

0113/92

**PATENTS ACT 1977**

IN THE MATTER OF an application by  
Deepwater Oil Services Limited  
to amend the specification of  
Patent No 2165286  
and

IN THE MATTER OF an opposition  
thereto by The Red Baron (Oil Tools  
Rental) Limited

**INTERIM DECISION**

Patent No 2165286 is dated 25 September 1985 and claims priority from earlier GB applications dated 6 October 1984 and 23 April 1985. On 7 November 1988 the patentees applied under Section 27 to amend their specification, the reason stated on Form 14/77 being "In view of the disclosure in Fig. 3 of European Patent specification No 0155129 which was published subsequent to the priority date of UK Patent No 2165286". The European patent has declared priority dates of 2 March and 4 July 1984, and as these are before the earliest declared priority date of the patent in suit the European patent lies in the Section 2(3) field.

As the result of official objection that further amendment of the specification appeared necessary, the patentees submitted revised proposals on 20 March 1989. Following advertisement, the present opponents filed notice of opposition on 6 September 1989 on the grounds that the proposed amendments still leave the patent with a main claim that is invalid in the face of prior art, do not meet the requirements of Section 76 in that they disclose additional matter and also serve to extend the protection conferred by the patent as granted, and introduce ambiguity and obscurity. In the supporting statement, the opponents base their case regarding invalidity on the disclosure contained in United States Patent No.1867289. They say this anticipates or renders obvious the subject matter of several

claims even when their scope is limited as proposed, and contend that, as the patentee was well aware before grant of the existence of this prior art, these claims are covetous.

In a supplementary statement filed on 13 November 1990 the opponents refer in addition to a United Kingdom patent which they say anticipates claims 1 to 5. This gave rise to official letters dated 22 November 1990 and 13 January 1991 requesting the opponents to confine both their statement and supplementary statement to admissible issues not affecting validity. In response, the opponents withdrew the supplementary statement but in an agent's letter dated 21 January 1991 argued in respect of the statement that they were entitled to raise invalidity to support the ground of covetousness.

In a counterstatement filed on 17 January 1990 the patentees maintain that the claims are both novel and inventive over the US prior art identified by the opponents, that there is no claim broadening or added matter to contravene Section 76 and that there is no ambiguity or obscurity. Nevertheless, they submit revised proposals which introduce additional limitations upon the scope of claim 1 and seek to clarify the description at line 10 on page 2. In so doing, unintentional errors are introduced into claim 1, these being referred to in evidence filed on behalf of the opponents by Mr Morris. A corrected version was submitted by the patentees in a supplementary counterstatement filed on 28 February 1991. The revised proposals, as corrected, were readvertised on 22 May 1991 and no new opposition was filed.

Evidence for the opponents is given by:

George Humphrey Otter Morris, who has fifteen years experience in oil well servicing and is a joint inventor of the European Patent Application; and  
Werner Bernhardt Lau, who also has many years experience in downhole services in the oil industry, and is a director of the opponent company.

Evidence for the patentees is given by:

Hector McDonald, the assistant operations manager of the patentee company, the inventor of the patent in suit, with over twenty years experience in the oil industry.

The normal three stages of evidence were completed with the filing of the opponents' evidence in reply on 10 May 1991. The opponents then filed a supplementary statement, on 24 June 1991, amplifying their objections based on US Patent No 1867289, and supported it with a second affidavit by Mr Lau, filed on 1 July 1991. An official letter dated 29 July 1991 gave the preliminary view that this evidence was inadmissible. It also expressed the prima facie view that the further evidence went to the validity of the patent and was inadmissible on these grounds also. Following arguments from both sides by way of agent's letters dated 2 and 15 August 1991, a further official letter issued on 6 September 1991 proposing that these matters should be decided as a preliminary matter at the hearing.

The hearing took place before me on 10 December 1991 when Mr Daniel Alexander appeared as counsel for the patentees and Miss Denise McFarland appeared as counsel for the opponents.

The patentees' specification relates to a cutting and recovery tool for severing and removing a well-head and associated portion of casing lying below the sea bed when a site is to be abandoned. In a first embodiment shown in Figure 1, the tool comprises a housing 1 with a screw threaded outside surface 2 for engaging a similarly configured internal surface on the well-head. A tool shaft 5 passes through the housing and is rotatable therein but only when sufficient downward force is applied to the shaft to compress springs 17 and disengage splines 16 extending between shaft and housing. In use, the tool is lowered onto the well-head and the shaft is rotated to engage the screw threads. A downward force is then applied to disengage the splines allowing the shaft to be rotated so driving a cutting tool mounted on its lower end. When the casing has been

severed, the shaft is raised bringing with it the cut casing and well-head.

In a second embodiment shown in Figures 2 to 5, instead of a screw threaded surface 2 on the housing, arms having teeth 26 are provided, the arms being mounted on a cylindrical body 21 equivalent to the housing 1 and urged outwardly by springs 17. The splines are replaced by a more sophisticated clutching arrangement. In use, the tool is lowered and a downward force applied causing the teeth to snap into engagement with a formation on the inner surface of the well-head. During this operation the shaft moves downwards slightly relative to the body freeing a shaft-mounted collar 29 from engagement with the toothed arms to enable the snap action. When a sufficient down-force is applied to the shaft the clutch disengages allowing the shaft to rotate freely. When cutting is complete, the down-force is released sufficiently for the collar 29 to urge the toothed arms firmly against the well-head whilst the tool together with the severed head and casing are removed. Once at the surface, the collar is held just clear of the arms freeing them for inward movement out of engagement with the well-head allowing the tool to be easily removed. Alternatively the tool can be unscrewed from the severed well-head.

By their proposed amendments the patentees seek to limit the scope of their claims to the second embodiment. However, when the three sets of proposals submitted are taken together there is some doubt as to exactly how the patentees intend the claims to be renumbered. At the hearing Mr Alexander explained that the desired amendments involve the replacement of claims 1 to 9 as granted by new claims 1 to 6 as submitted in the supplementary counterstatement, the renumbering of claims 10 to 12 as claims 7 to 9, claim 7 being made appendant to claim 1 and claim 9 referring to Figure 2 rather than Figure 1 of the accompanying drawings, the deletion of claim 13 and consequential amendment of the description. Further amendment of the description involves changes to the wording of line 10 and deletion of lines

16 to 20 on page 2.

The new claims thus read as follows:-

1. A cutting and recovery tool for use with a well-head, the well-head having an upwardly-directed face and an engageable formation on its internal side wall at a location below said face, the tool comprising a housing having a downwardly-directed face for abutment with the upwardly-directed face of the said well-head, the housing being securable in the well-head by fixing means, so that the housing and the well-head remain in engagement when the housing is subjected to an upward force, and in which the fixing means comprises a plurality of arms, each arm being secured at one end to the housing and each having a distal end carrying a segment having a profile for engagement with said formation of the well-head, means for selectively moving said distal ends transversely into and out of said engagement, and a mandrel extending through the housing and rotatable relative to the housing, the mandrel being adapted to carry a radially-acting cutter at a location below the housing.
2. A tool according to Claim 1, wherein the mandrel is axially movable relative to the housing.
3. A tool according to Claim 2, wherein said distal ends are transversely movable by engagement with a tapered face of the mandrel.
4. A tool according to Claim 3, wherein the arms are pivotally mounted on the housing.
5. A tool according to any one of the preceding claims, in which the mandrel is biased upwardly of the housing by spring means.
6. A tool according to Claim 5, in which the spring

means also act to bias the arms outwardly.

7. A cutting and recovery tool according to Claim 1, substantially as hereinbefore described with reference to and as shown in Fig. 2 of the accompanying drawings.

8. A method of severing and recovering a well-head and casing, comprising the steps of engaging with an upwardly-directed face of the well-head a tool comprising a housing which has means for coupling the tool to an existing formation on the side wall of the well-head, a mandrel passing through the housing and movable therethrough, the mandrel being spring-biassed upwardly relative to the housing, and a radially-expandable casing cutter on the mandrel, the cutter being spaced below the housing, coupling the housing to said existing formation on the well-head so that the housing and the well-head remain coupled on application of an upward force to the housing, applying a downward force to the mandrel to move the mandrel downwardly through the housing against the action of said spring bias, maintaining said downward force at a magnitude sufficient to hold said cutter at a constant distance below the housing, rotating the mandrel relative to the housing to cause the cutter to rotate, expanding the cutter radially to engage and sever a side wall of the casing, reducing the magnitude of said downward force to allow the mandrel to move upwardly relative to the housing under the action of said spring bias, and applying an upward force to the housing thereby to raise the well-head and severed casing.

9. A method of severing and recovering a well-head and casing, substantially as hereinbefore described with reference to Fig. 2 of the accompanying drawings.

The opponents say in their statement that as the patentees have

chosen to maintain claims broad enough to embrace prior art of which they were well aware before grant, those claims are covetous and no amendment should be permitted in the exercise of discretion. In their supplementary statement they indicate that the claims concerned are claims 1 to 4 as proposed which they claim are anticipated or lack inventive step having regard to the United States patent.

At the hearing Mr Alexander submitted that the opponents' case concerning covetousness was inadmissible as it was based not on the European patent which the patentees were attempting to avoid by the amendments they had proposed but on a different, United States patent. He argued that the covetousness allegation was in fact a disguised attack on the validity of the patent and as such was not allowable in Section 27 proceedings. He also pointed out that it was uncontroverted that the patentees had drawn the US document to the attention of the examiner during prosecution of the application that matured into the patent in suit. He referred me in particular to paragraph 9 of the supplementary statement where the opponents specifically concede as much. This he contended demonstrated that there had been no bad faith on the part of the patentees and for this reason also he claimed the covetousness allegation was inadmissible. Accordingly he applied for those parts of the opponents' statements and evidence dealing with covetousness to be struck out.

Miss McFarland accepted there was no evidence of bad faith but argued that bad faith was not a precondition for establishing a case of covetousness. The necessary facts were that the patentees knew about the US document while their patent application was still before the Comptroller, and that the document did in fact render the patent invalid. She drew a distinction between examining expert evidence concerning the validity of the claims, which she argued was necessary before deciding whether to exercise discretion under Section 27, and entering into a general attack on validity. The opponents, she

said, had sought to avoid a general attack on validity and for this reason had withdrawn the supplementary statement of 13 November 1990. Although it is well-settled practice that amendment proceedings may not be used for a roving enquiry into validity, she submitted that to refer to one prior art document was not a roving enquiry.

After hearing counsels' arguments, I ruled that the opponents' objections, so far as they depended on invalidity based on the US document, should be struck out. I said that the principal authorities are identified in para 27.13 of the CIPA Guide to the Patents Acts, which was referred to by the patentees' agents in correspondence. The leading case is Great Lakes Carbon Corporation's Patent [1971] RPC 117, and a case directly on the point at issue is Bucher-Guyer's Patent (November 1986), which the CIPA Guide quotes as deciding that "...an opponent was not permitted to contend that the proposed amendment would .... leave it clearly anticipated by some further prior art." What I said in that case was:

"This application highlights an apparent conflict between two principles on which these cases have been decided in the past, one that the Comptroller will not allow an amendment that leaves a patent clearly invalid, and one that the Comptroller will not permit amendment proceedings under Section 29 [of the Patents Act 1949] to be expanded into a roving inquiry into the validity of the patent (for which the authority cited at the hearing was Great Lakes Carbon Corporation's Patent [1971] RPC 117 at 126). [Counsel for the opponent's] main argument was that to point to one clear anticipation of the patent could not be regarded as embarking on a roving inquiry into validity. In addition, he submitted that, as was usual in patent litigation, it was necessary to lead evidence to give the hearing officer the background information that the skilled man would have - in this case as I understand it the information that was common knowledge among

agricultural engineers in 1969. Therefore, if the patent was clearly invalid in the light of that common knowledge, it would be wrong of the hearing officer to ignore the situation.

In my view [this] submission does not properly take account of the policy associated with these proceedings. It is in the public interest that a patent granted in ignorance of some defect in it should be corrected as soon as possible. The patentee is under a positive obligation to have it corrected without undue delay, and if he neglects this obligation he risks being left with an incurably bad patent. The counterpart of this obligation is that the patentee should be encouraged to amend by making the procedure as straightforward as possible. As a general rule, if the patentee notifies the Comptroller of a specific defect and puts forward a proposal for correcting it, the Comptroller will not go out of his way to search for other flaws."

and later on I said:

"The idea that a brief inspection of one new document might shorten these proceedings is superficially an attractive one, but [counsel for the patentee] told me that the patentees would argue strongly that the article in "The Engineer" was not an anticipation. It therefore seems unlikely that time and effort will be saved by admitting this document. I also do not believe that the opponents will be prejudiced by my ignoring the article, because they can either apply under section 32 or 33 [of the 1949 Act] for the patent to be revoked, or, if the invalidity is as clear as they say, simply proceed as though the patent did not exist."

I therefore ruled that paras 4 to 13 of the opponents' statement of case file, paras 4 to 13 of their supplementary statement,

were to be struck out and that I would disregard paras 10 to 11 and 16 to 21 of Mr Morris's affidavit, and paras 6 to 9 of Mr Lau's 1st declaration. Mr Lau's second statutory declaration is concerned solely with the US document, and I refused to allow it to be admitted.

The opponents' other pleaded objections are of claim broadening, added matter, ambiguity and obscurity, and it was accepted by Mr Alexander that these were all matters that should be considered. However it became clear at the hearing that there were objections only to the passages in the proposed claim 1 that refer to:

"... means for selectively moving said distal ends transversely into and out of engagement" and

"... the well head having an engageable formation on its internal side wall".

The objections centre on "selectively", "out of", and "engageable" and I shall consider them in that order.

The opponents' objection to the word "selectively" was put by Mr Morris in his affidavit. He considered the use of the word "selectively" to be confusing as it implies that the arms move "separately" which, he says, is clearly not the case. Mr McDonald's evidence in answer was that "selectively" means "alternatively" rather than "separately".

Mr Alexander argued that to attempt to interpret the term "selectively" as meaning "separately" did not stand up to close scrutiny since moving the arms separately out of engagement with the well-head walls would have no effect. Miss McFarland said the opponents could accept that the word "selectively" had to be interpreted as Mr Alexander had argued and I am satisfied that "selectively" qualifies "moving ... into and out of" and does not disclose the facility for moving one arm independently

of the others.

The objection to "into or out of engagement" in para 14 of the opponents' supplementary counterstatement is that there is no disclosure of any means to "move the distal ends out of engagement". This feature is concerned with the arrangements for disconnecting the well head from the tool when the cutting operation is complete and the tool and well head have been brought to the surface. Mr McDonald's evidence for the patentees is that the expression "means for" does not necessarily require that particular items must be present to carry out the acts referred to, only that the overall arrangement of items must be such that the acts will be fulfilled in use. He believes the description relating to engagement and disengagement of the arms with the well-head, at p.2 l.65-87 and p.3 l.11-28 of the published application, gives support to the wording objected to in Claim 1 as proposed to be amended. In evidence in reply, Mr Lau says that he remains unconvinced that there is disclosure of specific apparatus for selectively moving the arms out of engagement.

Mr Alexander submitted that the originally filed description disclosed snapping the tool arms not only into, but also out of engagement with the grooved formations on the inside of the well-head and that the disclosure of snapping the arms out of engagement supported the wording which the opponents found objectionable. He referred me in particular to the description at lines 19 to 25 on page 3 which indicates that when the collar 29 is clear of the arms they "then can move inwardly out of engagement with the well-head grooves, and the tool is then easily withdrawn from the well-head without damaging either itself or the well-head". He contended that in some embodiments snapping off was clearly the sole method of separating the tool from the well-head, this being implicit, he said, from lines 25-28 on page 3 which states that unscrewing is an alternative method. He maintained that, with sufficient force applied to the tool it could be snapped off the well-head without manual

intervention even if the distal ends of the arms were provided with tapered buttress screw threads as illustrated in Figure 2. Drawing on Mr McDonald's evidence, he argued that the overall arrangement including the biasing springs 17 and pivotal mounting of the arms was such as to enable the disengaging movement to take place and that this provided the necessary support for the proposed reference in claim 1 to means for moving the arms out of engagement. The tool and well head could be separated by simply pulling them apart, and the effect of Mr McDonald's evidence was that the skilled person would appreciate this from reading the specification.

Miss McFarland maintained that there was no teaching of means for selectively moving the arms out of engagement. She said Mr Alexander's argument was that it was implicit in the specification that the arms could be snapped out of engagement but this merely served to underline the lack of any specific teaching. Indeed, in her contention the specification taught away from such a snapping action. The description at lines 22 to 43 on page 1 indicated that the invention sought to overcome the problem of downgrading well-heads by damaging the internal threads. This, she said, implied that a snapping action across the threads of the well-head of the kind Mr Alexander had outlined was to be avoided. Such an action could cause damage because a relatively large force would be required to effect disengagement. If this were not the case there would be a substantial risk of losing the well-head during the recovery operation. The expert evidence, she said, was inconclusive. Mr Morris and Mr Lau had said they could find no support and Mr McDonald felt able to state in his statutory declaration only that disengagement was described "to the extent that a person skilled in the relevant oilfield technology would have no difficulty in accomplishing these actions".

Having heard these arguments and studied the evidence, I do not consider that there is disclosure in the specification as filed of the disengaging snap action outlined by Mr Alexander. So far

as the proposed claim is concerned, it specifies:

"a tool comprising .... means for .... moving said distal ends ... out of said engagement...."

and there is in my view no disclosure to support this. It is clear from the description that the arms are mounted on the tool in such a way that they can be moved inwardly out of engagement with the well-head to permit the tool to be easily withdrawn but the way in which inward movement is effected is not described. Quite possibly the patentees were not concerned when filing the specification with the means that might be used for effecting disengagement, since this would be a relatively straightforward operation to be performed at the surface, provided that the arms were inwardly moveable so as to be disengageable. In summary I find this particular objection to be justified.

Miss McFarland then drew my attention to the fact that in claim 1 as granted the formation on the internal side wall of the well-head had been defined as "an existing formation" whereas as proposed it was "an engageable formation". In her contention, "existing formation" covered only those formations available at the time of filing the patent application, that is the screw threaded or groove formations described at lines 40 to 41 on page 1 of the specification as filed, and that being the case, the proposal to amend "existing" to "engageable" amounted to claim broadening as other types of formation would become available on the market subsequent to the filing date. On the other hand, Mr Alexander argued that the expression "existing formation" simply referred to the formation, of whatever kind, that happened to have been provided on the well-head and that to amend this to "engageable formation" could only impose an additional restriction on the scope of the claim. I am satisfied that screw threaded and groove formations were given only as examples of formations that might exist on well-heads and that the tool described in the specification was capable of locking onto a well-head provided with any kind of engageable formation. In consequence, I consider the

interpretation that Mr Alexander put on the expression "existing formation" to be the correct one and I am not persuaded that there is any material difference in scope between "existing formation" as used in claim 1 as granted and "engageable formation" as proposed.

In all these circumstances I withhold discretion to amend in the manner proposed but allow the patentees a period of two months from the date of this decision in which to submit further proposals for amendment to take account of this decision. If no proposals for further amendment are filed within that period I shall issue a final decision refusing the application to amend.

Neither party has applied for costs, though it would be normal to deal with costs at the end of the proceedings, and there is therefore still time for an application for costs to be made. I should perhaps say however that my provisional view on costs is that an opponent who sustains an objection to an amendment is normally awarded costs, but since in this case I have struck out the major part of the opponents' case, I would be inclined to make no order for costs.

Dated this 30 day of January 1992



W J LYON

Superintending Examiner, acting for the Comptroller

PATENT OFFICE