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D E C I S I O N
of 30 June 2004

Case Number: T 1138/02 - 3.2.4

Application Number: 95935612.2

Publication Number: 0737031

IPC: A01J 5/017, A01J 7/04

Language of the proceedings: EN

Title of invention:
An implement for milking animals

Patentee:
MAASLAND N.V.

Opponent:
Prolion B.V.

Headword:
-

Relevant legal provisions:
EPC Art. 100(a), 111(1), 112, 123(2)(3)
EPC R. 57a

Keyword:
"Referral to the Enlarged Board of Appeal (no) - immaterial to the Board's decision"
"Admissibility of the main request (no)"
"First auxiliary request - novelty (yes) - inventive step (yes)"

Decisions cited:
G 0001/84, G 0003/98, J 0016/90, T 0295/87, T 0223/97

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 1138/02 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 30 June 2004

Appellant: (Proprietor of the patent)
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 11 October 2002 revoking European patent No. 0737031 pursuant to Article 102(1) EPC.**

Composition of the Board:

Chairman: M. Ceyte
Members: C. Scheibling
M.-B. Tardo-Dino

Summary of Facts and Submissions

I. By its decision dated 11 October 2002, the Opposition Division revoked the patent. On 7 November 2002 the appellant (patentee) filed an appeal and paid the appeal fee simultaneously. The statement setting out the grounds of appeal was received on 30 January 2003.

II. The opposition was grounded on Articles 100(a) EPC (54 and 56 EPC) and 100(c) EPC.

III. The following documents played a role in these proceedings:

D0: EP-A-0 476 771

D1: EP-A-0 630 558

D2: WO-A-9412019

D3: EP-A-0 277 396

D6: "VDI/MEG Kolloquium Landtechnik", Tagung Braunschweig-Völkenrode, 5/6 December 1990; pages 45 to 69 and 111 to 126

IV. Oral proceedings took place on 30 June 2004.

The appellant (patentee) requested that the decision under appeal be set aside and that the patent be maintained on the basis of the set of claims filed on 28 May 2004 according to his main request or on the basis of one of the set of claims according to one of

his auxiliary requests one to four filed at the oral proceedings.

Furthermore, the appellant requested that the following question be referred to the Enlarged Board of Appeal: "In case in appeal proceedings the main claim of a granted European patent falls due to grounds for opposition and there are several defendable combinations with subclaims possible, can the patentee be forced to give up subject-matter under Rule 57a EPC by having to choose between said combinations and not being allowed to defend said combinations in parallel with a single request containing a plurality of independent claims ?"

V. The independent Claims of the main request read as follows:

"1. An implement for milking animals, such as cows, comprising a milk box (1) including a milking robot (9) for automatically connecting teat cups (11) to, respectively disconnecting them from the teats of an animal, and for automatically milking this animal, the milk box having cleaning means for automatically cleaning the teats of the animal before the teat cups (11) are connected thereto, the milk box comprising means (14, 19) for automatically removing foremilk from the teats of the animal, which can be activated before the teat cup (11) is connected for milking the usable milk of said animal, characterized in that the means for removing foremilk are constituted by a second group of teat cups (14) which can automatically be connected to, respectively disconnected from the teats of an animal."

"2. An implement for milking animals, such as cows, comprising a milk box (1) including a milking robot (9) for automatically connecting teat cups (11) to, respectively disconnecting them from the teats of an animal, and for automatically milking this animal, the milk box having cleaning means for automatically cleaning the teats of the animal before the teat cups (11) are connected thereto, the milk box comprising means (14, 19) for automatically removing foremilk from the teats of the animal, which can be activated before the teat cup (11) is connected for milking the usable milk of said animal, characterized in that the means for removing foremilk are constituted by the cleaning means (19)."

"23. An implement for milking animals, such as cows, comprising a milk box (1) including a milking robot (9) for automatically connecting teat cups (11) to, respectively disconnecting them from the teats of an animal, and for automatically milking this animal, the milk box having cleaning means for automatically cleaning the teats of the animal before the teat cups (11) are connected thereto, the milk box comprising means (14, 19) for automatically removing foremilk from the teats of the animal, which can be activated before the teat cup (11) is connected for milking the usable milk of said animal, characterized in that there is provided a sensor (26) to detect whether or not foremilk has been removed."

"29. An implement for milking animals, such as cows, comprising a milk box (1) including a milking robot (9) for automatically connecting teat cups (11) to, respectively disconnecting them from the teats of an

animal, and for automatically milking this animal, the milk box having cleaning means for automatically cleaning the teats of the animal before the teat cups (11) are connected thereto, the milk box comprising means (14, 19) for automatically removing foremilk from the teats of the animal, which can be activated before the teat cup (11) is connected for milking the usable milk of said animal, characterized in that there are provided means to check the foremilk collected, e.g. on colour, electric conductivity, filter resistance, etc., and, depending on the results of this check, to determine the time during which foremilk is removed."

"31. An implement for milking animals, such as cows, comprising a milk box (1) including a milking robot (9) for automatically connecting teat cups (11) to, respectively disconnecting them from the teats of an animal, and for automatically milking this animal, the milk box having cleaning means for automatically cleaning the teats of the animal before the teat cups (11) are connected thereto, the milk box comprising means (14, 19) for automatically removing foremilk from the teats of the animal, which can be activated before the teat cup (11) is connected for milking the usable milk of said animal, characterized in that the time during which foremilk is removed depends on the relative animal."

"34. An implement for milking animals, such as cows, comprising a milk box (1) including a milking robot (9) for automatically connecting teat cups (11) to, respectively disconnecting them from the teats of an animal, and for automatically milking this animal, the milk box having cleaning means for automatically

cleaning the teats of the animal before the teat cups (11) are connected thereto, the milk box comprising means (14, 19) for automatically removing foremilk from the teats of the animal, which can be activated before the teat cup (11) is connected for milking the usable milk of said animal, characterized in that the foremilk is discharged to a separate tank (18)."

The sole independent claim of the first auxiliary request corresponds to claim 2 of the main request.

VI. The appellant argued that since claim 1 as granted was not novel and since unity of invention was no longer a requirement at this stage of the proceedings, a plurality of independent claims covering each possible combination of former claim 1 as granted with one of the former dependent claims should be admissible in a single request, because each of said new independent claims would result from amendments occasioned by a ground for opposition. Furthermore, restricting the number of independent claims would amount to force the patentee to give up subject-matter.
With respect to novelty and inventive step, the appellant mainly argued that D1 discloses two embodiments, a first one where no foremilking takes place and a second one where the means for foremilking are also the means for milking the usable milk; that D6 does not disclose that the means for removing the foremilk are constituted by the cleaning means; that the sole embodiment of D2 disclosing cleaning means which are separate from the milking means does not disclose removing milk during the cleaning operation and that D2 does not disclose foremilking at all; that D3 does not disclose means to remove foremilk which can

be activated before the teat cup for milking the usable milk is connected; that D0 does not disclose foremilking.

VII. The respondent (opponent) requested that the appeal be dismissed, and that the request for referral to the Enlarged Board of Appeal be rejected.

The respondent had argued in writing that by modifying the feature reading "…comprising means (14, 19) for automatically removing foremilk from the teats of the animal, which are activated before the teat cup (11) is connected…" to read "…comprising means (14, 19) for automatically removing foremilk from the teats of the animal, which can be activated before the teat cup (11) is connected…" the appellant extended the subject-matter beyond the content of the application as filed. He further argued that the subject-matter of claim 1 of the first auxiliary request was not new with respect to D1 or D2, or at least did not involve an inventive step with respect to D2 taken alone or with respect to D2 or D0 taken in combination with D3.

Reasons for the Decision

1. The appeal is admissible.

2. *Admissibility of the main request:*

2.1 It is true that according to Rule 57a EPC, amendments to the claims are permitted provided they are occasioned by grounds for opposition specified in Article 100 EPC even if the respective ground has not

been invoked by the opponent. However, opposition appeal proceedings are an independent procedure which is not to be seen as a continuation or extension of the substantive examination procedure (see G 1/84, OJ EPO 1985, 299). This is to be seen in the restriction imposed on the patent proprietor to only amend the existing independent claims of the granted version during the opposition proceedings. Generally speaking it is not permitted to add new additional independent claims; it is only permitted to define more precisely the invention claimed in the independent claims, so as to challenge more effectively e.g. the lack of patentability raised by the opponent. This prohibition is also justified by the fact the added independent claims can not be regarded as a restriction to the existing independent claims as granted and therefore as an attempt on the part of the patent proprietor to meet a ground for opposition.

According to the established jurisprudence of the Boards of Appeal, the addition of new claims is not considered as occasioned by the grounds of opposition, if the subject-matter of these claims although having an adequate support in the original description has not previously been claimed as such in the granted version; see T 295/87, OJ OEB 1990, 470.

In the Board's view the addition of independent claims is inadmissible irrespective of the fact that their subject-matter is new or not in comparison with the claims as granted. This means that an introduction of an additional independent claim which corresponds to a granted dependent claim is not admissible either. Opposition proceedings should not be an opportunity for

the patent proprietor to introduce additional independent claims for purposes which are not in fact related to meeting a ground for opposition.

An exception to this principle may be made in the case dealt with by decision T 223/97, where the subject-matter of an independent claim covers two alternatives e.g. two structurally distinct variants. The replacement of this granted claim by two independent claims each directed to one of these two alternatives is to be considered as a restriction to the granted main claim, since only the two alternatives would still be protected. Expressed differently such replacement is to be seen as an amendment from the patent proprietor aiming at more precisely defining subject-matter of the main claim so as to more effectively challenge the ground(s) for opposition raised by the opponent.

2.2 In the present case, claim 1 as granted claims in its characterising part means (14, 19) for automatically removing foremilk from the teats of the animal. Claims 2 and 3 as granted define two structurally distinct variants or alternatives of the claimed means for removing foremilk; according to claim 2, the means for removing foremilk are constituted by a second group of teat cups and according to claim 3 said means are constituted by the cleaning means. The new independent claims 1 and 2 each directed to one of these two variants are to be seen as an amendment aiming at more precisely defining the means for removing foremilk claimed in claim 1 as granted, in order to meet the lack of patentability raised by the opponent. Accordingly, the introduction of these two independent

claims is to be regarded as occasioned by the grounds for opposition and is therefore admissible.
This does not apply to the new independent claims 23, 29, 31 and 34, wherein:
claim 23 is a combination of granted claims 1 and 23;
claim 29 is a combination of granted claims 1 and 28;
claim 31 is a combination of granted claims 1 and 29;
claim 34 is a combination of granted claims 1 and 31.
Claim 23 as granted requires the presence of a sensor (26) to detect whether or not foremilk has been removed; claim 28 as granted requires the presence of means for checking the foremilk collected; claim 29 as granted requires the time during which foremilk is removed being dependent on the relative animal and claim 31 as granted requires that the foremilk should be discharged to a separate tank.
None of these dependent claims defines alternatives for the means or organs specifically claimed in claim 1 as granted; they merely define preferred embodiments of the implement claimed in granted claim 1.
It follows that the addition of the new independent claims 23, 29, 31 and 34 which correspond to the granted dependent claims 23, 28, 29 and 31 is not to be regarded as occasioned by the grounds for opposition and is thus not admissible.

Consequently, the main request is not admissible.

3. *Referral of a question to the Enlarged Board of Appeal*

3.1 Pursuant to Article 112(1)(a) EPC if an important point of law arises a Board of Appeal during proceedings on a case may refer any question of law to the Enlarged Board of Appeal if it considers that a decision is

"required" for this point. According to the well established jurisprudence of the Boards of Appeal an answer to the point of law referred must be necessary to the decision of the Board of Appeal. If the Board can reach a decision though it leaves open the question to be referred, then the referral is not "required" within the meaning of Article 112(1)(a) EPC and thus, not admissible, even if relating to an important point of law of general interest (see J 16/90, OJ EPO 1992, section 1.2; G 3/98 OJ EPO 2001, 62, section 1.2).

In the present case, the referral of the question concerning the main request is to be rejected as inadmissible since, as stated hereinafter, this main request is, in any case, not allowable having regard to Article 123(2) EPC, so that the question of law posed by the Appellant can be evaded.

3.2 Indeed, the main request comprises, *inter alia*, an independent claim 29 which is a combination of the features of claims 1 and 28 as granted. Claim 28 as granted referred back to any one of claims 23 to 27; however the features of claim 23 as granted have not been introduced into claim 29 according to the main request. The appellant has considered that the wording of the new independent claim 29 can be founded on the passage of the description as originally filed, page 4, lines 5 to 23. This passage refers to the presence of a sensor to detect whether or not foremilk has been removed as well as to means for checking the foremilk collected. Thus, the means to check the foremilk collected (the features of claim 28 as granted) are disclosed in this passage in combination with the

sensor to detect whether or not foremilk has been removed (the features of claim 23 as granted).

3.3 Consequently, the introduction of the features of claim 28 as granted into a new independent claim, without introducing the features of claim 23, contravenes the provisions of Article 123(2) EPC. This conclusion was agreed to be the appellant during oral proceedings.

3.4 For this reason, and irrespective of any other considerations, even if the main request were admissible, it would not be allowable. Consequently, the question the appellant requested to refer to the Enlarged Board of Appeal has to be left open because it is not material to the Board's decision on the main request.

4. *First auxiliary request - amendments*

4.1 Claim 1 according to the first auxiliary request results from the combination of the features of claims 1 and 3 as originally filed, with the indication that the cleaning means and the means for removing foremilk from the teats of the animal are part of the milk box and with the modification of the expression "which are activated" so as to read "which can be activated".

4.2 The indication that the cleaning means and the means for removing the foremilk are part of the milk box is supported by the whole of the description, as well as by the figures.

4.3 The respondent argued that by amending the expression "which are activated before the teat cup (11) is connected for milking the usable milk" to read "which can be activated before the teat cup (11) is connected for milking the usable milk", the "activation" does not compulsorily take place "before" the teat cup is connected for milking the usable milk. Thus, implements in which the means for removing foremilk are activated after the teat cup is connected for milking usable milk are also covered by the amended wording.
However, even if "can be activated" does not mean that it has to be activated compulsorily; "can" clearly indicates that the possibility to do so must be given. This means that the implement must enable the activation of the means for automatically removing foremilk before the teat cup is connected for milking the usable milk, whether said activation takes effectively place or not.

4.4 Consequently, the modification of the wording of the claim has no influence on the constructive features of the implement, and implements wherein the means for removing foremilk are activated after the teat cup is connected for milking usable milk are still clearly excluded by the amended wording.

4.5 Therefore, the amendments made do not contravene the requirements of Article 123(2) EPC.

4.6 Since the features which have been added further limit the protection conferred by the new independent claim 1, the requirements of Article 123(3) EPC are also met.

4.7 An amended description has been filed in oral proceedings in order to adapt it to the wording of the new independent claim. Said amended description meets the requirements of Article 123(2) EPC. This point has not been disputed by the respondent.

5. *Novelty of the subject-matter of claim 1 according to the first auxiliary request*

5.1 With respect to D1:

5.1.1 D1 discloses two embodiments.
In the first embodiment (Figures 1 to 3), a first robot arm provided with teat cups and a second robot arm provided with a cleaning and massaging device, are disclosed. With respect to this embodiment no reference is made to means for automatically removing foremilk.

5.1.2 The second embodiment (Figures 5 to 7) discloses a first robot arm provided with a sensor (98) to determine the coordinates of the teats and a second robot arm provided with a cleaning and massaging device (107), which can also be utilised as a foremilking device (column 10, lines 42 to 49). Since in this embodiment the first robot arm does not comprise teat cups, and since it is said (column 10, lines 49 to 51) that "It will be obvious that with the foremilking device 107 it is also possible to milk "normally teat after teat", when reading the corresponding passage, a skilled person will consider that, in the second embodiment "normal milking" is carried out by device 107 of the second robot arm (by milking teat after teat). Thus, in the second embodiment the means

for removing the foremilk cannot be activated before the teat cup for milking the usable milk is connected.

5.1.3 The respondent considered that from the whole of the description of D1 a skilled person would be given a teaching disclosing all the features of claim 1, and furthermore, that the combination of claims 1 and 2 of D1 discloses a possible embodiment of the invention which would be novelty destroying for claim 1.
First of all, the Board wants to point out that a vague assertion cannot be considered to be an argument. Moreover, such a consideration cannot be directly and non-ambiguously derived from D1, and thus, requires from a skilled person an intellectual step (operation) involving more than a simple application of general knowledge to D1. In fact, a lack of information (i.e. a lack of definition) cannot be considered to be an unambiguous disclosure and therefore, a vague assertion cannot prejudice the novelty of claim 1 of the patent in suit.
In the same way, claims 1 and 2 of D1 are silent about cleaning and therefore the object disclosed therein cannot be novelty destroying without including the disclosure of the description which indicates that the cleaning/massaging device is also utilized as a foremilking device; see column 10, lines 42 to 55. However, this passage and the Figures, also make clear for a person skilled in the art that the teat cup used for cleaning purposes and for removing the foremilk is also used for milking the animal. Therefore, when read in the light of the description, the feature of claim 2 of D1 which reads: "the foremilking device comprises a separate teat cup (108)" has to be construed as meaning that the teat cup (108) is a special type of teat cup

and not as being an additional teat cup with respect to the teat cup for milking the usable milk.

However, the respondent has not demonstrated that such teaching can be deduced clearly and unambiguously from D1.

5.2 With respect to D2:

5.2.1 D2 mainly discloses three embodiments.

5.2.2 A first embodiment is defined page 5, line 28 to 31 as follows: "The tubular arrangement last described could form part of the actual milking arrangement and the first small amount of milk drawn from the teat could be used to clean the teat, the milk being discarded" and a third embodiment is defined page 6, lines 2 and 3 as follows: "a suitably modified milking device is used and the first amount of milk diverted from the usual collector".
Thus, even if admitting that "the first amount of milk" means "the foremilk", in the first and third embodiments, it would not be possible to activate the means for automatically removing foremilk from the teats of the animal before the teat cup for milking the usable milk of said animal is connected.

5.2.3 In a second embodiment as defined page 5, line 33 to page 6, line 2, a separate teat cleaning arrangement is placed on each teat for a short while, the robot replacing these with milking devices in turn.
In this second embodiment there is no indication that any foremilking takes place at all.

5.3 With respect to D3:

According to D3 the cup used for cleaning is also suitable for milking and even if considering that foremilking takes place (see column 3, lines 13 to 27), in D3, it would not be possible to activate the means for automatically removing foremilk from the teats of the animal before the teat cup for milking the usable milk of said animal is connected.

5.4 With respect to D6:

D6 does not disclose that the means for removing the foremilk are constituted by the cleaning means.

5.5 Indeed none of the cited documents discloses all of the features of claim 1 according to the first auxiliary request. Thus novelty of the subject-matter of claim 1 according to the first auxiliary request is given with respect to the cited prior art documents.

6. *Inventive step of the subject-matter of claim 1 according to the first auxiliary request*

6.1 D6 is considered to be the closest prior art document. D6 discloses an implement for milking animals, such as cows, comprises a milk box (section 3.1; Figure 3). It is further indicated that such a milk box has to include milking robot (Figure 8) for automatically connecting teat cups to, respectively disconnecting them from the teats of an animal, and for automatically milking this animal. The milk box also comprises cleaning means (Figure 4) for automatically cleaning the teats of the animal before the teat cups are

connected thereto, and the milk box comprises means (Figure 9 and following passage, page 119) for automatically removing foremilk from the teats of the animal, which can be activated before the teat cup is connected for milking the usable milk of said animal.

6.2 Thus the implement according to claim 1 of the first auxiliary request differs from that known from D6 in that the means for removing the foremilk are constituted by the cleaning means.

6.3 Therefore, the problem to be solved by the invention can be seen in providing an implement for milking animals in which no contamination of the usable milk by the foremilk can take place and which exhibits improved efficiency of the cleaning and foremilking means.
This problem is solved by using the same means for cleaning and foremilking and as a result, the time needed to perform the cleaning and foremilking operations is reduced.

6.4 The sole cited document which discloses the use of the same means for cleaning and for removing the foremilk is D3. However in D3 the same means are also used for milking the usable milk.
Consequently, even if a person skilled in the art would consider applying the teaching of D3 to D6, it would result in providing D6 with teat cups able to clean the teats, to remove the foremilk and to milk the animal, all together. Thus, the resulting implement would not be able to activate the means for removing the foremilk before the teat cup for milking the usable milk is connected.

6.5 The respondent considered D2 to form the closest prior art document. He submitted that the combination of the teachings of different embodiments of D2 would lead a skilled person to the subject-matter of claim 1 in suit.

However a skilled person needs to start from a well defined starting point, i.e. a precisely defined object. He cannot be expected to modify the mechanical structure of a prior art object in order to solve a given problem, if said object is not a comprehensively defined one but a hypothetical one.
Therefore a skilled person cannot choose as starting point, a combination of teachings of D2 but only one of the defined specific embodiments of D2.

6.6 The appellant objected that D2 does not disclose foremilking at all. D2 indicates that "the first small amount of milk drawn from the teat could be used to clean the teat" and that "the loss of milk yield is of little significance" (page 5, lines 29 to 31). From this passages, the appellant deduced that in the meaning of D2, "the first small amount of milk drawn from the teat" has to be construed as meaning "the first amount of usable milk drawn from the teat" since a skilled person would not use contaminated foremilk for cleaning purposes and since foremilk is not usable milk and therefore cannot have any influence on the milk yield.

6.7 The Board concludes from this that D2 does not provide a skilled person with a clear teaching, which would be necessary to consider D2 as the most promising starting point.

6.8 But even if considering that D2 does disclose foremilking in the first and third embodiments, then the means for cleaning and foremilking would also perform the normal milking (as in D3), so that it would not be possible to activate the means for removing the foremilk before the teat cup for milking the usable milk is connected, whether considering these embodiments of D2 alone or in combination with D3. In the second embodiment of D2 no foremilking is disclosed and should a person skilled in the art try to improve said embodiment by providing foremilking, he would obviously choose one of the other embodiments disclosed in D2 already performing foremilking, because he cannot be expected to modify the second embodiment in absence of promptings in the prior art without exerting inventive skill.

6.9 The appellant also considered that D0 in combination with D2 would disclose all the features of claim 1 of the first auxiliary request.
Claim 1 of the first auxiliary request differs from D0 in that:
the milk box comprises means for automatically removing foremilk from the teats of the animal, which can be activated before the teat cup is connected for milking the usable milk,
the means for removing the foremilk are constituted by the cleaning means.

6.10 The sole embodiments of D2 which eventually disclose foremilking are the first and third embodiments. However in these embodiments the means for removing the foremilk are also used to milk the usable milk. Therefore, a combination of the first or third

embodiment of D2 with the implement according to D0 would likewise use the foremilking device to milk the usable milk and thus not disclose that the means for automatically removing foremilk from the teats of the animal can be activated before the teat cup is connected for milking the usable milk and thus, not result in the implement as claimed.

6.11 Therefore, the subject-matter of claim 1 of the first auxiliary request involves an inventive step with respect to the cited prior art.

Order

For these reasons it is decided that:

1. The request for referral to the Enlarged Board of Appeal is rejected

2. The decision under appeal is set aside and the case is remitted to the first instance with the order to maintain the patent on the basis of the following documents:

   Claims: claims 1 to 29 of the first auxiliary request filed during oral proceedings,

   Description: columns 1 to 6 filed during oral proceedings,
   columns 7, 8 and 9 as granted,

   Drawings: Figures 1 to 11 as granted

The Registrar: The Chairman:

G. Magouliotis M. Ceyte