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**Datasheet for the decision  
of 28 November 2008**

**Case Number:** T 0342/07 - 3.2.03

**Application Number:** 97903797.5

**Publication Number:** 0836668

**IPC:** E21B 15/02

**Language of the proceedings:** EN

**Title of invention:**

Multi-activity offshore exploration and/or development  
drilling method

**Patentee:**

Transocean Offshore Deepwater Drilling Inc.

**Opponent:**

BP America Production Company  
GLOBALSANTAFE CORPORATION

**Headword:**

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**Relevant legal provisions:**

EPC Art. 100(c) and 123(3), 100(b), 84, 100(a), 54, 56

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

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**Keyword:**

"Admittance of sole request - yes"  
"Added subject-matter - (no) after amendment"  
"Protection conferred extended - (no) after amendment"  
"Novelty and inventive step - (yes) after amendment"  
"Insufficiency of disclosure (no)"

**Decisions cited:**

T 0099/91, T 0113/06

**Catchword:**

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Case Number: T 0342/07 - 3.2.03

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.03  
of 28 November 2008

**Appellant:** Transocean Offshore Deepwater Drilling Inc.  
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**Decision under appeal:** Decision of the Opposition Division of the European Patent Office posted 27 December 2006 revoking European patent No. 0836668 pursuant to Article 102(1) EPC.

**Composition of the Board:**

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

## Summary of Facts and Submissions

- I. This appeal lies from the decision of the Opposition Division dated 1 June 2006 and posted on 27 December 2006, to revoke the European patent No. 0 836 668 pursuant to Article 102(1) EPC 1973.
- II. The Appellant (Proprietor) filed a notice of Appeal on 22 February 2007, paying the appeal fee on the same day. The statement of grounds of appeal was submitted on 3 May 2007. With letter of 18 February 2007 the Opponent II withdrew his opposition.
- III. With letter of 14 March 2008 the Appellant requested accelerated processing before the Board, and in its letter of 23 May 2008 presented a legitimate interest. A summons to attend oral proceedings was sent out on 12 June 2008 and a communication pursuant to Article 15(1) RPBA was issued on 3 September 2008. Observations by a third party, together with a new document R1 (= Baker, Ron (1998) "A Primer of Offshore Operations" third edition), were filed on 17 November 2008. The oral proceedings were duly held on 27 and 28 November 2008.
- IV. At the beginning of the oral proceedings, the Appellant repeated its main request, which had been filed with its letter of 25 November 2008. The Appellant also tabled an auxiliary request, based on the combination of earlier requests. At the end of the oral proceedings, the Appellant withdrew the above main request, making its auxiliary request, now merely based on the combination of Version 2 of claim 1 as filed on 3 May 2007 and Version 1c of claim 5 as filed on 14 October

2008, its sole request. The Appellant submitted a new set of claims 1 to 6 and a newly adapted description together with the figures as granted in accordance with this request.

Thus at the end of the oral proceedings the Appellant requested that the decision under appeal be set aside and the patent be maintained on the basis of claims 1 to 6 and the description as filed during the oral proceedings.

The Respondent (Opponent I) requested that the appeal be dismissed.

V. The wording of claims 1 and 5 reads as follows:

"1. A method for conducting offshore drilling operations with a multi-activity drilling assembly operable to be mounted upon a drilling deck (190) positioned above the surface of a body of water and having a first tubular advancing means (160) and a second tubular advancing means (162), the method comprising the steps of:

- (a) advancing tubular members by the first tubular advancing means (160) into the body of water (194) and into the bed (196) of the body of water for conducting primary drilling operations for a single well;
- (b) advancing tubular members by the second tubular advancing means (162) into the body of water (194) and into the bed (196) of said body of water (194)

for conducting activity auxiliary to said primary drilling activity for the single well; and

- (c) transferring tubular members between the first tubular advancing means (160) and the second tubular advancing means (162);

wherein primary drilling activity is conducted at least in part by advancing tubular members from the first (160) tubular advancing means and auxiliary drilling activity is conducted simultaneously for the single well by advancing tubular members to the bed (196) of said body of water from the second (162) tubular advancing means."

"5. A method for conducting offshore drilling operations into the bed (196) of a body of water, for a single well, from a drilling deck (190) operable to be positioned above the surface of the body of water, said method being conducted, at least partially, from a first means (160) for advancing tubular members and, at least partially, from a second means (162) for advancing tubular members both advancing means (160, 162) being positioned within a superstructure, said method for conducting drilling operations comprising the steps of:

- (a) drilling (284) at least a portion of a wellhole into the bed (196) of the body of water from one of the said first or second means (160, 162) for advancing tubular members;
- (b) running (284) at least one casing from the said one of said first or second means (160, 162) for advancing tubular members into the at least a

portion of the wellhole; and being characterised by the steps of:

- (c) simultaneously during at least a portion of the time period utilized for performing steps (a) and (b), running (264) a blowout preventer (200) and riser into the body of water from the other of said first or second means for advancing tubular members (160, 162) to a position in proximity to the at least a portion of the wellhole in the bed of the body of water (196);

wherein the events of step (c) are performed independently of and during at least a portion of the same time period as the events of steps (a) and (b) to reduce the overall time necessary to perform steps (a) through (c) for conducting offshore drilling operations from the drilling deck (190) on a single well being drilled into the bed (196) of the body of water; and

- (d) landing (266) the blowout preventer (200) and riser onto the wellhole from the other of said first or second means for advancing."

VI. The following evidence has been considered for the present decision:

D15 = GB 2 291 664 A

E1 = US 4 819 730 A

E18 = Paper OSEA 94139 "The role of semi submersible crane vessels in deepwater field developments: overview of previous experience and new applications", presented at the 10th Conference &

Exhibition Offshore South East Asia, 6 to 9  
December 1994

VII. The parties submitted essentially the following arguments:

VII.1 Admissibility of sole request

The Respondent argued that following G 9/91, the purpose of the Appeal was to enable the losing party to challenge the decision of the Opposition Division. It was therefore the requests of the Appellant which had been rejected by the Opposition Division which should be reconsidered in the appeal procedure, not new ones which had never been considered in the proceedings before the Opposition Division. With its grounds of appeal, the Appellant already filed ten new auxiliary requests. With subsequent written submissions the Appellant had filed another six new auxiliary requests, in particular Version 1c of claim 5, and had also filed new requests shortly before the oral proceedings. Even at the beginning of the first day of the oral proceedings, the Appellant intended to submit two more additional requests. Since no new documents had been filed and no new arguments had been presented from the Respondent's side, the Appellant should explain why the new requests were necessary. Furthermore, because the additional requests had been filed by the Appellant without formally withdrawing the existing auxiliary requests, the Appellant had not in fact amended the existing requests on file, but rather

submitted additional requests. The Appellant had also not given any prior notice of its intentions, and the Respondent had thus had to consider all of the requests, greatly increasing work needed for the proceedings. Thus, the Appellant's behaviour amounted to an abuse of procedure, and the Appellant's now sole request should not be admitted.

The Appellant argued that when the Appeal was filed, it had had to consider the voluminous prior art on file, and also that due to the complicated nature of the case and the number of issues, fall back positions were necessary. The Appellant had then further filed only slightly tidied up versions as a reaction to the reply of the Respondent. After the Appellant had received the communication of the Board, a number of issues had to be dealt with, in particular the objection of added subject-matter in claim 5, which had not been raised before, and the Appellant had thus had to consider this new position. The subsequently filed fall back position was a reaction to these objections and the Appellant had done everything it could do to respond to the communication of the Board. For example, a chart had been prepared explaining the amendments. An extensive written submission of the Respondent had then followed, as a result of which the Appellant had submitted a final letter indicating which claims would be pursued in the oral proceedings. Thus, in the Appellant's view, its conduct had been entirely appropriate, and it was entitled to react to the communication of the Board and to the further

submissions of the Respondent. Apart from that, no substantial amendments to the granted claims had been made. In fact, the amendments were minimal, and thus did not constitute an undue burden.

## VII.2 Amendments of claims

The Respondent argued that the current wording of claim 1 corresponded to a combination of claim 37 as filed and features arbitrarily selected from the original application, such as the terms "drilling deck", "simultaneous", and "single well". The original claim 37 set out steps of advancing tubular members from the first and second tubular station and transferring the former between these tubular stations. The "wherein" clause of claim 37 subsequent to the transfer step only qualified the previous steps of advancing tubular members, because of the original wording "can be conducted", and did not constitute a separate method step. In the present claim 1, therefore, step (c) formed the end point of the claimed method, whereas the "wherein" clause explained the previous steps (a) and (b). Since primary and auxiliary "drilling" activities were addressed by the "wherein" clause, it was both impossible and nowhere disclosed in the original application, that step (b) of claim 1 occupied the same time frame as step (a), i.e. that drilling "into" the seabed according to steps (a) and (b) of claim 1 took place simultaneously on a single well. The concept of simultaneous drilling with the aid of a first and second means was only disclosed in the context of multiple wells: cf. page 8 (as published). If the

embodiment of figure 23b of the application was said to form the basis of simultaneous primary and auxiliary drilling activities for a single well, then claim 1 had been generalized, since various further features, i.e. additional method steps, had been omitted from this embodiment and claim 1 thus contained added subject-matter. Moreover, simultaneous drilling operations through a "drilling deck" were merely described in combination with a drilling activity simultaneous to an activity auxiliary to drilling: cf. page 9 (as published).

Moreover, in respect of claim 5 the Respondent argued that the advancing of the BOP (Blow Out Preventer) and riser to a specific position in proximity to the wellhole as described by step (c) of claim 5, was not derivable from the original application. Furthermore, compared to claim 5 as granted, the already vague meaning to be attached to this position had changed, since the entirely separate landing step (d) according to present claim 5 involved a further downward movement of the BOP, which was no longer simultaneous to steps (a) and (b). In particular, no movement of the BOP to a defined position was described by the figure 11- and 12- embodiment. Page 24 of the application (as published) merely disclosed the start of the running of the BOP while the casing was drilled and run. No disclosure could be found in which a particular position of the BOP was reached whilst running the casing. Only when the BOP was landed could its position be derived from page 24, and there thus remained an undefined time gap. For

example, the cementing of the casing as described on page 24 could also take place whilst the BOP was being run to the "proximity" of the seabed. Finally, at the same time as the BOP was being landed the other rotary station laid down drilling equipment. Thus, the cementing step and the laying-down step had both been omitted from the method of claim 5. Moreover, the position of the BOP whilst the casing was being simultaneously run was not derivable from the figure 23b embodiment: cf. time bars 264 and 284. Furthermore, those parts of the time bar 266 in figure 23b which concerned the landing of the BOP after the simultaneous running of the casing in time bar 284 overlapped with the making-up and laying-down of bottom hole assemblies and running tools, as indicated by time bar 286. Thus, the broad concept of claim 5 was both arbitrarily selected and generalized from the specific descriptions of the embodiments shown in figures 11 and 12 or figure 23b.

The Appellant argued in respect of claim 1 that the purpose of the invention was to shorten the critical path. Claim 37 as originally filed firstly served as a rudimentary basis of steps(a), (b) and (c) of claim 1. The "activity" described in step (b) of claim 1 had to be read as "operations". Moreover, the primary and auxiliary steps of the "wherein" clause of claim 1 had to be construed as being different from the primary and auxiliary operations in steps (a) and (b) of claim 1. A basis for the "wherein" clause, which in fact operated to shorten the time duration of

the critical path, could be found in the embodiment of figure 23b of the original application, which referred to exploratory drilling and thus also to a single well. In figure 23b, step 284 was removed from the critical path, since the BOP and riser were simultaneously run and landed as shown in steps 264 and 266 of figure 23b. Thus, a handover of tubular members was avoided. Moreover, the concept of simultaneously advancing tubular members according to the "wherein" clause was also derivable from pages 34 and page 7 of the application (as published). Finally, the term "drilling deck" could be derived from figure 5, where a deck was shown which was separated from the main deck of the drillship.

Furthermore, as regards the subject-matter of claim 5, the Appellant argued that to run a BOP and riser to a position in "proximity to" the wellhole actually meant to go "to" the seabed with it, such that, however, the tubular members were at that stage still suspended in water. Since the wellhead had a certain height, in "proximity to" also meant running the BOP down to where it was needed prior to landing, i.e. above the wellhead. The final further step involved more care and was thus described as an extra step (d) in present claim 5. However, it was essential that the BOP was landed all the way down to the seabed, irrespective of whether it was also stopped at an appropriate point prior to landing, since this also depended on the operator. The general concept of claim 5 was again described on page 34 of the application (as published). A detailed basis for

the single well procedure of claim 5 could be found in figure 23b, time bars 264 and 266, which concerned the simultaneous running and landing of the BOP while running of the casing took place: cf. time bar 284. The time line on top of figure 23b was appropriate to compare the critical and non-critical paths. The lay-down steps 286, 288 etc., had no influence on the key steps. Moreover, a basis for claim 5 could also be found in the figure 11- and 12- embodiment, and the advancement and position of the BOP prior to landing were implicitly derivable from the corresponding description on page 24 of the application (as published).

### VII.3 Amendments of description

The Respondent argued that following from T 0113/06, amendments which were not necessitated by any grounds for opposition should not, in principle, be allowed if there was the slightest doubt that the unamended patent could be construed differently to the patent as amended. Thus, for this reason alone, the amendments in column 9, lines 31 to 42 of the present description were not justified. Moreover, the description had to be used to interpret the claims in order to determine the extent of protection that is conferred by the patent in suit, in accordance with the Protocol of Article 69 EPC.

Therefore, since in particular in column 9, lines 35 to 40 of the patent as granted either a rotary table or a top drive assembly are specified

as "essential" tubular advancing means at each station, their omission from the description of the granted patent broadened the scope of the independent claims, contrary to the requirements of Article 123(3) EPC.

The Appellant argued that in particular the amendments in columns 9, 12 and 13 of description corresponded to the text of the original description and were made in fact to remove the objections of added subject-matter. Moreover, paragraph [0042] in column 9 of the granted patent merely concerned a specific embodiment of the drillship, and thus the omission of lines 35 to 40 in column 9 did not extend the scope of the claims.

#### VII.4 Insufficiency of disclosure, Clarity of Amendments

The Respondent argued that the key feature of claim 5 was the lowering of the BOP in a first step from a rig and landing it in a further step from that same rig. However, the patent as filed was totally silent as to how the landing step was done, since the BOP was firstly lowered from a position laterally different from the wellhead. Thus, the invention as described by claim 5 could not be carried out. Furthermore, the wording of the newly added feature (d) of claim 5 was vague, due to the term "landing the BOP ... from", since "from" could also involve the common meaning of "coming over from". Thus, claim 5 also encompassed the landing of the BOP and riser which previously had come over from, i.e. had been transferred from, the other advancing means in a first step.

The Appellant argued that how to achieve lateral adjustment of the BOP and riser was common technical knowledge, e.g. by means of guidelines or remote controlled vehicles, having regard to the large vertical distance compared with the required small lateral deviations during running of BOP and riser, in particular under severe conditions such as strong currents and waves. Therefore, landing the BOP from an advancing means onto a laterally offset wellhole, as defined by feature (d) of claim 5, could be readily achieved by the skilled person. Moreover, with respect to the clarity of the new amendments, the wording "landing ... from ..." in step (d) of claim 5 in fact defined which of the advancing means did the landing. This interpretation was also consistent with the terms used in steps (a) and (b) of claim 5.

#### VIII.5 Novelty and Inventive step

The Respondent conceded that D15 did not disclose two advancing means which both served to advance tubular members into the seabed for a single well, and thus the novelty of claim 1 was not disputed by the Respondent. However, based on the closest prior art D15, the problem was how to go to two wells simultaneously. Since this was known from E18 or E1, which described suitable dual rigs, claim 1 was not inventive.

As for the novelty of claim 5, the Respondent firstly argued that document D15 described the

placing, i.e. the running of a casing into the seabed, whilst simultaneously a BOP and riser were being run to the seabed at the rear end of the drilling platform. Since according to the wording of step (d) the BOP and riser were landed "from" the other tubular advancing means, this could also be construed as "coming over from". Thus, D15 further described the BOP coming over by cranes or conveyor means from the "preassembly installation" at the rear end, i.e. the other advancing means, and disclosed its subsequent landing by means of the drilling derrick. Therefore claim 5 lacked novelty over the disclosure of D15. If claim 5 was considered to be novel, the Respondent further argued in respect of inventive step that D15 alone described a pre-assembly installation that could be used to run the BOP "to" the seabed. The problem to be solved was thus how it could be landed otherwise than from the main derrick, and it was obvious to land it simply from the pre-assembly point of D15. Moreover, the capability of assembling and retrieving a full riser string with BOP was known from E18. Since the cranes of E18 were supposed to be provided with motion compensation, it was thus also obvious to land the BOP from a crane and to apply this teaching to the cranes of D15, thereby arriving at the subject-matter of claim 5.

As for claim 1, the Appellant argued that its subject-matter differed from the closest prior art D15 in that both method steps (a) and (b) described the advancing of tubular members into the seabed. The problem underlying this

distinguishing feature was how to improve the floating platform of D15 by further shortening the critical path by providing additional versatility. Neither E18 nor E1 suggested drilling of a single wellhole, since they concerned development drilling on multiple wells. Moreover, the drilling platform of D15 was not suitable for dual rigs, and also the pre-assembly station of D15 could not be readily adapted for drilling into the bed. Thus, claim 1 was inventive.

With respect to claim 5 the Appellant argued that "landed from the other means" in step (d) of claim 5 could not be understood as "coming over from" the other means, and thus in claim 5 one and the same advancing means ran and landed the BOP. Since the document D15 disclosed a handover between the pre-assembly point and the drilling derrick of D15 by means of a crane or conveyor means, running and landing of the BOP did not take place from the same advancing means, viz. from the pre-assembly installation of D15. Taking D15 as the nearest prior art, the technical problem solved by use of one and the same advancing means in claim 5 was to save time when landing the BOP onto the wellhead. E18 could not teach the use of a crane of D15 for landing the BOP, since apparently only the derricks of E18 could provide motion compensation, and thus were in a position to lower the riser strings. However, E18 did not describe the assembly and retrieval of a full riser string with BOP's in the same context as placing the latter. Therefore claim 5 was also inventive.

## 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. *Admissibility of observations by a third party*

The observations raised mainly referred to document R1 submitted by the third party. However, the observations were filed at a very late stage of the proceedings, namely shortly before the oral proceedings were held. Moreover, the Board did not consider R1 *prima facie* more relevant than the other prior art documents on file. The Board therefore exercised its discretion under Article 13(3) RPBA to disregard the document R1 and the third party's observations.

3. *Admissibility of sole request*

It is true that an inter-partes appeal should mainly give the losing party the opportunity to challenge the rejection of its requests by the Opposition Division: G 9/91 (OJ 1993, 498, point 18 of the Reasons). However, according to the procedural principles developed in the case law of the boards of appeal, admission of other requests may be justified by the Board at its discretion, if the Patentee would otherwise be deprived of any opportunity of retaining a patent. In the present case, the Appellant's new requests submitted with its grounds of appeal were clearly filed as an immediate reaction to the decision under appeal. In its grounds of appeal the Appellant fully explained, in respect of each request, the

reasons for its submission, what amendments had actually been made, and where these amendments found their basis in the original application. Then, in response to the objections raised by the Respondent in its reply, the Appellant submitted slightly amended requests with its letter of 11 March 2008. Finally, with the Appellant's letter of 14 October 2008, amended requests were filed. These contained minor amendments, in particular a new version of claim 5, and were in direct response to the Board's communication of 3 September 2008. These amended requests were still filed in good time, viz. one and a half months before the oral proceedings, and the Appellant also provided a detailed summary of its then current requests, including an annexed and clearly structured table for explanation. In this table, the version of claim 5 according to the eventual sole request is explained (see under "Amendment No.6") as having been filed to further distinguish the claim over D15 in that it was now said that the BOP and riser were actually landed on the wellhead and were not still being run to somewhere near the seabed. As argued by the Appellant in its grounds of Appeal and reiterated during the oral proceedings, the "landing step d)" of Version 1c of claim 5 was clearly derivable from the specification: cf. paragraph [0056], line 15: "... and lands the BOP 200 onto the wellhead...".

Moreover, with its letter of 25 November 2008, admittedly only shortly before the oral proceedings, the Appellant stated its intention to pursue only certain of its requests during the hearing for reasons of procedural simplification and efficiency. As far as concerns the nature of the amendments filed during the

appeal proceedings, which were presented in structured combinations thus forming the main and auxiliary requests, the Board agrees with the Appellant that no substantial amendments to the granted claims were made. Furthermore, the new requests and in particular the ultimate sole request did not change the case, i.e. did not substantially extend or alter the framework of discussion which had been the subject of the decision under appeal. Although the Board acknowledges that the various requests and the associated amendments may have been numerous, in the Board's judgement, all the parties (and also the Board) were reasonably able to deal with all the issues in the case during the two days set aside for the oral proceedings. An adjournment to another day, possibly to allow time to consider the newly filed version of claim 5 of the ultimate sole request, clearly was not necessary. This version of claim 5 corresponds in substance to Version 1 as filed with the grounds of Appeal and only minor amendments, based on the original description, were made on 14 October 2008. Therefore, the Respondent were able to consider the sole request on file without undue burden.

There is thus no sign of any procedural abuse and the Board is also satisfied that the present sole request satisfies Rule 80 EPC. The Board therefore exercised its discretion to admit the sole request of the Appellant, pursuant to Articles 13(1) and (3) RPBA.

4. *Amendments*  
(Articles 100 (c) and 123(3) EPC)

4.1 *Amendments of Claim 1*

The present method claim 1 is based on the subject-matter of claim 37 as originally filed. However, the wording "... a drillship semi-submersible, tension leg platform, jack-up platform offshore tower, or the like, ..." at lines 16 and 17 of claim 37 has been replaced by "... drilling deck positioned above the surface of a body of water ..." at lines 3 and 4 of claim 1.

Moreover, the term "tubular station" of claim 37 has been replaced by "tubular advancing means" wherever it appears in claim 1. Furthermore, compared to claim 37, claim 1 contains the additional features "...into the body of water..." at line 9 and 15, "... for conducting primary drilling operations for a single well;" at line 11 and 12, and "... for conducting activity auxiliary to said primary drilling activity for the single well;" at line 17 to 19. The "wherein" clause of claim 37 has been modified in that the features "primary activity can be conducted..." and "...auxiliary drilling activity can be conducted by advancing tubular members..." of claim 37 have been replaced by "primary drilling activity is conducted at least in part ..." and "... auxiliary drilling activity is conducted simultaneously for the single well by advancing tubular members to the bed of said body of water ..." in claim 1 respectively.

4.1.1 As to the basis of these amendments the Board firstly notes that the broadly formulated subject-matter of originally filed claim 37 did not specify any particular sort of well, and thus tubular advancing activities for either single or multiple wells were encompassed, which activities are referred to as

"exploration" or "development" drilling throughout the original application: cf., e.g., page 32, lines 11 to 16 of the application (as published). The limitation on one of these two possible drilling methods, viz. on activities for one single well as defined by present claim 1 is thus, in the opinion of the Board, derivable from the original application.

Secondly, the terms "drilling activity" (or "drilling operations") and "activity auxiliary to drilling activity" have to be construed. The original method claim 37 explicitly describes the advancing of tubular members from the second tubular station "and" into the bed of a body of water. This is referred to as the "auxiliary drilling activity" in claim 37. Therefore, in the opinion of the Board, "drilling activity", irrespective of whether primary or auxiliary drilling is conducted, does not merely concern the actual drilling into the seafloor, but rather the entire advancing of tubular members from above, be it through the seawater or layers of the seabed. Moreover, the Board notes that the step of advancing of tubular members from the first tubular station "into" the bed of a body of water, i.e. the actual drilling into the seafloor, also corresponds to the "primary activity" in claim 37. Thus in claim 37, both "drilling activity" and "activity" are to be considered as comprising any activity, as far as the advancing of tubular members is concerned, either by lowering tubular members through seawater down to the seabed or by drilling into the seabed. As regards the terms "activities" and "operations", the Board further notes that throughout the application as originally filed these terms are synonymous, in particular in relation to the advancing

of tubular members: cf., e.g., claim 37: "A method for conducting... drilling operations...". Furthermore, the skilled person would readily recognize from originally filed page 18, last bridging paragraph (as published), that the tubular stations of original claim 37 are, in fact, identical tubular advancing means which are interchangeable, and that the definition of primary and auxiliary is thus arbitrary.

Taking account of these considerations, which likewise apply to claim 1, in the Board's view, the "wherein" clause of claim 1 gives further information about the primary and auxiliary (drilling) activity according to method steps (a) and (b) by stating that that part of the primary activity that consists in advancing tubular members, takes place simultaneously with that part of the auxiliary activity which consists of advancing tubular members to the seabed. Those parts of method steps (a) and (b) of claim 1 which concern primary and auxiliary activities "into" the seabed, necessarily cannot occur simultaneously on a single, i.e. the same, well. The transfer of tubular members according to method step (c), i.e. the ability to pass, e.g., tubular segments back and forth between the first and second tubular advancing means, can take place at any time. Finally, having regard to the wording "a ... drilling assembly operable to be mounted upon..." at line 16 of original method claim 37, an actual use of the described offshore platforms is not addressed but rather the claim means that the drilling assembly used is merely suitable to be mounted upon such a platform, the platform thus actually not forming part of the subject-matter of claim 37. However, irrespective of whether the drilling deck positioned above the water

surface as described by claim 1 is used in the claimed method, or whether the drilling assembly simply can be mounted upon the drilling deck, such a drilling deck falls within the ambit of the subject-matter of original claim 37, since it constitutes a generally known and mandatory design feature, which is also in conformity with commonly known platforms "or the like" according to lines 16 and 17 of original claim 37. Apart from that, a drilling assembly carrying out drilling operations through a drilling deck is explicitly described on, e.g., page 9, second paragraph of the specification (as published).

- 4.1.2 As regards the "wherein" clause of present claim 1 and its general concept of simultaneous advancing of tubular members on a single well, one such advancement being "to the seabed", whilst steps (a) and (b) are also carried out for that single well, this is based on the description as originally filed. The term "tubular" corresponds to relatively large conduits used in the drilling industry, such as riser conduits, casing and drillstrings of various diameters: cf. page 12, lines 19 to 21 (as published). Moreover, page 34, lines 6 to 15 of the specification (as published) describes method steps "such as blowout prevention and riser running while drilling a top hole" by means of a first and second rotary station, thus removing a first sequence of advancing tubular members from the critical path of a second sequence due to simultaneous advancing of the latter. This generally described concept is likewise applicable for single and multiple wells and is, for a single well, also derivable from page 7, lines 17 to 21 (as published). Moreover, the Board notes that the two independent simultaneous tubular

advancing activities have to take place "through the moon pool" (cf. lines 6 to 11 on page 34, as published), i.e. into the water, but not necessarily into the seabed. In the Board's view therefore, the general concept of the "wherein" clause according to claim 1 on file is not functionally linked to the method steps of further advancing tubular members "into" the seabed by either one or both of the first and second tubular advancing means. This conclusion is also in accordance with various simultaneous drilling sequences as described by the original application (as published) for a single well, viz.:

- the start of running of BOP and drilling riser to the seabed with main rig while drilling a hole section with auxiliary rig (cf. figure 11; page 24, lines 7 to 11)
- running the BOP and drilling riser to the seabed with main rig while pulling the drilling assembly to the surface with auxiliary rig (cf. figure 11; page 24, lines 10 and 11)
- running the BOP and drilling riser to the seabed with main rig while running the tubular casing to the seabed with auxiliary rig (cf. figure 11; page 24, lines 11 and 12)
- running the BOP and drilling riser to the seabed with main rig while landing the tubular casing in the wellhead with auxiliary rig (cf. figure 11; page 24, line 12)
- running the BOP to the seabed with main rig while drilling and running the casing (cf. figure 23b; page 30, lines 7 to 9 and page 31, lines 6 to 8)

Therefore, the general concept of advancing tubular members according to the "wherein" clause of claim 1 would be directly and unambiguously recognized by the skilled person and would not be considered as being "detached" from a particular embodiment, as argued by the Respondent.

4.1.3 Summing up, the Board concludes that the subject-matter of claim 1 does not extend beyond the content of the application as filed and can be deduced from the original claim 37 and the original description, in particular pages 34 (lines 6 to 15) and 7 (lines 17 to 21). Claim 1 therefore complies with Article 100(c) EPC.

#### 4.2 *Amendments of Claim 5*

In the opinion of the Board, the subject-matter of method claim 5 is generally based on page 34, lines 6 to 15 of the original application (as published), where the key concept of moving the BOP and riser running out of the critical path while drilling a top hole (for the casing) is explicitly described. As already discussed under point 4.1.2, these independent tubular advancing operations can be performed by simultaneous advancement into the water on single (or multiple) wells by virtue of two substantially identical driller consoles. Moreover, as for steps (c) and (d) of claim 5, the Board agrees with the Respondent in that due to the wording "to a position in proximity to the wellhole", which was already in claim 5 of the granted patent, the positional height of the BOP and riser above the seabed is indeed vague. Furthermore, after the BOP and riser were being run to the proximity of the seabed as described by step (c) of claim 5, the term "landing"

according to step (d) encompasses either landing immediately after step (c), or landing of the BOP and riser after step (c) at a later stage wherein additional activities prior to landing can be carried out. However, in the Board's view, and also in accordance with the argument of the Appellant, the application as filed discloses running the BOP and landing it as two different method steps, irrespective whether the running of the BOP is previously stopped or not.

Reference is firstly made to the drilling sequence for a single well as described in detail by the figure 23b embodiment. The two different time bars 264 and 266 as shown in the diagram of figure 23b imply that the BOP is run in a first step to the "proximity" of the seabed and then, in a second step, is landed. This is indicated by the end point of time bar 264, the latter being drawn offset and distinct from the start point of time bar 266 in figure 23b. Moreover, due to the timeline on top of the diagram, the skilled person could easily derive from figure 23b that time bar 284 shows the time period of drilling and running the casing which slightly overlaps the end of time bar 264, i.e. that in any case the BOP and riser are simultaneously run to a position in proximity to the wellhole as is described by step (c) of claim 5. Finally, landing of the BOP according to time bar 266 is started immediately after the BOP has been run to the proximity of the seabed, and further landing of the BOP takes place after the casing has been drilled and run. The Board notes that, e.g., the laying down of BHAs (Bottom Hole Assembly) and running tools as shown by time bar 286 is also taking place during the further

landing of the BOP. However, the skilled person would readily recognize that these method steps are not related to the key concept of simultaneously advancing tubular members into the water. Thus, the combination of feature groups (a) to (c) of claim 5 and the landing of the BOP and riser immediately after step (c) is considered to be disclosed. Furthermore, the absence of, e.g., laying down operations during the further landing of the BOP does not extend the subject-matter of the originally filed application.

Moreover, reference is made to the figure 11 and 12 embodiment for a single well on page 24, lines 7 to 8 (as published), describing the riser and BOP as having to be run "to" the seabed by a first (main) rig simultaneously during drilling and the running of the casing by a second (auxiliary) rig. Thus, the skilled person would derive from this that prior to landing necessarily the BOP approaches the seafloor, due to the considerable amount of time which is used to drill and run the casing at the same time, as can also be readily seen from figure 11 as originally filed, where the BOP "200" is positioned in the "proximity" of the seafloor while the casing "202" is still being run. After that, as described on page 24, lines 16 to 17 of the application (as published), the first rig lands the BOP onto the wellhead: cf. also figure 12. In the view of the Board, no close functionality to the key concept of shortening the critical path of the drilling operation can be seen in the cementing of the casing as described on page 24, lines 13 and 14 of the application (as published), since this is achieved by lowering the BOP into the water while the casing is being simultaneously run, as pointed out above. Rather, as also argued by

the Appellant, the subsequent landing step takes further advantage of advancing tubular members into the water by means of two identical rigs, since the BOP can thus be run all the way down by one and the same advancing means. Finally, for the sake of completeness, the Board notes that the laying down of the jetting and drilling assembly on board the drillship, as described on page 24, lines 17 to 19, takes place at the same time as the landing of the BOP is started. However, neither any relationship of this method step to the key concept of simultaneously advancing tubular members into the water, nor to the final landing step of the BOP, would be derivable for the skilled person from the content of the application as filed. The combination of feature groups (a) to (c) of claim 5 and the landing of the BOP and riser after step (c) at a later stage is therefore also considered to be disclosed, and the absence of the cementing operation and still less of the laying down operation, does not extend the subject-matter of the originally filed application.

As regards the disclosure of the features "drilling deck" and "first and second means for advancing tubular members" reference is made to point 4.1.1 above.

Summing up, the subject-matter of claim 5 can be deduced from page 34, lines 6 to 15 of the application (as published) in combination with the method steps described for the figure 23b embodiment on page 30 lines 4 to 9, and 31, lines 4 to 8 and for the figure 11 and 12 embodiment on page 24, lines 7 to 17 (as published). The Board is, therefore, satisfied that its subject-matter does not extend beyond the content

of the application as filed in accordance with Article 100(c) EPC.

#### 4.3 *Amendments of description*

- 4.3.1 Compared to the patent as granted, significant amendments have been made in columns 9, 12 and 13 of the description. In particular the amendments in column 12, line 15 and column 13, lines 38 to 40 and also the amendments in column 9, lines 9 to 13 and 32 to 42 restore the text passages as originally filed and are thus clearly a fair attempt to overcome the objections of added subject-matter raised during the opposition procedure. Therefore, in the view of the Board, the present amendments were occasioned by a ground for opposition under Article 100 EPC and are not "voluntary" amendments as argued by the Respondent, citing T 0113/86.

Furthermore, Article 123(3) EPC provides that a European patent may not be amended in such a way as to extend the "protection it confers". Therefore, in order to assess the extent of protection conferred, substantive examination at the European Patent Office has to be based on the provisions of Article 69 and its Protocol, which serve primarily as a link to national law, thus adapting the respective national law for use by the judicial instances which deal with pending infringement issues. Although according to Article 69 the extent of the protection conferred shall be determined by the claims in the first place, Article 1 of the Protocol on the interpretation of Article 69 EPC stipulates that the description and drawings should not be employed only for the purpose of resolving an

ambiguity found in the claims. In principle, therefore amendments of the description may affect the scope of the patent. In the present case, however, the omitted sentence in column 9, lines 35 to 37 merely said that tubular advancing means are essential. This is in conformity with the claims which, being method rather than apparatus claims, define the advancing of tubular members by use of advancing means. Irrespective of the description, therefore, the claims imply some means for advancing the tubular members and an omission of the above mentioned sentence in the description cannot give rise to a construction of the claims as not comprising tubular advancing means. Furthermore, even if the sentence was understood in the sense that a rotary table or a top drive are essential, which in the Board's judgement is not a correct interpretation, it could merely be read in context with the embodiment described in paragraph [0042], and thus not as actually contributing to a general interpretation of the invention according to the independent claims as granted. Moreover, also the rest of the description of the granted patent, e.g. column 9, paragraph [0041] and column 10, lines 42 to 47 describe tubular advancing means without any limitation whatsoever.

In the Board's view therefore, even taking into account the fact that the description may be used for the interpretation of the claims, with the result that the scope of the patent in particular cases may be narrower than defined by the claims, the omission of lines 35 to 37 column 9 does not infringe Article 123(3) EPC.

- 4.3.2 The Respondent had no objections to the remaining amendments to the description, i.e. on pages 2, 3, 3a,

4, 5, 9 and 10. Nor does the Board have any objections to them as they consist in the adaptation of the description to the present claims and the citation of prior art document D15 in accordance with Article 84 EPC and Rule 42 EPC.

4.4 Therefore the present claims and description fulfil the requirements of Rule 80 EPC and Article 123(2),(3) EPC.

5. *Insufficiency of disclosure*  
(Article 100(b) EPC)

Although not explicitly mentioned in the original application, the Board agrees with the Appellant that repositioning of a BOP hanging from a riser string is a step routinely carried out by the skilled person, as was also stated in the decision of the Opposition Division. The ratio of the vertical distance between the drillship and the seabed to the lateral deviation between the BOP and the wellhole is normally extremely large. A skilled person, using his ordinary technical knowledge, would thus necessarily carry out lateral adjustments during the running of the BOP by means of, e.g., guidelines, ROVs (Remotely Operated Vehicle) or subsea thrusters and would, therefore, also achieve a lateral movement of the BOP in order to land the latter onto the wellhead as defined by step (d) of claim 5. Moreover, the Respondent, who is contesting that the subject-matter of claim 5 can be carried out, has the burden of proof. However, no plausible evidence or argument as to why lateral displacement of the BOP would not be feasible for the skilled person was provided.

The subject-matter of claim 5 therefore meets the requirements of Article 100(b) EPC.

6. *Clarity of Amendments*  
(Article 84 EPC)

In the view of the Board, the word "from" in step (d) of claim 5 clearly serves to determine which of the advancing means is performing the landing, and is consistent with the wording used in steps (a), (b) and (c) of claim 5. Moreover, this is supported by the description, since "the" main rig and (first) rotary station 160 actually lands the BOP, as is also clearly shown in figures 11 and 12: cf. page 24, lines 16 and 17 of the original application (as published), corresponding to paragraph [0056] of the patent.

Therefore claim 5 complies with Article 84 EPC.

7. *Novelty*  
(Article 100(a) EPC, see Article 54 EPC)

7.1 *Claim 1*

The Respondent did not dispute the novelty of claim 1, and since also the Board has no reason to doubt that its subject-matter is novel, claim 1 is considered to comply with Article 54 EPC.

7.2 *Claim 5*

The document D15 describes drilling on a single well from a floating "drilling platform 1", which comprises a "drilling derrick 14" and a "pre-assembly

installation 34" (cf. abstract; pages 1 to 4, line 17, page 8, line 3 to page 10, line 22; figures 1 to 3; figure 11 and figures 14 to 16). After drilling a top hole, the casing is placed, i.e. run, into the wellhole by means of the drilling rig ("drilling derrick 14"). During the drilling activities of the drilling rig, the interconnection of riser pipes can be simultaneously carried out thus forming a sub-assembly at the "pre-assembly installation 34": cf. in particular page 3, lines 4 to 11 and lines 19 to 27, figures 2, 11 and 14 to 16. The subassembly of the riser string comprises at most so many riser pipes that its length is 90 percent or more of the desired final length of the riser string: cf. page 4, lines 7 to 17 and claim 10. The transfer of the pre-assembled riser string between the "pre-assembly installation 34" and the "drilling derrick 14" takes place by means of a "conveyor 106", which moves along "rails 104" in the figure 14 to 16 embodiment: cf. page 10, lines 9 to 22. In the figure 9 to 13 embodiment, the transfer is apparently achieved by means of the "hoisting crane 2", cf. page 9 line 17 to page 10, line 8. The parties agreed that the BOP must be conventionally connected to the end of the riser string, and is landed by means of the "drilling derrick 14": cf. page 1, line 33 to page 2, line 2.

However, contrary to the Respondent's view, claim 5 clearly provides that the subsequent landing of the BOP and riser is performed by means of a second advancing means, viz. by the same advancing means which simultaneously has been running the BOP and riser to the proximity of the seabed, at least partly while drilling and the running of the casing by a first advancing means has been taking place. Although

lowering 90 percent of the riser string by means of the "pre-assembly installation 34" in D15 can also be considered as running the BOP and riser to the vaguely defined "proximity" of the seabed, while simultaneously the casing is being run by the "drilling derrick 14", D15 does not state that the subsequent landing of the BOP and riser also takes place by means of the "pre-assembly installation 34". On the contrary, D15 discloses a handover between the "pre-assembly installation 34" and the "drilling derrick 14" prior to landing of BOP and riser. Thus, in the opinion of the Board, the subject-matter of claim 5 differs from the disclosure of D15 in that the running and landing of the BOP and riser are fully performed by one and the same advancing means.

The novelty of claim 5 over the remaining known prior art was not disputed by the Respondent, and is also acknowledged by the Board. Therefore the subject-matter of claim 5 meets the requirements of Article 54 EPC.

8. *Inventive step*  
(Article 100(a) EPC, see Article 56 EPC)

8.1 *Claim 1*

During the oral proceedings, document D15 was taken as representing the closest prior art, as to which, reference is made to point 7.2 above. The subject-matter of claim 1 thus differs from the disclosure of D15 in that according to step (b), on a single well tubular members are also advanced into the seabed by a further (second) advancing means.

The problem underlying this distinguishing feature can be seen in an improvement in the operation of the floating platform so as to further shorten the critical path.

The prior art E18 states on page 5, left and right column and figure 7 that two drilling rigs are used on the SSCV (Semi Submersible Crane Vessel). However, the use of both rigs for advancing tubular members into a single well is not derivable from E18. As regards the disclosure of E1, a floating drilling platform is described which also comprises dual rigs. However, merely simultaneous drilling on multiple wells is addressed by E1: cf. column 1, lines 5 to 17; line 55 to column 2, line 20; column 5, line 52 to column 6, line 26; figures 1,2, 3a and 3b.

Therefore the Board concludes that, starting from D15, and irrespective of whether the "pre-assembly installation 34" of D15 can be readily adapted for drilling into the seabed or not, the skilled person, faced with the problem of how to further shorten the critical path, does not get any incentive from either E18 or E1 to use their dual rigs on a single well, and to advance tubular members thereby from both of the rigs into that single well.

The subject-matter of claim 1 therefore involves an inventive step.

## 8.2 *Claim 5*

During the oral proceedings, D15 was again considered as nearest prior art. As pointed out above with respect

to the novelty of claim 5, the subject-matter of claim 5 differs from the disclosure of D15 in that the running and landing of the BOP and riser are fully performed by one and the same advancing means.

In the light of D15, the problem to be solved can be seen in additional time saving when landing the BOP onto the wellhole.

It is reiterated that E18 does not hint at conducting drilling operations with both rigs on a single well. Moreover, in particular the paragraph of E18, starting on page 5, left column, headed "Interface of crane operations with drilling", does not provide any information as to how an assembled full riser string with BOPs is actually placed, i.e. landed onto the wellhole, be it with or without motion compensation. The operations in non-critical time, i.e. the time saving operations to assemble/retrieve casings, the BHA and full riser strings with BOPs appear to take place by means of cranes and a pre-assembly point at the rear end of the platform, as is shown in figure 7 of E18.

To conclude, starting from D15 and taking into consideration his ordinary common technical knowledge, in the Board's view, the skilled person would not get any incentive whatsoever to use the "pre-assembly installation 34" for landing of the BOP if he was looking for time savings. Moreover, the skilled person would also not get any indication from E18 to modify D15 such that the "pre-assembly installation 34" should be replaced by a crane or a derrick of E18 and should then be used to land the BOP and riser onto the

wellhole, let alone onto a single well, to achieve the advantages of the claimed solution.

The subject-matter of claim 5 thus also involves an inventive step.

## **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:
  - Description, pages:  
2,3,3a,4 to 10 as filed during the oral proceedings;
  - Claims, No.:  
1 to 6 as filed during the oral proceedings;
  - Drawings, figures:  
1 to 23b as granted.

The Registrar

The Chairman

A. Counillon

U. Krause

