

Summary of Facts and Submissions

I European patent application no. 79 200 678.5, filed on 20 November 1979 and published under the number 0 011 894, was refused by decision of the Examining Division 106 dated 23 April 1982. The decision was based on claims 1-6 filed on 14 December 1981, claims 1 and 2 reading as follows:

1. A method of installing a tubular element in the bottom of a body of water comprising the steps of lowering the tubular element from the water surface to the water bottom, closing the tubular element at the upper end, reducing the pressure within the tubular element by operating a pumping unit so as to cause the tubular element to penetrate into the water bottom until a desired depth and then stopping the pumping unit, characterized in that the pumping unit is removably mounted on the tubular element either before or after the lowering of the tubular element to the water bottom, and that, after stopping the operation of the pumping unit, the pumping unit is disconnected from the tubular element, raised to the water surface and recovered.

2. An apparatus for carrying out the method as claimed in claim 1, comprising a tubular element which is adapted to be closed at the upper end and which is open at the lower end, a thin cutting edge at the lower end of the tubular element, and a pumping unit for reducing the pressure within the tubular element, characterized in that the pumping unit is removably connected to the tubular element by a remotely controlled releasable coupling and that the pumping unit is adapted to be remotely controlled, wherein the pumping unit is provided with hoisting means extendible from the water surface to the water bottom for raising the pumping unit to the water surface."

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Case Number: T 127 / 82

DECISION
of the Technical Board of Appeal 3.2.1
of 19.05.83

Appellant: SHELL Internationale Research Maatschappij B.V.
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Decision under appeal:

Decision of Examining Division 106
Office dated 23 April 1982
application No 79 200 678.5
EPC

of the European Patent
refusing European patent
pursuant to Article 97

Composition of the Board:

Chairman: G. Andersson
Member: P. Ford
Member: K. Schügerl

that the tubular member penetrates into the sea-bed. When the desired depth has been reached, the pumping is stopped. This state of the art is correctly indicated in the pre-characterising part of claim 1 (Rule 29(1)(a) EPC).

According to the US document, the pump itself is positioned on a vessel and the connection between the pump and the tubular element is established by a suction discharge line (a flexible hose), which may be disconnected from the tubular element once the desired depth has been reached and reconnected to the tubular member for its removal (column 4, lines 19-28).

The differences from this prior art, as featured in the characterising portion of claim 1, may be summarised in the following way:

First, the pumping unit is transferred from the vessel to the tubular member and, second, the pumping unit is removed from the tubular member after its penetration into the sea-bed and recovered.

3. Whether these steps from the prior art are inventive or not, has to be decided having regard to FR-A-2 247 377. It must be remembered first that the skilled person, contrary to what is asserted in the statement of the grounds of appeal, will be assumed to have read and understood the French document in the same way as the US document, irrespective of the features or the problems disclosed in or derivable from one or the other document.
4. According to FR-A-2 247 377, a pumping system is fixedly connected to a tubular element. Such a permanent connec-

II In its decision, the Examining Division stated that the subject matter of claim 1 did not involve any inventive step having regard to FR-A-2 247 377 and to US-A-3 496 900 and that also the subject matter of claims 2-6 was lacking in inventive merits.

III Against this decision the applicant lodged an appeal on 5 June 1982, paying the appeal fee and filing the statement of grounds in due time. The applicant deleted claims 3-6 and requested that the decision of the Examining Division be set aside for claims 1 and 2 and that a patent be granted on that basis.

IV The applicant maintained that starting from the cited prior art documents, several steps had to be taken in order to arrive at the invention and that it could not be considered as obvious even to a skilled person to carry out all these steps.

V In the course of the written procedure before the Board of Appeal, the appellant amended the description by submitting new pages of the description.

Reasons for the Decision

1. The appeal complies with Articles 106 - 108 and Rule 64 EPC and is, therefore, admissible.
2. US-A-3 496 990 discloses the anchoring of vessels etc., especially also of floating drilling platforms by lowering a tubular member to the bottom of a body of water and by reducing the pressure in the tubular member so

6. Although the practitioner will in general not be led by considerations referred to in the previous paragraph, the known position of a pumping unit on an anchor as such may still be regarded as an alternative. The question, however, whether it has been obvious or not, to make use of this alternative, may be left undecided, for this step would not be the whole of the invention, as indicated in paragraph 2. An additional and essential step is the idea of disconnecting and recovering the pumping unit after penetration. No precedent for this concept can be found in the search documents.
7. In its decision, the Examining Division argued that, since according to the US document the hose is disconnected from the tubular element after penetration, it would have been obvious to disconnect the pumping element as well. This, however, would presuppose a certain capability of generalisation, insofar as from the fact that the hose is disconnected and recovered, the inference is drawn that in another connection other elements, which are out of duty after penetration, may be disconnected and recovered. Such a capability of generalisation cannot be attributed to the practitioner which will be more inclined to cling to the concrete facts presented to him by the state of the art.
8. Summarizing, the subject matter of claim 1 is the result of an inventive step; claim 1 therefore meets the requirements of Articles 52 and 56 EPC.
9. Claim 2 is concerned with an apparatus for carrying out the method as claimed in claim 1. Since claim 2 differs from claim 1 only in that the underlying subject matter is featured in a product claim instead of a method claim,

tion is necessary because the tubular element is held to the ground by the pressure difference between the exterior and interior of this element and not or at least mainly not by friction as the tubular member according to US-A-3 496 990. The reduced pressure in the interior will diminish due to leakage around the lower edge of the element. To make good this reduction in pressure difference, the pumping system has to be actuated at least from time to time.

Thus, the pumping system according to the French document serves a similar purpose to that of the pump according to the application only in the first stage, namely the stage of penetration of the tubular element into the bottom; the removal of the pumping system after that stage would destroy the function of the anchor.

5. The Examining Division argued inter alia that the drawback of a pump on a vessel, namely to be less efficient when the water bottom is at a great depth, would encourage the skilled person to attach the pump directly to the tubular element. Such an inference is, however, not acceptable, because the skilled person is not so quick in recognising the disadvantages of a given construction; he is, as a rather unimaginative spirit, more inclined than a potential inventor, to accept the state of the things as they are.

Further, in general, it is only after the invention has been made that the disadvantages of the prior art become fully apparent by comparison with the invention. Clearly, such disadvantages can then not be regarded as an incentive, which would lead the skilled person to the invention.

the above statement under paragraph 8 is equally valid for claim 2.

10. The amendment to the description takes into account the prior art of US-A-3 496 900 and FR-A-2 247 377 according to Rule 27(1)(c) EPC. Since the amendment is also in line with Article 123(2) EPC, it is not open to objection.
11. No application has been made for reimbursement of the appeal fee in accordance with Rule 67 EPC and it is not considered that the circumstances of the case would justify the reimbursement.

For these reasons, it is decided that:

The decision is set aside and the case is remitted to the Examining Division with the order to grant the European Patent on the basis of claims 1 and 2, submitted on 14 December 1981, of the description, pages 1, 2, 2a and 2b submitted on 20 January 1983 and of the description, pages 3-10 and the drawings as filed.

P.F.

J. R.

