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**Datasheet for the decision  
of 5 October 2021**

**Case Number:** T 0883/18 - 3.2.01

**Application Number:** 06787864.5

**Publication Number:** 1959766

**IPC:** A24F47/00, A24D3/04, A24F1/10

**Language of the proceedings:** EN

**Title of invention:**  
METHOD AND SYSTEM FOR VAPORIZATION OF A SUBSTANCE

**Patent Proprietor:**  
JT International SA

**Opponent:**  
Philip Morris Products S.A.

**Headword:**

**Relevant legal provisions:**  
EPC Art. 123(2), 100(b), 100(c), 54, 56, 114(2)  
RPBA Art. 12(4)  
EPC R. 116(1)

**Keyword:**

Grounds for opposition - subject-matter of the main request extends beyond content of earlier application (yes)

Amendments - auxiliary request 1 - allowable (yes)

Clarity - Auxiliary request 1 (yes)

Late-filed evidence - correct exercise of discretion by the opposition division (yes) - submitted with the grounds of appeal admitted (no)

Novelty - auxiliary request 1 (yes)

Inventive step - auxiliary request 1 - (yes)

**Decisions cited:**

G 0003/14

**Catchword:**



**Beschwerdekammern**

**Boards of Appeal**

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Case Number: T 0883/18 - 3.2.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.01**  
**of 5 October 2021**

**Appellant 1:**  
(Patent Proprietor)

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**Appellant 2:**  
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**Decision under appeal:**

**Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
29 January 2018 concerning maintenance of the  
European Patent No. 1959766 in amended form.**

**Composition of the Board:**

**Chairman** G. Pricolo  
**Members:** S. Mangin  
A. Jimenez

## **Summary of Facts and Submissions**

- I. The appeals were filed by appellant 1 (patent proprietor) and appellant 2 (opponent) against the interlocutory decision of the opposition division finding that, on the basis of the auxiliary request 4, the patent in suit (hereinafter "the patent") met the requirements of the EPC.
- II. The opposition division held that the subject-matter of the main request extended beyond the content of the application as filed.

The opposition division further held that:

- (1) auxiliary request 4 submitted during oral proceedings in opposition was admissible, clear and did not extend beyond the content of the application as filed;
- (2) the patent, on the basis of this request, disclosed the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
- (3) documents D3 (US 4848374), D4 (US 2104266) and D5 (US 2860638) were to be admitted into the opposition proceedings;
- (4) the subject-matter of this request was novel over D2 (US 6164287) and D3 and involved an inventive step starting from D2, and starting from D5 in combination with D4.

- III. Oral proceedings were held before the Board on 5 October 2021.
- IV. The appellant 1 (patent proprietor) requested that the decision under appeal be set aside and that the patent

be maintained as granted (main request), or in the alternative, that the patent be maintained in the form found allowable by the opposition division (auxiliary request 1), or that the patent be maintained in amended form on the basis of auxiliary requests 2-11 filed with the reply to the statement of grounds of appeal on 12 October 2018.

The appellant 2 (opponent) requested that the decision under appeal be set aside and that the patent be revoked.

V. Claim 1 of the main request (claim 1 as granted) reads:

A device (10) for generating an inhalable vapor comprising:  
a body (12);  
a heater (16) within said body (12) capable of heating a smokeable material (31) in a cartridge (30) to generate an inhalable vapor;  
a mouthpiece (11) comprising an air inlet (22) or inlets directed downward through the mouthpiece (11), or along a diagonal through the mouthpiece (11).

VI. Claim 1 of auxiliary request 1 (with the feature numbering of appellant 2 on page 3 of its statement of grounds of appeal) reads:

F1 A device (10) for generating an inhalable vapor comprising:  
F2 an elongated main body  
F2.1 with a mouthpiece (11) at one end and  
F2.2 an attached tubular casing (12) at the other end;  
F3 the tubular casing (12) comprising a vaporization chamber (15) and

F3.1 a heater (16) capable of heating a smokeable material (31) in a cartridge (30) to generate an inhalable vapor;

F4 the mouthpiece (11) comprising an air inlet (22) or inlets directed downward through the mouthpiece (11), or along a diagonal through the mouthpiece (11).

VII. The following document is further relevant for the decision:

D8: EP 0 277 519 A2

### **Reasons for the Decision**

1. Main request - Added subject-matter - Article 123(2) EPC

According to Article 15(8) RPBA 2020, if the Board agrees with the finding of the department which issued the decision under appeal, on one or more issues, and with the reasons given for it in the decision under appeal, the Board may put the reasons for its decision in abridged form in respect of that issue.

In the communication under Article 15(1) RPBA 2020 the Board informed the parties that it agreed with the finding of the opposition division in respect of added subject-matter in view of the reasons given under point 1 on pages 4-7 of the appealed decision. During oral proceedings, the appellants referred to their written submissions regarding the main request. The Board thus confirms its preliminary opinion and adopts thereby the reasoning of the opposition division as its own. As a consequence, the main request, and thus the appellant 1's appeal, fails because claim 1 as granted extends beyond the content of the application as filed.

2. Auxiliary request 1

2.1 Added-subject-matter - Article 123(2) EPC

The Board confirms the findings of the opposition division which held that the subject-matter of claim 1 does not extend beyond the content of the application as originally filed.

2.1.1 As regards feature F4, objected to by appellant 2, it is based on figure 2 and on the paragraph bridging pages 4 and 5:

*"In the preferred embodiment, the air inlet or inlets are directed downward, so as to improve the extraction of vapor from the cartridge. They could also be directed along a diagonal through the mouthpiece, or laterally through the case itself, above the cartridge".*

Although there is no literal disclosure of the air inlet or inlets being directed downward through the mouthpiece, considering the above cited paragraph as well as figure 2, an air inlet directed downward can technically make sense only when it extends through the mouthpiece.

2.1.2 Appellant 2 argued that if figure 2 formed the basis for feature F4 there was an unallowable intermediate generalisation since the following features were not introduced into claim 1:

- (i) the mouthpiece was removable for inserting a tobacco cartridge (see figure 2 and first paragraph of the detailed description on page 4)
- (ii) the cartridge was in direct contact with the walls of the vaporisation chamber so as to facilitate heat transport towards the substrate of the cartridge and

that vapor was generated above the cartridge (figure 2 and last two paragraph of page 4)

(iii) the vaporisation chamber was the vaporisation chamber of the heater (figure 2 and first paragraph of the detailed description on page 4), i.e. the vaporisation chamber could not be any kind of vaporisation chamber located in the tubular casing as claimed but was originally disclosed as being the vaporisation chamber of the heater.

- 2.1.3 The Board does not agree. The above cited features cited by appellant 2 are not structurally and functionally linked to the air inlet(s). Regarding feature (i), the third paragraph of page 6 reads "*In an alternate embodiment, the mouthpiece is permanently attached to the body. In that case, the vaporization chamber could be accessed by operating a sliding or hinged door, or similar means, built into the device*". In view of this passage the skilled person understands that the air inlet(s) in the mouthpiece and their orientation are independent of whether the mouthpiece is removable or permanently attached. The omission of the mouthpiece being removable in claim 1 does not therefore lead to an unallowable intermediate generalisation. Feature (ii) relates to the arrangement of the tobacco cartridge in the vaporisation chamber to improve the heat transfer between the heater and the cartridge and does not relate directly to the inlets in the mouthpiece. Furthermore, this feature is defined in original dependent claim 4 and not in original independent claim 1 wherein the air inlets are defined. As for feature (iii), whether the vaporisation chamber is said to be the vaporisation chamber "of the heater" does not further define the vaporisation chamber. The skilled person understands that the vaporisation



chamber is linked to the heater required to heat the vaporisation chamber to generate the vapor.

2.1.4 Furthermore, appellant 2 was of the opinion that while throughout the description emphasis was placed upon the device having a removable cartridge that could be inserted into, and removed from, the vaporization chamber, this essential feature was not present in claim 1.

2.1.5 However, in the Board's view, as already expressed in the communication pursuant to Article 15(1) RPBA, the term "cartridge" is understood by a skilled person in the present technical field as referring to a consumable component which is removable. Accordingly, the insertion and removal of the cartridge in the device of claim 1 is implicit. As a consequence, the Board also does not agree with appellant 2 that claim 1 reads upon devices configured for a single use, in which the cartridge is not removable after use.

2.2 Clarity - Article 84 EPC

2.2.1 Appellant 2 considered that claim 1 was unclear for the following reasons:

(a) In the passage of claim 1 reciting "an elongated main body with a mouthpiece (11) at one end and an attached tubular casing (12) at the other end; the tubular casing (12) comprising a vaporization chamber (15)" it was not clear whether "the elongated main body" and "the mouthpiece" were one or two elements. These features found a literal basis in the first paragraph of page 1 of the application as originally filed and suggested that there were two distinct elements, the elongated

main body and the mouthpiece, attached to a third separate element, the tubular casing. However, the subsequent sentence in paragraph 1 of page 1 of the application as originally filed reading "the mouthpiece and the casing form a unitary unit", casts doubts on whether the mouthpiece and the elongated main body were one or two elements and whether the tubular casing was an integral part of the mouthpiece or was attached to the mouthpiece as claimed.

- (b) The means for removing the cartridge from the device was an essential feature of the patent in dispute but was omitted in claim 1. No embodiments of a single-use device, in which the cartridge was not removable after depletion, were described in the original application.

2.2.2 As regards point (a), the features "*an elongated main body with a mouthpiece (11) at one end and an attached tubular casing (12) at the other end; the tubular casing (12) comprising a vaporization chamber (15)*" are clear and are to be understood such that the entire device comprises an elongated main body, which is made of two elements: a mouthpiece at one end and a tubular casing at the other end. This interpretation is supported by the description and in particular figures 1 and 2 and the first paragraph under detailed description.

Furthermore the above features are not in contradiction with the "*mouthpiece and the casing form[ing] an unitary unit*" (first paragraph of the description). Indeed the mouthpiece at one end and the attached tubular casing at the other end form a unitary unit. As mentioned by appellant 1 this feature is not to be

interpreted as if the mouthpiece and the casing were formed by an integral piece.

Regarding the objection related to the removable cartridge not being defined in claim 1 while being an essential feature, following G 3/14 the Board does not have the power to examine this objection as it is not based on a non-compliance introduced by the amendments made to granted claim 1. Indeed the cartridge being removable was not a feature of claim 1 of the patent as granted.

### 2.3 Sufficiency of disclosure - Article 100(b) EPC

The Board confirms the decision of the opposition division finding that the patent discloses the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. Reference is made to point 2.4 on pages 11 and 12 of the appealed decision.

- 2.3.1 Appellant 2 argued that "the feature of downward or diagonal air inlet(s) had no specific meaning according to the patent in dispute and consequently the skilled person did not know whether s/he was working within the forbidden area of the claims". Referring to the air inlets 22 and 49 of the embodiments of figures 2 and 4 respectively, appellant 2 considered that the skilled person could not determine whether any type of orientation of an air inlet in or next to a mouthpiece was encompassed by the wording of claim 1. Furthermore the necessary distance between an air inlet and the point which contacted the lips of a user so that the air inlet would still be considered as being arranged "through the mouthpiece" was not defined and could not be deduced from the patent in dispute.

2.3.2 The Board takes the view that figures 1 and 2 illustrate an example of the invention, which is sufficient to enable the skilled person to carry out the invention as defined in claim 1. Furthermore, the distance between the point where the user contacts the mouthpiece with their lips and the air inlet is not defined in claim 1, which renders claim 1 broad, but does not prevent the skilled person from carrying out the invention over the whole extent claimed. The skilled person will place the air inlet downwards or along a diagonal through the mouthpiece 11 as described in figure 2.

#### 2.4 Admissibility of documents D3-D5

The Opposition Division admitted the documents D3-D5 filed after the final date for making written submissions under Rule 116(1) EPC into the opposition proceedings under Article 114(2) EPC. The Board does not see any reasons to overturn the discretionary decision of the opposition division. Documents D3-D5 are therefore part of the appeal proceedings.

2.4.1 Appellant 1 considered that documents D4-D5 filed on and received after close of business on Friday 1 December 2017 were very late filed in view of the oral proceedings on the next Wednesday and did not represent an appropriate response to the auxiliary requests filed on 6 October 2017. Appellant 1 further considered that the Opposition Division had mistaken in evaluating the prima facie relevance of these documents. The Opposition Division considered that documents D4 and D5 disclosed a vaporisation chamber and a heater within a tubular casing, features which were not present in D2 nor D3.

However under the assessment of novelty of claim 1 (point 2.5.2.3 of the appealed decision) the Opposition Division considered that D2 and D3 disclosed these features.

- 2.4.2 It is established case law that, on appeal against a decision taken by a department of first instance in exercise of its discretion, it is not for the Board to review all the facts and circumstances of the case as if it were in that department's place and decide whether it would have exercised discretion in the same way. If the EPC requires that a department of first instance exercise discretion in certain circumstances, that department should have a certain degree of freedom to do so without interference from the Boards. They should overrule the way in which it exercised its discretion in reaching a decision in a particular case only if they conclude that it did so in accordance with the wrong principles, without taking the right principles into account or in an arbitrary or unreasonable way, thereby exceeding the proper limits of its discretion (Reference is made to the 9th edition of the Case Law Book V.A.3.5.1b).

Regarding the admission of documents D4 and D5, the Opposition Division applied the right criterion, namely the prima facie relevance. As regards the assessment of prima facie relevance, the appellant did not argue that it was done in an unreasonable or arbitrary way. Whether, at a later stage, an in-depth substantive assessment revealed that D4 and D5 were not more relevant than D2 or D3 is irrelevant, as this assessment was anyway made in a different context than the assessment of the prima facie relevance.

- 2.5 Admissibility of document D8 - Article 12(4) RPBA 2020

The Board does not admit document D8 filed by appellant 2 with their statement of grounds of appeal into the appeal proceedings.

- 2.5.1 Appellant 2 argued that document D8 was cited in response to the Opposition Division's decision of maintaining the patent on the basis of auxiliary request 4A filed during the oral proceedings in opposition. Appellant 2 emphasised that document D8 was highly relevant against the novelty of claim 1 and should therefore be admitted into the appeal proceedings.
- 2.5.2 In the case before the Board the statement of grounds of appeal were submitted before 1 January 2020. Whether or not document D8 should be admitted must be therefore decided on the basis of Article 12(4) RPBA 2007 (see Article 25(2) RPBA 2020), which gives the Board discretion not to admit, on appeal, documents that could have been presented in opposition proceedings.
- 2.5.3 In the case in hand, auxiliary request 1 corresponds to auxiliary request 4 that was submitted as auxiliary request 4A during oral proceedings in opposition. Auxiliary request 4A was submitted in reaction to an objection based on Article 123(2) EPC. It differs from auxiliary request 4 which was submitted on 6 October 2017, two months in advance of the oral proceedings in opposition, in that the location of the mouthpiece and the tubular casing have been specified to be respectively at one end and at the other end of the elongated body.

Appellant 2 did not substantiate that the filing of D8 was in direct relation to the amendments made to claim

1 of auxiliary request 4A (which is identical to auxiliary request 4 allowed by the Opposition Division in the decision under appeal and is thus identical to present auxiliary request 1) but rather submitted that D8 was highly relevant for the claim 1 as maintained. Nor is it evident for the Board how these amendments, which are of a minor nature, would justify the introduction of a new document in appeal proceedings. Therefore, the filing of D8 does not represent a legitimate response to the admission of auxiliary request 4A in oral proceedings in opposition. In view of its alleged relevance also in respect to claim 1 as granted, appellant 2 (opponent) could have and should have submitted document D8 during opposition proceedings, for example together with the submission of documents D4 and D5 on 1 December 2017.

2.6 Novelty in view of documents D2, D3 and D5 - Article 54 EPC

The Board confirms the finding of the opposition division in the appealed decision, according to which the subject-matter of claim 1 is novel over D2, D3 and D5.

2.6.1 Novelty over D2

(a) Appellant 2 considered that D2 disclosed a device for generating an inhalable vapor comprising an elongated body (D2, column 1, line 64-column 2, line 2 and figures 1 and 2). The tablet tube 11 together with the mouthend piece 18 were considered to anticipate the mouthpiece of claim 1 and the conductor tube 12 was considered to anticipate the tubular casing of claim 1. D2 further disclosed a heater (the burner 16 with the conductor 13)

capable of heating a smokeable material in a cartridge (the tobacco tablet 15) to generate an inhalable vapor. Furthermore figures 1 and 2 disclosed an air inlet 14 directed downward or along a diagonal through the mouthpiece.

For the disclosure of feature F3, appellant 2 considered two alternative approaches:

- following a first approach, the vaporisation chamber in which the tobacco tablet was placed was considered partly in the conductor tube 12, such that the conductor tube 12 comprised a vaporisation chamber. Furthermore since D2, column 4, lines 37-41, disclosed that *"the size and spacing of the conductor between the tobacco and heat source are designed to produce and maintain the predetermined temperature or temperature range in the tobacco material"* if the conductor was chosen to be smaller, the tablet 15 would be arranged further in the conductor tube 12 or even completely within the conductor tube 12. According to appellant 2 the skilled person would routinely vary the thickness of the conductor to adjust the desired parameters of the heater, such as the heating speed and the maximum temperature. D2 therefore implicitly disclosed the vaporisation chamber in the conductor tube 12.

- Following a second approach, as claim 1 of auxiliary request 1 did not establish any relationship between the vaporisation chamber and the heater, the vaporisation chamber could be considered the chamber in the conductor tube 12 where butane in the presence of oxygen formed CO<sub>2</sub> and H<sub>2</sub>O. While a corresponding chamber was not explicitly disclosed in D2, the butane heater of D2



necessarily created a vapor in a vaporisation chamber in the conductor tube 12.

- (b) The Board judges that the conductor tube 12 of D2 does not comprise a vaporisation chamber, instead the vaporisation chamber is located in the tablet tube 11, considered by appellant 2 as forming part of the mouthpiece.

The first approach presented by appellant 2 cannot be followed as there is no direct and unambiguous disclosure that the tobacco tablet 15 is in the conductor tube 12. On the contrary, the passage at column 8, lines 42-45 discloses that "the forward portion of tobacco tablet 15 fits into chamber 25 in tablet tube 11". Furthermore, looking at figure 1, the tobacco tablet is clearly in the tablet tube 11 and not in the conductor tube 12. The further argument based on the passage at column 4, lines 37-41, whereby the skilled person would reduce the size of the conductor 13 and arrive at the tobacco tablet located inside the conductor tube 12, is an argument relating to inventive step, not to novelty, as for the assessment of the latter it is necessary to establish where there is a clear and unambiguous disclosure of a feature in the prior art.

The second approach presented by appellant 2 cannot be followed either. The vaporisation chamber of claim 1 cannot be considered as the chamber where butane mixes with oxygen and generates CO<sub>2</sub> and H<sub>2</sub>O. This interpretation would be contrary to the understanding of the skilled person dealing with devices for generating inhalable vapor, comprising an unspecified heater, i.e. not specifically a

butane heater. Furthermore, the term vapor and vaporisation throughout the patent and in the related prior art refers to the tobacco smoke vapor and not to the carbon dioxide and the water generated by the combustion of the butane.

#### 2.6.2 Novelty over D3

The Board judges that D3 does not disclose "a heater (16) capable of heating a smokeable material (31) in a cartridge (30) to generate an inhalable vapor"; instead the smokeable material is heated outside the cartridge.

- (a) According to appellant 2, figure 2 of D3 disclosed a heater (heat generating device 230) capable of heating a smokeable material in a cartridge formed by the end of the chamber portion 228 to generate an inhalable vapor. Appellant 2 submitted that the patent in dispute did not describe any limitation conferred by the term "cartridge" so that this feature was to be interpreted broadly. According to paragraphs [0030] and [0056] of the patent, the cartridge must be understood as a space configured to contain smokeable material. This was the case for the end chamber portion 228 of the device described in D3 (column 3, lines 41-48), into which liquid aerosol precursor was directed.
- (b) The Board does not agree that the end of the chamber portion 228 in the device of figure 2 can be considered as a cartridge. As explained above, a cartridge must be able to be inserted and removed. In D3, the end chamber portion 228 is not to be removed from the heater 230. The end chamber portion 228 receives liquid aerosol precursor from the flexible container 236, wherein it is heated.

The heater of D3 does not therefore heat the smokeable material in the cartridge.

### 2.6.3 Novelty over D5

The Board considers that D5 neither discloses a heater nor a vaporisation chamber.

(a) Appellant 2 considered that D5 (column 1, lines 15-26) disclosed a device for "furnish[ing] smoke without employing combustion" and therefore disclosed a device for generating an inhalable vapor. D5 (column 2, line 69 - column 3, line 2) also disclosed a vaporisation chamber in the form of a capsule 14 filled with a filler material, such as cotton or mineral matter in which the flavour and taste components of tobacco were absorbed. Figure 4 showed how air drawn through the cartridge mixed with the substrate in the cartridge to extract the volatile components contained therein, which were then delivered to the user. D5 (column 3, lines 21-29) may be modified to accommodate a lighted cigarette which would form the heater of claim 1. When a user puffed on the device of D5, warm smoke was drawn from the lit cigarette into the capsule 14 to extract the volatile flavours and aromas components of tobacco in the capsule. Appellant 2 argued that because ambient temperature could generate an inhalable vapor from the capsule, a person of ordinary skill in the art would immediately recognize that the heat from the warm smoke was even more capable of generating an inhalable vapor from the capsule.

(b) The Board does not agree with the interpretation made by appellant 2 of the device disclosed in

document D5. D5, column 1, lines 15-16 discloses that "this invention relates to a smoking device and more particularly to a device requiring no combustion". The skilled person would therefore not consider the lighted cigarette that may be received in the tubular extension 37, as shown on figures 15 and 16 (D5, column 3, lines 21-27), as the heater of the device. Furthermore in D5 no vaporisation occurs in capsule 14, such that it cannot be considered as a vaporisation chamber. In D5, the air flowing through the device picks up the tobacco flavour and aroma as it passes through the capsule 14. Even considering that the lit cigarette would warm up the air passing through the device, D5 does not disclose that the temperature of the air would be high enough to evaporate the concentrated cigarette smoke in the capsule 14.

2.7 Inventive step starting from D2, starting from D3 and starting from D5 in combination with D4 - Article 56 EPC

2.7.1 Inventive step starting from the teaching of D2.

(a) As mentioned above with respect to novelty over D2, appellant 2 argued that in view of the disclosure on column 4, lines 37-41 that "the size and spacing of the conductor between the tobacco and heat source are designed to produce and maintain the predetermined temperature or temperature range in the tobacco material", the skilled person would reduce the size of the conductor 13, such that the tobacco tablet 15 would be arranged within the conductor tube 12 (see figures 1 and 2). Appellant 2 argued that only the size of the conductor needed

to be reduced, no other modifications were required.

- (b) The Board does not agree. The subject-matter of claim 1 differs from the disclosure of D2 in that the tubular casing comprises the vaporisation chamber. The arrangement of the vaporisation chamber in the mouthpiece has the same technical effect as the arrangement of the vaporisation chamber in the tubular casing. The problem to be solved may therefore be regarded as to provide an alternative arrangement of the vaporisation chamber.

In D2 the skilled person has no motivation to change the location of the tobacco tablet which defines the vaporisation chamber. Indeed, D2, column 8, lines 42-45 discloses that the forward portion of the tobacco tablet fits into chamber 25 of the tablet tube 11, considered as part of the mouthpiece by appellant 2. Furthermore the passage of column 4 of D2 cited by appellant 2 does not provide any incitation to the skilled person to reduce the size of the conductor. This passage leaves it open to the skilled person whether to reduce or increase the size of the conductor. Additionally, the adjustment of the size of the conductor is not for the purpose of placing the tobacco tablet in the conductor tube but for producing and maintaining a predetermined temperature in the tobacco material in view of the conductor material used.

Even if the skilled person were to change the size of the conductor, the skilled person would also modify the position of the shoulders in both the tablet tube and the conductor tube to keep the device configuration unchanged. If the skilled

person would reduce the size of the conductor, he would necessarily have to position the shoulders in the conductor tube closer toward the end of the tube, otherwise the tablet would not be pushed against the shoulder of the tablet tube. It is only in a very specific situation that a modification of the conductor tube might not be necessary, when the reduction of the size of the conductor is less than the gap between the tablet tube and the conductor tube. The Board notes that when the gap between the two tubes is reduced, the tolerance for the thickness of the tobacco tablet is also reduced. Appellant 2's argument is therefore based on an ex-post facto analysis, whereby the skilled person would reduce the size of the conductor by less than the gap between the tablet tube and the conductor tube and not modify the position of the shoulders in the respective tubes such that the tobacco tablet be partly placed in the conductor tube. However D2 neither teaches nor suggests to place the tobacco tablet in the conductor tube as required by claim 1.

2.7.2 Inventive step starting from D3

- (a) Appellant 2 only stated in their statement of grounds of appeal that as D3 disclosed the subject-matter of claim 1, claim 1 also lacked an inventive step in the light of D3.
- (b) This reasoning is not convincing. The Board judges that D3 does not disclose heating a smokable material in a cartridge and does not recognise any teaching in D3 that would motivate the skilled person to modify the device of D3 such that the smokable material would be heated in the cartridge.

2.7.3 Inventive step starting from D5 in combination with D4

(a) Appellant 2 considered that the only difference between the subject-matter of claim 1 and D5 was the provision of a heater capable of heating a smokeable material in a cartridge to generate an inhalable vapor. Starting from D5, the problem to be solved could be seen in providing a vaporisation device with optimised vaporisation. Appellant 2 argued that since vaporisation was the main objective of the device of D5, the skilled person would always look for ways of optimising vaporisation. Figure 3 of D4 disclosed a device similar to the device of D5 which comprised a vaporisation chamber (heating chamber 3) containing a cigarette (page 2, first column, lines 1 and 2 of D4). Air was drawn through air inlet 8 and the vaporisation chamber towards a mouthpiece 2. Additionally D4 taught employing a heater (heating coil 5) for improving vaporisation (page 2, right column, lines 10-15). D4 described therefore the beneficial effect of heating the substrate in comparison to vapor generation from a smokeable material at ambient temperature. According to appellant 2, a skilled person would readily appreciate from D4, as well as common general knowledge from putting water on a heated stove, that vaporisation could be improved by application of heat to the volatilisable material. Faced with the problem of optimising vaporisation, particularly when the ambient temperature is cold and/or when more vapor is desired, the skilled person would readily employ the heater of D4 in the device of D5. The skilled person would simply have to arrange the heating coil 5 from D4 around the

capsule 14 of D5 instead of the heating chamber 3 of D4, which would not result in any structural modifications of the device of D5.

- (b) The Board agrees with the findings of the Opposition Division. D5 is not the closest prior art and is not an appropriate starting point as the device of D5 is not a device for generating inhalable vapour. The device of D5 neither requires a heater for combustion nor an evaporation chamber. In contrast, D5 discloses passing ambient air through a capsule filled with cotton or mineral matter in which the tobacco flavour and taste components are absorbed.

Should D5 be nevertheless taken as a starting point, then the skilled person would not combine the teaching of D5 with the teaching of D4 as these documents deal with very different devices. While the shape of the two devices may be similar, they rely on totally different principles.

Should the skilled person nevertheless combine the teaching of D5 with the teaching of D4, and introduce heating coils providing temperatures in the range of 200-225°C (D4, left column of page 2, lines 69-73) in D5, further substantial modifications would be required to be made to the device of D5: electricity would need to be supplied to the heating coil, components of the device would need to be changed to withstand such temperatures and thermal insulation would be required. The modifications required would not simply consist in taking the heating coil of D4 and placing it around the capsule of D5 as alleged by appellant 2.

3. The appellant 2 also argued that the objections of lack of novelty and inventive step against claim 1 also



applied to claim 7. However, as claim 7 is directed to a kit comprising the device of claim 1 and a cartridge, these objections also fail for the reasons stated above with respect of claim 1.

4. To conclude none of the objections raised by appellant 2 against auxiliary request 1, corresponding to the request found allowable by the opposition division, are convincing.

### **Order**

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

The appeals are dismissed.

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated