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**Datasheet for the decision
of 15 October 2025**

Case Number: T 1983/23 - 3.3.05

Application Number: 17817599.8

Publication Number: 3548160

IPC: B01D46/00, B01D46/24, B01D50/00

Language of the proceedings: EN

Title of invention:
FILTER ELEMENTS, AIR CLEANER ASSEMBLIES, AND METHODS OF USE
AND ASSEMBLY

Patent Proprietor:
Donaldson Company, Inc.

Opponent:
MANN + HUMMEL GmbH

Headword:
Filter Elements/DONALDSON

Relevant legal provisions:
EPC Art. 54, 123(2)
RPBA 2020 Art. 11, 12(4)

Keyword:

Amendments - main request and auxiliary requests 1 to 15 -
allowable (no)

Novelty - auxiliary requests 16 and 17 (no)

Auxiliary requests 18 to 31 - admissibly raised and maintained
(yes)

Remittal - (yes)

Decisions cited:

Catchword:



Beschwerdekammern
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Case Number: T 1983/23 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 15 October 2025

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
6 November 2023 concerning maintenance of the
European Patent No. 3548160 in amended form.**

Composition of the Board:

Chairwoman O. Loizou
Members: T. Burkhardt
R. Elsässer

Summary of Facts and Submissions

I. The appeals by the patent proprietor (appellant 1) and the opponent (appellant 2) are against the opposition division's decision to maintain European patent No. 3 548 160 B as amended on the basis of auxiliary request 17 then on file.

II. The following documents were among those discussed at the opposition stage.

| | |
|----|-----------------------|
| D1 | US 5,755,844 |
| D3 | EP 0 889 229 A2 |
| D4 | DE 10 2005 015 918 A1 |

III. The opposition division came to, *inter alia*, the conclusion that:

- the main request and auxiliary requests 1 to 15 did not meet the requirements of Article 123(2) EPC
- auxiliary request 16 met the requirements of Article 54 EPC in view of D1 but not in view of D3 and D4
- auxiliary request 17 met the requirements of the EPC.

IV. With its grounds of appeal, the opponent re-submitted auxiliary requests 16 and 17 and submitted auxiliary requests 18 to 31.

V. Claim 7 of the main request (granted version) reads as follows:

"7. The filter cartridge (125, 225) of claim 5, wherein a seal member (17j) extends from the support structure (126s, 226s)."

VI. Claim 7 of auxiliary requests 1 to 8 and claim 6 of auxiliary requests 9 to 15 also contain the feature that the "seal member [...] extends from the support structure".

VII. Claim 1 of auxiliary request 16 reads as follows:

"1. A filter cartridge (125, 225) comprising:
a. filtration media (126, 226) surrounding an open filter interior (126i, 226i) around a central axis (X) of the filter cartridge (125, 225) and extending between a first end (141, 241) and a second end (142, 242);
b. an open end cap (145, 245) coupled to the filtration media (126, 226) at the first end (141, 241), the open end cap (145, 245) having an end face (145c, 245c); and
c. a seal structure (155, 255) having an end face (155a, 255a) and an outwardly directed radial sealing surface (155s) or an inwardly directed radial sealing surface (255s),
said filter cartridge being characterized in that the seal structure (155, 255) is located entirely within the filtration media interior (126i, 226i) such that the seal structure end face (155a, 255a) is axially spaced from the open end cap end face (145c, 245c)."

VIII. Compared with claim 1 of auxiliary request 16, claim 1 of auxiliary request 17 has been restricted to "[a]n *air* filter cartridge" (emphasis added by the board).

IX. The board issued a communication under Article 15(1) RPBA, indicating its preliminary view that, *inter alia*:
- the main request and auxiliary requests 15 did not meet the requirements of Article 123(2) EPC
- auxiliary requests 16 and 17 did not meet the requirements of Article 54 EPC in view of D1

- auxiliary requests 18 to 31 were to be admitted
- the case was to be remitted to the opposition division for further prosecution

X. The arguments put forward by the patent proprietor during the appeal proceedings can be summarised as follows.

The main request and auxiliary requests 1 to 15 met the requirements of Article 123(2) EPC.

Auxiliary requests 16 and 17 met the requirements of Article 54 EPC in view of D1.

Auxiliary requests 17 to 31 should be admitted into the appeal proceedings.

The case should be remitted to the opposition division for further prosecution.

XI. The arguments put forward by the opponent during the appeal proceedings can be summarised as follows.

The main request and auxiliary requests 1 to 15 did not meet the requirements of Article 123(2) EPC.

Auxiliary requests 16 and 17 did not meet the requirements of Article 54 EPC in view of D1, D3 and D4.

Auxiliary requests 17 to 31 should not be admitted into the appeal proceedings.

The case should not be remitted to the opposition division for further prosecution.

XII. Requests

The patent proprietor requested that the decision under appeal be set aside and the patent be maintained as granted (main request) or, in the alternative:

- that the patent be maintained in amended form on the basis of one of auxiliary requests 1 to 16, or
- that the opponent's appeal be rejected (auxiliary request 17), or
- that the patent be maintained in amended form on the basis of one of auxiliary requests 18 to 31

The proprietor also requested that the case be remitted to the opposition division for further prosecution of auxiliary requests 18 to 31.

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

Reasons for the Decision

Main request

The main request is the granted version of the patent.

Since the main request does not comply with the requirements of Article 123(2) EPC, the question of its admission raised by the opponent need not be answered.

1. Article 100(c) in combination with Article 123(2) EPC

1.1 Claims 7 to 9

For the reasons set out below, the subject-matter of claim 7 (and thus also that of claims 8 and 9, which depend on claim 7) extends beyond the original disclosure.

The feature

"the seal member extends from the support *frame*" of claims 7 and 16 as originally filed has been replaced in claim 7 by

"a seal member (17j) extends from the support *structure* (126s, 226s)" (emphases added by the board).

The opposition division's view that this replacement goes beyond the original disclosure is correct.

The terms "support *frame*" and "support *structure*" do not have the same meaning.

It has not been disputed that a "support frame" is only disclosed in the claims of the application as originally filed, not in the description.

On appeal, the patent proprietor merely alleged that this replacement related at most to a clarity issue due to possibly misleading reference numbers in the claims.

On appeal, it has neither indicated the basis for the replacement nor why the opposition division's view was incorrect. It has not contested that:

- a seal member extending from a support structure is only disclosed in paragraph [0072] of the application as originally filed
- this paragraph relates to the secondary filter cartridge 27 (the description of which starts in

paragraph [0068] as filed), whereas the claims cover the primary filter cartridge 25/125

- paragraph [0072] related to the first embodiment, the primary filter cartridge of which comprises a "serviceable seal surface component 17" (see Figures 1 to 9 and the description from paragraph [0049] to paragraph [0073] as filed)

- there was no basis for transferring the teaching of the seal from the secondary to the primary filter cartridge, let alone to the other embodiments (e.g. to the second embodiment with a "remote sealing structure 155" as described in paragraphs [0074] to [0078] and in Figures 10 to 13 as filed)

The opposition division's view is correct. The general statement on the use of similar reference numbers for the different embodiments (paragraph [0074] of the application as originally filed) is not sufficient to shift the teaching of the seal from the secondary to the primary filter cartridge, let alone to the other embodiments.

Since the application as filed must not be used as a reservoir (Case Law of the Boards of Appeal of the EPO, 11th edn., 2025, II.E.1.6.1), claims 7 to 9 go beyond the original disclosure.

1.2 Claim 1

While the definition of the interior of the filtration media in part a. of claim 1 as granted, namely,

"filtration media (126, 226) surrounding an open filter interior (126i, 226i) around a central axis (X) of the filter cartridge (125, 225)"

differs from that in claims 1 and 10 as filed, namely,

"filtration media defining an interior area", the opposition's view is correct that this amendment is based on paragraph [0057] as filed.

Paragraph [0057] as filed belongs to the "First Filter Arrangement Embodiment" (starting in paragraph [0049] as filed). Statements in the description as to similarities to the other embodiments (e.g. paragraphs [0074], [0079], [0088] and [0092] as filed) make clear that the definition in paragraph [0057] as filed also applies to these embodiments. In fact, the other embodiments differ in their seal structures and/or the presence of a safety filter cartridge, rather than in the respective positions of the "filter interior" and the "filtration media".

Moreover, the additional expression "the seal structure [...] is located entirely within the filtration media interior" in claim 1 makes it clear that a situation where the seal structure axially extends beyond the filtration media (situation depicted in the first picture of page 10 of the opponent's grounds of appeal) does not fall under claim 1. This can therefore not be a reason that claim 1 goes beyond the original disclosure.

Auxiliary requests 1 to 15

2. Article 123(2) EPC

Claim 7 of auxiliary requests 1 to 8 and claim 6 of auxiliary requests 9 to 15 have the same issue as claim 7 of the main request.

Hence, these requests do not meet the requirements of Article 123(2) EPC either, the question of their admission notwithstanding.

Auxiliary request 16

Auxiliary request 16 corresponds to the main request with dependent claims 7 to 9 being deleted.

3. Novelty

For the reasons set out below, the subject-matter of claim 1 does not meet the requirements of Article 54 EPC in view of **D1**.

3.1 The "seal structure" of D1, which is construed as lip 46 of gasket 4D of Figure 8, is located entirely within the "filtration media" interior, which is construed as the interior of tubular element 2.

3.2 The patent proprietor held the view that the "seal structure" of claim 1 had to be an entire piece, not only a sealing portion of a piece that may have other portions not located within the filtration media interior.

However, the opposition division is correct in that the claim has to be construed in a broad manner and that in the circumstances of the case at hand the seal structure can be a sealing portion of a larger piece.

Such an interpretation is confirmed by claim 4 of auxiliary request 16, which requires that the seal structure, the extension member and the open end cap be "integrally formed as a singular component", with the

extension member and the open end cap not necessarily being entirely within the filtration media interior.

- 3.3 The patent proprietor also holds the view that the filter cartridge of D1 does not *comprise* the seal structure. In the patent proprietor's view, this would mean that there had to be a kind of association between the filter cartridge and the "seal structure", e.g. that the seal structure had to be attached to the filter cartridge, not to the filter housing. In D1, however, the seal was attached to the housing (D1, column 8, lines 17 to 19).

However, claim 1 does not require a specific kind of connection/attachment between the filter cartridge and the seal structure.

Moreover, while stopper 371 in Figure 8 prevents gasket 4/4D (with lip 46) from being removed from projection 37 during normal use, this does not mean that it is not possible to separate gasket 4 from the housing (here from projection 37). In fact, gasket 4 is made from a compressible material ("compressed resiliently", e.g. column 9, line 67) and is thus suitable to be "fitted over an outer peripheral surface 370 of the projection 37 in the direction of arrow 'S1' of the drawing" (column 9, lines 19 to 33).

This finding is further supported, as the opponent noted, by the fact that while claim 1 requires that "the open end cap" (feature b.) is "*coupled* to the filtration media" (feature a.), there is no such requirement for the "seal structure" (feature c.).

Under the circumstances of the case in hand, the cartridge of D1 (tubular element 2 of Figure 8) can be considered to comprise the seal structure (lip 46).

- 3.4 Consequently, D1 anticipates the subject-matter of claim 1 (Article 54 EPC).

Auxiliary request 17

Compared with claim 1 of auxiliary request 16, claim 1 of auxiliary request 17 has been restricted to an "air filter cartridge" (emphasis added by the board).

4. Novelty

The opposition division held auxiliary request 17 allowable.

However, **D1** is directed to an "air cleaner" (column 1, lines 5 and 6) and therefore still anticipates subject-matter of claim 1.

Consequently, auxiliary request 17 also has to fail.

Auxiliary requests 18 to 31

5. Admission

Auxiliary requests 18 to 31 were submitted for the first time with the patent proprietor's grounds of appeal. They correspond, respectively, to auxiliary requests 2 to 15 with dependent claims 7 to 9 (auxiliary requests 2 to 24) or claims 6 to 8 (auxiliary requests 25 to 31) being deleted.

Concerning their subject-matter, auxiliary requests 18 to 31 correspond to a multitude of permutations of different constructional combinations (like auxiliary requests 2 to 15) of the following features:

- (a) mandatory presence of an outwardly directed radial sealing surface
- (b) the seal structure seals against baffle 114, the baffle possibly being a portion of the outlet tube 15
- (c) presence of further pieces of equipment: a housing, a side wall, an access cover, a dust/water injector, etc.
- (d) the outlet tube is (snap-fit) attached to the housing
- (e) presence of an extension member, possibly with two segments (152c, 152d) resulting in an annulus 152f in between
- (f) the baffle 114 is received in the annulus

While auxiliary requests 8 to 31 were submitted for the first time at the appeal stage, the patent proprietor had announced its intention to maintain them at the oral proceedings before the opposition division (see the last three paragraphs of page 1 of the minutes). The parties and the opposition division agreed that these requests in which dependent claims 7 to 9 had been deleted would be considered during the discussion to correspond to auxiliary request 16 onwards and that they could be submitted afterwards. A discussion took place, however, only for auxiliary requests 16 and 17, not for auxiliary requests 18 to 31. This was no longer necessary since the opposition division held auxiliary request 17 allowable.

The board therefore finds that these auxiliary requests were, under the circumstances of the case at hand,

raised and maintained in the proceedings leading to the decision under appeal and that the patent proprietor could therefore expect auxiliary requests 18 to 31 to be discussed if necessary, as is the case now in appeal.

Regarding the objection of lack of substantiation of these requests, the board is satisfied that the patent proprietor, which submitted these requests with its grounds of appeal, substantiated them only in its reply. Indeed, they are related to the defence against the opponent's appeal, not to the patent proprietor's appeal.

For these reasons, auxiliary requests 18 to 31 are admitted (Article 12(4) RPBA).

Remittal to the department of first instance

6. During the first-instance proceedings, the opposition division interpreted the fact that the filter cartridge *comprises* the seal structure narrowly (see point II. 2.1.5). Because of this narrow interpretation, the opposition division considered that auxiliary request 17 met the requirements of Articles 54 and 56 EPC. Therefore, it was not necessary to discuss the objections raised in view of clarity, intermediate generalisation and inventive step for auxiliary requests 18 to 31.

As a consequence, these aspects now need to be discussed with the parties for the first time. Moreover, it is obvious that these discussions cover a multitude of combinations of features (see items (a) to (f) in point 5. above).

The board considers that these aspects amount to special reasons within the meaning of Article 11 RPBA, and, in exercising its discretion, the case is remitted to the department of first instance, in line with the patent proprietor's request.

7. In the event of remittal, the opponent requested that this decision comment on novelty in view of D3 and D4, possibly in an *obiter dictum*.

However, the board's duty, after having heard the issues raised by the parties, is to provide a reasoned decision addressing those issues and not to refer to matters not at issue. In view of the above findings regarding novelty, it is not necessary for the outcome of the decision to deal with novelty over D3 and D4. On the contrary, it appears preferable that this issue be heard and assessed in opposition and appeal proceedings should this become necessary.

Consequently, this request is rejected.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairwoman:



C. Vodz

O. Loizou

Decision electronically authenticated