

Publication in the Official Journal ~~Yes~~ / No

File Number: T 687/90 - 3.2.3  
Application No.: 87 301 450.0  
Publication No.: 0 234 874  
Title of invention: Offshore platforms

Classification: E02B 17/02, E21B 43/01

DECISION  
of 16 March 1992

Applicant: British Gas plc

Headword:

EPC Article 123(2)

Keyword: "Content of original application" - "Disclosed complex of technically necessary features essential for definition of claimable subject-matter"

Headnote



Case Number : T 687/90 - 3.2.3

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.3  
of 16 March 1992

**Appellant :** British Gas plc  
Rivermill House  
152 Grosvenor Road  
London SW1V 3JL (GB)

**Representative :** Morgan, David J  
Patents Manager  
British Gas plc  
Rivermill House  
152 Grosvenor Road  
London SW1V 3JL (GB)

**Decision under appeal :** Decision of Examining Division of the European  
Patent Office dated 13 June 1990 refusing  
European patent application No. 87 301 450.0  
pursuant to Article 97(1) EPC.

**Composition of the Board :**

**Chairman :** C.T. Wilson  
**Members :** K.W. Stamm  
J. van Moer

**Summary of Facts and Submissions**

- I. European patent application No. 87 301 450.0, filed on 19 February 1987 and published on 2 September 1987 under publication No. 0 234 874, was refused by the decision of the Examining Division dated 13 June 1990 based on Claims 1 to 12 filed on 3 May 1990, independent Claims 3 and 4 introducing subject-matter which extended beyond the content of the application as filed.

Original Claims 1 and 4 read as follows:

"1. A marine structure including a hollow base, adapted to be flooded with water, at least one topsides deck and a plurality of hollow caissons connecting the topsides to the base, characterised in that each of said caissons comprises at least two telescopic sections, one section being arranged to move slidably within another and in that said topsides are adapted to permit passage therethrough of casings and drill strings directly into and out of the hollow regions of said caisson."

"4. A method for the installation of a marine structure is defined in any one of the preceding claims which comprises positioning the structure, whilst it is floating, over its location, with the telescopic sections of the caisson fully retracted, supporting the topsides, at least partially flooding the base, thereby causing the telescopic sections to extend and the base to sink to the sea-floor by reducing the support in the topsides, securing the base on the sea floor, raising the topsides and upper caisson sections to the desired working height and fixing the caisson sections to prevent relative movement therebetween."

Claims 3 and 4 underlying the decision read as follows:

"3. A method of installing a marine structure of the type including a topside deck (5) which at site is supported at a working level above sea level on a base (1) which is located on the sea floor, the method comprising supporting the deck (5) at a first position above the base (1), moving the base (1) to the point where the structure is to be sited, causing the base (1) to sink to the sea floor and then raising the deck (5) to a second position at which the deck (5) is at its working level, characterised in that the base (1) is caused to move by floating on the surface of the sea."

Claim 4 has a prior art portion identical with the one of Claim 3 and the following characterising portion:

"4. ..., characterized in that as the base (1) sinks, the deck (5) simultaneously descends to a level which is below the working level."

II. In its decision, the Examining Division found the deletion of five features in respect of Claims 3 and 4 not permissible since it regarded these features as being consistently presented by the original application as essential features of the invention. The decision also found the addition of three features not permissible. The features are summarised as follows:

(a) deleted features:

1. limitation to structures as defined in Claim 1;
2. fully retracted telescopic sections;
3. partially flooding the base;
4. securing the base to the sea floor;

5. raising the upper caisson sections to the desired working height and fixing the caissons to prevent relative movement therebetween.

(b) added features:

6. causing the base to move by floating on the surface of the sea (Claims 3 and 5);
7. deck simultaneously descending to a level below the working level (Claim 4):
8. conductors acting as piles in addition to being casings for the wall (Claim 12).

III. On 3 July 1990 the Appellants filed a Notice of Appeal against the decision together with the Statement of Grounds and paid the appeal fees. They are of the opinion that the amendments mentioned in the decision as unallowable deletions and additions "do not constitute added subject matter because they are clearly inessential features in defining the novelty of the inventions in Claims 3 and 4 over the prior art cited by the Examiner" (US-A-3 927 535) (Giblon). The Appellants submit that Claims 3 and 4 and dependent Claims 5 to 12 are allowable.

IV. The Appellants therefore request the Board to consider and to allow Claims 1 and 2, and to set aside the decision refusing Claims 3 and 4 (and Claims 5 to 12). Moreover, in their Statement of Grounds dated 20 June 1990 the Appellants state that they: "do not wish to jeopardise the entire application by their support of claims 3 to 12. Consequently the Appellants wish to add claims 13 to 17." This is understood by the Board as being an auxiliary request to consider new Claims 13 to 17 in place of Claims 3 to 12, should the Board consider the latter claims to be unallowable.

## Reasons for the Decision

1. The Appeal is admissible.

2. Main request

2.1 The following features of present Claim 1 are added to Claim 1 as originally filed:

- (a) "for installation at an offshore position"
- (b) "of the type" (adapted to be flooded with water)
- (c) "a topsides deck" (replacing: "at least one topside deck")
- (d) "legs" (replacing: "caissons")
- (e) "the deck" (replacing: "the topsides")
- (f) "each leg" (replacing: the hollow regions of said caisson),
- (g) "characterized in that the topsides deck (5) is mounted immovably on the upper end (4) of each leg."

Feature (a) is sufficiently disclosed in the third paragraph of the original application. Features (b) to (f) are considered as redactional amendments within the disclosed information. Feature (g) is regarded as an equivalent circumscription of "Secured to the upper end of the upper caissons is the superstructure or topsides" (lines 2 and 3 on page 4 of the description). The subject-matter of Claim 1 does not, therefore, extend beyond the content of the originally filed application.

2.2 Claim 2 reads: "A marine structure as claimed in Claim 1, characterised in that at least one of the legs is provided with a J-tube at the lower end thereof." This corresponds to lines 4 and 5 of the last paragraph of page 3 of the

description. The subject-matter of Claim 2 also does not extend beyond the content of the application as filed.

- 2.3 Method Claims 3, 4 and 5 refer to a marine structure without mentioning a hollow base. Such a hollow base was, however, clearly presented in the structure and in the method described and claimed in the original application as a defining feature, the technical necessity of which was evident and not questionable. No technical reason is presented in the application which would lead a skilled person to an interpretation of the application without assuming a hollow base. The subject-matter of Claims 3, 4 and 5 extends, therefore, beyond the content of the originally filed application.
- 2.4 Contrary to that what the Appellants appear to submit, taking account of the prior art does not allow to dismantle the originally disclosed interrelated complex of features and to replace it by any other partial composition which was not disclosed. Rule 29 (1)(a) EPC requires that those technical features which are necessary for the definition of the claimed subject-matter but which, in combination, are part of the prior art shall form the first portion of a claim, the remaining features which it is desired to protect forming the characterising portion.

The application as originally filed describes on two pages the prior art, a structure and a method as characterised in original Claims 1 and 4, understandable as solutions of a given problem according to Rule 27(1)(d) EPC. The following four pages of the description refer to preferred modes of operation and to the drawings as illustrating the invention. The claimed complex of features is described by its mere repetition only, and thus is to be regarded - lacking any further explanation - as necessary definition

of the subject-matter the protection of which is sought. No reason is given in this application which might justify questioning the necessity of the definitions given by original Claims 1 and 4.

Method Claims 6 to 12, dependent either directly or indirectly on Claims 3 to 5 must therefore share their fate.

3. Auxiliary request

3.1 Claim 13 integrates all the features which correspond to the original entity in Claims 4 and 1.

3.2 Claim 14 is based on original Claim 5; Claim 15 on the first paragraph of page 3 of the description; Claim 16 on point 12 on page 5 in combination with point 1; and Claim 17 (corrected to read "the wells" rather than "the wall" ?) on point 12, page 5 of the original description.

4. Summarising, the subject-matter of Claims 3 to 12 extends beyond the content of the application as originally filed, Claims 1, 2 and 13 to 17 however, comply with Article 123(2) EPC.

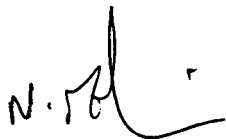
5. Having regard to the fact that in the present case the reasons for the impugned decision referred only to the question of added subject-matter pursuant to Article 123(2) EPC and that the claims have been changed to a substantial extent as compared to the claims underlying the decision under appeal, the Board considers it appropriate, in order to avoid the loss of an instance, to remit the case in accordance with Article 111(1) EPC to the Examining Division for further prosecution.

**Order**

**For these reasons it is decided:**

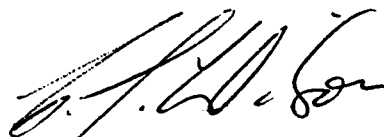
1. The decision under appeal is set aside.
2. The Appellants' request relating to Claims 3 to 12 is rejected.
3. The case is remitted to the first instance for further prosecution on the basis of Claims 1 and 2 filed on 3 May 1990 together with Claims 13 to 17 submitted with the Statement of Grounds dated 20 June 1990.

**The Registrar**



**N. Maslin**

**The Chairman**



**C.T. Wilson**

*Su*      *JM*

01231

