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**Datasheet for the decision
of 7 December 2018**

Case Number: T 1104/15 - 3.3.05

Application Number: 10178236.5

Publication Number: 2275188

IPC: B01D46/52

Language of the proceedings: EN

Title of invention:

Air filter housing having side-entry

Patent Proprietor:

Donaldson Company, Inc.

Opponent:

Baldwin Filters, Inc.

Headword:

Side entry housing/DONALDSON

Relevant legal provisions:

EPC Art. 76(1)

RPBA Art. 13(1), 13(3)

Keyword:

Late-filed auxiliary requests - justification for late filing
(no)

Late-filed request - submitted during oral proceedings -
request clearly allowable (no) - admitted (no)

Decisions cited:

T 1634/09

Catchword:



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Case Number: T 1104/15 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 7 December 2018

Appellant: Baldwin Filters, Inc.
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
31 March 2015 concerning maintenance of the
European Patent No. 2275188 in amended form.**

Composition of the Board:

Chairman E. Bendl
Members: A. Haderlein
S. Fernández de Córdoba

Summary of Facts and Submissions

- I. The present appeal of the opponent (appellant) lies from the opposition division's interlocutory decision finding that European patent No. 2 275 188 in amended form, and the invention to which it relates, meet the requirements of the EPC. In particular, it held that the then pending auxiliary request 1 complied with the requirements of Article 76(1) EPC.
- II. The patent in suit is based on a second-generation divisional application deriving from a European patent application corresponding to an International application published as WO 03/095068 A1 ("grandparent application").
- III. In the statement of grounds of appeal, the appellant objected to, amongst others, the "plurality of ribs 250" feature (see section "Feature 1.10" on page 19 of the grounds of appeal) and to features disclosed on page 17, lines 17 et seq. of the grandparent application (see section "Feature 1.15" on pages 22 and 23 of the grounds of appeal) missing from claim 1 of the auxiliary request 1 held allowable by the opposition division.
- IV. With its reply to the statement of grounds of appeal the proprietor (respondent) filed a main request and ten auxiliary requests.
- V. In a communication under Article 15(1) RPBA dated 11 October 2018, the board raised various objections under Article 76(1) EPC with respect to the main request corresponding to the request found allowable by the opposition division. In particular, the board was of the preliminary opinion that the "plurality of

ribs 250" feature referred to on page 14, lines 29 et seq. of the grandparent application was inextricably linked to the "sidewall [that] defines the edges" feature in claim 1 (see 3.12 of the communication).

VI. At the oral proceedings held on 7 December 2018 before the board, auxiliary request X filed with the grounds of appeal was discussed in particular.

The appellant raised various objections under Article 76(1) EPC in view of that request. It argued that the following feature ("feature 1.15") was disclosed on page 17, lines 14 et seq. of the grandparent application:

"If the filter element 50 is not properly seated within the housing 48 with the radial seal 142 formed, the cover 52 will be precluded or prevented from fitting or properly mounting to the body member 60."

However, this feature was disclosed in this passage only along with other features such as the projection 304 and the recess 150.

After the discussion of the then pending auxiliary request X with respect to the provisions of Article 76(1) EPC, the respondent filed a new main (sole) request and withdrew all remaining requests.

VII. The wording of claim 1 of the main (sole) request is as follows (amendments with respect to the previously pending auxiliary request X are underlined):

"1. A side entry housing (48) for an air cleaner (40) comprising a body construction (62) and a removable cover (52);

(a) the body construction (62) provides a sealing surface (176) against which a seal member (136) of a filter element (50) compresses to form a radial seal (142), the filter element includes a media pack having first and second opposite ends; the first end defines a first flow face, and the second end defining a second flow face; the first flow face corresponds to an inlet end, and the second flow face corresponds to an outlet end; the filter element includes a sealing system sealing the filter element against the housing, the sealing system includes a frame construction and the seal member; the frame construction provides a support structure against which the seal member can be compressed against to form the seal with the housing; the filter element is a wound construction, namely a coil in that a layer of filter media is rolled a series of turns around a center point, and a non-cylindrical construction, namely a race track configuration with a pair of parallel sides joined by a pair of arced or curved ends; the filter element includes a band circumscribing the wound filter construction and secured to an outer periphery adjacent to the first flow face, helping to provide a slide surface for mounting the filter element with the housing; characterized in that

(b) the body construction (62) provides a stop surface (188) adjacent to the sealing surface and angled thereto that provides for an end surface for the seal member to engage when the filter element (50) is properly seated within the housing (48);

(i) the body construction (62) includes a body member (60) an inlet construction and an outlet construction, the body member includes a curved sidewall (68, 224) extending between the inlet construction (56) and the outlet construction (58) and having a bight section forming a closed end (234) and an open end (236),

wherein the open end (236) is sufficiently large to accommodate accepting the filter element (50) therethrough, and the open end (236) corresponds to a side entry (72); and the sealing surface (176) being defined by an outlet construction housing (178) of the outlet construction (58), the outlet construction housing (178) including an outer rim (186) connecting to the body member (60), the sealing surface (176) being an annular surface adjacent to the outer rim (186); the inlet construction (56) includes an inlet construction housing (202) including an inlet duct (204) defining and [sic] inlet port (206) and defining an internal volume (208), wherein circumscribing the internal volume (208) is an outer rim (210) which interacts with and engages with the body member (60); the sidewall is curved in a shape that generally corresponds to the shape of the filter element, and the sidewall is U-shaped;

(ii) the sidewall (224) defines an inlet end (238) mounted adjacent to the inlet construction (56) and an outlet end (240) mounted adjacent to the outlet construction (58), and edges (252, 254) that extend between the inlet end and the outlet end, and wherein the edges (252, 254) define the open end (236) and interact with and engage the cover (52); and the sidewall (224) also includes a plurality of ribs (250) extending from edge (252) to edge (254);

(iii) the body member (60) includes a slide mount (260) that enables the filter element (50) to be slid through the side entry (72) along the slide mount to be conveniently and smoothly inserted through the opening (236) and oriented with the seal member (136) compressed against the sealing surface (176) to form the radial seal (142);

(iv) the slide mount (260) includes a ramp (262) having a slide surface (264) angled downwardly from the open

end (236) to the closed end (234) so that the slide surface is closer to the inlet end (238) at the open end (236) adjacent the edges (252, 254) than the slide surface (264) is to the inlet end (238) at the closed end (234);

(v) the removable cover (52) is selectively removable from the body member (60) to selectively expose and cover the side entry (72);

(A) the removable cover includes an inlet end (278) adjacent to the inlet construction (56), an opposite outlet end (280) adjacent to the outlet construction (58), and a pair of edges (282, 283) extending between the inlet end (278) and the outlet end (280);

(B) the removable cover (52) includes a curved sidewall (276) defining a ledge (292) extending toward an internal volume in the housing (48) and comprising an annular surface that extends from an element covering portion of the sidewall adjacent to the outlet end to a neck adjacent to the inlet end of the sidewall for engaging the band of the filter element (50) and supporting and stabilizing the filter element (50) wherein if the filter element (50) is not properly seated within the housing (48) with the radial seal (142) formed, the cover (52) will be prevented from fitting to the body member (60)."

VIII. The appellant's arguments, as far as relevant for the present decision, may be summarised as follows:

The respondent's main (sole) request should not be admitted into the proceedings because it did not overcome the objections raised. In particular, the features relating to the "projection 304" and the "recess 150" disclosed on page 17, lines 19 et seq. were still missing from claim 1. This had already been objected to in the grounds of appeal. Also, there was

no sound reason to file a request including the feature relating to the "ribs 250" at such a late stage while the corresponding objection had been raised as early as in the statement of grounds of appeal.

IX. The respondent's arguments, as far as relevant for the present decision, may be summarised as follows:

The amendments made in the main (sole) request take into the consideration the objections with respect to the feature concerning the "plurality of ribs 250". Not including the features regarding the "projection 304" and the "recess 150" from page 17, lines 19 et seq., does not lead to subject-matter not directly and unambiguously disclosed in the application as filed.

X. Requests

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

The respondent requested that the patent be maintained on the basis of the main (sole) request filed during the oral proceedings before the board.

Reasons for the Decision

1. Admissibility of the respondent's main (sole) request

1.1 This request was filed at the oral proceedings before the board. Its admission into the proceedings was therefore at the board's discretion (Article 13(1), (3) RPBA).

1.2 The board's discretion is to be exercised in view of, *inter alia*, the complexity of the new subject-matter,

the state of the proceedings and the need for procedural economy. According to an approach frequently adopted by the boards (see, for instance, T 1634/09, Reasons 3.2, also cited in the Case Law of the Boards of Appeal of the EPO, 8th ed., IV.E.4.2.5), a request filed at a very late stage in the proceedings may be admitted and considered at the board's discretion in particular if sound reasons exist for filing it so far into the proceedings and if the auxiliary request is clearly or obviously allowable in the sense that it overcomes the objections raised previously.

- 1.3 With respect to the previously pending main request and ten auxiliary requests, the present main (sole) request includes the feature concerning the "plurality of ribs 250".

The appellant, in its statement of grounds of appeal (see III above), had already objected to this feature missing from claim 1 of the then main request. Also, the board in its communication under Article 15(1) RPBA had objected to the omission of this feature in claim 1 of the then main request (see V above). Thus, the objection cannot be considered as unexpected or surprising to the respondent. Nor did the respondent submit any sound reason for filing the corresponding request as late as at the oral proceedings before the board.

- 1.4 Before the respondent filed the present main (sole) request, there had been a discussion concerning feature 1.15. In this discussion, the appellant reiterated an objection under Article 76(1) RPBA that it had already raised in the statement of grounds of appeal (see III above) arguing that this feature was inextricably linked to the other features disclosed on

page 17, lines 14 et seq., such as the projection 304 and the recess 150 (see VI above). It is common ground that the latter features are missing from claim 1. This request is therefore not clearly and obviously allowable in the sense that it does not clearly overcome the objections raised by the appellant, i.e. the objection under Article 76(1) EPC with respect to these features being missing from claim 1.

- 1.5 For the above reasons, the board does not admit the respondent's main (sole) request into the proceedings.
2. In the absence of an admissible request by the respondent, the decision under appeal is to be set aside and the patent to be revoked.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



C. Vodz

E. Bendl

Decision electronically authenticated