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**Datasheet for the decision
of 14 October 2008**

Case Number: T 0799/05 - 3.2.04

Application Number: 99953734.3

Publication Number: 1126757

IPC: A01J 5/013

Language of the proceedings: EN

Title of invention:

A system for regulating the handling of milk during the milking process and a method for regulating said milking process

Patentee:

DeLaval Holding AB

Opponent:

Octrooibureau Van der Lely N.V.
WestfaliaSurge GmbH

Headword:

Somatic cells/DELAVAL

Relevant legal provisions:

EPC Art. 100(b)
RPBA Art. 13

Relevant legal provisions (EPC 1973):

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Keyword:

"Sufficiency of disclosure (no)"
"Auxiliary request filed during the oral proceedings (not admitted)"

Decisions cited:

T 0292/85, T 1321/04

Catchword:

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Case Number: T 0799/05 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 14 October 2008

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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
21 April 2005 concerning maintenance of
European patent No. 1126757 in amended form.

Composition of the Board:

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

Summary of Facts and Submissions

I. In its interlocutory decision dated 21 April 2005, the opposition division found that, having regard to the amendments submitted by the patent proprietor, the European patent No. 1 126 757, against which two oppositions had been filed, met the requirements of the European Patent Convention.

II. On 17 June 2005 opponent I (hereinafter appellant I) lodged a first appeal against this decision and simultaneously paid the appeal fee. A statement setting out the grounds of appeal was received on 27 July 2005.

A second appeal was lodged by opponent II (hereinafter appellant II) on 20 June 2005, for which the appeal fee was paid on the same day. A statement setting out the grounds of appeal was received on 22 August 2005.

On 21 June 2005 the patent proprietor (hereinafter appellant III) lodged a further appeal against this decision and simultaneously paid the appeal fee. A statement setting out the grounds of appeal was received on 22 August 2005.

III. Oral proceedings before the board were held on 14 October 2008.

IV. Appellants I and II requested that the decision under appeal be set aside and the patent be revoked.

Appellant III requested that the decision under appeal be set aside and the patent be maintained either on the basis of the amended claims of the main request filed

with letter dated 12 September 2008 or, auxiliarily, on the basis of one of the sets of amended claims of first to fourth auxiliary requests filed with the same letter or on the basis of the amended claim 1 of the fifth auxiliary request filed during the oral proceedings before the board.

V. Independent claims 1 and 27 of the main request read as follows:

"1. A method for regulating a milking process, said method comprising the steps of

- i) identifying at least one volume of milk,
- ii) assessing particles in the identified volume by either
 - a) counting of substantially individual somatic cells in the volume of milk, or
 - b) assessing at least one property of at least one biological particle in the volume of milk,

wherein the assessment of particles is performed by automated microscopy by creating a spatial image representation of electromagnetic radiation from an exposing domain containing a sample of the milk and performing a quantitated detection of the image, and

- iii) obtaining at least one result of the assessment of particles in the identified volume of milk,
 - iv) providing at least one predetermined milk quality parameter,
 - v) correlating the at least one result obtained in step iii) with the predetermined milk quality parameter provided in step iv),
 - vi) transferring any one or both of
 - c) the at least one result obtained in iii), and
 - d) the correlation obtained in v)
- to regulating means capable of regulating the milking process of at least a portion of the milk being milked, and
- vii) regulating the milking process based on any one or both of c) the at least one result obtained in iii), and d) the correlation obtained in v)."

"27. A system for regulating a milking process, said system comprising

- i) detecting means for identifying at least one volume of milk,
- ii) means for assessing particles in the identified volume by either

- a) counting of substantially individual somatic cells in the volume of milk, or
- b) assessing at least one property of at least one biological particle in the volume of milk,

wherein the assessment of particles is performed by automated microscopy performed by creating a spatial image representation of electromagnetic irradiation from an exposing domain containing a sample of the milk and performing a quantitated detection of the image,

- iii) storage means for storing and providing at least one result of the assessment of particles in the identified volume of milk,
- iv) storage means for storing and providing at least one predetermined milk quality parameter,
- v) processing means for correlating the at least one result provided in iii) to the at least one predetermined milk quality parameter provided in iv), and
- vi) means for regulating the milking process based on the correlation obtained in step v)."

Independent claims 1 and 28 of the first auxiliary request read as follows:

"1. A method for regulating a milking process, said method comprising the steps of

- i) identifying at least one volume of milk,
- ii) assessing particles in the identified volume by either
 - a) counting of substantially individual somatic cells in the volume of milk, or
 - b) counting of other biological particles,
- iii) obtaining at least one result of the assessment of particles in the identified volume of milk,
- iv) providing at least one predetermined milk quality parameter,
- v) correlating the at least one result obtained in step iii) with the predetermined milk quality parameter provided in step iv),
- vi) transferring any one or both of
 - c) the at least one result obtained in iii), and
 - d) the correlation obtained in v)

to regulating means capable of regulating the milking process of at least a portion of the milk being milked, and

- vii) regulating the milking process based on any one or both of c) the at least one result obtained in iii), and d) the correlation obtained in v)."

"28. A system for regulating a milking process, said system comprising

- i) detecting means for identifying at least one volume of milk,
- ii) means for assessing particles in the identified volume by either
 - a) counting of substantially individual somatic cells in the volume of milk, or
 - b) counting of other biological particles,
- iii) storage means for storing and providing at least one result of the assessment of particles in the identified volume of milk,
- iv) storage means for storing and providing at least one predetermined milk quality parameter,
- v) processing means for correlating the at least one result provided in iii) to the at least one predetermined milk quality parameter provided in iv), and

- vi) means for regulating the milking process based on the correlation obtained in step v)

Independent claims 1 and 27 of the second auxiliary differ respectively from claims 1 and 28 of the first auxiliary request in that the features "wherein the assessment of particles is performed by automated microscopy by creating a spatial image representation of electromagnetic radiation from an exposing domain containing a sample of the milk and performing a quantitated detection of the image" have been added after the expression "counting of other biological particles".

Independent claims 1 and 25 of the third auxiliary request differ respectively from claims 1 and 28 of the first auxiliary request in that the alternative feature "or b) counting of other biological particles" has been deleted.

Independent claims 1 and 24 of the fourth auxiliary request differ respectively from claims 1 and 25 of the third auxiliary request in that the features "wherein the assessment of particles is performed by automated microscopy by creating a spatial image representation of electromagnetic radiation from an exposing domain containing a sample of the milk and performing a quantitated detection of the image" have been added after the expression "counting of substantially individual somatic cells in the volume of milk".

Independent claim 1 of the fifth auxiliary request reads as follows:

"1. A method for regulating a milking process, said method comprising the steps of

- i) identifying at least one volume of milk,
- ii) assessing particles in the identified volume by counting of substantially individual somatic cells in the volume of milk, said assessing step including:

- arranging said volume of milk as a sample in a sample compartment having a wall part defining an exposing area, the wall part allowing electromagnetic signals from the sample in the compartment to pass through the wall and to be exposed to the exterior,

- exposing, onto an array of active detection elements, an at least one-dimensional spatial representation of electromagnetic signals having passed through the wall part from the sample in the sample compartment, the representation being one which is detectable as an intensity by said individual active detection elements, under conditions which will permit processing of the intensities detected by the array of detection elements during the exposure in such a manner that representations of electromagnetic signals from somatic cells are identified as

distinct from representations of electromagnetic signals from background, the size and volume of the liquid sample being sufficiently large to permit the assessment of the number of somatic cells to fulfil a predetermined requirement to the statistical quality of the assessment, preferably based on substantially one exposure,

processing the intensities detected by the detection elements in such a manner that signals from the somatic cells are identified as distinct from backgrounds signals, and

correlating the results of the processing to the number of somatic cells in the milk,

- iii) transferring the correlation obtained in ii) to regulating means capable of regulating the milking process of at least a portion of the milk being milked, and
- vii) regulating the milking process based on the correlation obtained in ii).

VI. Appellants I and II essentially submitted that the requirements of Article 100(b) EPC were not met, because the skilled person was unable, without any inventive contribution, to carry out steps v) and vi) of claim 1 of the main, first, second, third and fourth auxiliary requests. Moreover, they submitted that amended claim 1 of the fifth auxiliary request should

not be admitted into the proceedings essentially because it was late filed and not *prima facie* allowable.

Appellant III submitted in essence that the patent specification gives sufficient information of how to carry out the claimed steps v) and vi). More particularly: Paragraph [0042] of the patent specification discloses a correlation consisting in a simple conversion of the number of individual somatic cells as counted in the analyzed volume of milk into "the number of somatic cells per volume of milk", which constitutes the predetermined milk quality parameter referred to in the claims. The patent specification, thus, discloses at least one way of carrying out the claimed invention and therefore fulfils the requirement of sufficiency of disclosure.

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 appeals are admissible.
2. *Article 100 (b) EPC (main, first, second, third and fourth auxiliary requests)*

According to the jurisprudence of the Boards of Appeal an invention is sufficiently disclosed within the meaning of Article 100(b) or 83 EPC if at least one way is clearly indicated enabling the skilled person to carry out the claimed invention (see in particular T 292/85, OJ EPO 89, 275).

As substantiated below, the patent specification does not describe a single way of carrying out the steps v) and vi) in claim 1 of the main request, that is the steps of

- v) correlating the result obtained in step iii) with the milk quality parameter, and
- vi) regulating the milking process based on the correlation obtained in step v).

In paragraph [0042] of the patent specification it is stated that "the result of the counting of individual somatic cells is correlated to a value substantially representing the number of somatic cells per volume of milk, by the use of one or more calculated and/or predetermined parameters." (emphasis added).

Correlating an entity with another means establishing a certain relationship between these two entities. In the context of the above quoted passage, this expression should apparently be given the meaning that the result of the counting of individual somatic cells is "converted" into a value representing the number of of somatic cells per volume of milk.

However in this case, the patent specification is wholly silent as to how the milking process may be

regulated on the basis of these converted number of somatic cells (step vi) of claim 1) without comparing it with a predetermined limit.

The opposition division has stated on page 7 of its decision that what is in fact done in step v) is that the result obtained in step iii) is compared with a predetermined limit. However, terms used in a patent document should be given their normal meaning in the relevant art unless the description gives the terms a special meaning, the patent document being its own dictionary, see e.g. T 1321/04. In the absence of any definition in the patent specification, the term "correlating" should mean what it says, namely a certain relationship is established between the result obtained in step iii) and the milk quality parameter in accordance with step iv). There is no question of "comparing" these two entities. Moreover, in the above quoted passage, the result of the counting of individual somatic cells is said to be correlated to a value representing the number of somatic cells per volume of milk. Here the term "correlated" cannot be understood as meaning "compared", since the result of the counting of somatic cells, that is the number of somatic cells, on the one hand, and the number of somatic cells per volume of milk, on the other hand, are not directly comparable. The skilled reader is thus left in doubt as to the exact meaning of the expression "correlating" in the claimed step v). It also follows that contrary to the appellant III's submissions the above quoted paragraph [0042] does not disclose let alone describe in detail a single way of carrying out the steps v) and vi) of the claimed invention. Moreover, none of the other parts of the description do

disclose a single way of carrying out the above steps. Thus, in the absence of information in the patent specification of how to carry out the claimed steps v) and vi), the disclosure of the claimed invention is insufficient.

Furthermore, "correlation" in the field of data analysis means a relationship between two independently measured variables, i.e. when there is no known relationship between them. It is exactly the performing of the correlation step which is expected to establish whether or not a relationship exists between the two independently measured variables. However, there is no indication in the patent that this other meaning of the term "correlation" should be excluded when construing the claim, but at the same time there is no embodiment which could help the skilled person to carry out the invention according to this, actually more natural interpretation than the one discussed above, i.e. based on the notion of "comparing".

- 2.1 Appellant III submitted that according to paragraph [0046] of the patent specification, "[o]ne quality parameter of milk is the presence of blood in the milk, and one preferred embodiment of the present invention is based on the assessment of the number of blood particles". The patent specification defines the presence of blood in the milk as a second milk quality parameter. In this case the correlation consists in comparing the assessed number of blood particles with a reference value.

However, paragraph [0046] follows paragraph [0045] dealing with the assessment of biological particles in

the milk, that is with the alternative b) of step ii) , but not with the alternative a) of step ii) of "counting of substantially individual somatic cells in the volume of milk".

2.2 Thus, the patent specification does not describe the claimed invention in a manner sufficiently clear and complete for it to be carried out by the skilled person. Therefore, the ground for opposition under Article 100(b) EPC prejudices the maintenance of the patent on the basis of the main request. Claim 1 of the first to fourth auxiliary request contains in essence the same two steps as claim 1 of the main request. These auxiliary requests must also fail on the ground of insufficiency of disclosure.

3. *Fifth auxiliary request (admissibility)*

3.1 Claim 1 according to this request was filed during the oral proceedings to replace claim 1 of the previous fifth auxiliary request filed with letter dated 12 September 2008 after oral proceedings had been arranged. The admissibility of the present fifth auxiliary request has to be considered in conjunction with the previous fifth auxiliary request.

3.1.1 This request is completely new with respect to all previously filed requests, i.e. with respect to each of the six requests submitted before the opposition division as well as to each of the fifteen requests filed with the statement of grounds of appeal.

In this respect, it has to be noted that the present main request essentially corresponds to the fourth

auxiliary request submitted before the opposition division and that present first, second, third and fourth auxiliary requests respectively correspond to first, fifth, eighth and twelfth auxiliary requests submitted with the statement of grounds of appeal.

- 3.1.2 Both claim 1 of the present fifth auxiliary request as well as claim 1 of the previously filed fifth auxiliary request contain additional features extracted from a passage bridging pages 9 (from line 22) and 10 (to line 11) of the description of the application as filed, which features refer to the correlation of the obtained results of the counting of individual somatic cells in the identified volume of milk to the number of somatic cells in the milk and define in a more detailed way how these results are obtained.

Claim 1 of the present fifth auxiliary request differs from that of the previously filed fifth auxiliary request essentially in that the features "providing at least one predetermined milk quality parameter" (see feature iv) in granted claim 1) and "correlating the at least one result ... with a **predetermined** milk quality parameter..." (see feature v) in granted claim 1; emphasis added) have been deleted.

- 3.2 With respect to the admissibility of this request, appellant III essentially argued as follows:

- a) During the appeal proceedings the European patent was transferred from the previous proprietor (ChemoMetec A/S) to the present proprietor (i.e. appellant III) who chose a new representative. Appellant III realized only in a late stage of the

proceedings that the claims on file did not contain detailed features concerning how the assessment of particles was performed, whereafter he submitted claim 1 of the previous fifth request.

- b) In drafting claim 1 of this previous fifth request a mistake was made in so far as this claim not only contains an additional feature concerning the correlation of "the results of the processing to the number of somatic cells in the milk" but also refers to the correlation as defined by feature v), without making it clear that this additional feature is a *species* of feature v).

3.2.1 The board cannot accept the arguments under item a) above for the following reasons:

- i) The request for registration of transfer of right was filed by the new representative of appellant III by letter dated 5 November 2007. An objection under Article 100(b) EPC concerning the insufficient disclosure of the step "correlating the result ... with at least one predetermined milk quality parameter" had already been submitted by appellant I with his letter dated 9 January 2006. Further objections under Article 100(b) EPC concerning the insufficient disclosure of the step of counting individual somatic cells had already been submitted by appellant II with letters of 22 August 2005 and 1 March 2006.

Claim 1 of the previously filed fifth auxiliary request, which was filed with letter dated

12 September 2008, could have been filed by appellant III in an earlier stage of the proceedings, e.g. after the date at which registration of transfer was filed (5 November 2007) and before oral proceedings had been arranged (6 June 2008).

- ii) In the board's communication dated 11 July 2008, the board made provisional comments on Article 100(b) EPC only relating to the feature of "assessing at least one property of at least one biological particle ...". Thus, the filing of claim 1 of the previous fifth auxiliary request cannot be considered as a reaction of appellant III to the board's communication.

These reasons also apply for the present fifth auxiliary request.

The argument under item b) above does not alter the situation. A party cannot rely on its own mistake for securing an advantageous procedural position, such as the filing of a request for which the other party had no time to prepare.

Therefore, there is no proper justification for the late filing of this request.

- 3.3 Moreover, the amendments leading to the fifth auxiliary request are quite extensive and raise new issues which have not been considered so far in the previous opposition or appeal proceedings.

In particular, since in claim 1 of this request it is not stated that the "number of somatic cells in the milk" is the "predetermined milk quality parameter" which is no longer mentioned in claim 1, it is not immediately apparent that the requirements of Article 123(3) EPC would not be contravened. It is also not clear that the additional features extracted from a passage of the application as filed which relates to "an assessment of somatic cell in a milk" are in relationship with "a method of regulating a milking process" comprising the step of assessing particles "by counting of substantially **individual** somatic cells" (emphasis added) in an identified volume of milk. Thus, it is not immediately apparent that the requirements of Article 123(2) EPC would not be contravened.

Furthermore, it is not immediately apparent that the ground for opposition under Article 100(b) EPC would not prejudice the maintenance of the patent on the basis of this claim having regard to the feature concerning the correlation (see section 2.2.1).

Moreover, the terms in claim 1 "to fulfil a predetermined requirement to the statistical quality of the assessment" do not appear to meet the requirements of Article 84 EPC.

Therefore, the amended claim 1 of the fifth auxiliary cannot be considered as being *prima facie* allowable.

- 3.4 From Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA) it is clear that amendments to a party's case after the grounds of appeal have been

filed may be admitted and considered at the board's discretion.

For the above reasons, the board in exercising its discretion in particular under Article 13(1) RPBS decided that the fifth auxiliary request should not be admitted into the proceedings.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

G. Magouliotis

M. Ceyte