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D E C I S I O N
of 9 June 2000

Case Number: T 0742/97 - 3.3.5

Application Number: 93901896.6

Publication Number: 0618834

IPC: B01D 29/075

Language of the proceedings: EN

Title of invention:
Dynamic Filter System

Applicant:
Pall Corporation

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 84, 111(1)
EPC R. 29(4)

Keyword:
"Clarity and conciseness (yes, after amendment)"
"Remittal to the first instance for substantive examination of
the new claims"

Decisions cited:
-

Catchword:
-



Case Number: T 0742/97 - 3.3.5

D E C I S I O N
of the Technical Board of Appeal 3.3.5
of 9 June 2000

Appellant: Pall Corporation
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 10 February 1997
refusing European patent application
No. 93 901 896.6 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: R. K. Spangenberg
Members: A.-T. Liu
J. H. Van Moer

Summary of Facts and Submissions

- I. The appeal was from the decision of the examining division rejecting European patent application No. 93 901 896.6.
- II. The decision was based on the set of 15 claims filed with the applicant's letter dated 5 June 1996. These claims were all drafted as independent claims.

Regarding the independent claims 1, 2, 3, 14 and 15 relating to a dynamic filter assembly, the examining division found the following:

- these claims were of similar scope.
- they used slightly different terminology
- each of the claims comprised most of the features of another claim in this same group.

The examining division therefore held that the claims were not clear and concise as required by Article 84 EPC.

A further objection raised by the examining division was that these claims were not grouped in an appropriate manner as laid out in Rule 29(4) EPC.

- III. With the statement of the grounds of appeal, the appellant filed, as main request, a new set of claims and amended pages of the description. The new set of claims comprised independent claims 1 and 2 directed to a dynamic filter assembly, with claims 3 to 53 being dependent on claims 1 and 2.

Claims 1 and 2 were worded as follows:

"1. A dynamic filter assembly (101) comprising:
a housing (105) having a base (152);
a process fluid inlet (106) arranged to direct process fluid into the housing (105);
a permeate outlet (108) disposed in the base (152) and arranged to direct permeate from the housing (105);
a stationary filter unit (147) disposed within the housing (105) and including a plurality of stacked filter elements (148), each filter element (148) including an outer periphery, a permeate passage (163), and a filter (162) having an upstream side which communicates with the process fluid inlet (106) and a downstream side which communicates with the permeate passage (163), the filter unit (147) further including a holder (157,198,201,202) coupled to the outer periphery of each filter element (148) and having a permeate duct (166,201) which is coupled to the permeate passage (163) in each filter element (148) and to the permeate outlet (108), wherein the holder (157,198,201,202) is mounted on the base (152) with the permeate duct (166,201) sealed to the permeate outlet (108); and
a rotary unit (132) disposed within the housing (105) and having a member (151) which faces the filter (162) of at least one of the filter elements (147), the member (151) being rotatable with respect to the filter (162) to prevent fouling of the filter (162).

2. A dynamic filter assembly (101) comprising:
a housing (105) having a base (152);
a process fluid inlet (106) arranged to direct process fluid into the housing (105);
a first permeate outlet (108) and a second

permeate outlet (108), each permeate outlet (108) being disposed in the base (152) and arranged to direct permeate from the housing (105);

a filter unit (147) disposed within the housing (105) and comprising a plurality of stacked filter elements (148), each filter element (148) having at least first and second filter sections (172) and each filter section (172) including a permeate passage (163) and a filter (162) having an upstream side which communicates with the process fluid inlet (106) and a downstream side which communicates with the permeate passage (163), wherein the filter unit (147) comprises at least first and second filter modules, each filter module including a holder (157,198,201,202) having a permeate duct (166,201) and supporting a plurality of filter sections (172) mounted to the holder (157,198,201,202), wherein the permeate passage (163) of each of the filter sections (172) communicates with the permeate duct (166,201) of the holder (157,198,201,202), wherein each holder (157,198,201,202) is mounted on the base (152) with the permeate duct (166,201) sealed to the permeate outlet (108) in the base (152) and wherein the plurality of stacked filter sections (172) of the first filter module are respectively disposed coplanar with the plurality of filter sections (172) of the second filter module; and

a rotary unit (132) disposed within the housing (105) and having a plurality of members (151) interleaved with the filter elements (148), the members (151) being arranged to rotate relative to the filter elements (148) to prevent fouling of the filters (162)."

The appellant submitted that the two independent claims

comprised features such that neither of them could be made dependent on the other without unduly reducing the scope of protection being sought.

- IV. With the same letter, the appellant also filed three other sets of claims with adapted pages of the description as basis for a first, second and third auxiliary request.

- V. The appellant requested the Board to overturn the decision under appeal and remit the application to the examining division for further substantive examination on the basis of the main request, or alternatively, to overturn the decision and pass the application for acceptance on the basis of the main request. First, second and third auxiliary requests were submitted for consideration if the decision was not overturned on the basis of the main request.

Reasons for the Decision

Main request

- 1. As indicated above (point III), the claims of this request have been revised to contain two independent claims directed to a dynamic filter assembly.

- 2. Claim 1 stipulates a stationary filter unit including a holder coupled to the outer periphery of each filter element of this filter unit. These features are not included in claim 2 which does not stipulate that the filter unit is stationary.

On the other hand, claim 2 requires that the filter

unit comprises at least first and second filter modules, each filter module including a holder supporting a plurality of filter sections mounted to the holder.

- 2.1 Claims 1 and 2, beyond sharing a number of features in common, are thus directed to different, mutually independent embodiments of a filter assembly. The Board holds that a main claim drafted to include both alternatives would, in the present case, not gain in conciseness but more probably lack clarity.
- 2.2 As is correctly indicated in the impugned decision, the Convention does not, in principle, prohibit the drafting of more than one independent claim in the same claims category. The Board has no reason to reject the appellant's arguments that claims to two alternatives as stipulated in claims 1 and 2 are justified by the protection sought by him. Since the same terminology and reference numerals are being used in both claims, as far as the same features are concerned, these two claims would not place an undue burden on the reader seeking to establish the extent of monopoly.
3. The Board therefore holds that the objections of lack of clarity and lack of conciseness raised by the examining division are no longer applicable to the present set of claims.
4. The two independent claims are now in subsequent order and the dependent claims 3 to 53 appropriately grouped into various preferred embodiments of the assembly according to claims 1 and 2. These subgroups constitute the subject-matter of claims 3 to 12, claims 13 to 19, claims 20 to 26, claims 27 to 30, claims 31 to 42 and

claims 43 to 53. The claims are thus in conformity with Rule 29(4) EPC.

5. The reasons for the refusal of the application, namely the lack of clarity and lack of conciseness due to an unjustified plurality of independent claims in the same claims category and the infringement of Rule 29(4) EPC, have thus been removed with the present amendments to the claims.
6. The Board observes that the compliance of the new claims with Article 84 EPC has only been examined by the Board with the view to the objections raised in the impugned decision. Since the substantive examination has not been completed, the Board exercises its power under Article 111(1) EPC to remit the application to the first instance who has the task to carry out this examination.

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:

S. Hue

R. Spangenberg