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**Datasheet for the decision  
of 7 June 2024**

**Case Number:** T 0369/22 - 3.2.01

**Application Number:** 17170100.6

**Publication Number:** 3248481

**IPC:** A24F47/00

**Language of the proceedings:** EN

**Title of invention:**  
ELECTRONIC VAPOUR INHALERS

**Patent Proprietor:**  
JT International SA

**Opponents:**  
Philip Morris Products S.A.  
Nicoventures Trading Limited

**Headword:**

**Relevant legal provisions:**  
EPC Art. 76(1), 83, 84, 52(1), 56, 111(1), 123(2)  
RPBA 2020 Art. 12(3), 12(4), 12(6)  
RPBA Art. 13(2) (2007)

**Keyword:**

Divisional application - subject-matter extends beyond content of earlier application (yes) - subject-matter extends beyond content of earlier application (no) - after amendment  
Amendments - extension beyond the content of the divisional application as filed (no)  
Sufficiency of disclosure - (yes)  
Claims - clarity (yes)  
Inventive step - (yes)  
Amendment to case - basis for amendment indicated (yes) - amendment within meaning of Art. 12(4) RPBA 2020 - suitability of amendment to address issues (yes)  
Late-filed facts - admitted (yes)  
Late-filed objection - should have been submitted in first-instance proceedings (yes)  
Late-filed request - amendments after arrangement of oral proceedings  
Late-filed auxiliary requests - justification for late filing (no)

**Decisions cited:**

G 0002/10, T 1500/07, T 0211/95

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 0369/22 - 3.2.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.01**  
**of 7 June 2024**

**Appellant:**  
(Patent Proprietor)

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**Decision under appeal:**

**Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
13 December 2021 concerning maintenance of the  
European Patent No. 3248481 in amended form.**

**Composition of the Board:**

**Chairman**            G. Pricolo  
**Members:**            V. Vinci  
                              A. Jimenez

## **Summary of Facts and Submissions**

I. Appeals were filed by the patent proprietor and the opponents 1 and 2 against the interlocutory decision of the opposition division maintaining European patent No. 3 248 481 in amended form.

The opposition division found that the ground for opposition pursuant to Article 100(c) in association with Article 76(1) EPC was prejudicial to the maintenance of the patent as granted and decided to maintain the patent in amended form according to auxiliary request 1 filed at the oral proceedings. The subject-matter of independent claim 1 according to the auxiliary request 1 was found to comply with the requirements of Articles 52(1), 54 and 56 EPC in view of the following prior art:

D1: WO 95/27 411, 19 October 1995

D5: WO 94/06314, 31 March 1994

D6: GB 2504732 A, 12 February 2014

D7: GB 2504730 A, 12 February 2014

With their statement of grounds of appeal the appellant (opponent 2) filed following additional evidence:

D12: US 2008/0092912 A1

and requested that this prior art document be admitted into the appeal proceedings.

With a communication pursuant to Article 15(1) RPBA dated 14 March 2024 the Board informed the parties of its preliminary, non-binding assessment of the case.

Oral proceedings pursuant to Article 116 EPC were held before the Board on 7 June 2024 by videoconference.

- II. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained as granted, alternatively that the patent be maintained in amended form according to the auxiliary request 1 as maintained by the opposition division, or according to the auxiliary requests 2, 4, 8-12, 14, 18-23, 25, 29-32 as filed with the first letter dated 27 May 2024 or according to the auxiliary requests 3, 5, 6, 7, 13, 15-17, 24, 26-28 as filed with the second letter dated 27 May 2024.

The appellants (opponents 1 and 2 ) requested that the decision under appeal be set aside and that the patent be revoked.

- III. Independent claim 1 according to the patent as granted reads as follows (features labelled according to the decision under appeal):

1.1 *An electronic vapour inhaler (10,110) comprising:*

1.2 *a housing (12);*

1.3 *an induction heating arrangement (34) arranged to inductively heat an induction heatable element (28, 46, 62, 70, 90) of a cartridge (26, 44, 56, 60, 68, 84) or capsule inserted into the housing to heat a flavour-release medium (30, 54, 64, 78, 86) within the cartridge or capsule;*

1.4 *a control arrangement (20) which is arranged to energise the induction heating arrangement (34) to inductively heat the induction heatable element and*

*thereby heat the flavour-release medium*

*1.5 the control arrangement (20) being further arranged to recognise an inserted capsule or cartridge by detecting a characteristic of the induction heatable element and to control the operation of the induction heating arrangement (34) based on the detected characteristic; characterized in that*

*1.6 the control arrangement (20) is arranged to detect a change in the electromagnetic field generated by the interaction between the induction heatable element and the induction heating arrangement during insertion of a capsule or cartridge into the housing.*

Independent claim 1 of the auxiliary request 1 corresponding to the version of the patent as maintained by the opposition division comprises following additional feature:

*1.2a "a mouthpiece (18) at one end of the housing (12)"*

Independent claim 1 of each one of the auxiliary requests 2 to 11 contains further limitations, but does not recite feature 1.2a added to claim 1 of the auxiliary request 1.

Compared to independent claim 1 according to the auxiliary request 1, independent claim 1 of the auxiliary request 12 is directed to an *"electronic cigarette"* and further specifies in its characterizing portion that:

*"the control arrangement (20) is configured to set automatically a heating profile upon recognition of the*

*capsule or cartridge."*

Compared to independent claim 1 according to the auxiliary request 1, independent claim 1 of the auxiliary request 13 further specifies in its characterizing portion that:

*"the control arrangement (20) is arranged to detect a change in the electromagnetic field that varies between different cartridges that have induction heatable elements of different lengths, thickness or shape, wherein the control arrangement (20) is configured to set automatically a heating profile upon recognition of the capsule or cartridge."*

Compared to independent claim 1 according to the auxiliary request 1, independent claim 1 of the auxiliary request 14 is directed to an *"electronic cigarette"* and further specifies in feature 1.4 of the preamble that the induction heatable element heats the flavour release medium

*"to produce a vapour for inhalation, wherein the flavour-release medium comprises tobacco or a tobacco material, the tobacco or the tobacco material being impregnated with a vapour-forming medium",*

and in the characterizing portion that

*"the control arrangement (20) is configured to set automatically a heating profile upon recognition of the capsule or cartridge".*



## Reasons for the Decision

### APPEAL OF THE PATENT PROPRIETOR

#### Main Request - Patent as Granted

#### Article 100(c) in association with Article 76(1) EPC

1. The ground for opposition pursuant to Article 100(c) in association with Article 76(1) EPC is prejudicial to the maintenance of the patent as granted as correctly stated in the decision under appeal.
- 1.1 The contested patent is based upon European patent application No. 17170100.6 filed as a divisional application of the parent European patent application No. 15798169.7 published as WO 2016/075436.
- 1.2 With their appeal the appellant (patent proprietor) contested the view of the opposition division that the omission in claim 1 of the patent as granted of the feature that the housing of the claimed electronic vapour inhaler comprised "*a mouthpiece at one end of the housing*", as recited in independent claim 36 that, in combination with dependent 38 of the original international parent application, formed the basis for claim 1 as granted, infringed Article 76(1) EPC. The appellant (patent proprietor) pointed out that, in analogy with the the assessment of compliance with the requirements of Article 123(2) EPC, compliance of the content of a divisional application with the requirements of Article 76(1) EPC had to be assessed by applying the so called "*gold standard*". Furthermore, it was put forward that according to established case law of the Boards of Appeal an European divisional application did not need to be limited to the same

subject-matter claimed in the parent application as filed to comply with the requirements of Article 76(1) EPC. The appellant (patent proprietor) further argued that a person skilled in the art realized that claim 1 as granted was directed specifically to the sixth aspect of the invention disclosed in the international parent application as filed, this aspect dealing only with the automatic detection of the type of cartridge inserted into the housing of an electronic vapour inhaler as clearly reflected in the feature combination recited in granted claim 1. The appellant (patent proprietor) was of the opinion that a person skilled in the art reading the international parent application as a whole directly and unambiguously derived that in the technical context of the sixth aspect of the originally disclosed invention the presence of the mouthpiece was merely incidental to the functionality of the control arrangement provided to detect the type of cartridge inserted into the housing of the inhaler, which was indeed the technical problem addressed by this specific aspect of the invention according to the contested patent. In view of all the above and according to established case law of the Boards of Appeal (reference was made to the conclusions of the decision T1500/07, Reasons 2.2 and 4.5 and T 0211/95, Reasons 4.3.3 and 4.4) the mouthpiece could be omitted in claim 1 as granted without infringing Article 76(1). In support of this conclusion, the appellant (patent proprietor) referred to the passage on page 13, lines 8-15 of the international parent application describing the control arrangement without mentioning the mouthpiece. Finally, the appellant (patent proprietor) drew the attention to the content of Figures 1 and 1A of the original international parent application showing that the mouthpiece was removably mounted either on a cover 25 closing the housing at one of its ends or was made

integral with said removable cover respectively. In their opinion, the removably arrangement of the mouthpiece with respect to the housing strengthened the perception of the person skilled in the art that this element of claimed electronic vapour inhaler was meant to be merely optional.

- 1.3 The Board is not convinced by the arguments brought forward by appellant (patent proprietor) and confirms the assessment of the opposition division for the following reasons:

It is uncontested that the combination of claims 36 and 38 of the originally filed international parent application provides the only available and substantially literal basis for the wording of claim 1 as granted. However, the mouthpiece feature which is recited in claim 36 of the international parent application is omitted in claim 1 as granted. The Board observes that the mouthpiece is present in both specific embodiments of the inhaler according to the contested patent shown in Figures 1 and 1a of the original parent application. Furthermore - as pointed out by the appellants (opponents 1 and 2) - the mouthpiece is listed on page 8 of the description of the international parent application as one of the features of the electronic vapour inhaler according to the sixth aspect of the invention. It is true that the passage on page 13, lines 8-15 of the description of the international parent application as filed referred to by the appellant (patent proprietor) and describing in details the control arrangement does not mention the mouthpiece. However, as correctly pointed out by the opposition division and the appellants (opponents 1 and 2), this passage must be read in connection with the previous passage on page 12, last paragraph, relating

to the same embodiment of Figure 1 and mentioning the mouthpiece which is indeed shown in this figure. Regarding the missing inextricable structural and functional technical link between the mouthpiece and the claimed control arrangement invoked by the appellant (patent proprietor) in support of the allowability of the omission of the mouthpiece in claim 1 as granted, the Board shares the view of the appellants (opponents 1 and 2) that this criterion is used to assess compliance with Articles 76(1) or 123(2) EPC of an intermediate generalisation of a specific embodiment presented in the originally filed description. This is not the case here because the amendment under discussion consists in the omission of a feature recited in an originally filed independent claims, this omission resulting in the granted independent claim being broader compared with the scope of the original independent claim. Regarding the jurisprudence cited by the appellant (patent proprietor) the Board - in agreement with the appellants (opponents 1 and 2) - observes that it is antecedent to the G2/10 setting the overriding criteria of the "*gold standard*" that has to be applied when assessing compliance with Articles 76(1) and 123(2) EPC, this criterion replacing the so-called "*three-point-test*". This jurisprudence is therefore obsolete in view of the conclusions of the G2/10 and therefore not relevant for the present case. Furthermore, as convincingly pointed out by the appellants (opponents 1 and 2), the cited T1500/07 and T0211/95 relate to situations where at least two ways to carry out the invention were explicitly presented in the originally filed parent application, while in the case at issue only one way is disclosed, namely an electronic vapour inhaler always provided with a mouthpiece. Finally, from the fact invoked by the appellant (patent

proprietor) that the mouthpiece is shown in the figures as being removable from the cover (Figure 1) or from the housing together with the cover (Figure 1A) it cannot be directly and unambiguously inferred that this feature can be omitted in claim 1 as granted without infringing Article 76(1) EPC. Otherwise, any removable component of an originally claimed device recited in an independent claim could be omitted without infringing Articles 76(1) or 123(2) EPC. This cannot of course always be the case. Therefore, in absence of any clear and unambiguous basis in the whole international parent application as originally filed for an electronic vapour inhaler deprived of the mouthpiece, the omission of this technical feature in claim 1 as granted results in non-compliance with the requirements of Article 76(1) EPC as correctly decided by the opposition division.

- 1.4 In conclusion and irrespective of the further issues raised by the appellants (opponents 1 and 2) against the subject-matter of claim 1 as granted, the decision of the opposition division that the main request is not allowable is to be confirmed.

#### **APPEALS OF THE OPPONENTS - PATENT AS MAINTAINED**

##### **Auxiliary Request 1**

2. The auxiliary request 1 filed in appeal corresponds to the version of the patent allowed by the opposition division. Independent claim 1 of this request has been amended with respect to independent claim 1 as granted by specifying that the electronic vapour inhaler comprises "*a mouthpiece (18) at one end of the housing (12)*". The appeals of the appellants (opponents 1 and 2) are directed against the interlocutory decision of

the opposition division maintaining the patent in this amended form.

Distinguishing features over D1

3. At the oral proceedings the appellants (opponents 1 and 2) did not longer contest the findings of the opposition division that the subject-matter of independent claim 1 according to the auxiliary request 1 was novel over D1 and acknowledged that the electronic vapour inhaler disclosed in this prior document did not comprise a *"mouthpiece at one end of the housing"* as required by feature 1.2a.

Therefore, novelty over D1 is no longer in dispute.

- 3.1 However, the appellant (patent proprietor) maintained that - contrary to the assessment of the opposition division - D1 did not directly and unambiguously disclose feature 1.6 of claim 1 according to which the control arrangement of the claimed electronic vapour inhaler was *"arranged to detect a change in the electromagnetic field generated by the interaction between the induction heatable element and the induction heating arrangement during insertion of a capsule or cartridge into the housing"* (emphasis added). The appellant (patent proprietor) referred to the passage on page 23, lines 10-12 of D1 also cited in the decision under appeal stating that *"The cigarette susceptor's impedance is monitored upon cigarette insertion into the lighter subsystem..."* (emphasis added). They contested the interpretation of the opposition division and the appellants (opponents 1 and 2) of the expression *"upon cigarette insertion"* as meaning *"during cigarette insertion"*. In the appellant's (patent proprietor's) opinion allegedly

supported by the meaning commonly and semantically associated to the term *"upon"*, the expression *"upon cigarette insertion"* was understood by a person skilled in the art as meaning *"at the end of the cigarette insertion"* or *"immediately after insertion of the cigarette has been completed"*, rather than as *"during insertion of the cigarette"* as instead required by feature 1.6 of claim 1. The appellant (patent proprietor) observed that this interpretation was supported and confirmed by the information contained on page 23, line 12 onwards of D1 describing that the monitoring of the reflected susceptor's impedance by the control arrangement monitoring was carried out with the aid of a lookup ROM table expressing the correspondence between several burst current frequencies and values of the impedance of different cartridge types stored therein. It was alleged that the use of a lookup ROM table in the monitoring process of D1 implied that only one variable was taken into account, namely the applied frequency of the burst current applied, whereby the position of the susceptors during insertion was not detected and hence disregarded. In fact, the disclosed lookup ROM table would not make any sense if also the instant position of the susceptor during insertion was taken into account as a variable. In the appellant's (patent proprietor's) opinion, the use of the expression *"upon insertion"* in D1 as meaning *"after insertion"* was also confirmed by the text in the third full paragraph on page 21 as well as by the wording of claim 22 according to which the controller was responsive *"to a draw upon the smoking article"* read together with the wording of claim 24 reciting that *"said controller applies an initial alternating magnetic field to an intended location of the susceptor material"*, wherein said intended location could only indicate the final

location of the susceptor within the housing after full insertion.

3.2 The interpretation of the technical content of D1 proposed by the appellant (patent proprietor) is not convincing. The Board shares the view of the opposition division and the appellants (opponents 1 and 2) that the cited passages of D1 must be read as meaning that the detection ("*monitoring*" in the language of D1) of a change in the electromagnetic field generated by the interaction between the induction heatable element located in the cartridge ("*susceptor*") and the induction heating arrangement takes place during the insertion of the cartridge into the housing and not only when the cartridge reaches its final stationary position within the housing. The reasons are as follows:

The Board follows the interpretation of claim 1 provided by the appellant (opponent 1) according to which feature 1.6 only requires that the control arrangement detects a change in the electromagnetic field generated by the interaction between the induction heatable element and the induction heating arrangement during insertion of the cartridge into the housing, i.e. in an interval of time starting at the point in time where the cartridge is moved into the housing and ending at the point in time where the capsule has reached its final and stationary position. Feature 1.6 does not require recognition of the cartridge at this stage, but only detection of the magnitude of the perturbation of the magnetic field during insertion. In fact, according to feature 1.5 of claim 1, recognition takes place only after insertion of the cartridge ("*..to recognise an inserted capsule..*") and on the basis of the detected



perturbation of the magnetic field. This is exactly the way how also the controller of D1 operates. The Board takes the view that the term "*monitoring*" when referred to a certain parameter characterizing or governing an ongoing process inherently implies that changes of magnitude of said parameter are detected, be continuously or intermittently, during a certain period of time. The interpretation provided by the appellant (patent proprietor) of the cited passage on page 23, lines 10-12 of D1 as meaning that the reflected impedance of the susceptor is monitored by the controller only after full insertion of the cartridge in the housing and hence only at the point in time where the cartridge has reached its final fully inserted position in the housing is not consistent with the commonly accepted meaning of the term "*monitoring*" given above. Regarding the alleged technical implications of the use of a lookup ROM table in respect of the way how the controller of D1 operates, the Board shares the argument of the appellant (opponent 2) that as no details regarding the structure and content of the lookup ROM table are provided in D1, the conclusion of the appellant (patent proprietor) inferred from the use of a lookup ROM table that the monitoring of the reflected impedance carried out by the controller of D1 took place only after fully insertion of the cartridge into the housing is based on mere speculations. Furthermore, the view of the opposition division and the appellants (opponents 1 and 2) that the term "*upon*" in the cited passage on page 23 of D1 is used in the technical context of this prior art document as a synonym for "*during*" rather than for "*after*" is confirmed by the text of the last lines of page 2 stating that "*the cigarette may be prone to break or leave pieces upon its withdrawal from the lighter*". Here the term "*upon*" can only mean "*on*"

*withdrawing*" or *"during withdrawing"* because the cigarette can only break in pieces while being removed and not after it has been completely removed. In addition, on page 12 of D1 , line 9 from the bottom it is explained that *"the induction heating sources should not be damaged upon insertion, adjustment and removal of the cigarettes"*. From this statement the person skilled in the art also derives that the expression *"upon insertion, adjustment and removal"* is indeed used here to mean *"during insertion, adjustment and removal"* of the cartridge rather than *"immediately after insertion, adjustment and removal"* of the cartridge as instead asserted by the appellant (patent proprietor). In fact, no damage can occur after the cigarette has been fully inserted, adjusted and removed if it did not already occur in the course of these actions. Furthermore, the Board follows the view of the appellants (opponents 1 and 2) that the teaching in claim 22 that *"the controller is responsive to a draw upon the smoking article"* merely relates to the delivery of the full current power triggered by the puff of the user and not to the delivery of the burst current by the controller. Finally, the expression *"intended location of the susceptor material"* in claim 24 does not necessarily indicate the final position of the cartridge into the housing, but rather the space within the housing crossed by the cartridge during its insertion and in which the cartridge is located after having been fully inserted. Therefore document D1 also directly and unambiguously discloses feature 1.6 of claim 1 as maintained as correctly assessed by the opposition division.

- 3.3 The Board thus confirms the view of the opposition division that the subject-matter of claim 1 of the patent as maintained only differs from document D1 in

the provision of a mouthpiece at one end of the housing according to feature 1.2a.

Admissibility of document D12

4. The admittance into the appeal proceedings of document D12 filed for the first time by the appellant (opponent 2) with their statement of grounds of appeal was contested by the appellant (patent proprietor). They pointed out that the appellants (opponents 1 and 2) in their notices of opposition as well as in the following submissions had extensively and repeatedly argued that the mouthpiece was an essential feature of the electronic vapour inhaler according to claim 1 which therefore could not be omitted without infringing Article 76(1) EPC. The appellant (patent proprietor) argued that the introduction of the mouthpiece in independent claim 1 and its implications for the assessment of inventive step were well predictable for the appellants (opponents 1 and 2) already before opposition oral proceedings. Under these circumstance it was not justified to withhold this piece of prior art until the appeal proceedings. The appellant (patent proprietor) was thus of the opinion that document D12 could and should have been filed during the proceedings before the opposition division and therefore that it should not be admitted into the appeal proceedings.

- 4.1 The Board does not follow the arguments of the appellant (patent proprietor):

As it results from the written submissions of the appellants (opponents 1 and 2) before the department of first instance the objection under Article 76(1) EPC raised in view of the omission of the mouthpiece in independent claim 1 was indeed already present in their

notices of oppositions and dealt with and followed by the opposition division in its preliminary opinion issued in preparation for oral proceedings. However, despite the unfavourable provisional assessment of the objection under Article 76(1) EPC by the opposition division, the appellant (patent proprietor) decided to maintain their position regarding this issue and to file in preparation for oral proceedings a new set of amended auxiliary requests without introducing the mouthpiece in any of the amended independent claims. The submission of an amended auxiliary request introducing the mouthpiece in claim 1 was withheld until oral proceedings. The Board takes the view that the appellants (opponents 1 and 2) - in view of the procedural behaviour of the appellant (patent proprietor) - could not be expected to be prepared for any possible amendment to independent claim 1 including the introduction of the mouthpiece which was deemed not necessary by the appellant (patent proprietor) during the whole written opposition proceedings and despite the preliminary opinion of the opposition division. Under these circumstances, the Board finds that the submission of D12 with the statement of grounds of appeal of the appellant (opponent 2) represents a timely appropriate and justified reaction to the submission of the amended auxiliary request 1 at the oral proceedings, where the appellants (opponents 1 and 2) did not have the possibility to search for the newly claimed subject-matter and hence to react by submitting new evidence to support the objection of lack of inventive step. The appeal proceedings was indeed the first reasonable opportunity to do so. Furthermore, the Board notes that the technical content of document D12 is not complex to the extent that its introduction could negatively impact on procedural

economy.

- 4.2 For all these reasons the Board, in exercise of the discretionary power conferred to it by Article 12(4) and (6) RPBA, decided to admit document D12 into the appeal proceedings.

Request for Remittal

5. With their reply to the statements of grounds of appeal of the appellants, the appellant (patent proprietor) requested that the case be remitted to the opposition division for further prosecution should the Board decide to admit document D12 into the appeal proceedings. At the oral proceeding the appellant (patent proprietor) justified this request with the right of having their amended case examined at two level of jurisdiction. The appellants (opponents 1 and 2) considered the remittal of the case not justified because the objection of lack inventive step of the subject-matter claim 1 according to the auxiliary request 1 was already decided upon by the opposition division. Furthermore, the contribution of document D12 to the discussion on inventive step was extensively discussed by the parties in their written submission. Finally they pointed out that a remittal of the case because of the introduction of a single and non-complex prior art document which was on file from the beginning of the appeal proceedings was clearly against procedural economy.

- 5.1 The Board observed that - contrary to the appellant's (patent proprietor's) opinion and according to settled case law of the Boards of Appeal - the parties have no absolute right to have each and every matter examined at two instances. On the contrary, pursuant to Article

111(1) EPC, a board has the discretion to exercise any power within the competence of the department which was responsible for the decision appealed. Taking into account that the objection of lack of inventive step of the subject-matter of claim 1 of the auxiliary request 1 in view of D1 in combination with D12 have been indeed extensively discussed by the parties in their written submissions, the Board see no "*special reasons*" within the meaning of Article 11 RPBA to remit the case to the opposition division for further prosecution.

Articles 52(1) and 56 EPC - Inventive Step

6. Contrary to the findings of the opposition division the subject-matter of claim 1 of the patent as maintained is rendered obvious by the prior art.

6.1 As stated under points 3.2 and 3.3 above, the inhaler according to claim 1 of the patent as maintained only differs from the inhaler of document D1 in that it comprises

*"a mouthpiece arranged at one end of the housing".*

6.2 The Board shares the definition of the technical problem addressed by the contested patent as maintained proposed by the appellants (opponents 1 and 2) namely - starting from D1 - to provide an alternative to the filter portion of the consumable cigarette positioned in the housing of the known inhaler enabling the user to take the puff. The appellants (opponents 1 and 2) convincingly argued in this respect that since no particular structural feature of the mouthpiece was defined in claim 1, no particular or synergistic effect resulted from the introduction of this additional component into the inhaler of D1 a part the that an

alternative way to inhale the vapour was provided for the user.

6.3 The appellants (opponents 1 and 2) drew the attention to the inhaler shown in Figure 3 of D12 that - similarly to the inhaler of D1 - comprised an housing and a flavour-release medium consisting in a consumable cigarette inserted into the housing with its filter portion protruding therefrom (see housing 20, cigarette 150, filter plug 200 in Figure 3). It was observed that according to this embodiment, a mouthpiece 120 disposed at the end of the housing 20 and fully encircling the filter plug 200 of the cigarette 150 was additionally provided to enable the user to inhale the vapour. The appellants (opponents 1 and 2) argued that it was obvious for a person skilled in the art seeking for an alternative way enabling the user of the inhaler of D1 to take a puff to add a mouthpiece as suggested by D12 to the structurally identical electronic vapour inhaler of D1, thereby arriving without inventive step to the subject-matter of claim 1 of the patent as maintained.

6.4 The appellant (patent proprietor) replied that the inhaler of D12 - contrary of the inhaler of D1 - used a resistance heating arrangement mandatorily requiring a mouthpiece to safely isolate and protect the user mouth from the relatively high heat produced by this kind of heating arrangement. Since the induction heating arrangement used in the inhaler of D1 - in view of its inherent lower heat production and dispersion - did not require such an isolation, the person skilled in the art had no motivation to add a mouthpiece to the electronic vapour inhaler of D1 as suggested by the appellants (opponents 1 and 2). Furthermore, the appellant (patent proprietor) observed that the housing of the inhaler in Figures 1, 2 and 4 of D1 must have a

width comparatively larger than the housing of the inhaler of document D12, whereby this lateral mismatching rendered technically and ergonomically meaningless to add a correspondingly large mouthpiece at the end of the housing of D1. Finally, it was alleged that the connection of the mouthpiece to the housing of the inhaler of D12 was not compatible with the structure of the inhaler according to D1 to such an extent that non-obvious major modifications and adaptations would be required. For all these reasons the appellant (patent proprietor) was of the opinion that it could not be considered obvious for the person skilled in the art to isolate the mouthpiece from the different structural and functional context of the inhaler of D12 and to add it at the end of the housing of the inhaler of D1, said housing being merely implicit in the embodiments of Figures 1 and 2 and partially shown in the embodiment in Figures 4 and 5.

6.5 The arguments of the appellant ((patent proprietor) are not convincing:

The Board shares the view of the appellants (opponents 1 and 2) that D1 and D12 respectively suggest two alternative solutions enabling the user to take a puff from an electronic vapour inhaler, namely either by directly sucking on the filter portion of the cigarette as in D1 or by sucking on a mouthpiece secured at one end of the housing of the inhaler and fully encircling the filter of the cigarette. The Board is convinced that the person skilled in art promptly realizes that these solutions are fully interchangeable and can be chosen at will. The fact that the inhaler of D1 uses a different kind of heating arrangement does not prevent the person skilled in the art to use a mouthpiece to take the puff also in the inhaler of D1. Furthermore,



no lack of compatibility between the mouthpiece of the inhaler of D12 and the housing of the inhaler of D1 as shown in Figures 4 and 5 is apparent taking also into account that no details of the housing of the inhaler of D1 are disclosed. The Board also observes that contrary to the allegation of the appellant (patent proprietor), it is not necessary to use a mouthpiece dimensioned to match the lateral comparatively large dimension of the housing of the inhaler of D1. In fact, it is sufficient that the lateral dimension/diameter of the mouthpiece be dimensioned such as to merely encircle the cylindrical filter portion protruding from the housing. In conclusion, the Board does not see any reason why the person skilled starting from the inhaler of D1 and looking for an alternative solution enabling the user to take a puff should rule out the possibility to add to this known inhaler a mouthpiece. This implementation of the inhaler of D12 does not require any major modification or adaptation and is considered to be obvious for a person skilled in the art in view of the teaching of D12.

- 6.6 Therefore, irrespective of the further objections raised by the appellants (opponents 1 and 2) under Articles 76(1), 123(2), 83 and 84 EPC, the auxiliary request 1 is not allowable.

#### **Auxiliary Requests 2 to 11**

##### Article 76(1) EPC

7. Irrespective of their contested admissibility into the appeal proceedings, independent claim 1 of each one of these requests suffers from the same issue raised under Article 76(1) EPC against independent claim 1 of the patent as granted. This fact was acknowledged by the

appellant (patent proprietor) at the oral proceedings. Therefore, auxiliary requests 2 to 11 are not allowable for the same reasons presented in respect to the main request.

### **Auxiliary Requests 12 to 13**

#### Admissibility

8. Auxiliary requests 12 to 13 were filed in 2 separate sets on 27 May 2024 after notification of the communication issued by the Board under Article 15(1) RPBA. The admittance of these requests was contested by the appellants (opponents 1 and 2).

8.1 The appellants (opponents 1 and 2) put forward that the decision on the admissibility of these auxiliary requests must be taken by considering all the auxiliary requests filed by the appellant (patent proprietor) as a block and irrespective of whether some of them had been already filed with the statement of grounds of appeal and merely renumbered with the last submissions of the appellant (patent proprietor) dated 27 May 2024. That said, it was objected that the new set of auxiliary requests on file taken as a whole was not convergent and in any event unsubstantiated. Furthermore, it was pointed out that according to established case law of the Boards of Appeal also a mere reordering of the requests after notification of the communication of the Board pursuant Article 15(1) RPBA had still to be considered an amendment of the appeal case the admissibility of which was subjected to the strict criteria of Article 13(2) RPBA. Finally, it was criticized that the appellant (patent proprietor) was not able to indicate any exceptionally circumstance justified by cogent reasons for submitting the

auxiliary requests 12 and 13 at such a late stage of the appeal proceedings.

8.2 The appellant (patent proprietor) replied that all the new auxiliary requests and in particular the auxiliary requests 12 and 13 were a timely appropriate reaction to the preliminary opinion of the Board regarding in particular the non-relevance of documents D6 and D7 for the questions of novelty and inventive step and the envisaged admittance of document D12 into the appeal proceedings. Furthermore it was pointed out that feature had been deleted and not added in independent claim 1 of these auxiliary requests with respect to the requests filed with the statement of grounds of appeal. In the appellant's (patent proprietor's) view all the amendments introduced in view of the preliminary conclusions of the Board, including the renumbering of the requests, had merely the purpose of streamlining the appeal proceedings thereby enhancing procedural economy.

8.3 The Board notes that the auxiliary requests 12 and 13 are new requests which were not included in the set of auxiliary requests filed with the statement of grounds of appeal of the appellant (patent proprietor). The observation of the appellant (patent proprietor) that features had been merely deleted in the respective independent claim and not added does not change the fact that the submission of these new auxiliary requests represents an amendment of the patent proprietor's appeal case submitted after notification of the communication of the Board according to Article 15(2) RPBA the admittance of which is subjected to the discretion of the Board to be exercised under the strict criteria set forth in Article 13(2) RPBA. Finally, the Board points out that according to

established case law of the Boards of Appeal the provisional conclusions of the board expressed in a communication issued according to Article 15(1) RPBA invoked by the appellant (patent proprietor) are not considered "*exceptional circumstances justified by cogent reasons*" within the meaning of Article 13(2) RPBA.

- 8.4 As no convincing reasons for the late filing of the auxiliary requests 12 and 13 were provided by the appellant (patent proprietor) nor exceptional circumstances of the appeal proceedings justified by cogent reasons could be identified by the Board, auxiliary requests 12 and 13 were not admitted into the appeal proceedings under Article 13(2) RPBA.

#### **Auxiliary Request 14**

9. Auxiliary request 14 filed with the first submissions of 27 May 2024 is identical to the auxiliary request 18 filed with the statement of grounds of appeal of the appellant (patent proprietor) which is in turn based on the auxiliary request 5 underlying the decision under appeal wherein, in addition, the feature that the electronic cigarette comprises a mouthpiece at one end of the housing was introduced in claim 1. It is worth to notice that the auxiliary request request 14 combines the amendments introduced in the auxiliary requests 2 and 5 filed with the statement of grounds of appeal of the appellant (patent proprietor) as also acknowledged by the appellants (opponents 1 and 2) at the oral proceedings.

Admissibility

- 9.1 The appellants (opponents 1 and 2) objected to the admissibility of this request essentially for reasons of lack of substantiation and convergence and because it was not clearly suitable for overcoming all the issues raised. It was also maintained that the renumbering of this request introduced with the first submissions of 25 May 2024 resulting in a new ranking with respect to original ranking of the auxiliary request 18 filed with the statement of grounds of appeal was an amendment of the patent proprietor's appeal case the admittance of which was also subjected to the strict criteria of Article 13(2) RPBA.
- 9.2 The appellant (patent proprietor) conversely maintained the arguments raised in support of the admittance of the auxiliary requests 12 and 13 and additionally stressed that the auxiliary request 14 had been already filed with the statement of grounds of appeal as auxiliary request 18. Furthermore, sufficient substantiation within the meaning of Article 12(3) RPBA could be derived from the submissions made with their reply to the statements of grounds of appeal of the appellants (opponents 1 and 2) regarding the auxiliary requests 2 to 14 which according to point 17 of this reply also applied to the auxiliary requests 15 to 27 and 29 to 41 filed with the statement of grounds of appeal. Reference was made in particular to the substantiation of the auxiliary requests 2 and 5 the combination of which formed the basis for the auxiliary request 14 under examination.
- 9.3 The Board takes the view that in the present case where the set of auxiliary requests filed after the notification of the communication issued pursuant to

Article 15(1) RPBA also includes several auxiliary requests already filed with the statement of grounds of appeal of the appellant (patent proprietor), it is appropriate to assess admissibility by looking at the auxiliary requests individually. In view of this, the admissibility of the auxiliary request 14 which is identical (apart for the lower ranking) to the auxiliary request 18 filed with the statement of grounds of appeal is subjected to the discretion of the Board to be exercised according to the criteria set forth in Article 12(4) RPBA.

9.3.1 The Board observes that - contrary to the allegation of the appellants (opponents 1 and 2) that the appellant (patent proprietor) failed to clearly indicate the basis for the amendments introduced - the basis for the amendment of feature 1.1 ("*electronic cigarette*" instead of "*electronic vapour inhaler*") and feature 1.4 of claim 1 that now additionally specifies that the flavour-release medium is heated "*to produce a vapour for inhalation, wherein the flavour-release medium comprises tobacco or a tobacco material, the tobacco or the tobacco material being impregnated with a vapour-forming medium*" have been provided with the reply of the appellant (patent proprietor) dated 6 September 2022, namely in the paragraph bridging pages 53 and 54. Although this passage of the reply refers to the auxiliary request 2, it indeed indicates the basis for the same amendments in features 1.1 and 1.4 introduced in claim 1 of the auxiliary request 14.

9.3.2 Regarding the second amendment in claim 1 of the auxiliary request 14 consisting in the introduction of the further limitation that "*the control arrangement is configured to set automatically a heating profile upon recognition of the capsule or cartridge*", the Board

concurr with the appellant (patent proprietor) that the basis for this amendment are provided in the context of the discussion of auxiliary request 5 (see reply dated 6 September, pages 58 and 59) containing the same amendment. Furthermore, the Board sees in the passages of the reply of the appellant (patent proprietor) discussing the auxiliary request 2 and 5 sufficient substantiation as to why the amendments introduced in claim 1 of the auxiliary request 14 are suitable to overcome all the objections at issue.

9.3.3 Finally, as it will be discussed below, the amendments introduced in claim 1 successfully address all the objections at issue and this without negatively impacting on procedural economy.

9.4 For all these reasons the Board, in exercise of the discretionary power conferred to it by Article 12(4) RPBA, decided to admit the auxiliary request 14 into the appeal proceedings.

#### Remittal of the Case

10. Remittal of the case to the department of first instance was requested by the appellant (opponent 2) in the event that the Board intended to admit any of the auxiliary requests of the appellant (patent proprietor). This request was maintained at the oral proceedings. The appellant (opponent 1) expressed the view that the case should not be remitted. The appellant (patent proprietor) announced that they were not requesting the remittal of the case, but had nothing to object against it.

10.1 In view of the positions expressed by the parties at the oral proceedings and taking into account that all

the issues potentially affecting the auxiliary request 14 had been duly discussed in writing, the Board did not see any "*special reasons*" within the meaning of Article 11 RPBA to remit the case to the opposition division for further prosecution and thus decided to exercise any power within the competence of the first instance department to come to a complete assessment of the case (Article 111(1) EPC).

11. The appellants (opponents 1 and 2) maintained all their objections raised in writing under Articles 76(1), 83, 84 and 56 EPC against the auxiliary request 14.
12. The Board takes the view that the auxiliary request 14 complies with the requirements of Articles 76(1), 123(2), 83 and 84 EPC.

Article 76(1) and 123(2) EPC

- 12.1 Following issues raised under Articles 76(1) and 123(2) EPC regarding claim 1 of the auxiliary request 14 are under discussion. Some of them have been raised against the main and the auxiliary request 1 and analogously apply to the auxiliary request 14.

*Disclosure of Feature 1.1*

- 12.1.1 In their written submission the appellants (opponents 1 and 2) objected that there was no clear and unambiguous support either in the international parent application nor in the divisional application as filed for the electronic vapour inhaler being an "*electronic cigarette*" as now required by feature 1.1 of claim 1. The appellants (opponents 1 and 2) argued that this feature was presented only in relation to the



background prior art.

- 12.1.2 The Board does not agree and concurs with the appellant (patent proprietor) that page 10, line 26-28 of the international parent application corresponding to the text in paragraph [0049] of the A-Publication discloses that *"when tobacco or a tobacco material is used, the electronic vapour inhaler 10 can be used as an electronic cigarette"*. This passage thus clearly supports the replacement of *"electronic vapour inhaler"* by *"electronic cigarette"* in feature 1.1 taking also into account that the embodiment now covered by claim 1 is limited to an induction heating arrangement suitable for heating a flavour-release medium consisting of tobacco or tobacco material.

*Disclosure of Feature 1.2a*

- 12.2 Regarding this objection the parties at the oral proceedings referred to the arguments provided in writing and did not make any further submission. The Board has thus no reasons to deviate from its preliminary assessment of this issue as set out in the communication according to Article 15(1) RPBA which is herewith confirmed and reads as follow:
- 12.2.1 Claim 1 of the patent as maintained includes the additional feature that the inhaler comprises *"a mouthpiece at one end of the housing"*. The same feature is present in independent claim 1 of the auxiliary request 14. The opposition division came to the conclusion that the introduction of this feature in independent claim 1 overcame the objection raised against the patent as granted under Article 76(1) EPC. This conclusion was contested by the appellants (opponents 1 and 2). In this respect it was argued that

the wording introduced in claim 1 deviated from the wording of claim 36 of the originally filed parent application reciting "*a housing having a mouthpiece at one end*". In the appellants' (opponents' 1 and 2) view, the wording introduced in claim 1 encompassed possibilities not disclosed either in the international parent application nor in the divisional application as filed, this resulting in non-compliance with both Articles 76(1) and 123(2) EPC. The appellants (opponents 1 and 2) contested the view of the opposition division and the appellant (patent proprietor) that claim 28 could form a basis for the introduction of feature 1.2a in claim 1 because, although claim 28 contained the exact wording introduced in the independent claim 1, it related to a different combination of features compared to the combination of features now recited in independent claim 1.

12.2.2 The Board does not agree:

Irrespective of the question whether the wording of feature 1.2a introduces undisclosed information for a reader construing the claim with a mind willing to understand, what does not seem to be the case, the Board does not see why the person skilled in the art should be prevented from applying the arrangement of the mouthpiece as defined by the wording used in claim 28 of the originally filed parent application, which essentially corresponds to the wording of feature 1.2a, also to the embodiment covered by claims 36 and 38 of the parent application. Furthermore, the Board's takes the view that the arrangement of the mouthpiece resulting from the wording of feature 1.2a is clearly supported by the content of Figures 1 and 2.

*Tobacco or tobacco material as flavour-release medium*

12.3 The appellant (opponent 2) maintained that the feature introduced in claim 1 that *"the flavour-release medium comprises tobacco or a tobacco material, the tobacco or the tobacco material being impregnated with a vapour-forming medium"* resulted in an unallowable intermediate generalisation of the specific embodiment presented on page 10, lines 22-24 of the original international parent application and in the corresponding paragraph [0049] of the A-publication. It was objected that according to this specific embodiment the cartridge also comprised *"an elongate induction heatable element in the form of a rod"*, and that the flavour-release medium was a *"granulated or particulate material"* which *"adhered to the surface of the induction heatable element"*. The appellants (opponents 1 and 2) argued that as all these features were clearly intrinsically linked in the original international parent application and in the divisional application to the use of tobacco or tobacco material as flavour-release medium, their omission in claim 1 infringed Articles 76(1) and 123(2) EPC.

12.3.1 The Board does not agree:

The Board takes the view that from the wording of features 1.3 and 1.5 it results that the cartridge containing the induction heatable element and the flavour-release medium is not a feature of the electronic cigarette defined in claim 1, but only a component that can be used with it. Therefore, as the wording added in feature 1.4 of claim 1 does not limit its subject-matter it cannot even result in subject-matter that extends beyond the scope of the parent and divisional application as filed. In any event the

wording introduced in feature 1.4 of claim 1 essentially corresponds to the wording on page 10, lines 22-26 of the international parent application as filed and in paragraph [0049] of the divisional application, wherein the use of propylene glycol or glycerol is mentioned as a mere example ("*such as*"). The other features allegedly unallowably omitted in claim 1 are not present in this sentence.

*Automatic setting of the heating profile*

12.4 The appellant (opponent 2) pointed out that the feature introduced at the end of claim 1 was allegedly based on the information disclosed on page 8, lines 19-23 of the international parent application corresponding to paragraph [42] of the A-Publication. It was objected that this passage contained the additional requirement that the heating profile was set automatically upon recognition of a cartridge or capsule "*so that the flavour-release medium is heated in an optimum manner to release the flavour and aroma therefrom*". However this requirement was unallowably omitted in claim 1.

12.4.1 The Board does not agree and follows the view of the appellant (patent proprietor) that the missing wording only expresses a desirable technical effect which does not imply any further limitation in term of technical features. The omission of this wording does not thus add any undisclosed information infringing Article 76(1) or Article 123(2) EPC.

*Disclosure of features 1.5 and 1.6 in combination*

12.5 The appellant (opponent 2) objected that the limitations imposed by amended features 1.6 of independent claim 1 are based on paragraphs [42] and

[43] of the A-Publication and on the corresponding paragraphs of the original international parent application. However, they alleged that there was no direct and unambiguous disclosure both in the parent and divisional application as filed that the claimed functionalities of the controller to achieve detection of the change in the electromagnetic and to set automatically the heating profile were combined as now required by claim 1.

- 12.5.1 The Board does not agree and concurs with the appellant (patent proprietor) that there is no technical reason for the person skilled in the art reading the application as a whole and in the light of their common general knowledge ("*gold standard*" applies) to assume that these functionality should not be combined.

*Dependent claims*

- 12.6 With their statement of grounds of appeal the appellant (opponent 2) objected that there was no disclosure in both the parent and divisional application for the the additional features of independent claims 2 to 13 in combination with the features of amended claim 1.
- 12.7 However, the allegation of the appellant (opponent 2) was based on the assumption that the introduction of features 1.2a rendered claim 1 as amended non-compliant with the requirements of Articles 76(1) and 123(2) EPC (see point 12.2.1 above). As this assumption is not followed by the Board for the reason presented under point 12.2.2 above, the objection of the appellant (opponent 2) against the dependent claims of the auxiliary request 14 is moot.

Article 83 EPC: sufficiency of Disclosure

13. The auxiliary request 14 meets the requirements of Article 83 EPC.

13.1 With their statement of grounds of appeal the appellant (opponent 1) objected that the patent as maintained did not comply with the requirements of Article 83 EPC. This objection was maintained with respect to the auxiliary request 14.

13.2 In this respect the parties at the oral proceedings referred to the arguments provided in writing and did not make any further submission. The Board has thus no reasons to deviate from its preliminary assessment of this issue as set out in the communication according to Article 15(1) RPBA which is herewith confirmed and reads as follow:

13.3 The appellant (opponent 1) alleged that - contrary to the conclusions of the opposition division - there is no sufficient disclosure in the contested patent regarding:

(1) how a detection of a change in the electromagnetic field generated by the interaction between the induction heatable element and the induction heating arrangement during insertion of the cartridge could be achieved, and

(2) how this detection permitted to distinguish different types of cartridge inserted in the inhaler.

13.3.1 Regarding point (1) the appellant (opponent 1) argued that according to paragraphs [0054] to [0056] of the contested patent the inhaler was switched on only after

the cartridge was fully inserted into the housing of the inhaler. Accordingly, there was no electromagnetic field in place during insertion of the cartridge. Consequently the claimed detection of a change in the electromagnetic field during insertion of the cartridge was not possible because no electromagnetic field at all and hence no perturbation thereof was present during insertion of the cartridge.

13.3.2 The Board follows in this respect the argument of the appellant (patent proprietor) and of the opposition division that the cited paragraphs describe only one exemplary embodiment of the invention which focuses on the preliminary setting of the electronic vapour inhaler. From the following paragraph [0060] describing *"one possible implementation"* it is clear that detection starts *"as a cartridge is inserted into the chamber"* (emphasis added) and hence already during insertion of the cartridge as required by claim 1, i.e. not only after the insertion is completed as it might be the case according to the embodiments of paragraphs [0054] to [0056]. Therefore, the objection of the appellant (opponent 1) is not justified.

13.3.3 Regarding point (2), the appellant (opponent 1) essentially argued that when a cartridge was in the process of being inserted into the housing of the inhaler, it was not always possible to distinguish one cartridge type from another simply on the basis of the length of the susceptor provided within the cartridge. This because the interaction of the susceptor with the magnetic field generated by the induction heating arrangement did not only depend on the length of the susceptor, but also on the specific point of time of the insertion, i.e on the actual relative position of the susceptor within the magnetic field generated in

the cavity of the housing. The appellant (opponent 1) thus concluded that the patent was insufficiently disclosed at least because the invention could not be carried out across the entire range claimed, i.e. because recognition could not be achieved for any kind of cartridge.

- 13.4 The Board is not convinced and concurs with the appellant (patent proprietor) and the opposition division that, as stated in paragraph [0060], different and distinguishable electromagnetic field signatures can be associated to different cartridges by providing within the cartridges one or more induction heatable elements (susceptors) having not only different lengths, but also different thicknesses and shapes. The appellant (opponent 1) based their objection on the case where only the axial length of the induction heatable elements is different from one cartridge to another. However, in view of the possibility to characterize each specific induction heatable element by any combination of length, thickness and shape of the susceptor located therein as suggested in the paragraph [0060] of the contested patent, the Board concurs with the the opposition division and the appellant (patent proprietor) that a person skilled in the art is able to create a correlation between the specific combination of these geometrical parameters of a specific susceptor and a certain magnitude of the perturbation of the electromagnetic magnetic field generated by the induction heating element in such a way to recognize the type of cartridge which has been inserted. Furthermore, as explained by the appellant (patent proprietor), it would be also possible to monitor the changes in the magnetic field during the period of time in which the insertion takes place and not only at a single point of time (i.e. at a single



relative position of the susceptor within the housing), this enhancing the possibility to distinguish different types of cartridges even if their susceptors have the same length. The Board is thus convinced that the person skilled in the art is able to perform the invention essentially across the entire range encompassed by the claim taking into account that they are able to recognize and disregard technically meaningless and not functioning possibilities. The contrary has not been convincingly proved by the appellant (opponent 1) who carries the burden of proof when compliance with the requirements of Article 83 EPC is questioned.

Article 84 EPC: lack of clarity

14. The subject-matter of claim 1 of the auxiliary request 14 complies with the requirements of Article 84 EPC.

*Objection relating to feature 1.2A*

- 14.1 With their statement of grounds of appeal the appellant (opponent 2) maintained the lack of antecedent basis in claim 1 as maintained for the feature "*end of the housing*", i.e. that the housing had not been previously defined as having an end resulted in a lack of clarity. Furthermore and for the first time with their statement of grounds of appeal, the appellant (opponent 2) raised several new objections under Article 84 EPC also related to the wording of feature in 1.2a. The appellant (opponent 2) justified these new objections by explaining that the appeal proceedings was the first opportunity for them to study in detail claim 1 submitted during the oral proceedings and to detect possible clarity issues introduced by the amendments. The appellant (patent proprietor) requested not to

admit the new clarity objections and contested them also in the substance.

14.2 All the above clarity objections also apply to claim 1 of the auxiliary request 14. In this respect the parties referred at the oral proceedings to their written submissions and did not make any further submission. Consequently, the Board has no reasons to deviate from the assessment of these alleged clarity issue and, when applicable, of their admissibility into the appeal proceedings as presented in its preliminary opinion that is herewith confirmed and that reads as follows:

14.2.1 The Board concurs with the opposition division that the objected lack of antecedent basis in claim 1 allegedly affecting the feature "*end of the housing*" is of a mere formal nature and does not amount to a lack of clarity. In fact, as convincingly explained in the decision under appeal, it is not necessary to previously define that the housing has an end since this is already implicit in the wording "*a mouthpiece at one end of the housing*".

14.2.2 Regarding the new clarity objections, the Board observes that the introduction of feature 1.2a was the only amendment introduced at the oral proceedings. This amendment is not considered complex and unexpected, but represents a straightforward and predictable reaction to the objection under Article 76(1) EPC which was on file from the beginning of the opposition proceedings. Therefore, the Board cannot follow the view of appellant (opponent 2) that it was not possible for them to sufficiently study this simple amendment and to detect and object further potential clarity issues related thereto already during the oral proceedings.

Therefore, the Board decided to exercise the discretion conferred to it by Article 12(4) RPBA and not to admit the new clarity objections into the appeal proceedings because they could and should have been raised during the first instance oral proceedings (Article 12(6) RPBA).

*Clarity objection relating to the additional amendments in claim 1 of the auxiliary request 14*

- 14.3 The appellant (opponent 1) argued that a lack of clarity resulted from the fact that it was not clear what the difference between "tobacco" and "tobacco material" recited in feature 1.4 actually was. It was pointed out that the description did not provide any explanation regarding the technical difference implied by these terms. Furthermore, the appellants (opponents 1 and 2) argued that the specific flavour-release medium now recited in claim 1 did not impose any clear and unambiguous limitation to the claimed electronic cigarette and in particular to its control arrangement. In this respect it was pointed out that the cartridge and hence the flavour-release medium contained therein were not part of the subject-matter of claim 1 as clearly resulted from claim 2 which defined for the first time the combination electronic cigarette - cartridge. In the appellant's (opponent's 1 and 2) view the fact that no clear limitation was imposed by the wording added to feature 1.4 of claim 1 also resulted in a lack of conciseness and hence of clarity contrary to Article 84 EPC. Finally, the appellant (opponent 2) objected that it was unclear what the person skilled in the art understood under the expression "heating profile" of amended feature 1.6 of claim 1.

14.4 The arguments of the appellants (opponent 1 and 2) cannot be followed:

14.5 Regarding the objected expression "*tobacco material*", in feature 1.4, the Board concurs with the appellant (patent proprietor) that an expert in the tobacco manufacturing industry understands the term "*tobacco material*" as meaning "*reconstituted tobacco*" or "*homogenized tobacco*", i.e. a material consisting essentially of tobacco in different forms to which additives are added. The difference with respect to "*tobacco*" is thus clear for a person skilled in the art. Furthermore, the Board agrees with the appellant (patent proprietor) that by specifying the kinds of flavour-release medium contained in the cartridge, which is indeed not part of the subject-matter of claim 1, some limitations for the required operational characteristic of the induction heating arrangement are implicitly introduced. On the other hand, even assuming as alleged by the appellant's (opponents 1 and 2) that the wording added in feature 1.4 has no limiting effect at all on the subject-matter of claim 1, the Board cannot see how in the present case the introduction of non-limiting information relating to the nature of the flavour-release material suitable to be used with the claimed electronic cigarette may result in a lack of clarity of the claim. Finally, the Board concurs with the appellant (patent proprietor) that the person skilled in the art understands under the expression "*heating profile*" the function expressing the variation of the current that has to be supplied by the controller to the induction heating arrangement during a certain interval of time, and hence the quantity of energy transmitted to the flavour-release medium starting from the point in time in which the controller is activated by the user's puff. No lack of clarity

thus arises.

Article 52(1) and 56 EPC: Inventive Step

15. The subject-matter of independent claim 1 of the auxiliary request 14 involves an inventive step over the prior art within the meaning of Articles 52(1) and 56 EPC.

15.1 The appellant (opponent 1) put forward that there was no doubt that the heating arrangement of D1 was also suitable for creating vapour by heating a flavour-release medium consisting of tobacco or tobacco material as now specified in feature 1.4 of claim 1. In this respect they also referred to the cross-reference D5, page 16, line 14-20. Furthermore, it was argued that the expression "*to set an heating profile*" in the feature introduced at the end of claim 1 did not require that the heating profile was selected from a plurality of heating profiles, but rather simply that the controller - upon recognition of a "*on-specification*" cartridge - triggered the activation of a certain and predefined heating profile. In their opinion the same functionality was disclosed on page 23, lines 15-25 for the controller of D1, whereby the subject-matter of claim 1 of the auxiliary request 14 did not involve an inventive step over the combination of D1 and D12 for the same reasons presented in respect of claim 1 of the patent as maintained.

15.2 The appellant (opponent 2) argued that the subject-matter of claim 1 of the auxiliary requests 14 was obvious in view of the combination of document D1 with documents D6 or D7 which suggested to select a suitable heating profile optimized for a specific kind of

cartridge in use.

- 15.3 The reasoning of the appellants (opponents 1 and 2 ) is not convincing:

The Board concurs with the appellant (patent proprietor) that the expression "*to set an heating profile*" and in particular the term "*to set*" must be read and interpreted in view of the information provided by features 1.5 and 1.6 in combination. Feature 1.5 requires that "*the control arrangement ..... to control the operation of the induction heating arrangement based on the detected characteristic [of the induction heatable element]*". In view of this teaching the person skilled in the art construing the claim by a mind willing to understand realizes that what is meant by "*to set a heating profile*" actually means to select a heating profile from a plurality of heating profiles stored in the controller that optimally matches the characteristics of the induction heatable element previously detected according to feature 1.5. On the contrary - as convincingly argued by the appellant (patent proprietor), document D1 discloses in the cited passage of page 23 a mere GO/NO-GO safety control triggering a single pre-stored heating profile when a on-specification cigarette is recognized while preventing activation of the heating arrangement if a off-specification cigarette inserted in the housing is detected. Therefore, the reasoning of the appellant (opponent 1) is based on a too broad interpretation of feature 1.6 of claim 1 and cannot be followed.

- 15.4 Regarding the line of argument of the appellant (opponent 2), the Board concurs with the appellant (patent proprietor) that the person skilled in the art

starting from D1 and aiming to optimise the delivery of the heat in view of the specific flavour-release medium provided in a electronic-cigarette, would not look at documents D6 and D7 because they relate to diffusers and not to electronic cigarettes. A combination of D1 with D6 or D7 is thus not obvious.

- 15.5 In conclusion the Board takes the view that the person skilled in the art aiming to implement the control arrangement of the electronic cigarette of D1 does not find in the cited prior art any motivation to configure the control arrangement in such a way to set automatically a heating profile matching the characteristic of a specific kind of induction heatable element previously detected.

## **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 with the order to maintain the patent with the following claims and a description to be adapted thereto:

Claims: N° 1-13 according to the auxiliary request 14 filed with the first letter of 27 May 2024.

The Registrar:

The Chairman:



M. Schalow

G. Pricolo

Decision electronically authenticated