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**Datasheet for the decision
of 15 March 2011**

Case Number: T 1099/08 - 3.2.04

Application Number: 02076614.3

Publication Number: 1264538

IPC: A01J 7/02

Language of the proceedings: EN

Title of invention:

A device for and a method of cleaning a milking machine, and a milking machine

Patentee:

Lely Enterprise AG

Opponent:

DeLaval International AB

Headword:

Off-peak periods/LELY

Relevant legal provisions:

EPC Art. 84, 123(2), 111(1)

Relevant legal provisions (EPC 1973):

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Keyword:

"Clarity of the amendments (yes)"
"Added subject-matter (no)"
"Remittal for further prosecution"

Decisions cited:

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Catchword:

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Case Number: T 1099/08 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 15 March 2011

Appellant:
(Patent Proprietor)

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 16 April 2008
revoking European patent No. 1264538 pursuant
to Article 101(3)(b) 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 dispatched on 16 April 2008, revoked the European patent No. 1 264 538, against which an opposition based upon Article 100(a) EPC (with respect to Articles 52(1) and (2), 54 and 56 EPC) had been filed.
- II. The patent proprietor (hereinafter appellant) lodged an appeal against this decision on 11 June 2008 and simultaneously paid the appeal fee. The grounds of appeal were received on 31 July 2008.
- III. Oral proceedings before the board were held on 15 March 2011.
- IV. During oral proceedings the appellant withdrew his main and first auxiliary requests filed with the grounds of appeal and requested that the decision under appeal be set aside and the patent be maintained on the basis of claims 1 to 16 of the second auxiliary request filed with the grounds of appeal (method claims 17 to 25 were deleted), as sole request. He also requested that the case be remitted to the department of first instance for consideration of the issues of novelty and inventive step.

Claim 1 of the sole request reads as follows:

"1. A device (1) for milking animals, said device (1) being provided with:

 a cleaning device (42) for cleaning at least a part of a milking machine (33), said cleaning device

(42) comprising a cleaning start device (35) for starting the cleaning, and

a milking machine (33) provided with a computer having a memory (37), the computer being adapted to store the points of time of the visits of the animals to the milking machine (33) in the memory (37), characterized in that the cleaning start device (35) is activated by means of a cleaning start signal issued by the computer, on the basis of historical data in relation to the points of time of the visits of the animals stored in the memory (37), and in that the computer comprises an analysis-unit (38) for determining the off-peak periods in the visits to the milking machine (33), wherein the computer, with the aid of the historical data, issues an off-peak signal indicating that an off-peak period is expected."

- V. The opponent (hereinafter respondent) requested that the appeal be dismissed and that the case should not be remitted, if the sole request were deemed to comply with Articles 84 and 123(2) EPC.
- VI. The appellant essentially submitted that amended claim 1 is clear and that its subject-matter can be directly and unambiguously derived from the application as filed. With respect to his request for remittal the appellant referred to the parties' right to have a full examination before by two instances.
- VII. The respondent essentially submitted that the amendments to claim 1 rendered it obscure and ambiguous (Article 84 EPC) and that the feature "the computer, with the aid of the historical data, issues an off-peak signal indicating that an off-peak period is expected"

introduced added subject-matter and thus contravened the requirements of Article 123(2) EPC).

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments (Articles 84 and 123 (2) EPC)*
 - 2.1 Claim 1 of the appellant's sole request differs from granted claim 1 by the following additional features:
 - (i) "the computer comprises an analysis-unit (38) for determining the off-peak periods in the visits of the animals to the milking machine (33)",
 - (ii) "wherein the computer, with the aid of the historical data, issues an off-peak signal indicating that an off-peak period is expected".
 - 2.1.1 The respondent essentially submitted that the additional features render claim 1 unclear (Article 84 EPC) for the following reasons:
 - (a) The purpose and function of issuing an off-peak signal is obscure. As stipulated in the claim, the cleaning start device is activated by means of a cleaning start signal issued by the computer and not by means of an off-peak signal.
 - (b) The meaning of the terms "analysis-unit (38) for determining the off-peak periods" is ambiguous in so far as the patent specification refers to an

analysis unit for **calculating** the expected off-peak periods (paragraph [0026]) as well as to the possibility that the off-peak periods are manually inputted by the farmer (paragraph [0030]).

2.1.2 The board does not find these arguments convincing for the following reasons:

(a') According to feature (ii), the purpose and function of issuing an off-peak signal is to indicate that an off-peak period is expected. Thus it is possible to clean automatically during these off-peak periods, when the milking machine is hardly visited, which minimizes the inconvenience for the animals as a result of cleaning (see paragraph [0006] of the patent specification).

Amended claim 1 leaves it open whether off-peak signal and cleaning start signal are separate signals or not. According to the patent specification (paragraph [0006], lines 50 to 55), the off-peak signal may be a cleaning start signal but is preferably a separate signal issued at a predetermined point of time before the expected off-peak period, so that it is possible to activate some preparative actions before starting the cleaning. Moreover, the patent specification does not require that the computer issues a cleaning start signal each time when an off-peak signal is issued in so far as the cleaning can take place during selected off-peak periods (see paragraph [0007], column 2, lines 11 to 14; paragraph [0038], column 6, lines 56 to 58). The fact that claim 1 covers inter alia the

possibility that each off-peak signal is a cleaning start signal is consistent with the description of the patent specification.

(b') According to the patent specification, the off-peak periods are manually inputted by the farmer only in the starting phase (see paragraph [0030]) of the device, whereafter the data in the memory in relation to the visits of the animals are continuously updated for being able to take a changed visiting behaviour of the animals into account (see paragraph [0037]), so that on the basis of the historical data the off-peak periods can be determined by the analysis-unit of the computer. In any case, claim 1 relates to a milking device provided with a computer comprising an analysis-unit for determining the off-peak periods which does not exclude the possibility of manually inputting off-peak periods in the starting phase. There is thus no inconsistency between present claim 1 and paragraph [0030] of the description.

2.1.3 Therefore, the amendments made in claim 1 comply with the requirements of Article 84 EPC.

2.2 Additional feature (i) in combination with the features of granted claim 1 is originally disclosed in claim 3 (in combination with claim 1) of the application as filed.

Additional feature (ii) in combination with feature (i) is disclosed in paragraph [0006] of the application as filed which refers in the first sentence (column 1,

lines 39 to 41) to the "analysis-unit for determining the off-peak periods ..." and in the subsequent sentence (column 1, lines 41 to 44) to the feature that "the computer ... issues an off-peak signal indicating that an off-peak period is expected".

2.2.1 In this respect, the respondent submitted that feature (ii) corresponds to the subject-matter of claim 5 of the application except that it does not state that the off-peak period is expected "within a pre-determined period". Claim 5 is dependent on claim 4 which refers to the average cleaning duration. Thus, amended claim 1 - in so far as it does not refer to "a predetermined period" and to the features of claim 4 - introduced added subject-matter.

2.2.2 The board does not find this argument relevant in so far as the basis for feature (ii) is not claim 5 of the application as filed but - as explained before - paragraph [0006] of the description.

2.2.3 Therefore, amended claim 1 does not contravene the requirements of Article 123(2) EPC.

2.3 The further amendments made in the sole request are in essence as follows:

(i) deletion of claim 3 as granted,

(ii) adaptation of re-numbered claim 3 to amended claim 1, and

(iii) deletion of dependent claim 17 as granted and method claims 19 to 27 as granted.

2.3.1 No objections were raised against these amendments. The Board is satisfied that they do not contravene Article 123(2) EPC.

3. *Remittal*

3.1 The opposition division did not admit the main request into the proceedings because it considered that the amendments made were not occasioned by a ground of opposition (Rule 80 EPC) and rejected the three auxiliary requests as contravening Article 123(2) EPC.

3.2 The board finds it appropriate to remit the case to the opposition division in accordance with Article 111(1) EPC since, on the one hand, the opposition division considered and decided solely on formal issues and left the essential issues of novelty and inventive step entirely undecided and, on the other hand, granted claim 1 has been substantially amended in the appeal proceedings.

3.3 Although in the interests of procedural economy the board would have been prepared to consider and decide on the patentability of the claimed invention without remitting the case, the appellant has maintained his request for remittal in order to have the case considered by two instances.

The board agrees with the appellant that in view of the above circumstances it would have been unfair to deprive him of a full examination of the patentability of the claimed invention by two instances.

The case should therefore be remitted to the opposition division for further prosecution.

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