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**Datasheet for the decision
of 6 March 2007**

Case Number: T 1481/05 - 3.2.04

Application Number: 99201331.8

Publication Number: 0954962

IPC: A01J 5/007

Language of the proceedings: EN

Title of invention:

A method of and an implement for automatically milking animals

Patentee:

MAASLAND N.V.

Opponent:

DeLaval International AB

Headword:

Pulse milkflow - MAASLAND

Relevant legal provisions:

EPC Art. 69, 84, 100(c), 111(2), 123(2), 123(3)

EPC R. 29(1), 29(6), 29(7)

Keyword:

"Added matter - main request (yes)"

"Reinsertion after grant of deleted definitions relating to the claimed subject-matter (admissible under Article 123(3) EPC)"

"Definitions enclosed in parentheses in the claims: lack of clarity - auxiliary request 1"

"Remittal for further prosecution - auxiliary request 2"

Decisions cited:

T 1149/97

Catchword:

-



Case Number: T 1481/05 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 6 March 2007

Appellant: MAASLAND N.V.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 14 November 2005
revoking European patent No. 0954962 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: M. Ceyte
Members: P. Petti
T. Bokor

Summary of Facts and Submissions

- I. An opposition - based upon Articles 100a) and c) EPC - was filed against the European patent No. 954 962. The opposition division by its decision dated 14 November 2005 revoked the patent. It held that the subject-matter of independent claims 1 and 10 filed with letter 15 September 2005 extended beyond the content of the application as filed (Articles 100(c) and 123(2) EPC).

These independent claims read as follows:

Claim 1: "A method of automatically milking animals, comprising the following steps:
measuring repeatedly or continuously the momentary pulse milk flow;
controlling the duration and/or the level of the milk vacuum under the teat during the actual suction phase on the basis of the measured quantity, characterized in that this method comprises the following steps:
storage, during the actual suction phase, of the maximum value of the pulse milk flow measured thus far or the quantity related thereto,
lowering or reducing or closing off the vacuum level of the milk vacuum as soon as the momentary value of the pulse milk flow or the quantity related thereto has come below a specific, preferably adjustable threshold value, which threshold value has a value between 60% and 80% of the maximum value of the pulse milk flow measured thus far or the quantity related thereto."

Claim 10: "An implement for automatically milking animals, said implement comprising at least one adjustable pulsator (5), at least one pulse milk flow

sensor (8), means for measuring repeatedly or continuously the momentary pulse milk flow, and means for controlling the duration and/or the level of the milk vacuum under the teat during the actual suction phase on the basis of the measured quantity, characterized in that the implement further comprises means for storing, during the actual suction phase, the maximum value of the pulse milk flow measured thus far or the quantity related thereto, and means for lowering or reducing or closing off the vacuum level of the milk vacuum as soon as the momentary value of the pulse milk flow or the quantity related thereto has come below a specific, preferably adjustable threshold value, which threshold value has a value between 60% and 80% of the maximum value of the pulse milk flow measured thus far or the quantity related thereto."

- II. On 30 November 2005 the 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 10 March 2005.
- III. Together with the statement setting out the grounds of appeal the appellant filed as first auxiliary request amended claims 1 to 17.

Each of independent claims 1 and 10 of this first auxiliary request differs from the corresponding claim of the main request in that the following sentences were added between parentheses:

- i) "(By pulse milk flow it is meant the milk flow from a teat during a single suction phase of the milking process)".

ii) "(By suction phase it is meant the time during which the teat is exposed to a vacuum during the previously mentioned pulse milk flow)".

IV. Oral proceedings before the board were held on 6 March 2007.

V. The appellant requested that the decision under appeal be set aside and the patent be maintained in amended form either on the basis of claims 1 to 17 filed with letter 15 September 2005 (main request) or, alternatively, on the basis of either claims 1 to 17 filed with the statement setting the grounds of appeal (first auxiliary request) or claims 1 to 17 filed during oral proceedings (second auxiliary request).

Independent claims 1 and 10 of the second auxiliary request read as follows:

Claim 1: "A method of automatically milking animals, comprising the following steps:

- measuring the momentary pulse milk flow wherein by pulse milk flow is meant the milk flow from a teat during a single suction phase of the milking process;
- controlling the duration and/or the level of the milk vacuum under the teat during the actual suction phase on the basis of the measured quantity, wherein by suction phase is meant the time during which the teat is exposed to a vacuum during the previously mentioned pulse milk flow,

characterized in that this method comprises the following steps:

- storage, during the actual suction phase, of the maximum value of the pulse milk flow measured thus far or the quantity related thereto,
- lowering or reducing or closing off the vacuum level of the milk vacuum as soon as the momentary value of the pulse milk flow or the quantity related thereto has come below a specific, preferably adjustable threshold value, which threshold value has a value between 60% and 80% of the maximum value of the pulse milk flow measured thus far or the quantity related thereto."

Claim 10: "An implement for automatically milking animals, said implement comprising at least one adjustable pulsator (5), at least one pulse milk flow sensor (8), means for measuring the momentary pulse milk flow wherein by pulse milk flow is meant the milk flow from a teat during a single suction phase of the milking process, and means for controlling the duration and/or the level of the milk vacuum under the teat during the actual suction phase on the basis of the measured quantity, wherein by suction phase is meant the time during which teat is exposed to a vacuum during the previously mentioned pulse milk flow, **characterized in that** the implement further comprises means for storing, during the actual suction phase, the maximum value of the pulse milk flow measured thus far or the quantity related thereto, and means for lowering or reducing or closing off the vacuum level of the milk vacuum as soon as the momentary value of the pulse milk flow or the quantity related thereto has come below a

specific, preferably adjustable threshold value, which threshold value has a value between 60% and 80% of the maximum value of the pulse milk flow measured thus far or the quantity related thereto."

The opponent (hereinafter respondent) requested that the appeal be dismissed and, auxiliarily, that the case be remitted to the department of first instance for further prosecution.

- VI. The appellant essentially argued that claims 1 and 10 of the main request met the requirements of Articles 100(c) and 123 EPC and that claims 1 and 10 of the first auxiliary request met the requirements of Article 84 EPC. This was contested by the respondent.

Reasons for the Decision

1. The appeal is admissible.
2. *Main request*
 - 2.1 Claim 1 of the main request differs from claim 1 of the application as filed in that the following definitions of the terms "pulse milk flow" and "suction phase", which were enclosed in parentheses in claim 1 as originally filed, have been deleted:
 - (i) "By pulse milk flow it is meant the milk flow from a teat during a single suction phase of the milking process".

- (ii) "By suction phase it is meant the time during which the teat is exposed to a vacuum during the previously mentioned pulse milk flow".

These definitions, which were also contained in the description of the application as filed, have also been deleted from the description of the patent as granted.

Definition i) makes it clear that the measured flow was the milk flow of a single teat during a single suction phase. Definition ii) makes it clear that the "suction phase" is the same phase in which the pulse milk flow is measured.

The deletion of definition i) from the claims and the description introduces new subject-matter, namely that the milk flow of more than one teat may constitute the "pulse milk flow". This has no basis in the application as filed, which consistently refers to the measurement of pulse flow of the milk coming from a single teat.

2.1.1 In this respect, the appellant essentially argued as follows:

- (a) It makes no sense to interpret the claimed subject-matter as relating to the milk pulse flow of more than one teat, in so far as what has to be measured is the flow of each single teat, since each udder's quarter is different from another one.
- (b) It is common general knowledge that the expressions "pulse milk flow" and "suction phase" refer to each single teat.

- (c) A wording between parentheses is normally considered as not limiting the claim and, thus, the deletion of definitions i) and ii) cannot extend the claimed subject-matter beyond the application as filed.

2.1.2 The board cannot accept these arguments for the following reasons:

- (a) It is well known that in a milking implement the pulsating vacuum can be applied to the teat cups either individually or synchronously. Therefore, it is technically conceivable to measure the pulse milk flow of more than one teat.
- (b) No evidence was presented to the Board that it is generally known that the expressions "pulse milk flow" and "suction phase" refer only to a single teat.
- (c) The issue of whether a sentence between parentheses has a facultative character, or not, has to be dealt with having regard to the context to which it belongs. Rule 29(7) EPC is not applicable here, as it strictly addresses the issue of reference signs in parentheses, and may not be generalised to **any** subject-matter contained in parentheses. In the present case, particularly due to the presence of terms "... it is meant", the sentences between parentheses in claim 1 of the application as filed cannot be immediately recognized as being merely optional. It is also observed that these two definitions have been

deleted not only from the claims but also from the description. As has been explained, concerning definition i) above, it is evident that the measured milk flow may, in absence of this definition, be derived from more than one teat. This information is nowhere provided in the application as filed, so that the main request (essentially the claims as granted, with a further limitation not relevant to this issue) extends beyond the content of the application as filed.

2.2 Therefore, the ground for opposition according to Article 100(c) prejudices the maintenance of the patent on the basis of the main request.

3. *First auxiliary request*

3.1 Claims 1 and 10 of the first auxiliary request differ from the corresponding claims 1 and 10 of the main request in that they contain the definitions of "pulse flow" and "suction phase", enclosed in parentheses.

3.2 In this regard, the question arises whether the use of parentheses in the claims is admissible at all. According to Rule 29(1) EPC, the claims should define the matter for which protection is sought in terms of technical features of the invention. Thus the claims should give a clear definition of the invention. In defining the technical features references may only be made to the description or the drawings insofar as this is absolutely necessary (Rule 29(6) first sentence). Rule 29(7) mentions the possible use of parentheses in connection with reference signs, but otherwise the EPC is silent about the possibility to use parentheses in

the claims in general, and thus there appears to be no explicit prohibition against their use.

3.3 The problem arises from the fact that in standard language, parentheses may be used for widely varying purposes, where the semantic role of the parentheses can often only be inferred from the context of use. In general, the reader can never be quite certain of the intended meaning. In other words, the use of parentheses by itself introduces some level of ambiguity in any text, patent claims being no exception. Therefore, as a rule, the use of parentheses in claims should be avoided, apart from the well-established use with reference signs or their standard uses in the relevant technology (see also Guidelines for Examination before the EPO, C III-4.11).

3.4 As a typical example, parentheses may be used to insert an explanation into a passage in order to render it more intelligible. In the present case, the two sentences enclosed in parentheses may be construed as an explanation of the invention defined in claim 1, explanation which is per se not part of this definition; on the other hand, since these sentences define two claimed technical features, they may also be construed as part of the definition of the claimed invention. In other words, the reader is left in doubt as to whether or not the explanation between the parentheses should be considered as part of the claim or not, and hence should determine the scope of protection or not (see also Guidelines, C III-4.11).

3.5 Therefore, the parentheses introduce in the present case an ambiguity as to the content of the claimed subject-matter.

3.6 It follows that claims 1 and 10 of the first auxiliary request do not meet requirements of Article 84 EPC.

4. *Second auxiliary request*

4.1 The second auxiliary request was filed during oral proceedings before the board. In this respect, the respondent asked the board to decide whether this request could be considered as being "timely filed".

The filing of the second auxiliary request clearly represents a reaction to the discussion of the clarity of the claims of the first auxiliary request as to the presence of the above mentioned parentheses, this issue having been discussed for the first time during oral proceedings.

The board finds that the second auxiliary request clearly does not raise issues which the board or the respondent could not be expected to deal with without adjournment of the oral proceedings (Rule 10b of the Rules of Procedure of the Boards of Appeal).

4.2 Compared with claims 1 and 10 of the first auxiliary request, claims 1 and 10 of the second auxiliary request have in essence been amended by deleting the parentheses, so that the above mentioned lack of clarity no longer applies.

4.3 With respect to this request, the respondent referred to the decision T 1149/97 (OJ 2000, 259) and essentially argued as follows:

- The amendments of the second auxiliary request were based upon subject-matter which was no longer specified in the patent as granted in so far as the above-mentioned definition had been deleted before grant and thus have to be considered as "abandoned" matter.
- The grant of the patent constitutes a "cut-off point" after which amendments re-introducing abandoned matter can not be allowed because the re-introduction would contravene Article 123(3) EPC.

4.4 The board cannot accept these arguments for the following reasons:

4.5 Decision T 1149/97 (*supra*) deals with reinstatement of subject-matter which in view of Articles 84 and 69 EPC has been deleted before grant or indicated as no longer relating to the invention, in order to avoid inconsistencies of the patent specification. The competent board found that such reinstatement should as a rule not be allowable under Article 123(3) EPC, and came to the conclusion that for such pre-grant deletions and indications a "cut-off effect" should be expected in that they become substantive under Article 123(3) EPC after grant (see point 6.1.12 of the reasons).

- 4.6 The board concurs with the findings of T 1149/97 that "cut-off" effects due to the grant of a patent may be seen in the restrictions imposed on further amendments to the patent specification by ... Article 123(3) EPC" (see Headnote I). However, the present board considers that even if the *ratio decidendi* of this decision is perfectly applicable to the present case, the outcome is different, because the facts of the present case are substantially different from those underlying this cited decision.
- 4.7 Firstly, it is noted that decision T 1149/97 itself does not consider re-introduction of deleted **features** - as opposed to deleted **subject-matter falling under patent protection** - to be inadmissible as a matter of principle, see point 5.1 of the reasons.
- 4.8 Secondly, even if its Headnotes can be easily misunderstood to convey an even stricter standard, decision T 1149/97 makes it perfectly clear that the invoked "cut-off effect" finds its basis in Article 123(3), see point 6.1.10 of the reasons, and in the assumption that "the deletion is **normally** carried out because the deleted passages of the original disclosure relate to subject-matter **no longer meeting the wording of the claims to be granted**" (board's emphasis), see point 6.1.10 of the reasons. Furthermore, the competent board, though it did not state it explicitly, applied a straightforward test to determine whether or not Article 123(3) EPC was infringed: Is it possible to identify some subject-matter which did not fall under the scope of protection in the granted version of the patent, but would do so if the amendment in question (the reintroduction of the deleted features)

would be allowed? Since the board was able to identify such abandoned subject-matter, it did not allow the amendment (see points 13 and 14 of the reasons).

- 4.9 This board finds this test to be most suitable for determining any violation of Article 123(3) EPC. Applying the very same test, the present board is unable to identify abandonment of subject-matter. In the present case, claims 1 and 10 as granted did **not** exclude from the protection those methods and implements in which a "pulse milk flow" and a "suction phase" corresponded to the deleted definitions. Such an intention could not be deduced from the description of the patent either. On the contrary, the claims as granted could be interpreted as defining a method and an implement which are in fact more general than the method and the implement disclosed in the application as filed, see also point 2 above.
- 4.10 Thus, the above-mentioned definitions cannot be considered as "abandoned" matter and their re-introduction into the claims of the second auxiliary request does not extend the protection conferred with respect to that of the patent as granted (Article 123(3) EPC).
- 4.11 Moreover, the deletion of the parentheses does not contravene Article 123(2) EPC.
- 4.12 Firstly, the above-mentioned definitions are *expressis verbis* disclosed in claim 1 as filed as well as in the corresponding part of the description as filed. These definitions were contained between parentheses in claim 1 as filed. Even if the board were to accept the

argument that the definitions were intended as merely optional, it could not be denied that they were disclosed and therefore could be claimed not only as optional, but also as necessary - in other words without parentheses.

4.13 Secondly, in the light of the complete disclosure of the application as filed, the definitions in question make perfect sense from a technical point of view, and even though only contained in parentheses, the skilled person would have had no reason to assume that the definitions were intended as merely optional, see also point 2.1.2 c above.

4.14 The respondent also argued that the reinstatement of the above mentioned definitions into claim 1 without deleting dependent claim 9 results in a lack of clarity of claim 1 because it defines a method "applied to each teat individually" which method is also defined in claim 9.

The board cannot accept this argument because the reinstated definitions refers to "a teat" (see definition (i)) or to "the teat" (see definition (ii)) and claim 1 does not indicate that the pulse milk flow of each teat is measured. In other words, claim 1 makes it clear that the pulse milk flow coming from a single teat during the suction phase of the same teat is measured (and not the sum of the flows coming from a plurality of teats) without indicating whether the method is applied for all teats. Therefore, claim 9 neither is superfluous, nor renders claim 1 unclear.

4.15 Therefore, claims 1 and 10 of the second auxiliary request comply with the requirements of Articles 84 and 123(2) and (3) EPC.

5. The ground for opposition according to Article 100(a) EPC has not been considered by the opposition division.

Accordingly the board, in exercising its discretion under Article 111(1) EPC, considers it appropriate to remit the case to the first instance for further prosecution on the basis of the claims of the second auxiliary request.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:

G. Magouliotis

M. Ceyte