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D E C I S I O N
of 26 November 2004

Case Number: T 0853/02 - 3.2.4

Application Number: 92925466.2

Publication Number: 0631468

IPC: A01J 5/16

Language of the proceedings: EN

Title of invention:

Milking system with variable pressure source

Patentee:

Bou-Matic Technologies Corporation

Opponent:

DeLaval International AB Patent & Trademark Department

Headword:

Conventional pulsator/BOU-MATIC

Relevant legal provisions:

EPC Art. 54, 100(c), 123(2), (3), 111(1)

Keyword:

"Disclosed disclaimer"

"Lack of clarity, objections against a non amended part of the claim - inadmissible"

"Remittal for further prosecution (disclosed disclaimer erroneously not taken into account in assessing inventive step) "

Decisions cited:

G 0002/03, T 0271/84, T 0170/87, T 0611/90, T 0597/92

Catchword:

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Case Number: T 0853/02 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 26 November 2004

Appellant: Bou-Matic Technologies Corporation
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 21 May 2002
revoking European patent No. 0631468 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: M. Ceyte
Members: P. Petti
M. B. Tardo-Dino

Summary of Facts and Submissions

- I. An opposition based on Articles 100(a), (b) and (c) EPC was filed against the European patent EP-B-0 631 468. The opposition division, by its decision dispatched on 21 May 2002, revoked the patent.
- II. The reasons given by the opposition division in the appealed decision can be summarized as follows:
- independent claims 1 and 25 as granted, upon which was based the main request then on file, contravened Article 100(c) EPC,
 - the subject-matter of each of independent claims 1 and 25 of the auxiliary request then on file was distinguished from the prior art disclosed in each of documents DE-A-3 609 275 (D3) and WO-A-93/18644 (D1) only by a "disclaimer",
 - since "disclaimers" are meaningless in assessing inventive step, the subject-matter of each of the independent claims 1 and 25 of the auxiliary request lacked an inventive step.
- III. On 26 July 2002 the patent proprietor (hereinafter appellant) lodged an appeal against this decision and simultaneously paid the appeal fee. A statement setting out the grounds of appeal was received on 27 September 2002.
- IV. Oral proceedings were held on 26 November 2004.

V. The appellant requested that the appealed decision be set aside and a patent be granted, as a main request, on the basis of the set of claims 1 to 34 as filed with the letter dated 18 June 2003 in annex I.

Alternatively, as auxiliary request I, the appellant requested that a patent be granted on the basis of the set of claims 1 to 28 as filed with the letter dated 18 June 2003 in Annex II.

The appellant also submitted ten further auxiliary requests. Auxiliary requests II and III were based upon the sets of claims filed with letter dated 18 June 2003, respectively in Annexes III and IV. Auxiliary requests IV to XI were based upon the sets of claims filed with letter dated 27 September 2004, respectively in Annexes V to XII.

VI. The respondent requested that the appeal be dismissed.

Auxiliarily, the respondent requested that the case be remitted to the first instance, if the board found that any of the appellant's requests met the requirements of Articles 123(2) and (3) and 84 EPC.

VII. The independent claims 1 and 24 of the main request read as follows:

"1. A method for milking a mammal, comprising:
providing a teat cup (12; 14) having a liner (24; 26) for location around a teat of a mammal;
defining a milk flow passage (28; 30) within said liner (24; 26) and a pulsation chamber (32; 34) between said liner (24; 26) and said teat cup (12; 14);

applying a negative pressure below atmospheric pressure to said milk flow passage (28; 30);
supplying a negative pressure to said pulsation chamber (32; 34) during an on portion of said pulsation cycle;
supplying a higher pressure to said pulsation chamber during an off portion of said pulsation cycle;
characterized by the use of a variable pressure source (82) for controllably varying the rate of pressure change in said pulsation chamber (32; 34) without using a two-way valve pulsator alternating between a first condition connecting a negative pressure source to the pulsation chamber and a second condition supplying atmospheric or higher pressure as on and off portions of a pulsation cycle;
the method comprising supplying a controllably variable pressure to said pulsation chamber (32; 34) and varying the pressure supplied to said pulsation chamber (32; 34) along a controllably variable pressure curve of selectable waveshape.

24. Milking apparatus for milking a mammal, comprising:
a teat cup (12; 14) having a liner (24; 26) for location around a teat of a mammal;
a milk flow passage (28; 30) within said liner (24; 26), and a pulsation chamber (32; 34) located between said liner (24; 26) and said teat cup (12; 14);
a negative pressure source (48) for applying a negative pressure below atmospheric pressure to said milk flow passage (28; 30); and a variable pressure source (82) for supplying a negative pressure to said pulsation chamber (32; 34) during an on portion of a pulsation cycle to open said liner (24;26) below the teat and a

higher pressure to said pulsation chamber (32; 34) during an off portion of said pulsation cycle to close said liner (24; 26) below the teat, characterized in that the variable pressure source (82) is arranged to controllably vary the rate of pressure change applied to said pulsation chamber (32; 34) without a two-way valve pulsator, alternating between a first condition connecting a negative pressure source to the pulsation chamber and a second condition supplying atmospheric or higher pressure as on and off portions of a pulsation cycle; wherein said variable pressure source (82) is arranged to supply a controllably variable pressure to said pulsation chamber (32; 34) and to vary the pressure supplied to said pulsation chamber (32; 34) along a controllably variable pressure curve of selectable waveshape."

The independent claims 1 and 20 of the auxiliary request I read as follows:

"1. A method for milking a mammal, comprising: providing a teatcup (12; 14) having a liner (24; 26) for location around a teat of a mammal; defining a milk flow passage (28; 30) within said liner (24; 26) and a pulsation chamber (32; 34) between said liner (24; 26) and said teat cup (12; 14); applying a negative pressure below atmospheric pressure to said milk flow passage (28; 30); supplying a negative pressure to said pulsation chamber (32; 34) during an on portion of said pulsation cycle; supplying a higher pressure to said pulsation chamber during an off portion of said pulsation cycle;

characterized by the use of a variable pressure source (82) for controllably varying the rate of pressure change in said pulsation chamber (32; 34) without using a two-way valve pulsator alternating between a first condition connecting a negative pressure source to the pulsation chamber and a second condition supplying atmospheric or higher pressure as on and off portions of a pulsation cycle; the method comprising supplying a controllably variable pressure to said pulsation chamber (32; 24) and varying the pressure supplied to said pulsation chamber (32; 34) along a controllably variable pressure curve of selectable waveshape, the method further comprising abruptly changing the pressure at the beginning of the transition from at least one of said on and off portions of said pulsation cycle to the other of said on and off portions of said pulsation cycle, and then varying the pressure at a slower rate of change, all during said transition.

20. Milking apparatus for milking a mammal, comprising:
a teat cup (12; 14) having a liner (24; 26) for location around a teat of a mammal;
a milk flow passage (28; 30) within said liner (24; 26), and a pulsation chamber (32; 34) located between said liner (24; 26) and said teat cup (12; 14);
a negative pressure source (48) for applying a negative pressure below atmospheric pressure to said milk flow passage (28; 30); and
a variable pressure source (82) for supplying a negative pressure to said pulsation chamber (32; 34) during an on portion of a pulsation cycle to open said

liner (24; 26) below the teat and a higher pressure to said pulsation chamber (32; 34) during an off portion of said pulsation cycle to close said liner (24; 26) below the teat,
characterized in that the variable pressure source (82) is arranged to controllably vary the rate of pressure change applied to said pulsation chamber (32; 34) without a two-way valve pulsator, alternating between a first condition connecting a negative pressure source to the pulsation chamber and a second condition supplying atmospheric or higher pressure as on and off portions of a pulsation cycle;
wherein said variable pressure source (82) is arranged to supply a controllably variable pressure to said pulsation chamber (32; 34) and to vary the pressure supplied to said pulsation chamber (32; 34) along a controllably variable pressure curve of selectable waveshape, and
wherein said variable pressure source (82) is further arranged to provide an abrupt pressure change at the beginning of the transition from at least one of said on and off position of said pulsation cycle to the other of said on and off portions of said pulsation cycle, followed by a slower rate of pressure change."

VIII. The appellant essentially submitted that:

- the independent claims of the main request (claims 1 and 24) as well as those of the auxiliary request I do not contravene the requirements of Articles 84 and 123 EPC,

- the subject-matter of these independent claims is novel with respect to the prior art disclosed by documents D3 and D1.
- IX. The opponent (hereinafter respondent) essentially submitted that:
- the independent claims 1 and 24 of the main request contravene Articles 84 and 123(3) EPC,
 - the subject-matter of each of independent claims 1 and 20 of the auxiliary request lacks novelty with respect to the prior art known from each of documents D3 and D1.

Reasons for the Decision

1. The appeal is admissible.
2. *Interpretation of the claims*
 - 2.1 It can be understood from the application as filed (hereinafter Aaf) that the invention claimed by claim 1 of the Aaf relates to a method of milking a mammal in which

a two-way valve which alternates between a first condition connecting a negative pressure source to the pulsation chamber of the teat cup and a second condition supplying atmospheric or higher pressure to the pulsation chamber so as to provide a pulsation cycle having an on portion during said first condition

and an off portion during said second condition of the valve

is replaced by

a variable pressure source for supplying a controllably variable pressure source to the pulsation.

It is clear from the description of the Aaf that the two-way valve alternating between two conditions (as referred to in claim 1 of the Aaf) is a **conventional pulsator** (see page 2, lines 9 to 19; page 2, lines 34 to page 3, line 2; page 19, lines 32 and 39; Figure 1), i.e. a two-way valve with fixed ports, which is suitable for subjecting the pulsation chamber of the teat cup to a pulsating pressure varying between a first negative pressure and a second higher pressure.

Claim 1 as granted is directed to a method of milking a mammal comprising the following features:

- (a) a negative pressure is supplied to the pulsation chamber during the on portion of a pulsation cycle,
- (b) a higher pressure is supplied to the pulsation chamber of the teat cup during the off portion of the pulsation cycle,
- (c) a variable pressure source is used for controllably varying the rate of the pressure change in the pulsation chamber of the teat cup without using a two-way valve pulsator.

The above expression "two-way valve pulsator" has to be interpreted in the light of the description of the patent, which refers to a conventional pulsator constituted by a conventional two-way valve which alternates between a first condition connecting the negative pressure source to the pulsation chamber of the teat cup and a second condition supplying higher pressure to the pulsation chamber (column 1, line 49 to column 2, line 1; column 13, line 56, line 5.

2.2.1 Therefore, claim 1 of the patent as granted, due to the expression "the use of variable pressure source ... without using a two-way valve pulsator" defines a method in which a variable pressure source is used not only for providing a pulsation cycle in the pulsation chamber but also for controllably varying the rate of pressure change in the pulsation chamber without using a conventional pulsator which alternates between a first condition connecting the negative pressure source to the pulsation chamber of the teat cup and a second condition supplying atmospheric or higher pressure as on and off portions of the pulsation cycle, i.e. without using a pulsator which consists only of a two-way valve with fixed ports which alternates between the two above mentioned conditions.

2.2.2 This interpretation is also consistent with the passage in the description of the patent which refers to "a pressure source and a valve with a variable orifice" (column 14, lines 47 to 49) as a further example of the variable pressure source referred to in the claims.

It is clear from this passage that the variable pressure source can also comprise a valve with a

variable orifice. Therefore, it is also clear that a variable pressure source comprising a valve with a variable orifice cannot be considered as being a conventional pulsator. Such a variable pressure source is covered by the above mentioned feature c in so far as it is not excluded by the disclaimer "without using a two-way valve pulsator" (hereinafter referred to as "unamended disclaimer").

It has to be noted that the appellant during the oral proceedings before the board agreed with this interpretation of claim 1 of the patent as granted.

2.3 Claim 1 of the main request of the appellant differs from claim 1 of the patent as granted in that

(i) the unamended disclaimer "without using a two-way valve pulsator" has been replaced by the wording

"without using a two-way valve pulsator alternating between a first condition connecting the negative pressure source to the pulsation chamber and a second condition supplying atmospheric or higher pressure to the pulsation chamber as on and off portions of a pulsation cycle" (hereinafter referred to as "amended disclaimer"),

and

(ii) the feature according to which the method comprises "supplying a controllably variable pressure to said pulsation chamber (32;34) and varying the pressure supplied to said pulsation

chamber (34;34) along a controllably variable pressure curve of selectable waveshape" (hereinafter feature d) has been added.

3. *Article 84 EPC with respect to claim 1 of main request*

3.1 The respondent argued that the amended disclaimer, in so far as it attempts to exclude two-way valves, was not supported by the passage in column 14, lines 47 to 49 of the description of the patent in so far as this passage contemplated using a two-way valve as a variable pressure source.

3.1.1 This objection does not directly relate to the amended disclaimer because it could have also been raised for the unamended disclaimer which also refers to the terms "without using a two-way valve pulsator". In other words, this objection does not concern the amendments that led to claim 1 of the main request but claim 1 of the patent as granted. Therefore, this objection represents an attempt to raise an objection under Article 84 EPC to a feature already present in claim 1 of the patent as granted. Since Article 84 EPC is not a ground of opposition, the board considers this objection as being inadmissible.

3.1.2 In any case, as already stated in the above sections 2.2.1 and 2.2.2, the unamended disclaimer as well as the amended disclaimer exclude only a conventional two-way valve pulsator with fixed ports and not a two-way valve with a variable orifice referred to in the passage in column 14, lines 47 to 49 of the description of the patent.

3.1.3 The respondent further argued that claim 1 of the main request, which contains a disclaimer (negative feature) did not positively define the matter for which protection is sought.

3.2.1 Since this objection could also have been raised against the unamended disclaimer specified in claim 1 as granted, the board considers it as being inadmissible (see the considerations in the above section 3.1.1).

3.3 The respondent further argued that the expression "varying the pressure ... along a controllably variable pressure curve of selectable waveshape" in feature d has no clear technical meaning. However, this expression is contained in claim 3 of the granted patent. Therefore, for the same reasons given in sections 3.1.1 and 3.1.2, also this objection is considered as being inadmissible.

It has to be noted that this expression represents a generalisation of the features described in details in the portions of the description of the patent which refer to Figures 7 to 10 and 12.

4. *Article 123 EPC with respect to claim 1 of the main request*

4.1 The amendments that led to claim 1 of the main request concern the amended disclaimer and feature d (see section 2.3 above).

- 4.1.1 Having regard to the considerations in the above section 2.1, the amended disclaimer is directly and unambiguously derivable from claim 1 of the Aaf.
- 4.1.2 Feature d comprises a first statement ("supplying a controllably variable pressure to said pulsation chamber") which can be derived from claim 1 of the Aaf (page 22, lines 15 to 17) and a second statement ("varying the pressure ... along a controllably variable pressure curve of selectable waveshape") which can be derived from claim 2 of the Aaf.
- 4.1.3 Therefore, claim 1 does not contravene the requirements of Article 123(2) EPC.
- 4.2 With regard to Article 123(3), the respondent essentially argued as follows:
- The amended disclaimer in claim 1 of the main request can be clearly derived from the Aaf, in which the prior art method was presented as being a method using only a two-way valve pulsator with fixed ports. Therefore, claim 1 of the main request clearly excludes only the use of two-way valve pulsators with fixed ports.
 - The unamended disclaimer in claim 1 of the patent as granted cannot be interpreted as excluding only the use of two-way valve pulsators with fixed ports, because a passage in the description of the patent as granted (column 2, lines 15 to 18) refers to document D3 which discloses a method in which a pulsator is associated with valves having variable orifices. Therefore, due to this passage

in the description of the patent, the unamended disclaimer in claim 1 of the patent as granted has to be interpreted as excluding the use of two-way valve pulsators not only with fixed ports but also with variable orifices.

Consequently, since the amended disclaimer excludes from the protection less than what the unamended disclaimer does, claim 1 of the main request, which includes the amended disclaimer, has been amended in such a way to extend the protection conferred and thus contravenes the requirements of Article 123(3) EPC.

- It is clear not only from the above mentioned passage in the description of the patent as granted but also from the previous proceedings that the intention of the appellant was to exclude from the protection the use of any two-way valve pulsators (with fixed ports and with variable orifices). Since the amendments leading to claim 1 of the main request make it clear that only two-way valve pulsators with fixed ports are excluded (opening the possibility that pulsators with variable orifices are not excluded), these amendments do not ensure a sufficient degree of certainty (with respect to the protection) for third parties. Any doubt with respect to the determination of the extent of protection should not give an advantage to the patent proprietor.

4.2.1 The board cannot accept these arguments of the respondent for the following reasons:

- The passage in column 2, lines 15 to 18 of the description of the patent as granted mentions document D3 as referring to the measurement of milk flow variations without referring to the use of pulsators. Therefore, this passage is not useful for interpreting the unamended disclaimer in claim 1 as granted. In other words, although document D3 discloses the use of a pulsator associated with valves having variable orifices, the fact that this document is mentioned in the description of the patent does not necessarily imply that the use of the pulsator disclosed in document D3 is disclaimed in the absence of a clear statement referring to the relationship of this pulsator to the claimed subject-matter.
- Having regard to the considerations in the above sections 2.1 and 2.2, although the unamended disclaimer and the amended disclaimer have different wordings, they have the same technical meaning and therefore the same scope. Reference is made in this respect to the decision T 271/84 (OJ 1987, 405) according to which an amendment to a claim does not contravene Article 123(2) or (3) EPC if the amended claim has the same meaning as the unamended claim, on its true construction in the context of the specification.
- The determination of the extent of protection provided by a patent claim has not to be made on the basis of the proceedings which led to the

granting of the patent or of the submissions made during these proceedings in order to take account of particular circumstances. The basis for such an interpretation has to be the patent as granted itself, as it can be understood by a skilled person, whereas the intention of the patent proprietor, which is a subjective factor different from the concrete aim of the patent, is not decisive.

4.2.2 Therefore, claim 1 of the main request has not been amended in such a way as to extend the protection conferred and thus does not contravene the requirements of Article 123(3) EPC.

5. *Novelty with respect to claim 1 of the main request*

5.1 Document D3 discloses a method for milking a mammal comprising:

providing a teat cup 3 having a liner 5 for location around a teat of a mammal;

defining a milk flow passage within said liner 5 and a pulsation chamber 7 between said liner 3 and said teat cup 3;

applying a negative pressure below atmospheric pressure to said milk flow passage;

supplying a negative pressure to the pulsation chamber 7 during the on portion of a pulsation cycle ,

supplying a higher pressure to the pulsation chamber of the teat cup during the off portion of the pulsation cycle,

using a pulsator B1 associated with throttle valves D3 and D4, wherein the unit formed by the pulsator B1 and the valves D3 and D4 is a variable pressure source suitable for controllably varying the rate of the pressure change in the pulsation chamber of the teat cup (see column 6, lines 61 to 69; Figure 1), which supplies a controllably variable pressure to the pulsation chamber.

The unit formed by the pulsator B1 and the valves D3 and D4 also supplies a controllably variable pressure to the pulsation chamber.

Moreover, this unit changes the slope of the transition curves between on and off portions of the pulsation cycle, so that it can be assumed that said unit varies the pressure supplied to the pulsation chamber along a controllably variable pressure curve of selectable waveshape.

Furthermore, having regard to the comments in section 1 above, the combination of the pulsator B1 and the valves D3 and D4 cannot be considered as "a conventional two-way valve pulsator alternating between a first condition connecting the negative pressure source to the pulsation chamber and a second condition supplying atmospheric or higher pressure to the pulsation chamber as on and off portions of a pulsation cycle".

5.1.1 The appellant asserted that document D3 discloses the possibility of controlling the slope of the pressure change on the basis of the milk flow either during the same pulsation cycle (claim 4: column 1, lines 46 to 52) or during the next pulsation cycle (claim 5: column 1, lines 53 to 58) and argued that the subject-matter of claim 1 was novel because document D3 does not disclose the possibility of controlling the slope of the pressure change during the same transition.

The board considers this argument as being irrelevant because claim 1 does not refer to the transitions between on and off portions of the pulsation cycle.

5.2 Therefore, the subject-matter of claim 1 of the main request lacks novelty having regard to document D3. Consequently, the main request of the appellant has to be rejected.

6. *Articles 84 with respect to the independent claims 1 and 20 of the auxiliary request I*

6.1 Claim 1 of the auxiliary request I differs from claim 1 of the main request by the addition of the following feature:

(e) "the method further comprises abruptly changing the pressure at the beginning of the transition from at least one of said on and off portions of said pulsation cycle, and then varying the pressure at a slower rate of change, all during said transition".

6.1.1 Feature e substantially corresponds to the subject-matter of claim 6 of the patent as granted. Therefore, for the same reasons given in section 3.3.1 above, the objections under Article 84 EPC raised by the respondent against this feature are considered as being inadmissible.

6.2 Claim 20 of the auxiliary request I of the appellant differs from claim 25 of the patent as granted not only in that the feature according to which "the variable pressure source (82) is arranged to controllably vary the rate of pressure change applied to said pulsation chamber without using a two-way valve pulsator" (column 18, lines 51 to 54) has been replaced by the feature

(c²⁰) "the variable pressure source (82) is arranged to controllably vary the rate of pressure change applied to said pulsation chamber without using a two-way valve pulsator, alternating between a first condition connecting the negative pressure source to the pulsation chamber and a second condition supplying atmospheric or higher pressure to the pulsation chamber as on and off portions of a pulsation cycle"

but also in that the following features have been added:

(d²⁰) "said variable pressure source (82) is arranged to supply a controllably variable pressure to said pulsation chamber (32;34) and to vary the pressure supplied to said pulsation chamber (34;34) along a

controllably variable pressure curve of selectable waveshape";

(e²⁰) "said variable pressure source (82) is further arranged to provide an abrupt pressure change at the beginning of the transition from at least one of said on and off portions of said pulsation cycle, followed by a slower rate of pressure change".

6.2.1 Feature c²⁰ contains the amended disclaimer referred to in claim 1. Features d²⁰ and e²⁰ are substantially identical with the features specified in claims 27 and 28 of the patent as granted. Thus, the considerations in the above sections 3.1, 3.2, 3.3 and 6.1.1 apply *mutatis mutandis* for claim 20 of the auxiliary request I. Therefore, the objections under Article 84 EPC raised by the respondent are inadmissible.

6.3 It has to be noted that during the oral proceedings the appellant asserted that the passage in the description of the patent which contemplates using a two-way valve as a variable pressure source was no longer consistent with the claims of the auxiliary request I.

7. *Article 123 with respect to the independent claims 1 and 20 of the auxiliary request I*

7.1 Having regard to the considerations in the above sections 4.2 to 4.2.2, the independent claim 1 of this request does not contravene Article 123(3) EPC. This applies *mutatis mutandis* for claim 20.

7.2 Feature e (see the above section 6.1) can be derived from claim 5 of the Aaf. Therefore, having also regard to the considerations in the above sections 4.1 to 4.1.3, claim 1 of the first auxiliary request does not contravene the requirements of Articles 100(c) and 123(2) EPC.

7.3 Features c²⁰, d²⁰ and e²⁰ in claim 20 of the first auxiliary request can be derived from claims 49 to 52 of the Aaf. Therefore, this claim does not contravene the requirements of Articles 100(c) and 123(2) EPC.

8. *Novelty of the subject-matter of the independent claims 1 and 20 of the auxiliary request I*

8.1 The subject-matter of claim 1 of this request differs from that of claim 1 of the main request by feature e.

Feature e in claim 1, which is directed to a method of milking a mammal, defines a method step, i.e. an activity which has to be performed during at least one of the transitions between the on and off portions of the pulsation cycle. This activity consists in providing at least two different rates of change of pressure during the transition from at a least one of the on and off portions to the other one of the portions of the pulsation cycle.

Claim 20, which is directed to a milking apparatus for milking a mammal, specifies a feature corresponding to feature e, namely feature e²⁰ which represents a functional definition of a means allowing the above mentioned step or activity to be performed. According to feature e²⁰, the variable pressure source is

"arranged to provide" at least two different rates of change of pressure.

Thus, feature e implies that the rate of change of pressure applied to the pulsation chamber is controlled during the transitions so that the rate of change of pressure is actively varied, while feature e²⁰ implies that the apparatus is provided with means for controlling the rate of change of pressure applied to the pulsation chamber during the transitions so that the rate of change of pressure can be actively varied. This interpretation of features e and e²⁰ is consistent with the description (column 3, lines 8 to 19; column 9, lines 21 to 28) and the drawings (Figures 7, 8, 10 and 12) of the patent.

8.2 Document D3 refers to the possibility of choosing the rate of change of pressure during the transitions by means of the valves (with variable orifices) D3 and D4 (see column 6, line 61 to column 7, line 4).

8.2.1 The drawings of this document (see particularly Figures 2 and 3) represent graphs showing the pressure in the pulsation chamber during the pulsation cycle. These graphs show that during the transition time from the on portion pressure (negative pressure (-40 kPa) in the pulsation chamber) to the off portion (atmospheric pressure in the pulsation chamber) the transition curve has a slope with a continuously decreasing rate of change of pressure.

With regard to these graphs, the respondent asserted that the shape of the transition curve implies that at the beginning of the transition from the on portion to

the off portion there is a high rate of change (so as to have an "abruptly changing") while thereafter there is a slower rate of change. In these respects the respondent argued that the drawings of document D3 also disclose features e and e²⁰ so that the content of document D3 deprives of novelty the subject-matter of claims 1 and 20 of the first auxiliary request.

- 8.2.2. The board cannot accept these arguments of the respondent for the following reasons:

Document D3 does not refer to the possibility of actively varying the rate of pressure change **during the transitions** from a portion (on or off) to another portion (off or on) of the pulsation cycle. Even if the drawings show a transition curve with a continuously decreasing rate of change of pressure, this does not mean that the apparatus disclosed in this document is arranged to **control** the rate of change of pressure during the transition so that the rate of change of pressure is **actively** varied.

- 8.2.3 Therefore, document D3 does not disclose either feature e or feature e²⁰.

- 8.3 Document D1 discloses a method for milking a mammal comprising:

providing a teat cup 4 having a liner 5 for location around a teat of a mammal;

defining a milk flow passage 7 within the liner and a pulsation chamber 6 between the liner and said teat cup;

applying a negative pressure below atmospheric pressure to said milk flow passage;

supplying a negative pressure to the pulsation chamber during the on portion of a pulsation cycle ,

supplying a higher pressure to the pulsation chamber of the teat cup during the off portion of the pulsation cycle,

using a pulsator 11 associated with controllable valves 16, 17 and 18, wherein the unit formed by the pulsator and the valves 16, 17 and 18 supplies a controllably variable pressure to the pulsation chamber.

8.3.1 The drawings of document D1 (see particularly Figures 2 to 4) represent graphs which also show transition curves having a continuously decreasing rate of change of pressure. However, document D1 does not disclose the possibility of controlling the rate of change of pressure during the transitions so that the rate of change of pressure is actively varied.

8.3.2 Therefore, document D1 does not disclose features e and e²⁰.

8.4 Having regard to the above considerations, the subject-matter of claims 1 and 20 of the auxiliary request I is novel with respect to the documents D3 and D1.

9. *Further prosecution of the proceedings*

9.2 In the decision G 2/03 of 8 April 2004 (see particularly section 2), the Enlarged Board of Appeal dealt with the allowability of "undisclosed disclaimers", i.e. "negative features" which have no basis in the application as filed, and *inter alia* found that an undisclosed disclaimer "which is or becomes relevant for the assessment of inventive step ... adds subject-matter contrary to Article 123(2) EPC" (see Order, point 2.3).

Having regard to the considerations in section 2.1 above, the amended disclaimer cannot be considered as being an "undisclosed disclaimer".

However, in the decision under appeal, the opposition division considered this feature, which was also specified in claim 1 filed with the letter dated 6 March 2002, as being a "disclaimer" of the type referred to in the decisions T 170/87 and T 597/92, i.e. as being an "undisclosed disclaimer", and asserted that "a disclaimer can be used to make an inventive teaching which overlaps with the prior art but it cannot make an obvious teaching inventive" (see section 5.1). On the basis of this interpretation, the opposition division disregarded the amended disclaimer in assessing inventive step. Therefore, the existence of an inventive step cannot have been reasonably assessed.

9.3 With the communication dated 13 September 2004 the board informed the parties of its intention to remit the case to the first instance for further prosecution (Article 111(1) EPC), given that the disclosed

disclaimer has not been taken into consideration by the opposition division when assessing inventive step.

- 9.3.1 The appellant submitted that in order to accelerate the proceedings it could be appropriate to deal with inventive step during the oral proceedings before the board in view of pending infringement proceedings concerning the patent in suit.

In principle a case is remitted to the first instance when in its decision the first instance *inter alia* fails to take account of the inventive merits, the decision being issued on the strength of a lack of novelty or when the inventive merit has not been properly assessed. It is true that in exercising its discretionary powers a board must take into account the public's as well as the parties' common interest in having opposition proceedings conducted speedily and, as far as reasonably possible, without remittal. However, if as in the present case a substantive issue has not yet been properly examined, the board's opting to consider that issue would mean that it was continuing the examination of the opposition. This is clearly not the task of a Board of Appeal (see in particular decision T 611/90 OJ EPO 93, 50 point 3 of the reasons) and would deprive the parties of their right to have the issue of inventive step properly examined if necessary by two instances.

The respondent was in favour of a remittal for further prosecution.

- 9.4 Under these circumstances and in the exercise of its discretion under Article 111(1) EPC the board remits

the case to the first instance for further prosecution, in order to examine *inter alia* whether the subject-matter of the independent claims 1 and 20 of the first auxiliary request involves an inventive step.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

G. Magouliotis

M. Ceyte