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**Datasheet for the decision
of 13 June 2024**

Case Number: T 0760/22 - 3.2.01

Application Number: 14717692.9

Publication Number: 2978327

IPC: A24D3/06

Language of the proceedings: EN

Title of invention:

SMOKING ARTICLE INCLUDING A FLAVOUR DELIVERY MEMBER

Patent Proprietor:

Philip Morris Products S.A.

Opponent:

JT International S.A.

Headword:

Relevant legal provisions:

EPC 1973 Art. 54, 56, 83, 123(2), 100(a), 100(b), 100(c)

EPC Art. 112(1)(a)

RPBA 2020 Art. 12(3), 12(5), 15(1)

Keyword:

Novelty - (yes)

Inventive step - (yes)

Sufficiency of disclosure - (yes)

Amendments - added subject-matter (no)

Discretion not to admit submission - submission admitted (no)

Referral to the Enlarged Board of Appeal - (no)

Decisions cited:

T 0389/13, T 1137/21, T 0925/98, T 1329/11

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

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Case Number: T 0760/22 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 13 June 2024

Appellant: JT International S.A.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 28 January 2022
rejecting the opposition filed against European
patent No. 2978327 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman G. Pricolo
Members: A. Pieracci
P. Guntz

Summary of Facts and Submissions

- I. An appeal was filed by the opponent in the prescribed form and within the prescribed time limit against the decision of the opposition division to reject the opposition against the European patent No. 2 978 327.
- 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, to which only the opponent replied.
- III. Oral proceedings before the Board took place on 13 June 2024. At the end of the oral proceedings the decision was announced.
- IV. The final requests of the appellant (opponent) are:

that the decision under appeal be set aside and that the patent be revoked or, in the alternative, that a question be referred to the Enlarged Board of Appeal.
- V. The final request of the patent proprietor (respondent) are:

that the appeal be dismissed or, in the alternative, that the patent be maintained in amended form based on one of auxiliary requests 1 to 7 as filed during opposition proceedings.
- VI. The question which the opponent requested to refer to the Enlarged Board of Appeal and which it submitted with letter dated 17 January 2024, reads as follows:

"In the context of the assessment of inventive step, can a foreseeable disadvantageous modification of the closest prior art which is not compensated by an unexpected technical advantage contribute to the presence of an inventive step?"

VII. The following documents are mentioned in the present decision:

D1: WO 2014/091605 A1;

D1a: EP 2 932 860 A1;

D2: WO 2013/179429 A1;

D2a: EP 2856890 A1;

D3: EP 2537426 A2;

D6: US 2008/0302373 A1;

D7: WO 2012/156705 A1;

D8: US 2012/0270710 A1;

D9: US 6502582 B1;

D10: US 2011/0023900 A1;

D11: Capri Technology, Brown & Williamson Tobacco Corporation, Nov 1986;

D12: Design Characteristics of Ultralim Products, Report No. RD.2150. BAT. (UK & Export) Ltd, September 1989;

D14: US 2004/0261807 A;

D32: CORESTA Recommended Method No. 94, Determination of Crush Strength of Flavour Capsules for Filters - definition and Measurement Principle (August 2020).

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

IX. Claim 1 of the patent as granted (features numbering according to the appealed decision), reads as follows:

TF 1: "Smoking article (100) comprising a tobacco substrate (101) and a filter (103), the filter (103) comprising

TF 1.1: a filter segment (201) comprising filter material (203), the filter segment (201) having a cross sectional area measured perpendicular to the longitudinal direction of the filter; and

TF 1.2: a flavour delivery (205) member embedded in the filter segment (201) and surrounded on all sides by the filter material (203),

TF 1.3: the flavour delivery member (205) comprising structural material enclosing liquid flavourant for flavouring smoke during smoking, wherein the flavour delivery member (205) releases at least a portion of the liquid flavourant when the filter (103) is subjected to external force;

TF 2: wherein a cross sectional area of the flavour delivery member (205) measured perpendicular to the longitudinal direction of the filter is about 30%, or greater, of the cross-sectional area of the filter segment (201),

- and
- TF 3: wherein the filter material (203) of the filter segment (201) comprises fibres of between about 5.0 and about 12.0 denier per filament
- TF 4: and between about 10,000 and about 30,000 total denier;
- TF 5: wherein the filter segment and the flavour delivery member are circular in cross section;
- TF 6: the diameter of the filter segment is between 3.6 mm and 6.5 mm
- TF 7: and the diameter of the flavour delivery member is between 2.5 mm and 4.5 mm;
- TF 8: wherein the resistance to draw (RTD) of the smoking article, before the liquid flavourant is released, is greater than 130 mm H₂O; and
- TF 9: wherein the flavour delivery member comprises a capsule
- TF 10: and the capsule has a burst strength of between about 5 N and about 24 N."

Reasons for the Decision

1. Added subject-matter of claim 1 of the patent as granted (Article 100(c) and 123(2) EPC)
 - 1.1 The opponent contested the finding of the opposition division that Article 100 (c) EPC does not prejudice the maintenance of the patent as granted by arguing with reference to T 389/13 that there is no unambiguous teaching that claims 1, 2, 5, 6, 7, 8, 11 and 15 of the original application could be combined together and with a range obtained by combining a lower limit

recited in claim 1 with an upper limit recited in claim 7. Furthermore, the examples of the patent in suit do not disclose the majority of the features of claim 1 and a link between the features of the dependent claims does not exist as in the case underlying T 389/13.

At the oral proceedings the opponent further argued referring to T 1137/21, that by adding the features of specific dependent claims into claim 1, a choice had been made among the available parameters' ranges without any pointer being provided for the specific combination of features, in particular for combining what can be understood as being most preferred and less preferred ranges of different parameters.

In particular the opponent argued that for the diameter of the filter segment and the flavour delivery member the features of dependent claim 8 have been added to claim 1, while other options and possible values are also present in claims 9 and 10. For the ratio between the cross sectional area of the flavour delivery member and of the filter member the value given in original claim 1 has been maintained but other possible values are given in claim 3 and 4, which have not been introduced into claim 1. However no indication is present in the application as originally filed to combine the specific set of features with each other.

- 1.2 The Board cannot follow the argument of the opponent, and considers that T 389/13 cannot be directly applied to the present case. This is because the originally filed claims of the patent in suit, contrary to the case of T 389/13, are linked to each other by inter-related dependencies, since they are each explicitly dependent on one or any of the preceding claims.

The Board however concurs with the opponent, also referring to T 389/13 for this, in that, for deciding on the issue of added subject-matter a case by case analysis has to be made to assess whether the amended subject-matter is to be derived by a person skilled in the art directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the application documents as filed (see the Case Law of the Boards of Appeal (CLB), 10th edition, 2022, II.E.1.1).

In the present case the Board considers that due to the interrelated dependencies of the dependent claims and due to the limited number of features of the same, the person skilled in the art would consider the combination of features of granted claim 1 as evidently apparent from the set of claims as originally filed, or in other terms, as being directly and unambiguously derivable from the application as originally filed. That also other combinations of features would appear to the person skilled in the art as being also directly and unambiguously derivable from the original set of claims is not relevant for this issue. That an explicit pointer is not present for leading to the specific combination of features is also not relevant as long as the person skilled in the art, as in the present case, would derive it directly and unambiguously from the original application documents.

With respect to the feature of 10.000 to 30.000 total denier, as found by the opposition division (see the appealed decision, page 9, point 11.2.1, with reference to T 925/98), in case of a disclosure of a general and a preferred range a combination of the preferred disclosed narrower range and one of the part-ranges lying within the disclosed overall range is to be seen

as unequivocally derivable from the original disclosure. As this is the case here, since a range of 10.000 and 35.000 for the total denier is present in claim 1 as originally filed and a range of 12.000 and 30.000 is present in claim 7 as originally filed, the claimed range of 10.000 to 30.000 does not add subject-matter extending beyond the content of the application as originally filed.

Therefore the Board is not convinced by the argument of the opponent that the decision of the opposition division that subject-matter has not been added is not correct.

In view of the above finding there is no need to address the issue of admittance of (some of) the above objections of added subject-matter into the proceedings, which has been contested by the patent proprietor.

2. Sufficiency of disclosure (Article 100(b) and 83 EPC)

2.1 The opponent contested the finding of the opposition division in points 12.2.1 and 12.2.3 of the appealed decision that the invention is sufficiently disclosed arguing that serious doubts do exist whether the invention can be carried out since an example of the invention as claimed is not shown in the patent in suit, in particular in view of the RDT value claimed. Furthermore, even if the person skilled in the art would be able to measure the RDT a research program would be needed to identify articles having the desired RDT values. Moreover, no indication is provided in the patent in suit on how to exclude meaningless embodiments. The fact that the ratio between the cross sectional area of the flavour delivery member and that

of the filter segment has no upper limit implies that by applying the invention one could arrive at articles which do not work properly. No indication as to how to exclude these articles is provided in the opposed patent.

- 2.2 It is established jurisprudence of the Boards of Appeal that an objection of lack of sufficient disclosure presupposes that there are serious doubts substantiated by verifiable facts. The burden of proof is upon the opponent to establish on the balance of probabilities that a skilled reader of the patent, using his common general knowledge, would be unable to carry out the invention (see CLB, II.C.9).
- 2.3 In the present case the Board finds that the objection of insufficiency of disclosure raised by the opponent is not based on serious doubts substantiated by verifiable facts and that therefore the respondent has failed to discharge its burden of proof.
- 2.4 As argued by the patent proprietor the opponent has not convincingly shown why, contrary to the finding of the opposition division, the person skilled in the art would not be in the position of performing the invention with the teaching of the patent in suit and with the support of the common general knowledge even in the absence of a specific example according to the claimed invention. The Board is unable to see any evidence supporting the argument that a research program constituting an undue burden is needed to carry out the invention.
- 2.5 Why the skilled person would not be in the position to implement the claimed invention excluding any meaningless embodiment has also not been convincingly

shown by the opponent. The opponent's argument remains a mere allegation and, as mentioned above, it is the opponent who carries the burden of proof of insufficiency of disclosure. The Board therefore sees no reason not to concur with the opposition division (see the appealed decision point 12.2.3 last sentence) and the patent proprietor that the person skilled in the art wishing to successfully put the invention into practice would be in the position to disregard unsuitable embodiments.

2.6 The Board is thus not convinced by the arguments of the opponent that the opposition division was wrong in its assessment of sufficiency of disclosure of the claimed invention.

2.7 Further objections of insufficiency

2.7.1 The opponent also argued that in absence of specification of the measurement conditions of the burst strength the invention is insufficiently disclosed. The opponent refers to document D32, not admitted by the opposition division in opposition proceedings, to argue that the conditions in which the burst strength is measured would affect the results of the test, since a high variation is shown in D32 even when all the conditions are specified as it is done there.

2.7.2 The Board does not consider it necessary to address the issue of admittance into the proceedings of document D32 as the opponent's arguments based on this document are not convincing. The fact that the choice of the test method for the burst strength and the setting condition of the test affect the value of the burst strength measured is rather an issue of clarity and

thus not relevant for the assessment of sufficiency of disclosure as indicated by the opposition division (see appealed decision, point 12.2.4, last sentence) and by the patent proprietor.

2.7.3 The opponent also argued with reference to D2/D2a in relation to the variability of the test results for measuring the burst strength which depends on the position of the capsule in the filter. The Board concurs with the patent proprietor that D2/D2a relates to a capsule inserted in a cavity of the filter and not embedded in the filter as according to the patent in suit, so that the issues of uncertainties due to the movement of the capsule in the cavity mentioned therein do not convincingly apply to the claimed invention. The Board shares the view of the patent proprietor that the argument of the opponent that in figure 2 of the patent in suit there is margin for movement of the capsule is a speculation and not convincing. The opponent also argued that from D2/D2a it is apparent that there is also a repulsive force exerted by the filter which would affect the measurements. This issue however, even admitting that it would arise, is rather linked to the issue of clarity of the claimed subject-matter than to that of sufficiency of disclosure.

2.7.4 The argument of the opponent that a lack of sufficiency arises, since the patent specification does not provide any example of a commercially available capsule to be used in the invention, in particular having the required burst strength, or any method for making them according to the invention, is not convincing since it has not been shown that this would not be feasible for a person skilled in the art by supporting the teaching of the patent with common general knowledge.

2.7.5 The opponent also argued, citing T 1329/11, that since there is a weak presumption of sufficiency and no example or precise information on how to carry out the invention, the burden of proof shifts to the patent proprietor. The Board disagrees that this is the case since, as outlined above, it does not find that serious doubts supported by verifiable facts have been submitted by the opponent.

3. Novelty of the subject-matter of claim 1 in view of D1/D1a (Article 100(a) and 54 EPC)

3.1 The opponent contests the finding of the opposition division that document D1/D1a does not deprive of novelty the subject-matter of claim 1. The opponent objects to the finding of the opposition division (see the appealed decision, pages 14 and 15, points 13.3 and 13.5) that multiple selections would be necessary to arrive at the subject-matter of claim 1 starting from the teaching of D1a, by arguing that only a single selection would be necessary.

3.2 However, at least feature TF 1.3, namely:

"the flavour delivery member comprising structural material enclosing liquid flavourant for flavouring smoke during smoking, wherein the flavour delivery member releases at least a portion of the liquid flavourant when the filter is subjected to external force",

in particular the feature of the "liquid flavourant", cannot be directly and unambiguously derived from document D1/D1a.

- 3.3 The opponent's argument that the capsule "normally" contains a liquid flavourant is not convincing since that this "normally" is the case does not correspond to a direct and unambiguous disclosure.
- 3.4 The further argument that the person skilled in the art would understand on the mere basis of its common general knowledge that the flavourant is a liquid is also not convincing as it is an assertion for which there has not been provided any substantiation.
- 3.5 The fact that D1/D1a mentions a "component for suppressing volatilization of the flavour component" and that the capsule is referred to as a "flavour releasing material" and that the embodiment with the thread is described as having the thread "impregnated with a flavour component" does not directly and unambiguously imply that the flavour component is a liquid. In fact as argued by the patent proprietor the volatilization and the flavour release could as well refer to a solid material instead of a liquid and the fact that the thread is impregnated does not disclose anything in relation to the embodiment with the capsule.
- 3.6 The fact that in paragraph [0022] of D1/D1a it is disclosed that the flavour releasing material could be menthol, which is used as liquid in paragraph [0041] of the patent in suit does not allow to conclude that the menthol mentioned in D1/D1a is also in liquid state, since as indicated by the patent proprietor the menthol could also be present in solid state.
- 3.7 Since at least feature TF 1.3 is not disclosed in D1/D1a the Board cannot follow the argument of the opponent that the opposition division was wrong in

considering the subject-matter of claim 1 to be novel with respect to that document.

4. Novelty of the subject-matter of claim 1 in view of D2/D2a (Article 100(a) and 54 EPC)
 - 4.1 The opponent contested the finding of the opposition division that multiple selections would be necessary to arrive at the subject-matter of claim 1 starting from D2/D2a so that a direct and unambiguous disclosure of the claimed subject-matter would not be provided in that document.
 - 4.2 The Board is not convinced by the argument of the opponent that a single selection, namely the selection of a small filter diameter as opposed to a large filter diameter, is sufficient to arrive at the subject-matter of claim 1.
 - 4.3 This is because the conclusion of the opponent is based on the embodiment of sample 2 of table 1 of D2/D2a disregarding that in that case the capsule is not meant to be embedded, with the argument that this is not relevant for the teaching provided by that example. According to the opponent the person skilled in the art would understand that for a filter with a small diameter a filter tow having 6 denier per filament and 17.000 total denier is appropriate independently from whether the capsule is embedded in the filter segment or not, which would then imply that features TF 3 and TF 4 are disclosed in D2/D2a also for the case in which the capsule is embedded.
The Board does not consider this as a proper way of addressing direct and unambiguous disclosure since there is no basis for the interpretation given by the opponent.

The Board is unable to identify in D2/D2a such a generalized teaching as argued by the opponent. The values disclosed are just for a specific example, in which the capsule is not embedded and a direct and unambiguous disclosure of these values for the cases where the capsule is embedded is not present. At least for this reason the opponent's line of argument of lack of novelty in view of D2/D2a cannot be followed.

- 4.4 The Board has thus no reason to conclude that the opposition division was not correct in finding that document D2/D2a does not deprive of novelty the subject-matter of claim 1.
- 5. Inventive step of the subject-matter of claim 1 in view of document D3 (Article 100 (a) and 56 EPC)
- 5.1 The opponent contested the finding of the opposition division (see the appealed decision, page 19, point 15.3 to page 20, point 15.7) that document D3 discloses the features of the subject-matter of claim 1 apart from features TF 4 and TF 6, namely:

"(the filter material comprises fibers) between about 10000 and about 30000 total denier" (TF 4)

and

"the diameter of the filter segment is between 3.6 mm and 6.5 mm" (TF 6)

and that the subject-matter of claim 1 is based on an inventive step considering D3 as the closest prior art in combination with the common general knowledge.

5.2 The opponent argued that feature TF 6 is indeed also disclosed by D3 but that even if this were not the case the subject-matter of the claim would still be not inventive.

The opponent also contested the argument of the patent proprietor that feature TF 2, namely:

"wherein a cross sectional area of the flavour delivery member measured perpendicular to the longitudinal direction of the filter is about 30%, or greater, of the cross sectional area of the filter segment"

is not disclosed in D3 and argued that even if feature TF 2 would not be disclosed in D3, it would be automatically achieved by a single modification of the cigarette of D3, i.e. by reducing the diameter of the cigarette.

5.3 Independently from the obviousness of features TF 4 and TF 6, the Board shares the view of the patent proprietor that document D3 also does not show feature TF 2.

5.4 The Board cannot follow the finding of the opposition division (see the appealed decision, page 19, point 15.3.3) and the argument of the opponent, that paragraph [0080] of D3 discloses feature TF 2 of claim 1.

5.5 As argued by the patent proprietor, a set of different diameters for the spherical object is given in paragraph [0080] of D3, however without a link to the diameter or the cross sectional area of the filter. This is only given in the last sentence of paragraph [0080], reading:

"For a cigarette having a diameter of about 7mm to about 8mm, a typical cellulose acetate tow filter material can readily accept, and maintain in the desired position with the filter element, a single object having a diameter of about 3.5"

which leads to a cross sectional area of the flavour delivery member of 19% or 25% of the cross sectional area of the cigarette, respectively, and does not provide a direct and unambiguous disclosure of a cross sectional area of the flavour delivery member larger than 30%, i.e. within the claimed range.

Therefore independently from whether it would be obvious to introduce feature TF 4 and possibly TF 6 in D3 in view of the common general knowledge, feature TF 2 would still not be present so that the person skilled in the art would not arrive at the claimed subject-matter.

- 5.6 The Board also cannot follow the argument of the opponent that feature TF 2 would be in any case automatically obtained by the person skilled in the art when willing to provide a smaller and lighter cigarette. According to the opponent the person skilled in the art would reduce the diameter of the filter while keeping the same flavour delivery member, i.e. without changing it, thus obtaining the value of the feature TF 2 as claimed.

The Board disagrees and concurs with the patent proprietor that, since paragraph [0081] of D3 states that the invention therein disclosed exhibits desirable resistance to draw, the person skilled in the art would not act so as to change it and thus would not maintain

the same flavour delivery member when reducing the dimension of the filter because the resistance to draw would increase. Therefore the argument that feature TF 2 would be automatically obtained by reducing the diameter of the filter cannot be followed, since in that case the person skilled in the art would use a different flavour delivery member.

5.7 The lines of argument of the opponent in view of the combination of D3 with D9, D10, D11 and D12 do not lead to a different conclusion as these documents do not relate to feature TF 2 but rather to the denier values of the fibers of the filter material.

6. Inventive step of the subject-matter of claim 1 in view of document D8 (Article 100 (a) and 56 EPC)

6.1 The opposition division found that the subject-matter of claim 1 differs from the smoking article of D8 because it does not show features TF 3 and TF 4, i.e. a particular range of fibers and total denier values for the filter, namely:

"wherein the filter material of the filter segment comprises fibers of between about 5.0 and about 12.0 denier per filament" (TF 3)

and

"between about 10000 and about 30000 total denier" (TF 4)

and that it would have been not obvious for the person skilled in the art to introduce the claimed denier values for the cigarette of D8.

6.2 The opponent contested the finding of the opposition division arguing that the sole difference between the subject-matter of claim 1 and the disclosure of D8 is feature TF 4, i.e. the total denier range.

6.3 Independently from whether it would be obvious to introduce fibers with the claimed denier and have the total denier as claimed in claim 1 in the cigarette disclosed in D8, the Board shares the view of the patent proprietor that contrary to the finding of the opposition division (see the appealed decision, page 21, point 16.1.3, 16.1.5 and 16.1.6) and to the argument of the opponent, feature TF 2, namely:

"wherein a cross sectional area of the flavour delivery member measured perpendicular to the longitudinal direction of the filter is about 30%, or greater, of the cross-sectional area of the filter segment"

is not directly and unambiguously derivable from D8.

6.4 The opponent derived feature TF 2 from the disclosure of a capsule having a diameter of 3.5 and 4 millimetres with a filter having a circumference in the lower end of the range of 16 to 27 mm disclosed in paragraph [0079] of D8.

6.5 The Board concurs with the patent proprietor that in D8 (see paragraph [0081], last sentence) there is only the disclosure of a combination of a capsule with a filter with a given diameter, which is a capsule with a diameter of 3.5 mm and a filter with a circumference of 24.5 mm, which then leads to a ratio of cross sectional areas of about 20%, thus not according to feature FT 2 of claim 1.

The argument of the opponent that the capsule indicated in paragraph [0083] has to be considered disclosed in combination with the circumference range from about 16 mm to about 27 mm derivable from paragraph [0079] cannot be followed as it is not directly and unambiguously derivable from those paragraphs.

Furthermore it is explicitly indicated in paragraph [0081] of D8 that the size and shape of the capsule can vary and should be such that certain criteria should be fulfilled, such as not be so large that the draw resistance of the smoking article be affected. Consequently the person skilled in the art would be careful not to interpret the disclosure of D8 so as to depart from what is specifically described therein. The way the opponent has deduced feature TF 2 from D8 cannot thus be considered as being correct.

6.6 Therefore, even if it was obvious to introduce feature TF 3 and TF 4 in D8 in view of the teaching of documents D9 to D12 as argued by the opponent, feature TF 2 would still not be present so that the person skilled in the art would not arrive at the claimed subject-matter.

6.7 The further argument of the opponent, that it would be obvious as a matter of routine implementation to use the only capsule disclosed in D8 with a diameter of 3.5 and 4 mm for the entire filter range of 5.1 to 8.6 mm, which is derivable from D8, can also not be followed. The person skilled in the art, considering the teaching provided by D8 itself that the resistance to draw should not be adversely affected by the capsule, would be cautious in changing the relationship between the filter and the capsule dimension from the one specifically provided in paragraph [0083] D8.

The Board is, thus, not convinced by the arguments of the opponent that the subject-matter of claim 1 is obvious when starting from D8 as the closest prior art.

7. Inventive step of the subject-matter of claim 1 in view of D11 (Article 100(a) and 56 EPC)

7.1 The opponent argued that the person skilled in the art would introduce a conventional flavour capsule with a diameter of 3.5 mm in the thin cigarette of D11, as it is known from a plurality of documents such as D3, D6, D8, D14 and others, to solve the problem of providing a flavour releasable by the consumer in a super-slim cigarette and that by doing this the skilled person would arrive at the claimed subject-matter.

7.2 The opponent contested the argument of the opposition division that the person skilled in the art would not introduce a conventional capsule in D11 because this would alter significantly the characteristic of the cigarette, in particular the RTD value (see the appealed decision, page 23, point 17.5, second and third paragraph).

7.3 The opponent argued that accepting a disadvantageously higher RTD than in D11 as according to the invention cannot provide the basis of inventive step and that the person skilled in the art would, if necessary, adapt the ventilation to lower the RTD.

7.4 The opponent also contested that the opposition division alleged a prejudice in introducing a standard capsule in a super-slim cigarette but that such prejudice is not substantiated and the patent has not

shown with which technical measure the alleged prejudice has been overcome.

- 7.5 The opponent argued that in normal use the flavour capsule is crushed to release the flavour before the cigarette is smoked. Once crushed the cross-sectional occupancy of the capsule is reduced, so that no significant increase in RTD upon smoking is expected. Furthermore the RTD before crushing of the capsule is irrelevant for the smoker.
- 7.6 The Board is not convinced by the arguments of the opponent and rather concurs with the opposition division and shares the view of the patent proprietor for the following reasons.
- 7.7 The Board accepts to the benefit of the opponent the problem it formulated, i.e. to modify the cigarette of D11 so as to provide flavour releasable by the consumer in a super-slim cigarette.
- 7.8 The Board is of the opinion that when starting from D11 and looking for a solution of that problem the person skilled in the art would not choose a solution which would lead to abandon the requirements and the constraints set in D11 itself, but would remain within the framework of the constraints set by D11. In fact the choice of the starting point in an inventive step analysis defines the framework of the further development of the invention (see also CLB, I.D.3.6)
- 7.9 As argued by the patent proprietor, it is stated in D11 itself that the Capri cigarette is designed to provide conventional smoking properties in an ultra slim design, such as a tar delivery of 9 mg , a nicotine

delivery of 0.8 mg and an open cigarette pressure drop of 5-6 inches water gauge, i.e. 127 to 152,4 mm water gauge.

The introduction of a standard capsule would increase the resistance to draw contrary to the aim of D11 of providing conventional smoking properties (see page 1 of D11).

- 7.10 The argument of the opponent that the RTD is irrelevant for the consumer since the capsule is crushed before smoking is not convincing since this is not necessarily and always the case (see for example the patent in suit, paragraph [0011] first two sentences). The person skilled in the art would thus not choose a technical solution which would lead to not fulfil the requirements originally set in D11 in one of the possible ways of using the claimed article. The person skilled in the art would thus look for a solution to the objective problem which would also satisfy the constraints set in D11 itself.
- 7.11 The argument that there is an alleged unsubstantiated prejudice is not correct. As indicated above in point 7.9 ,D11 itself indicates that it aimed at maintaining certain properties of a regular cigarette in the slim-cigarette of D11.
- 7.12 Also the opponent's argument that the ventilation would be adapted to compensate an increase in pressure drop caused by the insertion of the flavour capsule can not be followed. The Board rather concurs with the patent proprietor that, as can be derived from page 5 of D11, an increase of ventilation would reduce the tar delivery below the aimed level of D11.

7.13 Thus, the opposition division correctly found that the subject-matter of claim 1 is non rendered obvious when considering D11 as the closest prior art.

8. Further objections of lack of inventive step

8.1 The opponent stated in the written procedure that the subject-matter of claim 1 lacks an inventive step when starting from either of D6, D7, D9, D10 or D12 as closest prior art (see the statement setting out the grounds of appeal, point 7.5, pages 41 and 42). In its preliminary opinion the Board, concurring with the patent proprietor, indicated that these objections lack substantiation in the sense of Article 12(3) RPBA and that it was preliminary foreseen not to admit them into the proceedings pursuant to Article 12(5) RPBA. At the oral proceedings the opponent referred to its written submissions without providing any arguments on admittance or on substantiation of its objections. The Board having reconsidered all the factual and legal aspects of the case, in view of the absence of any reason for admitting the above objections, which remained unsubstantiated, decided not admit them into the proceedings pursuant to Article 12(3) and (5) RPBA.

9. Referral of a question to the Enlarged Board of Appeal

The opponent requested the referral of the following question to the Enlarged Board of Appeal pursuant to Article 112(1)(a) EPC should the Board acknowledge an inventive step in the claimed subject-matter based on the assumption that the skilled person would be deterred from using a relatively large capsule in a relatively small filter in the expectation of such configuration being disadvantageous in terms of resistance to draw:

"In the context of the assessment of inventive step, can a foreseeable disadvantageous modification of the closest prior which is not compensated by an unexpected technical advantage contribute to the presence of an inventive step?"

The Board considers the above question not relevant for the present case. In fact, the finding of the Board is not based on an alleged "disadvantageous modification" or on an alleged prejudice, but rather on the application of the problem and solution approach to the present case in view of the problem formulated by the opponent while taking into account the constraints set by the disclosure of the prior art chosen by the opponent as starting point (see point 7.8 above). The answer to the posed question is thus not relevant for the present case.

Since the outcome of the present appeal proceedings is not dependent on the answer to the submitted question, the request for a referral of the above question was refused (see CLB, V.B.2.3.3).

Order

For these reasons it is decided that:

The appeal is dismissed

The Registrar:

The Chairman:



M. Schalow

G. Pricolo

Decision electronically authenticated