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D E C I S I O N
of 24 July 2001

Case Number: T 1145/98 - 3.3.5

Application Number: 93309138.1

Publication Number: 0608606

IPC: B01D 53/26

Language of the proceedings: EN

Title of invention:
Gas drying apparatus

Patentee:
Knorr-Bremse Systems for Commercial Vehicles Limited

Opponent:
MAHLE Filtersysteme GmbH

Headword:
Gas drying apparatus/KNORR

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
"Amendment not allowable under Article 123(2)"

Decisions cited:
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Catchword:
-

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Case Number: T 1145/98 - 3.3.5

D E C I S I O N
of the Technical Board of Appeal 3.3.5
of 24 July 2001

Appellant: (Proprietor of the patent)
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 12 October 1998 revoking European patent No. 0 608 606 pursuant to Article 102(1) EPC.**

Composition of the Board:

Chairman: R. K. Spangenberg
Members: M. M. Eberhard
M. B. Günzel

Summary of Facts and Submissions

I. European patent No. 608 606 based on application No. 93 309 138.1 was granted on the basis of eight claims. The respondent (opponent) filed a notice of opposition requesting revocation of the patent on the grounds of lack of novelty and lack of inventive step. The respondent relied on DE-A- 32 32 902 (D1) and EP-B-0 365 066 in support of his arguments.

II. The opposition division decided to revoke the patent. The decision was based on amended claim 1 filed on 25 February 1998, which reads as follows:

"1. A replaceable gas drying cartridge for drying apparatus including a main body (1) having a gas input port (2), a gas delivery port (3) and retaining means (6) for the cartridge, the cartridge comprising a generally cylindrical housing (29) with an attached closure member (21,26) at an open end having means (23,27) for cooperating with the retaining means (6) for sealingly engaging said body to define an inflow path from said input port through said desiccant and out via the delivery port, characterised by the housing having a separate internal divider (31) extending axially in the direction from said closure member (21) into desiccant (37) contained by the housing (29) to divide it into inner and outer flow paths in series and resilient compacting means (35,36), including a gas permeable plate (36, 36a), urging the surface of the desiccant in one said flow path away from said closure member."

The opposition division took the view that the subject-matter of claim 1 lacked novelty over the disclosure of

D1. It considered that the teaching of D1 was not restricted to the specific embodiment where the divider (17) was welded to the closure member (14) but also covered the possibility that the divider and the closure member were separate parts connected to each other via sealing means. The opposition division further held that the latter feature, if new, would not have imparted inventiveness to claim 1.

III. The appellant lodged an appeal against this decision and submitted a set of amended claims (Annex A1) on 22 December 1999. In a communication accompanying the summons to the oral proceedings, which were requested by both parties, the parties' attention was drawn to unclarities in claim 1. The board further raised the question whether the amendments in claims 1 and 3 of Annex A1 met the requirements of Article 123(2) EPC. In this context, the appellant was asked to indicate where the additional features incorporated into claim 1 were disclosed in the application as filed. In reply thereto, he filed a set of amended claims (claims 1 to 3 of Annex A2 and claims 4 to 10 of Annex B) on 21 June 2001, as the sole request in replacement for all the previous sets of claims. He further informed the board of his intention not to attend the oral proceedings. The respondent indicated on 11 July 2001 that he would not attend the oral proceedings. The latter were held on 24 July 2001 for the purpose of giving the decision orally. Claim 1 of Annex A2 reads as follows:

"1. A replaceable gas drying desiccant cartridge for drying apparatus including a main body (1) having a gas input port (2), a gas delivery port (3) and retaining means (6) for the cartridge, the cartridge comprising a generally cylindrical housing (29) with an attached

closure member (21,26) at an open end having means (23,27) for cooperating with the retaining means (6) for sealingly engaging said body to define an inflow path from said input port through said desiccant and an outflow path therefrom towards the delivery port, characterised by the housing having a separate insert acting as an internal divider (31) which divides the desiccant into inner and outer flow paths in series the divider having a first portion extending axially in a direction from said closure member (21) into the desiccant (37) contained by the housing (29) to define said inner and outer flow paths a radially extending gas permeable portion spaced from the closure member but integral with the first portion and by which said radially extending portion the desiccant in one said path flow is constrained and sealing means between the divider and the closure member to constrain gas flow between said ports to flow via said paths and resilient compacting means (35) acting between said closure member and a gas permeable plate (36, 36a) urging the surface of the desiccant in the other said flow path away from said closure member."

IV. The appellant presented the following arguments in connection with the allowability of the amendments in claims 1 and 3 of Annex A2.

The divider in the application as filed was clearly a separate internal freely positionable component within the cylindrical housing. The divider had a first **solid** axial portion (ie. wall 31) and a radially extending gas **permeable** portion (33) spaced from the closure member and by which desiccant of one flow path is constrained. The gas permeable portion is also spaced (by 25) from the closure member (21) in Figure 2.

Although not fixed to the closure member (21), the further, inwardly extending, wall (34) of the moulded plastic divider component "sealingly engages around the port (22) of the plate (21) to constitute the sealing of claim 1". With regard to claim 3, it was disclosed in Figure 2 that the compacting means (spring 35) acted in a sense to maintain the sealing means in engagement with the closure member, namely by acting against axial movement which otherwise resulted in axial separation from (22).

V. The respondent did not present any comment concerning the allowability of the amendments in claims 1 and 3 of Annex A2. He put forward arguments concerning the issues of novelty and inventive step.

VI. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the amended claims filed on 21 June 2001 (ie claims 1 to 3 of Annex A2 and claims 4 to 10 of Annex B). He requested the board to reach a decision on the basis of the submissions presented in writing before oral proceedings. The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

2. Claim 1 of Annex A2 differs from claim 1 on which the appealed decision is based in particular by the following additional features marked in bold:

(i) the divider has a "**first portion**" extending axially in a direction from said closure member (21) into the desiccant (37) ....and "**a radially extending gas permeable portion spaced from the closure member but integral with the first portion and by which said radially extending portion the desiccant in one said path flow is constrained**";

(ii) the housing has "**sealing means between the divider and the closure member to constrain gas flow between said ports to flow via said paths**";

(iii) "resilient compacting means (35) **acting between said closure member and a gas permeable plate (36, 36a)** urging the surface of the desiccant **in the other** said flow path away from said closure member" .

The board is satisfied that the additional features in items (i) and (ii) are disclosed in the application as filed.

Concerning the feature in item (iii) that the resilient compacting means (35) acts between the closure member (21) and a gas permeable plate (36,36a) (hereinafter feature F), the board observes that this feature had already been incorporated into claim 1 of Annex A1 previously on file. In its communication accompanying the summons to the oral proceedings the board had raised the question whether the amendments made in claims 1 and 3 of Annex A1 met the requirements of Article 123(2) EPC. The board had also asked the appellant to indicate where the additional features

introduced in these claims were disclosed in the application as filed. The appellant had thus been made aware by the board that the allowability of the amendments made in the claim including feature F was questionable. The summons to oral proceedings on 24 July 2001 having been issued on 10 May 2001, the appellant had the opportunity and sufficient time to comment on the issue or to further amend the claim, which he actually did with respect to other features. As regards the allowability under Article 123(2) EPC of feature F, it was the appellant's decision neither to comment nor to further amend but to simply retain this feature in the claim as it stood. The appellant's right to be heard on the issue of allowability under Article 123(2) EPC of the introduction of feature F into the claim was thus observed and the board is entitled under Article 113(1) EPC to take a decision on the matter. The board was unable to find information in the application as filed from which the skilled person would have directly and unambiguously derived this feature in combination with the other features stated in claim 1.

On page 6 of the application as filed which describes the cartridge according to Figure 2, it is indicated that a helical compression spring (ie 35) is located between the frusto-conical wall (34) and a perforated plastic compacting plate (36), the plate (36) being clad with an air permeable polyester cloth (36a) (see page 6, lines 11 to 15). According to page 6, lines 3 to 6, and Figures 2 and 3 the solid frusto-conical wall (34) is a portion of the divider. Therefore it is disclosed in these passages that the resilient compacting means (35) is located between the solid frusto-conical wall (34) of the divider and the gas

permeable plate (36,36a) and thus acts between the divider and the said permeable plate. It is not directly and unambiguously derivable therefrom that the resilient compacting means (35) acts between the closure member (21) and the said permeable plate. It is observed in this context that the solid frusto-conical wall (34) of the divider and the closure member (21) are spaced apart so that the apertures (24) of the closure member are in communication with the annular mesh oil filter (25).

On page 7, lines 18 to 21, of the application as filed, it is further stated in connection with the embodiment according to Figure 2 that "the resilient compressive means comprises a compacting plate (36) and a helical compression spring acting on the end of the inner body of desiccant". It can also not be directly derived from this statement that the resilient compacting means (35) acts between the closure member (21) and the said plate (36).

Regarding the embodiment of Figure 4, it is disclosed in the paragraph bridging pages 7 and 8 of the application as filed that there is an annular compacting plate (46) and a compression spring (45) which now act upon the end of the outer body of desiccant. Therefore, in this embodiment, the resilient compacting means acts between the said plate and the radially extending permeable portion of the divider, and not between the closure member and the said plate.

In the embodiment illustrated in Figure 5, there is no separate compacting plate (see page 8, lines 7 to 8). According to page 8, lines 8 to 14, the disc or plate (50) is provided with a helical compression spring (55)

which causes the plate to act on the whole body of the desiccant. In order to separate the inflow from the outflow, a flexible wall (56) is provided which sealingly engages the underside of plate (50) and the closure member (21). Plate (50) is a portion of the divider. Assuming that it would be directly derivable from Figure 5 that the resilient compacting means acts between the gas permeable plate (50) and the closure member (21) via the said flexible wall (56), the board observes that this disclosure only concerns the specific embodiment of Figure 5; ie an embodiment including the flexible wall (56) as defined above where the gas permeable plate is a portion of the divider and the resilient compacting means urges the surface of the desiccant in both the inner and outer flow paths away from the closure member (see original claim 3). However, claim 1 is not restricted to the specific embodiment of Figure 5 but is much broader and clearly encompasses other embodiments. The application as filed contains no further information from which it would be directly and unambiguously derivable that in the gas drying cartridge according to embodiments other than that of Figure 5, the resilient compacting means acts between the closure member and a gas permeable plate.

It follows from the above that claim 1 submitted on 21 June 2001 contains an additional feature F which is not disclosed in the application as filed in combination with the remaining features stated in claim 1. Therefore, this claim does not meet the requirements of Article 123(2) EPC and the sole request on file cannot be granted.

Order

For these reasons it is decided that:

The appeal is dismissed

The Registrar: The Chairman:

G. Rauh R. Spangenberg