

**Internal distribution code:**

- (A) [ - ] Publication in OJ
- (B) [ - ] To Chairmen and Members
- (C) [ - ] To Chairmen
- (D) [ X ] No distribution

**Datasheet for the decision  
of 10 January 2024**

**Case Number:** T 1716/21 - 3.2.01

**Application Number:** 14784354.4

**Publication Number:** 3054798

**IPC:** A24F47/00

**Language of the proceedings:** EN

**Title of invention:**  
ELECTRONIC VAPOUR PROVISION SYSTEM

**Patent Proprietor:**  
Nicoventures Trading Limited

**Opponents:**  
Philip Morris Products S.A.  
JT International S.A.

**Headword:**

**Relevant legal provisions:**  
EPC Art. 54, 83, 100(a), 123(2), 111(1)  
RPBA 2020 Art. 11, 12(3), 12(5), 15(1)

**Keyword:**

Remittal - (no)  
Novelty - main request, first auxiliary request, second  
auxiliary request (no) - third auxiliary request (yes)  
Sufficiency of disclosure - (yes)  
Amendments - added subject-matter (no)  
Discretion not to admit submission - requirements of Art.  
12(3) RPBA 2020 met (no)

**Decisions cited:**

T 2773/18, G 0003/14, G 0001/03

**Catchword:**



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

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

Case Number: T 1716/21 - 3.2.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.01**  
**of 10 January 2024**

**Appellant:** Nicoventures Trading Limited  
(Patent Proprietor) Globe House  
1 Water Street  
London WC2R 3LA (GB)

**Representative:** D Young & Co LLP  
120 Holborn  
London EC1N 2DY (GB)

**Respondent:** Philip Morris Products S.A.  
(Opponent 1) Quai Jeanrenaud 3  
2000 Neuchâtel (CH)

**Representative:** HGF  
HGF Limited  
1 City Walk  
Leeds LS11 9DX (GB)

**Respondent:** JT International S.A.  
(Opponent 2) 8 rue Kazem Radjavi  
1202 Geneva (CH)

**Representative:** Karl, Christof  
Bardehle Pagenberg Partnerschaft mbB  
Patentanwälte, Rechtsanwälte  
Prinzregentenplatz 7  
81675 München (DE)

**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 16 July 2021  
revoking European patent No. 3054798 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman**            G. Pricolo  
**Members:**            A. Pieracci  
                              A. Jimenez

## **Summary of Facts and Submissions**

- I. An appeal was filed by the patent proprietor in the prescribed form and within the prescribed time limit against the decision of the opposition division to revoke the European patent No. 3 054 798.
- II. In preparation for the oral proceedings the Board communicated its preliminary assessment of the case with a communication pursuant to Article 15(1) RPBA.
- III. Oral proceedings before the Board took place on 10 January 2024. At the end of the oral proceedings the decision was announced.
- IV. The final requests of the patent proprietor (appellant) are:

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 on the basis of the set of claims according to the first to sixth auxiliary requests, wherein the auxiliary requests correspond to those filed in opposition proceedings and have been re-filed with the statement setting out the grounds of appeal.

The patent proprietor (appellant) also requested remittal of the case to the opposition division to discuss any issue not explicitly addressed in the appealed decision.

- V. The final requests of the opponents 1 and 2 (respondents 1 and 2) are:

that the appeal be dismissed.

VI. The following documents are referred to in the present decision:

D1: GB 2507104 A1;  
D2: WO 2014/054035 A1;  
D3: DE 10 2009 029 768 A1;  
D15: WO 2014/060269 A2.

VII. The arguments of the parties are dealt with in detail in the reasons of the decision.

VIII. Claim 1 of the patent as granted (main request) reads as follows (features designation according to the decision of the opposition division):

"(a) An electronic vapour provision system (10) including:  
(b) a pressure drop or air flow sensor (62) for monitoring inhalation by a user through the electronic vapour provision system; and  
(c) a control unit (55) for detecting the start and end of inhalation based on readings from the sensor; and characterised in that the control unit is configured to:  
(c1) detect (405) the start of inhalation when the sensor reading departs by more than a first threshold from a previous reading; and  
(c2) detect (420) the end of inhalation when the sensor reading departs by less than a second threshold from the previous reading;  
(c3) wherein the first threshold is greater than the second threshold".

IX. Claim 1 of the patent as amended according to the first and the second auxiliary request is identical to claim 1 as granted.

X. Claim 1 as amended according to the third auxiliary request corresponds to claim 1 of the patent as granted with the addition of the following feature:

"wherein the previous reading comprises an ambient value which is updated on a periodic basis".

XI. Claim 13 as amended according to the third auxiliary request reads as follow (addition with respect to independent claim 14 of the patent as granted being underlined by the Board):

"A method of operating an electronic vapour provision system comprising a control unit and a pressure drop or airflow sensor, the method comprising:

monitoring inhalation by a user through the electronic vapour provision system using the pressure drop or air flow sensor;

and characterised by:

detecting (405) by the control unit the start of inhalation when the sensor reading departs by more than a first threshold from a previous reading; and

detecting (420) by the control unit the end of inhalation when the sensor reading departs by less than a second threshold from the previous reading, wherein the first threshold is greater than the second

threshold, wherein the previous reading comprises an ambient value which is updated on a periodic basis."

## Reasons for the Decision

1. Remittal of the case to the opposition division for deciding on novelty of the subject-matter of claim 1 in view of D3
  - 1.1 The patent proprietor requested the remittal of the case to the opposition division for deciding on the objection of lack of novelty in view of D3.
  - 1.2 The patent proprietor argued that, since according to Article 12(2) RPBA the primary object of the appeal proceedings is the judicial review of the decision under appeal, the absence of a decision of the opposition division on novelty in view of D3 constitutes special reasons in the sense of Article 11 RPBA for remitting the case to the opposition division. The remittal would also allow to have the case dealt by two instances.

According to the Case Law, so the patent proprietor, there are situations, such as the one in T1265/15, in which the Board has remitted the case to the first instance for dealing with documents which were in the proceedings but for a different ground.
  - 1.3 The Boards notes that it is settled case law that there is no absolute right to two instances (see the Case Law of the Boards of Appeal, 10th edition 2022, V.A.9.2.1) and that if all the issues can be decided without undue burden, the Board should normally not remit the case (see explanatory remarks on Article 11 RPBA 2020 in Supplementary publication 2, OJ 2020, page 54).
  - 1.4 The Board considers that in the present case the issue of novelty with respect to document D3 can be decided



without undue burden by the Board. Furthermore, novelty with respect to D3 has been an issue debated since the beginning of the opposition proceedings. All parties have provided their arguments in the appeal proceedings and the Board has given its preliminary opinion in its communication pursuant to Article 15(1) RPBA, to which the parties had opportunity to react. The Board thus considers it appropriate to exercise its discretion pursuant to Article 111(1) EPC in the sense of not remitting the case to the opposition division.

2. Novelty of the subject-matter of claim 1 of the patent as granted (main request) in view of document D1 (Article 100 (a) and 54 EPC)
  - 2.1 The patent proprietor contested the finding of the opposition division, which considered document D1 to disclose an embodiment according to the subject-matter of claim 1 and thereby found the priority of the patent in suit to be invalid and the subject-matter of claim 1 not novel in view of that same document (see appealed decision, point 23, pages 11 to 14).
  - 2.2 The patent proprietor argued (see the statement setting out the grounds of appeal, page 2, seventh paragraph) that the features (c1) and (c2) of claim 1, namely:  
  
(c1) detect the start of inhalation when the sensor reading departs by more than a first threshold from a previous reading; and  
  
(c2) detect the end of inhalation when the sensor reading departs by less than a second threshold from the previous reading;

are not directly and unambiguously derivable from document D1, page 11, lines 28 to page 12, line 3 and page 12, line 33 to page 13, line 17.

- 2.3 The patent proprietor argued that D1 although disclosing the comparison of the pressure signal from the pressure sensor with a first and a second threshold, does not directly and unambiguously disclose the comparison of the pressure signal with a previous reading (see page 3, second and third paragraph of the statement setting out the grounds of appeal).
- 2.4 The patent proprietor contested the finding of the opposition division that the passage of D1, page 13, lines 8 to 17, implies an explicit disclosure of a comparison between the measured pressure and the ambient pressure.

The patent proprietor argued that the fact that the above passage indicated by the opposition division stating that:

"the pressure change between the first threshold pressure and ambient pressure is greater than the pressure change between the second threshold pressure and ambient pressure"

describes only what is a direct consequence of the use of the sensor not implying anything more than a statement of facts, thus without unambiguously disclosing a comparison of the threshold values with a previous reading of the sensor.

- 2.5 The Board is not convinced by the arguments of the patent proprietor for the following reasons.

The Board concurs with the opponents that the person skilled in the art reading the claim in its broadest sensible technical interpretation would not consider the claimed subject-matter as necessarily requiring a **comparison** of the threshold values with a specific previous reading . What the claim language requires is that there is "a previous reading" and that the sensor reading departs by more than a first threshold, or by less than a second threshold, from said previous reading.

The Board also follows the argument of the opponents, that the passage at the bottom of page 11 of D1, indicating that:

"The computer 20 runs software that monitors the pressure signal from the pressure sensor 16..."

indicates a continuous monitoring of the pressure, so as to determine when a specific value of pressure is reached.

Values of pressure for which there is no flow are therefore also obtained when monitoring the sensor. The value associated to the absence of flow can be identified as a "previous value", i.e. a "previous reading", and the pressure interval given by the "first threshold pressure value" of document D1 (see page 13, lines 8 to 17) and the value associated to the condition of no flow corresponds to the threshold of feature c1 of claim 1 of the patent in suit.

In fact, as argued by the opponents, within a realistic interval of time in which the device of D1 is used, the value of the pressure corresponding to no flow does not change, so that also the pressure interval between this value and the "first threshold pressure value" of D1 during successive inhalations does not change but

remains constant as implicitly required by the term "threshold" in feature c1.

The Board consequently shares the view of the opponents that at least as a consequence of the broad interpretation of the claim, according to which a **comparison** between specific readings of the pressure sensor is not a requirement of the claim, feature c1 is directly and unambiguously derivable from document D1.

2.6 The same reasoning applies in an analogous way to the detection of the end of inhalation, so that also feature c2 is directly and unambiguously derivable from document D1.

2.7 The Board is thus not convinced that the opposition division erred in finding that the subject-matter of claim 1 of the patent in suit is not novel in view of D1.

2.8 In view of the above conclusion there is no need to address the objections of lack of novelty of claim 1 in view of documents D2 and D3.

3. Novelty of the subject-matter of claim 1 of auxiliary request 1 and 2 (Article 54 EPC)

Since claim 1 of auxiliary requests 1 and 2 is identical to claim 1 of the main request its subject-matter is also not new in view of D1.

4. Novelty of the subject-matter of claim 1 of auxiliary request 3 in view of document D1 (Article 54 EPC)

4.1 Claim 1 of auxiliary request 3 corresponds to claim 1 of the patent as granted with the addition of the

features of claim 2 as granted (corresponding respectively to claim 11 and 12 of the application as originally filed). In particular the following features have been added to claim 1:

"wherein the previous reading comprises an ambient value which is updated on a periodic basis".

4.2 The patent proprietor contests the argument of the opposition division (see point 27.2 of the appealed decision) that the added features are disclosed in D1 since:

"...the ambient value must be updated in order to obtain the actual ambient pressure value, i.e. each time the electronic cigarette is switched on. Moreover it is noted that the device of document D1 is said to work with a 'computer 20' and a 'software' (cf. page 11, line 34) which implies digital processing of the readings and signals and which intrinsically also provides a periodical update of the ambient value".

4.3 The Board concurs with the patent proprietor that the update "on a periodic basis" is understood by a person skilled in the art as meaning that the update takes place at fixed time intervals, which is not the case when an update takes place when the cigarette is switched on. Moreover the person skilled in the art understands the time interval claimed as being different from the internal time clock of the computer system used, since otherwise a continuous update and an update on a periodic basis would not be distinguishable.

4.4 The opponents argued similarly to the opposition division that since continuous pressure readings are

transmitted and received in the digital domain the feature of the "update on a periodic base" is implicitly disclosed by the use of the computer 20 of D1 (see the reply of opponent 1, page 17, point 5.2.2.1, and the reply of opponent 2, page 21 first paragraph).

The above arguments of the opponents are thus analogously not convincing.

- 4.5 Opponent 2 also argued that the ambient pressure needs to be periodically updated, i.e. the update is implicitly disclosed in document D1 (see the statement setting out the grounds of appeal, page 20, third to last paragraph).
- 4.6 This argument cannot be followed, since as found by the opposition division (see the appealed decision, page 15, point 27.2, first sentence), the update could also take place when switching on the cigarette, and thus not "on a periodic base".
- 4.7 The Board is thus convinced by the arguments of the patent proprietor that the opposition division erred in finding the subject-matter of claim 1 according to the third auxiliary request to lack novelty in view of D1.
5. Novelty of the subject-matter of claim 1 of auxiliary request 3 in view of document D2, D3 and D15 (Article 54 EPC)
- 5.1 The opponents argued lack of novelty in view of documents D2, D3 and D15 in relation to the added features in an analogous way as in view of D1, i.e. on the basis of the use of a computer for reading and transmitting the data from the sensor (see the reply of opponent 1, page 20, point 5.2.3.4, page 21, point

5.2.4.5; the reply of opponent 2, page 20, third paragraph to page 21 second paragraph and page 22, second to second last paragraph).

5.2 Analogously to what discussed above in relation to D1 these lines of argument cannot be followed and the Board, at least for this reason, concurs with the patent proprietor that none of documents D2, D3 and D15 deprives of novelty the subject-matter of claim 1.

6. Novelty of the subject-matter of claim 13 of the third auxiliary request (Article 54 EPC)

Since, as acknowledged by the parties, the combination of features of method claim 13 corresponds to that of claim 1, the subject-matter of claim 13 is also novel in view of D1, D2, D3 and D15.

7. Admittance into the proceedings of the objections of lack of inventive step of the subject-matter of claim 1 of auxiliary request 3

7.1 Opponent 1 (see the reply to the statement setting out the grounds of appeal, page 21, point 5.3.2) argued that if the subject-matter of claim 1 were deemed novel, then it would lack an inventive step in view of D3. But they suggested that a full submission would only be possible should a difference be identified by the Board between the claimed subject-matter and D3.

7.2 Opponent 2 (see the reply to the statement setting out the grounds of appeal, page 22, point II.) argued that if the subject-matter of claim 1 were deemed novel, then it would lack an inventive step over document D3 in combination with the common general knowledge "as outlined above", i.e. for the main request.

- 7.3 The Board concurs with the patent proprietor that the objections of the opponents are unsubstantiated since they do not indicate why the features added to claim 1 of the third auxiliary request would be derivable from the common general knowledge and be combined in an obvious way with the teaching of D3 to arrive at the claimed subject-matter.
- 7.4 The Board notes that the parties' complete case should be submitted either with the statement setting out the grounds of appeal or with the reply thereto (Article 12(3) RPBA) and that it is not up to the Board to provide indications to the parties on how to structure their case, as implicitly indicated by opponent 1. This would be contrary to a fair conduct of the proceedings.
- 7.5 The Board thus concurs with the patent proprietor that the opponents should have submitted a substantiated case on inventive step when filing their replies, and considers appropriate to make use of its discretion pursuant to Article 12(5) RPBA to the disadvantage of the opponents by not admitting their submissions on inventive step into the proceedings.
8. Added subject-matter of claim 13 of auxiliary request 3 (Article 123(2) EPC)
- 8.1 Opponent 1 (see the reply to the statement setting out the grounds of appeal, page 16, first paragraph to page 17 third paragraph) argues that the basis indicated by the patent proprietor with the reply to the notice of opposition for the amendments of claim 13 of auxiliary request 3, namely granted claims 1 and 2 and the passage on page 11, lines 23-25, namely:



"The first event is the expiry of the timer (535). In this case, the CPU updates the ambient pressure value (530) to match the most recent pressure reading, resets the timer (520), and repeats the process",

does not support the amendments to claim 13 since the granted claims cannot be considered as a valid basis for the amendments and the passage of the description indicated discloses in combination other features which have not been introduced into claim 13.

8.2 At the oral proceedings the patent proprietor referred to originally filed claims 11 and 12, as a basis for claim 13 of the third auxiliary request. This was contested by the opponents as being a late amendment of the patent proprietor's case.

8.3 It is true that in the statement setting out the grounds of appeal the patent proprietor only referred to granted claims 14 and 2 (see page 11, first paragraph) as a basis for claim 13 of the third auxiliary request.

However, since claim 14 as granted corresponds to claim 11 as filed with the functional features expressed in method steps and claim 2 as granted is identical to claim 12 as filed, the Board considers that at the oral proceedings the patent proprietor has only clarified, without changing the substance of its submissions, the basis for claim 13 already given with the statement setting out the grounds of appeal. This is not seen, under the specific circumstances of the present case, as resulting in any amendment of the patent proprietor's case.

The objection of the opponents to the admittance of the arguments of the patent proprietor on Article 123(2) EPC is thus dismissed.

- 8.4 The Board considers that claims 11 and 12 of the application as originally filed do indeed provide the basis for claim 13 of the third auxiliary request, since the methods steps of claim 13 correspond to the functional features of claims 11 and 12 of the application as originally filed. This has not been contested by the opponents.
- 8.5 Since claims 11 and 12 of the application as originally filed provide a basis for claim 13, the objections of the opponents based on the passages of the description of the original application are not relevant and do not need to be addressed.
9. Sufficiency of disclosure (Article 83 EPC)
- 9.1 The opponents argued that their objections of sufficiency of disclosure to the main request also applied to all auxiliary request and thus also to auxiliary request 3 (see the reply of opponent 1, page 4, point 3.1.7).
- 9.2 The opponents (see the reply of opponent 1, point 3.1, page 4 and appendix A, and the reply of opponent 2, page 2 and 3, point I) contested the finding of the opposition division arguing that the invention is not sufficiently disclosed. The opponents, making reference to an illustrative example based on figure 3 of document D3 (see Appendix A of the reply of opponent 1) which had already been submitted in opposition proceedings (see the grounds of opposition of opponent 1, point 4, pages 24 to 28) argued that a plurality of "previous readings" exist for which the invention would not work, so that it cannot be put into practice over

the whole scope of the claims and it is thus not sufficiently disclosed.

- 9.3 The Board on the basis of the opponents' submissions sees no reason to deviate from the finding of the opposition division and concurs with the latter that although the expression "previous reading" might be interpreted broadly, the description of the patent in suit provides indications on how to choose the "previous reading" so as to carry out the invention (see page 10, point 22.3 a) of the appealed decision with reference to paragraphs [0049]-[0051] and figure 5a of the patent in suit).
- 9.4 Since no arguments have been submitted by the opponents to indicate why the finding of the opposition division in relation to the example they submitted based on figure 3 of D3 is not correct, the Board sees no reason not to concur with the opposition division that the example submitted does not put the sufficiency of the claimed invention into question (see page 10, last paragraph, of the appealed decision).
- 9.5 The Board also concurs with the opposition division that the issue of sufficiency based upon the feature of a "previous reading" is rather linked to a clarity issue which is however not to be dealt with in these proceedings (see page 11, third paragraph of the appealed decision and G3/14).
- 9.6 With respect to the argument that allegedly a plurality of "previous readings" exist for which the invention cannot be put into practice, the Board notes that as long as the skilled person upon consideration of the entire disclosure and of the common general knowledge can infer which embodiment will work and which will not

work, a claimed invention is sufficiently disclosed even if a broad construction of the claim might also encompass embodiments which do not work (see in particular T2773/18, Reasons, point 3.2, and similarly G1/03, Reasons, point 2.5.2, second sentence). As this is presently the case as outlined by the opposition division (see the appealed decision, page 10, last paragraph and page 11 first paragraph) also this objection of the opponents does not hold.

9.7 The Board is thus not convinced by the arguments of the opponents that the opposition division erred in finding that the claimed invention is sufficiently disclosed.

#### 10. Conclusions

The Board concludes that, contrary to what was decided by the opposition division, no admissibly raised objection stands against the maintenance of the patent as amended according to the third auxiliary request.

## Order

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

The decision under appeal is set aside.

The case is remitted to the opposition division with the order to maintain the patent as amended in the following version:

### Description:

Page 2 as filed during the oral proceeding,  
Pages 3 to 9 of the patent specification.

### Claims:

No. 1 to 13 according to the third auxiliary request filed with the statement of grounds of appeal.

### Figures:

1-7B of the patent specification.

The Registrar:

The Chairman:



A. Voyé

G. Pricolo

Decision electronically authenticated