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Datasheet for the decision of 25 November 2010

Case Number: T 0385/09 - 3.2.04

Application Number: 00946559.2

Publication Number: 1119237

IPC: A01K 13/00

Language of the proceedings: EN

Title of invention:
A method of cooling animals

Patentee:
Lely Enterprises AG

Opponent:
DeLaval International AB

Headword:
-

Relevant legal provisions:
EPC Art. 53 a) c), 111(1)

Relevant legal provisions (EPC 1973):
EPC Art. 100 a) b)

Keyword:
"Invention excluded from patentability (no): sufficiency of disclosure (yes)"
"Remittal (yes)"

Decisions cited:
T 0774/89, T 0329/94, G 0001/03, G 0002/03

Catchword:
A method of cooling animals such as cows in which a liquid reduced to a fine spray is applied to the animals and air is blown over the wetted animals is not necessarily a therapeutic method.

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0385/09 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 25 November 2010

Appellant: (Patent Proprietor)
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Decision under appeal:
Decision of the Opposition Division of the European Patent Office posted 2 December 2008 revoking European patent No. 1119237 pursuant to Article 101(3)(b) EPC.

Composition of the Board:

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

Summary of Facts and Submissions

I. By its decision dated 2 December 2008 the Opposition Division revoked the European patent 1 119 237. On 11 February 2009 the Appellant (patentee) filed an appeal and paid the appeal fee simultaneously. The statement setting out the grounds of appeal was received on 20 March 2009.

II. The patent was opposed on the grounds based on Article 100a) and b) EPC 1973 (novelty, inventive step, industrial applicability (Article 52(4) EPC 1973), and sufficiency of disclosure). The Opposition division considered that all the sets of claims of the main and the auxiliary requests related to methods for treatment of the animal body and were accordingly excluded from patentability according to Article 53(c) EPC 2000, without deciding on the other grounds of opposition.

III. Claims 1 filed with the grounds of appeal reads as follows:

"1. A non-therapeutic method of cooling animals, such as cows, whereby a liquid is applied between the hairs and/or on the skin of the animal, and wherein air is blown over the liquid, and after applying the liquid air is blown over the liquid characterized in that the animals are cooled in a milking stall, in which milking stall a milking robot is disposed, so that the animals go to the milking stall spontaneously."

IV. Oral proceedings took place on 25 November 2010 before the Board of Appeal.

The Appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the claims filed with the grounds of appeal.

He mainly argued as follows:
The method is intended to give animals which are not in a pathological state a pleasant sensation. Cooling the animals by applying liquid on them is not a treatment by therapy, because it is not related to the health of the animal.
It is also clear for a person willing to understand that the claimed method does not contemplate cooling the animals down to such a degree that they become sick, but to provide them a pleasant feeling. Thus the claimed method is not contrary to "ordre public" or "morality".
Even if no temperature range is indicated in the patent specification a skilled person can easily, even by trial and error, find out the temperature at which the animals feel comfortable and thus can carry out the invention.

V. The Respondent (opponent) mainly submitted that the only reason for an animal to go spontaneously to the milking stall to be cooled is that it suffers from discomfort. If the claimed method provides relief from such discomfort, then it is necessarily therapeutic, and during the application of the method it is impossible to distinguish between healing and mere relief. Therefore the claimed method falls under the exception to patentability according to Article 53 (c) EPC. Moreover, if the method were not therapeutic, i.e. were to be applied to an animal which is not suffering from heat, this could cause pain to the animal or even

lead to illness, which would be contrary to morality. In this case the exclusion to patentability according to Article 53 (a) EPC would apply.
By the same token, if the animal does not suffer from discomfort, it will not be motivated to go to the milking stall, so that the claimed method cannot be carried out. On the other hand, there is no indication at which temperature the animal should be cooled to feel comfortable, so that it would amount to an undue burden to the skilled person to determine the adequate temperature.
The claims, now containing the disclaimer "non-therapeutic" also infringe Article 100(b) EPC because the skilled person is not provided with any information in the patent specification how the non-therapeutic application of the method should be distinguished from a therapeutic application.

The Respondent requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

2. *Allowability of the disclaimer*

The addition of the disclaimer "non-therapeutic" has not been objected to *per se* by the Respondent, even though the wording was not disclosed in the application as filed, nor was the difference between a therapeutic and non-therapeutic application of the method explicitly explained in any other manner. However, the Board is satisfied that the application does contain

teaching of a method which may possibly be regarded as therapeutic (cooling of cows in a heat stress), but also teaching of a method which is clearly not therapeutic, neither in view of its main purpose, nor because of any unavoidable side effect (cooling of healthy cows for luring them to the milking stall, see point 3 below). The patent was revoked in the first instance for contravening Article 53(c) EPC. Thus the disclaimer was also necessary for disclaiming subject-matter being excluded from patentability. Following decisions G 1/03 and G 2/03 (OJ EPO 2004,413 and 448), such disclaimers are allowed even when not disclosed, see Headnote, Points II.1. The Board is also satisfied that the disclaimer is appropriately formulated, has no bearing on novelty or inventive step, and is sufficiently clear and concise (G 1/03 and G 2/03 supra, Headnote, Points II.2-4)

3. *Exceptions to patentability under Article 53 EPC*

3.1 According to Article 53 EPC " European patents shall not be granted in respect of:
(a) inventions the commercial exploitation of which would be contrary to "ordre public" or "morality" …
(b) …
(c) methods for treatment of the … animal body by … therapy … practised on the … animal body…"

3.2 The Respondent contended that if the method were non-therapeutic, it would result in cooling an animal which is in a normal state so that its temperature would fall below an abnormal level. This however would cause suffering to the animal and therefore be contrary to morality according to Article 53 a) EPC.

This cannot be followed. According to claim 1 the method should have the effect that "the animals go to the milking stall spontaneously". An animal would only behave so in expectation of a reward, i.e. if the animal is subjected to a treatment which is perceived as pleasant. Hence the skilled person would clearly exclude from the scope of the claimed method the possibility of reducing the animal's body temperature to such a degree that it would cause suffering to the animal.

3.3 With reference to the case law on the meaning of "therapy" it is understood that therapy is concerned with bringing a body from a pathological state back into its normal healthy state or preventing a pathological state (see decision T 774/89, point 2.3.4 of the Reasons).

As pointed out in decision T 329/94 (see Headnote) when a method step has to be assessed with regard to the exclusion of subject-matter from patenting under Article 53(c) EPC the most important point is the purpose and inevitable effect of the step at issue.

3.4 In the present case the method is aimed at cooling animals subjected to heat (patent specification, paragraph [0008]). It is understood that this means heat caused by common and natural circumstances (typically weather conditions) so it is also understood that such temperature ranges, even if being defined as "heat" in the patent, will in most cases not cause any particular harm to the animals. Further, the animals to be cooled by the claimed method are animals such as

cows; such animals are able to regulate their body temperature in response to the ambient temperature. When temperature raises, an animal such as a cow may feel "hot". However, this by itself does not mean that the animal is in a pathological state and therefore a moderate cooling of this animal does not result in preventing a pathological state either, since such an animal is still able to regulate its body temperature naturally within certain limits. As the appellant has pointed out, the maximal temperature to which an animal can be exposed in its cowshed is fixed by various regulations in many states. But even apart from that, the skilled person would know that unbearable temperatures should never be allowed. Consequently, cooling this animal does not cure, alleviate, remove or lessen the symptoms of any disorder or malfunction of the animal's body, nor does cooling prevent or reduce the possibility of contracting any disorder or malfunction, since no such disorder or malfunction would normally occur if the animal would not be cooled. As stated in decision T 774/89 (*supra*) a therapeutic treatment starts from (an existing or likely imminent) pathological state, whereas a non-therapeutic treatment starts from (and of course ends in) a normal, healthy state. The Board finds that there is ample room for carrying out the invention on cows that are neither in a pathological state nor are likely to develop one.

3.5 In other words, in the present case the claimed method (since non-therapeutic) must be construed as being directed at a treatment of animals which are in a normal, healthy state, even if feeling hot. Accordingly, the claimed method is not a method for treatment of the animal body by therapy but a method for providing a

pleasant sensation to a healthy animal so that it enjoys going to the milking stall in order to experience this pleasant feeling again.

3.6 The Respondent argued that discomfort is a sign of a pathological state irrespective of the origin of discomfort and that therefore its relief is always to be considered as a therapy. This cannot be accepted either. For example, an animal can feel discomfort because it is hungry. If the Respondent were right in stating that providing relief is to be considered as a therapy, then feeding this animal would be a therapy too. This approach would thus encompass even the most natural and common everyday activities as therapeutic methods. The absurdity of this interpretation is evident. Accordingly the Board finds that providing relief from discomfort is not necessarily a therapy.

4. *Objection under Article 100 b) EPC*

As a preliminary remark, the Board notes that this ground of opposition was not decided on in the decision under appeal. In spite of that, the Board finds it expedient to treat this issue, irrespective of the remittal for novelty and inventive step (see point 4 below). In the present case this appears sensible, given that the argumentation of the Respondent with respect to Article 53(c) EPC was in close relationship with its arguments on Article 100(b) EPC.

4.1 The Respondent argued that it is not clear why a non-therapeutic method of cooling of animals (i.e. which does not provide any relief) should entice these animals to go to a milking stall spontaneously.

As already explained, the aim of the claimed method is to provide an animal (even if the animal is not ill) a pleasant feeling.
Accordingly, the Board finds it plausible that a healthy animal can be enticed to go to the milking stall in expectation of a pleasant sensation, and that this pleasant sensation may be provided, depending on the circumstances, by a cooling liquid applied to the skin.

4.2 The Respondent further argued that the patent specification does not indicate any temperature range, so that it would amount to an undue burden for the skilled person to find out the adequate temperature for carrying out the claimed method. However, it is clear for the skilled person that the animal should not be cooled to a degree which would render the treatment unpleasant. Thus, the temperature range within which cooling can be carried out is narrow.

Accordingly, it is not an undue burden for the skilled person to determine by trial and error the adequate temperature within a narrow range. The Board adds that within the framework of a cowshed with a milking stall, in the absence of any further pointer in the patent, the skilled person would simply use tap water, or at least start to experiment with tap water, which typically has a temperature of 10-15 °C.

4.3 It has also been argued that because the claimed method is "non-therapeutic" which means that it solely concerns healthy animals, Article 100(b) EPC (Art. 83 EPC) is only fulfilled if the skilled person is able to distinguish the therapeutic application of the cooling

method from the non-therapeutic one, and information to this effect is not given in the patent (see point V above).
Formulated differently, the skilled person is not given any teaching to carry out the method in a manner that would safely keep him within (or out of) the non-therapeutic application, i.e. within the scope of the claims. This means, according to the Respondent, that the skilled person can not carry out the invention as required by Article 100(b) EPC.

4.4 The Board notes that it would not be very equitable towards patentees to allow a non-disclosed disclaimer on the one hand and then to require a specific disclosure, i.e. technical teaching how the invention should be carried out right up to, but not entering the scope of the disclaimed subject-matter. This approach would in practice only allow disclosed disclaimers.
In fact, this issue is irrelevant for compliance with Article 100(b) EPC. This article mirrors Article 83 EPC, which is only concerned with the question whether the teaching is sufficient to carry out the invention (over its whole scope **at least**, but unproblematic if beyond). However, Article 100(b) is not concerned with the question whether the **exact limits** of the scope of protection ought to be or can be determined from a **legal** point of view. The first question is directed at the skilled person, the second at the patent lawyer. At most, this latter may be a question of clarity of the claims (Article 84 EPC).

That said, the Board holds that the skilled person can be expected to distinguish between healthy and ill animals. Further, a diligent farmer is supposed to be

cautious when treating ill animals, so it is likely that he would apply any unusual method on ill animals only very carefully, probably only after having consulted a veterinarian. The patent itself teaches that the application of the method should be made dependent on the health condition of the animal (see claims 3-5 as filed). This by itself should be sufficient for the skilled person to keep the therapeutic and non-therapeutic applications apart. Concerning the technical realisation of the cooling, this can be done irrespectively of whether the animal is in a normal state or not. In other words, although the method is not intended for ill animals, there is no technical hindrance which would preclude from carrying it out if the animal were ill.

4.5 The grounds of opposition only raised the Article 100(b) objections against the claims 3 and 4, dealing with the joint application of the atomised fine spray and the rubbing of the liquid into the skin of the animal (see point 4.3 of the grounds of opposition). Though this issue was not elaborated further in the appeal proceedings, for the sake of completeness the Board holds that these measures are relatively simple and straightforward, so that the skilled person would be able to combine them. The opponent himself cites documents where these measures are taught (D5, D6), though not in combination.

5. *Remittal*

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 substantive issues, especially regarding novelty (Article 54 EPC) and inventive step (Article 56 EPC) undecided.

In the present case the Respondent requested that the case be remitted to the department of first instance for examining novelty and inventive step and the Appellant agreed thereto.

Accordingly, the Board considers it appropriate to remit the case to the department of first instance for consideration of the undecided issues.

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