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**Datasheet for the decision
of 28 July 2022**

Case Number: T 0431/21 - 3.2.01

Application Number: 11846448.6

Publication Number: 2649269

IPC: E21B33/12

Language of the proceedings: EN

Title of invention:

EXTENDING LINES THROUGH, AND PREVENTING EXTRUSION OF, SEAL
ELEMENTS OF PACKER ASSEMBLIES

Applicant:

Halliburton Energy Services, Inc.

Headword:

Relevant legal provisions:

EPC Art. 111, 113(1)
EPC R. 103(1)(a), 137(3)
RPBA 2020 Art. 11

Keyword:

Right to be heard - substantial procedural violation (yes)
Reimbursement of appeal fee - violation of the right to be
heard (yes) - appealed decision sufficiently reasoned (no) -
equitable by reason of a substantial procedural violation
Remittal to the department of first instance (yes)

Decisions cited:

T 0233/12

Catchword:



Beschwerdekammern
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Case Number: T 0431/21 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 28 July 2022

Appellant: Halliburton Energy Services, Inc.
(Applicant) 10200 Bellaire Boulevard
Houston, TX 77072 (US)

Representative: Hoffmann Eitle
Patent- und Rechtsanwälte PartmbB
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 18 November
2020 refusing European patent application No.
11846448.6 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman G. Pricolo
Members: V. Vinci
A. Jimenez

Summary of Facts and Submissions

- I. The appeal was filed by the appellant (applicant) against the decision of the examining division to refuse the European patent application EP 11 846 448.

The examining division, in exercise of the discretion provided by Rule 137(3) EPC, decided not to consent to the amendments introduced in the main request and in the auxiliary requests 1 to 13, all requests filed on 28 July 2020. As the applicant did not file any further request during the oral proceedings and hence no agreement was reached on a text, the application was refused.

- II. With the statement of grounds of appeal the appellant (applicant) requested to set aside the decision of the examining division and to grant an European patent on the basis of the main request filed on 28 July 2020 or, in the alternative, on the basis of one of the auxiliary requests 1 to 13 filed with the main request. The appellant (applicant) further requested refund of the appeal fee under Rule 103(1)(a) EPC due to an alleged substantial procedural violation. In the event that the main request was considered not allowable, oral proceedings pursuant Article 116 EPC were requested.

- III. With a communication according to Article 15(1) RPBA dated 1 July 2022 the Board informed the appellant (applicant) of its preliminary assessment of the case according to which the request of reimbursement of the appeal fee under Rule 103(1)(a) EPC appeared justified due to a substantial procedural violation. The Board further informed the appellant (applicant) that, under

these circumstances, it intended to remit the case to the first instance department for further prosecution. With a letter dated 21 July 2022 the appellant (applicant) informed the Board that they agreed to the remittal of the case to the department of first instance and withdrew the request for oral proceedings.

IV. The arguments submitted by the appellant (applicant) can be summarized as follows:

The appellant (applicant) argued that the examining division came to the decision to disregard all the requests filed on 28 July 2020 by exercising its discretion under Rule 137(3) EPC in an unreasonable manner thereby exceeding the limits of the discretion. It was in particular criticized that the examining division did not correctly balance the applied criterion of the "*clear non-allowability*" with the legitimate interest of the applicant to obtain a valid patent. Furthermore, regarding the alleged substantial procedural violation, it was alleged that the appellant (applicant) was not given the opportunity during the oral proceedings to discuss the admissibility of each of the new requests separately and thus to explain how each of them was suitable for overcoming the "*prima facie*" objections raised under Article 84 EPC by the examining division. Finally, the appellant (applicant) pointed out that the decision of the examining division in the section relating to the "*clear non-allowability*" of all the requests filed on 28 July 2020 was not duly reasoned and substantiated because the extensive comments presented by the applicant in the response to the summons were not duly addressed. In the appellant's (applicant's) view, these circumstances amounted to a substantial procedural violation because the applicant's right to be heard guaranteed by Article

113 EPC has not been respected, this fact making the request of reimbursement of the appeal fee under Rule 103(1) (a) EPC equitable.

Reasons for the Decision

1. The Board comes to the conclusion that indeed the examining division exercised its discretion under Rule 137(3) EPC in an unreasonable manner thereby exceeding the limits of the discretion, and that the deficient reasoning in the contested decision gives rise to a substantial procedural violation in the meaning of Article 113(1) EPC and Rule 111(2) EPC detrimental to the appellant's (applicant's) right to be heard, these circumstances making the reimbursement of the appeal fee under Rule 103(1) (a) EPC equitable. The reasons are the following:

Exercise of the discretion under Rule 137(3) EPC

2. As decided in the similar case T 233/12 cited by the appellant (see reasons 6.2 of this decision) the Board agrees that the criterion that an amended set of claims is "prima facie" not allowable (so called "clear non-allowability") is, in general, an accepted principle (amongst others) to be taken into account in the assessment of whether consent under Rule 137 (3) EPC should be given to the amendment. However, the Board concurs with the appellant (applicant) that the examining division did not duly balance this criterion with the equally relevant principle of the legitimate interest of the appellant to obtain a valid patent. To come to this conclusion the Board considers, as also pointed out by the appellant (applicant), that the requests dated 28 July 2020 were filed in due time,

i.e. within the time limit set according to Rule 116(1) EPC, and that they are convergent, as also acknowledged by the examining division in its decision (see page 4). In fact each lower ranking auxiliary request is further limited with respect to the preceding higher ranking request by **incrementally** introducing additional features. Furthermore, the Board considers that the amendments filed by the appellant (applicant) in response to the summons to oral proceedings represent a fair attempt to overcome the "prima facie" objections raised therewith by the examining division under Articles 84 and 123(2) EPC.

In particular, in order to respond to the "prima facie" objection of the examining division that several features were allegedly essential for understanding the invention and for achieving the claimed technical effect and hence, as such, could not be omitted from the independent claims, the appellant (applicant) incrementally introduced in the main request and in the auxiliary requests at stake further technical features, like for example details concerning the arrangement, configuration and functionality of the "leaves", of the "end ring" and of the "annular seal element", as well as the clarification that the claimed packer assembly was for sealing an annulus formed between a tubular string and a wellbore. In the Board's view, as the amendments are considered at least to go in the right direction, the decision of the examining division to assess "prima facie", i.e. without discussing any of them in detail, that they were all unsuitable for overcoming the objections raised is not justified. In this respect the Board shares the appellant's (applicant's) view that discussing the alleged "clear non-allowability" for each request separately, as wished by the appellant (applicant), would have been

fair and appropriate and therefore should have not been denied by the examining division at the oral proceedings. Furthermore, the Board notes that the appellant (applicant) introduced in the method claim of each one of the newly filed main and auxiliary requests the corresponding features recited in the respective apparatus claim, thereby at least tentatively attempting to overcome the lack of correspondence objected by the examining division. Finally, the objection of the examining division that the fact that no adapted description was concurrently filed resulted in the impossibility to interpret the claims in the light of the description is not convincing and in itself does not justify the rejection of all the amendments under Rule 137(3) EPC. In fact the Board cannot see why, in the event that an interpretation of the scope of the claims in the light of the description was required and justified, also the originally filed description could not be used. Furthermore, the Board considers reasonable in the present case that the appellant (applicant), in view of procedural economy aspects, decided to postpone the adaptation of the description until agreement was reached on a set of claims according to common practice in examination proceedings at the EPO.

- 2.1 The same considerations and conclusions apply with the same reasons in respect to the "prima facie" objection raised under Article 123(2) EPC and to the amendments filed in reaction thereto.
- 2.2 For all the reasons above the Board thus concurs with the appellant (applicant) that the examining division exercised its discretion under Rule 137(3) EPC in an unreasonable manner and thereby exceeded the proper limits of its discretion.

Substantial Procedural Violation

3. Furthermore, the Board agrees with the appellant (applicant) that the reasoning presented in the section of the decision dealing with the alleged "clear non-allowability" issue in view of Article 84 EPC (see page 6, fourth full paragraph onwards) fails to explain why the detailed arguments presented in writing by the appellant (applicant) in support of the allowability of the requests filed on 28 July 2020 are not convincing. In fact in the relevant passages of the decision the examining division does not address or rebut these arguments in any way, but simply asserts the contrary.

3.1 As a matter of example, the Board observes that the appellant (applicant) with their reply to the summons to oral proceedings rebutted the objection of the examining division regarding the alleged lack of clarity of some expressions contained in claim 1 resulting from the omission of supposedly essential features and extensively substantiated their point of view. In particular, it was correctly argued that in order to assess whether a feature was essential or not, the technical problem addressed by the application must be considered, whereby any feature which did not contribute to solve this technical problem was not an essential feature and therefore did not need to be recited in the independent claim/s which otherwise would be unduly limited in scope. In this respect the appellant (applicant) explained for example why in their view it was not considered essential to recite in the independent claims how or under what circumstances the removable portion was removable, or to introduce the feature that two end rings and a seal element were

mounted on a base pipe. Furthermore, the appellant (applicant) substantiated their view that, contrary to the opinion of the examining division, it was clear for the person skilled in the art how and where a packer assembly in the meaning of claim 1 was used, what had to be understood in the technical context of claim 1 under "leaves", what their functionality was, what technical relation between the "annular seal element" and the "end ring" was foreseen, and so on, hereby singularly addressing all the points raised by the examining division. Furthermore, the appellant (applicant) precisely indicated the amendments in each one of the auxiliary requests.

- 3.2 The same considerations and conclusions apply with the same reasons to the objection raised under Article 123(2) EPC which was dealt with in detail by the appellant (applicant) in the reply to the summons.
- 3.3 In view of the above, the Board concludes that the examining division should have addressed the arguments provided by the appellant (applicant) in the decision under appeal and explained why they were considered not convincing, and not simply list the objections at stake and assert that the right to be heard was respected, as recited in the contested decision, page 6 onwards.
- 3.4 This deficiency in the decision under appeal gives rise indeed to a substantial procedural violation in the meaning of Article 113(1) EPC and Rule 111 (2) EPC in the sense that the decision is insufficiently reasoned and the appellant's (applicant's) right to be heard which encompasses the right to have their arguments considered in the written decision has not been respected. This circumstance also makes the reimbursement of the appeal fee under Rule 103(1)(a)

EPC equitable.

Remittal of the case

4. Finally the Board exercises the discretion provided by Article 111 EPC to remit the case to the department of first instance for further prosecution in view of the violation of the right to be heard of the appellant which constitutes a special reason to remit in the meaning of Article 11 RPBA, another special reason being that the examining division did not decide the new requests in the substance, but only the question of their admissibility. In this respect the Board observes that with letter dated 21 July 2023 the appellant (applicant's) agreed with the remittal of the case to the first instance department.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated