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**Datasheet for the decision
of 7 March 2007**

Case Number: T 0922/05 - 3.2.04

Application Number: 98203804.4

Publication Number: 0900523

IPC: A01J 5/017

Language of the proceedings: EN

Title of invention:

A construction for automatically milking animals

Patentee:

MAASLAND N.V.

Opponent:

DeLaval International AB

Headword:

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Relevant legal provisions:

EPC Art. 108, 111, 114(1)

EPC R. 65(1)

RPBA Art. 10a(2)

Keyword:

"Admissibility of appeal (no-insufficiency of grounds)"

Decisions cited:

J 0022/86; T 0220/83; T 0145/88; T 0729/90; T 0563/91;

T 0574/91; T 0065/96; T 0162/97

Catchword:

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Case Number: T 0922/05 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 7 March 2007

Appellant: MAASLAND N.V.
(Patent Proprietor) Weverskade 10
NL-3155 PD Maasland (NL)

Representative: Corten, Maurice Jean F.M.
Octrooibureau Van der Lely N.V.
Weverskade 110
NL-3147 PA Maasluis (NL)

Respondent: DeLaval International AB
(Opponent) PO Box 39
S-147 21 TUMBA (SE)

Representative: Jackson, Richard Eric
Carpmaels & Ransford
43-45 Bloomsbury Square
London WC1A 2RA (GB)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 24 May 2005
revoking European patent No. 0900523 pursuant
to Article 102(1) EPC.

Composition of the Board:

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

Summary of Facts and Submissions

- I. An opposition based upon Articles 100(a), (b) and (c) EPC was filed against the European patent No. 900 523. The opposition division revoked the patent by decision dated 24 May 2005.

In the decision under appeal, the opposition held that the ground for opposition according to Article 100(c) EPC prejudiced the maintenance of the patent on the basis of the main request of the patent proprietor since the subject-matter of dependent claim 6 extended beyond the content of the earlier application as filed (Article 76(1) EPC) and that the ground for opposition according to Article 100(a) EPC prejudiced the maintenance of the patent on the basis of first and second auxiliary requests since the subject-matter of claim 1 of these requests lacked novelty (Article 54 EPC) having regard to prior art documents D2 (EP-A-0347004) or D3 (US-A-4223635).

- II. The patent proprietor (hereinafter appellant) filed a notice of appeal against this decision on 4 June 2004 and simultaneously paid the appeal fee. The notice of appeal contained a formal request to set aside the decision of the Opposition Division "for the reasons as will be set out in the Grounds of Appeal". The notice of appeal further contained a request for oral proceedings. No reasons for the requests were given in the notice itself.
- III. The statement setting out grounds of appeal pursuant to Article 108 EPC, last sentence was received on 16 August 2004. Together with the grounds of appeal a

new set of claims 1 to 17 as well as an amended page 2 was filed. The grounds consists of a first paragraph identifying the decision under appeal and repeating the formal requests of the notice of appeal (see above), a second paragraph referring to the new set of claims 1 to 17, in which it is stated that "new claim 1 corresponds to the previous claims 1, 11 and 12" [and] claims 13-19 have been numbered as new claims 11-17".

IV. The third and final paragraph of the grounds of appeal reads as follows:

"The new main claim is based upon claims 1-11 and 12 as granted. It is now clear that there is provided a separate suction system for cleaning the udder and/or teats. Such a separate suction system is not known from any of the cited prior art documents. Therefore, the Art. 100(a) EPC objections are overcome."

V. Claim 1 of the main, first and second auxiliary requests before the Opposition Division was worded as follows:

"1. A construction for the automatic milking of animals, such as cows, by means of a milking robot (5) and one or more teat cups (6), characterized in that it comprises a suction system, of which the suction mouthpieces (81) are automatically movable such that the animal's udder and/or teats are automatically cleanable by means of the suction system"

VI. Claim 1 as submitted with the appeal is worded as follows:

"1. A construction for the automatic milking of animals, such as cows, by means of a milking robot (5) and one

or more teat cups (6), characterized in that it comprises a suction system, of which the suction mouthpieces (81) are automatically movable such that the animal's udder and/or teats are automatically cleanable by means of the suction system, the construction comprising a continuously sucking pump for drawing-in air through the suction mouthpiece (81), the suction mouthpieces (81) being connected to the continuously sucking pump through an air outlet line (79)." (amendments to the granted claim underlined by the board).

VII. In the written phase of the proceedings, the respondent requested that the appeal be rejected as inadmissible or at least to be dismissed as not allowable.

VIII. In a communication to the parties, the board indicated its preliminary opinion that the statement setting out the grounds of appeal clearly indicates a causal link between the amendments made to the granted claim 1 and the reasons given in the decision. Thus the board considered that the appellant submitted why the decision under appeal is incorrect, in so far as it concerns novelty with regard to the new amended claim 1.

IX. Oral proceedings were held on 7 March 2007. The appellant requested that the decision under appeal be set aside and the patent be maintained on the basis of claims 1 to 17 filed with letter of 19 January 2007. This latter was filed as a response to the communication from the board.

The respondent maintained its request to reject the appeal as inadmissible or to dismiss the appeal.

- X. With regard to the admissibility of the appeal, the appellant essentially argued as follows:
- (a) The appeal complies with the requirements of Article 108 EPC, since the new request prima facie overcomes both Article 100(c) EPC and Article 100(a) EPC objections. The wording of the new claims clearly identifies those features which distinguish the claimed invention from the prior art.
 - (b) The amendments made to the claims in order to overcome the finding of the Opposition Division on the Article 100(c) issue was simply to delete the claim in question. Such a simple and self-evident amendment could be easily identified by way of a simple comparison between the corresponding claim sets, and did not need any explanation.
 - (c) The appellant addressed only those substantive issues underlying the decision under appeal with which it disagreed. There was no need to address the Article 100(c) EPC issue, as in this regard the appellant agreed with the finding of the Opposition Division.
 - (d) There is no minimum requirement as to the amount of the reasons in the grounds of appeal. Though short, the grounds of appeal contains all essential elements necessary for deciding on the appeal.
 - (e) The appellant was frequently involved in proceedings before the present board, and it knew the board well. It was confident that the issues of the present appeal were not so complicated so as to present a difficulty for the board.

In its further written submissions, which were filed after the four-month's time limit pursuant to Article 108 EPC, third sentence, the appellant also presented further arguments in support of the allowability of the newly filed claims.

XI. With regard to the admissibility of the appeal, the respondent essentially argued as follows:

- (a) The reasoning of the grounds of appeal is so extremely short that this statement cannot possibly correspond to the spirit of Article 108 EPC. The grounds of appeal cannot be reduced to a simple "memo" to the board.
- (b) The reasons fail to contest the impugned decision or to indicate why the decision was incorrect, either with regard to the claims before the Opposition Division or with regard to the newly filed request. In this manner, the statement of the grounds of appeal is insufficient to suggest that the reasoning of the impugned decision no longer applies. It is not clear whether or not the reasons underlying the decision under appeal has been addressed at all.
- (c) The reasons also fail to explain how or why should the wording of the new main claim reflect the alleged novel features (the separate suction system). Even if the amendments are appropriate, they need to be identified and explained.
- (d) In not providing proper reasons, the proprietor essentially puts the burden on the board for finding out, why the decision under appeal is wrong.

- (e) The amendments presented cannot be expected to change the decision on the opposition, because the claim is still not novel.
- (f) Absent proper reasons the opponent and third parties can not identify the extent of the appeal or the arguments of the proprietor, without resorting to speculation. Thus they are left in uncertainty concerning the course of action which the proprietor may take during the appeal proceedings.
- (g) Neither the filing of the new claims in response to the communication from the board, nor the arguments put forward at a later stage can cure the deficiencies of the appeal itself. The grounds of appeal must mention the legal and factual reasons why the decision under appeal is incorrect, following decisions T 220/83 and T 145/88.

XII. The respondent also addressed the substantive issues underlying the decision under appeal.

Reasons for the Decision

Admissibility of the appeal

1. It appears to be common ground that the admissibility turns on the question whether the grounds presented in the statement of the grounds of appeal (see points III and IV above) are sufficient to comply with Article 108 EPC, third sentence.
2. As a preliminary remark, the board notes that the sufficiency of grounds is not a question of form, but

of substance. The mere existence of some argumentation and carrying the heading "Statement of the Grounds of Appeal" does not automatically pass the threshold of Article 108 EPC, even if clearly relating to the substance of the impugned decision, following T 145/88, (OJ EPO 1991, 251), see Headnote. On the other hand, sufficiency is also not a question of volume. There is indeed no minimum requirement as to the length or the fullness of detail of the argumentation which is necessary for an admissible appeal. The board is also conscious of the distinction between insufficiency for the purposes of admissibility vs. "insufficient", i.e. not convincing grounds which result in the dismissal of the appeal, see T 65/96, point 1.1. of the reasons. Thus in the present case the allegation that the new claims can not be expected to change the outcome of the opposition (see point XI (e) above) is irrelevant for the admissibility.

3. Rather, this board concurs with the reasoning of decisions T 220/83 (OJ EPO 1986, 249) and T 145/88 (*supra*), according to which the grounds of appeal should state the legal or factual reasons why the impugned decision should be set aside, see Headnote in both decisions. The same principle is expressed in an unmistakable fashion by decision J 22/86 (OJ EPO 1987,280), see point 2 of the reasons: "...the requirement for a written Statement "setting out the grounds of appeal" is clearly not merely formal, but involves a presentation of the Appellant's case... The requirement of Article 108 EPC is for a statement which sets out the substance of the Appellant's case; that is, the reasons why the appeal should be allowed and the decision under appeal should be set aside... a well-

drafted Statement of Grounds of Appeal should contain reasoning that is full but concise. And, in general, it is obvious that the less reasoning that a Statement contains, the greater will be the risk that the appeal will be rejected as inadmissible for non-compliance with Article 108 EPC. ..."

4. This principle is also mirrored in Article 10a(2) of the Rules of Procedure of the Boards of Appeal (RPBA): "The statement of grounds of appeal ...shall contain a party's complete case. They shall set out **clearly** and concisely the reasons why it is requested that the decision under appeal be reversed..., and should specify **expressly** all the facts, arguments and evidence relied on. ..." (emphasis by the board).

5. The substantive compliance of the appeal with Article 108 EPC, third sentence as explained above - i.e. the existence of the "legal and factual" reasons - must be determined in light of the particular circumstances of the case, see also J 22/86 (*supra*), point 2 of the reasons: " The question whether a particular statement alleged to be a Statement of Grounds of Appeal in a particular case meets the minimum requirement of Article 108 EPC can only be decided in the context of that particular case;.."

6. In the present case, in the first instance opposition proceedings the patent was revoked. It is normally expected that the proprietor would seek to secure a patent for some subject-matter already during the first instance proceedings. Indeed, during the first instance proceedings the proprietor filed several requests, which were refused either under Article 100(c) or under

Article 100(a) EPC. In other words, the appeal proceedings had to start from the presumption that there is no subject-matter in the patent which would not violate either Article 100(a) EPC (for lack of novelty) or 100(b) EPC (for extension of the divisional application over its parent), and the onus is on the proprietor to prove otherwise. The expected scope and content of the argumentation from the proprietor must be seen against this background.

7. The board agrees with the appellant that the statement of the grounds of appeal clearly addressed the novelty of the claims, i.e. the Article 100(a) issue of the decision, even if not making explicit reference either to the relevant passages to the decision under appeal, to the relevant legal provisions, or to the documents D2 or D3 which were regarded as novelty destroying in the decision. However, after having studied the case, it became apparent that the statement of the grounds of appeal remained silent on at least two issues, which would have been clearly relevant for deciding on the appeal, and therefore should have been addressed by the grounds of appeal in order to be complete:
 - (a) the compliance of the claims with Article 100(c) EPC
 - (b) the status of the requests before the Opposition division and the requests before the board, and the relationship between those requests, i.e. the identification of the amendments, if any (note that the appeal only made a reference to the granted claims)

8. The silence of the appellant on these issues is seen by the board as a serious defect of the appeal. This is

not changed by the fact that both issues could have been easily dispensed with in just a few sentences, without lengthy argumentation. Contrary to the opinion of the respondent, it is not even required that the appellant explicitly challenges the impugned decision under appeal on the Article 100(c) issue, a simple statement of acceptance would have sufficed.

9. The insufficiency of the grounds can not be excused by the fact that the appellant was acting in good faith. "Knowing the board" (or the other party, for that matter) is particularly no reason for expecting a more lax treatment. On the contrary, the boards must treat parties strictly equally, in order to prevent any accusation of partiality or simply "insider practices".

10. The board's overall perception of the insufficiency of the grounds is further aggravated by an immediately apparent substantial deficiency in the chain of reasoning presented in support of the novelty issue. The decision under appeal found the claimed subject-matter to lack novelty in view of both D2 and D3. As already stated, in accordance with the well-established case law the statement of the grounds of appeal should contain the full reasons why the appeal should be allowed and the decision under appeal should be set aside, see decision J 22/86 (*supra*). This means in the present case that the statement of grounds should contain the full reasons, that is a *prima facie* complete chain of reasoning leading to the conclusion that the amended subject-matter is novel over D2 and D3 i.e. the conclusion argued for by the appellant.

11. The statement of the grounds of appeal says "It is now clear [due to the amendment of claim 1] that there is provided a separate suction system for cleaning of the udder and/or teats. Such a separate suction system is not known from any of the cited prior art documents".

12. This logically means that amended claim 1 should define a separate or a further suction system for cleaning the udder and/or teats. This is apparently not the case: The claimed construction of amended claim 1 is "characterized in that it comprises a suction system", but not a separate suction system. The amendment in claim 1 merely reads: "the construction comprising a continuously sucking pump for drawing-in air through the suction mouthpiece (81), the suction mouthpieces (81) being connected to the continuously sucking pump through an air outlet line (79)". There is no apparent logical link between the amendment in claim 1 relating to the presence of a continuously sucking pump and the statement that "by reason of this amendment" "it is now clear that there is provided a separate suction system".

13. It results from the *de facto* absence of a logical link between the reasoning presented in the statement of the grounds of appeal and the amendment in claim 1 that the statement of grounds in combination with the amended claims does not contain an unbroken chain of reasoning, that is the full reasons why according to the appellant the subject matter of amended claim 1 would be novel over both D2 or D3. The appellant thus puts the onus on the board to fill in the missing logical link in the chain of reasoning.

14. Indeed it can not be expected from the board to seek out the arguments in order to verify for itself if the presently filed claims would overcome the grounds for the revocation. It is quite possible that this latter exercise would not pose a serious mental challenge to the board - the board even accepts that in the present case some aspects are more or less self-evident, provided that the board proceeds to look for the relevant details of the case **on its own motion**. However, it is this latter aspect which is the key to this case, and not the perceived or objective ease or difficulty of the examination. When it is the admissibility which is at stake, the board should expect to be directed towards the facts that need to be examined, and should refrain from advancing arguments on its own. Examining admissibility means the examination of the fact whether there **are** sufficient grounds, not whether there **could be**.
15. It is highly questionable if it would be appropriate for the board to actively search for the arguments in support of appellant's case in an inter partes proceedings, even if the board is clearly entitled to do so by virtue of Article 114(1) EPC. In inter partes proceedings, any active contribution of the board made for the benefit of one party without an explicit request of that party may be seen as an action to the detriment of the opposing party and would thus question the impartiality of the board.
16. For the avoidance of doubt, it must be emphasized that a board not only may, but is obviously **obliged to** perform certain activities even without any specific instructions from either the appellant or any other

party. Thus it is expected from a board as a matter of course to read the decision under appeal (including all those parts of the file which the decision refers to) and certainly the requests upon which it was based. It is likewise expected from the board to read the appeal and its annexes, to endeavour to understand the arguments and to construe the request of the parties in light of the circumstances, even if the requests are somewhat unclear or the arguments do not appear convincing. What is and can not be expected, however, that a board substitutes a **non-existing** statement or argument with its own, presumes the existence of a request when there is none, or fills in the missing links of the chain of reasoning and thereby establishes a coherent and complete argumentation in support of such requests instead of the requesting party, no matter how straightforward it may seem in light of the particulars of the specific case.

17. The board is aware of the substantial body of case law where the sufficiency of the grounds has been examined for the purposes of admissibility. There are several decisions in which a relatively lenient position was taken towards the appellant, in the sense that the appeals were deemed to be admissible if the competent board was able to infer from the particulars of the case the presumed intentions of the applicant and the probable reasons underlying its actions, see decision T 162/97, point 1.1.2 of the reasons, (not published in OJ)(in inter partes proceedings, further see T 574/91, point 1.2 of the reasons (in inter partes proceedings), T 729/90, point 1.2 of the reasons (in ex parte proceedings), T 563/91, point 1.2 of the reasons (in inter partes proceedings)).

18. The present board recognizes that good arguments may be advanced in support of such a lenient approach. It is certainly arguable that appeals should be decided primarily on their substance, and parties should be given the possibility to argue their case without strict formal requirements.

19. However, excessive leniency towards one party will rightly be perceived as an injustice towards the other. This also applies to the leniency in admitting appeals. On the other hand, proceedings should not be clogged with excessively voluminous submissions simply to overcome a potential rejection of the appeal on the basis of inadmissibility. Therefore, parties and the boards alike need some guidelines about the contents of admissible submissions. Article 10a (2) RPBA (see point 4 above) is eminently suitable for providing these guidelines.

20. Attention is drawn again to the provision that the statement of grounds of appeal shall contain a party's complete case. Though Article 10a(2) RPBA have been adopted primarily with an eye towards regulating late-filed submissions, the board is guided by the very same principle when applying it to an appeal with apparently insufficient grounds. Such an appeal can hardly constitute the complete case of the appellant, because the insufficiency of the grounds will inevitably trigger later submissions from the appellant, seeking to complete the insufficient grounds so as to make them sufficient. Thus rejecting an appeal as inadmissible on the basis of insufficiency of grounds equals to the judgement of the board that sufficiency only could have

- been established by later submissions, which necessarily would have contravened Article 10a(2) RPBA.
21. By the same token, Article 10a(2) RPBA further states that "[the grounds of appeal] shall set out **clearly** and concisely the reasons why it is requested that the decision under appeal be reversed..., and should specify **expressly** all the facts, arguments and evidence relied on". The present board is of the opinion that submissions of a party, which only make it possible for a board to **infer** a line of argumentation, do not fulfil the requirements of either the "**clear** reasons" or the "**express** specification of facts and arguments" as prescribed by the RPBA.
22. The board further notes that the RPBA is exclusively concerned with the procedural aspects of the appeal procedure. Thus it appears logical that non-compliance with the RPBA should have procedural, rather than substantive consequences, all the more as these latter consequences are clearly regulated by Article 111 EPC. This also dictates that an examination of a party's submissions as to the compliance with Article 10a(2) RPBA primarily should be decisive for the admissibility of such submissions.
23. Finally, the board notes that no exceptional circumstances can be recognized in the present case, such as an immediately apparent defect of the impugned decision, which might have allowed the board to dispense with the requirement of providing sufficient grounds for the appeal.

24. For the reasons above, the board finds that the grounds submitted by the appellant with the grounds of appeal are insufficient. Substantive arguments by the appellant submitted after the time limit as specified in Article 108 EPC, third sentence can not be taken into consideration for the admissibility of the appeal, which accordingly must be rejected as inadmissible pursuant to Rule 65(1) EPC.

Order

For these reasons it is decided that:

The appeal is rejected as inadmissible.

The Registrar:

The Chairman:

U. Bultmann

M. Ceyte