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**Datasheet for the decision
of 23 October 2008**

Case Number: T 0074/06 - 3.2.04

Application Number: 98964656.7

Publication Number: 1039796

IPC: A01J 5/007

Language of the proceedings: EN

Title of invention:

A method and an apparatus for separation of foremilk

Patentee:

DeLaval Holding AB

Opponent:

Octooibureau Van der Lely N.V.

Headword:

Separation/DELAVAL

Relevant legal provisions:

EPC Art. 100(a), 100(c), 123, 54, 56
RPBA Art. 13

Relevant legal provisions (EPC 1973):

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Keyword:

"Admissibility of an auxiliary request filed by the proprietor
after his response to the statement of grounds of appeal"

"Matter extending beyond the content of the application as
filed (no)"

"Inventive step (auxiliary request IX): yes"

Decisions cited:

T 0153/85

Catchword:

-



Case Number: T 0074/06 - 3.2.04

DECISION
of the Technical Board of Appeal 3.2.04
of 23 October 2008

Appellant: Octooibureau Van der Lely N.V.
(Opponent) Weverskade 110
NL-3147 Pa Maassluis (NL)

Respondent: DeLaval Holding AB
(Patent Proprietor) P.O. Box 39
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 17 November 2005
rejecting the opposition filed against European
patent No. 1039796 pursuant to Article 102(2)
EPC.

Composition of the Board:

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

Summary of Facts and Submissions

I. The opposition division by its decision dated 17 November 2005 rejected the opposition filed against the European patent No. 1 039 796.

Independent claims 1 and 10 of the granted patent read as follows:

A method of preparing a lactating animal for milking comprising the following steps:

- localizing at least one teat (4)
- automatically approaching a milking means (6,8) to said teat and having said means automatically performing the following steps:
 - stimulating the teat in order to induce milk letdown;
 - extraction (2) of milk from each teat;
 - a first amount of the extracted milk is separated (17, 44, 58, 96) from the main milk flow and discarded;

characterized in that

- a second amount of the extracted milk is separated (18, 32) from the main milk flow and analyzed (34, 36, 64, 78), the result of the analysis being used to control at least one valve device (32, 37) for directing said second amount of milk to a milk tank (20) or to a second receptacle (22) for collecting and storing and/or disposing of milk unsuitable for human consumption.

10. An apparatus for preparing a lactating animal for milking in accordance with one of the methods in claims 1 9, **characterized by** a separating device (17, 44, 58, 64, 86) for separating a first amount of extracted milk from the main milk flow and discarding it, means for separating (32) and receiving (34, 64, 84) a second amount of milk from the main milk said receiving means (34, 64, 84) being provided with sensing means (36, 74, 76) for indication of the milk quality, said sensing means being associated with a control unit (14) for control of the milking process.

- II. On 16 January 2006 the opponent (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 16 March 2006.

- III. The proprietor (hereinafter respondent) filed with letter dated 19 September 2006 a response to the statement setting out the grounds of appeal.

- IV. In a communication dated 29 August 2008 the board drew the attention of the parties *inter alia* to the issues of
 - a) whether the features in granted claim 1 concerning the function of the "valve device" ("for directing said second amount ...") which distinguished granted claim 1 from claim 1 of the application as filed extended beyond the content of this application, and

- b) whether the terms "preparing a lactating animal for milking" made it clear that the steps of the method defined by claim 1 took place in the pre-milking phase of the milking process.
- V. By letter dated 25 September 2008 the respondent submitted auxiliary requests I to X in response to the board's communication. Auxiliary requests VI to X correspond to auxiliary requests I to V, respectively, with apparatus claims 10 to 19 deleted in auxiliary requests VI to X.
- VI. Oral proceedings before the board were held on 23 October 2008.
- VII. The appellant requested that the decision under appeal be set aside and the patent be revoked.
- VIII. The respondent requested that the appeal be dismissed (main request). Auxiliarily, he requested that the decision under appeal be set aside and the patent be maintained in amended form on the basis of one of the sets of claims filed as auxiliary requests I to VI by letter dated 25 September 2008 or of the sets of claims filed as auxiliary requests Vb, VIII, IX and X during the oral proceedings before the board. Auxiliary request VII filed during the oral proceedings was withdrawn.
- IX. Each of auxiliary requests I to V contains method claims 1 to 9 as well as apparatus claims 10 to 19. Auxiliary request Vb is only based upon the method claims 1 to 9 of the granted patent. Auxiliary requests

VI, VIII, IX and X contain the method claims of auxiliary requests I, III, IV and V, respectively.

Claim 1 of the auxiliary requests I and VI differ from granted claim 1 in that the expressions "comprising the following steps" and "localizing at least one teat(4);" have been replaced respectively by the terms "comprising the steps of per udder quarter" and "localizing one teat (4); and". Claim 10 of auxiliary request I differs from granted claim 10 in that the terms "per udder quarter" have been added at the end of the claim.

Claim 10 of auxiliary requests II, IV and V corresponds to granted claim 10.

Claim 1 of auxiliary requests III and VIII reads as follows:

"A method of preparing a lactating animal for milking comprising the steps of per udder quarter:

- localizing one teat (4); and
- automatically approaching a milking means (6, 8) to said teat and having said means automatically performing the following steps:
 - stimulating the teat in order to induce milk letdown;
 - extraction (2) of milk from each teat;

- a first amount of the extracted milk is separated (17, 44, 58, 96) from the main milk flow and discarded;

characterized in that

- a second amount of the extracted milk is separated (18, 23) from the main milk flow into a first receptacle (34) and analyzed (34, 36, 64, 78), the result of the analysis being used to control at least one valve device (37) for directing said second amount of milk from said first receptacle (34) to a milk tank (20) or to a second receptacle (22) for collecting and storing and/or disposing of milk unsuitable for human consumption, wherein said valve device (37) is a three-way valve provided between the first receptacle (34), the second receptacle (22) and the milk line to the milk tank (20), said valve device (37) being suitable for connecting the first receptacle (34) to either the second receptacle (22) or to the milk tank (20)."

Claim 1 of auxiliary requests IV and IX reads as follows:

"A method of preparing a lactating animal for milking comprising the following steps:

- localizing at least one teat (4); and
- automatically approaching a milking means (6, 8) to said teat and having said means automatically performing the following steps:

- stimulating the teat in order to induce milk letdown;
- extraction (2) of milk from each teat;
- a first amount of the extracted milk is separated (17, 44, 58, 96) from the main milk flow and discarded;

characterized in that

- during premilking, a second amount of the extracted milk is separated (18, 23) from the main milk flow and analyzed (34, 36, 64, 78), the result of the analysis being used to control at least one valve device (32, 37) for directing said second amount of milk to a milk tank (20) or to a second receptacle (22) for collecting and storing and/or disposing of milk unsuitable for human consumption."

X. The appellant essentially submitted that

- the auxiliary requests were late filed and thus inadmissible,
- due to the added feature "for directing said second amount of milk ...", the subject-matter of claim 1 of the main request and of auxiliary request IX extended beyond the content of the application as filed,
- the subject-matter of apparatus claim 10 of the main request as well as of auxiliary requests II,

IV and V lacked either novelty or an inventive step over document DE-A-19 547 892 (D1),

- the subject-matter of method claim 1 of auxiliary request IX lacked inventive step over document D1.

XI. The respondent essentially contested the appellant's arguments.

Reasons for the Decision

Since the European patent was already granted at the time of the entry into force of the EPC 2000 on 13 December 2007, the transitional provisions according to Article 7 of the Act revising the EPC of 29 November 2000 and the Decisions of the Administrative Council of 28 June 2001 and of 7 December 2006, Article 2, have been applied. When Articles or Rules of the version of the EPC 1973 are cited, the year is indicated.

1. The appeal is admissible.

2. *Admissibility of the auxiliary requests*

2.1 Article 12(2) of the Rules of Procedure of the Boards of Appeal (RPBA) stipulates that the grounds of appeal and the reply must contain a party's complete case. Under Article 13(1) RPBA it is at the Board's discretion to admit and consider any amendment to a party's case after it has filed the grounds of appeal or the reply.

However, submissions made after the grounds of appeal or the reply cannot in principle be rejected on the

grounds of being late, if they have been prompted by the Board's communication(s) or by submissions made by the other party which have been admitted in the proceedings.

Auxiliary requests II, IV, V, IX and X were submitted by letter of 25 September 2008 in response to the board's communication of 29 August 2008.

Claim 1 of auxiliary requests II, V and X has been amended by addition of features which define in a more specific way the functions of the "valve device" in granted claim 1. The amendments leading to these requests represent a reaction of the respondent to the board's communication (see above section IV, item a)).

Claim 1 of auxiliary requests IV and IX as well as claim 1 of auxiliary requests V and X contain the additional feature "during the pre-milking". This amendment also represents a reaction of the respondent to the board's communication (see above section IV, item b)).

Therefore, auxiliary requests II, IV, V, IX and X which were submitted by letter dated 25 September 2008 could not be rejected on the grounds of being late and were accordingly admitted into the proceedings.

2.2 Auxiliary requests I, III, VI and VIII were also submitted by the same letter dated 25 September 2008.

Claim 1 of auxiliary requests I, III, VI and VIII has been amended to state that the claimed method relates to milking "per udder quarter".

This added feature, which was not specified in any of the dependent claims, cannot be considered as a reaction to the board's communication. Thus, the respondent could have submitted these requests in an earlier stage of the proceedings, before oral proceedings were appointed, in particular in his response to the grounds of appeal.

Moreover, the amendment ("per udder quarter") leading to the claims of these requests would have extended the frame of discussion with respect to that determined by the written proceedings.

Therefore, the board in exercising its discretion under Article 13(1) RPBA decided not to admit these requests into the proceedings.

2.3 Auxiliary request Vb was submitted at a very late stage of the oral proceedings before the board.

One of the crucial criteria applied by the Boards of Appeal for admitting an auxiliary request at a late stage in the appeal proceedings, in particular in the course of the oral proceedings before the Boards is whether or not there is a proper justification for this late filing to forestall tactical abuse (see for example T 0153/85 OJ EPO 1988, 1).

No new matter was raised during the oral proceedings before the Board. The potential lack of patentability of the apparatus claims which may have prompted the filing of the auxiliary request Vb was known to the respondent from the beginning of the appeal proceedings

indeed even from the opposition proceedings. For filing this auxiliary request the respondent thus waited the oral proceedings, more precisely the board's announcement that the subject-matter of the apparatus claims according to the main request and the auxiliary requests II, IV and V was not patentable. He did not provide any proper justification for such a late filing. The claims of auxiliary request Vb correspond to the granted method claims 1 to 9 with granted apparatus claims 10 to 19 deleted. It is observed that the respondent had already submitted five auxiliary requests VI to X, i.e. a not inconsiderable number of auxiliary requests having only method claims. It goes without saying that this auxiliary request Vb was not the proprietor's "last chance" to get its patent maintained.

For the above reasons, the board decided not to admit this too late filed request Vb into the proceedings.

3. *Apparatus claim 10 of the main request and auxiliary requests II, IV and V*
- 3.1 Claim 10 of the main request refers (in the pre-characterising portion) to an "apparatus for preparing a lactating animal for milking in accordance with one of the methods claims 1-9") and defines (in the characterising portion) a first group of features relating to "a separating device for separating a first amount of extracted milk ..." and a second group of features relating to "means for separating and receiving a second amount of milk...".

The characterising features of the first group clearly define the means for carrying out the third step defined in the pre-characterising portion of claim 1 ("a first amount of the extracted milk is separated ..."), while the features of the second group relate to the method steps defined in the characterising portion of claim 1. However, claim 10 does not define any means for carrying out further steps defined in claim 1, such as for instance "localizing at least one teat" and "automatically approaching a milking means to said teat".

Thus, this claim 10 should be construed as defining an apparatus which is suitable for the stated purpose of preparing a lactating animal for milking and is provided with the features which are expressly defined in its characterising portion, without necessarily comprising any further features which are defined in the method claim to which it refers.

- 3.1.1 Document D1 discloses an apparatus comprising a separating device ("Meßeinrichtung" 38 and valve 36) for separating a first amount of extracted milk from the main flow and discarding it, means for separating (valves 12 and 18) a second amount of milk from the main flow, means for receiving (receptacle 20) this second amount, said receiving means (20) being provided with sensing means ("Analyseeinrichtung" 27) for analyzing said second amount, the milking process being controlled on the basis of the results of the analysis.

In order to separate the second amount of milk, at the end of the milking process the milk extracted from the teats of an animal and collected in a milk collecting

vessel ("Milchsammelgefäss "1) is transferred via milk lines (9 and 15) to the receiving means (20), whereafter it is analyzed by the sensing means (27). If the analysis of the milk is approved, the milk contained in the receiving means (20) is transferred via milk lines 23 and 16 to the milk tank; if the analysis is not approved this milk is transferred to a milk line 17 for milk unsuitable for consumption.

However, the apparatus of D1 also permits that the second amount be separated immediately after the first amount has been separated. Therefore, the apparatus of D1 can be considered as being suitable for preparing a lactating animal to the milking process.

3.1.2 In this respect, the respondent essentially argued as follows:

- a) In the apparatus of D1, the second amount of milk is not separated from the "main milk flow" but from a milk collecting vessel (20), in which there is a stationary mass of milk.
- b) The apparatus of D1 is provided with a large and expensive milk collecting vessel, while the claimed apparatus does need such a large vessel.
- c) The apparatus of D1 is provided with a "polluting" analyzing device, while the patent in suit concerns a "non-polluting" method of analysis.
- d) The apparatus of D1 is unsuitable for preparing an animal for the milking process because the separation of the second amount from the milk collecting vessel (20) requires time to increase

the pressure in the vessel from the vacuum level to the atmospheric value and to build up again the vacuum. Furthermore, the analysis of the milk in the analyzing device (27) also requires time.

- e) The claimed apparatus comprises a control unit which must be programmed to perform the steps of the method during the pre-milking phase, while the control unit of the known apparatus is not programmed for separating the second amount during the pre-milking phase.

- f) Since it is clear from the terms "preparing a lactating animal for milking" that all preparing operations are made during the pre-milking, which "is generally a teat operation", claim 10 implies that first and second amounts of milk are individually separated from the milk extracted individually from each teat or udder's quarter. This circumstance represents a further difference of the claimed apparatus with respect to the apparatus of D1, in which first and second amounts of milk are separated from the milk extracted from all udder quarters.

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

- a') Having regard to the patent specification (see Figures 1 and 2), the expression "main milk flow" is to be construed as meaning merely the milk path from the collecting means (2) to the milk tank (20) (via separating device 17 and milk selector 18). In the apparatus of D1 first and second amounts of

milk are also separated from the milk path from the teat cups to the line (16) for the milk suitable for consumption, i.e. from the main milk flow.

- b') Claim 10 does not exclude the presence of a milk collecting vessel.
- c') Claim 10 refers to a sensing means for indication of the milk quality without specifying how the analysis of the milk is performed and without referring to a "non polluting" analysis.
- d') Claim 10 does not refer to features concerning either the time spent on separating the second amount of milk or the speed of the analysis.
- e') Claim 10 refers to "sensing means being associated with a control unit (14) for control of the milking process". The control unit referred to in claim 10 has the function of controlling a valve device either to direct the second amount of milk to a milk tank or to discard it. D1 concerns an apparatus which is provided with a control unit capable of performing the same function. Therefore, the apparatus according to D1 can be considered as being provided with a control unit which is suitable for separating the second amount during the pre-milking phase.
- f') Claim 10 does not make it clear that first and second amounts of milk are separated from the milk extracted individually from each udder's quarter. Moreover, the apparatus of D1 can be considered as

being suitable for separating amounts of milk extracted from only one udder's quarter.

3.1.4 Having regard to the above considerations, the subject-matter of claim 10 of the main request lacks novelty (Article 54(2) EPC, 1973) with respect to document D1.

3.2 The above considerations also apply to apparatus claim 10 of auxiliary requests II, IV and V, which corresponds to claim 10 of the main request.

3.3 Therefore, the ground for opposition under Article 100(a) EPC 1973 prejudices the maintenance of the patent on the basis of the main request and of auxiliary requests II, IV and V.

4. *Auxiliary request IX (amendments)*

4.1 Claim 1 of this request differs from claim 1 of the application as filed in that

i) the expression "for directing said second amount of milk to a milk tank (20) or to a second receptacle (22) for collecting and storing and/or disposing of milk unsuitable for human consumption" has been added before the terms "at least one control valve (32, 37)" (amendment before grant), and

ii) the terms "during premilking" have been added before the feature "a second amount of the extracted milk is separated ..." (amendment after grant).

4.1.1 Both amendments can clearly and unambiguously be derived from the last passage on page 12 of the application as filed, in so far as this passage refers to "the separation of a predetermined amount of milk **during premilking**, which milk upon approval **can be returned to the main milk flow or otherwise discarded**" (emphasis added). This passage has to be read in conjunction with Figure 1 and with a sentence on page 7 (lines 5 and 6), which relate to the possibility of directing the milk either to a waste tank (22) or to a milk tank (20) by means of three-way valve (37), and with claim 1 of the application as filed, which refers to the control of "at least one valve device" and to the separation of a "second amount of extracted milk". The skilled reader will immediately realize that the predetermined amount of milk referred to on page 12 corresponds to the second amount of milk referred to in claim 1 and that the possibility of either directing said amount to the main milk flow or discarding it is not bound to the three-way valve represented in Figure 1 but is in relation with the valve device referred to in claim 1.

Having regard to these considerations, the appellant's argument that the above mentioned additional features have been arbitrarily selected from Figure 2 which shows further important structural elements (such as a valve 32, a sensor 36 and a manoeuvring device 38), is not relevant.

4.1.2 Therefore, the subject-matter of claim 1 of the auxiliary request IX does not extend beyond the content of the application as filed (Article 100(c) EPC 1973 and Article 123(2) EPC).

4.2 Moreover, claim 1 of this request contains all the features of claim 1 as granted and the added limiting feature "during premilking", so that the requirement of Article 123(3) EPC is not contravened.

5. *Auxiliary request IX (inventive step)*

5.1 Document D1 discloses a method of milking a lactating animal comprising the following steps which are performed in the pre-milking phase and therefore relate to the preparation of a lactating animal for milking:

- localizing at least one teat;
- approaching a milking means to said teat and having said means automatically performing the steps of stimulating the teat in order to induce milk letdown and extracting milk from each teat;
- a first amount of the extracted milk is separated from the main milk flow and discarded,
- the thereafter extracted milk exclusive of the first amount is delivered to a first receptacle ("Milchsammelgefäß" 1).

Moreover, the method of milking of D1 also comprises the following steps, which are performed at the end of the milking, i.e. when milk is no longer extracted from the animal's udder, and therefore are not performed during pre-milking:

- a second amount of milk is separated from the first receptacle (1) by means of valves (12 and 18), delivered to a second receptacle ("Probensammlerbehälter" 20) and analyzed,

- the result of the analysis is used to control two valve devices (29 and 31) for directing the content of the second receptacle (20), either to a milk tank or to a waste milk tank for disposing of milk unsuitable for human consumption.

5.2 Claim 1 is for "a method of preparing a lactating animal for milking". This is limited to a method of preparing a lactating animal for milking and not merely to a method that would be suitable for preparing a lactating animal for milking (see *inter alia* the Guidelines C III, 4.13, last paragraph).

D1 does not disclose such a step. A further essential difference is that the steps defined in the characterizing part of claim 1 are carried out in the claimed method during pre-milking.

The claimed method thus only relates to the pre-milking phase, in which foremilk (see column 2, lines 21-24 of the patent specification) exclusive of the first drops of milk (see column 3, lines 33-36, column 4, lines 50-52) is analysed. The step of preparing the lactating animal for milking takes place before the main milking phase (column 9, lines 15-20). In contrast to this, D1 describes a method in which the sampling and analysis of milk take place after the milking procedure is terminated.

The analysis of foremilk is very different from the analysis of the average composition of milk extracted throughout the complete milking procedure. As submitted by the respondent, the analysis of foremilk, i.e. milk

extracted before the onset of the actual milking procedure allows a greater flexibility in handling the subsequent extracted milk and/or a greater flexibility in handling the animal. If e.g. the analysis indicates that the animal has mastitis, the milking process can be interrupted and the herdsman can be informed. Also the composition of the extracted milk varies throughout the milking procedure. An important indicator of e.g. mastitis, mainly present in the foremilk can be diluted if like in D1 the average composition of the milk is analysed after the completion of the milking process.

It is observed that the claimed method of preparing a lactating animal in which the sampling and analysis of milk take place during pre-milking is neither disclosed nor suggested in D2.

On the contrary D1 teaches to carry out these steps after the milking procedure is terminated and thus teaches away from the claimed method. Therefore, D1 does not provide motivation for the skilled person to modify the method disclosed in D1 in a manner so as to arrive at the claimed method.

- 5.3 From the foregoing it follows that the subject-matter of claim 1 according to the auxiliary request IX involves an inventive step (Article 56 EPC).

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 with the order to maintain the patent on the basis of the following documents:

Claims 1-9: filed as Auxiliary Request IX during the oral proceedings.

Description : columns 1 and 3 as filed during the oral proceedings, columns 2, 4-9 of the patent specification.

Drawings 1-14: of the patent specification.

The Registrar:

The Chairman:

G. Magouliotis

M. Ceyte