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**Datasheet for the decision
of 1 December 2011**

Case Number: T 2375/10 - 3.3.10
Application Number: 06726487.9
Publication Number: 1869137
IPC: C09K 8/03, C09K 8/24,
C09K 8/467, C09K 8/32
Language of the proceedings: EN

Title of invention:

Methods of using wellbore servicing fluids comprising resilient material

Applicant:

HALLIBURTON ENERGY SERVICES, INC.

Headword:

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Relevant legal provisions:

EPC Art. 56, 111(1)
EPC R. 103(1)(a), 111(2)

Keyword:

"Procedural violation (yes): decision not reasoned"
"Remittal (yes): reimbursement of appeal fee (yes)"

Decisions cited:

T 0278/00, T 1366/05, T 0087/08

Catchword:

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Case Number: T 2375/10 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 1 December 2011

Appellant:
(Applicant)

HALLIBURTON ENERGY SERVICES, INC.
P.O. Box 1431
Duncan
OK 73533 (US)

Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 29 June 2010
refusing European patent application
No. 06726487.9 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: P. Gryczka
Members: J.-C. Schmid
D. S. Rogers

Summary of Facts and Submissions

- I. The appeal lies from the decision of the Examining Division refusing European patent application No. 06726487.9.
- II. The Examining Division found that the claims according to the then sole pending request did not involve an inventive step (Article 56 EPC).
- III. With the grounds of appeal, the Appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the new main request, or subsidiarily, on the basis of auxiliary requests 1 to 4, all requests filed on 9 November 2010.
- IV. In a communication dated 21 April 2011, the Board indicated that the decision under appeal appeared to lack reasoning, and, therefore, on account of this procedural violation, it intended to remit the case to the first instance for further prosecution and to order the reimbursement of the appeal fee.
- V. With a fax dated 30 November 2011 the Appellant informed the Board that it would not attend the oral proceedings and requested the Board to remit the case to the department of first instance and to order the reimbursement of the appeal fee.
- VI. At the end of the oral proceedings held on the 1 December 2011 in the absence of the Appellant the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.

Procedural violation

2. According to established jurisprudence of the Boards of Appeal, to satisfy the requirement of Rule 111(2) EPC a decision should contain, in logical sequence supporting arguments. The conclusions drawn by the deciding body from the facts and evidence must be made clear. Therefore all the facts, evidence and arguments which are essential to the decision must be discussed in detail in the decision including all the decisive considerations in respect of the factual and legal aspects of the case. The purpose of the requirement to reason the decision is to enable the Appellant and, in case of an appeal, also the Board of Appeal to examine whether the decision could be considered to be justified or not (see T 278/00, OJ EPO, 2003, 546; T 87/08 and T 1366/05 not published in OJ EPO).

In the present case the Examining Division decided against the Appellant, that the subject-matter of claim 1 according to the sole then pending request did not involve an inventive step (Article 56 EPC).

Article 56 EPC requires that the assessment of inventive step is made having regard to the state of the art. Accordingly, the logical chain of reasoning of the Examining Division in the decision under appeal, to justify the above conclusions under Article 56 EPC, has to contain a proper assessment of the question of obviousness in the light of the prior art.

The only part of the section "Reasons for the Decision" of the written decision under appeal dealing with the issue of inventive step is to be found in point 3, comprising two paragraphs. Paragraph 3.1 merely summarizes the arguments of the Applicant and does not reflect the Examination Division's own considerations, this paragraph in fact should rather belong to the section "Facts and Submissions" of the written decision under appeal. The mere summary of a party's submission is not per se a reasoning proper to the deciding body. Consequently, paragraph 3.2 is the sole portion of the written decision under appeal which may reveal the reasoning of the Opposition Division on the issue of inventive step and, thus, is the sole portion of the decision which could justify the Examination Division's conclusion of lack of inventive step. However, there is no reference at all in this paragraph to any prior art, paragraph 3.2 merely stating that the claimed subject-matter did not comply with the requirements of Article 56 EPC since the technical effect of pressure reduction in a wellbore fluid was only demonstrated for graphite as the resilient material, but that this effect had not been shown for the other cited materials and therefore the selection of materials recited in claim 1 did not solve the technical problem in its entire breadth.

Therefore, the Examining Division arrived in the appealed decision at the conclusion that the claimed subject-matter lacked inventive step merely by declaring that a purported effect has not been achieved by other cited materials, i.e. the technical problem as defined in the application as filed had not been solved in the entire breadth of the claims, without

reformulating the problem in a less ambitious way and without assessing obviousness of the claimed solution to that reformulated problem in the light of the cited prior art.

Since, the requirement of inventive step defined in Article 56 EPC is based on the state of the art, the decision of the Examining Division, by arriving at a conclusion of lack of inventive step without reference to prior art, is insufficiently reasoned in the sense of Rule 111(2) EPC.

3. This failure amounts to a substantial procedural violation requiring that the decision under appeal is set aside and the case is remitted to the first instance (see T 278/00, loc. cit. point 5, above). The appeal is thus deemed to be allowable and the Board considers it to be equitable by reason of the substantial procedural violation to reimburse the appeal fee pursuant to Rule 103(1)(a) EPC.

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.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:

C. Rodríguez Rodríguez

P. Gryczka