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**Datasheet for the decision
of 5 April 2011**

Case Number: T 0005/10 - 3.2.04

Application Number: 06120790.8

Publication Number: 1790240

IPC: A24B 1/00

Language of the proceedings: EN

Title of invention:

Tobacco slab

Applicant:

Philip Morris Products S.A.

Headword:

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Relevant legal provisions:

EPC Art. 56

Relevant legal provisions (EPC 1973):

-

Keyword:

"New request filed at the oral proceedings - admissibility
(no) "

"Main request - auxiliary requests 1 and 2 - inventive step
(no) "

Decisions cited:

-

Catchword:

-



Case Number: T 0005/10 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 5 April 2011

Appellant: Philip Morris Products S.A.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 10 July 2009
refusing European application No. 06120790.8
pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: C. Scheibling
Members: A. de Vries
C. Heath

Summary of Facts and Submissions

I. This appeal is against the decision of the Examining Division dated 10 July 2009 to refuse the patent application. The Examining Division considered that claim 1 as amended did not comply with the requirements of Article 84 and Rule 137(5) EPC and that the previous set of claims lacked novelty with respect to D4. The Appellant's notice of appeal was received on 18 September 2009 and the appeal fee was paid simultaneously. The statement setting out the grounds of appeal was received on 19 November 2009.

II. The following documents played a role in the present proceedings:

D4: EP-A-0 647 411

D7: US-A-1 365 969

III. Oral proceedings took place on 5 April 2011 before the Board of Appeal.

The Appellant (applicant) requested that the decision under appeal be set aside, that a patent be granted based on the main request filed with letter dated 4 March 2011 or one of the auxiliary requests 1 and 2, filed during the oral proceedings.

He mainly argued as follows:

The new requests which were filed at the beginning of the oral proceedings result from a discussion which took place in preparation of these oral proceedings. The amendments undertaken are easy to understand and do

not delay the proceedings. These requests should therefore be admissible.

D4 is not an enabling disclosure and can therefore not lead a skilled person to the claimed invention.

Moreover, in D4 separations are provided in the tobacco slab and also the side surfaces of the tobacco slab are covered by a layer of smokable material. There is no hint in D4 which could lead the skilled person to omit these features from the tobacco slab disclosed in this citation.

IV. Claims 1, 5, 6 and 9 according to the main request read as follows:

"1. A multi-layer structure (20) comprising a continuous tobacco slab (10) made of shredded tobacco and in addition at least one layer, preferably one or two layers, of a smokable material other than shredded tobacco which multi-layer structure is obtainable by a process comprising the steps of

- filling a pre-defined amount of shredded tobacco sufficient to make at least two cigarettes into a mold,
- evenly distributing the shredded tobacco within the mold,
- adding at least one layer of smokable material other than shredded tobacco into the mold before and/or after filling the pre-defined amount of shredded tobacco into the mold and
- evenly compressing the shredded tobacco and the at least one additional layer by exertion of a pre-defined pressure,

wherein the continuous tobacco slab lacks any means or indications of pre-positioning or separation."

"5. A process for making a tobacco slab (10) made of shredded tobacco characterized in that it is continuous, has a substantially uniform composition and a substantially uniform distribution of the shredded tobacco and lacks any means or indications of pre-positioning or separation or a multi-layer structure (20) comprising the tobacco slab (10) and in addition at least one layer, preferably one or two layers, of a smokable material other than shredded tobacco, said process comprising the steps of

- filling a pre-defined amount of shredded tobacco sufficient to make at least two cigarettes into a mold,
- evenly distributing the shredded tobacco within the mold,
- optionally adding at least one layer of smokable material other than shredded tobacco into the mold before and/or after filling a pre-defined amount of shredded tobacco into the mold,
- evenly compressing the shredded tobacco and optionally the at least one additional layer by exertion of a pre-defined pressure, and
- removing the slab (10) or the multi-layer structure (20) from the mold, and optionally
- transferring the slab (10) or the multi-layer structure (20) into a package."

"6. A package which comprises an inner sleeve enclosing a continuous tobacco slab (10) which lacks any means or indications of pre-positioning or separation and is made of shredded tobacco obtainable by a process comprising the steps of

- filling a pre-defined amount of shredded tobacco sufficient to make at least two cigarettes into a mold,

- evenly distributing the shredded tobacco within the mold,
- evenly compressing the shredded tobacco by exertion of a pre-defined pressure or the multi-layer structure (20) according to any of claims 1 to 4 and an outer sleeve enclosing the inner sleeve."

"9. Use of the multi-layer structure (20) according to any of claims 1 to 4 in a cigarette making device for the preparation of make your own cigarettes."

Claim 1 of auxiliary request 1 comprises the features of claim 5 of the main request and adds that the shredded tobacco "has an average density of between 150 mg/cm³ and 250 mg/cm³".

Claim 2 of auxiliary request 1 is as claim 6 of the main request, but deletes its penultimate feature and adds that it encloses "a multi-layer structure (20) comprising the tobacco slab (10) made of shredded tobacco and in addition at least one layer, preferably one or two layers, of a smokable material other than shredded tobacco, which multi-layer structure is obtainable by a process of claim 1" and "wherein the inner sleeve covers four outer surfaces of the tobacco slab (10) or of the multi-layer structure (20) and wherein the outer sleeve covers the two outer surfaces of the tobacco slab (10) or of the multi-layer structure (20) which are not covered by the inner sleeve" and that the shredded tobacco "has an average density of between 150 mg/cm³ and 250 mg/cm³".

The sole claim of the second auxiliary request is as claim 6 of the main request but replaces its penultimate feature with the following wording "a multi-layer structure (20) comprising a continuous tobacco slab (10) made of shredded tobacco which has a substantially uniform composition and a substantially uniform distribution of shredded tobacco and lacks any means or indications of pre-positioning or separation and in addition at least one layer, preferably one or two layers, of a smokable material other than shredded tobacco which multi-layer structure is obtainable by

- filling a pre-defined amount of shredded tobacco sufficient to make at least two cigarettes into a mold,
- evenly distributing the shredded tobacco within the mold,
- adding at least one layer of smokable material other than shredded tobacco into the mold before and/or after filling the pre-defined amount of shredded tobacco into the mold,
- evenly compressing the shredded tobacco and the at least one additional layer by exertion of a pre-defined pressure, and
- removing the slab (10) or the multi-layer structure (20) from the mold"

and adds "wherein the inner sleeve covers four outer surfaces of the tobacco slab (10) or of the multi-layer structure (20) and wherein the outer sleeve covers the two outer surfaces of the tobacco slab (10) or of the multi-layer structure (20) which are not covered by the inner sleeve".

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments to the party's case:*
 - 2.1 At the beginning of the oral proceedings the Appellant filed new requests in which the independent claims have been modified to specify that the continuous tobacco slab "does not include any outer or inner binding agent".
 - 2.2 Since these new requests were filed after filing of the grounds of appeal, they constitute amendments to the case in the sense of Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA). Under that article the Board is afforded discretion in admitting and considering such amendments. The article further stipulates that this discretion "shall be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy".
 - 2.3 An approach frequently adopted by the Boards when exercising their discretion in admitting amendments filed in the course of oral proceedings can be summarized as follows: unless good reasons exist for filing amendments so far into the procedure - this may be the case when amendments are occasioned by developments during the proceedings -, they are only admitted at such a late stage if they are clearly or obviously allowable.

2.4 This means that it must be immediately apparent to the Board, with little or no investigative effort on its part, that amendments successfully address the issues raised without giving rise to new ones.

Thus the first question is therefore why have these requests been filed only at this late stage. The Appellant indicated that when discussing the case the day before the oral proceedings with the Applicant, it became apparent that such modifications might be necessary.

However, the Board holds that since no change in the facts or objections raised so far has occurred, there was no manifest need to submit new requests, so that the amendments proposed find no justification in developments during the proceedings itself.

Furthermore, the Board cannot see prima facie how the amended claims address the objections raised so far, especially since D4 which is considered to be the closest prior art, discloses in one alternative a tobacco slab that does not include any outer or inner binding agent (see D4, column 4, lines 37 to 41; claim 5) so that the proposed amended does not render the claims clearly allowable.

The Board thus concludes that prima facie the inventive step issue has not been successfully addressed in the amended versions of the independent claims.

2.5 Therefore, the Board uses its discretion under Article 13(1) RPBA not to admit these late filed requests.

2.6 In order to address concerns of the Board in respect of D7 for the assessment of inventive step, the representative filed new auxiliary requests 1 and 2. These were admitted by the Board as they constitute a response to the Board's concerns.

3. *Main request*

3.1 D4 discloses a structure comprising a tobacco slab sufficient to make at least two cigarettes (column 7, lines 41 to 45 and 52 to 53) which is made of shredded tobacco (column 3, lines 54 to 58) and which is pressed (column 10, lines 33 to 35).

Additionally there is provided a layer of a smokable material (column 5, lines 46 to 51). It is implicit that this material is not made of shredded tobacco because it is intended to provide support to the slab. Furthermore, it is implicit that the shredded tobacco must be evenly distributed and compressed within the slab, because taste and smoking behaviour shall be consistent (column 10, lines 29 to 31).

3.2 In agreement with the Appellant, the Board considers that the tobacco slab of claim 1 differs from that of D4 in that:

- the side surfaces of the tobacco slab remain uncovered (due to the specific production process),
- the tobacco slab lacks any means or indications of pre-portioning or separation.

The Appellant also submitted that the tobacco slab of D4 is not continuous, which is merely a different way of expressing that the tobacco slab of this citation

comprises means or indications of pre-portioning or separation.

- 3.3 The Appellant contended that the technical problem the invention seeks to solve with respect to D4 as closest prior art is to provide a tobacco slab which allows the preparation of a cigarette having the same properties as a commercial one.

However, the distinguishing features do not contribute to solve the stated problem, which in addition is already solved by D4 (see column 4, lines 37 to 41; column 10, lines 25 to 29).

Consequently, the objective problem to be solved by the invention might rather be seen in providing an alternative tobacco slab.

However, the Appellant failed to convince the Board that omitting the pre-portioning or separations and leaving the side surfaces of the tobacco slab uncovered provides any technical effect.

The Appellant contended that the partial separations which are provided into the tobacco slab of D4 by the knives 23 (Figures 9 and 10) would have a mechanical action on the tobacco slab, which would result in an increased density of tobacco at the borders of the cut and that the tobacco slab according to the invention would not suffer this drawback.

However, in the application under examination too, the user is taught to use the knife of the portioning and separating means to separate a portion of tobacco from the slab (page 12, lines 23 to 27). Thus, no distinguishing technical effect with respect to density

can result from the absence of any pre-portioning or separation means.

No specific effect has been invoked with respect to having the side walls of the tobacco slab uncovered either.

Since the features which distinguish the claimed tobacco slab from that of D4 do not provide any distinguishing technical effect, they cannot provide inventiveness to the claimed product.

The Appellant also submitted that the D4 does not provide an enabling disclosure, because it would not be possible to provide a tobacco slab according to D4 with pre-portioning cuts, if it does not include any binding agent.

There is however no such limitation in D4. On the contrary, in column 4, lines 37 to 41, it is indicated that the tobacco is pressed sufficiently to guarantee that its structure remains stable even if a portion of tobacco is removed from the tobacco slab.

Therefore, the assumption of the Appellant that no pre-portioning would be possible without binding agent is purely speculative.

Consequently, the subject-matter of claim 1 does not involve an inventive step and the main request must fail.

4. *Auxiliary requests 1 and 2*

4.1 According to these requests, the package claim (claim 2 of auxiliary request 1 and claim 1 of auxiliary request

2) comprises either a tobacco slab or a multi-layer structure.

4.2 The tobacco slab disclosed in D4 comprises a sleeve covering four of its outer surfaces as stated in column 5, lines 28 to 31. Furthermore, this sleeve is preferably made of paper coated with an aluminium foil (column 5, lines 36 and 37).

In column 6, lines 7 to 17 it is further indicated that a package in form of a sleeve is provided, which sleeve should be stiff enough to retain its shape, preferably made of cardboard.

In column 6, lines 41 to 45 it is then stated that the package according to claims 9, 10 respectively 11 and/or claims 14 to 16 can be provided with a further package. These passages thus disclose the possibility of providing a further package to a tobacco slab provided with a package according to one of claims 14 to 16 and a package according to one of claims 9 to 11.

The same type of package is disclosed in the claims of D4. Claim 14 refers to a package made of a sleeve for a tobacco slab according to one of claims 1 to 12.

However, the tobacco slab according to claim 11 already comprises a sleeve to preserve the integrity of the tobacco slab which in itself is not self-supporting. The sleeve of claim 11 is thus a sleeve which is different from that of claim 14 which forms the package.

Claim 17 indicates that a further wrapper may be provided around the package according to one of claims 14 to 16 of a tobacco slab according to one of claims 1 to 13. This confirms that the wrapper disclosed in claim 14 is intended to be wrapped around a tobacco

slab which is provided with a sleeve (inner sleeve) according to claim 11 and a package (outer sleeve) according to claim 14.

Furthermore, according to claims 10 or 11 the inner sleeve covers four outer surfaces of the tobacco slab and according to claims 15 and 16 the outer sleeve covers the two major outer surfaces (top and bottom) and either the minor lateral surfaces (determined by the product width) or the major lateral surfaces (determined by the product length), i.e. the two outer surfaces not covered by the inner sleeve.

The Appellant considered that the expression "die stabartigen Teilmengen jeweils durch eine Stranghülle ... wie mit Aluminium kaschiertem Papier ... zusammengehalten sind" in the passage, column 5, lines 46 to 51 and claim 11 of D4 means that each portion and not the whole tobacco slab is provided with a sleeve.

This point of view cannot be shared. The sole embodiment using a paper coated with an aluminium foil is that of Figure 5, where the whole tobacco slab is enclosed by it. Furthermore, the quoted passage refers to "die stabartigen Teilmengen", i.e. a plurality of portions, thus a slab, whereas the interpretation of the Appellant would have required the singular "jede stabartige Teimenge". Finally, throughout the document sleeves are used to provide integrity to the slab in its entirety and not to individual portions. Therefore the skilled person would construe this passage as meaning that each tobacco slab formed by all portions together is provided with a sleeve.

Accordingly, D4 discloses a package for a tobacco slab with an inner sleeve that covers four outer surfaces of

the tobacco slab and an outer sleeve that covers the two outer surfaces of the tobacco slab which are not covered by the inner sleeve.

4.3 Claim 2 of auxiliary request 1 requires in addition that the shredded tobacco of the tobacco slab has an average density of between 150 mg/cm^3 and 250 mg/cm^3 . This range corresponds to the normal tobacco density range of a commercial cigarette. D4 specifies in column 4, lines 38 to 41 that the tobacco is compressed (i.e. its density is) such that the smoking behaviour is that of a usual commercial cigarette. It follows that D4 implicitly discloses this feature. This point has not been challenged by the Appellant.

4.4 Thus the package according to claim 2 of auxiliary request 1 and claim 1 of auxiliary request 2 differs from that of D4 in that the tobacco slab lacks any means or indications of pre-portioning or separation.

For the reasons already explained with respect to the main request, the tobacco slab according to the invention does not involve an inventive step with respect to the tobacco slab known from D4 and consequently a package comprising a tobacco slab according to the invention cannot involve an inventive step with respect to the package of D4.

4.5 Accordingly, the first and second auxiliary request must fail too.

Order

For these reasons it is decided that:

The appeal is dismissed.

The registrar:

The Chairman:

G. Magouliotis

C. Scheibling