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Datasheet for the decision of 4 July 2013

Case Number: T 1986/09 - 3.3.10

Application Number: 03700361.3

Publication Number: 1466073

IPC: E21B33/138

Language of the proceedings: EN

Title of invention:
LOST CIRCULATION COMPOSITIONS

Applicant:
HALLIBURTON ENERGY SERVICES, INC.

Headword:

Relevant legal provisions:
EPC Art. 123(2), 111(1)

Keyword:
Remittal for further prosecution.

Decisions cited:

Catchword:

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Case Number: T 1986/09 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 4 July 2013

Appellant: (Applicant)	HALLIBURTON ENERGY SERVICES, INC. P.O. Box 1431 Duncan, Oklahoma 73536 (US)
Representative:	Turner, Craig Robert A.A. Thornton & Co. 235 High Holborn London WC1V 7LE (GB)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 13 May 2009 refusing European patent application No. 03700361.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: P. Gryczka
Members: R. Pérez Carlón
C. Schmidt

Summary of Facts and Submissions

I. The appeal lies from the decision of the examining division to refuse European patent application EP 03 700 361.

II. The examining division did not admit the then pending main and first auxiliary requests into the proceedings and decided that the subject-matter claimed in the second auxiliary request was not inventive having regard at the prior art in particular since there was no example on file which could show that a blend of a resilient carbon based material, a water soluble but not water swellable polymer, and an alcohol, showed a synergistic effect in the claimed method.

III. The independent claims of the sole request of the appellant (applicant), filed during the oral proceedings before the board, read as follows:

1. "A method of preventing or alleviating lost circulation of drilling fluid in a wellbore penetrating a subterranean formation, said method comprising treating said wellbore with a lost circulation composition comprising a blend of a resilient carbon-based material, a water-swellable but not water-soluble crystalline synthetic polymer and glyoxal, wherein the resilient carbon-based material rebounds by at least about 20 volume percent when a compaction pressure of 10,000 psi is applied, wherein the polymer comprises 7.61 to 38.1 kg/m^3 (2 to 10 pounds per barrel) of the blend and the resilient carbon-based material comprises 266 to 343 kg/m^3 (70 to 90 pounds per barrel) of the blend, wherein the resilient carbon-based particulate material comprises graphite carbon particles and ungraphitized carbon particles, and the quantity of the

resilient graphitic carbon particles exceeds the quantity of ungraphitized carbon particles, and the polymer comprises a crosslinked polyacrylamide."

2. "A method of preventing or alleviating loss of drilling fluid in a wellbore penetrating a subterranean formation, said method comprising adding to said drilling fluid a lost circulation composition; and allowing said additive to enter a lost circulation zone of said formation, wherein the lost circulation composition comprises a blend of a resilient carbon-based material, a water-swellable but not water-soluble crystalline synthetic polymer, and glyoxal, wherein the resilient carbon-based material rebounds by at least about 20 volume percent when a compaction pressure of 10,000 psi is applied, wherein the polymer comprises 7.61 to 38.1 kg/m^3 (2 to 10 pounds per barrel) of the blend and the resilient carbon-based material comprises 266 to 343 kg/m^3 (70 to 90 pounds per barrel) of the blend, wherein the resilient carbon-based particulate material comprises graphite carbon particles and ungraphitized carbon particles, and the quantity of the resilient graphitic carbon particles exceeds the quantity of ungraphitized carbon particles, and the polymer comprises a crosslinked polyacrylamide."

3. "A method of treating lost circulation of fluids in a wellbore penetrating a subterranean formation, the method comprising introducing into said wellbore a lost circulation composition and allowing said composition to enter a lost circulation zone of said formation, wherein the lost circulation composition comprises a blend of a resilient carbon-based material, a water-swellable but not water-soluble crystalline synthetic polymer and glyoxal, wherein the resilient carbon-based material rebounds by at least about 20 volume percent

when a compaction pressure of 10,000 psi is applied, wherein the polymer comprises 7.61 to 38.1 kg/m^3 (2 to 10 pounds per barrel) of the blend and the resilient carbon-based material comprises 266 to 343 kg/m^3 (70 to 90 pounds per barrel) of the blend, wherein the resilient carbon-based particulate material comprises graphite carbon particles and ungraphitized carbon particles, and the quantity of the resilient graphitic carbon particles exceeds the quantity of ungraphitized carbon particles, and the polymer comprises a crosslinked polyacrylamide."

IV. Oral proceedings before the board took place on 4 July 2013.

V. The final request of the applicant was that the decision under appeal be set aside and a patent be granted upon the basis of the claims filed during the oral proceedings before the board.

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

Reasons for the Decision

1. The appeal is admissible.

Amendments:

2. Claim 1 finds a basis on method claim 13 when referring back to the combination of composition claims 1 to 9 as filed and the passage of the description on page 3, lines 2-4.

Claim 2 finds a basis on method claim 14 when referring back to the combination of composition claims 1 to 9 as

filed and the passage of the description on page 3, lines 2-4.

Claim 3 finds a basis on method claim 15 when referring back to the combination of composition claims 1 to 9 as filed and the passage of the description on page 3, lines 2-4.

Claim 4 finds a basis on claim 16 as originally filed.

The claims do not contain subject-matter which extends beyond the content of the application as originally filed (Article 123(2) EPC).

Remittal:

3. The examining division dealt with the issues of inventive step of a subject-matter which included the presence of an alcohol in the blend defined in the claims, and of clarity and added subject-matter arising from features which are not anymore in the claims of the request submitted before the board.

In contrast, the independent claims of the sole request in appeal proceedings are directed to methods using a blend comprising glyoxal, which is a component of some of the blends tested in the application (see table I), so that the argument of the examining division that the application did not contain any example which could show the alleged synergistic effect of the blends in the methods claimed does no longer apply.

The examining division had not dealt with the patentability of claims related to methods involving compositions comprising glyoxal, and the claimed subject-matter raises new issues, such as whether a

synergistic effect has been achieved.

In order to allow these issues to be examined by two instances, the board considers it appropriate to exercise the power conferred to it by Article 111(1) EPC to remit the case to the examining division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the first instance for further prosecution on the basis of the claims filed during the oral proceedings before the board.

The Registrar: The Chairman:

C. Rodríguez Rodríguez P. Gryczka

Decision electronically authenticated