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**Datasheet for the decision
of 25 February 2013**

Case Number: T 1910/09 - 3.3.05

Application Number: 04743118.4

Publication Number: 1635930

IPC: B01D 53/26

Language of the proceedings: EN

Title of invention:

Air dryer cartridge

Patentee:

WABCO GmbH

Opponents:

MAHLE International GmbH
Haldex Brake Products GmbH

Headword:

Air dryer cartridge/WABCO

Relevant legal provisions:

EPC Art. 52(1), 54(1)(2)
RPBA Art. 13(1)(3)

Keyword:

"Novelty (no, main request)"
"Admissibility of auxiliary requests filed after oral
proceedings have been arranged (no)"

Decisions cited:

T 1685/07

Catchword:

-



Case Number: T 1910/09 - 3.3.05

DECISION
of the Technical Board of Appeal 3.3.05
of 25 February 2013

Appellant:
(Patent Proprietor)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted 15 July 2009
revoking European patent No. 1635930 pursuant
to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman: G. Raths
Members: B. Czech
P. Guntz

Summary of Facts and Submissions

- I. The appeal is from the decision of the opposition division revoking European patent No. 1 635 930.
- II. In the contested decision, the opposition division considered the following prior art documents:
- D3: US 5 427 609 A
D16: DE 1 619 872 A
D17: US 3 464 186 A
- III. The patent was revoked by the opposition division on the grounds that the subject-matter of the respective claims 1 according to all requests then on file either lacked novelty over the cited prior art or that the amendments to the claims did not meet the requirements of Article 123(2) EPC.
- IV. More particularly, claim 1 according to the first auxiliary request then on file, was found to lack novelty over each of documents D3 and D17.

Claim 1 according to said first auxiliary request then on file reads as follows:

"1. A vehicle air dryer cartridge (10) having an inlet connectable to a compressed air source, an outlet connectable to a reservoir and a desiccant (18) provided intermediate of the inlet and the outlet adapted to remove moisture from air passing through the air dryer, wherein the air dryer cartridge further includes a coalescing means (20) to capture oil droplets present in air received from the source, and

characterised in that the coalescing means (20) is positioned downstream of the desiccant(18)."

- V. Moreover, concerning the disclosure of document D16, the opposition division stated the following (see point 2.2.4 c) of the reasons):

"In view of the Opposition Division, the term "cartridge" signifies a prefabricated subassembly that can easily be installed in or removed from a larger equipment. In D16, the term "cartridge" is used only to designate the vessel (k,k1) which contains an oil coalescing medium. However the Opposition Division is of the opinion that the steel pressure vessel (a) constitutes itself also a prefabricated subassembly that can easily be installed in or removed from a larger equipment by connecting the inlet/outlet flanges of said vessel to said larger equipment. So according to the signification of the term "cartridge" given above by the Opposition Division, the steel pressure vessel (a) can be considered as being a cartridge."

"Furthermore a second cartridge may be part of a first cartridge when said second cartridge needs to be replaced more often than said first cartridge. Obviously the way of fastening the said first and second cartridges to their respective fluid flow connections may vary as it is the case in D16."

Concerning novelty of the subject-matter of claim 1 according to said first auxiliary request then on file, the opposition division came to the following conclusions:

"The apparatus of D16 is not explicitly defined as being a vehicle air dryer cartridge, so the subject-matter of claim 1 is new over D16 (Article 54(1) and (2) EPC)."

"However the following reasoning, **which is not part of the present decision**, can be made:

same reasoning as under points 2.2.4 c).

The Opposition Division is of the opinion that new feature "vehicle air dryer cartridge" is equivalent to the feature "air dryer cartridge for a vehicle" that means suitable for a vehicle (see Guidelines III. 4.13). The utilisation of the air dryer cartridge disclosed in D16 is not limited to a particular application, it can be employed anywhere where a separation of water and oil out of an air flow is desired. The term vehicle is quite large and may refer not only to cars but also to big and heavy trucks."

"So the Opposition Division considers the air dryer cartridge as described in D1 6 as being suitable for a vehicle. So the air dryer cartridge described in D16 anticipates all the features of the vehicle air dryer cartridge according to claim 1."

VI. Under cover of its statement setting out the grounds of appeal filed on 25 November 2009, the appellant (proprietor of the patent) filed nine sets of amended claims as a main request and first to eighth auxiliary requests. It held *inter alia* that the claimed subject-matter was novel over documents D3 and D17, but did not address document D16.

VII. In their respective replies, respondent I (opponent 2)

and respondent II (opponent 3) both questioned the admissibility of the appeal, at least with respect to the appellant's main request.

With regard to the auxiliary requests, they questioned the allowability of the amendments proposed under Article 123(2) EPC and the clarity of some of the added features.

Novelty objections were maintained or raised against the respective independent claims 1 according to all requests based on documents D3, D16 and D17.

- VIII. The parties were summoned to oral proceedings to be held on 27 February 2013. In a communication issued in preparation for the oral proceedings, the board *inter alia*
- gave a positive preliminary opinion concerning admissibility of the appeal;
 - expressed "strong doubts as to the novelty of the subject-matter of claim 1 at issue over the disclosure of document D16, *inter alia* because it is not apparent why the device disclosed in D16 should not be considered as a "vehicle air dryer cartridge";
 - addressed issues under Article 123(2) EPC;
 - questioned the clarity of some of the amendments in the claims according to the auxiliary request; and
 - expressly drew the parties' attention to the provisions of Articles 12 and 13 RPBA.

- IX. In its letter of 25 January 2013 referring to the board's communication, the appellant expressly withdrew its request for oral proceedings and its representative confirmed that he would not attend any such hearing.

Under cover of the same letter, the appellant filed two sets of amended claims as new first and second auxiliary requests replacing all the auxiliary requests previously on file. The appellant held that the amendments made were allowable and that the claimed subject-matter was not disclosed in the prior art including D16.

Claim 1 according to said new first auxiliary request has the following wording (amendments made to claim 1 according to the main request made visible by the board):

*"1. A vehicle air dryer cartridge (10) having an inlet connectable to a compressed air source, an outlet connectable to a reservoir and a desiccant (18) provided intermediate of the inlet and the outlet adapted to remove moisture from air passing through the air dryer, **characterized in that** ~~wherein~~ the air dryer cartridge further includes a **single** coalescing means (20) to capture oil droplets present in air received from the source, ~~and characterised in that~~ the **single** coalescing means (20) **being** ~~is~~-positioned downstream of the desiccant(18)."*

Claim 1 according to said new second auxiliary request differs from claim 1 according to the new first auxiliary request in that the following wording was appended to the latter:

", and in that the coalescing means (20) comprise a plurality of substantially circular sheets of filter paper which coalesce the droplets into larger droplets which are temporarily retained on the fibres of the

- filter paper sheets for subsequent removal and hence are not absorbed by the filter papers sheets".*
- X. On 28 January 2013, respondent II requested a decision in writing but maintained its auxiliary request for oral proceedings as a precautionary measure. It upheld its objections regarding the alleged lack of novelty of the subject-matter of claim 1 according to the main request at issue. Moreover, referring to Article 13(1) and (3) RPBA, it questioned the admissibility of the new auxiliary requests of the appellant in view of their late filing. Furthermore, it held that the amendments to the respective claims 1 of the new auxiliary requests 1 and 2 gave rise to a lack of clarity (Article 84 EPC) and did not meet the requirements of Article 123(2) EPC. Respondent II also referred to decision T 1685/07 of 4 August 2010.
- XI. In a letter dated 4 February 2013, respondent I also maintained its auxiliary request for oral proceedings and raised objections against the claims according to the two new auxiliary requests of the appellant, inter alia on the grounds that the respective amended claims 1 lacked clarity and did not meet the requirements of Article 123(2) EPC.
- XII. On 7 February 2012 the board informed the parties by telefax (confirmation letter posting date 12 February 2013) that the oral proceedings had been cancelled and that "a reasoned decision in writing will be issued without delay".
- XIII. No further written submissions were received by the board until the 25 February 2013, on which day the

board, after deliberation, took the present decision.

XIV. Insofar as they concern the pending requests of the appellant and the issues dealt with in the present decision, the arguments of the parties can be summarised as follows:

With regard to the novelty of the subject-matter of claim 1 according to its main request, the **appellant** *inter alia* took the following view: "D16 does not disclose a vehicle desiccant air drier cartridge. D16 instead discloses a body containing a desiccant having an inlet and an outlet, the body further being provided with a removable oil coalescing cartridge. D16 thus discloses an air drier having an oil coalescing cartridge. This is different from a vehicle air drier cartridge und thus D16 cannot be held novelty destroying."

Concerning its two auxiliary requests at issue, the appellant stated that they were filed in the interest of procedural efficiency.

The feature "*single coalescing means*" added to the respective claims 1 was derivable from the application as a whole and the features "*... plurality of substantially circular sheets of filter paper ...*" added to claim 1 according to the second auxiliary request found a literal basis in the original PCT specification. D16 did not disclose a vehicle air drier cartridge with all the features of the claims at issue.

Respondent I (opponent 2) and **respondent II** (opponent 3) both questioned the admissibility of the appeal, at

least with respect to the appellant's main request, since the statement of grounds of appeal did not address the issue of novelty over document D16.

Both respondents agreed with the negative finding of the opposition division concerning lack of novelty of the subject-matter of claim 1 according to the main request at issue over the disclosure of *inter alia* document D16.

Respondent 2 submitted that the auxiliary requests 1 and 2 at issue should be disregarded pursuant to Article 13(1) and (3) of the RPBA in view of their belated filing.

Moreover, both respondents considered that insertion of the - allegedly implicit - features "*single coalescing means*" into the respective claims 1 according to both auxiliary requests gave rise to additional questions concerning the clarity of the amended claims and the disclosure of their subject-matter in the application as filed. Said claims were thus objectionable under both Article 84 and Article 123(2) EPC.

Respondent II also noted that the amendments proposed diverged from the ones proposed according to the auxiliary requests previously on file.

- XV. The appellant requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the claims according to the main request filed on 25 November 2009 or, in the alternative, on the basis of the claims according to

one of first and second auxiliary requests filed on 25 January 2013.

The respondents both requested that the appeal be dismissed.

Reasons for the Decision

Admissibility of the appeal

1. Rule 99(2) EPC stipulates that in order for an appeal to be found admissible, the statement of grounds of appeal must contain an indication of the reasons for setting aside the decision impugned.
 - 1.1 In their replies to the appellant's statement of grounds, both respondents considered that the appeal was not admissible, with respect to the appellant's main request, since said statement of grounds did not indicate why the opposition division's reasoning concerning lack of novelty over D16 was wrong.
 - 1.2 The board observes that concerning claim 1 of the first auxiliary request underlying the contested decision (see Summary of facts and submissions, point 4.2), which claim is undisputedly identical to claim 1 of the appellant's main request, the opposition division on the one hand expressly stated (see point 3.1.3.3 b of the reasons) that "the subject-matter of claim 1 is **new over D16**" but, on the other hand, emphasised that the subsequent reasoning concerning the **lack of novelty over D16** was "not part of the ... decision".

1.3 As already indicated by the board in its communication, this somewhat contradictory part of the decision can be understood to mean that the opposition division did not want to base the revocation of the patent, taking into account the modifications made to claim 1 in accordance with the first auxiliary request then on file, on the ground of lack of novelty over document D16, in addition to the ground of lack of novelty over each of documents D3 and D17 (point 3.1.3.3 a) of the reasons).

The respondents did not challenge this view in their respective responses to the board's communication.

1.4 Therefore, in the board's judgement, the fact that the appellant did not set out whether or not, and for which reasons, it considered the reasoning of the opposition division to be wrong with regard to the lack of novelty of the subject-matter of claim 1 according to the main request at issue over document D16 does not - as such - make the appeal inadmissible.

Moreover, the appeal is reasoned with regard to the ground upon which the opposition division had explicitly based its decision, i.e. the lack of novelty over the disclosure of documents D3 and D17.

1.5 Therefore the appeal meets the requirements of Article 108 EPC including, in particular, the requirements of Rule 99(2) EPC. Hence, the appeal is admissible (Article 110 EPC).

Main request - Novelty over document D16

2. From the appellant's written submission of 25 January

2013 (see point IX, second paragraph, above) the board understands that the appellant takes the view that the device shown in the figure of D16, which undisputedly comprises coalescing means (III; k; k1) arranged downstream of a desiccant (II) within a pressure vessel or body (a) made of steel, cannot be regarded as an air drier "*cartridge*".

2.1 In this respect, the board observes that the opposition division took position on this issue (see point 2.2.4 c) of the reasons, and point V of the present decision) and indicated the reasons for which it considered that the steel pressure vessel (a) shown in D16 could be considered as a "*cartridge*" within the broadest meaning of the term.

2.2 The appellant did not provide technical arguments in support of its assertion that the device shown in D16 was not a "*cartridge*" in the sense of claim 1. Neither did it provide arguments potentially challenging the interpretation of this term by the opposition division.

2.3 The board considers the broad interpretation of the term "*cartridge*" by the opposition division to be technically sensible and concludes that the device disclosed in D16 can indeed be qualified as being an air drier "*cartridge*".

3. Moreover, the appellant appears to consider that the feature "*vehicle*" distinguishes the claimed device from the device disclosed by D16.

3.1 However, the appellant did not specify which difference in terms of constructional features, function or size,

if any, is supposed to be implied by said feature.

3.2 The board observes that document D16 is focussed on the provision of dry and de-oiled compressed air (see e.g. page 1, the first five lines of the second paragraph, and page 3, lines 1 to 18). Moreover, D16 does not comprise indications from which it could be inferred that the disclosed device could not be used in connection with or on board of a vehicle of whatever size and/or type.

3.3 Hence, the board has no reason to depart from the finding of the opposition division, that the device disclosed in D16 is suitable for being used in connection with or on board of a vehicle.

4. Since none of the features of claim 1 at issue distinguishes the claimed device from the device disclosed in D16, the board concludes that the subject-matter of claim 1 lacks novelty (Articles 52(1) and 54(1) (2) EPC).

Admissibility of the new first and second auxiliary requests

5. The first and second auxiliary requests, replacing the seven auxiliary requests previously on file, were only filed after oral proceedings had been arranged, i.e. one month before the oral proceedings.

5.1 In the accompanying letter, the appellant stated that this course of action was taken "in the interest of procedural efficiency". This is the only statement of the appellant that can be related to the question of the admissibility of these late-filed requests.

- 5.2 However, the board does not accept this view for the following reasons:
- 5.2.1 The appellant did not indicate a reason for which this particular attempt to overcome the objections raised was only made at such a late stage of the appeal proceedings.
- 5.2.2 Filing two further auxiliary requests consisting of amended claims rather increases the complexity of the case, *inter alia* because the feature "*single*" inserted to further qualify the coalescing means cannot even be found *verbatim* in the application as filed and thus requires an additional thorough analysis of the original disclosure, including its implicit disclosure, which is often arguable.
- 5.2.3 Moreover, the amendments *prima facie* give rise to further questions concerning their allowability under Article 123(2) EPC (see the preceding paragraph) and their clarity (Article 84 EPC). This is corroborated by corresponding objections raised in the respondents' last written submissions.
- 5.2.4 Furthermore, as also pointed out by respondent II in said last written submission, the two new auxiliary requests at issue diverge (in the sense of decision T 1685/07 of 4 August 2010, reasons 6.5 and 6.6) from the auxiliary requests previously on file by virtue of the insertion of the feature "*single*" instead of features relating to constructional details of the cartridge (see *inter alia* the features "*base member*", "*casing*", "*inner container*") and/or the relative amount (see the feature "*majority of the oil droplets*") of the

oil droplets to be captured by the downstream coalescing means. Due to this amendment proposed according to the two new auxiliary requests, a further thorough revision of the prior art and the consideration of additional aspects becomes necessary.

- 5.3 Considering all these specific circumstances, the board, in the exercise of the discretion conferred on it by Article 13(1) and (3) RPBA, therefore decided not to admit the first and second auxiliary requests at issue to the appeal proceedings.

Absence of an admissible and allowable request

6. Considering that the board found that none of the appellant's requests was both admissible and allowable for the above reasons, the appeal cannot succeed.
7. The appellant's representative, as a professional knowing the legal procedural frame work of the appeal proceedings, must have been aware that by filing new requests consisting of amended claims after oral proceedings have been arranged, the appellant run the risk of having the admissibility of said late-filed new requests put into question by the adverse parties and/or by the board pursuant to Articles 12(4) and/or 13(1) RPBA.
- 7.1 By deciding, at the same time, to withdraw its request for oral proceedings, the appellant deliberately deprived himself of the opportunity to present comments in this respect at the oral proceedings to which it was duly summoned.

7.2 The appellant was made aware of the questionability of the admissibility of its late-filed requests by the written submission of respondent II of 28 January 2013 (forwarded to the appellant by the registrar of the board with a communication posted on 31 January 2013). Moreover, the parties were informed, by the board's communication posted on 12 February 2013 (see point XII above) that the board intended to issue a decision in writing. In view of the respondents' auxiliary requests for oral proceedings, it must have been obvious to the parties that the board would only dispense with oral proceedings if it intended to dismiss the appeal. For the board to issue any other decision would, in the contrary, have been a violation of the respondents' right to be heard. Nevertheless, the appellant did not file, until this day (25 February 2013) a written statement regarding the admissibility of its late filed new auxiliary request.

7.3 The board was thus in a position to reach a decision on the admissibility of the two new auxiliary requests at issue without infringing the appellant's right to be heard (Article 113(1) EPC).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

C. Vodz

G. Rath