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**Datasheet for the decision
of 23 May 2011**

Case Number: T 0652/09 - 3.2.04

Application Number: 02077629.0

Publication Number: 1285576

IPC: A01J 7/04

Language of the proceedings: EN

Title of invention:

A method of and a device for cleaning the teats and/or the udder of a dairy animal, a method of and a device for milking an animal

Patentee:

Lely Enterprises AG

Opponent:

WestfaliaSurge GmbH

Headword:

Soaking/Lely

Relevant legal provisions:

EPC Art. 54, 123, 111(1)

Relevant legal provisions (EPC 1973):

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Keyword:

"Remittal"

Decisions cited:

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Catchword:

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Case Number: T 0652/09 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 23 May 2011

Appellant:
(Patent Proprietor)

Lely Enterprises AG
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Representative:

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Respondent:
(Opponent)

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Representative:

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 12 January 2009
revoking European patent No. 1285576 pursuant
to Article 101(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 dispatched on 12 January 2009, revoked the European patent No. 1 285 576.
- II. The patent proprietor (hereinafter appellant) lodged an appeal against this decision on 18 March 2009 and simultaneously paid the appeal fee. The grounds of appeal were received on 20 May 2009.
- III. Oral proceedings before the board were held on 23 May 2011.
- IV. The appellant requested that the decision under appeal be set aside and the patent be maintained on the basis of claims 1 to 5 filed during the oral proceedings before the board. He also requested that the case be remitted to the department of first instance for consideration of the issue of inventive step not addressed by the opposition division.

Claim 1 reads as follows:

"1. A method of cleaning the teats and/or the udder of a dairy animal, the method comprising a cleaning step of applying a cleaning fluid on the teats and/or the udder, characterized in that the method comprises, prior to the cleaning step, a designation step of designating an animal whose teats and/or udder have to be soaked, and a soaking step of applying a soaking fluid on the teats and/or the udder, in that the soaking step is carried out by a mobile device for applying a soaking fluid, the mobile device being

provided with a reservoir for soaking fluid or with a connection device for connection with a reservoir for soaking fluid and in that the method comprises after the soaking step a guiding step of guiding the animal subjected to the soaking step to a predetermined place, and in that as a predetermined place a milking parlour for milking an animal is chosen, wherein prior to milking the cleaning step is carried out in the milking parlour."

- V. The opponent (hereinafter respondent) requested that the appeal be dismissed.
- VI. The appellant essentially submitted that the subject-matter of amended claim 1 did not contravene the requirements of Article 123(2) EPC. With respect to his request for remittal he referred to the parties' right of an examination at two levels of jurisdiction. The respondent, who did not raise any objections under Articles 123 and 54 EPC against the subject-matter of amended claim 1, did not object to the remittal of the case to the department of first instance.

Reasons for the Decision

1. The appeal is admissible.
2. *The sole request of the appellant*
 - 2.1 Claim 1 of this sole request corresponds to claim 1 of the third auxiliary request filed by the appellant's letter dated 22 April 2011 in response to the board's

communication annexed to the summons to oral proceedings.

- 2.2 Amended claim 1 includes the features of granted claims 1, 4, 6, 9 and 10, which corresponds to claims 4, 6, 9 and 10 of the application as filed, as well as the feature "wherein prior to milking the cleaning step is carried out in the milking parlour".

The amendments made in claim 1 are directly and unambiguously derivable from claims 4, 6, 9 and 10 in combination with page 2, lines 9 to 11 and 19 to 28 and page 3, lines 5 to 12 of the application as filed.

- 2.2.1 Therefore, the amendments made in claim 1 do not contravene the requirements of Article 123(2) EPC.

- 2.3 No objections of lack of novelty (Article 54 EPC) were submitted by the respondent in respect of claim 1.

The board is satisfied that the subject-matter of amended claim 1 is novel over either US-A-3 971 512 (D5) or WO-A-98/42182 (D6), in so far as none of them discloses the step of guiding the animal subjected to the soaking step to the milking parlour.

3. *Remittal*

- 3.1 The opposition division decided to revoke the patent on the ground that the subject-matter of claim 1 as granted was not novel over D5 or D6 and thus left the issue of inventive step undecided. If a decision revoking the patent because of lack of novelty is set aside in the appeal proceedings because of the presence

of novelty, the case should, as a general rule, be remitted to the department of first instance to consider and decide upon the issue of inventive step, especially when the patent proprietor requests remittal of the case.

- 3.2 Moreover, in the written phase of the appeal proceedings, the appellant submitted that the documents "Lava-Teat and "Clin-Teat" -"Costruzioni Tecnologiche Applicate" (D7) and "Prepping cows consistently" - "Midwest Dairy Business" (D8) should not have been admitted into the opposition proceedings since they do not provide sufficient evidence for the alleged prior use to which they refer.

In its communication annexed to the summons to oral proceedings, the board expressed the view that the decision of the opposition division to reject the proprietor's request that D7 and D8 be not admitted into the proceedings was correct on its merits. It is true that D7 is undated and D8 is published after the priority date of the European patent. However, both documents were cited in due time in the notice of opposition and relevant facts to which they refer are clearly dated.

The opposition division did not take position on whether the alleged public prior use referred to in D7 and D8 was sufficiently substantiated and whether this prior use could be prejudicial to the patentability of the claimed invention.

3.3 In order to have all these issues considered by two instances, the board considers it appropriate to remit the case to the department of first instance for further prosecution (Article 111(1) 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 for further prosecution.

The Registrar:

The Chairman:

G. Magouliotis

M. Ceyte