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Case Number: T 1671/14 - 3.3.05

Application Number: 06740115.8

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IPC: B01D29/54, B01D29/21, B01D29/23

Language of the proceedings: EN

Title of invention:
FILTER ELEMENT AND FILTER ASSEMBLY, METHOD OF FILTERING AND METHOD OF CONSTRUCTING THE FILTER ELEMENT

Patent Proprietor:
DONALDSON COMPANY, INC.

Opponent:
MANN+HUMMEL GmbH

Headword:
Filter including gussets/DONALDSON

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
Amendments - intermediate generalisation

Decisions cited:

Catchword:

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Case Number: T 1671/14 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 8 May 2018

Appellant: (Opponent)	MANN+HUMMEL GmbH Hindenburgstrasse 45 71638 Ludwigsburg (DE)
Representative:	Horn Kleimann Waitzhofer Patentanwälte PartG mbB Ganghoferstrasse 29a 80339 München (DE)
Respondent: (Patent Proprietor)	DONALDSON COMPANY, INC. 1400 West 94th Street P.O. Box 1299 Minneapolis, MN 55440-1299 (US)
Representative:	Tilmann, Max Wilhelm König-Szynka-Tilmann-von Renesse Patentanwälte Partnerschaft mbB Mönchenwerther Straße 11 40545 Düsseldorf (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 6 June 2014 rejecting the opposition filed against European patent No. 1874426 pursuant to Article 101(2) EPC**

Composition of the Board:

Chairman	E. Bendl
Members:	J.-M. Schwaller
	R. Winkelhofer

Summary of Facts and Submissions

I. The present appeal lies from the decision of the opposition division to reject the opposition against European patent No. 1 874 426, its independent claim 1 as granted reading:

"1. A filter element comprising:

(a) a first, outer tubular construction of filter media (12, 112); the first outer tubular construction of filter media defining a first open filter interior (14, 114);

(b) a second, inner tubular construction of filter media (18, 118); the second inner tubular construction of filter media defining a second open filter interior (22, 122);

(i) the second construction of filter media being located within the first open filter interior.

(ii) the second construction of filter media being radially spaced from the first construction of filter media;

(iii) the second open filter interior defining an unfiltered fluid channel (24, 124);

(c) a plastic inner liner (16, 116) within the first open filter interior supporting the first construction of filter media;

(d) a plastic outer liner (28, 128) within the first open filter interior supporting the second construction of filter media;

(i) a filtered fluid channel (20, 120) being defined between the inner liner and the outer liner,

(e) a brace arrangement (36, 136, 136') between the first construction of filter media and the second construction of filter media;

(f) a first open end cap (50, 150);

(g) a second open end cap (56, 156);

(i) the first construction of filter media extends between the first end cap and the second end cap;

(h) a third end cap (62, 162); the third end cap being closed;

(i) the second construction of filter media extends between the second end cap and the third end cap;

(ii) the third end cap is axially spaced from the first end cap; and

(iii) the brace arrangement comprises a plurality of gussets (184) extending radially between the first open end cap and the third end cap; the brace arrangement helps to sustain opposing forces (F3, F4): (i) on the outer portion of the first open end cap compressing the first open end cap inward and towards the media; and (ii) on the inner portion of the third end cap pushing the third end cap outward and away from the second filter media."

II. With its grounds of appeal, the appellant contested the appealed decision and argued inter alia that claim 1 as granted extended beyond the content of the application as filed. Further, it requested reimbursement of the appeal fee because "the opposition division did not consider substantive arguments of the opponent and applied Article 113 EPC incorrectly".

III. With its reply, the respondent filed seven sets of amended claims as auxiliary requests 1 to 7. Claim 1 of all requests included inter alia feature (h)(iii) as currently defined in claim 1 as granted.

IV. The board expressed its preliminary opinion that claim 1 of all the requests on file appeared to infringe the requirements of Article 123(2) EPC, but it was unable

to identify a substantial procedural violation which might justify reimbursement of the appeal fee.

V. With its response to the board's communication, the respondent submitted an eighth and a ninth auxiliary request.

VI. The appellant requested that these late-filed requests not be admitted as they raised new issues under Articles 123(2) and 84 EPC.

VII. At the oral proceedings, the discussion focused on the compliance of the main request and auxiliary requests I to VII with the requirements of Article 123(2) EPC. Auxiliary requests VIII and IX were not admitted into the proceedings. The respondent filed a new auxiliary request X, which was admitted and whose claim 1 reads as follows (differences to claim 1 as granted emphasised by the board):

"*1. A filter element comprising:*

(a) a first, outer tubular construction of filter media (12, 112); the first outer tubular construction of filter media defining a first open filter interior (14, 114);

(b) a second, inner tubular construction of filter media (18, 118); the second inner tubular construction of filter media defining a second open filter interior (22, 122);

(i) the second construction of filter media being located within open filter interior;

(ii) the second construction of filter media being radially spaced from the first construction of filter media;

(iii) the second open filter interior defining an unfiltered fluid channel (24, 124);

(c) a plastic inner liner (16, 116) within the first open filter interior supporting the first construction of filter media;

(d) a plastic outer liner (28, 128) within the first open filter interior supporting the second construction of filter media;

(i) a filtered fluid channel (20, 120) being defined between the inner liner and the outer liner;

(e) a brace arrangement (~~36,~~ 136, 136') between the first construction of filter media and the second construction of filter media;

(f) a first open end cap (50, 150);

(g) a second open end cap (56, 156);

(i) the first construction of filter media extends between the first end cap and the second end cap;

(ii) the second construction of filter media is secured to the second end cap;

(h) a third end cap (62, 162); the third end cap being closed;

(i) the second construction of filter media extends between the second end cap and the third end cap;

(ii) the third end cap is axially spaced from the first end cap; and

(iii) the brace arrangement comprises a plurality of gussets (184) extending radially ***and axially*** *between the first open end cap and the third end cap;* ***the gussets (184) connect the first open end cap and the third end cap;*** *the brace arrangement helps to sustain opposing forces (F3, F4): (i) on the outer portion of the first open end cap compressing the first open end cap inward and towards the media; and (ii) on the inner portion of the third end cap pushing the third end cap outward and away from the second filter media.*"

The appellant did not reiterate its request for reimbursement of the appeal fee.

VIII. The final requests of the parties were as follows:

The appellant requested that the decision under appeal be set aside and that the patent be revoked.

The respondent requested that the appeal be dismissed and that the patent be maintained as granted, or alternatively, in amended form on the basis of one of the sets of claims according to auxiliary requests I to VII dated 3 March 2015, or according to auxiliary request VIII or IX dated 21 March 2018, or according to auxiliary request X filed during the oral proceedings before the board.

Reasons for the Decision

1. Main request - allowability under Article 123(2) EPC

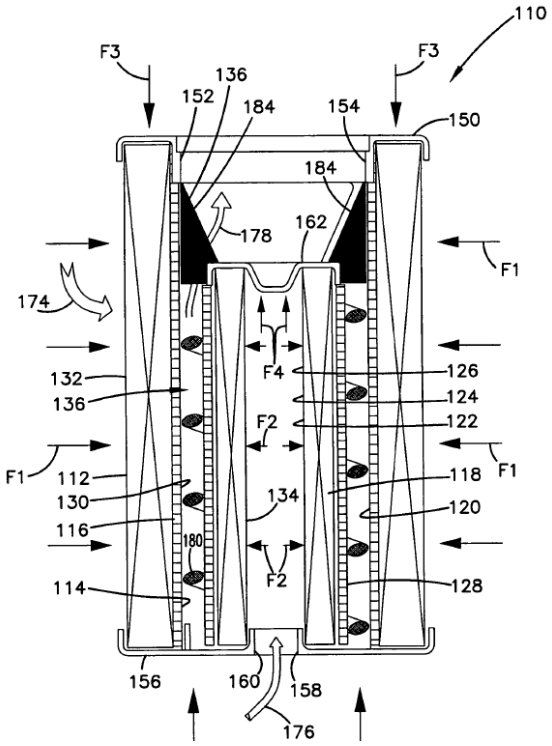
1.1 Feature (h)(iii) of the patent as granted was amended during the examination phase so as to include the feature "the brace arrangement comprises a plurality of gussets (184) extending radially between the first open end cap and the third end cap".

1.2 As there is no literal basis for this feature in the application as filed, the respondent explained that the gussets (184) were a specific embodiment of the generic feature "brace arrangement" defined in claim 1 as filed, which had the function of radially separating the first construction of filter media from the second construction of filter media. The respondent further argued that the feature of the gussets (184) radially extending between the first end cap (150) and the third

end cap (162) was directly and unambiguously derivable from figure 6 as filed.

1.3 The board recognises that the generic brace arrangement defined in claim 1 as filed has the function of radially separating the two filter constructions. In the specific embodiment illustrated in figure 6 (reproduced below), the radial separation of the two filter constructions is ensured by a spring (180) and the lower part of the gussets (184), which does not - as required by claim 1 at issue - extend radially between the first end cap (150) and the third end cap (162), but between the two filter constructions (112) and (118).

1.4 The gussets (184) illustrated in figure 6 - reproduced below - further have an upper (triangular) part which admittedly has a radial component, but this radial component cannot be seen as "extending radially between the first end cap (150) and the third end cap (162)" as alleged by the respondent.



1.5 The description as originally filed does not disclose the above disputed feature either. On its page 8, lines 28 to 30, the gussets (184) are described as acting as structural braces between the first end cap 150 and the third end cap 162; and on page 9, lines 5 to 11, they are described as helping to sustain opposing forces F3 acting on the first end cap and forces F4 acting on the third end cap, with the forces on the outer portion of the first end cap 150 compressing it inward and towards the media 112, and the forces on the inner portion of the third end cap 162 pushing it outward and away from second filter media 118. By connecting the end cap 150 to the end cap 162 with gussets 184, the forces F3 and F4 negate each other and provide a stable design.

None of these passages however is synonymous with the feature describing the gussets as "extending radially between the first end cap (150) and the third end cap (162)".

1.6 Even if, in the respondent's favour, this feature were directly and unambiguously derivable from the application as filed, its presence in claim 1 as granted in any case represents a non-allowable intermediate generalisation of the gussets (184) disclosed in the application as filed, since these are characterised not only by having a radial component, but also by having a defined axial component connecting the first end cap with the third end cap. The latter feature is not reflected by the wording of claim 1.

1.7 It follows from the above considerations that there is no direct and unambiguous disclosure of the above disputed feature in the application as filed; so claim 1 as granted infringes the requirements of Article 123(2) EPC.

2. Auxiliary requests I to VII - allowability under Article 123(2) EPC

Claim 1 of all these requests includes feature (h)(iii) of claim 1 as granted, i.e. that "the brace arrangement comprises a plurality of gussets (184) extending radially between the first open end cap and the third end cap ....".

Since this feature infringes the requirements of Article 123(2) EPC, the reasons for rejecting it (see points 1.1 to 1.7 above) apply mutatis mutandis to claim 1 of all these requests, which therefore do not meet the requirements of Article 123(2) EPC either.

3. Admissibility of auxiliary requests VIII and IX

3.1 The amendments proposed in claim 1 of both requests include the addition of the expression "and axially", such that feature (h)(iii) currently reads: "the brace arrangement comprises a plurality of gussets (184) extending radially and axially between the first open end cap and the third end cap; ..." (emphasis added).

3.2 These requests are not to be considered because the proposed amendment was not found prima facie allowable under Article 123(2) EPC for the following reasons:

First of all, there is no literal basis for said amendment in the application as filed.

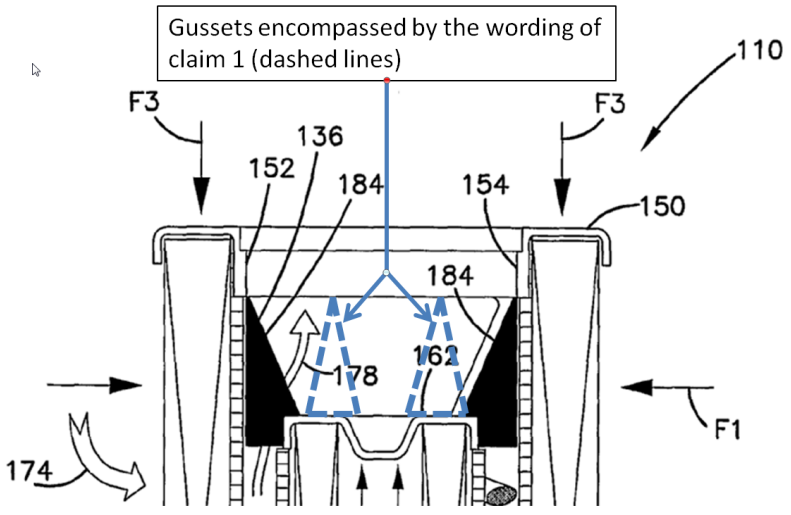
Moreover, it is manifest from figure 6 - which the respondent argued to be the basis for the proposed amendment - that the gussets (184) not only have a radial and an axial component, but also connect the first open end cap (150) and the third end cap (162).

Again, this feature is not reflected by the wording of the claims at issue.

4. Auxiliary request X - amendments

4.1 Unlike auxiliary requests VIII and IX, which were not admitted into the appeal proceedings, this request is to be considered because feature (h)(iii) in claim 1 at issue was amended so as to overcome the above prima facie deficiency, namely by specifying that "the gussets (184) connect the first open end cap and the third end cap". The respondent argued that figure 6 was the basis for this amendment.

4.2 In the course of further discussion it turned out that the proposed amendment is nevertheless not allowable under Article 123(2) EPC because it includes specific embodiments which have no basis in the application as filed. For instance, the gussets represented by dashed lines in the figure below would fall under the wording currently defined in claim 1 at issue, but there is no basis for the form and positioning of such gussets in the application as filed, in particular not in figure 6 and the corresponding parts of the description.



Therefore the proposed amendment constitutes a non-allowable intermediate generalisation of the gussets originally disclosed in the application as filed.

It follows that auxiliary request X is not allowable either.

5. Reimbursement of the appeal fee

5.1 For the board, the handling of the case by the opposition division does not justify reimbursement of the appeal fee for the following reasons.

5.2 The appellant stated in its grounds of appeal that the opposition division had ignored some of its arguments regarding independent claim 11 and so had not correctly assessed its objection under Article 123(2) EPC.

5.3 The board disagrees with this statement because it appears from the contested decision (page 5, second full paragraph) that the opponent did not provide further specific arguments regarding independent claim 11 at the oral proceedings before the opposition division. Thus the opposition division's (technical) judgement that the arguments given for claim 1 and those for claim 11 led to the same conclusions and that therefore the same reasoning applied cannot be seen as a substantial procedural violation justifying reimbursement of the appeal fee.

6. As none of the proposed requests meets the requirements of the EPC, the appeal succeeds.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The patent is revoked.

The Registrar: The Chairman:

I. Aperribay E. Bendl

Decision electronically authenticated