document D1. This relates to the use of the verb "can" in step b) (page 2, line 21 and page 5, line 14). Although the verb "can" may be an indication of an optional feature, it is also used to designate the circumstances in which something is possible, as indicated by the preceding "as". As already set out above, the skilled person considers the latter meaning to be the correct one for document D1 when read as a whole: in this case the circumstances are that there is "no mechanical movement" as further defined at the top of page 3 of document D1 (see point 2.5 above).

- 2.7 In consequence, there is no direct and unambiguous disclosure in the method of page 2 of document D1 of "*joining the first pipe section with the second pipe section wherein at least one of the first and second pipe sections maintains the pressurised fluid therein*" (step (d) of claim 1 as granted versus steps b) and c) of document D1).
- 2.8 In addition, document D1 considers the situation when the entire pipeline cannot be reeled onto one pipe laying drum and it is necessary to join pipeline lengths on different pipe laying drums (page 4, lines 12 to 16). One alternative is to use a method for joining the pipeline sections by installing an ice plug on either one or both sides of the joint, whereby the overpressure can be maintained (page 4, lines 16 to 19).
- 2.9 However, this passage does not directly and unambiguously disclose that the resulting pipeline sections are spooled onto a reel.
- 2.10 On the contrary, when such joining occurs on the lay barge, the skilled person would avoid such unnecessary

spooling and resulting unnecessary additional bending of the pipeline and instead proceed directly with laying the pipeline on the seabed. Since document D1 as a whole is concerned with a "*method for laying a pipeline onto a seabed from a lay barge*" (see claim 1 of document D1) and both the paragraphs before and after the one in lines 12 to 20 of page 4 are concerned with the situation on the vessel (page 4, lines 7 to 9) or lay barge (page 4, lines 21 and 22) and in the absence of any statement to the contrary, it is implicit for the skilled person that the passage page 4, lines 12 to 20 also mainly relates to the situation off-shore.

2.11 Since there is no direct and unambiguous indication in document D1 that particular teaching of the passage on page 4, lines 12 to 19 is to be combined with the method set out on page 2, it is not possible to combine a particular step from the passage on page 4, lines 12 to 19 with the method of page 2 when considering a lack of novelty objection.

2.12 Therefore, the subject-matter of claim 1 of the patent in suit is new with respect to the teachings of document D1 (Article 54 EPC).

3. *Remittal*

3.1 According to article 111(1) EPC, the board of appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.

3.2 The issue of inventive step has not yet been examined by the opposition division. Furthermore, the appellant

explicitly expressed a preference for remittal while the respondent did not argue against it. For these special reasons, the board considers it appropriate to exercise its discretion under Article 111(1) EPC and remit the case to the department of first instance for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:



N. Schneider

M. Poock

Decision electronically authenticated