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**Datasheet for the decision
of 14 May 2009**

Case Number: T 1878/06 - 3.2.04

Application Number: 99943530.8

Publication Number: 1100314

IPC: A01J 5/017

Language of the proceedings: EN

Title of invention:

An apparatus for automatically milking an animal

Patentee:

DeLaval Holding AB

Opponent:

Octrooibureau Van der Lely N.V.

Headword:

Support/DELAVAL

Relevant legal provisions:

EPC Art. 123, 111(1)

RPBA Art. 13(2)

Relevant legal provisions (EPC 1973):

EPC Art. 54(2)

Keyword:

"Novelty (amended claims): yes"

"Inventive step: remittal"

Decisions cited:

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Catchword:

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Case Number: T 1878/06 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 14 May 2009

Appellant: DeLaval Holding AB
(Patent Proprietor) P.O. Box 39
SE-147 21 Tumba (SE)

Representative: Gray, Helen Mary
Albihns GmbH
Bayerstrasse 83
D-80335 München (DE)

Respondent: Octrooibureau Van der Lely N.V.
(Opponent) Weverskade 110
NL-3147 PA Maassluis (NL)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 2 October 2006
revoking European patent No. 1100314 pursuant
to Article 102(1) EPC.

Composition of the Board:

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

Summary of Facts and Submissions

I. The European patent No. 1 100 314 was revoked by the opposition division by decision dated 2 October 2006.

The opposition division found that the subject-matter of claim 1 of the main request of the patent proprietor as well as that of claim 4 of his auxiliary request lacked novelty over EP-A-302 559 (hereinafter D1).

II. The patent proprietor (hereinafter appellant) lodged an appeal against this decision on 8 December 2006 and simultaneously paid the appeal fee. A statement setting out the grounds of appeal was received on 2 February 2007.

III. In his reply (dated 15 June 2007) to the grounds of appeal the opponent (hereinafter respondent) filed EP-A-360 354 (hereinafter D3) and submitted that the subject-matter of claim 1 according to main and auxiliary requests filed together with the grounds of appeal lacked an inventive step *inter alia* over the combination of documents D1 and D3.

By letter dated 2 December 2008, the appellant filed new main and auxiliary requests with amended claims.

Claim 1 of the new main request reads as follows:

1. An apparatus for automatically milking an animal, comprising a plurality of teatcups (60, 62, 64, 66) each having a teat entrance end (17a), and a movable arm (6) for moving said teatcups towards a teat of an animal to be milked and attaching it

thereto, wherein the teat entrance end (17a) of at least one of said teatcups is arranged, while being moved by said movable arm (6) towards said teat, to be held in relation to said movable arm (6) at a level which is different from that of the teat entrance end (17a) of a further one of said teatcups, when held in relation to said movable arm, wherein

a) said movable arm (6) is provided with an end portion (30) for holding a plurality of teatcups (60, 62, 64, 66) wherein said teatcup is held at a level, which is different from that of said further teatcup held by said end portion (30),

b) said at least one teatcup (60) and said further teatcup (62, 64, 66) are arranged to cooperate with a connection means of said end portion (30) in such a way, that they are held at different levels in relation to said end portion and

c) said connection means includes electromagnets for attaching the teatcups to said end portion."

Claim 1 of the new auxiliary request reads as follows:

"1. An apparatus for automatically milking an animal, comprising a plurality of teatcups (60, 62, 64, 66) each having a teat entrance end (17a), and a movable arm (6) for moving said teatcups towards a teat of an animal to be milked and attaching it thereto, wherein the teat entrance end (17a) of at least one of said teatcups is arranged, while being moved by said movable arm (6) towards said teat, to be held in relation to said movable arm

(6) at a level which is different from that of the teat entrance end (17a) of a further one of said teatcups, when held in relation to said movable arm, wherein

- a) said movable arm is a robot arm provided with a laser sensor (32),
- b) said movable arm (6) is provided with an end portion (30) for holding a plurality of teatcups (60, 62, 64, 66) wherein said teatcup is held at a level, which is different from that of said further teatcup held by said end portion (30),
- c) said at least one teatcup (60) and said further teatcup (62, 64, 66) are arranged to cooperate with a connection means of said end portion (30) in such a way, that they are held at different levels in relation to said end portion and
- d) said connection means includes electromagnets for attaching the teatcups to said end portion."

IV. In its communication dated 2 December 2008, the board informed the parties that it was inclined to admit document D3 into the proceedings and to remit the case to the department of first instance for consideration of the issue of inventive step.

V. The appellant requested that the case be remitted to the opposition division for the continuation of the proceedings on the basis of the main and auxiliary requests filed by letter of 2 December 2008.

The respondent also requested that the case be remitted to the opposition division for further prosecution. He

also requested an indication of whether an additional search should be made by the EPO concerning the new features introduced into the amended claims as well as that a sufficient span of time be given to him for carrying out a further search.

Reasons for the Decision

1. The appeal is admissible.
2. The admissibility of D3 into the proceedings was not objected to by the appellant (patent proprietor).

This citation, which relates to a laser sensor, cannot be rejected on the ground of being late, since it was submitted in response to the amended claims filed with the grounds of appeal, which *inter alia* refer to a robot arm provided with a laser sensor.

Therefore, D3 is admitted into the proceedings.

3. Since the board admits D3 submitted by the respondent (opponent), it must under Article 13(2) of the Rules of Procedure of the Boards of Appeal (RPBA) also allow the appellant (patent proprietor) to file amended claims in response.

Therefore, the amended claims according to the main request and the auxiliary request filed by letter dated 2 December 2008 are admitted into the proceedings.

4. *Amendments (Article 123 EPC)*

The allowability of the amendments under Article 123 EPC is not disputed.

Claim 1 of the main request finds basis in claims 1, 2 and 8 of the application as filed. In addition, clause c) of this claim, which reads "said connection means includes electromagnets for attaching the teatcups to said end portion", is disclosed in the paragraph on page 9 of the application as filed (paragraph [0046] of the patent specification).

Claim 1 of the auxiliary request differs from claim 1 of the main request by the addition of features of claims 15 and 16 as filed.

These amendments do not contravene the requirements of Article 123(2) and (3) EPC.

5. *Novelty (Article 54 (2) EPC 1973)*

Novelty of the subject-matter of the amended claims is not disputed.

None of the documents cited in the appeal proceedings refers to connection means including electromagnets for attaching the teat cups to the end portion of the movable arm.

Therefore, the subject-matter of claim 1 of the main request as well as that of claim 1 of the auxiliary request are novel.

6. *Remittal (Article 111(1) EPC)*

The decision under appeal does not deal with inventive step. Under these circumstances and considering that claim 1 of the main request and of the auxiliary request have been substantially amended and that a new citation (D3) has been admitted into the proceedings, the board in exercising its discretion under Article 111(1) EPC, finds it appropriate to remit the case for further prosecution to the department whose decision was appealed, as requested by both the appellant and the respondent.

7. *The respondent's requests concerning an additional search*

7.1 The board refrains from issuing any order to the opposition division concerning the additional search. This issue is left to the discretion of the opposition division, which has to decide on this issue in the course of the examination of inventive step. The board notes that any guidance to the opposition division could be perceived as an indication of the board's opinion on inventive step and, thus, could be perceived to be prejudicial to the decision of the opposition division.

7.2 In this respect, it has to be noted that the remittal of the case will give the respondent ample time to his own additional search.

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