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**Datasheet for the decision
of 25 November 2019**

Case Number: T 2068/16 - 3.2.04

Application Number: 10717644.8

Publication Number: 2440076

IPC: A24C5/47, A24D1/02, A24D3/04

Language of the proceedings: EN

Title of invention:
SMOKING ARTICLE

Patent Proprietor:
British American Tobacco (Investments) Ltd

Opponent:
Philip Morris Products S.A.

Headword:

Relevant legal provisions:
EPC Art. 56

Keyword:
Inventive step - (no)
Late-filed request - adjournment of oral proceedings would have
been required (yes) - admitted (no)

Decisions cited:

Catchword:



Beschwerdekammern

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Case Number: T 2068/16 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 25 November 2019

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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
24 June 2016 concerning maintenance of the
European Patent No. 2440076 in amended form.

Composition of the Board:

Chairman A. de Vries
Members: J. Wright
T. Bokor

Summary of Facts and Submissions

- I. The appeal was filed by the appellant-opponent against the interlocutory decision of the Opposition Division finding that, on the basis of auxiliary request 2, the patent in suit (herein the "patent") met the requirements of the EPC.
- II. The Opposition Division decided, amongst other things, that the subject matter of the claims as amended during the opposition proceedings involved an inventive step.
- III. Oral proceedings were held before the Board on 25 November 2019.
- IV. The appellant-opponent requests that the decision under appeal be set aside, and that the patent be revoked.

The respondent-proprietor requests that the appeal be dismissed (maintenance as upheld by the Opposition Division), in the alternative that the decision under appeal be set aside and the patent be maintained in amended form according to one of the auxiliary Requests 1 to 14 filed with letter dated 28 October 2019 or according to auxiliary request 15, filed during the oral proceedings before the Board.

- V. The independent claim 1 of the main request and auxiliary request 4 reads as follows:

"A smoking article (10, 30, 50) comprising a rod of smokeable material (12, 32, 52) and, a filter (14, 34, 54) attached to one end of the rod, said filter comprising an elongate body of cellulose acetate filter tow material (16, 36, 56a, 56b, 56c) wrapped with a transparent plug wrap (18, 38, 58), wherein a first

tipping wrapper (20a, 40a, 60a) overlies the join between the rod and the filter to attach the filter to the rod, and at least one additional tipping wrapper (20b, 40b, 40c, 60b) is provided around the filter, spaced from and separate to the first tipping wrapper such that a portion of the transparent plug wrap is exposed between the first and at least one additional tipping wrapper to define a window portion (22, 42a, 42b, 62) through which the cellulose acetate filter tow material is visible".

Claim 1 of auxiliary request 1 reads as for the main request but adds, after the wording "such that a portion of the transparent plug wrap", the words "that overlies the elongate body of cellulose acetate filter tow material".

Claim 1 of auxiliary request 2 reads as for the main request but adds at the end of the claim the wording "provided that where the elongate body of cellulose acetate filter tow material comprises a plurality of filter sections (56a, 56b, 56c), no two filter sections are spaced from each other to define a cavity therebetween in the filter (54)".

Claim 1 of auxiliary request 3 reads as for the main request but replaces the wording "said filter comprising an elongate body of cellulose acetate filter tow material wrapped with a transparent plug wrap" with the following wording:

"said filter comprising:

(i) a single elongate body of cellulose acetate filter tow material (16, 36) wrapped with a transparent plug wrap (18, 38); or

(ii) a plurality of cylindrical plugs of cellulose acetate filter tow material (56a, 56b, 56c) collated together side by side to form an elongate body wrapped with a transparent plug wrap (58) "

Claim 1 of auxiliary requests 5 and 9 reads as follows:

A smoking article (10, 30, 50) comprising a rod of smokeable material (12, 32, 52) and, a filter (14, 34, 54) attached to one end of the rod, wherein the rod of smokeable material comprises a cylinder of smokeable tobacco or tobacco-based material contained within a paper sleeve, said filter comprising an elongate body of cellulose acetate filter tow material (16, 36, 56a, 56b, 56c) wrapped with a transparent plug wrap (18, 38, 58), wherein a first tipping wrapper (20a, 40a, 60a) overlies the join between the rod and the filter to attach the filter to the rod, and at least one additional tipping wrapper (20b, 40b, 40c, 60b) is provided around the filter, spaced from and separate to the first tipping wrapper such that a portion of the transparent plug wrap is exposed between the first and at least one additional tipping wrapper to define a window portion (22, 42a, 42b, 62) through which the cellulose acetate filter tow material is visible.

Claim 1 of auxiliary request 6 reads as for auxiliary request 5 except that after the wording "such that a portion of the transparent plug wrap", the following wording is added: "that overlies the elongate body of cellulose acetate filter tow material".

Claim 1 of auxiliary request 7 reads as for auxiliary request 5 but adds the following wording at the end of the claim: "provided that where the elongate body of cellulose acetate filter tow material comprises a

plurality of filter sections (56a, 56b, 56c), no two filter sections are spaced from each other to define a cavity therebetween in the filter (54)."

Claim 1 of auxiliary request 8 reads as claim 1 of auxiliary request 5 except that it replaces the wording "said filter comprising an elongate body of cellulose acetate filter tow material wrapped with a transparent plug wrap" by the following wording:

"said filter comprising:

(i) a single elongate body of cellulose acetate filter tow material (16, 36) wrapped with a transparent plug wrap (18, 38); or

(ii) a plurality of cylindrical plugs of cellulose acetate filter tow material (56a, 56b, 56c) collated together side by side to form an elongate body wrapped with a transparent plug wrap (58)"

Claim 1 of auxiliary request 10 reads as for auxiliary request 5, except that after the wording "a first tipping wrapper overlies the join between the rod and filter", the following wording is added:

"and comprises an adhesive to bond the first tipping wrapper to the filter and the rod in order"

Claim 1 of auxiliary request 11 reads as follows:

"A smoking article (10, 30, 50) comprising a rod of smokeable material (12, 32, 52) and, a filter (14, 34, 54) attached to one end of the rod, wherein the rod of smokeable material comprises a cylinder of smokeable tobacco or tobacco-based material contained within a paper sleeve, said filter comprising an elongate body of cellulose acetate filter tow material (16, 36, 56a,

56b, 56c) wrapped with a transparent plug wrap (18, 38, 58), wherein a first tipping wrapper (20a, 40a, 60a) overlies the join between the rod and the filter and comprises an adhesive to bond the first tipping wrapper to the filter and the rod in order to attach the filter to the rod, and at least one additional tipping wrapper (20b, 40b, 40c, 60b) is provided around the filter, spaced from and separate to the first tipping wrapper such that a portion of the transparent plug wrap that overlies the elongate body of cellulose acetate filter tow material is exposed between the first and at least one additional tipping wrapper to define a window portion (22, 42a, 42b, 62) through which the cellulose acetate filter tow material is visible".

Claim 1 of auxiliary request 12 reads as for auxiliary request 10 except that, at the end of the claim, it adds the following wording:

"provided that where the elongate body of cellulose acetate filter tow material comprises a plurality of filter sections (56a, 56b, 56c), no two filter sections are spaced from each other to define a cavity therebetween in the filter (54)".

Claim 1 of auxiliary 13 request reads as for auxiliary request 3, except that after the wording "a first tipping wrapper overlies the join between the rod and filter", the following wording is added:

"and comprises an adhesive to bond the first tipping wrapper to the filter and the rod in order"

Claim 1 of auxiliary request 14 reads as for auxiliary request 5, except that after the wording "a first tipping wrapper overlies the join between the rod and filter", the following wording is added:

"and comprises an adhesive to bond the first tipping wrapper to the filter and the rod in order"

Claim 1 of auxiliary request 15 reads as for the main request, except that it adds the following wording at the end of the claim:

"wherein the smoking article comprises at least one thread extending at least partially through the filter (14, 34, 54), and wherein the at least one thread is disposed adjacent the transparent plug wrap (18, 38, 58) and is visible through the window portion (22, 42a, 42b, 62)".

VI. In the present decision, reference is made to the following documents:

D1: JP H1-127495 and its translation into English

VII. The appellant-opponent's arguments can be summarised as follows:

The subject matter of claim 1 of the main request lacks inventive step starting from D1 when combined with the skilled person's general knowledge.

Auxiliary request 15 should not be admitted into the proceedings since it is a surprising development in the proceedings which would necessitate adjournment of the oral proceedings.

VIII. The respondent-proprietor's arguments can be summarised as follows:

Claim 1 of the main request involves an inventive step starting from D1. It would not be obvious to replace flavour granules visible through the window of D1's cigarette with tow as this would result in a window framing usual filter material, which would be surprising for the smoker, rather than framing something out of the ordinary for the smoker, namely flavour granules.

Auxiliary request 15 should be admitted into the proceedings since it is only the combination of granted claims.

Reasons for the Decision

1. The appeal is admissible.
2. Introduction

The invention relates to, amongst other things, a smoking article having a filter with a window portion in it (see published patent specification, paragraph [0001]). The window (see published patent specification, paragraph [0007]) is defined by wrapping the filter with a transparent plug wrap and having a first and an additional tipping wrapper spaced from and separate from the first to expose the plug wrap. According to claim 1 of all the present requests, cellulose acetate filter tow is visible through the window.

3. Main request and auxiliary request 4, claim 1, inventive step starting from D1 in combination with the skilled person's general knowledge

3.1 The appellant-opponent raises the issue of inventive step starting from D1 with their grounds of appeal, thus at the earliest occasion in the appeal proceedings.. The Board has no doubt that it is admissible, not least because it responds to the present main request which was filed at the very end of opposition proceedings, namely during the oral proceedings before the opposition division.

3.2 In the Board's view, D1 and the general knowledge of the skilled person take away inventive step of claim 1.

D1 (see the English translation, page 3 lines 10 to 17, page 4, lines 9 to 13 and figures 1 and 2) discloses:

A smoking article comprising a rod of smokeable material (paper rolled tobacco 1) and, a filter attached to one end of the rod. The filter has an elongate body of filter material wrapped with a transparent plug wrap 6 and a first tipping wrapper 7-1 overlies the join between the rod and the filter to attach the filter to the rod.

An additional tipping wrapper 7-2 is provided around the filter, spaced from and separate to the first tipping wrapper. A portion of the transparent plug wrap is exposed between the first and additional tipping wrapper, defining a window portion (see page 4, lines 9 to 13 with figure 1 again). However, what is visible through the window is flavouring granules 5.

- 3.3 Therefore, the subject matter of claim 1 differs from D1 in that cellulose acetate filter tow is visible through the window (not flavouring granules 5).
- 3.4 In assessing inventive step according to the problem-solution approach, a first consideration is what the technical effect of this differing feature is.
- 3.5 The Board is not convinced by the respondent-proprietor's argument that an effect of the differing feature is simplifying manufacturing, since the windows of the claimed cigarette and of D1 have the same structural features. Rather, the technical effect can only be based on the identified difference (what is visible).
- 3.6 The patent does not say what technical effect is associated with making cellulose acetate tow visible. However, it does explain (see published patent specification, end of paragraph [0037]), that the window portions [make] the embodiments clearly visually distinctive from conventional smoking articles. There the effect is asserted for all filter materials and types; granted claim 1 was accordingly not limited to any particular material or type of filter. The choice of filter material (or type) is thus unrelated to the effect of the window per se. Nor has it been argued that the effect would lie in the special properties or qualities of cellulose acetate tow, a very common, if not the most common filter material. In the letter of 28 October 2019, paragraph bridging pages 6 and 7, the respondent argues (when discussing inventive step over the complex arrangement of another prior art) that "visualization of cellulose acetate tow material" gives rise to a "unique visual effect". Thus, the main focus is on visualisation, that is making visible the actual

filter or filter material so that a user can see it and so distinguish it from other filters or filter materials, thereby also making the smoking article distinctive.

3.7 This is the same effect as in D1, held to destroy the novelty of granted claim 1 in the decision under appeal. Thus, the window allows the user to distinguish the granules of the filter, cf. page 2, lines 27 to 30. The resultant filter cigarette is thus rendered visually distinct from other filter cigarettes, including also cigarettes with conventional filters. Thus the only additional effect of the invention with respect to D1 must lie in the fact that something else is visible through the window, namely a different filter or filter material. In the Board's view, the objective technical problem can therefore be formulated as how to modify the window filter of the cigarette of D1 to render it visually distinct from that of D1.

3.8 In the Board's view it would be obvious for the skilled person, faced with this problem, to consider replacing the filter behind the window of D1 by a different one, made of a different material. It is not in dispute that cellulose acetate tow is widely used in filters, for example in the ubiquitous single plug cellulose acetate tow filter, or that such filter material has a distinct appearance with respect to a filter with granules. It is therefore an obvious candidate for producing a cigarette filter with a window that is visually distinct from that of D1. Therefore, the Board concludes that, in solving the above problem, it would be obvious for the skilled person to replace the complex filter with flavour granules in D1 with a well-known filter of a different appearance, for example a conventional single plug cellulose acetate tow filter.

In so doing, the skilled person would arrive at the subject matter of claim 1 as a matter of obviousness.

3.9 In coming to this conclusion, the Board is not convinced by the respondent-proprietor's argument that the skilled person would not modify D1 because its central purpose is to have flavouring granules (that can be coloured and so easily distinguishable) viewable through its window (cf. D1, page 3, lines 1 to 5).

Whatever role the granules, with their distinctive colours, play in D1, if the skilled person's sole concern departing from that document is to modify the window filter to render it visually distinct from that of D1 then they will realise that this is most easily achieved by displaying something else behind the window. D1 already teaches the act of showing (the use of a window), so the user can see i.e. discriminate what is behind the window. Therefore, for the skilled person, to produce a window filter as in D1 but visually distinct from it is immediately apparent that they must change what is shown. Focused on this, the skilled person will immediately realise that any other known filter of different appearance, for example a conventional single plug cellulose acetate tow filter, will serve that purpose and produce a filter that is visually distinct from the D1 filter. That this will result in a filter with different properties or qualities is then equally obvious. For example, choosing a common single plug cellulose acetate tow filter plug will have the clear benefit of being cheap, though this will be at the price of no longer having flavouring granules. This is the sort of routine balance the skilled person must strike when considering options.

3.10 Nor is the Board convinced by the respondent-proprietor's contention that the skilled person would not replace D1's granule filter with a standard cellulose acetate tow filter because D1 teaches to use its window to frame the *unusual*, namely granules, whereas the claimed smoking article uses its window to frame the *usual*, namely a cellulose acetate tow filter, which would be surprising.

The Board notes firstly that claim 1 is not only limited to what might be perceived by the user as usual filters but also includes more unusual filters, as for example discussed in specification paragraph [0037], see also claims 8 and 9. Moreover, this argument appears based on the idea that it is the recognition that a window per se can give visual distinctiveness, independent of what is shown (which could therefore be non-distinct) that is inventive. In the Board's view however the window - the act of showing - is clearly central to D1's teaching, and it is entirely within the skilled person's normal skills of comprehension and abstraction to recognize that this aspect, even if used to special advantage in D1, can be used more broadly without that special advantage, irrespective of the nature - whether usual or unusual - of what is shown.

3.11 Therefore, the Board concludes that the subject matter of claim 1 lacks an inventive step over D1 with the skilled person's general knowledge.

4. Auxiliary requests 1 to 3 and 5 to 14

4.1 The respondent-proprietor has not provided any arguments regarding inventive step of these requests.

- 4.2 Irrespective of their admissibility, the Board holds that claim 1 of these requests lacks inventive step for the same reasons as apply to the main request. In particular claim 1 of all requests covers embodiments with a common single plug cellulose acetate filter, which the Board holds to lack inventive step as explained above. Further amendments define features that are inherent or implicit in that embodiment, or they add routine features of cigarettes. Therefore, these requests fail.
- 4.3 In particular, with regard to auxiliary requests 1, 6 and 11, since the Board finds it obvious for the skilled person to replace the coloured granules of D1's filter with a common single plug cellulose acetate tow filter, the transparent plug wrap would inevitably overlie the resulting elongate body of cellulose acetate tow (see D1, page 3, lines 11 to 17 with figure 2). Therefore, this new feature is found to be obvious.
- 4.4 Claim 1 of auxiliary requests 2, 7, 8 and 12 disclaims a cavity where several filter sections are present. For all cellulose acetate tow filters, such as for example single plug ones, which are still included in claim 1, the Board's conclusion must remain the same.
- 4.5 Claim 1 of auxiliary requests 3, 7, 8 and 13 expressly specifies a single plug cellulose acetate tow filter as one of two alternatives and thus fails for the same reasons.
- 4.6 Claim 1 of auxiliary requests 5, 6, 7, 9, 10, 11, 12, 13 and 14 adds the feature of a paper sleeve around a cylinder of tobacco based material or the further feature of using an adhesive to bond the tipping paper

to the rod and filter. These are trivially standard features of present day filter cigarettes and their addition alone or in combination is devoid of inventive step.

5. Auxiliary request 15, admission

5.1 Auxiliary request 15 was filed at the oral proceedings before the Board. The request thus amounts to an amendment to the Appellant's case within the meaning 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 *inter alia* complexity of the subject-matter, the state of the proceedings and the need for procedural economy.

Under paragraph (3) of the article, 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.

5.2 In the Board's view, admitting this amendment so late would be neither fair to the appellant-opponent nor conducive to procedural economy.

5.3 In particular, the Board holds that a proper consideration of this request, allowing the appellant-opponent time to formulate counter arguments, would require an adjourning of the oral proceedings. Such a course of action is, however, excluded under Article 13(3) RPBA.

5.4 In this respect, the Board is not convinced by the respondent-proprietor's argument that it would be unproblematic to deal with the request without adjournment since it is merely the combination of granted claims (cf. published patent specification, claims 1, 8 and 9).

5.5 The features of granted claims 8 and 9 (thread) were never given any prominence in the respondent-proprietor's case in appeal until the oral proceedings. Thus, neither the appellant-opponent nor the Board could have been prepared for this last-moment change in the respondent-proprietor's case.

Put another way, restricting amendments to a combination of granted claims does not relieve the respondent-proprietor of its procedural obligation to present its complete case as early as possible in appeal proceedings, Rule 12(2) RPBA.

5.6 For all these reasons the Board decided to exercise its discretion under Article 114(2) EPC with Article 13(1) and (3) RPBA by not admitting auxiliary request 15 into the proceedings.

6. Since all the respondent-proprietor's requests fail or have not been admitted into the proceedings, the Board must revoke the patent.

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