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**Datasheet for the decision
of 6 April 2016**

Case Number: T 1641/13 - 3.3.05

Application Number: 05760294.8

Publication Number: 1771237

IPC: B01D46/52

Language of the proceedings: EN

Title of invention:
Air filter arrangement

Patent Proprietor:
Donaldson Company, Inc.

Opponent:
Mann + Hummel GmbH

Headword:
Air filter/DONALDSON

Relevant legal provisions:
EPC Art. 84, 123(2), 123(3)

Keyword:

Claims - clarity (yes)

Amendments - extension beyond the content of the application
as filed (no) - broadening of claim (no)

Remittal to the department of first instance - (yes)

Decisions cited:

Catchword:



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Case Number: T 1641/13 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 6 April 2016

Appellant: DONALDSON COMPANY, INC.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 10 May 2013
revoking European patent No. 1771237 pursuant to
Article 101(3)(b) EPC.**

Composition of the Board:

Chairman H. Engl
Members: J.-M. Schwaller
P. Guntz

Summary of Facts and Submissions

- I. The present appeal lies from the decision of the opposition division to revoke European patent No. 1 771 237 on the grounds that none of the requests then on file met the requirements of Article 123(2) and/or (3) EPC.

Independent claim 1 of the patent as granted read as follows:

"1. A z-filter media construction (303) for air filtration comprising:

- (a) a stack (201, 250) of strips (251) of filter media;*
- (i) each strip of filter media comprising a sheet of corrugated media (66) secured to a facing sheet (64);*
- (A) each strip of filter media having front and rear edges (98) and side edges extending therebetween;*
- (B) the stack (201, 250) of strips (251) defining opposite inlet and outlet flow faces (260, 261) with a set of inlet flutes (11) and a set of outlet flutes (15) extending therebetween; and,*
- (C) the stack (201, 250) of strips (251) having first and second, opposite, side faces extending between the inlet and outlet flow faces; and*

characterized by

- (b) first and second, opposite, **separately** molded side pieces (255, 256);*
- (i) the first molded side piece (255) having a first side edge (252) of each strip of filter media in the stack (201, 250) of strips (251) embedded therein, during molding of the first molded side piece (255), to seal the first side edge (252) of each strip of filter media; and,*
- (ii) the second molded side piece (256) having a second side edge (253) of each strip of media in the stack*

(201, 250) of strips (251) embedded therein, during molding of the second molded side piece (256), to seal the second side edge (253) of each strip of filter media."

- II. According to the contested decision the term "separately", for lack of specification in the description, had to be construed in its broadest sense. Thus its insertion in claim 1 resulted in adding embodiments not disclosed in the application as filed. The subject-matter of claim 1 as granted thus extended beyond the original disclosure.
- III. With the grounds of appeal dated 20 September 2013, the appellant (patent proprietor) filed nine sets of amended claims as auxiliary requests I to IX.
- IV. With its response to the grounds of appeal, the respondent (opponent) filed objections under Article 123(2) and (3) EPC against the sets of claims filed with the grounds of appeal.
- V. Oral proceedings took place on 8 May 2015. The appellant submitted modified auxiliary requests Ia and IIa and, after a discussion of these new requests under Article 123(2) and (3) EPC, it withdrew the main request and auxiliary requests I, Ia and II. Auxiliary request IIa was thus made the new main request.

Claim 1 of auxiliary request IIa (now new main request) reads as follows:

*"1. A z-filter media construction (303) for air filtration comprising:
(a) a stack (201, 250) of strips (251) of filter media;*

(i) each strip of filter media comprising a sheet of corrugated media (66) secured to a facing sheet (64); (A) each strip of filter media having front and rear edges (98) and side edges extending therebetween; (B) the stack (201, 250) of strips (251) defining opposite inlet and outlet flow faces (260, 261) with a set of inlet flutes (11) and a set of outlet flutes (15) extending therebetween; and, (C) the stack (201, 250) of strips (251) having first and second, opposite, side faces extending between the inlet and outlet flow faces; and characterized by

*(b) first and second, opposite, **separate**, molded side pieces (255, 256);*

(i) the first molded side piece (255) having a first side edge (252) of each strip of filter media in the stack (201, 250) of strips (251) embedded therein, during molding of the first molded side piece (255), to seal the first side edge (252) of each strip of filter media; and,

(ii) the second molded side piece (256) having a second side edge (253) of each strip of media in the stack (201, 250) of strips (251) embedded therein, during molding of the second molded side piece (256), to seal the second side edge (253) of each strip of filter media."

Dependent claims 2 to 19 relate to specific embodiments of the z-filter media construction according to claim 1.

Independent claim 20 relates to an air cleaner assembly comprising a z-filter media construction according to dependent claim 9, and dependent claims 21 to 23 relate to specific embodiments of the air cleaner according to claim 20.

VI. The respondent argued in particular that figure 6A was a schematic representation which showed only one side piece - the molded piece 255 - of the filter media. Further, it was not excluded from the claims as originally filed and from figure 6A that the side pieces 255 and 256 could be connected together by any kind of means not represented on Figure 6A. There was therefore no basis in the application as filed for "separate" molded side pieces as defined in claim 1 at issue, contrary to Article 123(2) EPC.

The respondent further argued that the amendment as proposed in claim 1 at issue extended the protection conferred by the patent as granted, and so infringed Article 123(3) EPC.

VII. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request, submitted as auxiliary request IIa during the oral proceedings or, in the alternative, that the case be remitted to the department of first instance.

The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. Main request - Article 123(2) EPC

1.1 The subject-matter of claim 1 at issue corresponds to claim 1 as originally filed, amended by further defining the "first and second, opposite, molded side pieces" as being "separate".

1.2 For the board, although there is no literal basis in the application as filed for the word "separate", the amendment proposed to claim 1 is directly and unambiguously derivable from Figures 6A and 6B (reproduced below), in particular when taken in combination with the corresponding explanations on pages 16 to 18 of the application as filed.

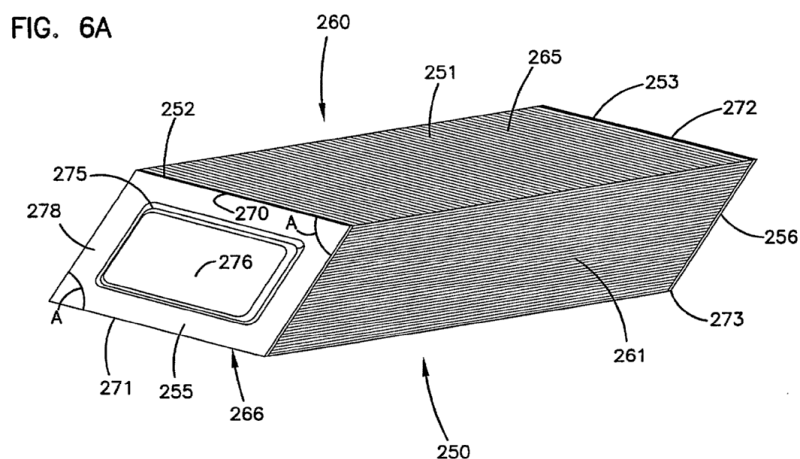
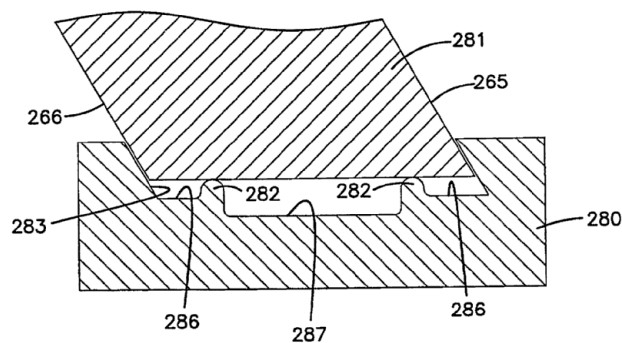


FIG. 6B



1.3 Figure 6A shows a filter media having **first and second opposite side pieces 255 and 256**. As explained at page 17, lines 28 to 31 and page 18, lines 5 to 7, of the application as filed, side piece 255 is **molded** and shows a stand-off indent arrangement 275 which is an artifact of the molding operation shown in the schematic cross-sectional view according to Figure 6B. As further explained at page 17, line 29, **an analogous**

stand-off arrangement is found in molded side piece 256
as well.

- 1.4 For the board the above disclosures are sufficient to conclude that the side pieces 255 and 256 are indeed separate. Although Figure 6A is a schematic view of the claimed filter, it is clear from both the figure and the description that the side pieces 255 and 256 are molded at the two opposite ends of the filter media and that they are unconnected. There is no indication in Figure 6A, or the description, of the presence of any connecting means between side pieces 255 and 256.
- 1.5 The above conclusion is confirmed by the molding process described in the first full paragraph at page 18 and in Figure 6B as filed, which disclose that for forming the molded end piece 255 the z-filter media is inserted into the mold arrangement 280, and a resin is introduced into the regions 286 and 287 and allowed to cure. The form of the mold is such that it is not possible for the resin to extend up the sides of the z-filter pack 250. If hypothetically the mold arrangement 280 extended to the second end of the filter media, then the resin would have to rise vertically to completely cover and enclose the flow faces 260 and 261, with the consequence that the functioning of the filter element would be impaired, because air flow through the filter would be partly obstructed.
- 1.6 For the board, the claimed subject-matter is not - as argued by the respondent - an unallowable intermediate generalisation either, since the proposed amendment is directly and unambiguously derivable from the original application documents.

- 1.7 It follows from the above considerations that the subject-matter of claim 1 is directly and unambiguously disclosed in the application documents as originally filed. The subject-matter of dependent claims 2 to 23 finds a basis in claims 2 to 23 as originally filed, respectively.
- 1.8 The claims of the main request hence satisfy the requirements of Article 123(2) EPC.
2. Main request - Article 123(3) EPC
 - 2.1 The issue to be decided here is whether or not the amendment substituting the feature "separately molded side pieces" by the feature "separate, molded side pieces" extends the protection conferred by the claims of the patent as granted.
 - 2.2 The board accepts the respondent's interpretation of the original claim term "separately molded side pieces", namely either to mean a separation in time - in the sense that the molding is not carried out simultaneously on both pieces - or space, in the sense that the end pieces are unconnected. The amendment "separate, molded side pieces" to claim 1 at issue now explicitly limits the scope of the claim to the spatial separation of the end pieces, so that no extension of protection is involved.
 - 2.3 Even if, for the sake of argument, the original term was to be construed as referring to a mandatory separation in time, the removal of the time separation component from device claim 1 would not broaden the scope of protection conferred by the amended claim, as compared with the patent as granted. From the arguments of the parties, the board does not see in which way a

filter media construction having two separate end pieces molded simultaneously could be distinguished from a filter media construction having two separate end pieces molded at separate times. Thus the process feature regarding a separation in time could have no limiting effect in the context of a product claim now limited to a device having two separate end pieces. Therefore, the scope of the claim remains unaffected by the amendment.

In summary, no extension of protection can be seen by the board and the amended claim 1 satisfies the requirements of Article 123(3) EPC.

3. Clarity (Article 84 EPC)

The respondent raised a clarity objection under Article 84 EPC against the expression "separate" in claim 1. However, the objection is in the board's view unfounded because the literal meaning of "unconnected" or "distinct" is supported both by Figures 6A and 6B and by the description of the production process, as described on pages 16 to 18, which results in separate, unconnected end pieces.

4. Remittal

Although the respondent requested that the case not be remitted to the department of first instance, the board does not accede to this request and exercises its discretion under Article 111(1) EPC to remit the case, because the contested decision concerned only the question of whether or not the claimed subject-matter met the requirements of Article 123(2) and (3) EPC; the outstanding grounds of opposition can then be examined by two instances.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution on the basis of claims 1 to 23 of the main request, filed as auxiliary request IIa during the oral proceedings.

The Registrar:

The Chairman:



C. Vodz

H. Engl

Decision electronically authenticated



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Case Number: T 1641/13 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of correcting an error in the decision
of 6 April 2016

Appellant: DONALDSON COMPANY, INC.
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Composition of the Board:

Chairman H. Engl
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In the Summary of Facts and Submissions, point V, the sentence "Oral proceedings took place on 8 May 2015" should read "Oral proceedings took place on **6 April 2016**".

The Registrar:

The Chairman



C. Vodz

H. Engl

Decision electronically authenticated