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**Datasheet for the decision  
of 3 December 2018**

**Case Number:** T 1302/15 - 3.2.04

**Application Number:** 10161319.8

**Publication Number:** 2213185

**IPC:** A24D3/04

**Language of the proceedings:** EN

**Title of invention:**

Filtered cigarette incorporating an adsorbent material

**Patent Proprietor:**

R.J. Reynolds Tobacco Company

**Opponent:**

Philip Morris Products S.A.

**Headword:**

**Relevant legal provisions:**

EPC Art. 76(1), 114(2)  
RPBA Art. 13(3)

**Keyword:**

Amendments - intermediate generalisation

**Decisions cited:**

G 0002/10, T 0183/09

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 1302/15 - 3.2.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.04**  
**of 3 December 2018**

**Appellant:** Philip Morris Products S.A.  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
28 April 2015 concerning maintenance of the  
European Patent No. 2213185 in amended form.

**Composition of the Board:**

**Chairman** A. de Vries  
**Members:** J. Wright  
C. Heath

## **Summary of Facts and Submissions**

- I. The appellant-opponent lodged an appeal, received 23 June 2015, against the interlocutory decision of the Opposition Division posted on 28 April 2015 concerning maintenance of the European Patent No. 2213185 in amended form. The appeal fee was paid at the same time. The statement setting out the grounds was received on 7 September 2015.
  
- II. The opposition was filed against the patent as a whole. The opposition division held that the patent as amended met all the requirements of the EPC. The division found, amongst other things, that the subject matter of claim 1 as amended met the requirements of Article 76(1) EPC because there was no extension of subject matter beyond, amongst other filings, the earliest application as filed, namely the grand-parent application, D19: WO2005/032287.
  
- III. Oral proceedings were duly held on 3 December 2018.
  
- IV. The appellant-opponent requests that the decision be set aside and that the patent be revoked.

The respondent-proprietor requests that the decision under appeal be set aside and that the patent be maintained based on claims of a main request, filed during oral proceedings before the Board, or in the alternative based on claims of one of Auxiliary Requests I to III, all filed with letter dated 24 March 2016.

V. Claim 1 of the requests is worded as follows:

Main request: "A cigarette (10) comprising a tobacco rod (12) and a filter element (20) connected to the tobacco rod (12), said filter element (20) having a mouth end section of filter material and an end proximal to the tobacco rod (12) and an end distal from the tobacco rod (12), wherein said filter element (20) comprises:

at least one breakable capsule (54) positioned in the mouth end section of filter material within a compartment (60) distal from the tobacco rod (12), the mouth end section of filter material comprising an annular outer section (56) and an inner portion (58) that includes the compartment (60) therein adapted for receiving the at least one breakable capsule (54), the at least one breakable capsule (54) comprising a gelatin outer shell and an internal payload, the internal payload comprising a compound capable of changing the nature or character of mainstream smoke drawn through the filter element (20) and the internal payload including one or more flavoring agents and a diluting agent; and

a granular adsorbent material (34) contained within a compartment (32), imbedded [sic] or dispersed within a section of fibrous filter material, or incorporated into a paper positioned between the at least one breakable capsule (54) and the tobacco rod (12) such that the breakable capsule (54) is positioned downstream from the adsorbent material (34),

wherein application of tactile pressure to the breakable capsule (54) causes the filter element (20) to deform and causes the breakable capsule (54) to

rupture and release its internal payload into the compartment (60), which allows a smoker to selectively adjust the flavor of the cigarette".

Auxiliary request I: "A cigarette (10) comprising a tobacco rod (12) and a filter element (20) connected to the tobacco rod (12), said filter element (20) having a mouth end section of filter material and an end proximal to the tobacco rod (12) and an end distal from the tobacco rod (12), wherein said filter element (20) comprises:

at least one breakable capsule (54) positioned in the mouth end section of filter material within a compartment (60) distal from the tobacco rod (12), the at least one breakable capsule (54) comprising a gelatin outer shell and an internal anhydrous payload, the internal payload comprising a compound capable of changing the nature or character of mainstream smoke drawn through the filter element (20) and the internal payload including one or more flavoring agents and a diluting agent; and

a granular adsorbent material (34) contained within a compartment (32), imbedded [sic] or dispersed within a section of fibrous filter material, or incorporated into a paper positioned between the at least one breakable capsule (54) and the tobacco rod (12) such that the breakable capsule (54) is positioned downstream from the adsorbent material (34)A wherein application of tactile pressure to the breakable capsule (54) causes the filter element (20) to deform and causes the breakable capsule (54) to rupture and release its internal payload into the compartment (60), which allows a smoker to selectively adjust the flavor of the cigarette".

Auxiliary request II: "A cigarette (10) comprising a tobacco rod (12) and a filter element (20) connected to the tobacco rod (12), said filter element (20) having a mouth end section of filter material and an end proximal to the tobacco rod (12) and an end distal from the tobacco rod (12), wherein said filter element (20) comprises:

at least one breakable capsule (54) positioned in the mouth end section of filter material within a compartment (60) distal from the tobacco rod (12), the at least one breakable capsule (54) being generally spherical in shape and possessing a rigid outer shell constructed of a food grade gelatin and an internal anhydrous payload, the internal payload comprising a compound capable of changing the nature or character of mainstream smoke drawn through the filter element (20) and the internal payload including one or more flavoring agents and a triglyceride diluting agent; and

a granular adsorbent material (34) contained within a compartment (32), imbedded [sic] or dispersed within a section of fibrous filter material, or incorporated into a paper positioned between the at least one breakable capsule (54) and the tobacco rod (12) such that the breakable capsule (54) is positioned downstream from the adsorbent material (34), wherein application of tactile pressure to the breakable capsule (54) causes the filter element (20) to deform and causes the breakable capsule (54) to rupture and release its internal payload into the compartment (60), which allows a smoker to selectively adjust the flavor of the cigarette".

Auxiliary request III: " A cigarette (10) comprising a tobacco rod (12) and a filter element (20) connected to the tobacco rod (12), said filter element (20) having a mouth end section of filter material and an end proximal to the tobacco rod (12) and an end distal from the tobacco rod (12), wherein said filter element (20) comprises:

at least one breakable capsule (54) positioned in the mouth end section of filter material within a compartment (60) distal from the tobacco rod (12), the at least one breakable capsule (54) being generally spherical in shape and possessing a rigid outer shell constructed of a food grade gelatin and an internal anhydrous payload, the internal payload comprising a compound capable of changing the nature or character of mainstream smoke drawn through the filter element (20) and the internal payload including one or more flavoring agents and a triglyceride diluting agent, wherein the walls of the compartment (60) are defined by a compressible and deformable material in the form of plasticized cellulose acetate; and

a granular adsorbent material (34) contained within a compartment (32), imbedded [sic] or dispersed within a section of fibrous filter material, or incorporated into a paper positioned between the at least one breakable capsule (54) and the tobacco rod (12) such that the breakable capsule (54) is positioned downstream from the adsorbent material (34), wherein application of tactile pressure to the breakable capsule (54) causes the filter element (20) to deform and causes the breakable capsule (54) to rupture and release its internal payload into the compartment (60), which allows a smoker to selectively adjust the flavor of the cigarette".



VI. The appellant-opponent argued as follows:  
The main request is late filed and not clearly allowable. Therefore it should not be admitted into the proceedings. The auxiliary requests add subject matter extending beyond the grandparent application D19 because they contain intermediate generalisations of the embodiment of figure 10.

VII. The respondent-proprietor argued as follows:

The main request should be admitted into the proceedings because it addresses the issue of added subject matter considered at the oral proceedings. The auxiliary requests do not add subject matter extending beyond the grandparent application as filed.

### **Reasons for the Decision**

1. The appeal is admissible.

2. Background

The invention relates to filtered cigarettes (see published patent specification, paragraph [0001]). Filter elements may comprise adsorbent for removing certain [harmful] gas phase compounds from cigarette smoke, but this may worsen its taste (see specification, paragraph [0004]). The invention aims to provide a cigarette filter element that removes certain gas phase compounds whilst yielding smoke with a desired taste (see specification, paragraph [0005]).

To this end (cf. claim 1 in all its versions), the filter element carries an adsorbent for removing

certain gas phase constituents from the smoke (see specification, paragraph [0006]) and a breakable capsule containing flavourings, which allows the smoker to adjust the taste of the smoke (see specification, paragraph [0018]).

3. Added subject matter

3.1 The patent is based on a divisional application of parent application EP 07121567.7, published as EP 1905318, which in turn was a divisional application of the grandparent application EP 04789206.2, published as WO20005/032287 (D19), Article 153(3) EPC. Considerable and wide ranging changes were made to the claims from grandparent via the parent application to the present divisional application and subsequently in the procedure leading to grant from the divisional as filed. If the requirements of Article 76(1) EPC are to be met, the subject matter of the claims must be disclosed in the very first filing, the grandparent application D19.

3.2 To better explain the relevant added subject matter issues, the Board will discuss the auxiliary requests first.

3.3 Auxiliary request I.

In deciding the question of allowability of amendments under Article 123(2) EPC, which likewise applies to Article 76(1) EPC, the Board, following well established practice (see Case Law of the Boards of Appeal, 8th edition, 2016 (CLBA), II.E.1.2.1 and the decisions cited therein), must consider whether the amendments in question are directly and unambiguously derivable by the skilled person from the application as

filed, using normal reading skills and, where necessary, taking account of their general knowledge.

This is the "gold standard" according to which amendments are assessed (see **G 2/10**, reasons 4.3). Furthermore (see CLBA, II.E.1.7 and the decisions cited therein), according to established case law, it will normally not be allowable to base an amended claim on the extraction of isolated features from a set of features originally disclosed only in combination, e.g. a specific embodiment in the description. Such an amendment results in an "intermediate generalisation".

An intermediate generalisation is justified only in the absence of any clearly recognisable functional or structural relationship among the features of the specific combination or if the extracted feature is not inextricably linked with those features.

- 3.3.1 Claim 1 is directed to a cigarette. A first claim section describes the geometry of the cigarette with its filter element and connected tobacco rod. In the Board's view, this has a basis in D19 (page 2, last line to page 3, line 2), where it is also implicit that the filter element has two ends, one distal and one proximate to the tobacco rod, and a mouth end section of filter material.
- 3.3.2 A second claim section defines, amongst other things, that the filter has a breakable capsule containing a smoke flavouring agent positioned in the mouth end section within a compartment. A third claim section defines that the filter comprises a granular adsorbent material and defines alternative ways of incorporating the adsorbent, one of which being to contain it within a compartment.

- 3.3.3 In order for the subject matter of claim 1 not to extend beyond the earlier application D19, there must at least be a disclosure in D19 of a cigarette having a breakable capsule containing a flavouring agent positioned in the mouth end section within a compartment in combination with a granular adsorbent material located in a compartment. Moreover, it must be directly and unambiguously clear to the skilled person from that disclosure that these features are not linked in some functional or structural way with other features not in the claim.
- 3.3.4 This specific combination of features is not directly and unambiguously derivable from the claims of D19. Independent claim 5 defines a capsule but does not say that it is in a compartment. The claim defines an adsorbent material, but not that it is contained in a compartment.
- 3.3.5 Claim 39, which refers back only to claim 5, defines that the capsule is located in a compartment having a specific structure (compartment within an central inner portion of filter material that is surrounded by an annular ring of filter material), not a generic compartment as defined in present claim 1.
- 3.3.6 Nor, in conjunction with this specific capsule compartment claim, is there a direct disclosure of containing adsorbent in a compartment. Claims referring back to claim 39 (40 and 41) define further features of the central portion of filter material but not a compartment for the adsorbent. Although claim 36 defines that the adsorbent is located in a [generic] compartment, it also only refers back to claim 5. Therefore none of these claims directly and

unambiguously disclose a cigarette with a breakable capsule located in a compartment in conjunction with adsorbent contained in a compartment.

3.3.7 Therefore, the Board must consider whether there is a direct and unambiguous disclosure for the claim 1 features of a capsule within a generic compartment in conjunction with adsorbent in a compartment in the description and drawings of D19.

3.3.8 D19 (see page 6, lines 14 to 20) summarises features of a generic embodiment having a breakable capsule. However, there it is not said that the capsule is within a compartment as claim 1 requires. It is merely said that the capsule is positioned in the mouth end section of filter material.

In this regard, the Board is not convinced by the respondent-proprietor's argument that the above passage implicitly discloses a compartment because the capsule, being a geometric object that is distinct from the filter material 36 inevitably sits in a compartment, namely the negative space within the filter material occupied by material other than filter material.

This interpretation does not correspond to the normal usage of the word "compartment" to denote "[a] space or chamber partitioned off" (see e.g. Oxford English Dictionary) and which may or may not be used to accommodate something else. As in the patent and its parent this normal usage differentiates from a situation in which something is embedded, see the claim wording itself, page 17, lines 14 to 16, or page 21, lines 23 to 27. Thus the skilled person reads claim 1 to define a chamber or space within the mouth end section of filter material and in which the capsule is

received. Were the capsule to be entirely surrounded by filter material, it would not be in such a chamber/ space. In other words it would not be in a compartment as claimed but rather embedded in the filter material. Therefore, the above general statement (page 6) that the capsule is positioned in the mouth end section of filter material is not an implicit disclosure of the capsule being in a compartment as claimed.

3.3.9 In the Board's opinion, the description of the various ways of incorporating the adsorbent material into the filter element (see page 17, lines 13 to 18) is not a direct and unambiguous disclosure of the adsorbent compartment 32 in the context of present claim 1 as the respondent-proprietor has argued. Firstly, there is no mention in the passage of a capsule, let alone one in a compartment, so the passage itself does not directly and unambiguously disclose the combination of features of present claim 1. Secondly, the passage comes with the qualification that what is described is "as shown in the drawings". Thus, the disclosure is not of a adsorbent compartment more generally applicable than one of the detailed embodiments shown in the drawings, which will now be discussed.

3.3.10 The description of D19's specific embodiments opens by describing the components of a cigarette according to the invention in general terms (see page 8, line 20 to page 16, line 20 and figure 1). These include a filter element 20. It is explained how the filter element 20 is arranged relative to other components (see page 9, lines 3 to 7), and for example its outer dimensions (see page 10, lines 8 to 11) but the interior of the filter element is not described.

The description (page 16, line 21 to page 21, line 23 and figures 2 to 9) then discloses various embodiments, explaining alternative structures of the filter element 20. However, none of these has a breakable capsule, let alone one in a compartment.

3.3.11 Only the last embodiment (page 21, line 23 to page 25, line 5 with figure 10) has a filter with a breakable capsule 54. Moreover (see page 21, lines 23 to 30), the capsule is located in a compartment 60 and the adsorbent 34 is likewise in a compartment 32. However, these features are disclosed in a particular way and together with other features that have not been claimed. Applying the approach outlined above (see section 2.3), it would only be possible to claim the features of a [generic] compartment containing the capsule and a [generic] compartment 32 containing the adsorbent isolated from other non-claimed features of the embodiment in the absence of a structural and functional relationship between them. If this were not the case, the claim would be a non-allowable intermediate generalisation of the embodiment of figure 10.

3.3.12 In the present case, the Board considers that in the particular embodiment of figure 10 there is a functional and structural relationship between the feature of a compartment for the capsule as such (as extracted and incorporated in present claim 1) and its particular arrangement in the filter element 20 of figure 10. Therefore, there is no justification for the [generic] capsule compartment feature of present claim 1.

3.3.13 As shown in figure 10, the walls of the compartment 60 are formed by an inner section of filter material 58.

This inner section is surrounded by an outer annular section of filter material 56. Thus, the compartment 60 cannot extend as far as the inner surface of the plug-wrap 26 (as the adsorbent compartment 32 does) but is bound by the concentric inner and annular outer sections of filter material. As it is in fact defined thereby, the compartment 60 for a capsule in the mouth end section of filter material 36 is structurally inextricable from the the inner and annular outer sections of filter material (which have not been claimed).

For similar reasons, the Board sees a functional relationship between the compartment 60 containing the capsule 54 and the inner and annular outer sections of filter material 58, 56.

In particular (see page 22, line 29 to page 23, line 3), the capsule is ruptured within its compartment by squeezing on the "relevant regions" of the filter element. These regions can but include the inner and annular outer sections of filter material. Thus, both play a functional role in deforming the compartment to rupture the capsule. Once ruptured (see page 22, lines 1 to 3), the capsule's payload disperses into the compartment 60 and the outer annular section 56 of filter material. To reach the outer annular section 56 it must enter the inner section 58 of filter material. Thus the concentric arrangement of these compartment-enveloping sections serves to soak up the payload of the ruptured capsule and so change the flavour/nature/character of smoke drawn through them (cf. page 22, lines 18 to 25 and present claim 1). In this regard, the Board is not convinced by the respondent-proprietor's argument that the skilled person considers the capsule-compartment to be more generally disclosed



than as explained above because the description continues (see page 23, lines 6 to 16) by explaining that the compartment can have a circular and/or conical cross-sectional shape. At most this passage merely defines alternative shapes for the compartment, building on the foregoing description of figure 10. Therefore, the skilled person does not read the passage as disclosing an alternative embodiment in which the capsule-compartment might be arranged in a fundamentally different way than as shown in figure 10. Consequently, this passage does not change how the skilled person perceives the functional and structural interrelationships between the capsule compartment 60 and various other features of figure 10 explained above.

3.3.14 The Board also considers that in the embodiment of figure 10, there is a structural and functional relationship between the adsorbent containing compartment 32, claimed as such, and the inner and annular outer sections of the filter material 58, 56 which have not been claimed. As seen in figure 10, the inner and annular outer sections of the filter material 58, 56 form one wall of the compartment 32, therefore these sections define the structure of the compartment 32. By the same token, since the sections 58, 56 serve to contain the contents of the compartment 32, preventing granules of adsorbent 34 from reaching the downstream capsule compartment 60, the filter material sections 58, 56 inevitably play a functional role in the compartment 32.

Put differently, in the embodiment of figure 10, the skilled person does not see a generic adsorbent compartment as claimed, but a particular compartment 32 having one of its boundary sides formed by and thus

structurally and functionally inextricable from the inner and annular outer filter material sections 58, 56.

3.3.15 Following the approach outlined above, there is no justification for extracting the feature of a compartment for the breakable capsule and including it in the claim without also claiming its enveloping inner and annular outer filter material sections 58, 56. Nor is there a justification for extracting the feature of a compartment containing granular adsorbent without defining that one of its boundaries is made up of the inner and annular outer sections of filter material 58, 56. This is because these features are only disclosed in D19 in a tight functional and structural interrelationship. Therefore, in at least these two respects, the subject matter of present claim 1 represents an unallowable intermediate generalisation of the embodiment of D19 figure 10, so claim 1 adds subject matter that extends beyond the grandparent application, D19.

#### 3.4 Auxiliary requests II and III

Claim 1 of these requests add various features compared to auxiliary request I which further define the capsule itself. However, these features do not resolve any or all of the issues identified above; in particular they fail to define the inner and annular outer filter material 58, 56 surrounding the capsule-compartment 60. Claim 1 of these requests also defines the adsorbent-compartment 32 in the same way as claim 1 of auxiliary request I. Therefore these requests fail for the same reasons as apply to auxiliary request I (see section 3.3 and its sub-sections).

4. Main request

4.1 The main request was filed at the oral proceedings before the Board. The request thus amounts to an amendment to the Appellant's case in the sense of Article 13 of the Rules of Procedure of the Boards of Appeal (RPBA). Under paragraph (1) of that article the Board exercises discretion in admitting such amendments in view of, amongst other things, the complexity of the subject matter, the state of the proceedings and the need for procedural economy. Furthermore, under Article 13(3) RPBA any amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise issues which the Board or the parties cannot reasonably be expected to deal with without an adjournment.

4.2 An approach frequently adopted by the Boards when exercising their discretion in admitting an amendment filed shortly before or during oral proceedings can be summarised as follows: Unless good reasons exist for filing the amendment so far into the proceedings - for example if it is occasioned by developments in the proceedings - it will be admitted only if it does not extend the scope or framework of discussion as determined by the decision under appeal and the statement of the grounds of appeal, and is moreover clearly allowable, see CLBA, IV.E.4.2.1 and the case law cited therein. In accordance with established jurisprudence, amended claims are clearly allowable if the Board can quickly ascertain that they overcome all outstanding issues without raising new ones, see CLBA, IV.E.4.2.2 and the cases cited therein, for example T 183/09, reasons 4.

- 4.3 In the present case, the issue of an intermediate generalisation arising from the feature of the adsorbent being, amongst other options, "contained within a compartment" was raised by the appellant-opponent in their grounds of appeal (page 7, section I.1.2, and page 14, section II.1, first three lines). Therefore, whether the respondent-proprietor considered that the number of issues raised in the appeal grounds made it difficult to decide which request to file and whether the issue was first discussed at length in the oral proceedings before the Board, it is still not a new issue and therefore the amendment is not occasioned by a development in proceedings.
- 4.4 Following the approach outlined above, admittance of the main request is dependent, amongst other factors, on it being clearly allowable. In the Board's view, claim 1 is not clearly allowable.
- 4.5 Claim 1 introduces the features of the mouth end section of filter material comprising an annular outer section and an inner section (inner portion in the words of claim 1) that includes the compartment containing the capsule. However, the feature of the compartment 32 (containing the granular adsorbent) remains unamended compared to the auxiliary requests.
- 4.6 As already explained (see section 3.3.15) in the discussion of the first auxiliary request, the Board considers that there is no disclosure in D19 of a compartment containing granular adsorbent as claimed, that is in conjunction with a capsule in a compartment (without defining that one of the adsorbent-compartment's boundaries is made up of the inner and annular outer sections of filter material 58, 56). Therefore, the Board considers that, prima facie, claim

1 of the main request adds subject matter extending beyond D19. Therefore, the main request is not clearly allowable.

- 4.7 For these reasons, the Board decided not to admit the amendments based on the main request into the proceedings, pursuant to Article 114(2) EPC with Articles 13(1) and 13(3) RPBA.
5. In summary, the main request has not been admitted into the proceedings and all the auxiliary requests add subject matter extending beyond the grandparent application, so they do not meet the requirements of Article 76(1) EPC. The Board concludes that it must revoke the patent in accordance with Article 101(3) b EPC.

**Order**

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

1.       **The decision under appeal is set aside.**
  
2.       **The patent is revoked.**

The Registrar:

The Chairman:



G. Magouliotis

A. de Vries

Decision electronically authenticated