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**Datasheet for the decision
of 6 April 2011**

Case Number: T 0618/07 - 3.3.07

Application Number: 99937218.8

Publication Number: 1096991

IPC: B01D 65/00

Language of the proceedings: EN

Title of invention:

Bridge apparatus for replacing a separation module and system including the same

Patent Proprietors:

Entegris, Inc.

Opponents:

Pall Corporation

Headword:

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Relevant legal provisions:

EPC Art. 123(2)

Relevant legal provisions (EPC 1973):

EPC Art. 54, 84

Keyword:

"Amendments - allowable (yes) - Main Request"

"Novelty (no) - Main Request"

Decisions cited:

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Catchword:

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Case Number: T 0618/07 - 3.3.07

DECISION
of the Technical Board of Appeal 3.3.07
of 6 April 2011

Appellants:
(Patent Proprietors) Entegris, Inc.
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Representative: Ricker, Mathias
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Respondents:
(Opponents) Pall Corporation
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Representative: Wössner, Gottfried
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
5 February 2007 concerning maintenance of
European patent No. 1096991 in amended form.

Composition of the Board:

Chairman: J. Riolo
Members: G. Santavicca
M.-B. Tardo-Dino

Summary of Facts and Submissions

- I. The appeal by the patent proprietors lies from the interlocutory decision of the Opposition Division maintaining European patent 1 096 991 (application N° 99 937 218.8, originating from international application PCT/US99/15462, published as WO 00/02650), according to which, account being taken of amended Claims 1 to 8 of Auxiliary Request 4 and of a description adapted thereto, both submitted at the oral proceedings held on 8 November 2006, the patent and the invention to which it relates were found to meet the requirements of the EPC. The decision also gave the reasons for refusing the Main Request (granted patent) and Auxiliary Requests 1 to 3, also submitted at the said oral proceedings.
- II. An opposition had been filed to seek revocation of the patent in its entirety, on the grounds that the claimed subject-matter extended beyond the content of the application as filed (Article 100(c) EPC) and lacked novelty and an inventive step (Article 100(a) EPC), *inter alia* having regard to the following documents:
D1: US-A-4 174 231;
D3: EP-A-0 818 228.
- III. According to the decision under appeal:
(a) The claimed subject-matter of the Main Request (patent as granted) did not extend beyond the content of the application as filed (Articles 100(c) and 123(2) EPC) but the subject-matter of Claim 4 was not novel (Article 54 EPC 1973) over the disclosure of D1.

- (b) The claims of the First Auxiliary Request were allowable too under Article 123(2) EPC. The subject-matter of Claim 1, however, lacked an inventive step over the combination of D3, as the closest prior art, and D1 (Article 56 EPC).
- (c) Claim 1 of each of the Second and Third Auxiliary Requests was not sufficiently clear (Article 84 EPC 1973).
- (d) The claims of the Fourth Auxiliary Requests were allowable under Article 123(2) EPC and their subject-matter was not obvious (Article 56 EPC).

IV. In their statement setting out the grounds of appeal, the appellants enclosed a new Main Request, made up of 9 claims, Independent Claim 4 reading as follows (Compared to Claim 4 as granted, deleted features are shown in strike-through, added features in bold):

"4. A connector apparatus adapted to replace a separation module (2) having a body configured to be received by a fluid dispensing system ~~used in industrial manufacturing processes~~ **for the point of use (POU) purification of photochemicals used in the microelectronics manufacturing industry** which includes a means (4) for pumping said fluid and said separation module (2), comprising inlet means (21a) and outlet means (21a) on an outside surface of said connector apparatus (40) which have the same configuration as inlet means (21) and outlet means (21) on an outside surface of said separation module (2) which is replaced by said connector apparatus (40), wherein said connector apparatus (40) comprises a body supporting the inlet means (21a) and outlet means (21a) and configured to be received by the fluid dispensing

- system, and wherein the inlet means (21a) and outlet means (21a) of said connector apparatus (40) are in fluid communication by an open fluid pathway (42-45) formed therein which is free of a filtration means.".
- V. The opponents (respondents) commented on the appeal with letter of 23 October 2007.
- VI. The parties were summoned to oral proceedings to be held on 28 April 2011 (EPO communication posted on 28 January 2011).
- VII. By letter dated 10 February 2011, the appellants withdrew their request for oral proceedings, announced that they would not attend oral proceedings on 28 April 2011 and requested a decision on the written record.
- VIII. In a communication dated 22 February 2011, in response to the letter of the appellants dated 10 February 2011, the Board indicated that oral proceedings were for the time being maintained and conveyed the provisional opinion of the Board, in particular on why novelty of Claim 4 of the Main Request, having regard to D1, needed to be debated and decided.
- IX. In their response to the communication of the Board (letter of 25 February 2011), the appellants confirmed their request for a decision on the written record.
- X. The respondents informed the Board that they would not take part in the oral proceedings (Letter dated 2 March 2011).

XI. Since none of the parties would attend the set oral proceedings and since a decision on the written record was requested by the appellants, the Board, by their communication faxed on 5 April 2011, cancelled the oral proceedings, closed the debate and informed the parties that their written decision would be issued soon.

XII. The appellants (patent proprietors) have essentially argued as follows:

Main Request

Amendments

The specific suitability for the use defined in Claim 4 of the Main Request was disclosed in the application as filed, so that no concerns in regard to Articles 84 and 123(2) EPC arose.

The subject-matter of Claim 4

Claim 4 of the Main Request explicitly required that the connector apparatus adapted to replace a separation module be suitable for the "point of use (POU) purification photochemicals used in microelectronics manufacturing industry". Hence, an apparatus which otherwise possessed all features specified in the claim but which would be unsuitable for the stated purpose or would require modification to be enable it to be so used, was not relevant. This was to be considered having regard to D1, which related to the parallel development in a completely unrelated technical field, namely that of combustion engines. In fact, starting

from D1, only by applying hindsight one could arrive at the subject-matter of Claim 4.

XIII. The respondents (opponents) have essentially made reference to the decision under appeal (according to which the subject-matter of Claim 4 as granted lacked novelty over D1) as well as to their submissions in the opposition proceedings (according to which the subject-matter of Claim 4 as granted lacked novelty over D1 because internal combustion engines were not only used to drive a motor car but were also regularly integral parts of industrial manufacturing processes where the engine was kept stationary coupled to a manufacturing environment) (Notice of opposition, page 5, second full paragraph).

XIV. The appellants (patent proprietors) requested that the decision under appeal be set aside and the patent be maintained on the basis of the Main Request submitted with their statement setting out the grounds of appeal.

XV. The respondents (opponents 02) requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

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2. The patent proprietors are the sole appellants against an interlocutory decision maintaining their patent in the amended form of the Fourth Auxiliary Request. Hence,

neither the Board, nor the non-appealing opponents, could challenge maintenance of the patent so amended (Case Law of the Boards of Appeal of the EPO, 6th edition 2010, VII.E.6.1).

Main Request

Amendments

3. Compared to Claim 4 as granted, Claim 4 according to the Main Request comprises the amendment "for the point of use (POU) purification of photochemicals used in the microelectronics manufacturing industry" to replace the feature as granted "used in industrial manufacturing processes".
 - 3.1 As pointed out by the appellants, the amendment has a basis on page 7, lines 4 to 6, of the application as filed (WO-A-00/02650).
4. This only amendment concerns an indication of an application of the claimed apparatus, which thus should be suitable for that application.
5. As a matter of fact, the amendment directly concerns the fluid dispensing system in which the connector apparatus of Claim 4 has to be received, thus only indirectly the claimed connector. Moreover, it is not clear at all what further structural limitations, if any, other than the disclosed identity of the connection means of connector and separation module, is thereby imparted to the connector.

5.1 Consequently, the amendment in Claim 4 is nothing more than a generic indication of a purposive application, which cannot clearly further limit the structure of the connector (Article 84 EPC).

5.2 As the appeal fails for lack of novelty, the Board need not detail further why Claim 4 is formally allowable.

Novelty

6. D1 was dealt with in the decision under appeal, as a novelty-destroying document for the subject-matter of Claim 4 as granted.

6.1 The Board shares the view of the Opposition Division that D1 directly and unambiguously discloses all of the structural features of Claim 4 as granted (as well as of Claim 4 according to the Main Request), in combination, for the following reasons.

6.2 The adaptor fitting 30 of D1 (Figure 3) is a connector apparatus as defined in Claim 1, which is adapted to replace a separation module 14 (Figure 1) having a body configured to be received by a fluid dispensing system (the Board here shares the view of the Opposition Division as given in point 2.2, paragraph bridging pages 11 and 12) which includes a motor pump and said separation module, the adaptor comprising inlet means 38 and outlet means 35 (Figure 3) on an outside upper surface of the adaptor, which inlet and outlet means have the same configuration as the inlet and outlet means on the outside upper surface of separation module 14 (Figure 1) to be replaced by adaptor 30, the adaptor 30 comprising a body 34 supporting the inlet and outlet

means 38,35 and configured to be received by the oil dispensing system, and wherein the inlet and outlet means of the adaptor 30 are in fluid communication by an open fluid pathway 38-32-35 formed therein which is free from a filtration means (Figure 4) (attention is also drawn to the detailed description of the mentioned figures of D1, namely column 1, lines 8-9; column 2, lines 3-22, 47 and 63-68; column 3, lines 1-40).

- 6.3 The only distinction between the apparatus of Claim 4 of the Main Request and that of D1 is the mention of the suitability for the intended application, i.e. for a fluid dispensing system "for the point of use (POU) purification of photochemicals used in the microelectronics manufacturing industry".
- 6.4 This statement of purpose requires that the claimed apparatus be in a form which would render it suitable for the stated use, e.g. that the connections of the connector apparatus claimed be identical to those of the separation module to be replaced.
- 6.5 Apart from said required identity of the connections, which is also fulfilled by the adaptor of D1, the defined statement of purpose or point of application of the dispensing system does not clearly define any further structural limitations such as a different size, a different shape, a different filtering means, further or different connections, etc., that are not present in the adaptor of D1.
- 6.6 It follows from the foregoing that the adaptor of D1, which is suitable for use in a system which has to be flushed and fulfils the objective of replacing, without

consuming expensive filtering means, a separation apparatus with a filter element, is in a form which is suitable for the generically stated use of the system, though it has never been described for that use.

6.7 Therefore, the adaptor of D1 takes away the novelty of the apparatus of claim 4 of the Main Request.

7. Consequently, the Main Request is not allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

J. Riolo