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**Datasheet for the decision
of 12 September 2022**

Case Number: T 0749/21 - 3.2.01

Application Number: 11794135.1

Publication Number: 2646639

IPC: E21B7/24, E21B17/07, F16F1/32

Language of the proceedings: EN

Title of invention:
VIBRATION TRANSMISSION AND ISOLATION

Applicant:
ITI Scotland Limited

Headword:

Relevant legal provisions:
EPC Art. 84, 111(1)
RPBA 2020 Art. 11

Keyword:
Claims - clarity (yes)
Remittal - (yes)

Decisions cited:

Catchword:



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Case Number: T 0749/21 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 12 September 2022

Appellant: ITI Scotland Limited
(Applicant) Atrium Court
50 Waterloo Street
Glasgow G2 6HQ (GB)

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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 22 January 2021
refusing European patent application No.
11794135.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman G. Pricolo
Members: J. J. de Acha González
P. Guntz

Summary of Facts and Submissions

- I. The appeal of the applicant lies against the decision of the Examining Division to refuse European patent application 11794135.1.
- II. In its decision the Examining Division held that:
- the subject-matter of claim 1 of the main request and of the first auxiliary request went beyond the content of the application as originally filed (Article 123(2) EPC; and
 - claim 1 of the auxiliary request 2 and claim 1 of auxiliary request 4 (corresponding to auxiliary request 3 now on file) were not clear (Article 84 EPC).
- III. With the statement of grounds of appeal, the appellant requested that the decision of the Examining Division be set aside, the claims of the main request be held allowable and the case be remitted to the Examining Division in order to grant a patent with a description to be adapted, or, in the alternative, that the claims of the auxiliary requests 1 to 3 filed therewith be held allowable and the case be remitted to the Examining Division in order to grant a patent with a description to be adapted.
- IV. In a communication pursuant to Article 15(1) RPBA 2020 (Rules of Procedure of the Boards of Appeal OJ EPO 2019, A63) dated 29 June 2022 the Board presented its preliminary view of the case. In particular, the Board pointed out that the subject-matter of claim 1 of the main request and of the auxiliary request 1 contravened Article 123(2) EPC and that claim 1 of the auxiliary

request 2 was not clear (Article 84 EPC) in line with the Examining Division's conclusions since these requests corresponded respectively to the main request and auxiliary requests 1 and 2 underlying the contested decision. However, in the Board's view claim 1 of the auxiliary request 3, which corresponded to auxiliary request 4 underlying the contested decision, was clear (Article 84 EPC). The Board further informed the appellant that it intended to remit the case to the Examining Division for further prosecution on the basis of the auxiliary request 3.

V. With letter dated 29 July 2022 the appellant withdrew the request for oral proceedings, the main request, and the auxiliary requests 1 and 2, on the condition that the application was remitted back to the Examining Division for further prosecution on the basis of Auxiliary Request 3.

VI. Oral proceedings set for 14 September 2022 were cancelled.

VII. Claim 1 of auxiliary request 3 (conditional main request) reads as follows:

"A resonance enhanced rotary drilling apparatus, which apparatus comprises:

- (a) a vibration damping and/or isolation unit; and*
- (b) a vibration enhancement and/or transmission unit,*

wherein the unit (a) and the unit (b) comprise a spring system comprising two or more frusto-conical springs arranged in series,

wherein:

- the spring system of the unit (a) satisfies the following equation:

$$\omega/\omega_{n1} \geq 2.3$$

- the spring system of the unit (b) satisfies the following equation:

$$0.6 \leq \omega/\omega_{n2} \leq 1.2$$

wherein ω represents an operational frequency of axial vibration of the resonance enhanced rotary drilling apparatus, ω_{n1} represents the natural frequency of the spring system of the unit (a); and ω_{n2} represents the natural frequency of the spring system of the unit (b), wherein the unit (a) is situated above an oscillator in the resonance enhanced rotary drilling apparatus, and wherein the unit (b) is situated below the oscillator in the resonance enhanced rotary drilling apparatus."

Reasons for the Decision

1. The subject-matter of claim 1 of auxiliary request 3 is based on claims 1, 2, 5, 6, 8 and 9 as originally filed and consequently meets the requirements of Article 123(2) EPC.
2. Claim 1 of auxiliary request 3 is clear (Article 84 EPC).
- 2.1 Auxiliary request 3 corresponds to auxiliary request 4 underlying the contested decision. The Examining Division held that claim 1 was not clear because it did not define a spring-mass system. Claim 1 made reference to a natural frequency which per definition was linked to a mass or inertia term. The latter remained undefined in the claim so that the natural frequency

could not be calculated and consequently the feature was unclear to the skilled person.

- 2.2 The Examining Division is correct that for a natural frequency to be defined a spring-mass system needs to be identified with the spring and its corresponding oscillating mass. This is known to the skilled person. However, it is clear for the skilled person from the wording of claim 1 which oscillating masses each of the spring systems (a) and (b) are supporting in the resonance enhanced rotary drilling apparatus claimed. The vibro-isolator spring system (vibration damping unit, (a)), which is positioned above the oscillator (also actuator, resonator), is supporting all the oscillating masses of the apparatus below it up to the drill-bit, and the spring (vibration transmission unit, (b)), which is positioned below the oscillator, is supporting also all the oscillating masses of the apparatus below it up to the drill-bit (see paragraph bridging pages 9 and 10; and paragraphs 2 and 3 on page 25 of the description as originally filed).
3. Consequently, the reason for refusing the auxiliary request 3 is incorrect. The appeal is therefore allowable.
4. The impugned decision is only based on Article 84 EPC for auxiliary request 3.

Under Article 111(1) EPC the Board of Appeal may either decide on the appeal or remit the case to the department which was responsible for the decision appealed.

Under Article 11 RPBA 2020 the Board may remit the case to the department whose decision was appealed if there are special reasons for doing so.

The Board holds that such special reasons are immediately apparent in the present case as the contested decision does not deal with the issues of novelty and inventive step (Articles 54 and 56 EPC) for any of the requests that were considered.

Under these circumstances and further considering that the appellant requested a remittal, the Board considers it appropriate to remit the case to the Examining Division for further prosecution.

5. Finally, as the appellant withdrew the request for oral proceedings within one month of notification of the communication issued by the Board in preparation for the oral proceedings and no oral proceedings took place, the appellant is entitled to a reimbursement of the appeal fee at 25% in accordance with Rule 103(4)(c) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution.
3. The appeal fee is reimbursed at 25%.

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated