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**D E C I S I O N**  
of 14 June 1995

**Case Number:** T 0045/93 - 3.2.3

**Application Number:** 88202433.4

**Publication Number:** 0316985

**IPC:** E21B 21/08

**Language of the proceedings:** EN

**Title of invention:**

A method of monitoring the drilling operations by analysing the circulating drilling mud

**Applicant:**

SERVICES PETROLIERS SCHLUMBERGER

**Opponent:**

-

**Headword:**

DRILLING MUD - ANALYSIS

**Relevant legal provisions:**

EPC Art. 113(1), 111(1)

EPC R. 67

**Keyword:**

"Decision based on facts to which the Appellant had no opportunity to present comments"

"Substantial procedural violation (yes)"

"Reimbursement of the appeal fee (yes)"

**Decisions cited:**

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**Catchword:**

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Case Number: T 0045/93 - 3.2.3

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.3**  
**of 14 June 1995**

**Appellant:** SERVICES PERTOLIERS SCHLUMBERGER  
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F-75007 Paris (FR)

**Representative:** Hyden, Martin Douglas  
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**Decision under appeal:** Decision of the Examining Division of the European  
Patent Office dated 7 August 1992 refusing  
European patent application No. 88 202 433.4  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** C. T. Wilson  
**Members:** J. B. F. Kollar  
L. C. Mancini

### Summary of Facts and Submissions

- I. European patent application No. 88 202 433.4 (publication No. 0 316 985) was refused following oral proceedings on 16 July 1992, the written decision of the Examining Division being dated 7 August 1992.
- II. In two communications according to Article 96(2) and Rule 51(2) EPC dated 28 May 1991 and 6 November 1991 respectively, the Examining Division referring to a single prior art document - namely GB-A-1 280 227 - had informed the Applicant of its grounds against the grant of a patent.
- III. The Applicant (now Appellant) had replied in the letters dated 18 July 1991 and 19 February 1992 respectively, each of them accompanied by a new and amended set of claims.
- IV. The decision of the Examining Division was taken on the basis of Claims 1 to 8 of the main request filed with the letter of 19 February 1992 and Claims 1 of the first and second auxiliary requests submitted during said oral proceedings.

Claim 1 of the main request reads as follows:

- "1. A method of monitoring drilling operations comprising analysing circulating drilling mud by periodically sampling the mud at the surface, after elimination of cuttings and analysing the samples to determine the successive values as a function of time or depth of the weight  $M_s$  of fine solids present in the mud, characterised in that the weight  $M_l$  of the liquid phase is determined by drying to constant weight a given weight  $M_m$  of mud

and in that the weight  $M_e$  of the electrolyte dissolved in the liquid phase present in a known weight  $M_m$  of mud is determined, the weight of  $M_s$  of the fine solids in the sample being determined by the expression:

$$M_s = M_m - M_1 - M_e$$

V. The reasons for the refusal were as follows:

(i) **Main and first auxiliary request**

The Examining Division considered that the subject-matter of Claims 1 of these requests did not meet the requirements of Articles 52(1) and 56 EPC, having regard to prior art documents

GB-A-1 280 227 and

GB-A-1 222 933 (should read CA-A-1 222 933).

Particularly the formula

$$M_s = M_m - M_1 - M_e$$

in the characterising portions of said claims was considered trivial since it only described the evident composition of the mud; a skilled person would apply a calculation according to this formula in a method disclosed in document CA-A-1 222 933 by mere professional routine and would thus arrive at the method of Claims 1 according to the main and first auxiliary requests without exercising any inventive skill.

(ii) **Second auxiliary request**

The subject-matter of Claim 1 according to this request did not meet the requirements of Article 123(2) EPC since its characterising feature "so as to determine the anion, monovalent cation and bivalent cation concentration of each sample" could not be unambiguously derived from the application documents as originally filed.

VI. The Appellant duly filed an appeal against this decision.

In the Statement of Grounds of Appeal dated 2 December 1992, the Appellant set out the reasons for which the decision of the Examining Division was contested and requested that the decision under appeal be set aside in its entirety.

**Reasons for the Decision**

1. The appeal is admissible.
2. The reasoning why the subject-matter of Claims 1 according to the main and first auxiliary requests was considered to be obvious in the light of documents GB-A-1 280 227 and CA-A-1 222 933 appears for the first time in the contested decision, cf. the last paragraph of page 4 and the second paragraph of page 5. Thus the Appellant did not have an opportunity to present his comments with regard to the grounds for refusal of said claims. This is both necessary and appropriate in the light of Article 113(1) EPC.

This alone amounts to a substantial procedural violation and the contested decision must therefore be set aside.

3. As a consequence of this procedural defect, any decision of the Board on the substantive issues of patentability would necessarily deprive the Appellant of his right to have his case considered by two instances. Consequently, the Board exercises its power under Article 111(1) EPC and remits the case to the Examining Division for further prosecution according to the Appellant's requests as they stood when the contested decision was taken.
4. Remittance seems to be appropriate also because it appears that the Examining Division has not finally substantiated which particular passage in CA-A-1 222 933 casts doubt on the patentability of the subject-matter as claimed; reference should be made to such particular passage in the publication to show why this is the case (cf. Guidelines, Part E, X.5, especially second paragraph).
5. Since the Board has found the substantial procedural violation to be the ground for allowing the appeal, it finds it equitable to order reimbursement of the appeal fee in accordance with Rule 67 EPC.

**Order**

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

1. The decision under appeal is set aside.
2. The matter is referred back to the Examining Division for further examination of the application as identified in points 3 and 4 above.
3. Reimbursement of the appeal fee is ordered.

The Registrar:

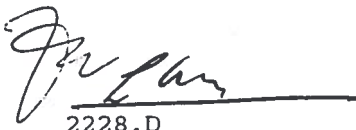


N. Maslin

The Chairman:



C. Wilson

  
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