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Datasheet for the decision of 13 February 2020

Case Number: T 0278/17 - 3.3.05

Application Number: 10167077.6

Publication Number: 2239039

IPC: B01D46/52, F02M35/024

Language of the proceedings: EN

Title of invention:
Air filter arrangement, assembly, and methods

Applicant:
Donaldson Company, Inc.

Headword:
Air Filter/Donaldson

Relevant legal provisions:
EPC Art. 76(1), 123(2)
RPBA 2020 Art. 11, 13, 25
RPBA Art. 13

Keyword:
Divisional application - subject-matter extends beyond content of earlier application (no, after amendment)
Amendments - extension beyond the content of the application as filed (no)
Late-filed request - justification for late filing (yes) - amendments after arrangement of oral proceedings
Remittal to the department of first instance - (yes)

Decisions cited:
T 2227/15, T 0032/16, T 0091/16, T 0634/16

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

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Case Number: T 0278/17 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 13 February 2020

Appellant: (Applicant)	Donaldson Company, Inc. 1400 West 94 Street Minneapolis, MN 55440 (US)
Representative:	Eisenführ Speiser Patentanwälte Rechtsanwälte PartGmbB Johannes-Brahms-Platz 1 20355 Hamburg (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 21 July 2016 refusing European patent application No. 10167077.6 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	G. Glod
Members:	T. Burkhardt
	P. Guntz

Summary of Facts and Submissions

I. The appeal lies from the examining division's decision to refuse the European patent application EP 10 167 077.6. The then main request and then auxiliary request 1 were found to contravene Article 76(1) EPC.

II. The examining division held that the omission of the "tapered region" in claim 1 of the main request and of auxiliary request 1, which requires a "recess on the trough", went beyond the disclosure of the parent application EP 05 778 924.0 as originally filed and thus contravened Article 76(1) EPC (reasons 1.2 and 2).

III. In its statement setting out the grounds of appeal, the applicant (appellant) argued that the "trough" and the "tapered region" were not inextricably linked (point III.1).

IV. In a communication under Article 15(1) RPBA 2007, the board issued its preliminary opinion.

While no objection was raised under Article 76(1) EPC to the omission of the "tapered region" in claim 1, several objections under Articles 76(1) and 123(2) EPC were raised for the first time.

V. With a submission dated 13 December 2019, the appellant submitted a new main request and four auxiliary requests.

VI. In a telephone conversation on 18 December 2019, the compliance of auxiliary request 2 with Articles 123(2) and 76(1) EPC was discussed *inter alia*.

VII. With a submission dated 13 January 2020, the appellant filed a new main request dated 10 January 2020. The sole claim of this request reads as follows:

"1. An air filter cartridge (300) comprising:
(a) a filter media pack (301) comprising a stacked construction of individual strips (200, 202) of media each comprising a fluted sheet (3) secured to facing sheet (4) to define inlet and outlet flow channels (11, 15) extending between first (305) and second (306), opposite, flow surfaces;
(b) a molded side panel arrangement comprising at least first (302) and second (303), opposite, molded panels molded directly to, and in sealing coverage over, a first set of two opposite sides of the media pack defined by lead ends (209a) and tail ends (209b) of the strips (200, 202) of media; and,
(c) an axial pinch housing seal arrangement (310);
characterized by
(d) the housing seal arrangement (310)
(i) being molded onto the filter cartridge (300);
(ii) being provided spaced from the first surface (305) toward the second surface (306);
(iii) being positioned at a location for forming a seal with housing components, when the filter cartridge (300) is positioned in a housing (800a) of an air cleaner (800) for use;
(iv) including a contoured surface (310a) with a recess on a trough (310b), facing in the same direction as the first surface (305), provided along the media pack (301) and surrounding said pack;
(v) being engagable by the housing (800a), with engagement into the recess, to pinch, axially, seal arrangement (310) to seal a bypass flow

around the filter cartridge (300), when installed;

(e) wherein by the term axial it is meant that forces are generally directed in the same direction as extension between flow faces (305, 306)."

VIII. The appellant requests that the contested decision be set aside and that a European patent be granted on the basis of the main request as filed with the submission of 13 January 2020.

As an auxiliary measure, it requests that a European patent be granted on the basis of one of four auxiliary requests as filed with the submission of 13 December 2019.

Reasons for the Decision

1. Main request - admissibility

The amendments in the (sole) claim of the main request are a reaction to issues raised by the board for the first time during the telephone conversation on 18 December 2019 with regard to auxiliary request 2.

Auxiliary request 2 was in turn a serious attempt to overcome all of the issues raised - mainly for the first time - in the communication under Article 15(1) RPBA 2007.

According to Article 25(3) RPBA 2020, the provisions of Article 13 RPBA 2007 continue to apply in the present

case. Article 13(1) RPBA 2020, which is not excluded by Article 25 RPBA 2020, applies directly (the board shares the reasoning of decision T 634/16, reasons 11 to 14) and is seen as a clarification of Article 13(1) RPBA 2007, especially of the criteria set out in the last sentence, that is more detailed and accounts for the relevant case law developed in the meantime.

Thus, besides Article 13(3) RPBA 2007, both Article 13(1) 2007 and Article 13(1) RPBA 2020 are applicable to the present case (see also T 32/16, reasons 1.1.2, and T 2227/15, reasons 1).

Accordingly, and since the amendments are directed to and clearly overcome all of the objections raised in the telephone conversation and the communication under Article 15(1) RPBA 2007, the board admits the new main request in consideration of Articles 13(1) RPBA 2020 and 13(1) and (3) RPBA 2007.

2. Main request - Articles 123(2) and 76(1) EPC

2.1 For the following reasons, the sole claim of the main request fulfils the requirements of Article 123(2) EPC.

Claim 1 is based on claim 1 of the present application as originally filed with amendments generally relating to the embodiment of Figures 7 to 10.

More precisely, the fact that the "media pack" is actually a "*filter* media pack" and the features "stacked construction of individual strips", "fluted *sheets* secured to a facing sheet", the "molded side panel arrangement comprising at least first ... and second ... opposite molded panels molded directly to, and in sealing coverage over, a first set of two

opposite sides of the media pack defined by lead ends ... and tail ends of the strips of media" are disclosed in point "VIII. A general Characterization of the Filter Cartridges and Methods", on page 37, in particular on page 37, line 37 to page 38, line 8 as originally filed. The word "general" in the title of this passage and in the penultimate line of page 37 indicates that these features are generally valid for the embodiments described and may therefore be combined with the embodiment of Figures 7 to 10.

The features that the housing seal arrangement is "spaced from the first surface toward the second surface" and "positioned at a location for forming a seal with housing components" are disclosed on page 17, lines 19 to 25.

The "axial pinch housing seal arrangement", the "recess on a trough ... facing in the same direction as the first surface", the suitability of the recess to be engaged by the housing and the definition of the term "axial" are disclosed on page 19, lines 10 to 18.

The omission in claim 1 of the feature "(ii) opening towards a flow surface", which was present in claim 1 as originally filed, is justified since the introduction of the feature "facing in the same direction as the first surface" implies the omitted feature.

In agreement with the same board in a different composition it is accepted that the "trough" and the "tapered region" (page 19, lines 10 to 13) are not inextricably linked, particularly since the "tapered region does not serve the purpose of an axial seal", since the function of the tapered region is not

discussed anywhere in the application as originally filed and since it is more likely to facilitate the assembly (T 91/16, reasons 1.2.1-1.2.3). Therefore, the omission of "tapered region" from claim 1 is acceptable.

2.2 The requirements of Article 76(1) EPC are fulfilled for the following reasons:

It is firstly noted that the description of the present application as originally filed and that of the parent application as originally filed are almost identical. The only difference is that the claims of the parent application as originally filed are appended as "preferred embodiments" to the description of the present application as originally filed.

The passages indicated above with regard to Article 123(2) EPC thus remain valid.

Moreover, it is noted that the feature "inlet and outlet flow channels extending between ... opposite flow surfaces" is not only disclosed in claim 1 of the present application as originally filed but also in the general passage on page 37, line 37 to page 38, line 3 of the parent application as originally filed.

The fact that the housing seal arrangement is molded *onto* the filter cartridge and that the trough is "provided along the media pack ... and surrounding said pack" is not only disclosed in claim 1 of the present application as originally filed, but can be derived directly and unambiguously from Figures 7 to 10 of the parent application as originally filed, where the cartridge is designated by reference numeral 300, the trough by 310b and the seal arrangement by 310.

2.3 As indicated in point 2.1 the board also concurs with T 0091/16 (reasons 1.2.1-1.2.3) that the features "recess on trough 310b" and "tapered region 310c" on page 19, lines 11-13 are not inextricably linked to each other.

3. Remittal

As indicated in Article 12(2) RPBA 2020, the primary object of the appeal proceedings is to review the decision under appeal in a judicial manner.

In the present case, the contested decision exclusively dealt with the requirements of Article 76(1) EPC. Patentability was not discussed.

Moreover, during the oral proceedings at the examination stage, novelty and inventive step were only discussed for the then second auxiliary request. The claims presently at stake are quite different however.

While claim 1 of the then second auxiliary request required that the sealing arrangement had a "tapered region", present claim 1 no longer requires this feature but comprises further features instead, such as the stacked construction of individual strips, fluted *sheets*, the molded side panel arrangement and the engageable nature of the recess.

Therefore, since the current request is considerably different from the requests underlying the impugned decision, so that no judicial review can be made except for Articles 123(2) and 76(1) EPC, there are "special reasons" within the meaning of Article 11 RPBA 2020

for a remittal to the department of first instance for further prosecution.

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.

The Registrar: The Chairman:

C. Vodz G. Glod

Decision electronically authenticated