

Internal distribution code:

- (A) [] Publication in OJ
(B) [X] To Chairmen and Members
(C) [] To Chairmen
(D) [] No distribution

D E C I S I O N
of 28 June 2005

Case Number: T 0874/03 - 3.2.04

Application Number: 95937223.6

Publication Number: 0741513

IPC: A01J 7/02

Language of the proceedings: EN

Title of invention:

An implement for milking animals

Patentee:

MAASLAND N.V.

Opponent:

DeLaval International AB

Headword:

-

Relevant legal provisions:

EPC Art. 104(1), 111(1), 123(2)

EPC R. 63.1

RPBA Art. 10b

Keyword:

"Document and its translation submitted for the first time during oral proceedings - *prima facie* relevant - exceptionally admitted with the agreement of the patentee"

"Remittal to the department of the first instance for consideration of this late filed material"

"Apportionment of costs to the detriment of the late filing party"

Decisions cited:

G 0009/91, T 1002/92

Catchword:

(i) A document filed shortly before, or during, the oral proceedings before the Board may not in principle be admitted into the proceedings, if its admission would lead to an adjournment of the proceedings;

(ii) However such late filed material may exceptionally be admitted if there are *prima facie* strong reasons that it would prejudice the maintenance of the European patent in whole or in part and if the patent proprietor agrees to its admission;

(iii) In such case the decision to admit such late filed material may in principle lead to an apportionment of costs to the detriment of the late filing party.



Case Number: T 0874/03 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 28 June 2005

Appellant: MAASLAND N.V.
(Proprietor of the patent) Weverskade 10
NL-3155 PD Maasland (NL)

Representative: Corten, Maurice Jean F.M.
Octrooibureau Van der Lely N.V.
Weverskade 110
NL-3147 PA Maassluis (NL)

Respondent: DeLaval International AB
(Opponent) P.O. Box 39
S-147 21 Tumba (SE)

Representative: Harrison, Michael Charles
Albihns GmbH
Bayerstrasse 83
D-80335 München (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 1 July 2003
revoking European patent No. 0741513 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: M. Ceyte
Members: C. Scheibling
T. Bokor

Summary of Facts and Submissions

- I. By its decision dated 1 July 2003 the Opposition Division revoked the patent. On 4 August 2003 the Appellant (patentee) filed an appeal and paid the appeal fee simultaneously. The statement setting out the grounds of appeal was received on 4 November 2003.
- II. Opposition was filed on the grounds based on Article 100(a) and (b) EPC. The opposition division found that the main request did not fulfil the requirements of Article 83 EPC and that the subject-matter of claim 1 according to the auxiliary request did not involve an inventive step.
- III. The following documents played a role in the present proceedings:
- D1: WO-A-94/08450
- D2: EP-A-0 476 771
- D3: GB-A-1 256 675
- D4: SU-A-1 412 672 and a translation into English (material submitted for the first time during oral proceedings before the Board)
- IV. Oral proceedings took place on 28 June 2005.
- The Appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the claims according to the main request or to the first auxiliary request, both filed with letter of

30 May 2005. He further requested that the case be remitted to the department of the first instance in order to take the late filed document D4 into consideration and that an apportionment of costs to the detriment of the Respondent (opponent) be ordered.

He mainly argued as follows: The requests now on file clearly overcome the objection raised under Article 100(b) EPC, since the contested claim 9 as granted has been deleted.

The claimed invention enables the detection of contaminations of all parts of the milking machine that come into contact with milk. Sensors are provided in all these relevant parts of the implement. Therefore, the sensors do not solely detect contaminations in the system but the contamination of the system itself. Consequently, the modification consisting in changing "in" to "of" does not contravene the requirements of Article 123(2) EPC.

D4 and its translation were filed for the first time during the oral proceedings. Therefore, the translation of D4 had first to be checked and the technical content of this document to be evaluated. The procedural steps to be undertaken would depending on the relevance of D4. Therefore, the case had to be remitted to the department of the first instance. Since the present appeal proceedings could have been avoided or at least postponed, had the Respondent filed D4 earlier, the costs incurred by the Appellant (two participants) for attending the oral proceedings before the Board were to be borne by the Respondent.

The Respondent (opponent) countered the Appellant's arguments and mainly argued as follows:

The amendment consisting in changing the word "in" to "of" in claim 1 of the main request is contrary to Article 123(2) EPC because the terminology "of the system" does not appear in the application as filed (WO-A-96/16536) in the way used in claim 1 as now amended. Furthermore, the amendment is an extension of protection contrary to Article 123(3) EPC, because such terminology no longer specifies where the contamination might be.

A new document D4 with a translation into English is cited against claim 1 of the new auxiliary request filed by the Appellant, because this new claim 1 has been so substantially modified that it was necessary to carry out a new search. D4 is one of the documents found and had to be translated. The translation was only available so recently that it was not possible to file it earlier.

The Respondent requested that the appeal be dismissed, that D4 be introduced into the proceedings, that the case be not remitted to the first instance and that the request of apportionment of costs be rejected.

V. Claim 1 according to the main request reads as follows:

"1. An implement for milking animals, such as cows, comprising at least one milking robot (8) for automatically connecting teat cups (4) to the teats of an animal, and at least one milking machine (1) for automatically milking the animals, characterized in

that the implement is provided with sensors (23 - 26) for the detection of contaminations of the milking system of the milking machine (1) "

Claim 1 according to the first auxiliary request reads as follows:

"1. An implement for milking animals, such as cows, comprising at least one milking machine (1) for milking the animals, the implement being provided with sensors (23 - 26) for the detection of contaminations in the milking system of the milking machine (1) characterized in that the milking machine (1) is suitable for automatically milking the animals, the implement comprises least one milking robot (8) for automatically connecting teat cups (4) to the teats of an animal, there is provided a computer (9) for the recording of contaminations in the milking system that have been ascertained by the sensors (23 - 26), on the basis of the information supplied by the sensors (23 - 26) there is defined a degree of contamination in the computer (9), there are provided cleaning means for the milking system, and the cleaning of the milking system is effected on the basis of the degree of contamination."

Reasons for the Decision

1. The appeal is admissible.
2. *Main request - Article 123(2) EPC*
 - 2.1 Claim 1 of the main request differs from claim 1 as originally filed (which in the present case was

published in the international application under number WO-A-96/16536) and as granted, in that the expression "the implement is provided with sensors for the detection of contaminations in the milking system" has been amended to read "the implement is provided with sensors for the detection of contaminations of the milking system".

2.2 The Appellant agreed that this amendment has been made in order to distinguish from implements which foresee detection of contaminations in the milk. Thus, the amendment of the word "in" to "of" is intended to exclude indirect detection of contamination, which is performed in the milk flow and not on the surfaces in contact with the milk.

2.3 However, there is no basis in the application as published under number WO-A-96/16536 for such an amendment.

Indeed, the expression "of the milking system" can be found in WO-A-96/16536 in the following passages:

page 1, lines 17 to 18 or 22, 23: "An other form of contamination of the milking system occurs when ...", "Again an other form of contamination of the milking system may occur when ..."

page 2, line 29: "the degree of contamination of the milking system is defined after..."

page 6, line 30 to 32 or lines 37, 38: "The application of the above mentioned sensors also enables to ascertain the degree of contamination of the milking system ...", "... recording of the degree of contamination of the milking system..."

These passages indicate that contamination of the milking system can occur, refer to the degree of

contamination of the milking system, or indicate that the sensors enable the ascertainment of the degree of contamination, but do not state whether the sensors are provided for the detection of contaminations of the milking system or in the milking system. Thus, they do not form a basis for the amendment made.

Further, there is no unambiguous disclosure in WO-A-96/16536 which could lead to the assumption that the sensors can detect contaminations of the milking system in absence of a detection of contaminations of the milk flowing in the milking system, i.e. it is not indicated that the sensors are able to perform a direct detection of contaminations deposited on the parts of the milking machine which come in contact with the milk.

The Appellant argued that one example of a possible sensor which performs a direct detection is a filter associated with pressure means as disclosed in claim 10 as granted. In his view, such a filter is a part of the milking machine and contaminations which are caught in the filter are therefore deposited on a surface of the milking machine. Therefore, this system performs a direct detection of deposited contamination.

This cannot be accepted. Although the filter is part of the milking machine, it does not detect the contaminations deposited on the surfaces of the machine which are in contact with the milk, but collects the particles or contaminations in suspension in the milk. Therefore, the filter/pressure means sensor does not perform a direct detection of contamination of the surfaces.

Furthermore, the aim of any filter is to retain particles in suspension in the liquid in order to avoid that said particles deposit and contaminate the circuit itself. Therefore, even if particles are retained in the filter and thus in the system, a person skilled in the art would not consider the particles retained in a filter as constituting contaminations of the system.

Therefore, claim 1 of the main request introduces information which is not directly and unambiguously derivable from that previously presented by the application as originally filed and hence contravenes the requirements of Article 123(2) EPC.

2.4 Thus, the main request is not allowable.

3. *First auxiliary request - Admissibility of the late filed document D4*

3.1 In proceedings before the Boards new facts and evidence which go beyond the facts and evidence presented in the notice of opposition should only be admitted into the proceedings if *prima facie* there are good reasons to suspect that such late-filed material would prejudice the maintenance of the European patent (see decision T 1002/92, OJ EPO 1995, 605)

According to the established practice of the Boards new facts and evidence, e.g. prior art documents filed shortly before, or during, the oral proceedings may not in principle be admitted into the opposition appeal proceedings, if they would lead to undue delay in the proceedings. Accordingly, the Rules of Procedure of the Boards of Appeal (RPBA) as amended in 2002 (OJ EPO

2003, 89) provide that any amendment to a party's case after it has filed its grounds of appeal - or after its reply to the grounds of appeal - may be admitted and considered at the Board's discretion; amendments sought to be made after oral proceedings have been arranged **shall not** be admitted, if they raise issues which the Board or the other party cannot reasonably be expected to deal with without adjournment of the oral proceedings (Article 10(b) points 1 and 3 RPBA)

In the present case document D4 and its translation into English were filed for the first time in the course of the oral proceedings before the Board. This document relates to a device for flushing (and thus cleaning) a milking unit comprising a data unit and contamination monitoring sensors. It is immediately apparent that this fresh material might represent the closest prior art.

Thus, it does appear to the Board that there are *prima facie* strong reasons to believe that the fresh material is relevant and could prejudice the maintenance of the European patent or cause its scope to be limited.

- 3.2 The Appellant requested that the oral proceedings be adjourned in order to allow him to check the accuracy of the translation into English which might affect the relevance of this material. In accordance with the right to a fair hearing, the Board before issuing a decision based on this new material against the patent proprietor, has a mandatory legal obligation to give that party an opportunity not only to refute the relevance of this late filed document and/or to amend the claimed subject-matter, but also to refute the

evidence filed with suitable documents of his own e.g. showing that the submitted translation was in fact inaccurate.

In such a case and in accordance with Article 10(b) point 3 RPBA cited above, such facts and evidence may not in principle be admitted into the proceedings because their admission would lead to an adjournment of the proceedings.

- 3.3 However, an exception to the above principle is justified in the case where the patent proprietor agrees to the admission of the fresh material. As emphasised by the Enlarged Board of Appeal in its decision G 9/91, OJ EPO 1993, 409, point 17 of the reasons, it may in some cases be in the patent proprietor's own interest that such facts and evidence are not excluded from consideration in the centralised procedure before the EPO. It is pointed out that such fresh material should be *prima facie* highly relevant in order to be exceptionally admitted into the proceedings with the agreement of the patent proprietor.

The above criteria set out by the Enlarged Board of Appeal in the decision G 9/91 concern the admissibility of a fresh ground for opposition. However, these criteria are also generally applicable to the admissibility of late filed facts and evidence submitted in support of a ground for opposition (see the above cited decision T 1002/92, point 3.2 of the reasons).

In the case to be decided both criteria set out in the decision G 9/91 which apply to the admissibility of late filed material are met:

- (i) as has already been explained the late filed material is *prima facie* highly relevant, and
- (ii) the patent proprietor has agreed to its admission into the proceedings.

3.4 For the above reasons the Board decides to admit prior art document D4 into the proceedings.

4. *Remittal to the first instance*

4.1 Under Article 111(1) EPC, it is at the Board's discretion either to examine and decide the case or to remit it to the department of the first instance, keeping in mind that in the first alternative the proceedings before the Board should be continued in writing in order to allow the patent proprietor in particular to verify the accuracy and quality of the translation of D4 and possibly to file e.g. an amended translation.

According to point 17 of the reasons given in decision G 9/91, if a fresh ground raised by an opponent - and this applies to fresh facts and evidence too - is admitted into the appeal proceedings, then the case should, having regard to the purpose of the appeal proceedings, be remitted to the department of the first instance for further prosecution, unless there are special reasons for doing otherwise. Thus, the examination of this fresh material should be undertaken by the department of the first instance so as to afford the parties two levels of jurisdiction, all the more so

when, as in the present case, the Appellant (patentee) has expressly asked for this.

- 4.2 The Respondent argued that claim 1 according to the new auxiliary request filed by the Appellant with letter of 30 May 2005 has been substantially modified with respect to claim 1 as granted. Therefore, an additional search had to be carried out. D4 was one of the documents found. However, it was not possible to file D4 earlier, because it had first to be translated into English. In other words, the filing of D4 has to be considered as a response to an unforeseeable modification of the claimed subject-matter.

Furthermore, in the Respondent's view D4 is a short document, easy to understand so that it would be possible to deal with it without delaying the proceedings or remitting case.

- 4.3 The Board does not share this point of view.

In the present case, claim 1 according to the first auxiliary request comprises the features of claims 1 to 4 as granted and was filed to overcome an objection based on Article 100(a) EPC. In the notice of opposition the Respondent stated that the subject-matter of none of claims 1 to 4 involved an inventive step. Thus, the Respondent had already considered the combination of claims 1 to 4 when filing the notice of opposition. Therefore, the combination of features resulting in the new claim 1 now on file cannot be considered as unforeseeable. On the contrary, it is the normal behaviour of a Patentee to combine the features of dependent claims with those of an independent claim

in order to attempt to overcome an objection of lack of inventive step.

Thus, since the scope of claim 1 according to the auxiliary request has not changed with respect to the scope of the combination of claims 1 to 4 as granted, the amendments made cannot justify the filing of a new prior art document.

5. *Apportionment of costs (Article 104(1) and Rule 63(1) EPC)*

When late filing of facts and evidence necessitates the remittal of the case to the department of the first instance, the costs of any oral proceedings in the appeal proceedings should normally be borne by the party responsible for the late filing.

The filing of document D4 for the first time during the oral proceedings, and its subsequent admission into the proceedings, will inevitably increase the costs to be incurred by the Appellant (patent proprietor) in defending his patent, compared to the normal costs which would have been incurred by the Appellant if document D4 had been filed in due time. As has already been explained in point 4 above, such late submission was not justified by a change in the subject of the proceedings.

Therefore, it is equitable in the present case that the expenses (travelling and accommodation costs for the two participants of the Appellant) incurred by the Appellant (not acting through a professional

representative) in connection with the oral proceedings in the appeal should be borne by the Respondent.

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.
3. The travel and accommodation costs of the Appellant incurred due to the oral proceedings before the Board shall be borne by the Respondent (opponent).

The Registrar:

The Chairman:

G. Magouliotis

M. Ceyte