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**Datasheet for the decision  
of 9 January 2023**

**Case Number:** T 2093/21 - 3.2.01

**Application Number:** 14813826.6

**Publication Number:** 3011132

**IPC:** E21B43/22, C09K8/58, C09K8/582

**Language of the proceedings:** EN

**Title of invention:**  
BIOLOGICAL AUGMENTATION OF LOW SALINITY WATER FLOODING TO  
IMPROVE OIL RELEASE USING NUTRIENT SUPPLEMENTATION

**Applicant:**  
Titan Oil Recovery, Inc.

**Headword:**

**Relevant legal provisions:**

EPC Art. 111, 113(1)  
EPC R. 111(2)  
RPBA 2020 Art. 11, 12(2), 12(4)

**Keyword:**

Appeal decision - remittal to the department of first instance (yes)

Amendment to case - request - amendment within meaning of Art. 12(4) RPBA 2020 - exercise of discretion - complexity of amendment (no) - amendment clearly identified (yes) - suitability of amendment to address issues (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 2093/21 - 3.2.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.01**  
**of 9 January 2023**

**Appellant:** Titan Oil Recovery, Inc.  
(Applicant) 9595 Wilshire Boulevard  
Suite 303  
Beverly Hills, California 90212 (US)

**Representative:** Forresters IP LLP  
Skygarden  
Erika-Mann-Straße 11  
80636 München (DE)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted on 8 July 2021  
refusing European patent application No.  
14813826.6 pursuant to Article 97(2) EPC.

**Composition of the Board:**

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

## **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 N° 14813826.
- II. In its decision on the state of the file issued by means of the EPO standard form 2048.2 the examining division held that the sole request on file did not meet the requirements of Articles 83, 84 and 123(2) EPC and thus refused the application.
- III. With their statement of grounds of appeal the appellant (applicant) requested to set aside the contested decision due to a substantial procedural violation and to remit the case to the first instance department for further prosecution on the basis of a new main request filed therewith. Reimbursement of the appeal fee under Rule 103(1) (a) EPC was also requested. Should these requests not be granted, oral proceedings pursuant to Article 116 EPC were requested.
- IV. With a communication according to Rule 100(2) EPC dated 17 November 2022 the Board informed the appellant (applicant) of its preliminary assessment of the case according to which it intended to remit the case to the examining division for further prosecution on the basis of the main request on file, which was deemed to be admissible, but considered the request for reimbursement of the appeal fee under Rule 103(1)(a) EPC not justified. With the same communication the appellant (applicant) was also invited to provide their comments within a period of 2 months.

V. With a letter dated 19 December 2022 the appellant (applicant) withdrew their request for reimbursement of the appeal fee. The case could thus be decided in writing.

VI. Claim 1 according to the main request at stake reads as follows:

*"A method for enhancing oil recovery, comprising the steps of:*

*determining a specific nutrient package used to initiate a microbiological response under actual reservoir conditions in combination with low salinity water injection;*

*applying the specific nutrient package to at least one targeted well to stimulate resident microorganisms to beneficially alter the resident microorganisms' hydrophobic properties so that interaction with oil contained in a reservoir rock formation is improved and optimize an effect of the low salinity water injection."*

## **Reasons for the Decision**

### **Admissibility of the Main Request**

1. The main request at stake was filed for the first time with the statement of grounds of appeal and thus represents an amendment of the party's case which, as such, may be admitted only at the discretion of the

Board pursuant to Article 12(4) RPBA 2020.

- 1.1 The Board considers that the circumstances of the case are such that the main request is to be admitted into the appeal proceedings for the following reasons:

With the main request at stake, the appellant seeks to remedy the objection raised under Article 123(2) EPC underlying the contested decision. There is no doubt that this request could have been filed in examination proceedings, in particular in response to the annex to the summons issued on 22 October 2020, where the reasons for non-compliance with Article 123(2) EPC were presented, rather than solely requesting a decision on the state of the file with letter dated 7 June 2021, i.e. two days before the date scheduled for the oral proceedings. Accordingly, with the main request the Board is put in a position in which, instead of reviewing the decision under appeal in a judicial manner (see Article 12(2) RPBA 2020), it has to decide whether to apply its discretion in the sense of to deal or not with the fresh case, i.e. not admitting it, admitting it and remitting the case to the examining division, or admitting it and deciding on the merits. However, considering for the reasons that will be explained herein below that the amendment made to the main request is of non-complex nature and has been clearly identified, that it clearly addresses and overcomes the objection raised under Article 123(2) EPC, and that the contested decision is also based on the grounds of non-compliance with the requirements of Article 83 and 84 EPC which have not been properly reasoned (see point 3.2 below), the Board finds that it is justified to exercise its discretion in the sense of admitting the main request in the appeal proceedings.

**ARTICLE 123(2) EPC**

2. The main request differs from the main request underlying the decision under appeal in that the amendment in independent claim 1 identified under point (b) of the annex to the summons dated 22 October 2020 and objected under Article 123(2) EPC by the examining division is reversed. As this was the only objection raised by the examining division under Article 123(2) EPC and the Board does not see any further issue in this respect, the main request is considered to meet the requirements of Article 123(2) EPC.

**ALLEGED PROCEDURAL VIOLATION / LACK OF REASONING**

3. The appellant (applicant) argued that the decision on the state of the file of the examining division was not reasoned in the meaning of Rule 111(2) EPC at least to the extent that the annex to the summons dated 22 October 2020 referred to in the EPO standard form 2048.2 did not contain any explanation as to why the amendments filed on 8 October 2020 did not overcome the objections raised under Articles 83 and 84 EPC in the previous summons dated 12 February 2020 and why the arguments submitted by the appellant (applicant) with letter dated 08 October 2020 in support of the allowability of the amended claims filed therewith were not convincing. In the appellant's (applicant's) view the above circumstances amounted to a violation of the applicant's right to be heard in the meaning of Article 113(1) EPC justifying the request to set aside the decision and to remit the case to the first instance department.
  - 3.1 In the EPO standard form 2048.2 used to issue the decision on the state of the file requested by the

appellant (applicant) with letter dated 7 June 2021, the examining division referred as reasons for the refusal of the application to three previous communications and in particular to the latest annex to the summons dated 22 October 2020 (and not 20 October 2020 as erroneously indicated in the form), thereby informing the appellant (applicant) that the application was likely to be refused under Article 97(2) EPC because the amendments filed on 8 October 2022 were considered to infringe Article 123(2) EPC and to be not suitable for overcoming the objections raised under Articles 83 and 84 EPC with the previous annex to the summons dated 12 February 2020.

- 3.2 The Board observes that in the annex to the summons dated 22 October 2020 referred to in the standard form, the examining division on the one side duly indicated the reasons for non-compliance with Article 123(2) EPC of the amended claims on file but, on the other side, merely copied (see points 1.2 to 1.8 of the annex) the reasons given in the previous annex summons dated 12 February 2020 (see points 1.1 to 1.7 of the annex) in support of the objections raised under Articles 83 and 84 EPC in respect of a previous set of claims no longer on file, i.e. the claims filed on 17 August 2017. By doing so the examining division failed to explain why the amended claims underlying the decision under appeal, beside being non-compliant with the requirements of Article 123(2) EPC, could not overcome the objections raised under Articles 83 and 84 EPC in the previous annex to the summons, and why the arguments submitted by the appellant (applicant) with the letter dated 8 October 2020 in support of the allowability of the amended claims filed therewith were not convincing. Therefore the Board concurs with the appellant (applicant) that the decision is not reasoned



in respect of Articles 83 and 84 EPC.

- 3.3 However, the Board is of the opinion that the fact that the objections under Articles 83 and 84 EPC have not been properly reasoned does not result in a substantial procedural violation in the meaning of Article 113(1) EPC negatively affecting the position of the appellant (applicant). In this respect it is observed that although it is not possible to infer from the content of the EPO standard form 2048.2 on which grounds the application was refused, it can be assumed that all grounds under Articles 83, 84 and 123(2) EPC mentioned in the latest annex to the summons dated 22 October 2020 apply. It follows that the refusal is anyway justified by the objection under 123(2) EPC, which is well reasoned in the meaning of Rule 111(2) EPC, and which also prompted the appellant to file an appeal and even remedy the lack of compliance with Article 123(2) EPC by filing a new main request with the statement of grounds of appeal.

#### **REMITTAL OF THE CASE**

- 3.4 The remittal of the case to the examining division for further prosecution under Article 111 EPC as requested by the appellant (applicant) is considered appropriate. Special reasons in the meaning of Article 11 RPBA are not only that the Board is now confronted with a fresh case which has not been decided by the first instance department, but also that, due to the lack of reasoning substantiated under point 3.2 above, it is not clear to what extent the arguments presented by the examining division in the annex to the summons dated 22 October 2020 in support of the objections raised under Articles 83 and 84 EPC apply to the previous and, as a consequence, to the present main request. Furthermore,

compliance with Articles 54, 56 EPC has also not been assessed.

## 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.

The Registrar:

The Chairman:



A. Voyé

G. Pricolo

Decision electronically authenticated