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**Datasheet for the decision  
of 19 January 2015**

**Case Number:** T 1931/13 - 3.3.05

**Application Number:** 07023233.5

**Publication Number:** 1889648

**IPC:** B01D46/24, F02M35/024

**Language of the proceedings:** EN

**Title of invention:**

Air filter element with integral radial seal gasket

**Applicant:**

Baldwin Filters, Inc.

**Headword:**

FILTER/BALDWIN

**Relevant legal provisions:**

EPC Art. 123(2), 76(1), 111(1)  
EPC R. 139

**Keyword:**

Amendments -  
extension beyond the content of the application as filed (no)  
Divisional application - subject-  
matter extends beyond content of earlier application (no)  
Correction of error -  
immediately evident that nothing else could have been  
intended (no)

**Decisions cited:**

G 0001/05, G 0003/89, G 0011/91, G 0002/95

**Catchword:**



**Beschwerdekammern  
Boards of Appeal  
Chambres de recours**

European Patent Office  
D-80298 MUNICH  
GERMANY  
Tel. +49 (0) 89 2399-0  
Fax +49 (0) 89 2399-4465

Case Number: T 1931/13 - 3.3.05

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.05**  
**of 19 January 2015**

**Appellant:** Baldwin Filters, Inc.  
(Applicant) 4400 East Highway 30  
Kearney,  
Nebraska 68848-6010 (US)

**Representative:** Hoeger, Stellrecht & Partner Patentanwälte  
Uhlandstrasse 14c  
70182 Stuttgart (DE)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted on 16 April 2013  
refusing European patent application No.  
07023233.5 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman** G. Raths  
**Members:** J.-M. Schwaller  
P. Guntz

## Summary of Facts and Submissions

I. European patent application No. 07 023 233.5 - a divisional of European patent application No. 01 203 469.0 - was filed by facsimile on 30 November 2007 with the following application documents:

- description pages 1 to 4 and 6 to 10 (facsimile pages 15/41 to 23/41);
- pages 11 to 15 containing 27 claims (facsimile pages 24/41 to 30/41);
- page 18 containing the Abstract (facsimile page 31/41);
- 8 sheets of drawings (facsimile pages 32/41 to 38/41);
- 3 sheets containing claims 1 to 16, entitled "New Set of Claims" (facsimile pages 39/41 to 41/41).

The facsimile also contained a covering letter (page 1/41), EPO form 1037.3 (page 4/41) and EPO form 1001.1 (pages 5/41 to 10/41), and fees for sixteen claims were paid.

II. In an interlocutory decision dated 19 June 2012, the examining division decided that claims 1 to 16 of the "new set of claims" were to be considered as the claims as initially filed. The examining division observed that, as set out in Article 106(2) EPC, this decision could only be appealed together with the decision terminating the examination proceedings.

III. In the final decision - dated 16 April 2013 - refusing the application at issue, the examining division observed that the interlocutory decision entered into force regarding the question whether claims 1 to 27 at pages 24/41 to 30/41 of the facsimile of 30 November 2007 could be held as the claims of the application as initially filed, and so no further decision (including a decision regarding the main request) could be taken as regards this issue.

The examining division further decided to give "no consent under Rule 137(3) EPC" to the claims according to auxiliary request I underlying the decision, and auxiliary request II was held as "not complying with Article 113(2) EPC".

IV. An appeal contesting the above decision was filed on 12 June 2013. The appellant requested in particular that page 5 of the description, which was not included initially with the application documents filed on 30 November 2007, be added to the description.

V. With the statement of grounds of appeal dated 8 August 2013, the appellant further requested (main request) that the claims as initially filed should be claims 1 to 27 as submitted by telefax of 30 November 2007, the prosecution of the application should be based on these claims, and the patent should be granted with the set of claims 1 to 8 and pages 1 to 3 of the description specification enclosed in the Appendix to the statement of grounds of appeal, with claim 1 reading as follows:

*"1. An air filter element comprising in combination: a filter pack (32) comprising a tubular filter element (35) and at least an inner supporting liner (33);*

a closed end cap (36) sealing the filter element and encapsulating one end of the filter pack (32);  
an open annular end cap (38) encapsulating the other end of the filter pack (32) and providing a formed-in-place gasket (44) thereon, the open annular end cap (38) comprising:  
a substantially stiff insert ring (42) having a base portion (41) embedded in the annular end cap (38) and a gasket-carrying flange (43) projecting from the annular end cap (38);  
the gasket-carrying flange (43) having a first gasket-carrying surface (45) projecting from the annular end cap (38) and carrying a formed-in-place foam surface for forming said gasket (44);  
the insert ring (42) also having a sealing portion (54) engaging the inner liner (33) and forming a fluid restriction (54) which restrains the foam material from filling the area (50) between the **gasket-carrying** flange (43) and the inner liner (33), and  
the annular end cap (38) being formed by a foaming urethane which encapsulates the second end of the filter pack (32) and fills a mold to form said gasket (44) while being restrained from filling the gap (50) between the **gasket-carrying** flange (43) and the inner liner (33)."

- VI. In a communication dated 21 August 2014, the board expressed its opinion that "Part I" of the above request - namely that the claims as initially filed should be claims 1 to 27 as submitted by telefax of 30 November 2007, and that the prosecution of the application should be based on these claims - could not be granted for the following reasons:

In accordance with decision G 1/05, it would have been possible to file a divisional application with the same

documents as the parent application and to amend the claims later.

Therefore, it could be assumed that this was the appellant's intention. The reasons for this assumption were as follows:

On the one hand, Form 1001 referred to 27 claims and, on the other hand, the application documents filed on 30 November 2007 contained seven pages of description called "what is claimed", the content of which corresponded literally to the 27 claims of the parent application as filed.

However, in the present case other facts clearly contradict this assumption. On 30 November 2007, the appellant paid the claims fee for 16 claims, i.e. for the "new set of claims" which accompanied the documents forming the divisional application. Furthermore it objected neither to the way the Receiving Section composed the electronic file (the "Claims" being formed by the "new set of claims" and the "old claims" being filed as "ANNEX"), nor to the notice of 23 January 2008 that the divisional application was to be published on 20 February 2008 with these claims. Moreover, with its letter of 20 March 2008, the appellant requested the correction of the published version of the application specification, but only to the extent that the missing page 5 was to be included, but not that the application contained an (allegedly) completely wrong set of claims.

Thus, the Receiving Section legitimately assumed that the set of claims intended to be filed as the claims of the divisional application was the "new set of claims", whereas the "old" claims were only submitted as a

background in order to show what had been filed originally.

In its communication, the board further confirmed the decision of the examining division refusing to add the missing page 5 to the description of the application documents. Eventually, it was of the preliminary opinion that claims 1 to 8 of the main request did not extend beyond the content of the application as filed.

- VII. With the letter of 18 December 2014, the appellant modified its main request, so that it now requests that the contested decision be set aside and that a patent be granted on the basis of the set of claims 1 to 8 (main request), or alternatively, on the basis of one of the sets of claims according to auxiliary request 1 or 2, all requests dated 8 August 2013.

### **Reasons for the Decision**

1. Concerning the request to correct the application documents as filed by the addition of missing page 5 of the description

For the board, the only way to include a missing page in the description would be to effect a correction under Rule 139 EPC.

In the present case, it is immediately apparent from the gap between pages 4 and 6 that an error occurred when filing the description. It is however doubtful whether the way the error is to be corrected is obvious in the sense that it is immediately evident that nothing else was intended than what is offered as the correction, as required by Rule 139 EPC.



Although there is a high likelihood that the appellant intended to file page 5 of the parent application, it cannot be regarded as a certainty. Furthermore, even if the way to close the gap was obvious, the Enlarged Board of Appeal has made it clear that filling gaps in an application by having recourse to sources outside this application violates Article 123(2) EPC, at least if those sources are used as more than evidence of the general knowledge of the person skilled in the art on the date of filing (see G 3/89, G 11/91, G 2/95).

Thus, since a correction of the filing documents seems to be impossible, the board confirms the examining division's refusal to correct the publication documents of the application.

2. Main request - allowability of the amendments

Apart from the double amendment of the feature "flange" into "gasket-carrying flange 43" in claim 1 (in bold in point V. above) and the addition of the reference numbers to the claimed subject-matter, claims 1 to 8 of this request correspond to claims 20 to 27 of the parent application.

For the board, the above amendments do not extend beyond the content of the application as filed, and so do not infringe the requirements of Article 123(2) EPC, because the reference numbers have their basis in the figures and the description as filed, and the feature "gasket-carrying flange 43" has its basis at page 7, lines 13 to 16 of the application as filed.

Although above claims 1 to 8 (corresponding to claims 20 to 27 of the parent application) have no basis in "new claims" 1 to 16 of the divisional application as

filed, it can be seen from pages 24/41 to 30/41 of the facsimile of 30 November 2007 that claims 1 to 27 of the parent application were initially filed as pages 11 to 17 of the description of the divisional application.

This fact was confirmed by the examining division, which mentioned - point 5 of its communication of 15 August 2012 - that claims having the exact wording of claims 20 to 27 of the parent application would overcome the problems under Article 76(1) EPC.

It follows from the above considerations that the subject-matter of the documents, in particular the subject-matter of the claims, of the divisional application as initially filed does not extend beyond the content of the earlier application as filed.

The requirements of Article 76(1) EPC are met.

3. Remittal

Since the reasons which led to the refusal of the application no longer apply, the board exercises its discretion under Article 111(1) EPC and remits the case to the examining division for further prosecution of the case.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution on the basis of claims 1 to 8 dated 8 August 2013 of the main request.

The Registrar:

The Chairman:



C. Vodz

G. Rath

Decision electronically authenticated