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**Datasheet for the decision  
of 1 July 2008**

**Case Number:** T 1302/05 - 3.2.03

**Application Number:** 96101005.5

**Publication Number:** 0719905

**IPC:** E21B 33/035

**Language of the proceedings:** EN

**Title of invention:**  
Wellhead

**Patentee:**  
Cooper Cameron Corporation

**Opponent:**  
Aker Kvaerner Subsea A.S.

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 76(1), 104(1)

**Relevant legal provisions (EPC 1973):**  
-

**Keyword:**  
"Added subject-matter - (no) after amendment"  
"Different apportionment of costs (no)"

**Decisions cited:**  
-

**Catchword:**  
-



Case Number: T 1302/05 - 3.2.03

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.03  
of 1 July 2008

**Appellant:** Aker Kvaerner Subsea A.S.  
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**Respondent:** Cooper Cameron Corporation  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 5 August 2005  
rejecting the opposition filed against European  
patent No. 0719905 pursuant to Article 102(2)  
EPC.

**Composition of the Board:**

**Chairman:** U. Krause  
**Members:** E. Frank  
K. Garnett

## Summary of Facts and Submissions

- I. The appeal lies from the decision of the Opposition Division, dated 29 June 2005 and posted on 5 August 2005, to reject the opposition of Opponent II and maintain the European patent No. 0 719 905 in unamended form.
- II. The Appellant (Opponent II) filed a notice of Appeal on 5 October 2005, paying the appeal fee on the same day. The statement of grounds of appeal was submitted on 9 December 2005.
- III. A communication pursuant to Article 15(1) RPBA was issued together with a summons to attend oral proceedings, which were duly held on 1 July 2008. At the beginning of the oral proceedings the Respondent (Proprietor) withdrew its then existing main and first auxiliary requests, making its second auxiliary request its sole request. During the oral proceedings, the Respondent submitted an amended description in accordance with claim 1 of this request.
- IV. Before the opening of the oral proceedings, the requests of the Appellant on file had been for the decision under appeal to be set aside, the patent to be revoked, reimbursement of the appeal fee and oral proceedings. See its letter of 17 November 2006, final paragraph, and the grounds of appeal. After the Respondent had withdrawn its main and first auxiliary requests, the Appellant withdrew all its existing requests and in their place requested solely an apportionment of costs to cover the travel and lodging costs of the representative (Mr Clarkson) and the

employee (Mr Bergene) of the Appellant and of the Appellant's preparation costs since the issue of the invitation to oral proceedings.

V. The wording of claim 1 reads as follows:

"1. A wellhead comprising a wellhead housing (20); a spool tree (34) fixed and sealed to the housing, and having at least a lateral production fluid outlet port (63) connected to a valve (70); and a tubing hanger landed (54) within the spool tree at a predetermined angular position at which a lateral production fluid outlet port (61) in the tubing hanger is in alignment with that in the spool tree; wherein at least one vertical production fluid bore in the tubing hanger (54) is sealed above the respective lateral production fluid outlet port (61) by means of a removable plug (66), and the bore through the spool tree (34) is sealed above the tubing hanger by means of a second removable plug (68); characterised in that a workover port (73) extends laterally through the wall of the spool tree from between the two plugs (66,68); a tubing annulus fluid port (64) extends laterally through the wall of the spool tree from the tubing annulus; and these two ports through the spool tree are interconnected via an external loop line containing at least one valve (71,72)."

VI. The parties submitted essentially the following arguments during the oral proceedings:

The Appellant argued that it never had any objections as regards the subject-matter of the second auxiliary request, now the sole request of the Respondent. When

the main and first auxiliary requests on file were withdrawn without prior notice at the beginning of the oral proceedings, the Appellant's presence at the oral proceedings became superfluous. Thus, payment of Appellant's travelling costs was justified. Furthermore, despite the negative written opinion of the Board attached to the summons to oral proceedings relating to the main and first auxiliary requests, the Respondent had not withdrawn these requests until the very last moment. Therefore the extensive preparation time of the Appellant since the invitation to oral proceedings should also be the subject of an order for reimbursement of costs.

The Respondent argued that during the written stage of the appeal proceedings the Appellant had likewise never withdrawn its arguments on the opposition grounds of lack of novelty and inventive step, and therefore the Respondent also faced additional and superfluous preparation for the case. Moreover, the written opinion of the Board was only a preliminary one and therefore did not oblige the Respondent to withdraw its requests prior to oral proceedings. The representative of the Respondent said that it was only on the day before oral proceedings that his United States' client had decided to withdraw its main and first auxiliary requests and seek maintenance of the patent on the basis of the second auxiliary request only. This decision had been made for purely practical reasons. The Respondent argued that it would be wrong to penalise a party for shortening proceedings in this way.

## Reasons for the Decision

1. The appeal complies with the provisions of Articles 106 to 108 EPC and of Rule 99 EPC and is, therefore, admissible.

2. *Amendments*  
(Article 100(c) EPC)

Since the patent in suit was granted on a divisional application to the earlier European application no. 92 305 014.0, Article 100(c) EPC requires that its subject matter may not extend beyond the content of that earlier application, as well as of the application as filed. No objections have been brought forward by the Appellant with respect to the amendments in present claim 1, which are based on the combination of claims 1, 9 and 11 of the earlier application as filed. Moreover, on page 2, column 2, at line 23 of the present patent the word "a" (loop line) has been replaced by the wording "an external" (loop line), to adapt the description to the present claim 1. The qualification of the loop line as "external" finds a basis in column 4, line 51 of the divisional application as published. The subject-matter of the amended claims therefore complies with the requirements of Article 100(c) EPC.

3. *Novelty and inventive step*  
(Article 100(a) EPC)

The Opposition Division found the claims to meet the requirements of novelty and inventive step and the Appellant, while not formally withdrawing the

opposition grounds under Article 100(a) EPC, stated that it did not further pursue these grounds in the appeal procedure. These grounds were therefore not open to decision by the Board.

4. *Apportionment of costs*  
(Article 104(1) EPC)

The Appellant argues that the oral proceedings before the Board on 1 July 2008 would have been unnecessary if the Respondent, who was well aware of the Board's negative written communication on added subject-matter as regards the main and first auxiliary requests, had withdrawn these requests in time, i.e. immediately after the receipt of the summons to oral proceedings. However, the Board agrees with the Respondent that the written communication of the Board according to Article 15 RPBA, which was attached to the summons to oral proceedings, merely set out the Board's provisional opinion without any binding effect. Since also the wording of Article 116(1) EPC does not contain any restriction on its applicability, the Respondent's request for oral proceedings has to be understood as a legally admissible request to safeguard its rights and interests.

The Appellant further argued that when the Respondent made its second auxiliary request its sole request and simultaneously dropped its main and first auxiliary requests, the oral proceedings held on 1 July 2008 became superfluous. The former second auxiliary request (now main request) had never been objected to by the Appellant in writing and thus the Respondent knew that its new request would lead to an instantaneous end of

the oral proceedings. However, in the Board's view, the Respondent's original requests were clearly submitted in time (ie, with its reply) and there can be no abuse of procedure in a party in good faith subsequently withdrawing certain requests and limiting itself to requests already in the proceedings. The Board acknowledges that costs can sometimes be saved if a party makes an early decision to limit its requests. This fact alone, however, does not make it equitable to order an apportionment of costs. If such an order were made as a matter of common practice, then the likely result would be that parties would maintain requests which they knew to be hopeless or in which they had no interest, simply to avoid being criticised for their withdrawal.

Furthermore, the Board notes that the formal position of the Appellant at the point when the oral proceedings were opened remained that it requested revocation of the patent and reimbursement of the appeal fee, in respect of which oral proceedings had also been requested. The Appellant had not taken a formal position in relation to the Respondent's second auxiliary request, understandably so, since this request had only been filed with the reply. While it might have been deduced that the Appellant was unlikely to raise any objections to the second auxiliary request, this was not certain. At the very least, the Appellant might have wanted to reply to amendments of the description in accordance with such a new claim 1. Thus, the oral proceedings also could not have been cancelled, since according to Article 116(1) EPC they were outstanding requests of the Appellant and the outcome of the appeal was not certain.



Thus, the Respondent's request for reimbursement of costs for preparation and for attending the oral proceedings is refused, since there are no reasons of equity justifying the request.

## **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 on the basis of:
  - Claim 1 filed as Auxiliary Request II with the letter dated 30 June 2006 and Claim 2 as granted;
  - The description page 2 as filed during oral proceedings and pages 3 to 6 as granted;
  - Figures 1 to 12 as granted.
3. The Appellant's request for an apportionment of costs is refused.

The Registrar

The Chairman

A. Vottner

U. Krause