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**Datasheet for the decision  
of 27 September 2016**

**Case Number:** T 0691/15 - 3.2.04

**Application Number:** 01992470.3

**Publication Number:** 1333729

**IPC:** A24D1/02, A24D1/00

**Language of the proceedings:** EN

**Title of invention:**

PROCESS FOR PRODUCING SMOKING ARTICLES WITH REDUCED IGNITION  
PROCLIVITY CHARACTERISTICS AND PRODUCTS MADE ACCORDING TO SAME

**Patent Proprietor:**

Schweitzer-Mauduit International

**Opponents:**

Julius Glatz GmbH  
PAPETERIES DU LEMAN SAS  
Miquel y Costas & Miquel, S.A.  
Delfortgroup AG

**Headword:**

**Relevant legal provisions:**

EPC Art. 123(2)  
RPBA Art. 13(3)

**Keyword:**

Amendments - extension beyond the content of the application  
as filed (yes)

Late-filed auxiliary requests - request clearly allowable (no)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

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Case Number: T 0691/15 - 3.2.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.04**  
**of 27 September 2016**

**Appellant:** Schweitzer-Mauduit International  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 10 February  
2015 revoking European patent No. 1333729  
pursuant to Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman**           A. de Vries  
**Members:**         S. Oechsner de Coninck  
                      T. Bokor

## **Summary of Facts and Submissions**

- I. The appellant (proprietor) lodged an appeal received on 1 April 2015 against the decision of the opposition division dispatched on 10 February 2015 on the revocation of the patent EP 1 333 729, and simultaneously paid the appeal fee. The statement setting out the grounds of appeal was received on 10 June 2015.
  
- II. Oppositions had been filed by four parties and were based on Article 100(a) together with 52(1), 54(1) and 56 EPC; Article 100(b) together with 83 EPC; as well as Article 100(c) together with Art 123(2) EPC. The opposition division came to the conclusion that claim 10 of the patent as granted or as amended according to the auxiliary requests 1 and 2 contravened Art 123(2) EPC. The opposition by opponent 2 was deemed not filed. Opponent 4 had withdrawn its opposition.
  
- III. Oral proceedings were held on 27 September 2016.
  
- IV. The appellant requests that the decision be set aside, and the patent be maintained in amended form on the basis of the Main Request filed with letter of 10 June 2015 (and re-filed with letter dated 15 September 2016) or on the basis of any of the Auxiliary Requests 1 or 2 filed in the oral proceedings before the Board.  
  
The opponents 1 and 3 as respondents both request that the appeal be dismissed.
  
- V. The wording of the independent claims of the main request (and corresponding to the wording of these claims as granted) reads as follows:

1. "A process for producing a paper wrapper (14) having reduced ignition proclivity characteristics when incorporated into a smoking article (10) comprising the following steps:

providing a paper wrapper (14) comprised of a paper web;

applying multiple layers (31, 33, 35) of a film-forming composition to said paper wrapper (14) at particular locations, said multiple layers (31, 33, 35) of said film-forming composition forming treated discrete areas (18) on said wrapper (14), said discrete areas (18) separated by untreated areas (28), said treated discrete areas (18) having a permeability of less than 25 Coresta, said treated areas (18) reducing ignition proclivity by reducing oxygen to a smoldering coal of said smoking article (10) as the coal burns and advances into said treated areas (18),

wherein said treated areas (18) comprise a plurality of discrete circumferential bands (24) disposed longitudinally along said smoking article (10), wherein said bands (24) have a width of greater than 4 mm, characterized in that said paper web has an initial permeability of greater than 60 Coresta, and that the treated areas have a BMI of less than  $8 \text{ cm}^{-1}$ , and that said paper wrapper (14) is dried after application of each of said layers (31,33,35)."

"10. A paper wrapper for use in surrounding a tobacco column (12) of a smoking article (10) comprising:

a paper web; and

treated discrete areas (18) on the paper web comprising a film-forming composition to the paper web, the treated discrete areas (18) being separated by untreated areas (28), the treated discrete areas (18) having a permeability of less than 25 Coresta, the treated areas (18) reducing ignition proclivity of a

smoking article (10) incorporating the paper wrapper (14), wherein the treated discrete areas (18) comprise a plurality of discrete circumferential bands (24), which are disposed longitudinally along said smoking article (10), when said paper is used for incorporation into a smoking article, and wherein the bands (24) have a width of greater than 4 mm, characterized in that the paper web has an initial permeability of greater than 60 Coresta and that the treated areas have a BMI of less than  $8 \text{ cm}^{-1}$ ."

*Auxiliary request 1*

Claim 1 is as claim 10 of the main request but changes the permeability values as follows (changes highlighted by the Board):

"....the treated discrete areas (18) having a permeability of less than 20 Coresta..." and "...the paper web has an initial permeability of greater than 60 Coresta to 110 Coresta..."

*Auxiliary request 2*

Claim 1 is as claim 10 of the main request but for the following change in permeability value. :

"....the treated discrete areas (18) having a permeability of less than 20 Coresta..."

VI. The Appellant's arguments are as follows:

- Claim 1 as granted describes the features resulting from the combination of claims 1, 5, 13, 14 and 15 of the original application as published. The amended ranges or limits are supported by page 7, lines 26-30 of the published application, which does not require any upper limit for the permeability of the paper web. Changing the upper permeability value from 20 Coresta in claim 14 as filed to 25 Coresta, is supported by the

top paragraph of page 5 of the published application and belongs to a general teaching applicable to all embodiments. In particular, the combination of reduced permeability of less than 25 Coresta for the treated areas with a high initial permeability above 60 Coresta for the paper web follows from the general statement on page 13, first paragraph, that the amount of composition generally increases as the paper permeability increases. Finally, a burn mode index BMI without the lower limit of original claim 15 is disclosed on page 11, lines 16-20 of the published application, which applies generally to the whole original teaching.

- As for claim 10 the paper wrapper contains the same values or ranges as in claim 1. The omission of multi-layering derives from the embodiment underlying claim 40, which is without limitation of multi-layering.
- Taking the original disclosure as a whole the skilled person recognises that the various permeability parameters are not specifically linked in specific combinations. Rather, he recognizes in the various ranges separate requirement from which he distills the basic broadest elements defining the broadest teaching of the patent.
- The late filing of the auxiliary requests 1 and 2 is justified by the development of the debate during oral proceedings. They contain clearly allowable subject-matter by returning to the values originally defined in claim 40.

VII. The arguments of opponent 1 and 3 as respondents are as follows:

- The original disclosure does not contain any example or preferred embodiment of the process and paper wrapper. All the dependent claims used as basis for disclosure for the specific combination of parameters



in granted claims 1 and 10 are directly dependent on claim 1. They are therefore not disclosed in combination but instead represent separate, unrelated sources of the original disclosure. That the particular BMI ranges can be combined with particular permeability ranges is not immediately apparent from the original disclosure.

The permeability of less than 25 Coresta in the first line of page 5 is not disclosed in relation with the other parameters, and can therefore not be combined without adding new information.

- For Claim 10 original claim 40 only provides an original disclosure of a combination of parameters but with different values. It is furthermore not possible to use the general description of the invention to modify the specific embodiment of claim 40 as originally filed.

- There is no real justification for the late filing of auxiliary requests 1 and 2, as they could have been filed earlier. Moreover they are not prima facie allowable under Article 123(2) EPC, as in particular new permeability ranges are introduced from the description, which were not present in originally filed claim 40. The provisions of Article 13(3) RPBA for their admission are therefore not satisfied.

- The objection that the appeal is inadmissible because it pursues requests which themselves cannot be admitted, was withdrawn during the oral proceedings.

## **Reasons for the Decision**

1. The appeal meets the requirements of Article 108 and Rule 99(2) EPC 2000, and is therefore admissible.
2. Background of the invention

The present patent is concerned with a process for producing a paper wrapper with reduced ignition proclivity. The general aim of the invention is to provide an improved method of applying a film-forming solution to a paper wrapper for decreasing its permeability without causing non-uniform dimensional changes or affecting the appearance of the wrapper (paragraph [0008] of the patent specification). For this purpose it is foreseen to apply multiple layers of a film-forming composition to the paper wrapper that form discrete areas on the wrapper separated by untreated areas. The treated discrete areas have a permeability within a predetermined range sufficient to reduce ignition proclivity.

The original detailed description, see in particular pages 6 to 13 of the international published application, presents various factors (width and spacing of bands 24, initial permeability of the paper wrapper, resultant permeability of the bands, burn mode index, composition of the material that forms the film) that may play a role in the implementation of the method without however indicating any particular preferred combination of those factors. These factors are also the subject of respective originally filed dependent claims, which depend directly and solely on independent claims.

Nonetheless, when considering the whole content of the application as originally filed the skilled person, who reads it with synthetic propensity and trying to make technical sense of its teaching, will recognise the main aspects of the method and paper wrapper that starts from a web having an initial permeability, with a film-forming composition being applied in discrete treated bands forming areas on the wrapper having reduced permeability and a certain burn mode index to reduce ignition proclivity, the treated bands furthermore extending over a certain width with a predetermined spacing between bands.

3. Main request: added subject matter, Article 123(2) EPC:

The European application underlying the patent was filed as an international application PCT/US01/51221 on 13 November 2001 published as WO 2002037991. The content of the published international application is identical to the content of the application as filed for the purpose of Art 123(2) EPC.

3.1 Claim 1 as granted contains additional and amended features with respect to independent claims 1, 21 or 40 of the originally filed and published application. In particular the following amended or added features are contested for added subject-matter:

- permeability of the treated discrete areas of less than 25 Coresta,
- width of the bands of greater than 4 mm,
- paper web initial permeability of greater than 60 Coresta and
- treated areas have a BMI of less than 8 cm<sup>-1</sup>.

Claim 10 as granted also contains the same limitations concerning these parameters: treated discrete areas

having a permeability of less than 25 Coresta, a band's width of greater than 4 mm, a paper web initial permeability of greater than 60 Coresta and the treated areas have a BMI of less than  $8 \text{ cm}^{-1}$ .

- 3.2 No explicit basis or embodiment combining all four parameters with these specific ranges of values has been identified in the description as published. Indeed the description as published does not appear to disclose a preferred embodiment of the process or of the paper wrapper that combines all four parameters in any range of values. Nor has this been argued by the appellant.
- 3.3 Looking for possible combinations of these parameters in any form in the published application, the skilled person finds in the combination of claims 1, 13 and 14, that are dependent on each other, the specific combination of web permeability of 60 to 90 Coresta with permeability of the treated areas of less than 20 Coresta. In independent claim 40 the same parameter ranges are combined with a Burn Mode Index of less than  $8 \text{ cm}^{-1}$ . However, neither of these potential bases in the original disclosure corresponds to the present claimed combination of treated discrete areas having a permeability of *less than 25* Coresta with, bands of width greater than 4 mm, a paper web initial permeability of greater than 60 Coresta and treated areas having a BMI of less than  $8 \text{ cm}^{-1}$ . Vis-a-vis either basis current claim 1 features a different range of initial permeability (greater than 60 as opposed to original 60 to 90 Coresta), a different range of permeability for the treated areas (less than 25 as opposed to original less than 20 Coresta), to which has been added (vis-a-vis either original basis) the bands' width being greater than 4 mm and (vis-a-vis original

claims 1, 13 and 14) a BMI of the treated areas less than  $8 \text{ cm}^{-1}$ .

3.4 The appellant submits that the subject-matter of the granted claim 1 including these multiple limitations derives from the combination of claims 1, 5, 13, 14 and 15 as originally published, with the additional amendments deriving from the original description as follows. The band width greater than 4 mm in claim 5 is also described on page 3, lines 21 to 22. Leaving the upper limit from claim 14 would also be supported by page 7, lines 26-30 not defining any upper limit and page 8, lines 23 to 26 listing several options for the permeability value. Changing the upper permeability value from 20 in claim 14 as filed to 25 would then be supported by the top paragraph of page 5. Finally a burn mode index BMI without lower limit as in the original claim 15 was also disclosed on page 11, lines 16-20.

3.5 According to established jurisprudence, the content of an application must not be considered to be a reservoir from which features pertaining to separate embodiments of the application could be combined in order to artificially create a particular embodiment. In the absence of any pointer to that particular combination, this combined selection of features does not, for the person skilled in the art, emerge clearly and unambiguously from the content of the application as filed, see Case Law of the Boards of Appeal, 8th edition, 2016 (CLBA hereinafter), II.E.1.4.1.

3.6 In the present case the passages referred to by the appellant in support of the amendments are distinct, disjunct passages of the original published application concerning ostensibly different aspects that may but

need not play a role for the invention and that can be read independently of each other. In some cases they moreover appear in a particular context from which they are then isolated.

Thus, the claimed paper web permeability range appears on page 4, line 15, in the section "summary of the invention" in a paragraph referring to "still another embodiment" contrasting it with previous embodiments or aspects stated on pages 3 and 4 focusing on multiple layer application of the film forming composition, drying between applications, the shape and dimensions of the bands or possible materials for the composition. According to page 4, line 15, "the paper web *can have* a permeability [in the claimed range]" (italics added by the Board). The paragraph bridging pages 4 and 5 in a further (different) statement of the invention highlights the treated discrete areas which *can be* made from multilayered film and can have sufficient permeability range to reduce proclivity. In the immediately following sentence this is illustrated ("For example") by stating that "the areas *can have* by a permeability of less than about 25 Coresta".

The passage on page 11 cited as basis for the claimed BMI range less than  $8 \text{ cm}^{-1}$  appears in the detailed description of embodiments in which various aspects and parameters are again discussed separately. Here again an open formulation is used: the "BMI of the treated areas *can be* generally less than about  $8 \text{ cm}^{-1}$ ".

The above non-committal formulations ("can have", "can be") are typical of many passages of the published application. They convey to the reader the sense that apart from the recurring common theme of applying bands of film-forming composition there is no single specific

teaching that certain conditions must necessarily be met to achieve the desired effect. The various aspects will thus be understood by the reader as facultative features of a broader teaching, each of which can be applied independently. More specifically, they do not direct the reader to any particular combination of the various aspects and parameter ranges detailed. Consequently, insofar as a particular combination is not already expressly stated, any combination of these various facultative, independent aspects results in a new specific teaching of their combined application for which there is no direct and unambiguous disclosure. The Board concludes that this is the case for the specific combination of initial paper web permeability, treated area permeability, band widths and BMI values now claimed in claim 1.

- 3.7 The Appellant submits that because they were not related to each other any of these limitations would therefore apply to all the embodiments. This would in particular be true for the band width that the passage on page 10 lines 7-9 defines to be generally dependent on the permeability but does not relate to any particular value thereof. Likewise with respect to the reduced permeability of less than 25 Coresta for the treated areas, this would belong to a general teaching applying to all embodiments that can therefore be combined with a high permeability above 60 Coresta for the paper web. This would be in particular so as the published application indicates on page 13, first paragraph, that the amount of composition (and thus treated area permeability) generally increases as the paper permeability increases. In the Board's view it is exactly for this reason, that these various aspects are originally presented separately of one another and only separately, that they cannot be combined without going

beyond that original disclosure. This is irrespective of whether these aspects are identified in the original text as general or generally applicable in some way. As long as they are presented as separate and distinct from one another, and not in a specific combination, subsequently defining or claiming that specific combination will add new subject-matter. For this reason the Board is also not convinced that the skilled person would immediately and unequivocally recognize these separate disparate aspects as constituent "basic elements" of a composite basic teaching.

3.8 For the above reasons the Board holds that the claim 1 has been amended to contain subject matter extending beyond the application as filed and therefore do not meet the requirements of Article 123(2) EPC.

3.9 With respect to independent claim 10 to a paper wrapper the appellant refers to the same arguments given for claim 1 as the two claims include the same values or ranges as defined in claim 1. Furthermore an embodiment without limitation of multi-layering would originally be defined in claim 40. The absence of the multiple layers would not mean that the other limitations do not apply.

The Board concurs with the appellant that claim 40 did not require the film composition to be applied in multiple layers. However, the claimed treated area permeability range less than 25 Coresta is originally disclosed only ever in the context of using a multi-layered film, see e.g. the sentence immediately preceding that bridging pages 4 and 5. The two features appear functionally linked, the former being a result of the latter. Therefore the one cannot be presented in isolation from the other without resulting in an



unallowable intermediate generalization (see CLBA, Chapter II.E.1.7). In any case, the above conclusions concerning the combination of the ranges of values for the four parameters also apply to the paper web as defined in the granted claim 10. Finally, insofar claim 40 is meant to serve as basis, the Board adds that apart from the BMI index range none of the claimed ranges now claimed correspond to those of original claim 40. Neither claim 40 nor its dependent claims indeed even mention band width. It follows that claim 10 also extends beyond the content of the application as filed.

3.10 From the above the Board concludes that both claims 1 and 10 contain subject matter extending beyond the application as filed and therefore do not meet the requirements of Article 123(2) EPC.

4. Auxiliary requests 1 and 2 - admission:

4.1 These requests have been filed at the end of the oral proceedings, after the issue of added matter for the main and auxiliary requests 1 to 5 had been debated at length by the parties.

Each of these requests comprises a single independent claim 1 directed at a paper wrapper in which the value of 20 Coresta has been restored. Claim 1 of the auxiliary request 1 furthermore reverts to the upper limit permeability of 110 Coresta.

The appellant explains that the requests were filed as a response to new elements of the debate and argues that the requests are clearly allowable as they address the issues discussed but do not introduce issues which

the other parties or the board cannot be expected to deal with.

4.2 The auxiliary requests 1 and 2 filed at the oral proceedings before the Board represent two further attempts in a long line of attempts (some 20 in all) by the Appellant to address the issue of added subject-matter which had already been raised by the respondents in their various submissions and again highlighted in the Board's communication. Therefore the Board cannot but conclude that the amendments proposed in these final two requests do not find a justification in developments during the proceedings itself.

4.3 The Board examined whether or not these amendments are "clearly allowable", a criterion regularly applied when the admission of late filed requests is at stake. This criterion is to be tested against the issues of added subject-matter as identified in the preliminary observations made by the Board in its communication and then discussed at the oral proceedings.

Since the single claim of these requests retains the two other ranges for BMI and widths of the bands that are contested by the parties and were discussed in the oral proceedings, it is evident that, on the face of it, not all issues have been addressed and that therefore these requests are not clearly allowable in the above sense.

4.4 For these reasons the Board decided to use its discretion under Article 13(3) RPBA not to admit these late filed requests.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



G. Magouliotis

A. de Vries

Decision electronically authenticated