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**Datasheet for the decision  
of 26 April 2016**

**Case Number:** T 2229/13 - 3.3.10

**Application Number:** 07794677.0

**Publication Number:** 2021430

**IPC:** C09K8/506, C09K8/508, C09K8/512

**Language of the proceedings:** EN

**Title of invention:**  
WEIGHTED ZERO SOLIDS LOSS CIRCULATION, FLUID LOSS AND  
INSULATING ANNULAR SPACE FLUID SYSTEMS

**Applicant:**  
Cabot Specialty Fluids Inc.

**Headword:**

**Relevant legal provisions:**  
EPC Art. 83

**Keyword:**  
Sufficiency of disclosure - (no) - all requests

**Decisions cited:**  
T 0409/91, T 0435/91

**Catchword:**



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

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Case Number: T 2229/13 - 3.3.10

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.10**  
**of 26 April 2016**

**Appellant:** Cabot Specialty Fluids Inc.  
(Applicant) Waterway Plaza Two,  
10001 Woodloch Forest Drive, Suite 275  
The Woodlands, TX 77380 (US)

**Representative:** Grünecker Patent- und Rechtsanwälte  
PartG mbB  
Leopoldstraße 4  
80802 München (DE)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 10 May 2013  
refusing European patent application  
No. 07794677.0 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** P. Gryczka  
**Members:** R. Pérez Carlón  
T. Bokor

## Summary of Facts and Submissions

- I. The appellant lodged an appeal against the decision of the examining division to refuse European patent application No. 07 794 667.0.
- II. The documents forming part of the examination proceedings included the following:
- D2: US 2005/0107264 A1
- III. The examining division concluded that the subject-matter of the main request and the first to fifth auxiliary requests contravened the requirements of Article 84 EPC. In particular, claim 1 of all the auxiliary requests required a "thermally-activated self-crosslinkable gel forming material" selected from carboxymethyl guar and carboxymethyl tamarind gum. If, as argued by the applicant, not every carboxymethyl guar was thermally-activated self-crosslinkable, essential features must be missing from those claims.
- IV. With the notice of appeal, the appellant filed a new main request and new first to fifth auxiliary requests. Claim 1 of the main request and of the first and second auxiliary requests reads as follows:

*"Use of an aqueous based composition comprising at least one alkali formate and at least one self-crosslinkable gel forming material selected from carboxymethyl guar and a carboxymethyl tamarind gum and combinations thereof, as a loss circulation fluid, wherein the self-crosslinkable gel forming material forms a gel at a temperature of 37.8°C (100°F) or more in the flow passages of a well bore."*

- V. Claim 1 of the third to fifth auxiliary requests contains, in addition to the feature of claim 1 of the main request, the following:

*"wherein said composition further comprises at least one encapsulated acid, or wherein said composition further comprises at least one encapsulated base."*

- VI. The appellant argued that claim 1 of all requests on file required a self-crosslinkable gel-forming material which only formed a gel within the flow passages of the well bore at a temperature of 100°F or more.

- VII. In the communication annexed to the summons for oral proceedings, the board informed the appellant that it understood that argument as disputing that every carboxymethyl guar was a "thermally activated self-crosslinkable gel forming material capable of forming a gel at the temperature of 37.8°C or more in the flow passages of a well bore" and that, if that were the case, the invention could not be considered disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

- VIII. In response, the appellant merely informed the board that it would not be attending the oral proceedings, which took place on 26 April 2016.

- IX. The appellant requested in writing that the decision under appeal be set aside and that a patent be granted on the basis of claims 1-15 of the main request, or alternatively on the basis of any of the first to fifth auxiliary requests, all filed with the grounds of appeal dated 20 September 2013.

- X. At the end of the oral proceedings, the decision was announced.

### **Reasons for the Decision**

1. The appeal is admissible.

#### Sufficiency of disclosure

2. Claim 1 is directed to the use of an aqueous-based composition as a loss-circulation fluid.

Said aqueous-based composition comprises:

- at least one alkali formate, and
- at least one self-crosslinkable gel-forming material,
  - selected from carboxymethyl guar, a carboxymethyl tamarind gum, and combinations thereof, and
  - which forms a gel at a temperature of 37.8°C or more in the flow passages of a well bore.

3. Claim 1 thus requires a gel-forming material which has a specific chemical structure (carboxymethyl guar, carboxymethyl tamarind gum) and, at the same time, is capable of forming a gel at 37.8°C or more in the flow passages of a well bore. The examining division already interpreted claim 1 in this manner, which has not been contested by the appellant.

4. The appellant argued that the wording of claim 1 required a self-crosslinkable gel-forming material which only formed a gel within the flow passages of the well bore at a temperature of 100°F or more (II.1.2.1 of the statement of grounds of appeal).

5. From this argument the board, like the examining division, concludes that not each and every carboxymethyl guar would always be capable of forming a gel at 37.8°C in the flow passages of a well bore.
6. According to the case law of the boards of appeal, the requirements of sufficiency of disclosure are met only if the claimed invention can be performed by a person skilled in the art over the whole area claimed without undue burden, using common general knowledge and having regard to the information in the patent in suit (T 409/91, OJ 1994, 653, Reasons 3.5; T 435/91, OJ 1995, 188, Reasons 2.2.1).

A claim containing functional features defined by means of a result to be achieved comprises a host of possible alternatives and is sufficiently disclosed only if all these alternatives are available to the skilled person.

7. The issue here is whether or not the host of variants encompassed by the functional definition "self-crosslinkable gel forming material which forms a gel at a temperature of 37.8°C or more in the flow passages of a well bore", which, at the same time, has the chemical structure of carboxymethyl guar, is made available to the skilled reader.
8. The examples of the application disclose compositions comprising "carboxymethyl guar", without providing any information which could allow a skilled person to distinguish between carboxymethyl guar suitable for the claimed invention, i.e. capable of forming a gel at a temperature of 37.8°C or more in the flow passages of a well bore, and other carboxymethyl guar such as those disclosed in document D2 and allegedly not having this property.

The appellant has not relied on any evidence showing that, at the date of filing, a skilled person knew how to obtain or to identify the type of carboxymethyl guar required by claim 1, i.e. fulfilling the functional feature that it is capable of forming a gel at a temperature of 37.8°C or more in the flow passages of a well bore.

As the application does not contain the required information allowing a skilled person to identify the required carboxymethyl guar which "forms a gel at a temperature of 37.8°C or more in the flow passages of a well bore", the board concludes that the subject-matter of claim 1 is not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art, as required by Article 83 EPC.

9. The same objection applies to the subject-matter of claim 1 of all the auxiliary requests on file, with the consequence that none of the requests of the appellant is allowable.

## **Order**

**For these reasons it is decided that:**

The appeal is dismissed.



The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated