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**Datasheet for the decision  
of 4 February 2025**

**Case Number:** T 1357/23 - 3.2.07

**Application Number:** 18164404.8

**Publication Number:** 3441558

**IPC:** E21B33/04, E21B33/038

**Language of the proceedings:** EN

**Title of invention:**

PROTECTED ANNULUS FLOW ARRANGEMENT FOR SUBSEA COMPLETION  
SYSTEM

**Patent Proprietor:**

OneSubsea IP UK Limited

**Opponent:**

FMC Technologies, Inc.

**Headword:**

**Relevant legal provisions:**

EPC Art. 123(2)

RPBA 2020 Art. 13(2)

**Keyword:**

Amendment after notification of Art. 15(1) RPBA communication  
- deletion of claims - taken into account (yes)  
Amendments - extension beyond the content of the application  
as filed (no) - allowable (yes)  
Late-filed objection - circumstances of appeal case justify  
admittance (no)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**

**Boards of Appeal**

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**Case Number: T 1357/23 - 3.2.07**

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.07**  
**of 4 February 2025**

**Appellant:** FMC Technologies, Inc.  
(Opponent) 1803 Gears Road  
Houston, TX 77067 (US)

**Representative:** Fish & Richardson P.C.  
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**Respondent:** OneSubsea IP UK Limited  
(Patent Proprietor) 100 New Bridge Street  
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**Representative:** Schlumberger Intellectual Property Department  
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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
6 June 2023 concerning maintenance of the  
European Patent No. 3441558 in amended form.**

**Composition of the Board:**

**Chairman** G. Patton  
**Members:** V. Bevilacqua  
Y. Podbielski

## **Summary of Facts and Submissions**

I. The present appeal was filed by the opponent against the opposition division's decision to maintain European patent No. 3 441 558 in amended form according to the main request filed during the opposition proceedings.

II. The appellant requested:

- that the decision be set aside and that the patent be revoked in its entirety.

The patent proprietor (respondent) requested in its reply to the statement setting out the grounds of appeal:

- that the appeal be dismissed and the patent thus be maintained on the basis of the request held allowable by the opposition division (main request),  
or, if the decision was set aside,
- that the patent be maintained according to one of:
  - the first or second auxiliary requests, first filed with the reply to the statement setting out the grounds of appeal, or
  - the third to seventh auxiliary requests, respectively corresponding to the first to fifth auxiliary requests filed during opposition proceedings by letter of 23 March 2023.

III. In preparation for oral proceedings, the board issued a communication pursuant to Article 15(1) RPBA 2020, in which it gave its preliminary opinion that the patent in suit was likely to be revoked.

IV. In response to the board's communication, the respondent issued a letter dated 31 January 2025 with which it filed new second and third auxiliary requests.

V. Oral proceedings before the board took place on 4 February 2025.

During oral proceedings, the respondent filed a new auxiliary request and an amended description and then withdrew all claim requests except this new auxiliary request which was therefore renamed as the (new) main request.

At the conclusion of the proceedings, the appellant requested

- that the decision be set aside and that the patent be revoked in its entirety,

and the respondent requested

- that the patent be maintained in amended form according to the main request.

At the end of oral proceedings, the decision was announced.

VI. Independent **claim 1 of the main request** reads as follows (amendments with respect to claim 1 as originally filed are in bold, emphasis added by the board):

"A system for use in a subsea well application **(20)**, comprising: a monobore subsea installation **(22)** having: a tubing head spool **(26)** disposed above a wellhead **(28)**; a tubing hanger **(36)** engaged with the tubing head

spool (26); a subsea tree (24) coupled to the tubing head spool (26) over the tubing hanger (36) and forming a plenum region (72) between the tubing hanger (36) and the subsea tree (24) ~~and an annulus stab;~~

**characterized in that:**

**the plenum region has a gallery area (76) formed in the plenum region by at least one annulus stab (62), extending between the tubing hanger (36) and the subsea tree ~~to~~ (24) which provides an isolated path within the at least one annulus stab (62) and through the plenum region, where the gallery area is protected from exposure to the annulus flow of well fluids, the plenum region comprising components (74) that are positioned in or along the plenum region (72), where the components (74) are protected from the annulus flow of well fluids by the at least one annulus stab (62), the isolated path further being routed through the tubing hanger (36) until exiting out through a side of the tubing hanger (36) to the tubing head spool (26) to accommodate an annulus flow path (46) along the monobore subsea installation (22)."**

VII. The arguments of the parties of relevance to the decision are dealt with in detail in the reasons for the decision.

## Reasons for the Decision

1. Main request - admittance
  - 1.1 The main request was filed during oral proceedings before the board.
  - 1.2 The appellant asked for the main request not to be taken into account under Article 13(2) RPBA, as it was filed after notification of a communication under Article 15(1) RPBA.

This amendment of the respondent's case should not be taken into account, according to the appellant, because the respondent had not provided any exceptional circumstances for having submitted it during oral proceedings before the board.

Moreover, again according to the appellant, the respondent additionally failed to provide reasons as to why the amendments made to this request overcame the "second objection" of added subject-matter raised against the set of claims held allowable by the opposition division (see decision under appeal, points II.14.5 and II.14.6 as well as the board's communication, point 3).

- 1.3 The board disagrees, and notes that the main request is based upon the third auxiliary request filed with the reply to the statement of grounds of appeal, whereby all method claims 11 to 14 were deleted. The third auxiliary request corresponds to auxiliary request 1 filed during the opposition proceedings with the respondent's letter dated 23 March 2023.

Contrary to what has been put forward by the appellant, when the third auxiliary request was filed (see the reply to the statement setting out the grounds of appeal, pages 21 and 22), the respondent did provide reasons as to why the amendments made to this request overcame the objections of added subject-matter raised against the set of claims held allowable by the opposition division.

The board also acknowledges the presence of exceptional circumstances (Article 13(2) RPBA) and on that basis has decided to take the main request into account, for the following reasons.

- 1.3.1 As discussed above, claims 1 to 10 of the main request correspond to claims 1 to 10 of the third auxiliary request filed with the reply to the statement of grounds of appeal and to claims 1 to 10 filed in auxiliary request 1 by letter of 23 March 2023 during opposition proceedings.
- 1.3.2 At no point during the opposition proceedings nor during the written phase of the appeal proceedings did the appellant raise any specific objection against these claims.
- 1.3.3 Furthermore, such a new request, being limited solely to the product claims of a request which was already on file, does not change the scope of the appeal proceedings despite being an amendment to the respondent's case, taking also into consideration the parties' written submissions.

This is because the deletion of an entire category of claims from a request which is already on file does not

introduce any new issues to be considered; indeed, on the contrary, removal of the method claims simplifies the proceedings.

Given that no specific objection has been raised against the claims of the new request neither in opposition proceedings nor in appeal proceedings, and since it neither alters the factual or legal framework of the proceedings, nor requires a reassessment of the subject-matter on file, the board considers that the above circumstances can be seen as exceptional and as allowing the discretion provided for in Article 13(2) RPBA to be exercised (see the Case Law of the Boards of Appeal, 10th Edition 2022, CLB in the following, V.A.4.5.5 g)).

2. Main request - added subject matter, "second objection"

2.1 The appellant argued, for the first time at the oral proceedings before the board, that the main request did not overcome the "second objection" of added subject-matter raised against the set of claims held allowable by the opposition division (see again decision under appeal, points II.14.5 and II.14.6 as well as the board's communication, point 3).

In this respect the appellant argued that claim 1 of the main request should be interpreted as comprising the feature that

**"all** the components positioned in or along the plenum region are protected".

According to the appellant, this feature meant that claim 1 of the main request still involved technical teaching going beyond the content of the original

disclosure, for the reasons already set out on pages 5 to 8 of the statement setting out the grounds of appeal ("second objection") against the set of claims held allowable by the opposition division.

This is because both paragraphs [0002] and [0010] of the original disclosure clearly stated:

"The isolation of the annulus flow path within the monobore subsea installation serves to protect components exposed to the plenum region from contact with deleterious fluids in the annulus flow path."

Therefore, the technical teaching of the application as originally filed, as repeated at least twice, was that all components exposed to the plenum region were protected.

Claim 1 of the main request provided protection of only a subset of these originally protected components, namely only those which were "positioned in or along the plenum region".

Similarly to what had already been argued against the claim held allowable by the opposition division, while it was indeed true that the claim did not explicitly exclude protection of components exposed to the plenum region, it still specifically related to embodiments in which only some of those components were protected.

This situation was similar to the situation of claim 1 held allowable by the opposition division, where only components in the gallery area were protected.

The selection, made in claim 1 of the main request, of a particular subset of components amounted to new technical teaching because the original disclosure did

not provide any basis for distinguishing between the components exposed to the plenum region in terms of protection.

- 2.2 The board is not convinced by the above objection, and fully concurs with the respondent's position (reply to the statement of grounds, page 21) that the amendments made to claim 1 of the main request over claim 1 as originally filed are based on paragraphs [0023] and [0024] of the description as originally filed and therefore comply with the requirements of Article 123(2) EPC.

The appellant focused on the amendment clarifying that the plenum region

"comprises components that are positioned in or along the plenum region, where the components are protected from the annulus flow of well fluids by the at least one annulus stab."

The basis for this amendment is to be found in paragraph 23 of the description as originally filed, which states:

"Various components 74, e.g. sensors, electronics, seals, and other components susceptible to the deleterious effects well fluid, may be **positioned in or along the plenum region** 72. The stabs, e.g. stabs 56, 62, provide isolation and **protection for these components** 74 by containing both the production flow and annulus flow of fluids along the interior of subsea installation".

As a consequence of this, the "second objection" of added subject-matter against claim 1 of the main request cannot stand.

3. Main request - further objections

3.1 During oral proceedings before the board, the appellant also raised a new objection of added subject-matter (Article 123(2) EPC) according to which claim 1 of the main request could not be based on paragraph [0024] of the original description for the reasons explained in the statement setting out the grounds of appeal, last paragraph of page 13 to page 18.

The appellant then went on to argue that the scope of protection of claim 1 of the main request had been made wider than the scope of granted claim 1, in contravention of the requirements of Article 123(3) EPC.

This is because, for the reasons given in the statement setting out the grounds of appeal (in particular on page 5 thereof), while according to granted claim 1 only the components in the gallery area were protected from the annulus flow of well fluids, claim 1 of the main request now provided protection of all the components "positioned in or along the plenum region".

According to the appellant, both these objections should be taken into consideration because, despite being late filed, they were based on arguments which were submitted with the statement setting out the grounds of appeal.

As the new objections did not alter the factual and legal framework of the proceedings, it would go against the principles provided for in Article 114 EPC not to take them into consideration.

3.2 The board is not convinced by the above arguments and has decided not to take these objections into account (Article 13(2) RPBA).

3.2.1 The appellant acknowledged that these objections were an amendment to its case made after notification of the communication under Article 15(1) RPBA.

In principle, such an amendment shall only be taken into account if there are exceptional circumstances which have been justified with cogent reasons by the party concerned (Article 13(2) RPBA 2020).

3.2.2 In the present case, the board finds that the circumstances submitted by the appellant are not exceptional.

The late submission of new objections of extension of subject-matter beyond the content of the application as filed and extension of the protection conferred by the granted claims based on the same or similar arguments is not justified by the fact that patentability objections on the basis of lack of novelty and/or inventive step against the set of claims held allowable by the opposition division have been submitted on the basis of the arguments on pages 13 to 18 of the statement of grounds of appeal; instead this shows that there was nothing to prevent the appellant from filing these new objections at an earlier stage.

Similarly, the fact that an objection of added subject-matter has been submitted against the claim held allowable by the opposition division on the basis of the arguments on page 5 of the statement of grounds of appeal does not justify the late submission of a new objection under Article 123(3) EPC, but again shows

that there was nothing to prevent the appellant from filing this objection at an earlier stage.

The appellant also failed to identify any new or unforeseen development in the appeal proceedings which would justify late filing of this new line of argument (CLB, *supra*, V.A.4.5.1).

- 3.2.3 As discussed above, claims 1 to 10 of the main request correspond to claims 1 to 10 of a request which was already on file at the opposition stage of the proceedings and was re-submitted with the reply to the statement setting out the grounds of appeal. Therefore the appellant had already had an opportunity to file objections against these claims.

However the appellant failed to do so in the opposition proceedings and during the written phase of the appeal proceedings, and it was not until the oral proceedings before the board that the appellant raised objections specifically formulated against this subject-matter.

- 3.2.4 In addition, according to established case law (CLB V.A.4.5.8 c)), Article 114 EPC does not stipulate any absolute right to raise objections at any stage of the proceedings or a duty of the board to investigate matter of its own motion.

#### 4. Adapted description

At the oral proceedings, the respondent filed a description (page 2) adapted to the main request, to which neither the appellant nor the board had any objection.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent in amended form in the following version:
  - claims 1-10 of the main request filed as the new auxiliary request during the oral proceedings before the board on 4 February 2025,
  - description: page 2 filed during the oral proceedings before the board on 4 February 2025 and pages 3-5 of the patent specification,
  - figures 1-3 of the patent specification.

The Registrar:

The Chairman:



G. Nachtigall

G. Patton

Decision electronically authenticated