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**Datasheet for the decision
of 12 January 2023**

Case Number: T 2333/18 - 3.2.01

Application Number: 14193668.2

Publication Number: 2863005

IPC: E21B17/08, E21B19/00

Language of the proceedings: EN

Title of invention:

Trigger joint

Patent Proprietor:

FMC Kongsberg Subsea AS

Opponent:

Aker Solutions AS

Headword:

Relevant legal provisions:

EPC Art. 76(1)

Keyword:

Divisional application - subject-matter extends beyond content of earlier application (yes)

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 2333/18 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 12 January 2023

Appellant: FMC Kongsberg Subsea AS
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Respondent: Aker Solutions AS
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 9 July 2018
revoking European patent No. 2863005 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman G. Pricolo
Members: V. Vinci
P. Guntz

Summary of Facts and Submissions

I. The appeal filed by the patent proprietor (appellant) is directed against the decision of the opposition division to revoke the European patent No. 2 863 005. The patent was granted on the basis of the European patent application No. 14 193 668 filed as divisional application of the international application WO 2010/090531

II. In its decision the opposition division held that the subject-matter of independent claim 1 as granted and according to the auxiliary requests 1 to 3 lacked novelty and inventive step respectively in the meaning of Articles 52(1), 54 and 56 EPC in view of the following prior art:

P1: US 2008/0314597

P2: WO 03/064809

III. With the communication according to Article 15(1) RPBA dated 15 March 2022 the Board informed the parties of its preliminary assessment of the case.

Oral proceedings pursuant to Article 116 EPC were held before the Board on 12 January 2023 by videoconference.

IV. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained as granted or, in the alternative, that the patent be maintained in amended form according to one of auxiliary requests 1 to 4 as submitted with the statement of grounds of appeal.

The respondent (opponent) requested that the appeal be

dismissed.

V. Claim 1 as granted reads as follows:

"System comprising a riser (1) extending from a subsea installation (2) arranged at the seabed to a floating unit (3),

a joint (20) forming part of the riser and an emergency disconnect package (7) above a subsea tree (9),

with the joint (20) arranged in the riser between the emergency disconnect package (7) and a connection point for a tension system connected between the riser and the floating unit (3)

characterised in that

the joint (20) is connected to a control unit (60),

where the control unit is in communication with the emergency disconnect package (7),

such that when signal from the joint (20) reaches a given value the control unit will as a consequence of this activate the emergency disconnect package (7)."

VI. Independent claim 1 of each of the auxiliary requests 1 to 4 is based on claim 1 as granted and comprises further additional features.

Reasons for the Decision

MAIN REQUEST - PATENT AS GRANTED

1. With their appeal the appellant (patent proprietor) contested the conclusion of the opposition division that the subject-matter of claim 1 as granted lacked novelty over document P2 and that the auxiliary requests 1 to 3 lacked inventive step in view of documents P1 or P2. With their reply to the statement of grounds of appeal of the appellant (patent proprietor) the respondent (opponent) contested the view of the opposition division that the subject-matter of claim 1 as granted was directly and unambiguously derivable from the parent application, and maintained that the patent did not comply with the requirements of Article 76(1) EPC.

Article 76(1) EPC

2. Contrary to the assessment of the opposition division the patent as granted does not meet the requirements of Article 76(1) EPC.
 - 2.1 In this respect the respondent (opponent) maintained the argument put forward during the opposition proceedings that the joint foreseen in the system according to the embodiment of figure 7 of the parent application, on which claim 1 at stake was allegedly based, was not originally disclosed as being a generic joint, but rather a specific joint embodied according to any of the four embodiments in figures 2 to 5 of the parent application (reference was made to the passage on page 11, lines 13 to 15 thereof). The respondent (opponent) thus concluded that, contrary to the

assessment of the opposition division, the omission in claim 1 of some specific structural features of at least one of the specific joints disclosed in the parent application in combination with the riser system to which claim 1 at stake is directed, i.e. fluid chambers arranged between inner and outer pipe segments and separated by a radially extending piston, resulted in an intermediate generalisation which was not supported by the parent application and which, as such infringed, Article 76(1) EPC.

2.2 The appellant (patent proprietor) replied that a disclosure of a generic joint was provided on page 6, lines 26-29 of the parent application. However the Board, in accordance with the respondent (opponent), considers this passage as a mere introduction to the immediately following paragraphs starting on line 30 of the same page describing the specific embodiments of the joint according to the parent application. Furthermore, the joint mentioned in the passage cited by the appellant (patent proprietor) is not disclosed therein in combination with a control unit and an emergency disconnect package in the meaning of claim 1 as granted.

2.3 The appellant (patent proprietor) further argued that the *"joint"* disclosed in the parent application and applicable to the system in figure 7 was not necessarily one of those presented in figures 2 to 5, but that the joint could also be embodied as a *"weak link"* according to figure 6 as explained in the passages on page 10, lines 9-14 and page 11, lines 1 and 2. It was thus alleged that the following passages on page 11 cited by the respondent (opponent) stating that the riser shown in figure 7 may be used with *"all different embodiments [of the joint] described above"*

(see page 11, lines 13-14, emphasis added) and that figure 7 showed *"a riser 1 with a joint 20, according to the invention"* (see page 11, lines 14-15) were understood by the person skilled in the art as meaning that the riser in figure 7 could also comprise a joint different from the specific joints disclosed in figures 2 to 5, i.e the weak link according to figure 6.

2.4 Irrespective of the admissibility issue raised by the respondent (opponent) in respect of this line of argument allegedly presented for the first time at the appeal oral proceedings, this reasoning of the appellant (patent proprietor) is not convincing for the following reasons:

The Board concurs with the respondent (opponent) in that the wording of the passage on page 10 cited by the appellant (patent proprietor), reading in particular *"In addition to the joint as explained above there is the possibility of providing the riser with a special riser weak link, as shown in fig. 6"* (emphasis added) is understood as meaning that the *"riser weak link"* mentioned therein is a different component of the riser which can be provided in addition to the joint previously described and shown in figures 2 to 5. This interpretation makes also technically sense because a weak link is not just a joint, but a special connection introducing a weak point in a structure in such a way that an excessive load causes a breakage in that point, thereby preserving other more critical parts or components of the structure. Therefore, the reference to *"all different embodiments (of the joint) described above"* does not refer to the weak link of figure 6, which is a different element which can be optionally provided in combination with a joint, but to one of the joints shown in figures 2 to 5 only. In any case, even

by assuming that the weak link could be considered one of the possible kind of joint referred to in lines 13-14 of page 11, it is disclosed as comprising some specific structural features (see page 10, line 18 onwards) which are completely omitted in claim 1 whereby, also in this case, an unallowable intermediate generalisation of an embodiment of the parent application would take place.

- 2.5 In the decision under appeal the opposition decision argued in support of their conclusion that the requirements of Article 76(1) EPC were met, that the passage on page 11 reading *"The signal or signals transmitted from the joint to the control unit (60) may represent the pressure of the fluid in the riser, within the chambers of the joint, the extension of the joint, the stress in the riser or other values in relation to the operation of the joint"* prompted the person skilled in the art to the idea that - as the signal to be processed could be representative of different parameters, i.e. not only of the pressure within the fluid chambers - they would directly and unambiguously derive that any kind of joint could be used provided that it was suitable for transmitting one of these parameters to the control unit (60). This reasoning is not convincing because the fact that different parameters may be transmitted by the joint and used by the control unit does not change the fact that the only joints disclosed in combination with the embodiment in figure 7 are the specific joints in figures 2 to 5 and not any kind of joint. As convincingly argued by respondent (opponent) in this respect, even by assuming that in view of the passage above the person skilled in the art realizes that the provision of fluid chambers in the joint is not essential for the functionality to be achieved, the

description of the embodiment in figure 7 of the parent application forming the basis of claim 1 as granted does not still support the allegation of the opposition division that it can be directly and unambiguously derived from the parent application that any kind of joint may be used as presently implied by claim 1 as granted.

- 2.6 Therefore the Board concludes that independent claim 1 as granted is not supported by the originally filed parent application, whereby the requirements of Article 76(1) EPC are not met.

AUXILIARY REQUESTS

3. The issue raised above in respect of the main request analogously applies for the same reasons to all the auxiliary requests because the independent claim 1 thereof also defines a generic joint.
4. In view of the above, the decision of the opposition division to revoke the patent is confirmed, but on the ground of lack of compliance with Article 76(1) EPC. A decision on the assessment of novelty and inventive step of the opposition division contested by the appellant (patent proprietor) with their appeal, and on the further issues raised by the respondent (opponent) with their reply is thus not required.

Order

For these reasons it is decided that:

The appeal is dismissed

The Registrar:

The Chairman:



A. Voyé

G. Pricolo

Decision electronically authenticated