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File Number: T 397/89 - 3.2.3

Application No.: 84 105 892.8

Publication No.: 0 127 126

Title of invention: Sub for connection in a drill string

Classification: E21B 7/06, E21B 17/07

DECISION
of 8 March 1991

Applicant: Dailey Inc.

Headword:

EPC Article 123(2)

Keyword: "Added subject-matter (main and first auxiliary
request affirmed; second auxiliary request denied)"

Headnote



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Boards of Appeal

Chambres de recours

Case Number : T 397/89 - 3.2.3

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 8 March 1991

Appellant : Dailey Inc.
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Decision under appeal : Decision of Examining Division 114 of the
European Patent Office dated 1 March 1989
refusing European patent application
No. 84 105 892.8 pursuant to Article 97(1) EPC

Composition of the Board :

Chairman : C.T. Wilson
Members : F. Brösamle
J. van Moer

Summary of Facts and Submissions

- I. Appellant's European patent application No. 84 105 892.8 was refused by a decision of the Examining Division dated 1 March 1989. That decision was based on Claim 1 dated 22 August 1986, in which claim it was set out:
- "the assembly further comprising means for transmitting torsional and longitudinal forces between"
- II. The reason given for the refusal was that the subject-matter of the above mentioned claim extended beyond the content of the application as filed, thereby infringing Article 123(2) EPC, since the feature referred to in I above would embrace other means than "protuberance means" and "receiving means" forming part of the documents as originally filed. It was felt that this information was "not directly and unambiguously derivable" from the application as filed even when account would be taken of matter which is implicit to a person skilled in the drilling technology.
- III. On 10 April 1989, the Appellant (Applicant) filed a notice of appeal against that decision, paying the appeal fee on the same day. The Statement of Grounds of Appeal was filed on 2 May 1989; three sets of claims (Claims "A" as the main request, Claims "B" and "C" as the first and second auxiliary request) were submitted, Claims 1 reading as follows:

Main request ("A"):

- "1. For a directional drilling apparatus comprising a tubular drilling string having two longitudinally spaced-apart stabilizers (14, 16), means for providing

for stepwise in situ adjustment of the distance between the said stabilizers and characterised by an assembly (22) of two tubular members (24, 26) in longitudinally telescoping relationship to each other, one of the tubular members being attachable at one end of the assembly to an upper portion of the drill string intermediate the stabilizers and the other of the tubular members being attachable at the opposite end of the assembly to a lower portion of the drill string intermediate the stabilizers, the assembly further comprising means (46, 52) for transmitting torsional and longitudinal forces between the said tubular members (24, 26) when one tubular member is positioned at any selected one of the plurality of different selectable positions relatively to the other tubular member, while permitting longitudinal adjustment of the position of the one tubular member relatively to the other between said selectable positions."

First auxiliary request ("B"):

- "1. For a directional drilling apparatus comprising a tubular drilling string having two longitudinally spaced-apart stabilizers (14, 16), means for providing for stepwise in situ adjustment of the distance between the said stabilizers and characterised by an assembly (22) of the two tubular members (24, 26) in longitudinally telescoping relationship to each other, one of the tubular members being attachable to one end of the assembly to an upper portion of the drill string intermediate the stabilizers and the other of the tubular members being attachable at the opposite end of the assembly to a lower portion of the drill string intermediate the stabilizers, the assembly further comprising means for transmitting torsional and longitudinal forces between the tubular members (24,

26) when one tubular member is positioned at any selected one of the plurality of different selectable positions relatively to the other tubular member, while permitting longitudinal adjustment of the position of the one tubular member relatively to the other between said selectable positions, the tubular members (24, 26) being relatively rotatable about their common longitudinal axis and the transmitting means comprising releasable interengaging means (46, 52) operable at a plurality of longitudinally spaced telescoped positions of the members (24, 26) to interlock the members in co-rotatable, longitudinally rigid, relationship."

Second auxiliary request ("C"):

"1. For a directional drilling apparatus comprising a tubular drilling string having two longitudinally spaced-apart stabilizers (14, 16), means for providing for stepwise in situ adjustment of the distance between the said stabilizers and characterised by an assembly (22) of two tubular members (24, 26) in longitudinally telescoping relationship to each other, one of the tubular members being attachable at one end of the assembly to an upper portion of the drill string intermediate the stabilizers and the other of the tubular members being attachable at the opposite end of the assembly to a lower portion of the drill string intermediate the stabilizers, the assembly further comprising protuberance means (46) on one of the members (24, 26) extending into an annular space (48) between the members and towards the adjacent surface of the other member; and receiving means (52) on the adjacent surface of the other member; adapted selectively to receive and engage the protuberance means (46) such that the members (24, 26) are movable axially relatively to one another, for substantially

the whole of their telescoping stroke, when the protuberance means (46) are disengaged from the receiving means (52), the latter being adapted to receive the protuberance means (46) when the members (24, 26) are rotated relatively to each other in one direction and to engage the protuberance means (46) to prevent further relative rotation of the members (24, 26) in said one direction thus enabling torque and longitudinal forces to be transmitted between the members (24, 26)."

- IV. The Appellant requests that the impugned decision be set aside and that a patent be granted on the basis of Claims "A" or "B" or "C". A refund of the appeal fee is also requested.

If the Board were disinclined to accept any of the Claim sets "A", "B" and "C" then oral proceedings were requested.

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. **Main request**
 - 2.1 This Claim 1 literally corresponds to the one refused by the impugned decision by the Examining Division, whereby the crucial feature thereof is "means (46, 52) for transmitting torsional and longitudinal forces".
 - 2.2 In the application as originally filed it is clearly set out that the foregoing means are "protuberance means" and "receiving means", see Claim 1, lines 8, 10 and 11,

Claim 2, line 1, Claim 3, line 1, Claim 5, lines 1 and 2 and Claim 6, lines 2 and 3 as well as page 2, lines 17 and 19, lines 33 and 37, page 5, lines 25 to 27 and Figures 2B and 3 in particular, and are nothing else.

- 2.3 In this context it has to be considered that the form of the receiving means depends on the thread (right hand according to page 6, line 12) of the drill string so that the cavities "52" are designed to transmit right hand rotation from the drill string to the drill bit, see page 6, lines 12 to 15 and reference signs "52, 46 and 54" in Figure 3.
- 2.4 The feature of Claim 1 ("means for transmitting torsional and longitudinal forces") is therefore a generalisation of the teaching disclosed in the application as originally filed which is not supported in that application even when read by a skilled person. It is quite clear that the feature under discussion would also cover the possibility to carry out the "means for transmitting forces" as friction transmitting members, i.e. clamping means which are activated and deactivated allowing to extend or shorten the distance between the stabilizers.
- 2.5 It is immediately clear for the Board that such an alternative was not envisaged in the application as originally filed, though it is now claimed.

The objection under Article 123(2) EPC raised by the Examining Division is therefore justified since this Claim 1 contravenes the requirements of that article of the EPC.

- 2.6 As a consequence of the foregoing the main request (Claims "A") has to be rejected.

3. First auxiliary request

3.1 Claim 1 of this request differs from the non-allowable Claim 1 of the main request by the features "the tubular members (24, 26) being relationship", see last seven lines of Claim 1 ("B" version).

3.2 Despite the fact that the "means for transmitting forces" are defined in Claim 1 of the first auxiliary request as "releasable interengaging means (46, 52) operable to interlock relationship", this wording would still embrace a clamping device transmitting torsional and longitudinal forces by friction, which alternative cannot be derived, explicitly or implicitly, from the application as originally filed so that Claim 1 of the first auxiliary request has also to be rejected for reasons of Article 123(2) EPC.

4. Second auxiliary request

4.1 Claim 1 differs from the originally filed Claim 1 by the insertions

- a) "directional", see line 1,
- b) "in situ adjustment", see line 4,
- c) "intermediate the stabilizers", see lines 9 and 10,
- d) "to each other", see lines 25 and 26, and
- e) "and longitudinal forces", see line 29.

4.2 The above amendments a) to e) are all supported by the application as originally filed:

Amendment a) finds its support in Figure 3, see cavity "52" and arrow "54" for instance. Amendment b) can be derived from the wording "without removing the drill string from the well bore" (see last two lines of originally filed Claim 1). Amendment c) finds its support inter alia in Figure 1, see reference signs "L" and "22". Amendment d) is

a clarification of the previously used term "are rotated relatively in one direction" of Claim 1 and amendment e) can be derived from the originally filed Claim 1, lines 19 to 21, where it is stated that the weight can be transmitted from one member to the other, and from Figure 3 and its corresponding text which makes it absolutely clear that the longitudinal forces can be transmitted in both directions, (see reference signs "52c" and "52b" in respect of pin "46").

4.3 Claim 1 of the second auxiliary request is as a result of the foregoing allowable, Article 123(2) EPC.

4.4 Dependent Claims 2 to 7 are based on originally filed Claims 2 to 7 and largely literally correspond to them, whereby only in Claim 6 the wording has been slightly altered, however, in a sense to clarify the teaching in an allowable manner.

Claims 2 to 7 are as a consequence also allowable, Article 123(2) EPC.

5. Claims 1 to 7 of the second auxiliary request being allowable, the auxiliary request for oral proceedings has no basis.

6. The request for refunding the appeal fee has to be rejected, since there is no basis for this request in the EPC. According to Rule 67 EPC the reimbursement of the appeal fee has to be ordered where the Board of Appeal deems an appeal to be allowable. Since Claim 1 of the main request (corresponding to the Claim 1 underlying the decision of the Examining Division) has to be rejected, see above 2.6, the appeal is not successful in this respect so that the appeal fee cannot be refunded.

7. The Appellant has inter alia pointed to the decision T 151/84, Thomson-CSF, unpublished; in the Board's opinion this decision is not applicable to the present case, since the Board has reached the conclusion that the Claims 1 in the versions "A" and "B" are based on added subject-matter due to the fact that narrow features as originally disclosed have been generalized to broader features without having a basis (explicitly or implicitly) in the application as originally filed. It did not therefore have to be decided in the present case whether features, which have a basis in the originally filed documents, can be claimed or not or can be omitted from a claim, so that the considerations laid down in T 151/84 are not comparable to the present situation, where two versions of Claim 1 define subject-matter which - even with the benefit of interpretation of the originally filed documents by a skilled person - cannot be unambiguously derived from these documents in the meaning of Article 123(2) EPC.

8. The Appellant argues for the existence of a "novel principle" or "novel functional principle", (see remarks 9 and 10 of the Statement of Grounds of Appeal), and derives therefrom that the claims can be broadened during the examining proceedings.

The Board admits the possibility of claim broadening in principle. However, in the Board's opinion there must be a clear and unambiguous basis to allow this. The approach followed by the Appellant, i.e. redrafting the claims in the light of the prior art and covering possibilities not derivable from the prior art in the claims has, however, to be rejected, since the requirements of Article 123(2) EPC have not to be seen in the light of the prior art but are simply a question of the original disclosure. As set out above the Board cannot find a basis for the "A" and "B" Claims 1 in the documents as originally filed, since no

general principle for varying the length of a drilling string is given, but only a constructional embodiment linked to the existence of protuberances and recesses, if these documents are read by a skilled person. A basis for generalization - as presented in Claims 1 in their "A" and "B" versions - cannot be seen from these originally filed documents, since it is felt that a skilled reader would not arrive at further alternatives, for instance clamping means which transmit forces (longitudinal or torsional) merely by the existence of friction.

Summarising, the arguments of the Appellant which should support the allowability of the claims "A" and "B" cannot be accepted by the Board so that these requests have to be rejected, see 2.6 and 3.2 above.

Order

For these reasons, it is decided:

1. The impugned decision is set aside.
2. The case is remitted to the first instance with the order to continue the examination of the case on the basis of Claims 1 to 7 according to the second auxiliary request, which are in agreement with the provisions of Article 123(2) EPC.
3. All other requests are rejected.

The Registrar:



N. Maslin

The Chairman:



C.T. Wilson

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