

**Internal distribution code:**

- (A) [ - ] Publication in OJ
- (B) [ - ] To Chairmen and Members
- (C) [ - ] To Chairmen
- (D) [ X ] No distribution

**Datasheet for the decision  
of 10 July 2015**

**Case Number:** T 0202/13 - 3.2.03  
**Application Number:** 02022449.9  
**Publication Number:** 1277913  
**IPC:** E21B15/02, E21B19/00, E21B7/12  
**Language of the proceedings:** EN

**Title of invention:**

Drillship or semi-submersible and multi-activity drilling assembly

**Patent Proprietor:**

Transocean Offshore Deepwater Drilling Inc.

**Opponents:**

Stena Drilling Ltd.  
Aker MH AS  
BP AMERICA INC.  
A.P. Moller-Maersk A/S

**Headword:**

**Relevant legal provisions:**

EPC Art. 100(c), 76(1), 123(2), 123(3), 84, 111(1), 104(1)  
RPBA Art. 12(2), 12(4), 13(1), 13(3), 16(1)

**Keyword:**

Late-filed requests - admitted (yes)  
Amendments - allowable (yes)  
Remittal to the department of first instance - (yes)  
Apportionment of costs - (no)  
Evaluation of evidence - standard of proof

**Decisions cited:**

T 0173/83, T 0830/90, T 0887/90, T 0729/91, T 0799/91,  
T 0958/91, T 0472/92, T 0254/98, T 0012/00, T 0342/07,  
T 1686/06

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

European Patent Office  
D-80298 MUNICH  
GERMANY  
Tel. +49 (0) 89 2399-0  
Fax +49 (0) 89 2399-4465

Case Number: T 0202/13 - 3.2.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.03**  
**of 10 July 2015**

**Appellant:** Transocean Offshore Deepwater Drilling Inc.  
(Patent Proprietor) Four Greenway Plaza  
Houston, TX 77046 (US)

**Representative:** Hoffmann Eitle  
Patent- und Rechtsanwälte PartmbB  
Arabellastraße 30  
81925 München (DE)

**Respondent:** Stena Drilling Ltd.  
(Opponent 1) Ullevi House,  
Greenbank Crescent,  
East Tullos  
Aberdeen AB12 3BG (GB)

**Representative:** Nederlandsch Octrooibureau  
P.O. Box 29720  
2502 LS The Hague (NL)

**Respondent:** Aker MH AS  
(Opponent 2) Seadrill Offshore AS / P.O. Box 110/4001  
Stavanger  
Odfjell Drilling AS / P.O. Box 33/5863 Bergen  
Serviceboks 413  
4604 Kristiansand S (NO)

**Representative:** Valea AB  
Box 1098  
405 23 Göteborg (SE)

**Respondent:** BP AMERICA INC.  
(Opponent 3) 4101 Winfield Road, Warrenville  
Illinois 60555 (US)

**Representative:** Mathys & Squire LLP  
The Shard  
32 London Bridge Street  
London SE1 9SG (GB)

**Respondent:** A.P. Moller-Maersk A/S  
(Opponent 4) trading in the name of Maersk Drilling  
Esplanaden 50  
1098 Copenhagen K (DK)

**Representative:** Guardian  
IP Consulting I/S  
Diplomvej, Building 381  
2800 Kgs. Lyngby (DK)

**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 19 November  
2012 revoking European patent No. 1277913  
pursuant to Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** G. Ashley  
**Members:** V. Bouyssy  
M. Blasi  
C. Donnelly  
E. Kossonakou

## **Summary of Facts and Submissions**

- I. European patent No. 1 277 913 (in the following: "the patent") concerns a drilling vessel and drilling assembly for simultaneously conducting offshore drilling operations and auxiliary drilling operations.
- II. The patent derives from European patent application No. 02022449.9 (D0), which is a divisional application of earlier European patent application No. 97903797.5, filed as PCT/US97/00537 and published as WO97/42393 (P0). In the following, when referring to the application as filed, reference is made to the application documents as originally filed at the EPO (D0). When referring to the earlier application as filed, reference is made to the earlier application as published (P0). The patent granted in respect of the earlier application was the subject of an opposition appeal (decision T 324/07).
- III. The patent as a whole was opposed by Opponents 1 to 4 on the grounds of Article 100(c) EPC, Article 100(b) EPC, and Article 100(a) EPC for lack of novelty and inventive step.
- IV. The Opposition Division decided that Article 100(c) EPC prejudiced the maintenance of the patent as granted and as amended, because claim 1 as granted and as amended introduced subject-matter extending beyond the content of the application as filed (Article 123(2) EPC), as well as beyond the content of the earlier application as filed (Article 76(1) EPC).
- V. This decision has been appealed by the patent proprietor.

VI. With the summons to oral proceedings, the Board sent a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) indicating to the parties its preliminary opinion of the case.

VII. Oral proceedings before the Board were held on 9 and 10 July 2015.

VIII. Requests

The patent proprietor (here the appellant) requested that the decision under appeal be set aside, and that the case be remitted to the Opposition Division for further prosecution on the basis of the highest order of allowable request for claim 1 and its dependent claims (claim 1 main request and claim 1 auxiliary requests 1a, 1 to 3, 4a, 4 to 11), in combination - if applicable - with the highest order of allowable request for independent claim 7 and its dependent claims (claim 7 main request and claim 7 auxiliary requests 1a, 1b, 1c, 1 to 8), as filed with the statement of grounds of appeal and the letter of 9 June 2015, in the order specified in the letters of 24 September 2014 and 9 June 2015.

Opponents 1 to 4 (here respondents 1 to 4) requested that the appeal be dismissed. In addition, respondent 1 requested a different apportionment of costs if the case were to be remitted to the Opposition Division.

IX. Cited evidence

In the statement setting out the grounds of appeal, the appellant referred to the following documents, which had already been filed in the opposition proceedings and are cited in the decision under appeal:

- D8: Maritime Hydraulics AS (in the following: "MH"),  
"MH Quotation no. 9604116 - Drilling Package for  
Drillship Project", dated 26 April 1996, sent to  
Mr Sturla Fjoran at Maritime Engineering AS ("ME")  
with letter dated 25 April 1996, including MH's  
"Technical Bulletin 01/96 - The Ram Rig  
Concept" (appendix 6.2) and MH's "General  
Catalogue 1996-97" (appendix 6.4)
- S9: MH's "Technical Bulletin 1/96 - The Ram Rig  
Concept"

The appellant also referred to the minutes of the  
hearing of Ms Timenes, Ms Furuholt and Mr Fjoran as  
witnesses before the Opposition Division on 14 May 2012  
(minutes of taking of evidence, hereafter "MTE").

- X. Claims of the appellant's requests
- a) Claim 1 - Main request

Independent claim 1 is directed to the following  
subject-matter (the feature numbering has been  
introduced by respondent 2; compared with claim 1 as  
granted, added features are indicated in bold, deleted  
features in strike-through):

- a) A vessel, the vessel being
- a1) a drillship having a bow (35), a stern (38) and an  
intermediate moon pool (34) between the bow and  
stern
- a2) or a semi-submersible having a moon pool and
- b) the vessel being fitted to conduct offshore  
drilling operations through the moon pool to the  
seabed and into the bed of a body of water,
- c) said ~~drillship~~ **vessel** including:

- c1) a derrick (40) positioned upon the ~~drillship~~ **vessel** and extending above the moon pool (34) for simultaneously supporting drilling operations and operations auxiliary to drilling operations through the moon pool (34);
- c2) a first means (160) connected to said derrick (40) for advancing tubular members through the moon pool (34), to the seabed and into the bed of the body of water;
- c3) a second means (162) connected to said derrick for advancing tubular members through the moon pool (34), to the seabed and into the bed of the body of water; and
- c4) means (164, 166, 168) positioned within said derrick (40) for transferring tubular assemblies between said first means (160) for advancing tubular members and said second means (162) for advancing tubular members to facilitate simultaneous drilling operations and operations auxiliary to said drilling operations,
- d) said transferring means (164, 166, 168) comprising
  - d1) a rail assembly (168) operably extending between a position adjacent to said first means for advancing tubular members (160) and a position adjacent to said second means (162), for advancing tubular members,
  - d2) first means (164), mounted to traverse upon said rail assembly (168), for handling tubular members ~~which are for advancement~~ **as said tubular members are advanced** through the moon pool (34) by said first means for advancing, and
  - d3) second means (166), mounted to traverse upon said rail assembly (168), for handling tubular members ~~which are for advancement~~ **as said tubular members are advanced** through the moon pool (34) by said second means for advancing (162) for conducting



operations extending to the seabed auxiliary to said drilling operations,

- e) wherein tubular assemblies may be operably transferred between said first means for advancing tubular members (160) and said second means for advancing tubular members (162) to facilitate simultaneous drilling operations and operations auxiliary to said drilling operations and
- f) wherein drilling activity can be conducted from said derrick by said first or second means for advancing (160, 162) and said first or second means for handling tubular members (164, 166) and auxiliary drilling activity can be simultaneously conducted from said derrick by the other of said first or second means for advancing and the other of said first or second means for handling tubular members."

- b) Claim 1 - Auxiliary request 1a

Claim 1 differs from claim 1 main request in that the wording of granted claim 1 "**which are for advancement**" has been reinstated in place of "as said tubular members are advanced".

- c) Claim 1 - Auxiliary request 1

Claim 1 differs from claim 1 the main request in that it comprises the additional limitation that the derrick is positioned "**upon a deck of the drillship or the semi-submersible**".

- d) Claim 1 - Auxiliary request 2

Claim 1 differs from claim 1 main request in that the two expressions "mounted to traverse upon said rail

assembly" have been changed to **"mounted to traverse upon said rail"**.

e) Claim 1 - Auxiliary request 3

Claim 1 differs from claim 1 auxiliary request 2 in that the words **"having a rail"** have been inserted after the expression "said transferring means comprising a rail assembly".

f) Claim 1 - Auxiliary request 4a

Claim 1 differs from claim 1 auxiliary request 1a in that the last feature has been recast as follows:

"wherein drilling activity can be conducted from said derrick by said first ~~or second~~ means for advancing (160,~~162~~) and said first ~~or second~~ means for handling tubular members (164,~~166~~) and auxiliary drilling activity can be simultaneously conducted from said derrick by the ~~other of said first or second~~ means for advancing **(162)** and the ~~other of said first or second~~ means for handling tubular members **(166)**".

g) Claim 1 - Auxiliary request 4

Claim 1 differs from claim 1 main request in that the last feature has been amended in the same manner as claim 1 auxiliary request 4a.

h) Claim 1 - Auxiliary request 5

Claim 1 differs from claim 1 main request in that it comprises the additional limitations of claims 4 to 6 as granted.

i) Claim 1 - Auxiliary request 6

Claim 1 differs from claim 1 auxiliary request 3 in that it comprises the additional limitation of claim 1 auxiliary request 1 and that the last feature has been amended in the same manner as in claim 1 auxiliary request 4.

j) Claim 1 - Auxiliary request 7

Claim 1 differs from claim 1 auxiliary request 5 in that it comprises the additional limitation of claim 1 auxiliary request 1 and that the last feature has been amended in the same manner as claim 1 auxiliary request 4.

k) Claim 1 - Auxiliary request 8

Claim 1 differs from claim 1 auxiliary request 7 in that it has been further amended in the same manner as claim 1 auxiliary requests 2 and 4.

l) Claim 1 - Auxiliary requests 9 to 11

Claim 1 differs from claim 1 auxiliary requests 3, 6 and 8, respectively, in that it has been limited to a **drillship**.

m) Claim 7 - Main request

Independent claim 7 is directed to the following subject-matter (the feature numbering has been introduced by respondent 2; compared with claim 7 as granted, added features are indicated in bold, deleted features in strike-through):

- a) A multi-activity drilling assembly operable to be supported from a position above the surface of a body of water
- b) for conducting drilling operations to the seabed and into the bed of the body of water for a single well,
- c) said multi-activity drilling assembly including:
  - c1) (a) a drilling superstructure (40) operable to be mounted upon a drilling deck (112) **of a drillship, semi-submersible, tension leg platform, or the like**, for simultaneously supporting drilling operations for a well and operations auxiliary to drilling operations for the well **through the drilling deck;**
  - c2) (b) first means (162) connected to said drilling superstructure (40) for advancing tubular members **through the drilling deck** to the seabed and into the bed of the body of water;
  - c3) (c) second means (160) connected to said drilling superstructure (40) for advancing tubular members **through the drilling deck** simultaneously with said first means (162) into the body of water to the seabed; and
  - c4) (d) means (166, 164, 168) positioned adjacent to said first and second means (162, 160) for advancing tubular members, for transferring tubular assemblies between said first means for advancing tubular members (162) and said second means for advancing tubular members (160) to facilitate simultaneous drilling operations auxiliary to said drilling operations,
- d) wherein drilling activity can be conducted for the well from said drilling superstructure (40) by said first or second means for advancing tubular members (162, 160) and

- e) auxiliary drilling activity can be simultaneously conducted for the well from said drilling superstructure (40) by the other of said first or second means for advancing tubular members (162, 160), and
- f) wherein said means for transferring tubular assemblies ~~of casings and of drill strings~~ comprises
  - f1) a rail assembly (168) operably extending between a position adjacent to said first means for advancing tubular members and a position adjacent to said second means for advancing tubular members;
  - f2) a first pipe handling assembly (164) mounted to traverse upon said rail assembly; and
  - f3) a second pipe handling assembly (166) mounted to traverse upon said rail assembly,
- g) whereby said tubular assemblies may be moved between said first means for advancing tubular members and said second means for advancing tubular members."

n) Claim 7 - Auxiliary request 1a

Claim 7 differs from claim 7 main request in that the wording of granted claim 7 "**of casings and of drill strings**" has been reinstated.

o) Claim 7 - Auxiliary request 1b

Claim 7 differs from claim 7 main request in that the wording "of a drillship, semi-submersible, tension leg platform, or the like" has been replaced by "**of a drillship, semi-submersible, tension leg platform, jack-up platform or offshore tower**".

p) Claim 7 - Auxiliary request 1c

Claim 7 differs from claim 7 main request in that it has been amended in the same manner as claim 7 auxiliary requests 1a and 1b.

q) Claim 7 - Auxiliary request 1

Claim 7 differs from claim 7 main request in that the words "**having a rail**" have been inserted after the expression "said transferring means comprising a rail assembly" and the two expressions "mounted to traverse upon said rail assembly" have been changed to "**mounted to traverse upon said rail**".

XI. The arguments of the parties in the written and oral proceedings, insofar as relevant for the present decision, can be summarised as follows:

a) Consideration of the appellant's requests

Respondents' case:

The numerous requests of the appellant, filed for the first time with the grounds of appeal, should not be admitted into the proceedings, pursuant to Article 12(4) RPBA, because they could already have been filed in the opposition proceedings and they contain amendments that had been withdrawn during the opposition proceedings. The late filing of this excessive number of requests amounts to a lack of due care or an abuse of procedure on the part of the appellant.

Appellant's case:

The requests are formulated clearly; the number of requests is appropriate and in proportion to the large number of objections raised under Article 100(c) EPC and the related reasons given in the decision under appeal. The number of requests is also proportionate to the complexity of the present case and has no adverse effect on procedural efficiency. The requests address all of the opponents' objections, each one thereof being a debatable point.

- b) Claim 1 - Main and auxiliary requests 1a, 1 to 3, 4a, 4 to 11 - Article 100(c) EPC

Appellant's case:

In contrast to patent applications that are drafted to describe an invention at increasing levels of detail, P0 was drafted to meet the "Best Mode" requirement under US Patent Law, and should be read with this in mind to understand what it actually teaches.

Contrary to the Opposition Division's decision, the combination of features of claim 1 does not extend beyond the teaching of P0. It is essentially based on claim 5 of P0 and on the preferred embodiment of the derrick illustrated in Figures 5 to 7 and described on pages 17 to 35. The reader would recognise that, in the context of claim 5 of P0, the ability to advance tubular members through the advancing stations is provided by the drawworks and the rotary tables and/or the top drives, whereas the handling means are rail-mounted and adapted to transfer or pass tubular assemblies to the advancing stations during the on-going process of building and advancing tubular members

to and/or into the seabed; the function of the handling means is clearly not to handle tubular members as they are advanced through the moon pool. The details of the rail assembly, the rail-mounted handling means and the functionalities of the advancing and handling means as required in claim 1 are based on the description of Figure 7 in page 19, line 4 to page 22, line 8 of P0.

Respondents' case:

There is nothing in the EPC or the case law to suggest that a patent document is to be interpreted differently depending on its origin.

Contrary to the appellant's submission, there is considerable doubt that the means for handling tubular members in claim 1 of P0 are the same as the rail-mounted handling means of claim 5 of P0. There is a sensible and technically meaningful alternative interpretation of claim 1 of P0, which associates the means for handling tubular members with other items of equipment, such as the drawworks or the top drives. Claim 1 of P0 is for a drillship, and defines first and second means "connected to" the derrick for handling tubular members "as said tubular members are advanced through the moon pool" by said first and second means for advancing, respectively. Turning to claim 2 of P0 and the detailed description of the drillship shown in Figures 5 to 8, it is explained that the first and second means for advancing tubular members may comprise a first and second top drive (page 20, line 18 to page 21, line 19), whereby the top drives are identical and each top drive is "connected to traveling block 152", comprises "a tubular handling assembly 188" and is adapted "to independently handle, make-up or break down, set back, and advance tubulars through multi-



stations over of a moon pool and into the seabed" (page 21, lines 8 to 11). This means that drilling activity can be conducted by the first top drive for advancing and handling tubular members, and auxiliary drilling activity can be simultaneously conducted by the second top drive for advancing and handling tubular members (page 21, lines 17 to 19), as required by the last feature in claim 1 of P0. It is clear from Figures 5 to 8 that each top drive is physically connected to the derrick via the traveling block and the drawwork cabling.

Claim 5 of P0 requires an additional rail-mounted transferring means which is clearly distinct from, and different to, the first and second handling means as defined in claim 1 (see wording "further including" in claim 4); this transferring means is adapted to move along a rail and thus is not connected to the derrick.

The definition of the rail-mounted first and second handling means in present claim 1 goes beyond this teaching of claim 5 of P0. There is no support in P0 for the generalisation of the rail-mounted pipe handling apparatuses 164 and 166 to rail-mounted transferring means for handling tubular members, whereby the terms "means" and "tubular members" have a broader meaning than the terms "apparatus" and "pipe". The terms "rail assembly" and "rail" are not synonymous and there is no support in P0 for the transferring means being mounted to traverse upon a generic "rail assembly". P0 does not provide any basis for rail-mounted transferring means, still less first and second handling means, adapted to handle the tubular members as they are advanced through the moon pool.

Finally, the last feature of claim 1 clearly requires that drilling activity can be conducted by any advancing means in combination with any handling means, while auxiliary drilling activity can be carried out simultaneously with the other advancing and handling means. This feature goes beyond the teaching in claim 1 of P0 that drilling activity can be conducted by the first advancing and handling means, while auxiliary drilling activity can be simultaneously conducted by the second advancing and handling means.

- c) Claim 7 - Main request and auxiliary requests 1a to 1c, 1 to 8 - Article 100(c) EPC

Appellant's case:

The combination of features of claim 7 is supported by claims 27 and 28 of P0 in light of the description of Figure 7 and claim 5 of P0. The details of the transferring means, its rail assembly and rail-mounted pipe handling assemblies and the functionalities of the advancing means are essentially based on the description of Figure 7 in page 19, line 4 to page 22, line 8 of P0. A skilled reader would recognise without any doubt from P0 that these details may be combined with the other features disclosed in the general context of claim 7 without creating an objectionable intermediate generalisation.

Respondents' case:

Claim 7 introduces subject-matter that extends beyond the disclosure of P0, in particular because of the following differences compared to claims 27 and 28 of P0:

- the feature that the drilling superstructure is "operable to be mounted upon a drilling deck" (feature (c1) of claim 7);
- the omission of the feature that the drilling superstructure is "operable to be mounted adjacent to an opening of a drillship, semi-submersible, tension leg platform, jack-up platform, offshore tower, or the like";
- the feature that the drilling superstructure simultaneously supports drilling operations and "operations auxiliary to drilling operations" (feature (c1));
- the feature that the first and second advancing means (hereafter "A1" and "A2") are both adapted for advancing tubular means "to the seabed", potentially at the same time (features (c2) and (c3));
- the feature that both drilling activity and auxiliary drilling activity can be simultaneously conducted by any of A1 and A2 (features (d) and (e)), although only A1 is adapted for advancing tubular means into the seabed;
- the omission of the further features of the rail and the rail-mounted pipe handling assemblies shown in Figure 7 of P0.

d) Claim 11 - Auxiliary request 1 - Article 100(c)  
EPC

Respondents' case:

Neither P0 nor D0 provides sufficient support for a drilling assembly as defined in dependent claim 11, which comprises a (single) "tubular setback envelope" positioned between the first and second means for

advancing tubular members and used in combination with two "tubular setback stations" (see claim 8).

Appellant's case:

The subject-matter of claim 11 is derivable from claim 29 of P0 and claim 9 of D0 in view of the teaching on pages 19 to 22 and Figure 7.

- e) Claim 7 - Auxiliary request 1 - Articles 76(1), 123(2) and (3) and 84 EPC

Respondents' case:

The addition of the wording "of a drillship, semi-submersible, tension leg platform, or the like" and "through the deck" adds new subject-matter as well as a lack of clarity. The addition of the features that the rail assembly has "a rail" and that the transferring/handling means are mounted to traverse upon "said rail" contravenes Articles 76(1) and 123(2) EPC as well as Article 123(3) EPC. The deletion of the expression "of casings and of drill strings" extends the scope of protection.

Appellant's case:

The contested amendments do not contravene the requirements of Articles 76(1), 123 and 84 EPC.

- f) Description - Article 100(c) EPC

Respondents 3 and 4 submit that the teaching in column 9, lines 10 to 13 of the patent specification introduces new subject-matter.

The appellant replies that this teaching is supported by the original teaching in page 20, lines 7 to 10 of either P0 or D0.

g) Remittal

In the event that the Board finds that any claim request overcomes the grounds of Article 100(c) EPC, the appellant and respondents 2 to 4 request that the case be remitted to the Opposition Division for examining compliance with Articles 100(b) and 100(a) EPC.

Respondent 1 contends that the Board should exercise its discretion under Article 111(1) EPC and deal with all matters directly.

h) Alleged prior disclosures to the public

Appellant's case:

D8 is a budget proposal submitted by Maritime Hydraulics AS ("MH") to Maritime Engineering AS ("ME") for the drilling package of a ME drillship. It describes a drilling package consisting of a RamRig with 600 tonne pulling capacity located above the moon pool (see page 1.0, "Introduction"), and includes as appendices MH's "Technical Bulletin 01/96 - The Ram Rig Concept" (appendix 6.2 titled "RamRig General Information") and MH's "General Catalogue 1996-97" (appendix 6.4 titled "MH General Catalogue"). It is acknowledged that MH's Technical Bulletin 1/96 was distributed at the Offshore Technology Conference ("OTC"), 6 to 9 May 1996, Houston, Texas.

However, the Opposition Division's conclusion that appendices 6.2 and 6.4 of D8 were made publicly available before the priority date of the patent (3 May 1996) is incorrect. The Opposition Division applied an incorrect standard of proof, namely "balance of probabilities" instead of "up to the hilt" or "beyond reasonable doubt", when trying to establish whether, when and how D8 was made available to the public. The division considered Mr Fjoran as being a separate third party, but in fact the alleged prior disclosure was one within the sphere of respondent 2. This justified the application of a high standard of proof. D8 was allegedly sent by MH to Mr Fjoran of ME and received by him on 26 or 27 April 1996. In view of the declaration of respondent 2 made during oral proceedings, it was no longer contested that D8 as appearing in the file corresponded to the quotation prepared by MH referred to by the witnesses Ms Timenes and Ms Furuholt. However, neither respondent 2, nor Mr Fjoran, nor ME have been able to produce specific evidence of the actual sending of D8 to ME, or of its delivery to and receipt by ME. It must be borne in mind that there were only a couple of days between the dates shown on D8 (25 and 26 April 1996, respectively) and the priority date of the patent, not all days being business days. Mr Fjoran needed the quotation D8 for the OTC and he travelled to Houston on 5 May 1996, i.e. after the priority date.

Irrespective of when Mr Fjoran received D8, he cannot be considered to be a member of the public, since he was under an implicit duty of confidentiality. D8 is a commercially sensitive document and would have been treated as such in its entirety; it is irrelevant whether Mr Fjoran thought he was free to disclose certain parts of D8 to interested third parties without

any restriction. In fact, Mr Fjoran acknowledged that he was not expected to carry out marketing of products for MH.

D8 is a unitary package sent in the form of a ring binder and it is unreasonable to assume that its recipient would split it up into its constituent parts and make a separate and correct assessment as to the confidentiality or otherwise of each constituent part. Appendices 6.2 and 6.4 of D8 provide general technical information on the RamRig design and thus are closely related to the RamRig design to which the budget proposal relates; they are thus an integral part of the budget proposal. The RamRig design was launched by MH in 1987 (see page 1 of Technical Bulletin 01/96). Of particular technical relevance for the present case are the two drawings in appendix 6.2 with the heading "Twin Ram", which show a double RamRig with two independent drilling and lifting systems. Respondent 2 has not provided any evidence that it was MH's intention to make this new Twin RamRig design available to the public by way of inserting it in D8 and sending D8 to Mr Fjoran, in advance of making this new design public at the OTC.

With respect to the alleged public prior disclosure of S9, the Opposition Division's decision should be upheld: it has not been proven beyond reasonable doubt that the alleged Technical Bulletin 1/96 was made publicly available by being put in MH's reception area before 3 May 1996.

Respondents' case:

It has been sufficiently proven that appendices 6.2 and 6.4 of D8 were marketing brochures sent before

3 May 1996 to Mr Fjoran, who was under no obligation of confidentiality in respect of the brochures; thus they form part of the state of the art under Article 54(2) EPC. The standard of proof to be applied was the "balance of probabilities" as respondent 2 had no control over Mr Fjoran because he was an independent third party. In any case, the chain of evidence documenting the public prior disclosure is complete beyond any reasonable doubt, and the three witnesses confirmed all the critical aspects of the disclosure. In particular, as the budget proposal D8 was sent with courier to the recipient's address which was only 250 km away in the same country, there was no reason to doubt that D8 was received prior to 3 May 1996.

Mr Fjoran confirmed that he immediately recognised that appendices 6.2 and 6.4 were marketing material, and that it was MH's intention to disseminate this material to potential customers so as to improve its sales.

MH also had a strong interest in presenting the Technical Bulletin 1/96 and the General Catalogue describing its RamRig products to potentially interested clients prior to the OTC 1996, in order to create interest and a focus during the OTC itself. There was no marketing reason for MH to withhold the information on the Twin RamRig design from the market prior to 3 May 1996. Thus there was no tacit obligation to secrecy originating from the circumstances.

This is confirmed by the placing of the Technical Bulletin 1/96 (S9) in the reception area of the MH facilities before the priority date, as well as by the sending of S9 to customers before that date, as evidenced by disclosures GVA-C (S16), ME5500 (S18), Smedvig (D3), D7a-IV, GVA Twindriller (D19-IV) and



Sonat (S10), and by the conclusions drawn by the Oslo district and appeal courts (S15T, S26).

Hence, the Opposition Division's finding with respect to the public prior availability of sections 6.2 and 6.4 of D8 should be upheld and its finding with respect to the alleged prior disclosure of S9 be reviewed.

i) Apportionment of costs

Respondent 1 requested apportionment of costs in its favour should the Board decide to remit the case to the Opposition Division for further consideration on the basis of an appellant's request that could already have been submitted in the opposition proceedings.

The appellant argued that such apportionment was not to be considered as equitable.

## **Reasons for the Decision**

### 1. Admissibility of appeal

1.1 In the notice of appeal, the appellant specified the decision under appeal by indicating the number of the patent and the date of the decision, and requested that the decision of the Opposition Division be reversed. Against the background that the Opposition Division had revoked the patent, it is clear that the Opposition Division's decision as a whole should be the subject of the appeal. Hence, the requirements of Rule 99(1) (b) and (c) EPC are fulfilled.

1.2 In the statement setting out the grounds of appeal, the appellant provided detailed reasons why its main and auxiliary requests would remedy all the deficiencies

identified by the Opposition Division in its decision. Since these requests are sufficiently substantiated to satisfy the requirements of Article 108, sentence 3, and Rule 99(2) EPC and Article 12(2) RPBA, the appeal is considered to be admissible.

2. Absent parties

2.1 As announced in their letters of 9 July 2015 and 9 June 2015, respectively, the duly summoned respondents 3 and 4 were not present at the oral proceedings.

2.2 The Board decided to continue the proceedings in their absence for reasons of procedural economy in accordance with Rule 115(2) EPC and Article 15(3) RPBA.

3. Consideration of the appellant's claim requests

3.1 The appellant filed for the first time with the statement of appeal grounds main and auxiliary requests 1 to 11 for claim 1, as well as main and auxiliary requests 1 to 8 for claim 7.

3.2 In accordance with Article 114(2) EPC and Article 12(4) RPBA, it lies within the discretion of the Board to disregard requests which could have been presented or were not admitted in the proceedings before the opposition division.

3.3 In the statement of appeal grounds, the appellant explained, in respect of each request, the reasons for its submission, what amendments had actually been made, and where a basis for these amendments could be found in D0 and P0. In each request, the amendments to claims

1 and 7 have been made with the aim of overcoming the Opposition Division's objections under Articles 76(1) and 123(2) EPC against claims 1 and 7 as granted.

- 3.4 The Board considers that the filing of these requests was a legitimate reaction of the appellant to the decision under appeal, and that the appellant exercised appropriate care by filing these requests as early as possible in the appeal proceedings.
- 3.5 The mere fact that there is a large number of possible permutations arising from combining the different requests does not amount to an abuse of procedure. In fact, a large number of requests could be expected given that the Opposition Division raised six objections of added subject-matter against granted claim 1 and six objections against granted claim 7.
- 3.6 The Board cannot find any evidence in the file to suggest that the appellant deliberately chose not to submit these requests in the opposition proceedings, despite being given the opportunity to do so.

In the opposition proceedings, the appellant filed auxiliary requests 1 to 10 in response to the summons to oral proceedings. The first day of the oral proceedings before the Opposition Division was taken up by a discussion of the objections under Article 100(c) EPC against claim 1 as granted (point 6.11 of the minutes). On the morning of the second day, the chairman announced that Article 100(c) EPC prejudiced the maintenance of the patent as granted (point 6.12). In reaction, the appellant renamed auxiliary requests 8 and 7 as auxiliary requests 1 and 2 and withdrew all other auxiliary requests (point 8). After discussion, the chairman announced that claim 1 auxiliary request 1

was not allowable (point 8.15). In reaction, the appellant corrected auxiliary request 2 (point 9). After further discussion, the chairman announced the decision of the Opposition Division that auxiliary request 2 was not admitted.

Thus, in the appeal proceedings, the appellant filed with letter of 9 June 2015 auxiliary requests 1a and 4a for claim 1 and auxiliary requests 1a, 1b and 1c for claim 7. There is no doubt that the filing of these requests constitutes an amendment to the appellant's case within the meaning of Article 13(1) and (3) RPBA. However, the amended requests do not add any further complexity to the present case as the amendments relate to matters already discussed and do not raise substantial new matters. Moreover, the respondents made no objection to the admission of these claim requests.

3.7 In conclusion, the Board decided to take all appellant's requests into consideration, pursuant to Article 114(2) EPC and Articles 12(4) and 13(1) and (3) RPBA.

4. Article 100(c) EPC - General comments

4.1 It is apparent that P0 was drafted to meet the "Best Mode" requirement under US Patent Law: it comprises a description of the objects of the invention (pages 7 and 8), a brief summary of a preferred embodiment of the invention (pages 9 and 10), a detailed description of the best mode of practicing the invention (pages 10 to 35 and drawings) and several independent claims for different products and methods (see claim 1 for a drillship; claims 11, 21 and 27 for drilling assemblies; claims 32 and 37 for drilling methods). This holds true also for D0, since it differs from P0

only with respect to the claims. Although an applicant filing an application drafted in this manner before the EPO might run into difficulties when searching for adequate support for claim amendments, the decision as to what P0 (or D0) discloses to a skilled reader does not depend on whether or not it aimed to comply with a disclosure requirement imposed by US Patent Law.

4.2 According to the established case law of the boards of appeal, in order for the ground for opposition under Article 100(c) EPC not to prejudice the maintenance of the patent, it is necessary that any subject-matter disclosed in the patent must be directly and unambiguously derivable from not only D0, but also from the disclosure of P0 (see Case Law of the Boards of Appeal, 7th edition, September 2013, in the following "CL 2013", II.F.1.3.1).

5. Claim 1 - Main request - Article 100(c) EPC

5.1 Claim 1 is directed to a drilling vessel supporting a derrick and including a first and second means for advancing tubular members through the moon pool (in the following: "A1" and "A2") and a first and second means for handling tubular members (in the following: "H1" and "H2"), whereby

- H1 and H2 are adapted for handling tubular members as said tubular members are advanced through the moon pool by A1 and A2, respectively (features (c2) and (c3) of claim 1);
- H1 and H2 form part of a means for transferring tubular assemblies between A1 and A2 to facilitate simultaneous drilling operations and operations auxiliary to said drilling operations (features (d) to (e));

- H1 and H2 are mounted to traverse upon a rail assembly extending between a position adjacent to A1 and a position adjacent to A2 (features (d1) to (d3));
- drilling activity can be conducted from said derrick by A1 or A2 and H1 or H2, and auxiliary drilling activity can be simultaneously conducted from the derrick by the other of A1 and A2 and the other of H1 and H2 (feature (f)).

5.2 Hence, the subject-matter of claim 1 differs from that of claim 5 of P0 in particular in that:

- 1) it equates H1 and H2 with the transferring means;
- 2) it does not expressly require that H1 and H2 be "connected to" the derrick;
- 3) it requires that both H1 and H2 be mounted to traverse upon a "rail assembly";
- 4) it requires that drilling activity can be conducted by A1, or A2, and H1, or H2, and auxiliary drilling activity can be simultaneously conducted from the derrick by the other of A1 and A2 and the other of H1 and H2.

5.3 For the following reasons, the Board agrees with the Opposition Division and the respondents that none of these amendments is directly and unambiguously derivable from the disclosure of P0.

#### 5.3.1 Equating handling means and transferring means

Claim 1 of P0 defines a first and second means for "advancing tubular members through the moon pool" (A1 and A2), and a first and second means for "handling tubular members as said tubular members are advanced through the moon pool" by the first and second means for advancing, respectively (H1 and H2). A skilled

reader of these definitions in the context of the claim understands that the term "advancing" refers to the act of lowering tubular members through the moon pool, whereas the term "handling" simply refers to the act of taking or holding tubular members while they are lowered through the moon pool.

Claim 1 of P0 requires that each of A1, A2, H1 and H2 be "connected to" the derrick. It follows from claim 2 of P0 that A1 and A2 preferably comprise a first and second top drive assembly, respectively. Such top drive assemblies are shown in Figures 5 to 8 of P0. They are operable to rotate, drive and advance tubular members (page 11, lines 11 and 12, page 20, lines 18 to 20 and page 21, lines 5 to 7). The top drive assemblies are preferably identical (page 20, line 20 and page 21, line 14), each comprising a tubular handling assembly (188) and being physically "connected to" the top of the derrick via a traveling block and the drawwork cabling (in Figures 5 to 8 see travelling blocks 152 and 154 connected to drawworks 140 and 142 through cable 144 running over sheaves 146, 148 and 150 at the top of the derrick 40; see "connected to" on page 20, line 21). The reader is told on page 21 of P0 that such top drive assemblies have "the ability to independently handle, make-up or break down, set back, and advance tubulars through multi-stations over of (sic) a moon pool and into the seabed" (lines 9 to 11), and thus enable "primary drilling activity and auxiliary activity to be conducted simultaneously" (lines 16 to 19). This functionality corresponds to that required in claim 1 of P0, see page 37, lines 4 to 8.

From this, the reader would conclude that A1 and H1 as well as A2 and H2 as defined in claim 1 of P0 are preferably parts of two identical top drive assemblies,

since they fulfill all advancing and handling functions required in the claim and are physically "connected to" the top of the derrick.

A means for transferring tubular assemblies is defined for the first time in claim 4 of P0, and this is in addition to the means for advancing and handling tubular members of claim 1 (see "further including" on page 37, line 20). Claim 5, which refers back to claim 4, contradicts this definition of the transferring means, since it teaches that the transferring means includes "said first means for handling tubular members" (page 37, line 13). The reader of claims 4 and 5 of P0 is thus left in doubt as to whether the first handling means for transferring tubular assemblies in claim 5 is the same H1 of claim 1 or is distinct from it. Turning to the embodiment shown in Figure 7 of P0, he recognises a rail-mounted transferring means in the form of pipe handling assemblies 164 and 166, which are adapted for transferring tubular assemblies between the top drive assemblies and thus are distinct from the advancing and handling means provided by the top drive assemblies.

In conclusion, the reader of P0 may construe claim 5 of P0 to mean that A1 and H1 and A2 and H2 are preferably parts of two identical top drive assemblies, while the rail-mounted handling means for transferring tubular assemblies is distinct from, and different from the top drive assemblies.

This understanding of claims 1, 4 and 5 of P0 is supported by the similar language used in claims 21, 22 and 26 of P0, which further define the means for handling and advancing tubular members as being in the form of the drawworks and the top drives, respectively.



The appellant argues that, in the context of claim 1 of P0, the expression "as said tubular members are advanced through the moon pool" should be construed broadly as covering all operations required to advance the tubular members to and into the seabed, and that H1 and H2 implicitly are only a means for transferring tubular members to the advancing means during the on-going process of building and advancing an assembly of tubular members to and into the seabed, rather than limiting the expression just to the handling of individual tubular members as they are lowered through the moon pool. However, as set out above, such a reading is not the only possible understanding of claim 1 of P0: a reader of this claim could also understand that H1 and H2 are means for holding the tubular members while they are being advanced, and the top drive assemblies shown in Figures 5 to 8 fulfill this handling function.

The appellant also submits that, in the context of claim 1 at hand, the handling means are limited to those means that are mounted on the rail for transferring tubular assemblies, as defined in claim 5 of P0 and shown in Figure 7. This, however, is not apparent from the claim language: claim 1 expressly defines the handling means as being a means for handling tubular members as they are advanced through the moon pool as well as for transferring tubular assemblies. There is no indication in P0 that these two handling and transferring functions are carried out by one and the same piece of equipment.

### 5.3.2 Handling means "connected to" the derrick

As reasoned under point 5.3.1 above, a reader of P0 may associate H1 and H2 as defined in claim 1 of P0 with the two identical top drive assemblies which are physically "connected to" the derrick, and thus the reader would recognise that this latter feature can be omitted from the arrangement of claim 1.

The appellant argues that the term "connected to" in claim 1 of P0 could have a wider meaning such as "associated in action and idea", without any physical connection, and that the "connected to" requirement of claim 1 of P0 is implicit from the requirement of present claim 1 that H1 and H2 are mounted to traverse upon the rail assembly operably extending between A1 and A2, and thus are associated "in action and idea" with the derrick. However, this is certainly not the ordinary and customary meaning that a skilled reader of claim 1 of P0 would give to the term "connected to" in the technical context of the claim.

In addition, the appellant submits that, in claim 1 of P0, the wording "connected to" only aims to distinguish H1 and H2 from any other handling means which are provided on the vessel, but which have no physical and functional connection to the derrick, e.g. the servicing cranes 70, 72 and 82 shown in Figures 1 to 4, and that the required physical and functional connection is now implicitly expressed in present claim 1. Again, the Board is not convinced that a reader of ordinary skill would construe the term "connected to" in this broad manner.

### 5.3.3 "rail assembly"

The term "rail assembly" has a broader meaning than the term "rail", since it may for instance encompass several rails. Claim 5 of P0 requires a "rail assembly" but, in the remainder of this claim, reference is made to "said rail", not to "said rail assembly". This inconsistency in the language of claim 5 leaves the reader in doubt as to whether the transferring means comprises a (single) rail or a rail assembly and whether, in claim 5, the first handling means is mounted to traverse upon a (single) rail or a rail assembly. Claim 1 defines two rail-mounted handling means for transferring tubular assemblies and the only clear disclosure of such transferring means in P0 is the embodiment of Figure 7, wherein first and second pipe handling apparatuses 164 and 166 are positioned upon one and the same rail 168, and are adapted to move along the rail to transfer tubular assemblies between the rotary tables and/or the top drive assemblies. This specific disclosure provides support for two handling means for transferring tubular assemblies being mounted to traverse upon one and the same rail, but not for two such handling means positioned upon a "rail assembly". The statement on page 20, lines 7 to 10, that "although a rail supported pipe handling systems are shown in Figure 7, other tubular handling arrangements are contemplated by the subject invention such as a rugged overhead crane structure within the derrick", also does not provide any hint to replace the single rail 168 by a generic rail assembly, since such a crane structure need not necessarily be mounted on a rail assembly.

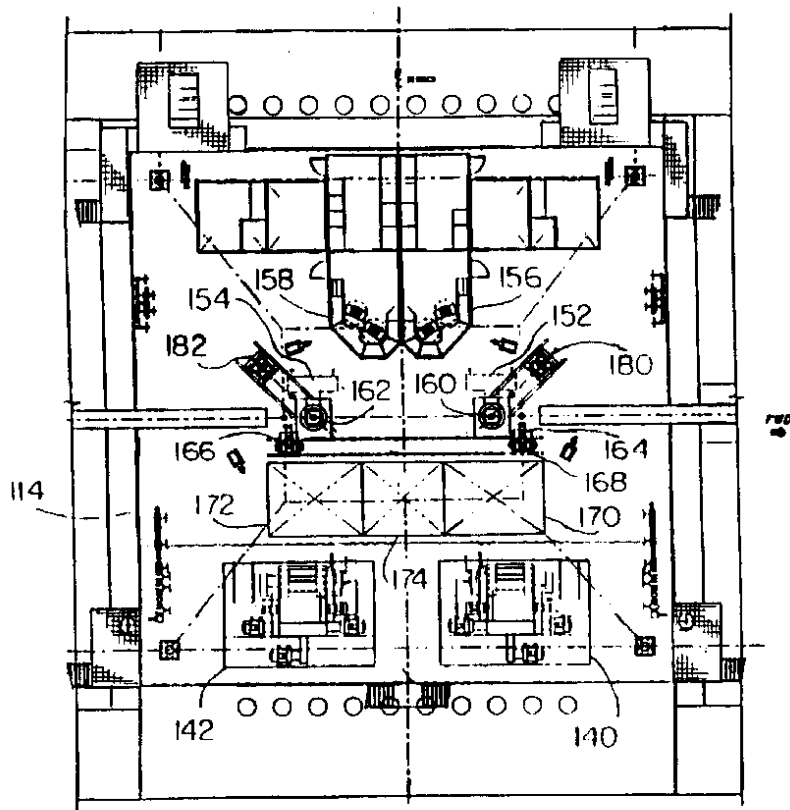
5.3.4 Cross embodiments A1+H2 and A2+H1

The Board shares the view of the Opposition Division and the respondents that the last feature of claim 1 (i.e. feature (f)) clearly requires that drilling activity can be conducted by any of the pairs A1+H1, A1+H2, A2+H1 and A2+H2, while auxiliary drilling activity can be simultaneously conducted by the remaining pair. Contrary to the appellant's view, the use of the pairs A1+H2 and A2+H1 is not excluded, even when reading feature (f) in combination with features (d2) and (d3). These latter features define H1 and H2 as means for handling tubular members as said tubular members are advanced through the moon pool by A1 and A2, respectively, but they do not impose any limitation as to H1 and H2 being usable only with A1 and A2, respectively. Therefore, feature (f) cannot be read as further defining operation by only the two pairs A1+H1 and A2+H2, even though it begins with the word "wherein".

The appellant also submits that the use of the pairs A1+H2 and A2+H1 is excluded when reading feature (f) in light of paragraphs 44 and 45 of the patent specification. However, the claim itself imparts a clear and credible technical meaning to feature (f), thus there is no reason for a reader to consult the description and drawings of the patent to give this feature a narrower meaning.

Feature (f) of claim 1 cannot be derived directly and unambiguously from P0. In particular there is no clear teaching in P0 that drilling activity can be conducted by the pair A1+H2 while auxiliary drilling activity is simultaneously conducted by the pair A2+H1, and vice versa. Even though claim 5 of P0 may suggest that H1 is

adapted to service both A1 and A2, this does not disclose that H1 and H2 are adapted to simultaneously service any of A1 and A2. This is also not disclosed in the description on page 20, lines 13 to 17: this passage describes the functionality of tubular handling systems (plural), and not that of each rail-mounted tubular handling assembly.



**Fig. 7**

In Figure 7 (see above), pipe handling assemblies 164 and 166 correspond to H1 and H2, and it is apparent that 164 and 166 cannot simultaneously service both the rotary table 162 and/or the top drive 182 and the rotary 160 and/or the top drive 180, respectively, because assemblies 164 and 166 are mounted upon one and the same rail 168.

- 5.4 For all these reasons, Article 100(c) EPC prejudices the maintenance of the patent on the basis of claim 1 main request.
6. Claim 1 - Auxiliary requests 1a, 1 to 3, 4a, 4 to 11 - Article 100(c) EPC
- 6.1 The objections under points 5.3.1 and 5.3.2 above apply to claim 1 auxiliary requests 1 to 11, since they also equate the rail-mounted transferring means with the handling means and lack the feature that the handling means are "connected to" the derrick.
- 6.2 In claim 1 auxiliary requests 1a and 4a, the wording "as said tubular members are advanced" has been replaced by the wording of claim 1 as granted "which are for advancement". Thus, claim 1 of these requests defines the rail-mounted handling means as means for handling tubular members that are intended for advancement, but are not necessarily being advanced yet. As decided by the Opposition Division, this amendment is not clearly and unambiguously derivable from P0. In fact, as explained under point 5.3.1 above, claim 1 of P0 appears to require that H1 and H2 are adapted to handle/hold the tubular members while they are advanced and this provides a plausible teaching to the reader which is in conformity with the description in P0 of the top drives in the illustrated embodiment. Thus, it is not completely clear to the reader that this feature can be omitted from claim 1.
- 6.3 The objection under point 5.3.3 above applies to claim 1 auxiliary requests 1a, 1, 4a, 4, 5 and 7, since they all require the handling means to be mounted upon a "rail assembly".

- 6.4 In conclusion, Article 100(c) EPC also prejudices the maintenance of the patent on the basis of claim 1 auxiliary requests 1a, 1 to 3, 4a, 4 to 11.
7. Claim 7 - Main request and auxiliary requests 1a, 1b and 1c - Article 100(c) EPC
- 7.1 Claim 7 is directed to a multi-activity drilling assembly for conducting drilling operations to and into the seabed and including, among others, a drilling superstructure, a first and second advancing means (in the following "A1" and "A2") and a means for transferring tubular assemblies between A1 and A2, which transferring means comprises a rail assembly and first and second first pipe handling assemblies mounted to traverse upon said rail assembly ("H1" and "H2"), whereby H1 and H2 may be moved between A1 and A2 (features (f) to (g)).
- 7.2 As explained for claim 1 main request (see point 5.3.3 above), the feature that H1 and H2 are mounted to traverse upon a "rail assembly" introduces subject-matter that extends beyond the content of P0. Thus, claim 7 main request introduces subject-matter which extends beyond the disclosure of P0.
- 7.3 This objection applies also to claim 7 auxiliary requests 1a, 1b and 1c since they all comprise this feature.
- 7.4 Therefore, Article 100(c) EPC prejudices the maintenance of the patent on the basis of claim 7 main request and claim 7 auxiliary requests 1a to 1c.

8. Claim 7 - Auxiliary request 1 - Article 100(c) EPC

8.1 The respondents contend that claim 7 introduces subject-matter which extends beyond the teachings of P0 and D0 because:

- 1) it requires that the drilling superstructure be "operable to be mounted upon a drilling deck" (feature (c1) of claim 7), but it does not require that the drilling assembly must be suitable to be "mounted adjacent to an opening of a drillship, semi-submersible, tension leg platform, jack-up platform, offshore tower, or the like";
- 2) it requires that the drilling superstructure simultaneously supports drilling operations and (any) "operations auxiliary to drilling operations" (feature (c1));
- 3) it requires that both A1 and A2 are adapted for advancing tubular means "to the seabed", potentially at the same time (features (c2) and (c3));
- 4) it requires that both drilling activity and auxiliary drilling activity can be simultaneously conducted by any of A1 and A2 (features (d) and (e)), although only A1 is adapted for advancing tubular means into the seabed;
- 5) it defines a "rail", but lacks the features that it is connected to, and supported by, the superstructure and that it physically extends between A1 and A2;
- 6) it specifies that the transferring means comprises a first and a second "pipe handling assembly" mounted to traverse upon a rail (features (f2) and (f3)), but it lacks the further features that:
  - the pipe handling assemblies are pipe handling apparatuses;



- first and second conduit setback envelopes are located adjacent to H1 and H2, respectively, whereby H1 and H2 are adapted for transferring tubular assemblies between their setback envelopes to A1 and A2, respectively;
- first and second iron roughnecks are positioned adjacent to A1 and A2 and operably utilised in cooperation with A1 and A2 to make-up and break down tubular assemblies.

8.2 The Board shares the view of the appellant that these objections are not persuasive.

8.2.1 "mounted adjacent to an opening of a drillship, semi-submersible, tension leg platform, or the like"

On the one hand, this amendment is supported by the language of claim 8 of D0. On the other hand, it follows from page 9, line 14 of P0 that the multi-activity drilling assembly carries out drilling operations through an unspecified drilling deck ("a drilling deck"). Even though claim 27 of P0 requires that the drilling assembly must be adapted to be mounted "adjacent to an opening of a drillship, semi-submersible, tension leg platform, or the like", this feature does not imply any limitation on the structure or function of the claimed drilling assembly. Thus, the fact that this feature has been omitted in claim 7 at hand does not add any matter to the disclosure of P0. In any event, the disputed feature is implicitly present in claim 7, because it specifies that the drilling superstructure of the drilling assembly must be operable to be mounted "upon a drilling deck" of the cited vessels, and that A1 and A2

are for advancing tubular members "through the deck", so that the drilling deck must include a large opening in the form of a moon pool or the like.

Finally, contrary to the respondents' view, it follows from the wording of features (a), (c), (c1), (c2), (c3) and (f) of claim 7 that the entire drilling assembly, i.e. including the drilling superstructure, the handling means and the transferring means, must be suitable for mounting on a drillship, semi-submersible, tension leg platform, or the like.

#### 8.2.2 "operations auxiliary to drilling operations"

As already ruled in the earlier decision T 342/07 (Reasons 4.1.1), it follows from the description and drawings of P0 (and thus of that of D0) that the terms "drilling activity", "drilling operations", "auxiliary drilling activity" and "activity auxiliary to drilling activity" are all synonymous terms referring to any activity/operation for advancing tubular members to the seabed or into the seabed during the exploration/development drilling of deep water wells.

This applies also to the expression "operations auxiliary to drilling operations", as used in feature (c1) of claim 7. It follows from page 9, lines 12 to 18 of P0/D0, and in view of the paragraph bridging pages 21 and 22, that the drilling superstructure of the multi-activity drilling assembly is "for simultaneously supporting exploration and/or production drilling operations and tubular or other activity auxiliary to drilling operations through a drilling deck", in particular "operations auxiliary to the primary drilling function". Page 11, lines 17 and 18 refers to "primary tubular operations" and

simultaneous "operations auxiliary to primary tubular operations". It is apparent from page 18, lines 6 and 17 that the two advancing stations conduct "drilling operations and/or operations auxiliary to drilling operations".

#### 8.2.3 "to the seabed"

Contrary to the respondents' view, features (d) and (e) of claim 7 do not require that a tubular member can be advanced by A2 to arrive at the seabed simultaneously with a tubular member advanced by A1. These features only require that the part of the drilling activity that involves advancing tubular members by either A1 or A2, takes place at the same time as the auxiliary drilling activity consisting in advancing tubular members by the other of A1 and A2 (see also T 342/07, Reasons 4.1.1). This requirement is supported by the disclosure of P0 and D0 (see point 8.2.4 below). Clearly, those parts of the primary and auxiliary drilling activities which concern advancing into the seabed cannot occur simultaneously for the same well bore.

#### 8.2.4 "simultaneously" conducting drilling and auxiliary drilling activities by A1 and A2

Features (c2) and (c3) of claim 7 make a distinction between A1 and A2: A1 is adapted to advance tubular members to and into the seabed, whereas A2 can advance tubular members (only) to the seabed. This seems to contradict the requirement of features (d) and (e) that A1 and A2 can be adapted for conducting both drilling activity and auxiliary drilling activity. To resolve this contradiction, the reader of claim 7 would consult the description and drawings of the patent. Here, it is

consistently taught that A1 and A2 are identical, to the extent that they have the same functionality for advancing tubular members to and into the seabed and for conducting both drilling activity and auxiliary drilling activity (the rotary tables and/or top drives are "substantially identical" or "identical", see column 8, line 17 and column 9, line 43 and paragraph 76). Thus, it would be read into features (c2), (c3), (d) and (e) that A1 and A2 are both adapted for advancing tubular means to and into the seabed.

The simultaneous drilling and carrying out of auxiliary activities by either A1 or A2 is supported by the wording of claim 27 of P0 and claim 8 of D0 in view of the teaching on page 18, line 9, page 21, line 14 and page 33, lines 17 to 21. In particular, the ability of A1 and A2 to simultaneously advance tubular members to and into the seabed is described on page 1, lines 13 and 14 ("a single derrick is operable to perform multiple drilling, development, and work over operations simultaneously"), page 32, lines 13 to 15 ("the subject invention can advantageously conduct multiple well developmental drilling activity, or work over activity, simultaneously on multiple wells") and is illustrated in the time chart of Figure 23b and in Figures 11, 13 and 20.

#### 8.2.5 "rail"

The definition of the "rail" in claim 7 is supported by claim 5 of P0 and claim 4 of D0 in light of the description of Figure 7 on page 19, lines 5 to 7. It is apparent that there is no need to require that the rail is connected to and supported by the drilling structure.

#### 8.2.6 "pipe handling assembly"

The details of the two rail-mounted pipe handling assemblies for transferring tubular assemblies between A1 and A2 are supported by the disclosure from page 19, line 4 to page 20, line 16 and Figure 7 (see above) of P0 and D0. On pages 19 and 20, the expressions "tubular handling assembly" and "tubular handling apparatus" are used to refer to one and the same equipment (see e.g. page 19, lines 4 and 20 and page 20, line 2). It follows from page 19 and Figure 7 that the tubular handling assemblies 162 and 164 are used together with three setback envelopes 170, 172 and 174 and two iron roughnecks 180 and 181 (181 is not shown in Figure 7). However, a skilled reader of this passage would recognise that these further features are entirely optional for transferring tubular assemblies between A1 and A2 for facilitating simultaneous drilling operations and operations auxiliary to said drilling operations. It is clear that the setback envelopes are entirely optional for achieving this effect, and this is confirmed by the fact that they are not required in claims 27 and 28 of P0 and claim 8 of D0, and only referred to in dependent claims 29 and 9 respectively. It is commonly known that iron roughnecks are mechanised equipment for making and breaking tubular connections (see page 19, lines 16 to 18). Consequently, this amendment does not amount to an unallowable intermediate generalisation, contrary to the respondents' submission.

9. Claim 11 - Auxiliary request 1 - Article 100(c) EPC
  - 9.1 The Board is not persuaded by the respondents' submission that claim 11 auxiliary request 1 introduces subject-matter which extends beyond the teachings of P0 and D0.
  - 9.2 Dependent claim 8 defines a first and second tubular setback "station". Claim 11 refers directly back to claim 8 and defines a tubular setback "envelope". The skilled reader would readily recognise that the terms "tubular setback station" and "tubular setback envelope" are alternative terms for a set back area for tubulars within the drilling superstructure. The additional features of claim 11 are supported by the teaching in P0 and D0, see the three setback envelopes 170, 172 and 174 in Figure 7 and page 19, lines 17 to 13 and page 19, line 20 to page 21, line 16.
10. In conclusion, Article 100(c) EPC does not prejudice the maintenance of the patent on the basis of claim 7 auxiliary request 1 and its dependent claims.
11. Claim 7 - Auxiliary request 1 - Articles 76(1), 123(2) and (3) and 84 EPC
  - 11.1 Claim 7 auxiliary request 1 differs from claim 7 as granted in that it comprises the further limitations that:
    - the drilling superstructure is operable to be mounted upon a drilling deck "of a drillship, semi-submersible, tension leg platform, or the like", and for simultaneously supporting drilling operations for a well and operations auxiliary to drilling operations for the well "through the drilling deck";

- the first and second advancing means are adapted for advancing tubular members "through the drilling deck"; and
- the rail assembly has "a rail" and the first and second means for transferring and handling tubular members are mounted to traverse upon "said rail".

In addition, the wording of granted claim 7 "of casings and of drill strings" has been deleted.

11.2 These amendments meet the requirements of Articles 76(1) and 123(2) EPC for the following reasons:

11.2.1 "drillship, semi-submersible, tension leg platform, or the like"

The added definition of alternative forms of vessels upon whose drilling deck the drilling assembly is operable to be mounted finds adequate basis in P0 and D0, see page 6, lines 4 to 9, page 8, lines 7 to 11 and page 9, lines 5 to 10.

11.2.2 "through the drilling deck";

The addition of the wording "through the deck" is supported by the teaching in P0 and D0, see page 9, lines 5 to 16, page 22, lines 2 to 8 with Figures 5, 6 and 9 to 22.

11.2.3 "rail"

The added limitation that the rail assembly has "a rail" and the first and second means for handling tubular members and transferring tubular assemblies are mounted to traverse upon "said rail" is supported by

the teaching in P0 and D0, see claim 5 of P0 and claim 4 of D0 in view of page 19, lines 4 to 7 with Figure 7.

#### 11.2.4 "of casings and of drill strings"

The deletion of the wording "of casings and of drill strings" is supported by the wording of claim 28 of P0 and claim 8 of D0. In addition, it follows from page 12, lines 19 to 21 of P0 and D0 that the term "tubular" refers to the typical conduits used in the drilling industry, such as riser conduits, casing and drill strings of various diameters, and that it is not limited to specific conduits within this group.

11.3 The amendments do not contravene Article 123(3) EPC.

11.3.1 Claim 7 as granted defines the transferring means as means adapted for transferring (any) tubular assemblies (feature (c4) above), without specific reference to the tubular assemblies being assemblies "of casings and of drill strings". This wording is used only when referring back to the transferring means (see feature (f)). The deletion of this wording ensures consistency within the claim while accurately expressing the intended limitation, without however extending the scope of the protection.

11.3.2 As set out under point 5.3.3 above, the expression "rail assembly" is considered to be a broader term than "rail". The limitation of the "rail assembly" to a "rail" thus results in a limitation of the claim scope.

11.4 The amendments do not introduce a lack of clarity.

11.4.1 According to feature (c1) of claim 7, the drilling superstructure must be "operable to be mounted upon a



drilling deck of a drillship, semi-submersible, tension leg platform, or the like".

11.4.2 In the context of the claim, it is apparent that this feature simply defines the ability of the drilling superstructure to be mounted on any one of the mentioned structures, which has a drilling deck and is capable of supporting the drilling superstructure above water while conducting drilling operations to and into the seabed, in particular for simultaneously conducting primary and auxiliary drilling operations, through the drilling deck. Hence, this feature does not render the definition of the claimed subject-matter unclear.

11.5 The Board concludes that claim 7 auxiliary request 1 meets the requirements of Articles 76(1), 123(2) and (3) and 84 EPC.

12. Under these circumstances, there is no need to consider claim 7 auxiliary requests 2 to 8.

13. Description - Article 100(c) EPC

13.1 It follows from column 9, lines 10 to 13 of the patent specification that "although a particular rail supported pipe handling system is shown in Figure 7, other tubular handling arrangements are contemplated within the scope of the appended claims".

13.2 The Board shares the appellant's view that this teaching is supported by the original teaching in P0 and D0, see page 20, lines 7 to 10.

14. Remittal

14.1 The decision under appeal deals only with objections under Articles 100(c), 76(1) and 123(2) EPC, and with the public prior availability of D8 and S9. It does not address any of the opponents' objections under Article 100(b) and Article 100(a) EPC.

14.2 With the exception of respondent 3, the parties did not address any of these objections in the appeal proceedings. In reply to the grounds of appeal, respondents 1, 2 and 4 made a general reference to submissions made in the opposition proceedings but such a general reference does not meet the requirements of Article 12(2) RPBA, which states that the reply must contain a party's complete case and, among others, "specify expressly all the facts, arguments and evidence relied on".

14.3 In the communication pursuant to Article 15(1) RPBA the Board indicated its intention to remit the case back to the Opposition Division for further prosecution, i.e. for consideration of the objections under Article 100(b) and Article 100(a) EPC, should it decide that the requirements of Articles 100(c), 76(1), 123 and 84 EPC are met.

14.4 In response, respondent 1 withdrew its request for the case not to be remitted. The other parties did not comment on the intended remittal.

14.5 The Board sees no reason to revise its opinion. It thus exercises its discretionary power under Article 111(1) EPC to remit the case to the Opposition Division for further prosecution on the basis of claim 7 of auxiliary request 1 and its dependent claims.

- 14.6 The appellant announced that the renumbering of these claims, the adaptation of the claim dependencies as well as the necessary adaptation of the description to the amended claims would be done at a later stage of the proceedings.
- 14.7 However, before remitting the case, for the sake of procedural efficiency, the Board decided to review the Opposition Division's conclusions on the alleged public prior disclosures, because these are *prima facie* highly relevant for the questions of novelty and inventive step, and because the Opposition Division's conclusions regarding D8 and S9 are disputed by the parties.
15. Alleged public prior disclosures
- 15.1 Several public prior disclosures were alleged by the respondents in the opposition proceedings and discussed in the annex to the summons to oral proceedings issued by the Opposition Division, namely:
- (a) the sending of S9 to customers as part of a general marketing action by MH and the placing of S9 in the reception areas of the MH facilities;
  - (b) the budget proposal D8 sent by MH to ME, including MH's Technical Bulletin 1/96 (appendix 6.2) and MH's General Catalogue 1996-97 (appendix 6.4);
  - (c) further public prior uses GVA-C (S16), ME5500 (S18), Smedvig (D3), D7a-IV, GVA Twindriller (D19-IV) and Sonat (S10) (the numbering of these documents is taken from the table annexed to the decision under appeal).
- 15.2 The public prior uses in point (c) were not discussed further, either in writing or in the oral proceedings before the Opposition Division, and are not addressed

in the decision under appeal. In its communication under Article 15(1) RPBA, the Board announced its intention not to consider them further, but instead to focus on S9 and D8, which were dealt with in the decision under appeal, and which were discussed in detail by the parties in the appeal proceedings.

15.3 There is agreement between the parties that a brochure with the title "Technical Bulletin 1/96 - The Ram Rig Concept" was made available to the public at the OTC in Houston between 6 and 9 May 1996, i.e. some days after the priority date.

15.4 S9

15.4.1 The respondents argued that S9, which is also entitled "Technical Bulletin 1/96 - The Ram Rig Concept", was made available to the public even before the priority date of 3 May 1996 by sending it to customers and displaying it in the reception area of MH. S9 consists of the cover sheet, text pages with a footer referring to a file location and the date of 10 April 1996, and several undated technical drawings.

15.4.2 The Board, having reviewed the evidence on file, comes to the same conclusions as the Opposition Division, namely that the public availability of S9 prior to the priority date is not sufficiently proven. The respondents referred to the fact that the Norwegian Courts accepted the "Technical Bulletin 1/96" as state of the art. However, this is not binding on the Board, as the Board has to take a decision on the basis of the evidence submitted to it. This evidence might differ from that presented in national proceedings, or be evaluated in a different way as a result of additional facts or evidence being made available.

- 15.4.3 The Board would highlight in this respect that the witnesses heard by the Opposition Division underlined the presence of a weight table in the final version of the "Technical Bulletin 1/96" (see minutes of taking of evidence, hereafter "MTE", e.g. pages 2, 5, 7, 21). Such a weight table is, however, not present in S9. There is no indication, unequivocal or conditional, in the witness statements that some other version without the weight table was put on the shelves in the reception area or was sent out to customers.
- 15.4.4 Indeed, section 6.2 of D8 dated 22 April 1996, which is to a large extent identical to S9, includes further pages, in particular a weight table. Due to the absence of the weight table, the Board is not satisfied that S9 on file represents the version of the brochure which allegedly was made available to the public. Thus, it cannot be concluded with certainty that S9 per se was publically available at any time before the priority date of the patent.
- 15.4.5 If it were considered that the final version of the "Technical Bulletin 1/96", which was used as marketing material to be sent to customers and displayed in the reception area, comprised the weight table as shown in section 6.2 of D8, this would mean that the final version of the content was available as from 22 April 1996 only, since it can be taken from the testimony of Ms Furuholt that the indication in the footer relates to the date of the document (MTE, page 27 et seq.). According to the testimony of Ms Timenes, the cover page was to be added and the documents still had to be printed, albeit in-house. Thus, some further time was still needed for the brochure to be finalised.

15.4.6 It might have been the routine at MH to send out marketing material and display it in MH's own facilities as soon as possible. However, it appears likely that during the days prior to the OTC in Houston, which started on 6 May 1996, the MH marketing and sales department was busy with preparing the material for the congress. Bearing in mind that there were only a couple of days between finalising the version dated 22 April 1996 and the priority date of 3 May 1996, the Board has strong doubts that "Technical Bulletin 1/96", as comprised in D8, was made available to a member of the public before 3 May 1996 by display at the reception area or by dispatch to unspecified customers (regarding the sending of the document to Mr Fjoran, see below).

15.5 D8

15.5.1 The second alleged public prior disclosure in respect of which the opposition division took a decision is the budget proposal D8 which was allegedly sent by MH to Mr Fjoran of ME around 26 April 1996.

15.5.2 The issues disputed between the parties related to the question as to whether Mr Fjoran had received D8 by 2 May 1996, i.e. a date before the priority date of the patent, and whether the recipient could be considered as a member of the public, i.e. a person not bound by an obligation to secrecy.

It was also disputed which standard of proof should be applied to the present case, "up to the hilt" or "balance of probabilities".

15.6 The wording "up to the hilt" is used, like the equivalent "beyond reasonable doubt", to indicate the

strict standard of proof, namely that the allegations need to be proven in such a manner that the deciding body, on the basis of a free evaluation of the evidence on file, can be sure that the alleged facts have actually occurred. In contrast thereto, the less strict standard "balance of probabilities" allows the deciding body to arrive at the conviction that an alleged fact has occurred if it is more likely to have occurred than not to have occurred (see also CL 2013, I.C.2.2 to 2.4).

- 15.6.1 The Board agrees with the appellant that the standard "up to the hilt" or "beyond reasonable doubt" is appropriate in the present case.

One of the joint respondents 2 is the successor of MH, the company directly involved in the alleged public prior disclosure because it created and dispatched the budget proposal D8 which is the subject-matter of the alleged prior disclosure and which was specifically prepared for its business partner ME. The alleged public prior disclosure thus originates from the sphere of respondent 2 and practically all the evidence in support of this allegation lies within the power and knowledge of one of the respondents, with the appellant having no ready access to it.

For such prior use situations, it is established case law that the allegations must be proven beyond any reasonable doubt (see e.g. T 472/92, OJ EPO 1998, 161, Reasons 3.1; CL 2013, III.G.4.3.2).

- 15.6.2 The Board accepts that the recipient Mr Fjoran or ME, i.e. the company for which he was working at that time, respectively, can be regarded as an independent third party. However, this does not change the fact that

respondent 2, as successor of MH, had full knowledge of the actions alleged to constitute the public prior disclosure and full access to the sources of evidence whereas the appellant was not involved and its position is therefore basically restricted to pointing to any inconsistencies or gaps in the chain of evidence.

In this respect, the present case differs from the situations underlying decisions T 12/00, T 254/98 and T 729/91 (all not published in the OJ) referred to by respondent 1, in which the opponent alleging the public prior use was not involved in the circumstances relating to it.

15.7 With respect to the allegations in dispute, i.e. that D8 was received prior to the priority date of the patent and that Mr Fjoran is to be considered as a member of the public not bound by an obligation to secrecy, the Board comes to the following conclusions:

15.7.1 It has not been established beyond any reasonable doubt that D8 was actually received by Mr Fjoran before 3 May 1996.

Respondent 2 has not provided sufficient evidence that D8 was actually sent to, and received by, ME or Mr Fjoran before that date. In the witness hearing on 14 May 2012 before the opposition division, Mr Fjoran testified that he needed to have the budget proposal of D8 before 5 May 1996, as he was then travelling to the OTC (MTE, page 40). He could not recall exactly when he actually received D8, but he concluded that it must have been on 26 or 27 April 1996 (MTE, passage bridging pages 36 and 37) given the dates 25 and 26 April 1996 printed in D8 (page 40) and the fact that MH normally sent packages to ME by courier, DHL or personal



delivery (pages 39 and 41). Mr Fjoran admitted that this is not what he remembered exactly, but rather what he surmised was most likely to have happened having been involved in the case since 2003, i.e. in the present case and the litigation of the related patents in Norway (pages 40 and 46).

The Board has no doubts that Mr Fjoran received D8 before he travelled to the OTC on 5 May 1996. Receiving it before his departure was of utmost importance to him and, in light of his witness testimony, this important deadline was undoubtedly met.

The witnesses Timenes and Furuholt testified as to the routine according to which the dispatch of a quotation was usually made, namely that it would have been sent on the day indicated on the quotation (here 26 April 1996), and the means of transport which would have been used (courier or overnight delivery). However, there is no evidence on file from which it could be concluded with the necessary degree of certainty either when this specific quotation left the ME company or when it arrived at MH or when Mr Fjoran actually received it. Considering the small number of days between the possible dispatch and the priority date, with a week end (27 and 28 April 1996) and a national Norwegian holiday (1 May 1996) in between, the Board holds that it is not proven beyond any reasonable doubt that D8 was received by Mr Fjoran by 2 May 1996 at the latest.

15.7.2 Also in dispute is whether the transmission of D8 was associated with an agreement on secrecy and whether or not ME or Mr Fjoran are therefore to be considered as members of the public.

A document was made available to the public, if it was possible for a member of the public to gain knowledge of the content of the document, and there was no bar on confidentiality restricting the use or dissemination of such knowledge. There may exist an express or a tacit agreement on secrecy. A tacit agreement on secrecy may be derived from the circumstances of the particular case, for example from a relationship of good faith or trust, and factors which may occur in contractual or commercial relationships (see e.g. T 830/90, OJ EPO 1994, 713, Reasons 3.2.2; T 799/91, Reasons 4).

D8 is a quotation sent by a vendor (MH) to a potential customer (ME with Mr Fjoran as the responsible person). Mr Fjoran explained that ME's business model was to design new vessels for the off-shore industry, and ship-owners were their clients. For the development of such vessels, ME contacted equipment suppliers describing its needs and requested proposals from them. At the time D8 was prepared, Mr Fjoran was involved in the conceptual stage of his project. He had had meetings with MH over a period of some weeks and was by then waiting for the necessary data, which eventually were provided in the form of the quotation D8 and which he could use for his meetings with the ship-owners (MTE, pages 36 et seqq., 43).

It is accepted that there was no written confidentiality agreement between MH and ME. However, for the following reasons, the Board is of the view that the circumstances implied an obligation of confidence between the parties which leads to the conclusion that ME or Mr Fjoran are not to be considered as a member of the public.

Offers made on the basis of specific needs communicated by a potential customer and the relevant information which is exchanged between business partners in preparation of such offers or contracts are usually considered as being confidential. In such situations, it is not apparent that any side would be interested in communicating the content of the offer or the exchanged information to the outside world (see also e.g. T 887/90, Reasons 3; T 1686/06, Reasons 3.3).

It appears to be undisputed that sections 1 to 5 of D8 (i.e. introduction 1.0, technical description 2.0, weight schedule 3.0, fabrication schedule 4.0 and compensation 5.0) comprise sensitive commercial information of a confidential nature with respect to the drilling package offered by MH to ME.

In addition, appendix 6.1 of D8 comprises drawings of the drilling package offered by MH, and some of the drawings of the drilling package are stamped "Confidential". Mr Fjoran acknowledged that this sensitive information had been provided by MH to him in confidence; he expressly mentioned an unwritten "gentleman's agreement" of confidentiality (MTE, pages 44 and 47).

The crucial question is how the sections 6.2 ("RamRig general information") and 6.4 ("MH General Catalogue") are to be evaluated. The respondents contend, and Mr Fjoran explained (MTE, page 44), that it was readily apparent from the title and content of appendices 6.2 and 6.4 of D8 that these parts comprise only marketing material which could be made public.

However, the Board is of the view that the content of appendices 6.2 and 6.4 cannot be considered separately

and assessed in isolation from the remainder of D8, which was clearly confidential. Mr Fjoran or Ms Furuholt might have considered sections 6.2 and 6.4 as not being *per se* confidential information (MTE, pages 32, 44 et seq.). This, however, does not prevent the Board from accepting the existence of an implicit obligation to secrecy because this is a conclusion to be drawn on the basis of all circumstances of the particular case, irrespective of the personal impressions of a witness (see also e.g. T 1686/06, Reason 3.2).

Indeed appendices 6.2 and 6.4 constitute, together with the other parts of D8, a unitary package in the form of a ring binder (MTE, pages 10, 26, 37, 46). Appendices 6.2 and 6.4 include general technical information describing the RamRig design, which is at the core of MH's quotation; these parts are thus technically linked to the undoubtedly confidential parts of D8.

The fact that appendices 6.2 and 6.4 were physically attached and are technically related to the confidential parts of D8 suffices for the Board to consider them as being part of the business relation in respect of which an implicit obligation to confidentiality arising from the circumstances exists.

The Board notes moreover that in the present case there are no unequivocal indicators or evidence on file on the basis of which it can be concluded that either D8 as a whole or the sections 6.2. and 6.4 were specifically exempted from the implicit obligation to secrecy. In fact, as explained by Mr Fjoran, ME was not there to market MH's products (MTE, bottom of page 37 and page 45).

Instead, it appears a likely scenario that sections 6.2 and 6.4 were copies of marketing material to be distributed at the OTC, from 6 to 9 May 1996, and included in D8 as exclusive, upfront information for Mr Fjoran and ME.

The decisions cited by respondents 2 and 3 in relation to the topic of confidentiality are not relevant in the present case. In the case underlying decision T 958/91 a company prospectus was considered as state of the art. Copies of the prospectus had been handed out to interested persons and potential clients when they visited a plant (T 958/91, Reasons 2). A similar situation was present in case T 173/83 (OJ 1987, 465), but the prospectus was sent by letter. In the present case, however, the relevant information forms integral part of a specific quotation and was sent in the context of an existing business relationship, which - as explained above - is to be considered as privileged.

15.7.3 In view of the above considerations it is not proven beyond reasonable doubt that D8 was received by Mr Fjoran before the priority date. Moreover, the Board does not consider Mr Fjoran as a member of the public. Hence, the content of D8 does not form part of the state of the art pursuant to Article 54(2) EPC.

15.8 As regards D3, which was also relied on in the appeal proceedings, it cannot be concluded from the filing of this document with the USPTO by the appellant as part of an Invention Disclosure Statement (IDS) that the content of D3 is state of the art under Article 54(2) EPC in the proceedings before the EPO. It should be noted that it would appear from 37 CR § 1.97 (h) and USPTO Manual of Patent Examining Procedure, 2129-IV that also under US law the mere filing of an

Information Disclosure Statement shall be not taken as an admission that the information cited in the statement is prior art against the claims of a US application

16. Apportionment of costs

16.1 Article 104(1) EPC and Article 16(1) RPBA set out the factors to be considered for apportioning costs.

16.2 Respondent 1 requested an apportionment of its costs because the remittal of the case to the Opposition Division for further consideration concerned claim 7 auxiliary request 1 and its dependent claims, i.e. a claim request which could have been submitted by the appellant during the opposition proceedings.

16.3 Even though the remittal does lengthen the proceedings and cause additional costs to all parties, it is not due to inequitable conduct of the appellant (see above point 3), but is rather inevitable in view of the fact that the decision under appeal does not address any of the objections raised under Article 100(b) and Article 100(a) EPC and none of the parties, except respondent 3, filed a case with respect to Article 100(b) and Article 100(a) EPC (see point 14.2 above). In addition, the appellant and respondents 2 to 4 requested that the case be remitted to the Opposition Division for (further) examination of these issues. Also, the Board cannot identify any disadvantage for respondent 1 that is specifically caused by the fact that basis for the remittal of the case for further prosecution is claim 7 of auxiliary request 1 and its dependent claims.

16.4 The Board therefore concludes that, in the present case, it is not equitable to order a different apportionment of the parties' costs.

## 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 for further prosecution on the basis of claim 7 of auxiliary request 1 and its dependent claims.
3. The request for apportionment of costs is refused.

The Registrar:

The Chairman:



C. Spira

G. Ashley

Decision electronically authenticated