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**Datasheet for the decision
of 15 July 2021**

Case Number: T 1857/18 - 3.2.01

Application Number: 12748326.1

Publication Number: 2741626

IPC: A24F47/00

Language of the proceedings: EN

Title of invention:

SMOKING ARTICLES AND USE THEREOF FOR YIELDING INHALATION
MATERIALS

Patent Proprietor:

RAI Strategic Holdings, Inc.

Opponent:

Philip Morris Products S.A.

Headword:

Relevant legal provisions:

EPC Art. 123(2), 100(b), 84

Keyword:

Amendments - extension beyond the content of the application
as filed (no)

Grounds for opposition - insufficiency of disclosure (no)

Claims - clarity (yes)

Decisions cited:

T 0017/86, T 0284/94, G 0003/14

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 1857/18 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 15 July 2021

Appellant: RAI Strategic Holdings, Inc.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 6 June 2018
revoking European patent No. 2741626 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

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

Summary of Facts and Submissions

- I. The appeal was filed by the appellant (patent proprietor) against the decision of the opposition division to revoke the patent in suit (hereinafter "the patent").
- II. During the opposition proceedings, the opponent had raised the grounds for opposition under Article 100(a) EPC (lack of novelty and lack of inventive step), 100(b) EPC and 100(c) EPC.
- III. The opposition division decided that
 - (1) the patent disclosed the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art,
 - (2) claim 1 of the main request filed during opposition proceedings met the requirement of Article 84 EPC,
 - (3) the subject-matter of the claims according to the main request extended beyond the content of the application as filed, *and*
 - (4) claim 1 of auxiliary request I filed during the oral proceedings in opposition met the requirements of Article 123(2) and (3) EPC but did not meet the requirements of Article 84 EPC.
- IV. The Board issued a communication pursuant to Article 15(1) RPBA 2020 on 1 April 2020 indicating to the parties its preliminary opinion, namely that the main request seemed to meet the requirements of Articles 123(2) EPC and 84 EPC and that the grounds of opposition under Article 100(b) did not prejudice the maintenance of the patent. The Board further noted that the opposition division did not consider the issues of novelty and inventive step of the main request in view

of D1 and D2 and that under these circumstances it considered that special reasons existed for remittal of the case to the opposition division (Article 111(1) EPC and Article 11 RPBA 2020). The Board concluded that a decision could be taken in written proceedings, with the findings that the main request fulfilled the requirements of Article 123(2), 83 and 84 EPC and ordering remittal of the case to the opposition division for further prosecution (i.e. for the assessment of novelty and inventive step).

- V. With letter of 10 November 2020 the respondent (opponent) withdrew the request for oral proceedings based on its understanding that if one of the requests were found to fulfil the requirements of Article 84, 83 and 123(2) EPC, the case would be remitted to the opposition division for further prosecution. The respondent submitted further comments regarding the main request on the interpretation of claim 1, added subject-matter, sufficiency of disclosure and clarity.
- VI. With letter of 13 November 2020, the appellant indicated that the request for oral proceedings was withdrawn on the condition that the Board intended to decide that the main request was admissible, met the requirements of Article 123(2), 83 and 84 EPC, and the case be remitted to the opposition division for further consideration of novelty and inventive step.
- VII. On 26 November 2020 the oral proceedings were cancelled by the Board.
- VIII. The appellant requests that the decision under appeal be set aside and that the patent be granted on the basis of the main request, or, in the alternative, on

the basis of one of the auxiliary requests A, B, I or II, all filed with the statement of grounds of appeal.

The respondent requests that the appeal be dismissed.

IX. Claim 1 of the main request (with added features compared to claim 1 as granted highlighted in bold) reads as follows:

An electronic smoking article (10) comprising:

- a substantially tubular shaped cartridge body (300) **having a mouth end (315) and an opposing engaging end (310);**
- a substantially tubular shaped inhalable substance medium that includes an inhalable substance therewith, the inhalable substance medium being positioned within the cartridge body so as to define an annular space between the inhalable substance medium and the cartridge body, **the inhalable substance medium having a first end (353) that is attached to the mouth end (315) of the cartridge body (300) and having a second, segmented end (354) that is attached to the engaging end (310) of the cartridge body (300);**
- an electrical heating member; and
- a control housing (200) with an engaging end operatively connected to the cartridge and including an electrical energy source that provides power to the electrical heating member;
- wherein the inhalable substance medium is operatively positioned with the electrical heating member so as to heat at least a segment of the inhalable substance medium sufficiently to form a vapor comprising the inhalable substance within the annular space.

X. Dependent claims 13, 15, 16 and 18:

Claims 13 (and claim 18, respectively) reads: The electronic smoking article of claim 12, (of claim 17, respectively), wherein the article is adapted for manual control of the indexing, or wherein the article comprises a puff actuated controller that automatically indexes the cartridge body past the projection segment, particularly wherein the automatic indexing distance is directly related to the duration of the puff.

Claim 15 reads: The electronic smoking article of claim 14, wherein the electrical energy source includes a projection, and wherein the electrical heating member includes electrical contacts adapted for interaction with corresponding contacts on the projection such that when heating is activated, heating occurs along the entire length of the electrical heating member, particularly wherein the electrical heating member is present within the cartridge body along a segment that is about 75% to about 100% the length of the inhalable substance medium.

Claim 16 reads: The electronic smoking article of claim 15, wherein the projection of the electrical energy source includes electrical leads, optionally wherein the electrical leads form an electrical connection with discrete segments of the electrical heating member such that when heating occurs, only the portion of the inhalable substance medium in proximity to a segment of the electrical heating member in electrical connection with the projection is heated, particularly wherein the segment of the electrical heating member that is in electrical connection with the electrical leads of the projection encompasses about 5% to about 50% of the length of the inhalable subject medium.

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

D1: US 5 505 214 A

D2: US 5 269 327 A

Reasons for the Decision

1. This decision confirms the preliminary opinion as expressed in the communication pursuant to Article 15(1) RPBA 2020, namely that the main request fulfils the requirements of Articles 84 and 123(2) EPC, the ground for opposition under Article 100(b) EPC does not prejudice the maintenance of the patent, and that the case should be remitted to the opposition division for further prosecution. Since both parties withdrew their request for oral proceedings on this condition, the Board cancelled the oral proceedings and took a decision in written proceedings. Accordingly, this decision takes into consideration all the written submissions of the parties, including the additional remarks on the main request submitted by the respondent on 10 November 2020.

2. Main request

The main request of the appellant filed with the statement of grounds of appeal is identical to the main request underlying the appealed decision and as such is part of the appeal proceedings.

3. Claim 1 - Added subject-matter - Article 123(2) EPC

The subject-matter of claim 1 does not extend beyond the content of the application as originally filed.

- 3.1 The introduction of the feature of the cartridge body "having a mouth end (315) and an opposing engaging end (310)" as well as "the inhalable substance medium having a first end (353) that is attached to the mouth end (315) of the cartridge body (300) and having a second, segmented end (354) that is attached to the engaging end (310) of the cartridge body (300)" is based on page 21, lines 15-19 and page 32, lines 24-32 of the application as originally filed.
- 3.2 The respondent is of the opinion that the application as originally filed only discloses a segmented end that is flared with spaces between the segments. Accordingly, the introduction of the "second, segmented end (354)" in isolation leads to an unallowable intermediate generalisation.
- 3.3 The Board judges differently. While in the figures all the inhalable substance mediums have a segmented flared end with spaces between the segments, this feature is described as optional on page 32, line 33 - page 33, line 11. Moreover, the following paragraph, page 33, lines 12-17, discloses other means for allowing air flow into the annular space, namely the use of a ferrule with perforation in the ferrule and/or a portion of the inhalable substance medium near the ferrule. Alternatively, the cartridge (and optionally the overwrap when present) may include apertures or perforation that allow air flow directly in the annular space.
- 3.4 In addition, the respondent refers to paragraph [0080] of the granted patent (page 32, lines 30-32 of the application as filed) disclosing: *"the segmented end being the point of attachment to the engaging end 310 of the cartridge body 305"*. This passage would imply

that the second segmented end is directly attached to the engaging end of the cartridge body. This feature has been omitted in claim 1 of the main request. This results in a further unallowable intermediate generalisation.

- 3.5 The Board does not agree with this argument either and judges that the feature *"the segmented end being the point of attachment to the engaging end 310 of the cartridge body 305"* is implicit from the wording of claim 1: *"a second, segmented end (354) that is attached to the engaging end (310) of the cartridge body (300)"*. Furthermore, both the wording of claim 1 and the wording of the description cover a direct and indirect attachment. There is no disclosure that the attachment should only be direct, neither in the description nor in the claim.
- 3.6 Furthermore the respondent is of the opinion that paragraph [0080] of the patent (page 32, line 35 - page 33, line 11 of the application as filed), which is the basis for the introduction of the "segmented end" of the inhalable substance medium, requires that the heating member is attached to a projection positioned inside a central cavity of the tubular inhalable substance medium. The respondent further explains that the specific segmented and flared arrangement described in paragraph [0080] provides a lead in for the projection and heating member as it is inserted into the central cavity of the tubular inhalable substance medium.
- 3.7 The Board disagrees with the above as well, because the heating member attached to a projection positioned inside a central cavity of the tubular inhalable substance medium is not structurally and functionally

linked to the segmented end of the tubular inhalable substance medium. There is also no disclosure in paragraph [0080] of the segmented end providing a lead in for the projection as alleged by the respondent.

3.8 The respondent is of the opinion that the first end of the inhalable substance medium being attached to a frame member 360, providing an indirect attachment to the mouth, must be included in claim 1 as no other ways of attachment are disclosed in the application as filed.

3.9 According to page 21, lines 18-24, of the application as filed, in particular the following disclosure, "*The inhalable substance medium particularly may be attached to the cartridge body at the respective terminal ends of each component. Such attachment may be direct or indirect*", the use of a frame member to attach the first end of the inhalable substance medium and the first end of the cartridge body is optional. Therefore, the use of a frame member and the indirect attachment is a possible embodiment as depicted on figure 4, but not the only possible one. Generalising the specific attachment depicted on figure 4 thus does not confront the skilled person with new technical information, which was not contained in the original application documents.

3.10 Finally, citing decisions T 0284/94 sections 2.1.2 to 2.1.4 and T 0017/86 point 2.3, the respondent further argues that the features added to claim 1 do not define all the means necessary for achieving the object of the amended claim. In other words that the feature of a second segmented end does not facilitate "*one or more of the following: tensioning of the inhalable substance medium within the cartridge body; configuration of the*

tubular inhalable substance medium to have a diameter that is less than the diameter of the tubular cartridge body; and provision for passage of air through the annular space defined by the outer surface of the wall of the inhalable substance medium and the inner surface of the wall of the cartridge body", according to page 33, lines 2-7 of the application as filed and hence contravenes Article 123(2) EPC.

- 3.11 The Board does not agree. Firstly it is to be noted that the above cited passage starts with *"Such segmented and (optionally) flared arrangement facilitates one or more of the following:"* such that the flared end being a non-mandatory feature is again emphasised. Secondly, the introduction in claim 1 of *"the inhalable substance medium having a first end (353) that is attached to the mouth end (315) of the cartridge body (300) and having a second, segmented end (354) that is attached to the engaging end (310) of the cartridge body (300)"* enables the tensioning of the inhalable substance medium within the cartridge body. Thirdly, the two other described objects: the tubular inhalable substance medium having a diameter that is less than the diameter of the tubular cartridge body and the provision for passage of air through the annular space defined by the outer surface of the wall of the inhalable substance medium and the inner surface of the wall of the cartridge body, are enabled. The application discloses various ways to arrive to such an object, via a segmented flared end with space between the segments as exemplified in the figures of the application, but also using a perforated ferrule (page 33, lines 12-17 of the application as filed). Therefore, the segmented end being flared and the provision of one or more openings are not essential. A generalisation is in this case possible without

presenting the skilled person with new technical information which was not contained in the original application documents.

4. Main request - sufficiency of disclosure - Article 100(b) EPC

The subject-matter of claim 1 is disclosed in a manner sufficiently clear and complete for a person skilled in the art to carry out the invention.

4.1 The respondent is of the opinion that there is no sufficiently clear and complete description of an arrangement in which there is a segmented second end that is not flared and does not have air openings between each pair of adjacent segments.

4.2 Claim 1 covers an inhalable substance medium having a second segmented end. Claim 1 does not require that the segmented end is flared. Thus, according to claim 1 the second segmented end can be of any shape, straight or flared. The figures show a flared segmented end such that this embodiment can undoubtedly be reproduced by the skilled person. While no figure shows the segmented end not flared, the flared segmented end is only optional according to paragraph [0080] of the patent. If the segmented end is not flared then according to paragraph [0081] of the patent, a ferrule can be used and the inhalable substance medium near the ferrule or the ferrule itself may be perforated.

Furthermore, the broad interpretation of the "segmented end" (see the discussion on clarity herein below) does not render the claim insufficiently disclosed. On the contrary it is common general knowledge to provide segmented ends, in the sense of being divided into

portions. No specific knowledge is required beyond common general knowledge to carry out the invention.

4.3 Similarly, the subject-matter of claims 13 and 18 as well as the subject-matter of claim 16 are disclosed in a manner sufficiently clear and complete for a person skilled in the art to carry out the invention.

4.3.1 The respondent is of the opinion that while claims 13 and 18 define *"a puff actuated controller that automatically indexes the cartridge body past the projection segment"*, no such arrangement is illustrated in the figures, and paragraph [0091] of the patent describes a desired function rather than the structure required to achieve that function. In relation to an automatic indexing mechanism there is no structure described nor any detail of how the automatic indexing system could be incorporated into any of the described embodiments.

4.3.2 The Board does not agree with the above. Regarding claims 13 and 18, paragraph [0092] discloses that *"the article may include a switch 280 in the control segment 205 of the control housing 200 that is sensitive either to pressure changes or air flow changes as the consumer draws on the article (i.e., a puff actuated switch)"*. Paragraph [0092] then discloses various puff actuated switches that can be used. Paragraph [0096] further gives guidance on how puff actuation of the heating and puff actuation of the movement of the cartridge through the receiving chamber may be achieved. With this information, the skilled person is able to carry out the invention.

4.3.3 The respondent is of the opinion that claim 16 (dependent on claim 15) requiring only a segment of the

electrical heating member to be heated is in contradiction with claim 15, requiring that the entire length of the heating member be heated. The respondent concludes that the invention defined by claim 16 is not described in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

- 4.3.4 The objection based on claim 16 is rather a clarity objection which has not been triggered by amendments of the granted patent and cannot be examined according to G3/14.

It is further to be noted that both dependent claims 15 and 16 comprise optional features. In claim 15, the feature: *"particularly wherein the electrical heating member is present within the cartridge body along a segment that is about 75% to about 100% the length of the inhalable substance medium"* and in claim 16 the feature: *"particularly wherein the segment of the electrical heating member that is in electrical connection with the electrical leads of the projection encompasses about 5% to about 50% of the length of the inhalable subject medium"* are optional such that the two claims do not contradict each other. Hence the invention defined in claim 16 can be carried out by a person skilled in the art.

5. Main request - Clarity - Article 84 EPC

The subject-matter of claim 1 is clear.

- 5.1 The respondent is of the opinion that claim 1 of the main request states that the inhalable substance has a second, "segmented end". However, it is not clear how the "segmented end" relates to the "at least a segment"

of claim 1. And while it is not clear what "segmented" means in this context, it is this feature of claim 1 that the proprietor alleges distinguishes claim 1 from the prior art and provides a technical effect.

- 5.2 The Board does not agree. Claim 1 first refers to "a second segmented end (354)" of the inhalable substance medium and second to "at least a segment of the inhalable substance medium" which are different. The use of the undefined article in "at least a segment of the inhalable substance medium" shows that reference is not made to the "segmented end" earlier defined in the claim, but to a portion of the inhalable substance which is heated.

In claim 1 the words "segmented" in the expression "a segmented end" and "segment" in the expression "at least a segment of the inhalable substance medium" should be given a consistent interpretation. The term "segment" can be given the meaning of "portion" and the term "segmented" can be given the meaning of "divided into portions". The segmented end of the inhalable substance medium does not require a physical cut of its end. The opposition division's interpretation based on paragraph [0080] of the patent is too narrow.

- 5.3 The respondent is further of the opinion that claim 1 is missing essential features. The segmented end of the inhalable substance medium on its own does not enable any of the object cited in paragraph [0080] of the patent. Only the specific flared arrangement of the inhalable substance medium depicted in the drawings can enable the above-mentioned objects.

- 5.4 The Board does not recognise any essential features missing; in particular the flared end is not an

essential feature of the invention. Firstly because it has been disclosed as optional (see paragraph [0080]) and secondly because it is not necessary to include all details of the invention in the independent claim. A certain degree of generalisation of the claimed features may be permitted, provided that the claimed generalised features as a whole allow the problem to be solved. In this case a more specific definition of the features is not required because the tensioning is achieved with the features introduced into claim 1. Reference is also made to point 3.11 above, under added subject-matter, which deals with a related issue.

6. Main request - Remittal

Under Article 111(1) EPC the Board of Appeal may either decide on the appeal or remit the case to the department which was responsible for the decision appealed. Further, in accordance with Article 12(2) RPBA 2020, it is the primary object of the appeal proceedings to review the decision under appeal in a judicial manner, and in accordance with Article 11 RPBA 2020 the Board may remit the case to the department whose decision was appealed if there are special reasons for doing so.

In the present case, the opposition division decided only on the questions of clarity, sufficiency of disclosure and added subject-matter and did not consider the further issues of novelty and inventive step of the main request in view of D1 and D2. The opposition division mentioned these issues in section 15 of the decision, when dealing with the prima facie allowability of auxiliary request I (corresponding to auxiliary request B in appeal proceedings). However, the statement of the opposition division that the amendments *"add novelty and inventive step over the*

prior art and thus overcome objections regarding the requirements of Article 54 and 56 EPC" cannot be seen as a reasoned statement on novelty and inventive step which the board can review. In view of the above circumstances, the Board considers that special reasons exist for remittal of the case.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated