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Datasheet for the decision of 6 February 2025

Case Number: T 0779/23 - 3.3.05

Application Number: 17753664.6

Publication Number: 3416734

IPC: B01D39/14, B01D46/52

Language of the proceedings: EN

Title of invention:
SURFACE COATED FILTER AND METHOD

Patent Proprietor:
Baldwin Filters, Inc.

Opponent:
Donaldson Company, Inc.

Headword:
Surface coated filter/Baldwin

Relevant legal provisions:
RPBA 2020 Art. 13(2)
EPC Art. 56

Keyword:
Amendment after notification of Art. 15(1) RPBA communication - exceptional circumstances (yes)
Inventive step - (yes)

Decisions cited:
T 1800/21

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

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Case Number: T 0779/23 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 6 February 2025

Appellant: (Opponent)	Donaldson Company, Inc. 1400 West 94th Street Bloomington, MN 55431 (US)
Representative:	IPLodge bv Technologielaan 9 3001 Heverlee (BE)
Respondent: (Patent Proprietor)	Baldwin Filters, Inc. 6035 Parkland Boulevard Cleveland, OH 44124 (US)
Representative:	Murgitroyd & Company 165-169 Scotland Street Glasgow G5 8PL (GB)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 16 February 2023 rejecting the opposition filed against European patent No. 3416734 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman	J. Roider
Members:	G. Glod
	P. Guntz

Summary of Facts and Submissions

I. The opponent's (appellant's) appeal lies from the opposition division's decision rejecting the opposition against European patent No. 3 416 734 B1.

II. The following documents cited in the impugned decision are of relevance here.

D4: WO 2005/123214 A1
D11: US 2008/0160318 A1

III. During oral proceedings before the board, the respondent (patent proprietor) made the request labelled "amended third auxiliary request" its sole request. This request had been submitted during those oral proceedings and is based on the previous third auxiliary request submitted on 30 October 2024.

IV. Claim 1 of the now sole request reads as follows.

"*1. A filter element (10, 300), comprising:*
a filter media pack (12, 312) including an outer surface (14, 314), the outer surface extending between a first flow face (16, 316) and a second flow face (18, 318); and a polymeric coating (20, 320) applied to the outer surface of the filter media pack;
characterised in that the polymeric coating is not a molded structure, has an average thickness of between 0.127mm and 2.540mm (0.005 and 0.100 in), and has a Shore A Durometer hardness of between 60 and 95, and wherein the polymeric coating (20) penetrates the filter media pack (12) to a depth of at least 0.2286mm (9,000 µin), and further comprising a border gasket (30) having a housing sealing surface, the border

gasket secured to the polymeric coating (20) in surrounding relation to the filter media pack (12), wherein the border gasket is molded in place and integrally bonded to the polymeric coating."

Claims 2 to 12 directly refer to claim 1.

Claim 13 of the now sole request reads as follows.

"*13. A method of applying a liquid coating to a filter (10, 200), comprising the steps of:*
providing a filter media pack (12, 212);
applying a polymeric fluid to an outer periphery (14, 214) of the filter media pack; and
allowing the polymeric fluid to form a polymeric coating (20, 220) on the outer periphery;
characterised in that the polymeric fluid is applied to the outer periphery of the filter media pack without molding to provide an outer layer having an average thickness of between 0.127mm and 2.540mm (0.005 and 0.100 in) and a Shore A Durometer hardness of between 60 and 95, and
wherein the polymeric coating (20) penetrates the filter media pack (12) to a depth of at least 0.2286mm (9,000 µin), and further comprising a border gasket (30) having a housing sealing surface, the border gasket secured to the polymeric coating (20) in surrounding relation to the filter media pack (12), wherein the border gasket is molded in place and integrally bonded to the polymeric coating."

Claim 14 refers to claim 13.

V. The appellant had objections under Article 13(2) RPBA and Article 56 EPC with respect to the now sole

request. The appellant's arguments, as far as relevant to the present decision, can be summarised as follows.

The request, submitted in reply to the board's communication under Article 15(1) RPBA, should not be taken into account. There were no exceptional circumstances which had been justified with cogent reasons.

The requirements of Article 56 EPC were not met. The problem to be solved vis-à-vis D4 was the provision of an alternative filter element. The solution was obvious. In particular, D4 also taught that the cured resin jacket 208 and the housing seal arrangement 209 were preferably integral with one another, thereby forming an overmould. This was preferably moulded in place (page 18, lines 3 to 6). The claimed thickness of the coating was commonly known, as illustrated by D11.

VI. The respondent's (patent proprietor's) arguments are reflected in the Reasoning given below.

VII. At the end of the oral proceedings before the board, the requests were as follows.

The appellant (opponent) requested that the decision under appeal be set aside and that the European patent be revoked.

The respondent (patent proprietor) requested that the patent be maintained in amended form on the basis of the sole request, which was labelled "amended third auxiliary request" and was submitted during the oral proceedings before the board on 6 February 2025.

Reasons for the Decision

1. Article 13(2) RPBA

Independent claims 1 and 13 of the current request were first submitted in the previous third auxiliary request, which was filed by letter dated 30 October 2024 in response to the communication under Article 15(1) RPBA.

The admittance of said third auxiliary request is governed by Article 13(2) RPBA. It includes the new independent claims, whereas the granted claim 7 has been deleted.

According to established case law the deletion of (a) claim(s) leading to an allowable set of claims can establish exceptional circumstances (T 1800/21, Reasons 3.4.6). In the case in hand, through the deletion of the granted claim 7, the objection under Article 123(2) EPC is overcome, and there are no resulting changes in the factual or legal framework of the case.

Claim 1 of the previous third auxiliary request is a combination of claims 1, 3, 5 and 12 of the patent as granted. Claim 13 (of said previous third AR) includes the corresponding amendments. It differs from claim 1 of auxiliary request 4 already submitted before the opposition division by the presence of the feature relating to the border gasket, among other features. This amendment is considered a direct reaction to the reference to paragraph [0057] of the patent in suit, made in the communication under Article 15(1) RPBA (point 12.3). The question of whether the problem was solved for the then auxiliary request 4, and in

particular the reference to said paragraph [0057], was only raised by the board in its communication. This point had not been brought up by the appellant.

According to established case law the filing of an auxiliary request in response to an objection first raised by the board in the communication may establish exceptional circumstances (Case Law of the Boards of Appeal of the EPO, 10th edition, 2022, V.A.4.5.5 a)).

In the case in hand, the new objection triggered the submission of the previous third auxiliary request, which was based on a combination of granted claims. This request ultimately led to the current - allowable, as set out below - sole request and therefore justifies exceptional circumstances.

The current sole request was submitted during oral proceedings before the board of appeal. It only differs from the previous third auxiliary request by the deletion of an obvious inconsistency in claim 10. This minor inconsistency was pointed out by the board during the oral proceedings and it was therefore appropriate to give the respondent the opportunity to remove the deficient part of claim 10. Exceptional circumstances are self-evident.

In summary, in view of the observations made above, the amendments present in the now sole request are justified by exceptional circumstances. The request is, thus, considered in the appeal proceedings.

2. Article 123(2) EPC

Claim 1 is based on claims 1, 3, 6, 19, 20 and 29 of the application as originally filed. Claim 13 includes

the corresponding amendments. The appellant did not raise an objection under Article 123(2) EPC. The board sees no reason to take a different stance.

3. Article 56 EPC

3.1 The invention relates to a filter element having a polymeric coating (paragraph [0001]).

3.2 It is undisputed that D4 is the closest prior art. D4 discloses a filter cartridge 201 comprising a coiled media pack of z-filter media 202 positioned with opposite flow surfaces 204 and 205, and with a cured resin jacket 208 around the media pack 202 in extension between the faces 204 and 205. Secured to the outer portion of the media pack 202 is a housing seal arrangement 209 (Figure 7 and page 17, line 30, to page 18, line 2).

3.3 The problem to be solved is to provide a filter element having improved durability and allowing better handling without giving rise to leakage problems (paragraph [0006] of the patent).

3.4 It is proposed to solve the problem posed by a filter element according to claim 1, characterised in that the polymeric coating is not a moulded structure, has an average thickness of between 0.127 mm and 2.540mm and a Shore A Durometer hardness of between 60 and 95, and in that the polymeric coating (20) penetrates the filter media pack (12) to a depth of at least 0.2286 mm, and in that the filter element further comprises a border gasket (30) having a housing sealing surface, the border gasket secured to the polymeric coating (20) in surrounding relation to the filter media pack (12),

wherein the border gasket is moulded in place and integrally bonded to the polymeric coating.

3.5 It is accepted that the problem is successfully solved since the combination of features leads to increased strength while still preventing leakage (see also paragraphs [0057] and [0069] of the patent). There is no evidence that contradicts this finding.

3.6 The proposed solution is not obvious.

D4 discloses that the cured resin jacket 208 and the housing seal arrangement 209 are preferably integral with one another, thereby forming an overmould (page 18, lines 3 to 5). D4 further discloses that the jacket could be applied by spraying. The housing seal could be moulded in place or, alternatively, moulded separately and attached (page 28, lines 17 to 23). The teaching of D4 is therefore not unambiguously directed towards the combination contained in claim 1.

In addition, the overmould is clearly taught as preferably having a Shore A hardness no greater than 30 (page 18, lines 13 to 15). This is also confirmed on page 29, lines 16 to 18, where the teaching refers to materials with a high Shore A hardness as heavy and costly.

Although it is accepted that the application of the coating by spraying will inevitably lead to some penetration into the outer surface of the filter media pack, D4 does not teach the spraying of a material with the required hardness if there is an overmould. Therefore, a clear teaching according to which the jacket penetrates the claimed distance into the filter media is also lacking in D4.

In summary, D4 does not teach the particular combination of a border gasket being moulded in place and integrally bonded to the polymeric coating, wherein the polymeric coating is not a moulded structure, has an average thickness of between 0.127 mm and 2.540 mm and a Shore A Durometer hardness of between 60 and 95, and penetrates into the filter media pack (12) to a depth of at least 0.2286mm. In addition, it is not indicated that this combination of features is beneficial. Therefore, there is no reason, without the benefit of hindsight, to specifically use the combination of features now claimed to solve the problem posed.

D11 generally teaches that coating layers can have a thickness of 1.524 to 2.540 mm (paragraph [0110]). However, D11 does not relate to a filter element as described in D4 and does not provide any details about the set-up including the hardness of the material.

3.7 Consequently, the subject-matter of claim 1 and claims 2 to 12 depending thereon involves an inventive step (Article 56 EPC).

3.8 It was not disputed that similar argumentation applied to independent claim 13 and to claim 14 depending thereon.

3.9 The requirements of Article 56 EPC are fulfilled.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the opposition division with the order to maintain the patent on the basis of the sole request, labelled amended third auxiliary request, submitted during the oral proceedings before the board on 6 February 2025, and a description to be adapted.

The Registrar: The Chairman:

C. Vodz J. Roider

Decision electronically authenticated