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D E C I S I O N
of 24 May 2005

Case Number: T 0314/03 - 3.2.4

Application Number: 95202054.3

Publication Number: 0688498

IPC: A01J 7/00

Language of the proceedings: EN

Title of invention:

A milking plant

Patentee:

MAASLAND N.V.

Opponent:

DeLaval International AB
Prolion B.V.

Headword:

-

Relevant legal provisions:

EPC Art. 69(1), 111(1), 123(3)
EPC R. 71(2)

Keyword:

"Amendment from plural to singular in granted claim 1"
"Extension of the protection conferred (no)"
"Remittal to the first instance for consideration of the
formal ground of added subject-matter and of the substantive
ground of inventive step, both raised by the opponents but
left undecided"
"Procedural expediency"

Decisions cited:

T 0271/84, T 0108/91

Catchword:

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Case Number: T 0314/03 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 24 May 2005

Appellant: MAASLAND N.V.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 30 January 2003
revoking European patent No. 0688498 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: M. Ceyte
Members: C. Scheibling
T. Bokor

Summary of Facts and Submissions

I. By its decision dated 30 January 2003 the Opposition Division revoked the patent. It was held in this decision that the amendment replacing the plural term "translucent parts" in granted claim 1 by the singular term "translucent part" infringed Article 123(3) EPC. On 26 February 2003 the Appellant (patentee) filed an appeal and paid the appeal fee simultaneously. The statement setting out the grounds of appeal was received on 7 May 2003.

II. Opposition was filed on the grounds based on Article 100(a) and c) EPC and more particularly Articles 56, 76(1), 84, 123(2) and 123(3) EPC.

III. Oral proceedings took place on 24 May 2005. Although duly summoned, Respondent II (opponent II) did not appear. Indeed, Respondent II informed the Board by a letter dated 18 February 2005 that he will not attend the oral proceedings. According to the provisions of Rule 71(2) EPC the proceedings were continued without him.

The Appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of:

- the claims according to the main request or to the first auxiliary request filed with letter of 7 May 2003,
- the claims according to the second or third auxiliary requests filed with letter of 21 April 2005, or

- the claims according to the fourth auxiliary request which correspond to the claims of the second auxiliary request filed with letter of 7 May 2003.

He mainly argued as follows: Although the extent of protection conferred by a European Patent shall be determined by the terms of the claims, the description and the drawings shall be used to interpret the claims (Article 69(1) EPC). However, in the light of the description, a person skilled in the art would understand that both expressions "translucent part" and "translucent parts" refer to the window. Thus, claim 1 as granted discloses only the provision of a single window, i.e. one translucent part. Consequently, claim 1 of the main request which refers to the singular term "translucent part" satisfies the requirements of Article 123(3) EPC.

Respondent I (opponent I) countered the Appellant's arguments and mainly argued as follows: The Appellant's reasoning implies that a person skilled in the art would be unable to make technical sense of granted claim 1. However, it is technically perfectly feasible to have a light sensor arrangement with more than one window and consequently more than one translucent part as shown in Figure 4 of the patent in suit. Therefore, there is no reason to assume that the claimed arrangement should also cover embodiments wherein the sensor arrangement has only one single translucent part.

Consequently, claim 1 of the main request offends against Article 123(3) EPC.

Respondent I requested that the appeal be dismissed and that auxiliary requests 2 and 3 be rejected as inadmissible.

Respondent II (opponent II) did not file any observation.

IV. Claim 1 according to the main request reads as follows:

"1. Milking plant for automatically milking animals in a milking parlour, comprising a light sensor arrangement (1) for determining the position of the teats of an animal, said light sensor arrangement (1) including a housing (2) having a window (3) behind which there are located a reflecting element (4), a transmitter element (5) and a receiver element (6), and a robot arm (56) co-operating with said sensor arrangement (1) for carrying the teat cups and for automatically connecting teat cups to the teats of an animal, the window (3) of the light sensor arrangement (1) being a sealed window (23), which sealing may consist of glass or a translucent synthetic resin material, forming a translucent part through which light for detecting the teats of an animal is radiated, characterized in that cleaning means (36) are provided for automatically cleaning the translucent part (23) of the sensor arrangement (1)."

Claim 1 as granted reads as follows:

"1. Milking plant for automatically milking animals in a milking parlour, comprising a light sensor arrangement (1) for determining the position of the teats of an animal, and a robot arm (56) cooperating

with said sensor arrangement (1), for automatically connecting teat cups to the teats of an animal, the light sensor arrangement (1) comprising translucent parts (23) through which light for detecting the teats of an animal is radiated, characterized in that cleaning means (36) are provided for automatically cleaning at least the translucent parts (23) of the sensor arrangement (1)."

Reasons for the Decision

1. The appeal is admissible.
2. *Article 123(3) EPC:*
 - 2.1 Claim 1 of the main request differs from claim 1 as granted by:
 - a) the addition of the following features:
 - said light sensor arrangement (1) including a housing (2) having a window (3) behind which there are located a reflecting element (4), a transmitter element (5) and a receiver element (6),
 - for carrying the teat cups
 - the window (3) of the light sensor arrangement (1) being a sealed window (23), which sealing may consist of glass or a translucent synthetic resin material,
 - b) the deletion of "at least" between "cleaning" and "the translucent parts", and
 - c) in that:
 - "translucent parts" was changed to read "the translucent part".

The modifications indicated under points a) and b) do clearly not extend the protection conferred and thus, are not objectionable.

Thus, the only question which arises is whether the amendment replacing the plural term "translucent parts" by the singular term "the translucent part" extends the protection conferred and thus, violates the requirements of Article 123(3) EPC.

2.2 According to Article 69(1) EPC, although the extent of protection conferred by a European patent shall be determined by the terms of the claims, the description and the drawings shall be used to interpret the claims.

2.3 The description of the patent in suit, column 4, line 47 to column 5, line 11 and paragraph [0020], indicates that the window may be divided in two portions, it may be sealed, the sealing may consist of glass or a translucent synthetic resin material, the sealing is to prevent penetration of dirt into the housing, the window itself can become dirty, means may be provided for automatically cleaning the window.

2.4 First, it has to be noted that even if the window is divided in two parts, according to the description of the patent in suit, it is still considered as constituting one single window, which means that all embodiments disclosed in the patent in suit comprise a single window.

2.5 Furthermore, from the whole of the description of the patent in suit, it is clear for a skilled person that it lies within the scope of the invention that all the

embodiments disclosed, even those which in the Figures are not represented with a sealed window, can be provided with a sealed window.

2.6 The aim of the invention is to clean the sealed window to avoid that the distance measurement be disadvantageously affected by dirt deposited on the window sealing, i.e. the translucent part of it (patent in suit, column 1, lines 24 to 30 and column 5, lines 8 to 11).

2.7 It is also clear that the plural form in claim 1 as granted was not intended to exclude any specifically disclosed embodiment from the claimed subject-matter.

Accordingly, it can be seen that the feature "translucent parts" used in the plural, although technically feasible in itself does not correspond to what is described in the embodiments of the patent specification, which relate to a single window having thus a translucent part. The amendment from the plural in granted claim 1 to the singular removes this inconsistency or inaccuracy.

2.8 According to the Case Law of the Boards of Appeal, an amendment to a claim to clarify an inconsistency does not contravene Article 123(3) EPC if the amended claim has the same meaning as the unamended claim, on its true construction in the context of the specification in the sense of Article 69 EPC (see decisions T 271/84; OJ EPO 1987, 405; T 108/91; OJ EPO 1994, 228).

- 2.9 Respondent I mainly argued that
- i) a claim does not have to cover all the embodiments disclosed in the description, and
 - ii) claim 1 as granted makes sense, since a skilled person would understand that "translucent parts" used in plural refers to a plurality of windows and the claimed device comprising a plurality of windows is undoubtedly technically feasible.

The Board cannot agree to this.

All the embodiments disclosed comprise only one window, since according to the description of the patent in suit one window can possibly comprise two portions and still be a single window. Therefore, a skilled reader would realise that the plural term "translucent parts" cannot imply a plurality of parts, that is a plurality of windows and that therefore, this plural form is evidently inconsistent with the totality to the disclosure of the patent.

- 2.10 As already stated the amendment from the plural in granted claim 1 to singular removes this inconsistency and thus, does not infringe Article 123(3) EPC, see the above cited decision T 108/91.

- 2.11 Accordingly amended claim 1 of the main request meets the requirements of Article 123(3) EPC.

3. *Further processing:*

- 3.1 Since proceedings before the Boards of Appeal are primarily concerned with the examination of the contested decision, remittal of the case to the

Opposition division in accordance with Article 111(1) EPC is normally considered by the Boards in cases where the Opposition division issues a decision solely upon a particular issue and leaves one substantive issue regarding sufficiency of disclosure (Article 83 EPC), novelty (Article 54 EPC) or inventive step (Article 56 EPC) undecided.

In the present case the Opposition division gave its decision solely upon the particular issue of extension of the protection conferred (Article 123(3) EPC) and left not only the substantive issue of inventive step but also the formal issue of added subject-matter (Article 123(2) EPC) undecided.

- 3.2 In this respect, the Board observes that one could have at least expected the Opposition division to completely examine the formal allowability of the amended claims both under paragraphs (2) and (3) of Article 123 EPC. In fact, the decision under appeal leaves both of the raised grounds for opposition not only the substantive ground of lack of inventive step but also the formal ground of added subject-matter undecided. It also goes without saying that the approach taken by the Opposition division is contrary to the general interest of procedural expediency.

It is also observed that according to the established case law of the Boards, the filing of amended claims has to be considered as a formulation attempt, which does not prevent the patent proprietor from returning to the granted version of the claims. Thus, even in cases where the objection of extension of the protection conferred is well founded, it can be easily

overcome by submitting the granted version of the claims, thereby rendering an appeal unnecessary.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:

G. Magouliotis

M. Ceyte