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D E C I S I O N
of 4 May 2006

Case Number: T 0727/04 - 3.3.02

Application Number: 97905324.6

Publication Number: 0923319

IPC: A24B 15/16

Language of the proceedings: EN

Title of invention:

Smokable filler material for smoking articles

Applicant:

British American Tobacco (Investments) Limited

Opponent:

-

Headword:

Smokable filler material/BRITISH AMERICAN TOBACCO

Relevant legal provisions:

EPC Art. 84

Keyword:

"Clarity (no) - subject-matter for which protection is sought not clearly and unambiguously defined - multifunctional ingredient in composition characterised by %-ranges"

Decisions cited:

G 0002/88, T 0337/95, T 0586/97

Catchword:

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Case Number: T 0727/04 - 3.3.02

D E C I S I O N
of the Technical Board of Appeal 3.3.02
of 4 May 2006

Appellant: British American Tobacco (Investments) Limited
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Representative: Williams, Aylsa
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 31 October 2003
refusing European application No. 97905324.6
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: U. Oswald
Members: H. Kellner
J. Willems

Summary of Facts and Submissions

- I. European patent application No. 97 905 324.6 based on PCT/GB97/00589 as published (WO 97/32492) was refused by a decision of the examining division on the basis of Article 97(1) EPC because the subject-matter of the requested set of claims extended beyond the application as filed.

The wording of claim 1 of the main request before the examining division was:

"A smoking article smokable filler material comprising a non-tobacco fuel material comprising one or more casing materials, a substantially non-combustible inorganic filler, aerosol generating source, a binder, optionally carbon and optionally an expansion medium, the smokable filler material comprising 10% to 70% casing material, 10% to 30% aerosol generating source, 30% to 80% inorganic filler material, 5% to 25% binder, 0 to 30% expansion medium and 0 to 20% carbon, all by dry weight of the smokable filler material, with the proviso that all the components add up to 100."

- II. The examining division considered in its written decision that the new sub-range of claim 1 "10% to 30% aerosol generating source" constituted a generalisation of features disclosed in a specific context and led to added subject-matter in the sense of Article 123(2) EPC.

In order to support its conclusions, it stated that glycerol and propylene glycol could act both as casing material and as an aerosol generating source.

Moreover, since oral proceedings had not been held in advance of the decision because of the lack of such a request, the examining division added an obiter dictum:

Under the heading "present claim 1, even if accepted, would not comply with the requirements of Articles 84 and 54 EPC" it pointed out that, since the casing material and aerosol generating source could be the same material (eg. glycerol), the claim was ambiguous since it defined different ranges for components which could be similar. The scope of claim would hence also embrace a composition containing 10% glycerol (as casing and aerosol generating source), in addition to the other compulsory components.

III. The appellant lodged an appeal against the decision of the examining division and filed grounds of appeal together with three sets of claims as main and auxiliary requests.

IV. With letter of 4 April 2006, nine sets of claims were submitted, replacing the sets of claims of all previously filed requests.

The appellant held that in its view all these sets of claims overcame "all of the objections raised in the Grounds for Revocation dated 31 October 2003", ie in the decision under appeal.

V. Claim 1 of the sets of claims of the main request, and the first and second auxiliary request reads as follows:

"A smoking article smokable filler material comprising a non-tobacco fuel material comprising one or more casing materials, a substantially non-combustible inorganic filler, aerosol generating source, a binder, optionally carbon and optionally an expansion medium, the smokable filler material comprising 10% to 50% casing material, 2% to 30% aerosol generating source, 30% to 80% inorganic filler material wherein said inorganic filler material is chalk, perlite, vermiculite, diatomaceous earth, colloidal silica, magnesium oxide or magnesium sulphate, 5% to 25% binder, 0 to 30% expansion medium and 0 to 20% carbon all by weight of the smokable filler material."

The only difference in claim 1 of the third, fourth and fifth auxiliary request with respect to claim 1 of the main request is the exclusion of magnesium oxide and magnesium sulphate from the examples for inorganic filler material.

In each of claims 1 of the sixth, seventh and eighth auxiliary request the inorganic filler material is restricted to chalk.

The wording of claim 1 of the ninth auxiliary request is:

"A smoking article smokable filler material comprising a non-tobacco fuel material comprising 10% to 50% casing materials, 5% to 80% substantially non-combustible inorganic filler, 2% to 30% aerosol

generating source, and 5% to 25% binder, all by dry weight of smokable filler material said casing materials being at least licorice and/or cocoa casing materials."

VI. Oral proceedings took place on 4 May 2006 in the presence of the representatives of the appellant.

VII. The arguments of the appellant may be summarised as follows:

It was totally clear to the person skilled in the art which substances were to be used as casing materials, inorganic filler, an aerosol generating source and binder.

The skilled person knew these substances from his common general knowledge and he also knew to which of these groups of substances as mentioned in the claims they belonged.

Therefore, with respect to the claimed teaching it was clear in which percentage each of the substances was to be applied.

In connection with the claimed %-ranges for the groups of substances, the appellant presented several examples in which it was also clear from the teaching of the application whether for instance a certain amount of glycerol was present in the smokable filler material as an aerosol generating source or as casing material.

Moreover, casing materials and an aerosol generating source were usually applied in two steps of the process

to produce a smokable filler material and therefore they could be distinguished at least by inspection of the process.

Additionally, each of the terms "casing materials", "inorganic filler", "aerosol generating source" and "binder" indicated a function and from its function in the smokable filler material it was also clear to which of the %-ranges for the groups of substances each of them belonged.

This held particularly with respect to the substances to be used as a casing material or as an aerosol generating source.

- VIII. During the oral proceedings, the appellant sought to introduce two new sets of claims as a new main request and as first auxiliary request. They were not admitted into the proceedings.
- IX. The representative of the appellant (applicant) requested that the decision under appeal be set aside and that a patent be granted on the basis of the sets of claims filed as main or, alternatively, first to ninth auxiliary request (filed with letter of 4 April 2006) or, alternatively that the case be remitted to the first instance for further prosecution on the basis of the sets of claims of the main request, alternatively the auxiliary requests.

Reasons for the Decision

1. The appeal is admissible.

2. The two sets of claims which the appellant sought to introduce during the proceedings were late-filed.

Neither of them provided an answer to newly-raised arguments and they were not *prima facie* allowable because of various problems with regard to clarity and original disclosure. These problems in principle did not differ from the problems set out in the decision of the examining division and from the problems already discussed in relation to the requests to be substituted by the new requests.

Additionally, the claims were amended in a way that required a highly complex further assessment.

3. As far as the provisions of Article 84 EPC are concerned, the following is noted:

- 3.1 Article 84 EPC requires *inter alia* that the claims be clear and define the subject-matter for which protection is sought. This serves the purpose of ensuring that the public is not left in any doubt as to which subject-matter is covered by a particular claim and which is not. From this principle of legal certainty, it follows, in the board's judgement, that a claim is not clear within the meaning of Article 84 EPC if it does not unambiguously allow this distinction to be made (see decisions G 2/88, OJ EPO 1990, 93, point 2.5 of the reasons; T 337/95, OJ EPO 1996, 628, points 2.2 to 2.5 of the reasons). A claim containing unclear technical features causes doubts as to the subject-matter covered by that claim, all the more so if those features are essential to the invention. Thus,

for the reason of lack of legal certainty, such a claim is not clear within the meaning of Article 84 EPC (see also decision T 586/97-3.3.01, not published in OJ EPO, in catchword 1 and point 4.1 of the reasons).

- 3.2 In the present case, claim 1 in all the requests seeks protection for a smoking article smokable filler material as a product *per se*.

The smokable filler material is characterised by its composition and therefore each of these claims 1 contains %-ranges for the ingredients selected from at least four groups of substances:

- casing materials,
- inorganic fillers,
- aerosol generating sources and
- binders.

The %-ranges are essential technical features in the corresponding claims, since they characterise the limits within which the sums of percentages of different ingredients (substances) selected from any of the groups must remain.

In order to establish beyond any doubt the subject-matter covered by such a claim, the groups and the %-ranges for them in the product as claimed must be defined unequivocally.

- 3.3 The groups from which the ingredients of a smokable filler material are to be selected are characterised in terms of the functions that any ingredient should perform in the smokable filler material and not in structural terms of chemical substances.

3.3.1 In the present case, the skilled person knows the functionality behind these groups and knows which substances are usually present for the desired functions.

On the other hand, he also knows that some of these substances are used in a multifunctionality covering more than one of the groups.

Therefore, and since the skilled person has to take into account that the applicant may use its own definitions and may create its "own dictionary" that may in some cases even deviate from the common general knowledge, the skilled person has to look at the description to see what substances are meant or preferred with respect to the functionally defined groups in the context of the application.

As examples of the casing material, propylene glycol and glycerol *inter alia* are mentioned in the description of the application as filed (see WO 97/32492, page 4, paragraph 5 and 6, in particular lines 3 to 5 of paragraph 5 and line 5 of paragraph 6).

Information is given on inorganic filler material on page 6 of that publication in the first paragraph and on binder material in the second paragraph on the same page and in the first paragraph on the next page (page 7 of WO 97/32492).

The preferred material for the aerosol generating source is defined in the last paragraph of page 7 and in the first paragraph on page 8; propylene glycol and

glycerol *inter alia* are mentioned again (see lines 2 and 4 of the last paragraph on page 7).

The same information about propylene glycol and glycerol belonging to both the casing material and aerosol generating source groups is to be derived from each of the claims 3 and each of the claims 8 of the main request and the first to eighth auxiliary requests.

These references in the description and claims of the application in suit constitute clear confirmation for the skilled person with his common general knowledge that propylene glycol and glycerol belong to both the casing material and aerosol generating source groups.

Accordingly, it is necessary in particular to examine these two groups with respect to the clarity of the related %-ranges.

- 3.3.2 It is not possible in the present case to establish whether propylene glycol or glycerol in the smokable filler material as claimed is present as casing material or as an aerosol generating source.

Particularly since in examples 1 and 2, covering samples 1 to 22 of 26 in the whole application, all the solid and liquid ingredients are mixed in one step (see page 13 of WO 97/32492, lines 1 to 4 of the first paragraph under the heading "Example 1" and page 15, lines 1 to 7), there is no reasonable way of seeing a difference between the amounts of propylene glycol or glycerol classified as belonging to one or other of the possible groups of substances.

- 3.3.3 If, under these circumstances, a smoking article smokable filler material
- contains casing material in an amount at the upper limit claimed for the casing material (50%) and
 - the casing material already contains glycerol
 - and now a certain amount of additional glycerol is added,

there are two arbitrary ways of classifying this additional amount of glycerol:

- as an aerosol generating source or
- as further casing material.

Depending on the outcome of that choice, the smokable filler material resulting from the addition of glycerol is or is not contained in the subject-matter for which protection is sought.

If the additional glycerol is classified as an aerosol generating source and its percentage remains beneath the upper limit of the %-range claimed for aerosol generating source materials, the smokable filler material resulting from the addition must be regarded as subject-matter for which protection is sought.

If, however, the additional glycerol is classified as casing material, the claimed range of casing material is exceeded and the resultant smokable filler material constitutes subject-matter which is different from that for which protection is sought.

Thus, two totally different conclusions can be reached in answering the question whether the resulting smokable filler material is subject-matter for which protection is sought or not, despite the material

- having the identical composition. These two conclusions, one being the complete opposite of the other, are simply the result of the fact that some of the ingredients of the smokable filler material can be classified arbitrarily.
- 3.3.4 The same effect is to be observed when the amount of ingredients of the different groups is changed slightly compared with the example mentioned above; for instance, it is not at all necessary to start with casing material in an amount exactly equal to the upper limit as claimed. This special case has only been taken above for convenience and ease of explanation of the facts and effects.
- 3.3.5 The question of propylene glycol and glycerol belonging to both the casing material and aerosol generating source groups applies to claim 1 in all the requests.
- 3.4 To summarise, for the skilled person there is no unequivocal definition in the application as filed, of the %-ranges for casing material substances and aerosol generating source substances in the smoking article smokable filler material for which protection is sought. Consequently, this feature leaves the actual subject-matter covered by the claim in doubt. Therefore, in the board's judgement, claim 1 according to the main request and all the auxiliary requests fails to meet the requirement of clarity imposed by Article 84 EPC.
4. The appellant has argued that the meaning of the terms "casing materials", "inorganic filler", "aerosol generating source" and "binder" and their %-ranges were clear to the person skilled in the art in the present

case, since each of these groups of substances in its percentage as claimed had a function and each of the substances was there to satisfy that function. For example, that part of glycerol being present in an amount higher than 50% clearly had to be an aerosol generating source, since casing material itself was limited to 50%. On the other hand, the skilled person knew for what purpose or function a substance was included in the smokable filler material.

However, the train of thought of the individual determining that function is untraceable and does not allow the skilled person, on the objective basis of common general knowledge, to establish unambiguously whether to qualify or disqualify propylene glycol or glycerol as belonging to casing material or an aerosol generating source, as long as it is not present in excessive amounts (see point 3.3.2 of this decision). As a consequence of this ambiguity, certain substances comprised in the smokable filler material composition are open to be labelled arbitrarily as "casing material" or "aerosol generating source", depending exclusively on the label the user wishes to apply. Since the technical features of %-ranges for the casing material and aerosol generating source in the smoking article smokable filler material remain unclear for the reasons given above and prevent the skilled person from identifying their exact meaning, the public is left in doubt as to which smokable filler materials are covered by claim 1 and which are not. This is at variance with the principle of legal certainty. Thus, the appellant's arguments do not convince the board.

5. Since a decision can only be taken on a request as a whole, none of the other claims in the requests needs to be examined. In these circumstances, the appeal relating to the appellant's main request and nine auxiliary requests must be dismissed for lack of clarity and thereby failing to meet the requirements of Article 84 EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

A. Townend

U. Oswald