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**Datasheet for the decision  
of 19 September 2023**

**Case Number:** T 0953/22 - 3.2.05

**Application Number:** 13831970.2

**Publication Number:** 2923127

**IPC:** F16L1/16, F16L1/20, F16L13/02

**Language of the proceedings:** EN

**Title of invention:**  
MECHANICALLY LINED PIPE

**Patent Proprietor:**  
TechnipFMC Subsea France

**Opponent:**  
Subsea 7 Limited

**Relevant legal provisions:**  
EPC Art. 69(1), 100(c), 123(3)  
EPC R. 139  
RPBA 2020 Art. 12(3), 12(5), 12(6), 13(2)

**Keyword:**

Correction of error - obvious error (no)  
Ground for opposition - added subject-matter (yes)  
1st and 2nd auxiliary requests - protection conferred by the granted patent extended (yes)  
3rd auxiliary request - requirements of Art. 12(3) RPBA 2020 met (no) - request admitted (no)  
4th, 5th and 6th auxiliary requests - requests not admitted by opposition division - circumstances of appeal case justify admittance (no)  
7th and 8th auxiliary requests - amendment after summons - exceptional circumstances (no) - taken into account (no)

**Decisions cited:**

G 0002/88, G 0003/89, G 0011/91, G 0001/93, T 1149/97,  
T 0431/03, T 0142/05, T 2221/10, T 2475/18, T 1473/19

**Catchword:**

An amendment to a figure of the patent as granted may extend the protection conferred by the patent even if the claims and the description remain unamended (see point 3 of the Reasons).



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Case Number: T 0953/22 - 3.2.05

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.05**  
**of 19 September 2023**

**Appellant:** TechnipFMC Subsea France  
(Patent Proprietor) 1BIS Place de la Défense  
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**Representative:** Murgitroyd & Company  
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**Respondent:** Subsea 7 Limited  
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**Representative:** Weal, Emily Teresa  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 10 February  
2022 revoking European patent No. 2923127  
pursuant to Articles 101(2) and 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** T. Vermeulen  
**Members:** M. Holz  
T. Karamanli

## Summary of Facts and Submissions

- I. The patent proprietor appealed against the opposition division's decision revoking European patent No. 2 923 127 (the patent), which is based on international application No. PCT/IB2013/002894 (European patent application No. 13 831 970.2 after entry into the European phase before the European Patent Office (EPO)).
- II. The following documents submitted during the opposition proceedings are cited in this decision.
- D2: T. Tkaczyk et al., "*Fatigue and Fracture Performance of Reeled Mechanically Lined Pipes*", Proceedings of the Twenty-second (2012) International Offshore and Polar Engineering Conference, Rhodes, Greece, 17 to 22 June 2012, pages 603 to 612
- D3: D. Wilmot et al., "*The Suitability of CRA Lined Pipes for Flowlines Susceptible to Lateral Buckling*", SUT Global Pipeline Buckling Symposium, 23 to 24 February 2011
- D4: DE 196 38 225 A1
- D5: CN 101462193 A
- D16: E.S. Focke, "*Reeling of Tight Fit Pipe*", PhD thesis, Technische Universiteit Delft, ISBN 978-90-9021849-6, 2007
- III. By communication dated 22 March 2023, the parties were summoned to oral proceedings before the board scheduled to take place on 19 September 2023.

IV. In a subsequent communication under Article 15(1) RPBA 2020 (OJ EPO 2021, A35), the board set out its preliminary opinion on the case.

V. Oral proceedings before the board were held on 19 September 2023.

VI. Requests

The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained as granted, i.e. the opposition be rejected, (main request), or, as an auxiliary measure, that the patent be maintained as amended on the basis of the claims according to one of the 1<sup>st</sup> to 3<sup>rd</sup> auxiliary requests filed by letter dated 25 January 2021, or according to one of the 4<sup>th</sup> to 6<sup>th</sup> auxiliary requests filed at the oral proceedings before the opposition division on 18 January 2022, or according to the 7<sup>th</sup> auxiliary request filed as the 8<sup>th</sup> auxiliary request by letter dated 12 September 2023 or according to the 8<sup>th</sup> auxiliary request filed as the 9<sup>th</sup> auxiliary request by letter dated 12 September 2023.

The respondent (opponent) requested that the appeal be dismissed. The respondent further requested that the case be remitted to the opposition division for further consideration of the grounds for opposition under Article 100(a) EPC and Article 100(b) EPC "*if the board finds that the ground for opposition under Article 100(c) EPC does not prejudice the maintenance of the patent as granted or that any of the appellant's auxiliary requests meets the requirements of Article 123(2) and (3) EPC*".

VII. **Claim, description and figure versions**

(a) Claim 1 as granted (corresponding to the appellant's main request) reads (the feature identification employed by the board is included in square brackets):

" **[1A]** A reelable mechanically lined pipe (MLP) (30) able to be reeled onto a reel (10) having a radius  $R$ , and formed from a plurality of pipe joints (A, B, C) having conjoining girth welds (36), and comprising at least a liner (32) and an outer pipe (34), the outer pipe having an outer diameter,  $D_H$ , and a wall thickness,  $t_h$ , the MLP having a radial insertion gap  $g$ , and **[1B]** wherein the liner thickness,  $t$ , is less than or equal to a value calculated by formula I:

$$t = a_{00}(\varepsilon D^{0.75})^0 g^0 + a_{01}(\varepsilon D^{0.75})^0 g^1 + a_{10}(\varepsilon D^{0.75})^1 g^0 + a_{11}(\varepsilon D^{0.75})^1 g^1 + a_{20}(\varepsilon D^{0.75})^2 g^0 + a_{21}(\varepsilon D^{0.75})^2 g^1 + 0.16 \quad (I)$$

where:

$t$  is in mm:

$a_{00}, a_{01}$ , are constants defined by Table 1:

$lj$	$a_{lj}$
00	2.39846
01	-0.239488
10	-5.48161
11	2.35153
20	6.50598
21	-1.37840

$\varepsilon = (D_H/2)/[(D_H/2)+R]$  is the maximum reeling strain,  
 $g$  is in mm, and  
 $D = D_H - 2t_H$ , wherein  $D_H$  and  $t_H$  are in mm;  
characterised in that **[1C]** the ends of each pipe joint terminate with overlay welds of a length in the range of  $L_{min} = 100$  mm and  $L_{max} = 4D_H$ ."

Figure 4 of the patent as granted is reproduced below:

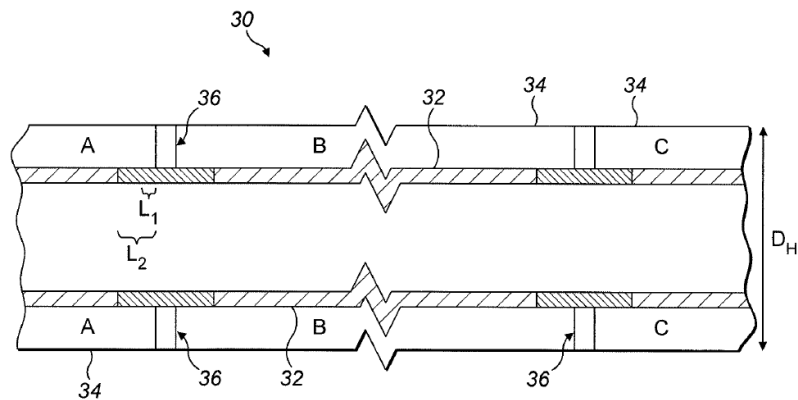


FIG. 4

(b) Figure 4 of the appellant's 1<sup>st</sup> auxiliary request is reproduced below:

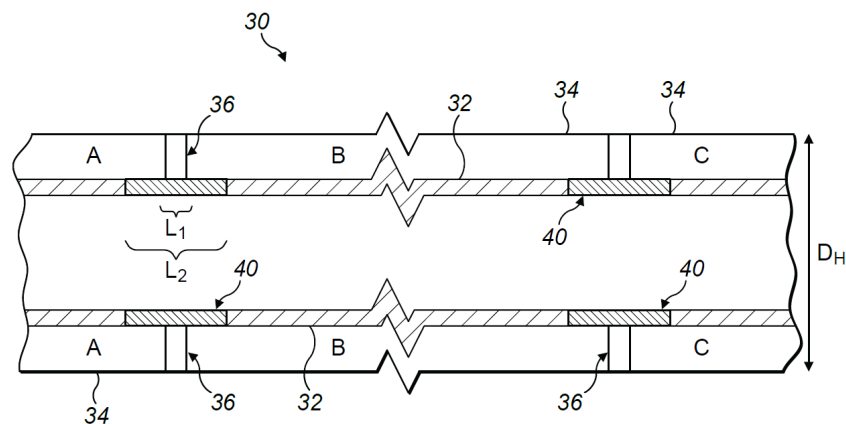
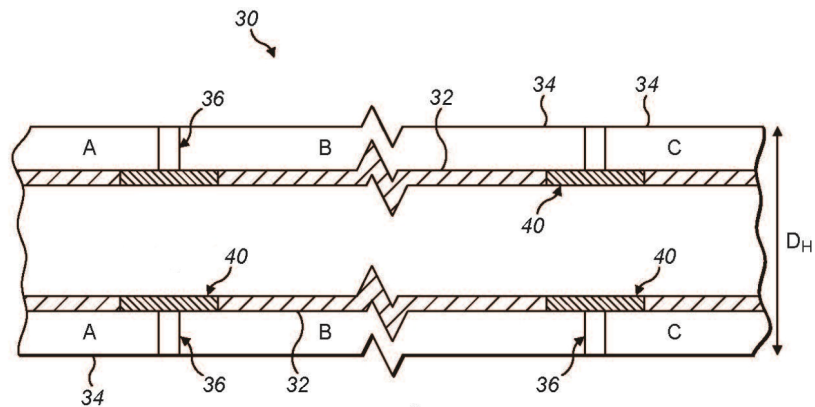


FIG. 4

The claims of the appellant's 1<sup>st</sup> auxiliary request are the same as the claims as granted.

(c) Figure 4 of the appellant's 2<sup>nd</sup> auxiliary request is reproduced below:



**FIG. 4**

The claims of the appellant's 2<sup>nd</sup> auxiliary request are the same as the claims as granted.

(d) Claim 1 of the appellant's 3<sup>rd</sup> auxiliary request differs from claim 1 as granted in that the following feature 1D is included at the end of the claim:

"[1D] and wherein there is a difference in bending moment capacities between successive joints."

Figure 4 of the appellant's 3<sup>rd</sup> auxiliary request is identical to Figure 4 of the patent as granted.

(e) Claim 1 of the appellant's 4<sup>th</sup>, 5<sup>th</sup> and 6<sup>th</sup> auxiliary requests reads as follows:

"A method of manufacturing a reelable mechanically lined pipe (MLP) (30) able to be reeled onto a reel (10) having a radius  $R$ , and formed from a plurality of pipe joints (A, B, C) having conjoining girth welds (36), and comprising at least a liner (32) and an outer pipe (34), the outer pipe having an outer diameter,  $D_H$ , and a wall thickness  $t_H$ , the MLP having a radial insertion gap  $g$ , and wherein



the liner thickness,  $t$ , is less than or equal to a value calculated by formula I:

$$t = a_{00}(\varepsilon D^{0.75})^0 g^0 + a_{01}(\varepsilon D^{0.75})^0 g^1 + a_{10}(\varepsilon D^{0.75})^1 g^0 + a_{11}(\varepsilon D^{0.75})^1 g^1 + a_{20}(\varepsilon D^{0.75})^2 g^0 + a_{21}(\varepsilon D^{0.75})^2 g^1 + 0.16 \quad (I)$$

where:

$t$  is in mm:

$a_{00}$ ,  $a_{01}$ , are constants defined by Table 1:

$lj$	$a_{ij}$
00	2.39846
01	-0.239488
10	-5.48161
11	2.35153
20	6.50598
21	-1.37840

$\varepsilon = (D_H/2)/[D_H/2+R]$  is the maximum reeling strain,  $g$  is in mm, and

$D = D_H - 2t_H$  wherein  $D_H$  and  $t_H$  are in mm;

and wherein the ends of each pipe joint terminate with overlay welds of a length in the range of  $L_{min} = 100$  mm and  $L_{max} = 4D_H$ ;

and able to be reeled onto a reel (10) having the radius  $R$ , comprising at least the steps of:

(a) providing a plurality of pipe joints (A, B, C), each having the liner (32) and the outer pipe (34) as defined above;

(b) terminating the ends of each pipe joint with clad overlay welds whose length is in the range  $L_{min} = 100$  mm and  $L_{max} = 4D_H$ ;

(c) girth welding the pipe joints together to provide pipe sections; and

(d) girth welding the pipe sections together to provide the MLP."

Figure 4 of the appellant's 4<sup>th</sup> auxiliary request is the same as Figure 4 of the patent as granted.

Figure 4 of the appellant's 5<sup>th</sup> auxiliary request is the same as Figure 4 of the appellant's 1<sup>st</sup> auxiliary request.

Figure 4 of the appellant's 6<sup>th</sup> auxiliary request is the same as Figure 4 of the appellant's 2<sup>nd</sup> auxiliary request.

- (f) The appellant's 7<sup>th</sup> auxiliary request differs from the patent as granted in that Figure 4 and the following passages of the description are deleted: page 5, lines 25 and 26 and paragraphs [0036] to [0041]. In addition, the reference signs are removed from the claims.
- (g) The appellant's 8<sup>th</sup> auxiliary request differs from the patent as granted in that the following passage is included at the end of paragraph [0039] of the description:

*"The increase in length of the overlay welds is made by increasing the length of the overlay welds themselves, not by the subsequent girth welding of overlay welds together."*

VIII. The submissions of the parties relevant to this decision can be summarised as set out below.

(a) *Patent as granted - Correction under Rule 139 EPC*

(i) *Appellant*

The amendments in Figure 4 of the patent as granted represented an obvious correction of an obvious error in Figure 4 of the application as filed on which the contested patent was based. This correction met the requirements of Rule 139 EPC. It was obvious that an error within the meaning of Rule 139 EPC was present in the way lengths  $L_1$  and  $L_2$  were depicted in Figure 4 of the application as filed. The correction of that error was obvious. The person skilled in the art reading page 2, lines 8 to 13; page 3, line 22 to page 4, line 10; Figure 3; page 4, lines 25 to 27; page 5, line 5 to page 6, line 4; page 6, lines 25 to 30; page 7, lines 22 to 28; page 8, lines 1 to 10; page 10, lines 18 to 28 and page 11, lines 5 to 28 of the application as filed would have immediately understood that Figure 4 as filed was not correct since Figure 4 as filed was not consistent with page 11, lines 5 to 13 of the application as filed. From a linguistic viewpoint, the term "length" had to be understood as referring to the length of a single overlay weld. The skilled person reading page 11, last paragraph of the description as filed understood that  $L_2$  referred to the length of a single weld extending on one side of the girth weld only. Claim 1 as filed required that the "*ends of each pipe joint*" terminated with overlay welds. The skilled person therefore had to analyse each pipe joint, not the combined pipe, to look for two welds of a length in the range defined in claim 1 as filed. The invention disclosed in the application as filed was to increase the length of the overlay welds to overcome the mismatch problem set out on page 3, line 22 to page 4, line 10 of the application as filed. This problem was, however, not overcome when looking at Figure 4 as filed. A total length of the overlay welds of 100 mm was not an increase compared to a typical length of an overlay weld on one side of the girth weld

of 50 mm. The representation of  $L_1$  and  $L_2$  in Figure 4 as filed was inconsistent with the skilled person's common general knowledge on clad overlay welding of mechanically lined pipes (MLPs) demonstrated by documents D2, D3, D4, D5 and D16. The skilled person was aware that the standard length of an overlay weld was approximately 50 mm and would understand that this length applied to a single weld associated with a single pipe joint being measured inwardly from the end of the pipe joint. Therefore, when the skilled person read on page 11, lines 5 to 7 of the application as filed that, conventionally, the pipe on either side of the girth weld had internally welded clad overlay welds added thereto, which were typically 50 mm long, they would understand this to be consistent with conventional clad overlay welds extending to and terminating at the respective ends of each pipe joint, as described for example in documents D5 and D16. The skilled person referencing Figure 4 as filed would note that the indications of weld lengths  $L_1$  and  $L_2$  appeared to incorporate both clad overlay welds and the girth weld. This was in direct conflict with the common general knowledge of the skilled person and the understanding they would have reached from reading the description, i.e. that  $L_1$  was a conventional, internally applied clad overlay weld having a length measured from the end of the pipe joint inwards. From the common general knowledge, the skilled person knew that each end of the pipe joints had to be provided with an overlay weld before girth welding. Consequently, there was an overlay weld extending on each side of the girth weld (see the appellant's sketch attached as Annex 1 to the minutes of the oral proceedings before the board). It was technically not feasible for a clad overlay weld to extend past an end of a pipe, and certainly not across a girth weld. The

concept of a "total weld length" was a misnomer. It suggested a single continuous weld extending from one pipe joint, across the girth weld, to the second pipe joint. Such an arrangement was not practised or possible in the formation of MLPs, as the skilled person would well know.

(ii) *Respondent*

There had to be a high bar for the test under Rule 139 EPC, i.e. there had to be an obvious error, and the correction of that error had to be obvious to protect the public. There should be no doubt for the person skilled in the art. The appellant had not filed any evidence of the common general knowledge as alleged by it. There was no evidence that it would have been impossible to connect the pipe joints in ways other than explained by the appellant. Even if this was the only option, it would not prevent the length of the overlay welds from being defined as depicted in Figure 4 of the application as filed. That figure was consistent with page 11 and other parts of the application as filed. In the prior art, the length of the overlay welds was not always 50 mm, as shown by several documents on file.

(b) *Patent as granted - Ground for opposition under Article 100(c) EPC*

(i) *Appellant*

The subject-matter of the patent as granted did not extend beyond the content of the application as filed. The patent as granted narrowed the subject-matter disclosed in the application as filed. Figure 4 of the

patent as granted limited the subject-matter to one of the interpretations possible in the application as filed. Hence, nothing new had been added in Figure 4 of the patent as granted in comparison to Figure 4 of the application as filed. Figure 4 of the patent as granted did not define the invention but only showed that  $L_2$  was larger than  $L_1$ . A basis for the amendment of this figure was clearly and unambiguously found on page 11 of the application as filed.

(ii) *Respondent*

Figure 4 of the patent as granted was not clearly and unambiguously disclosed in the application as filed. Figure 4 of the application as filed disclosed what the length was. Changing this length in Figure 4 of the patent as granted resulted in added subject-matter under Article 100(c) EPC. There was no basis in the application as filed for changing the measurement of  $L_2$  to what was shown in Figure 4 of the patent as granted. In view of this figure, the skilled person would take a different interpretation from that of the application as filed.

(c) *The appellant's 1<sup>st</sup> auxiliary request - Objection under Article 123(3) EPC*

(i) *Appellant*

Article 69(1), second sentence, EPC required generally taking account of the description and the drawings when interpreting a patent claim. However, a discrepancy between the claims and the description was not a valid reason to ignore the clear linguistic structure of a claim and to interpret it differently or to give a

different meaning to a claim feature which in itself imparted a clear credible technical teaching to the skilled reader (see T 2221/10, T 431/03 and T 1473/19, point 3.16.1 of the Reasons). The amendment in Figure 4 of the 1<sup>st</sup> auxiliary request could not extend the protection conferred by the patent as granted. The claims had not changed compared to the patent as granted, so the protection was not extended. The characterising portion of claim 1 was clear and unambiguous, so there was no need for the skilled person to fill any gap by consulting the figures. Figure 4 of the patent as granted only showed that  $L_2$  was larger than  $L_1$ . Neither of these parameters was mentioned in the claims. The skilled person knew that Figure 4 of the 1<sup>st</sup> auxiliary request was wrong, so they would not use this figure to interpret the claims.

(ii) *Respondent*

The appellant's 1<sup>st</sup> auxiliary request did not meet the requirements of Article 123(3) EPC. In the characterising portion of claim 1 as granted, the length could be interpreted in different ways. The skilled person would consult paragraph [0039] and Figure 4 of the patent as granted. From there, it was clear that it was the length of the overlay welds on one side of the girth weld that was meant in claim 1 as granted. The skilled person needed Figure 4 of the patent as granted to understand the claim. This was also the only example in the patent. In view of Figure 4 as amended according to the appellant's 1<sup>st</sup> auxiliary request, however, it was evident that the length of the overlay welds was the total length of the overlay welds. In the case in hand, there was no contradiction between the claims and the description/figures, so that decision T 431/03 did not apply.

Decision T 1473/19 did not apply because in the case in hand the person skilled in the art needed Figure 4 to understand claim 1 of the contested patent. This was true for both the patent as granted and the patent as amended according to the appellant's 1<sup>st</sup> auxiliary request. Since these figures differed in how the length of the overlay welds was depicted, the respective claim 1 was interpreted differently. As an example, an arrangement with a total length of the overlay welds of 160 mm, i.e. 80 mm on either side of the girth weld (see the respondent's sketch attached as Annex 2 to the minutes of the oral proceedings before the board) was not covered by claim 1 as granted but was within the extent of the protection conferred by the patent as amended according to the appellant's 1<sup>st</sup> auxiliary request.

(d) *The appellant's 2<sup>nd</sup> auxiliary request - Objection under Article 123(3) EPC*

(i) *Appellant*

Paragraph [0037] of the patent implied that "conventional" overlay welds were the same as the overlay welds of the invention. Therefore, removing the wrong reference signs in Figure 4 did not add, or delete, any subject-matter.

(ii) *Respondent*

By removing the reference signs in Figure 4, two different interpretations were possible: that of the main request, which led to a violation of Article 123(2) EPC, or that of the 1<sup>st</sup> auxiliary



request, which led to a violation of Article 123(3) EPC.

(e) *The appellant's 3<sup>rd</sup> auxiliary request - Admittance*

(i) *Appellant*

The skilled person was aware of the process for manufacturing a reelable MLP. The manufacturing steps set out in claim 7 of the patent as granted were the conventional sequence in forming an MLP. The technical effect of the patent was to achieve a reelable MLP where there was "*a difference in bending moment capacities between successive joints*". This was not solved in the art. Thus, claim 1 of the 3<sup>rd</sup> auxiliary request required the formation of the clad overlay weld prior to the pipes being joined by a girth weld.

(ii) *Respondent*

The opposition division considered that feature 1D had no bearing on the issues under Article 123 EPC. The appellant's 3<sup>rd</sup> auxiliary request had been rejected as not allowable under Article 123(2) EPC for the same reason as the main request. The appellant's argument in support of claim 1 of the 3<sup>rd</sup> auxiliary request, in so far as it could be understood, appeared to relate to inventive step. It did not appear to have any bearing on the objection under Article 123(2) EPC. The appellant's argument did not appear to be responsive to the decision under appeal.

(f) *The appellant's 4<sup>th</sup>, 5<sup>th</sup> and 6<sup>th</sup> auxiliary requests - Admittance*

(i) *Appellant*

The 4<sup>th</sup>, 5<sup>th</sup> and 6<sup>th</sup> auxiliary requests should be admitted into the proceedings. These requests, and in particular the 5<sup>th</sup> auxiliary request, *prima facie* overcame the previously raised objections. These requests should have been admitted by the opposition division.

(ii) *Respondent*

There was no reason to deviate from the decision of the opposition division not to admit appellant's 4<sup>th</sup>, 5<sup>th</sup> and 6<sup>th</sup> auxiliary requests into proceedings.

(g) *The appellant's 7<sup>th</sup> and 8<sup>th</sup> auxiliary requests - Admittance*

(i) *Appellant*

The circumstances of the case in hand justified the filing of 8<sup>th</sup> and 9<sup>th</sup> auxiliary requests by letter of 12 September 2023. These requests were a direct response to the board's communication under Article 15(1) RPBA 2020, which had introduced new issues in the last two sentences of point 6.1.1 and in the first paragraph on page 26. Moreover, the amendments overcame all the previously raised objections.

(ii) *Respondent*

The board's communication under Article 15(1) RPBA 2020 was in line with the findings in the decision under appeal and the parties' submissions. The board's

preliminary opinion did not contain any new or surprising issues. There were no exceptional circumstances. The requests were not *prima facie* allowable.

## **Reasons for the Decision**

### 1. *Patent as granted - Correction under Rule 139 EPC*

For the correction of a description, claim or drawing to be allowable under Rule 139, second sentence, EPC, the boards apply a two-step approach (see "Case Law of the Boards of Appeal of the European Patent Office", Tenth Edition, July 2022 (Case Law), II.E.4.2.; see also opinion G 3/89 (OJ EPO 1993, 117) and decision G 11/91 (OJ EPO 1993, 125)). It must be established

(i) that it is obvious that an error is in fact present in the document filed with the EPO, the incorrect information having to be objectively recognisable by the skilled person using common general knowledge, and

(ii) that the correction of the error is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.

The appellant submits that it was obvious that an error was present in how lengths  $L_1$  and  $L_2$  were depicted in Figure 4 of the application as filed on which the contested patent is based (Figure 4 as filed). The appellant considers that this allegedly incorrect information was objectively recognisable by the skilled person using common general knowledge for the following reasons.

- A. The representation of  $L_1$  and  $L_2$  in Figure 4 as filed contradicted other parts of the application as filed.
- B. The representation of  $L_1$  and  $L_2$  in Figure 4 as filed was inconsistent with the skilled person's common general knowledge on clad overlay welding of mechanically lined pipes (MLPs), demonstrated, for example, by documents D2, D3, D4, D5 and D16.
- C. It was technically not feasible for a clad overlay weld to extend past an end of a pipe joint and certainly not across a girth weld.

For the following reasons, the board does not share this view.

1.1 *Alleged contradiction with other parts of the application as filed*

The only passage of the application as filed which makes explicit reference to the parameter  $L_2$  shown in Figure 4 as filed is on page 11, last paragraph and page 12, first paragraph. The last paragraph on page 11 reads:

*"Thus, as shown in figure 4, the present invention involves increasing the length of the overlay welds from  $L_1$  (as a 'standard' weld length, e.g. 50 mm) to  $L_2$ .  $L_2$  is between  $L_{2min} = 100$  mm and  $L_{2max} = 4D_H$ , where  $D_H$  is the outer diameter of host pipe. Clearly, in Figure 4,  $L_2 > L_1$ ."*

This passage defines  $L_2$  as "the length of the overlay welds". This definition is ambiguous as it establishes a relationship between a (single) length and (plural)

welds. This passage could be understood, when read in isolation, as defining that  $L_2$  is the length of a single overlay weld or the total length of the welds. When reading page 11, last paragraph in isolation, both interpretations are possible. This passage does not exclude the possibility that an overlay weld having a length  $L_2$  is composed of multiple segments welded together. Moreover, even if interpreted as the length of a single overlay weld, it cannot be determined from the cited passage whether the overlay weld extends only on one side or both sides of the girth weld.

The appellant submits that the skilled person reading the above passage of the description as filed understood that  $L_2$  referred to the length of a single weld extending on one side of the girth weld only.

The board agrees that this may be one of several ways the cited passage of the description as filed can be understood from a linguistic viewpoint. However, while on page 11, line 7 the expression "*length of clad overlay weld*" (i.e. both "length" and "weld" in singular) is used, this does not necessarily imply that the expression "*length of the overlay welds*" used on page 11, last paragraph must be understood as referring to the length of a single overlay weld. Moreover, such an interpretation contradicts the depiction of  $L_2$  in Figure 4 as filed, where  $L_2$  extends on both sides of the girth weld.

The appellant refers to several other passages of the application as filed to support its view that the skilled person would understand that  $L_2$  referred to the length of a single weld extending on one side of the girth weld only. Firstly, the appellant refers to page 11, second paragraph of the description as filed.

This passage relates to a conventional pipe. However, the invention disclosed in the application as filed is different from a conventional pipe (see page 11, second paragraph: "*Conventionally, ...*" and the third paragraph: "*However, the present invention ...*"). It is not evident to what extent the invention disclosed in the application as filed (whose description starts on page 11, third paragraph) incorporates the details of conventional pipes referred to on page 11, second paragraph. The same holds true in view of page 2, lines 11 to 13 of the application as filed, which relates to the length of overlay welds "[a]ccording to common practice".

Page 11, last paragraph of the application as filed, when read in the context of the previous paragraphs on that page, can be interpreted by the skilled person in the way suggested by the appellant, i.e. that, in the MLP of the invention, the clad overlay welds are arranged in the same way as in the conventional pipes described on page 11, second paragraph. However, this is not the only way this passage can be construed (see above). Moreover, as set out above, such an interpretation contradicts the representation of  $L_2$  in Figure 4 as filed. The skilled person faced with different possible alternatives for understanding the passage on page 11, last paragraph would not choose an interpretation that contradicts the representation in a figure explicitly mentioned in that paragraph as showing length  $L_2$ .

The appellant considers that claim 1 as filed required that the ends of each pipe joint terminate with overlay welds. In its view, the skilled person therefore had to analyse each pipe joint, not the combined pipe, to look

for two welds of a length in the range defined in claim 1 as filed.

However, claim 1 as filed is not directed to a pipe joint but to an MLP formed by a plurality of pipe joints. Such an MLP is shown in Figure 4 as filed. The skilled person would understand that Figure 4 as filed shows an MLP in which the ends of each pipe joint (A, B, C) terminate with overlay welds. Such an interpretation is consistent with claim 1 as filed and is possible regardless of whether the overlay weld terminates at the end of the pipe joint or whether the same overlay weld extends across the girth weld to the adjacent pipe joint. In claim 1 as filed, it is possible that the length refers to the total length of the overlay welds at the ends of two neighbouring pipe joints.

The appellant sets out that the aim of the invention disclosed in the application as filed was to increase the length of the overlay welds to overcome the mismatch problem set out on page 3, line 22 to page 4, line 10 of the application as filed. In its view, this problem was, however, not overcome when looking at Figure 4 as filed since a total length of the overlay welds of 100 mm was not an increase compared to a typical length of a weld on one side of the girth weld of 50 mm.

Page 11, lines 25 to 27 of the application as filed discloses that "[...] as shown in figure 4, the present invention involves increasing the length of the overlay welds from  $L_1$  (as a 'standard' weld length, e.g. 50 mm) to  $L_2$ ". This is consistent with Figure 4 as filed since this figure shows that  $L_2$  is larger than  $L_1$ . It is thus not obvious that there is an error in how lengths  $L_1$

and  $L_2$  are depicted in Figure 4 as filed. Nor is this obvious in view of the disclosure on the technical problem and its possible solutions on page 6, lines 26 to 28; page 4, line 25 to 27; page 5, line 5 to page 6, line 4; page 7, lines 22 to 28; page 8, lines 1 to 10 and page 10, lines 18 to 28 (the latter referring to Figure 3) of the application as filed. Moreover, the values of 50 and 100 mm are not shown in Figure 4 as filed. Even if there was an error with these values, this error would not obviously reside in how  $L_1$  and  $L_2$  are depicted in Figure 4 as filed. The value of 50 mm is given on page 11, line 26 of the application as filed, but only as an example. It is therefore not obvious that a total length of the overlay welds of 100 mm does not increase the "standard" length.

1.2 *Alleged inconsistency with the skilled person's common general knowledge*

The appellant submits that the representation of  $L_1$  and  $L_2$  in Figure 4 as filed was inconsistent with the skilled person's common general knowledge on clad overlay welding of MLPs, demonstrated, for example, by documents D2, D3, D4, D5 and D16.

As set out above, it is not unambiguous that the arrangement of the clad overlay welds in the context of page 11, last paragraph of the application as filed corresponds to that of a conventional MLP. A reference to conventional pipes is made on page 11, second paragraph as filed. Figure 4 as filed, however, does not disclose such a conventional pipe. According to page 9, lines 5 and 6 of the application as filed, this figure is "*a cross-sectional longitudinal view through a portion of a reelable MLP according to one embodiment of the present invention*". The skilled person would



thus not expect  $L_1$  to correspond to any element of the MLP shown in Figure 4 as filed.  $L_1$  is merely shown as a reference to illustrate that length  $L_2$  is longer than  $L_1$  (as explicitly disclosed on page 11, last paragraph of the application as filed).

Documents D2 and D3 are scientific articles, and documents D4 and D5 are patent documents. Common general knowledge, however, does not normally include patent literature and scientific articles (see also Case Law, I.C.2.8.2). Document D16 is a doctoral thesis. The appellant referred to Figures 7.17 and 7.18 on page 135 of document D16. These figures illustrate test pieces used in the experiments of the doctoral thesis (see the last paragraph on page 133, the first paragraph on page 134, and the second and third paragraphs on page 135). The board is not convinced that these figures belong to the common general knowledge.

Nor does the application as filed include any reference to document D2, D3, D4, D5 or D16. It is not disclosed that the overlay welds described on page 11, last paragraph of the application as filed are produced in the same way as in any of these documents. More importantly, there is no reference in the application as filed to any of these documents regarding the definition of length  $L_2$ . Moreover, the fact that clad overlays are formed in a specific way in the prior art does not exclude the possibility that clad overlays can also be formed in a different way, irrespective of whether this is common in the art.

The appellant submits that the skilled person was aware that the standard length of an overlay weld was approximately 50 mm and understood that this length

applied to a single weld associated with a single pipe joint being measured inwardly from the end of the pipe. Therefore, when the skilled person read on page 11, lines 5 to 7 of the application as filed that, conventionally, the pipe on either side of the girth weld had internally welded clad overlay welds added thereto, which were typically 50 mm long, they would understand this to be consistent with conventional clad overlay welds extending to and terminating at the respective ends of each pipe joint, as described for example in documents D5 and D16.

The board does not share this view. Firstly, as set out above, the cited passage on page 11, lines 5 to 7 of the application as filed refers to conventional pipes. It is not unambiguous that the "invention" described starting on page 11, line 15 of the application as filed involves the same arrangement as conventional pipes. Secondly, Figure 7.18 on page 135 of document D16 (reproduced below) indicates that the length of the clad overlay weld on one side of the girth weld is 25 mm. In this figure, this would make the total length of the clad overlay welds 50 mm. If the appellant's argument is accepted that conventional clad overlay welds typically have a length of 50 mm, the corollary would be that overlay welds do not extend to and terminate at the respective ends of each pipe joint.

The appellant sets out that the skilled person referencing Figure 4 as filed would note that the indications of weld lengths  $L_1$  and  $L_2$  appeared to incorporate both clad overlay welds and the girth weld. This was in direct conflict with the common general knowledge of the skilled person and the understanding they would have reached from reading the description,

i.e. that  $L_1$  was a conventional, internally applied clad overlay weld having a length measured from the end of the pipe inwards.

As set out above, on page 11, second paragraph of the application as filed, length  $L_1$  is associated with a conventional pipe. Figure 4 as filed, however, does not show such a conventional pipe. The skilled person would not expect  $L_1$  to correspond to any element of the MLP shown in Figure 4 as filed. Moreover, as explained above, it is not evident that the definition of parameter  $L_2$  is identical to a common definition of an overlay clad weld length. Furthermore, contrary to the appellant's assertion, it is possible that the length of a clad overlay weld covers at least a portion of the width of the girth weld (see for example Figure 7.18 of document D16, reproduced below). In this figure, the angled slope of the bevelled pipe end causes the clad overlay weld to extend across at least a portion of the width of the girth weld.

### 1.3 *Alleged lack of technical feasibility*

The appellant submits that a clad overlay weld could only extend to and must terminate at the end of the pipe joint. It was not possible for a clad overlay weld to extend past the end of a pipe, and it was certainly not possible for a clad overlay weld to extend across a girth weld. The skilled person would therefore have noticed that the representation in Figure 4 as filed was incorrect.

The appellant, however, has not convincingly shown that, in the end product, a clad overlay weld could only extend to and must terminate at the end of the pipe joint. As an example, from Figure 7.18 on page 135

of document D16, it is apparent that, after the bevelling step, the overlay weld extends beyond the end of the pipe joint:

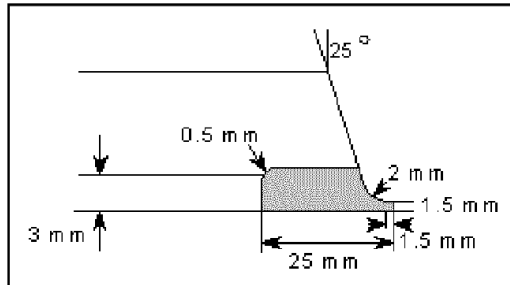


Figure 7.18 Detailed Tight Fit Pipe circumferential weld geometry (not to scale)

The same holds true for Figure 1 of document D2. There, too, the clad overlay weld extends beyond the bevelled end of the pipe joint (e.g. the "Host pipe"):

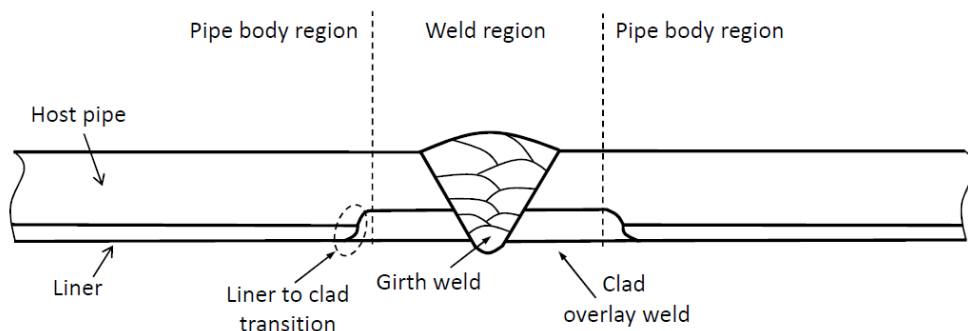


Figure 1. Lined Pipe Regions.

The same holds true for Figure 3 of document D5:

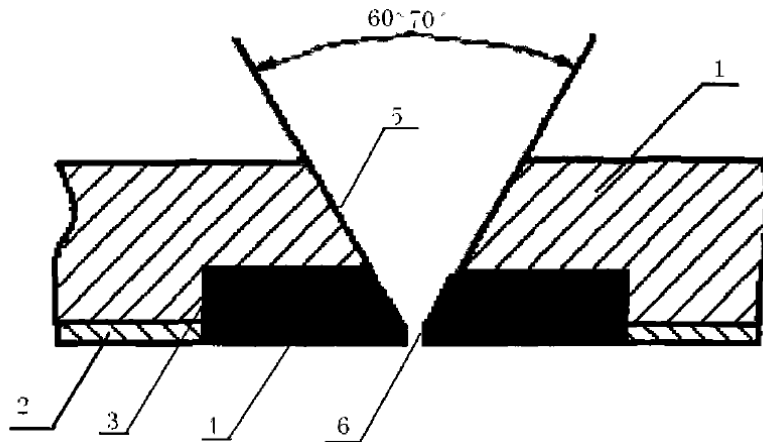


图 3

Therefore, the appellant's allegation that clad overlay welds could only extend to and must terminate at the end of the pipe joint is not correct. Whether, during the production of the pipe, there is an intermediate state in which the overlay clad weld terminates at the end of the pipe joint (as shown, for example, in Figure 2 of document D5) is not relevant to the question in hand for claim 1 as granted.

The appellant considers that the concept of a "total weld length" was a misnomer. It suggested a single continuous weld extending from one pipe joint, across the girth weld, to the second pipe joint. Such an arrangement was not practised or possible in the formation of MLPs, as the skilled person would well know.

As set out above, even assuming that the arrangement of one clad overlay weld on either side of the girth weld is conventional, this does not imply that such an arrangement was implicitly understood by the skilled person reading the last paragraph of page 11 of the description in the context of Figure 4 as filed.

Moreover, the appellant has not convincingly shown that an arrangement of a clad overlay weld extending beyond the end of a pipe joint was technically impossible (the above figures from the cited prior-art documents suggest the contrary). However, even if this were the case, this would not lead to the conclusion that the depiction of  $L_2$  in Figure 4 as filed was obviously incorrect. The application as filed does not exclude the possibility that the overlay clad weld having a total length  $L_2$  is composed of two segments welded together.

- 1.4 Consequently, there is no obvious error within the meaning of Rule 139 EPC in how lengths  $L_1$  and  $L_2$  are depicted in Figure 4 of the application as filed on which the contested patent is based. For this reason alone, the amendments in Figure 4 of the patent as granted do not meet the requirements for a correction under Rule 139 EPC.

2. *Patent as granted - Ground for opposition under Article 100(c) EPC*

The appellant submits that the patent as granted "reduced" the subject-matter disclosed in the application as filed. Figure 4 of the patent as granted limited the subject-matter to one of the interpretations possible in the application as filed. Hence, nothing new had been added in Figure 4 of the patent as granted in comparison to Figure 4 as filed.

As set out above, the last paragraph on page 11 can be understood, when read in isolation, as defining that  $L_2$  is the length of a single overlay weld or the (total) length of the combined overlay welds. However, the

former interpretation contradicts the depiction of  $L_2$  in Figure 4 as filed where  $L_2$  extends on both sides of the girth weld. Hence, in view of the application as filed as a whole, and in particular the reference to Figure 4 in the last paragraph on page 11, the only interpretation possible is that  $L_2$  is the total length of the overlay welds. In contrast to the appellant's view, Figure 4 of the patent as granted does not merely show that  $L_2$  is larger than  $L_1$ . This figure also depicts  $L_2$  as extending on one side of the girth weld only. For the reasons set out above, such an interpretation does not have a basis in the application as filed. In view of Figure 4 of the patent as granted, the subject-matter of the patent thus extends beyond the content of the application as filed.

The ground for opposition under Article 100(c) EPC therefore prejudices the maintenance of the patent as granted.

3. *The appellant's 1<sup>st</sup> auxiliary request - Objection under Article 123(3) EPC*

3.1 According to Article 123(3) EPC, the European patent may not be amended in such a way as to extend the protection it confers. For the purposes of Article 123(3) EPC, Article 69(1) EPC and the Protocol on the Interpretation of Article 69 EPC (the Protocol) are relevant (see Case law, II.E.2.3.1; see also decision T 2475/18, point 2.3 of the Reasons). Article 69(1) EPC provides that the extent of the protection conferred by a European patent or a European patent application is determined by the claims. Nevertheless, the description and drawings are used to interpret the claims.

The board notes that the wording of Article 123(3) EPC is not identical to the wording of Article 123(3) EPC 1973, which reads: "**The claims of the European patent may not be amended during opposition proceedings in such a way as to extend the protection conferred.**" (emphasis added by the board). However, the case law on Article 123(3) EPC 1973 makes it clear that the extent of protection under Article 69 EPC 1973 and the Protocol is determined by the wording of the claims, taking into account the description and drawings, and that amendments to the description and drawings may therefore also extend the protection under Article 69(1) EPC 1973 (see e.g. G 2/88, OJ EPO 1990, 93, point 4 of the Reasons; G 1/93, OJ EPO 1994, 541, point 11 of the Reasons; T 1149/97, OJ EPO 2000, 259, point 6.1.10 of the Reasons and T 142/05). For this reason, the basic principles analysed in the case law on Article 123(3) EPC 1973 are applicable to Article 123(3) EPC as well. In decision T 142/05, point 4 of the Reasons, the board held that amendments to the description and drawings could modify the content of the claims and possibly extend the scope of protection under Article 69(1) EPC 1973, even where the wording of the claims was clear and remained unamended.

3.2 In the case in hand, claim 1 of the appellant's 1<sup>st</sup> auxiliary request is identical to claim 1 as granted. Feature 1C of that claim defines that "*the ends of each pipe joint terminate with overlay welds of a length in the range of  $L_{min} = 100 \text{ mm}$  and  $L_{max} = 4D_H$* ". In view of the case law cited above, the description and drawings are used to determine both the extent of the protection conferred by the patent as granted and the extent of the protection conferred by the patent as amended according to the 1<sup>st</sup> auxiliary request.



Paragraph [0039] of the description of the patent as granted discloses that the length of the overlay welds is shown as  $L_2$  in Figure 4. According to the appellant's 1<sup>st</sup> auxiliary request, paragraph [0039] remains unamended. However, Figure 4 of the appellant's 1<sup>st</sup> auxiliary request differs from Figure 4 of the patent as granted. In Figure 4 of the patent as granted, length  $L_2$  of the overlay welds is depicted as extending on only one side of the girth weld. In contrast, in Figure 4 of the appellant's 1<sup>st</sup> auxiliary request, length  $L_2$  of the overlay welds is depicted as the total length of the overlay welds on both sides of the girth weld. The extent of the protection conferred by the patent as amended according to the appellant's 1<sup>st</sup> auxiliary request thus differs from the extent of the protection conferred by the patent as granted.

Using Figure 4 of the patent as granted to determine the extent of protection, an arrangement with a total length of the overlay welds of 160 mm, i.e. 80 mm on either side of the girth weld, (see the respondent's sketch attached as Annex 2 to the minutes of the oral proceedings before the board) is not within the extent of the protection conferred by the patent as granted. However, the same arrangement lies within the extent of the protection conferred by the patent as amended according to the appellant's 1<sup>st</sup> auxiliary request, which is determined using Figure 4 of the appellant's 1<sup>st</sup> auxiliary request.

In decision G 2/88, the Enlarged Board of Appeal held:  
*"In the case of a change in the technical features of the invention, if the technical features of the claimed invention after amendment are more narrowly defined, the extent of the protection conferred is less; and if*

*such technical features are less narrowly defined as a result of amendment, the protection conferred is therefore extended.*" (point 4.1 of the Reasons).

In view of its amended Figure 4, the protection conferred by the patent as amended according to the appellant's 1<sup>st</sup> auxiliary request has been extended compared to the protection conferred by the patent as granted, as can be seen from the above considerations on an arrangement with a total length of the overlay welds of 160 mm.

- 3.3 The appellant's counter-arguments are not convincing for the following reasons.
- 3.3.1 The appellant submits that the skilled person knew that Figure 4 of the 1st auxiliary request was wrong, so they would not use this figure to interpret the claims. However, as set out above in point 1., the skilled person would not immediately recognise Figure 4 of the appellant's 1<sup>st</sup> auxiliary request (which is identical to Figure 4 as filed) as being incorrect. The question of whether a figure can be used to determine the extent of protection if the skilled person immediately recognises that figure to be incorrect can therefore be left open.
- 3.3.2 The appellant argues that a discrepancy between the claims and the description was not a valid reason to ignore the clear linguistic structure of a claim and to interpret it differently or to give a different meaning to a claim feature which in itself imparted a clear credible technical teaching to the skilled reader. It referred to decisions T 431/03, T 2221/10 and T 1473/19, point 3.16.1 of the Reasons.

In accordance with the basic principles of the case law cited above (see point 3.1), the description and drawings are also taken into account for the purposes of Article 123(3) EPC if the claims are clear and unambiguous, so they are not only consulted to fill gaps.

3.3.3 Neither decision T 431/03 nor decision T 2221/10 are concerned with Article 123(3) EPC or Article 69 EPC or how the extent of protection is to be determined. These decisions are therefore not relevant to the case in hand.

3.3.4 Decision T 1473/19, point 3.16.1 of the Reasons, reads: *"Hence, although Article 69(1), second sentence, EPC requires that generally account be taken of the description and the drawings when interpreting a patent claim, the primacy of the claims under Article 69(1), first sentence, EPC limits the extent to which the meaning of a certain claim feature may be affected by the description and the drawings. The established case law of the Boards of Appeal that limiting features which are only present in the description but not in the claim **cannot** be read into a patent claim is thus fully compatible with relying on Article 69 EPC in conjunction with Article 1 of the Protocol as a legal basis for determining a patent claim's subject-matter."* (emphasis added by the board).

The board does not consider the aforementioned statement in decision T 1473/19 to be fully applicable to the case in hand.

Firstly, in light of Article 1 of the Protocol and the case law of the Enlarged Board of Appeal, the board, while also recognising the primacy of the claims under

Article 69(1) EPC, would not in the case in hand go so far as to say that the disclosure of the description and the figures could not be read into the patent claim. Under Article 1, first sentence, of the Protocol, *"Article 69 EPC should not be interpreted as meaning that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims"*. Nor should Article 69 EPC *"be taken to mean that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patent proprietor has contemplated"* (Article 1, second sentence, of the Protocol). Article 69 EPC *"is to be interpreted as defining a position between these extremes which combines a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties"* (Article 1, third sentence, of the Protocol). The Enlarged Board of Appeal found that the *"object of the Protocol is clearly to avoid too much emphasis on the literal wording of the claims when considered in isolation from the remainder of the text of the patent in which they appear; and also to avoid too much emphasis upon the general inventive concept disclosed in the text of the patent as compared to the relevant prior art, without sufficient regard also to the wording of the claims as a means of definition"* (see G 2/88, point 4 of the Reasons). In its decision G 1/93, the Enlarged Board of Appeal confirmed the key role of the claims but also the necessity of using the description and drawings to determine the extent of protection when applying Article 123(3) EPC: *"In principle, it does not matter whether the addition*

*concerns the claims, the description or the drawings, since the protection conferred by the patent has to be determined by all these elements in accordance with Article 69 EPC and the Protocol on the interpretation of this provision. However, the claims are no doubt the most important element in this respect."* (point 11 of the Reasons).

Secondly, the facts in case T 1473/19 are different from those in the case in hand since in the former the objection under Article 123(3) EPC was raised against a request with claims that were amended compared to the patent as granted, whereas in the latter the amendment is only to one of the figures of the patent as granted. In the case in hand, neither feature 1C nor the other features of claim 1 as granted define how the length of the overlay welds is to be understood. It is only by using the description and the drawings, in particular Figure 4 as granted, or, in the case of the 1<sup>st</sup> auxiliary request, Figure 4 as amended, that the extent of protection for the purposes of Article 123(3) EPC can be determined. Figure 4 as granted or amended is thus not used to read limiting features into claim 1 that are not present in this claim but to determine the extent of the protection conferred by the patent as granted or by the patent as amended, respectively.

- 3.4 In view of the above, the protection conferred by the patent as amended according to the appellant's 1<sup>st</sup> auxiliary request extends beyond that of the patent as granted. The patent as amended according to the appellant's 1<sup>st</sup> auxiliary request therefore does not comply with Article 123(3) EPC.

4. *The appellant's 2<sup>nd</sup> auxiliary request - Objection under Article 123(3) EPC*

The appellant sets out that paragraph [0037] of the patent implied that "conventional" overlay welds were the same as the overlay welds of the invention. Therefore, removing the wrong reference signs in Figure 4 did not add, or delete, any subject-matter.

The board does not share this view. Claim 1 of the 2<sup>nd</sup> auxiliary request is identical to claim 1 as granted and claim 1 of the 1<sup>st</sup> auxiliary request. As set out above, this claim does not include a definition of the length of the overlay welds. To determine the extent of the protection of the patent as granted and also amended, the description and the drawings need to be consulted. Paragraph [0039] of the patent as granted, which has not been amended according to the 2<sup>nd</sup> auxiliary request, discloses that the length of the overlay welds is depicted as  $L_2$  in Figure 4. According to Figure 4 as granted, length  $L_2$  of the overlay welds extends on only one side of the girth weld. Since Figure 4 of the appellant's 2<sup>nd</sup> auxiliary request does not show length  $L_2$  at all, the length of the overlay welds is undefined. The protection conferred by the patent amended according to the appellant's 2<sup>nd</sup> auxiliary request is thus extended compared to that of the patent as granted with respect to the length of the overlay weld.

Consequently, the appellant's 2<sup>nd</sup> auxiliary request does not comply with Article 123(3) EPC.

5. *The appellant's 3<sup>rd</sup> auxiliary request - Admittance*

In point 5.1 of the Reasons for the decision under appeal, the opposition division concludes that the appellant's 3<sup>rd</sup> auxiliary request contravened Article 123(2) EPC. The only reference to the 3<sup>rd</sup> auxiliary request in the statement of grounds of appeal is in point 6.3. The board cannot derive from the appellant's submission why the above reasoning of the opposition division would be incorrect. Hence, the appellant's submissions on its 3<sup>rd</sup> auxiliary request do not meet the requirements of Article 12(3) RPBA 2020. The board thus has discretion not to admit this request under Article 12(5) RPBA 2020. It is not self-explanatory that the requirements of Article 123(2) EPC are met for this request, i.e. that the opposition division's conclusion was apparently incorrect.

The board, exercising its discretion under Article 12(5) RPBA 2020, therefore decided not to admit the appellant's 3<sup>rd</sup> auxiliary request into the appeal proceedings.

6. *The appellant's 4<sup>th</sup>, 5<sup>th</sup> and 6<sup>th</sup> auxiliary requests - Admittance*

The appellant filed its 4<sup>th</sup>, 5<sup>th</sup> and 6<sup>th</sup> auxiliary requests for the first time in the oral proceedings before the opposition division. The opposition division took the view that the discussion on these auxiliary requests would essentially be a repetition of the discussions for the main, 1<sup>st</sup> and 2<sup>nd</sup> auxiliary requests. Considering the late stage of the proceedings and the criterion of clear allowability, the opposition division did not admit the appellant's 4<sup>th</sup>, 5<sup>th</sup> and 6<sup>th</sup> auxiliary requests into the opposition proceedings (see point 6.1 of the Reasons for the decision under appeal

and points 12 and 13 of the minutes of the oral proceedings before the opposition division).

In accordance with Article 12(6), first sentence, RPBA 2020, the board does not admit requests, facts, objections or evidence which were not admitted in the proceedings leading to the decision under appeal unless the decision not to admit them suffered from an error in the use of discretion or unless the circumstances of the appeal case justify their admittance.

The appellant's submissions do not allow the conclusion that the opposition division's decision not to admit the 4<sup>th</sup>, 5<sup>th</sup> and 6<sup>th</sup> auxiliary requests suffered from an error in the use of discretion. The appellant's view that these requests, and in particular the 5<sup>th</sup> auxiliary request, *prima facie* overcame the previously raised objections and that they should have been admitted by the opposition division, does in itself not imply that the opposition division's decision suffered from an error in the use of discretion. Nor has the appellant convincingly shown that the circumstances of the appeal case justified their admittance. Such reasons are not apparent to the board either.

The board, exercising its discretion under Article 12(6), first sentence, RPBA 2020, decided not to admit the appellant's 4<sup>th</sup>, 5<sup>th</sup> and 6<sup>th</sup> auxiliary requests into the appeal proceedings.

7. *The appellant's 7<sup>th</sup> and 8<sup>th</sup> auxiliary requests - Admittance*

The 7<sup>th</sup> and 8<sup>th</sup> auxiliary requests were filed by the appellant's letter dated 12 September 2023, i.e. after



notification of the summons to oral proceedings. In accordance with Article 13(2) RPBA 2020, any amendment to a party's appeal case made after notification of a summons to oral proceedings is, in principle, not taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

The appellant's view that the amendments in its 7<sup>th</sup> and 8<sup>th</sup> auxiliary requests overcame all the previously raised objections does, in itself, not represent exceptional circumstances justified with cogent reasons within the meaning of Article 13(2) RPBA 2020.

Moreover, the board shares the respondent's view that the board's communication under Article 15(1) RPBA 2020 is in line with the findings in the decision under appeal and the parties' submissions and that it does not contain any new or surprising issues. The last two sentences of point 6.1.1 of that communication refer to the interpretation that the length of the overlay welds refers to the total length of the overlay welds at the ends of two neighbouring pipe joints. This interpretation of the length of the overlay welds as the total length of these welds had been previously given, for example, on page 14, first paragraph and page 15, first paragraph of the Reasons for the decision under appeal. See also point 4.15 of the statement of grounds of appeal ("the combination of the overlay welds of both adjoining pipe joints"). On page 26, first paragraph of the communication under Article 15(1) RPBA 2020, the board set out that it was inclined to share the conclusion reached in decision T 142/05, cited by the opposition division in point 3.1 of the Reasons for the decision under appeal, that amendments to the description and drawings could change

the content of the claims and possibly extend the protection under Article 69(1) EPC, even if the wording of the claims was clear and remained unchanged.

The board is thus satisfied that the passages of the communication under Article 15(1) RPBA 2020 cited by the appellant do not contain any new objections or aspects.

In view of the above, there are no exceptional circumstances within the meaning of Article 13(2) RPBA 2020 in the case in hand.

Therefore, the board, exercising its discretion under Article 13(2) RPBA 2020, decided not to admit the appellant's 7<sup>th</sup> and 8<sup>th</sup> auxiliary requests into the appeal proceedings.

8. *Conclusions*

The ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent as granted. The appellant's 1<sup>st</sup> and 2<sup>nd</sup> auxiliary requests do not meet the requirements of Article 123(3) EPC. The board exercised its discretion and did not admit the appellant's 3<sup>rd</sup> to 8<sup>th</sup> auxiliary requests into the proceedings. Since none of the appellant's requests is allowable, the appeal must be dismissed.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



A. Pinna

T. Vermeulen

Decision electronically authenticated