

**Internal distribution code:**

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

**Datasheet for the decision  
of 11 January 2024**

**Case Number:** T 0919/22 - 3.2.07

**Application Number:** 15757240.5

**Publication Number:** 3186168

**IPC:** B65D85/10, A24F15/00, B65D5/02,  
B65D77/04, B65D77/38, B65D65/02

**Language of the proceedings:** EN

**Title of invention:**  
CONTAINER WITH WRAPPER WITH REMOVABLE PORTION

**Patent Proprietor:**  
Philip Morris Products S.A.

**Opponent:**  
British American Tobacco (Investments) Ltd

**Headword:**

**Relevant legal provisions:**  
EPC Art. 56  
RPBA 2020 Art. 12(4)

**Keyword:**

Inventive step - (no) - mixture of technical and non-technical features

Amendment to case - argument - admissibly raised and maintained (no) - amendment admitted (no)

**Decisions cited:**

G 0004/92, T 1914/12

**Catchword:**



**Beschwerdekammern**

**Boards of Appeal**

**Chambres de recours**

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

Case Number: T 0919/22 - 3.2.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.07**  
**of 11 January 2024**

**Appellant:** Philip Morris Products S.A.  
(Patent Proprietor) Quai Jeanrenaud 3  
2000 Neuchâtel (CH)

**Representative:** Millburn, Julie Elizabeth  
Reddie & Grose LLP  
The White Chapel Building  
10 Whitechapel High Street  
London E1 8QS (GB)

**Respondent:** British American Tobacco (Investments) Ltd  
(Opponent) Globe House  
1 Water Street  
London, WC2R 3LA (GB)

**Representative:** Grey, Ian Michael  
Venner Shipley LLP  
200 Aldersgate  
London EC1A 4HD (GB)

**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 9 February 2022  
revoking European patent No. 3186168 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** G. Patton  
**Members:** A. Cano Palmero  
R. Cramer

## **Summary of Facts and Submissions**

- I. The patent proprietor (appellant) lodged an appeal within the prescribed period and in the prescribed form against the decision of the opposition division revoking European patent No. 3 186 168.
- II. The opposition division found *inter alia* that the subject-matter of claim 1 of the main request and of auxiliary request 2 were not inventive (Article 56 EPC).
- III. The patent proprietor (appellant) requested  
  
that the decision under appeal be set aside, and that the patent be maintained in amended form according to the main request or according to any of auxiliary requests 1 or 1A,  
whereby  
the main request and auxiliary request 1 correspond to the main request and to auxiliary request 2 filed during opposition proceedings, and auxiliary request 1A has been filed for the first time with the statement setting out the grounds of appeal.
- IV. The opponent (respondent) requested  
  
that the appeal be dismissed.
- V. In preparation for oral proceedings, scheduled upon the parties' requests, the board communicated its preliminary assessment of the case to the parties by means of a communication pursuant to Article 15(1) RPBA, to which the appellant responded in substance

with letter dated 11 December 2023. The respondent announced with letter dated 20 December 2023 that it would not attend the oral proceedings.

- VI. Oral proceedings before the board were held on 11 January 2024 in the absence of the respondent in accordance with Rule 115(2) EPC and Article 15(3) RPBA.

At the conclusion of the proceedings the decision was announced. Further details of the proceedings can be found in the minutes thereof.

- VII. The lines of argument of the parties, which focused on the inventive step of the subject-matter of claim 1 of all requests, as well as the admittance of the appellant's arguments on inventive step based on a second technical problem, are dealt with in detail in the reasons for the decision.

- VIII. Independent **claim 1** according to the **main request** reads as follows:

"A container (10) of consumer goods (18) comprising: a housing comprising a box (12) and a lid (14) closing the box; and  
one or more consumer goods (18) wrapped in a wrapper (20) and contained within the housing, the wrapper being partially exposed when the lid (14) is open and having a removable portion (22) that can be removed when the lid is open to expose the consumer goods, the removable portion (22) of the wrapper (20) having a first part that is visible when the lid (14) is open and a second part that underlies one or more walls of the box (12) and is not visible when the lid is open, wherein the first part of the removable portion (22) of the wrapper (20) carries one or more first indicia,

characterized in that the second part of the removable portion of the wrapper carries one or more second indicia, and wherein the one or more second indicia on the second part of the removable portion (22) of the wrapper (20) are visually distinct from the one or more first indicia on the first part of the removable portion (22) of the wrapper (20) that is exposed when the lid (14) is open."

IX. Independent **claim 1** according to auxiliary request 1 reads as follows:

"A container (10) of consumer goods (18) comprising: a housing comprising a box (12) and a lid (14) closing the box; and one or more consumer goods (18) wrapped in a wrapper (20) and contained within the housing, the wrapper being partially exposed when the lid (14) is open and having a removable portion (22) that can be removed when the lid is open to expose the consumer goods, the removable portion (22) of the wrapper (20) having a first part that is visible when the lid (14) is open, the first part of the removable portion of the wrapper comprising a first part of a front panel, the front panel further comprising a second part underlying a front wall of the box (12) such that the second part of the front panel is not visible when the lid is open, characterized in that the first part of the removable portion (22) of the wrapper (20) carries no indicia, and wherein the second part of the front panel of the removable portion of the wrapper carries one or more indicia (26) such that the second part of the front panel of the removable portion (22) of the wrapper (20) is visually distinct from the first part of the front

panel of the removable portion (22) of the wrapper (20) that is exposed when the lid (14) is open."

X. Independent **claim 1** according to auxiliary request 1A reads as follows:

"A container (10) of consumer goods (18) comprising:  
a housing comprising a box (12) and a lid (14) closing the box; and  
one or more consumer goods (18) wrapped in a wrapper (20) and contained within the housing, the wrapper being partially exposed when the lid (14) is open and having a removable portion (22) that can be removed when the lid is open to expose the consumer goods, the removable portion (22) of the wrapper (20) having a first part that is visible when the lid (14) is open, the first part of the removable portion of the wrapper comprising a first part of a front panel, the removable portion (22) of the wrapper (20) also having a second part that underlies one or more walls of the box (12) and is not visible when the lid is open, the second part of the removable portion of the wrapper comprising a second part of the front panel, characterized in that the first part of the removable portion (22) of the wrapper (20) carries no indicia, and  
wherein the second part of the removable portion of the wrapper carries one or more indicia (26) such that the second part of the removable portion (22) of the wrapper (20) is visually distinct from the first part of the removable portion (22) of the wrapper (20) that is exposed when the lid (14) is open."

## **Reasons for the Decision**

1. *Main request - Inventive step, Article 56 EPC*
- 1.1 The appellant concurred with the opposition division that document D2 (**US 5,465,837 A**) does not directly and unambiguously disclose the feature that the one or more second indicia on the second part of the removable portion of the wrapper are visually distinct from the one or more first indicia on the first part of the removable portion of the wrapper that is exposed when the lid is open. This feature is also seen as the distinguishing feature by the board.
- 1.2 The appellant however contested the reasoned finding of the opposition division that the subject-matter of claim 1 according to the main request lacked an inventive step in view of document D2, in particular that the distinguishing feature did not make a technical contribution (see decision under appeal, point II.12).

### ***First technical problem***

- 1.3 In a first line of argument, the appellant argued that one technical effect associated with the distinguishing feature was the introduction of a time delay between revealing the first indicia and revealing the second indicia, which created an element of surprise for the consumer, which could increase the likelihood of the consumer taking an enhanced note of the indicia on the second part of the removable portion of the wrapper. In particular, the distinguishing feature enabled full control as to "what" was to be revealed and "how" it was to be revealed.



- 1.3.1 In contrast, according to the appellant the entire image of the sole indicia of document D2 is already anticipated by the visible part of the image before the pull-off flap is removed. There is no visual distinction in document D2 and there is no element of surprise for the consumer. Hence, there is no improved communication with the consumer.
- 1.3.2 The objective problem could be defined as how to adapt a wrapper for a bundle of consumer goods to provide improved means for communicating with the consumer. According to the appellant, the opposition division incorrectly focused solely on "what" was being presented (*i.e.* a second indicia) rather than "how" the indicia was being presented (*i.e.* when the removable portion of the wrapper is removed from the rest of the wrapper). Contrary to the finding of the opposition division, the problem was indeed to be seen as a technical problem.
- 1.4 The board disagrees for the following reasons.
  - 1.4.1 The board is of the view that the placement of two distinct indicia on different parts of the removable portion of the wrapper results in a mix of technical and non-technical features. However, the problem-solution approach must be applied such that an inventive step cannot be acknowledged on the basis of features that do not contribute to the technical character of the invention (see Case Law of the Boards of Appeal, 10th edition 2020, I.D.9.2.1 and T 0641/00 (COMVIK), headnote 1).
  - 1.4.2 It is not disputed that D2 discloses a container in which the removable portion 34 of the wrapper (in the form of a pull-off flap) contains **one single** overall

indicia (printed image 36) covering the entirety of the front wall 26 of such pull-off flap 34. A consumer would see a first part of this sole indicia when the package lid is opened. The entire image of the sole indicia of D2 is only revealed in its entirety when the pull-off flap 34 is removed from the package (see figures 2 and 3).

The board, however, does not follow the appellant's argument that there is no visual distinction in the visible and non-visible part of the sole indicia of D2 and that consequently there is no element of surprise for the consumer. In fact, D2 discloses that the printed image extending over the front wall 26 of the pull-off flap can be *"intended as a voucher, a certificate of participation in competitions or the like"* (see column 2, lines 55 to 57 of D2). The board is convinced, in line with the finding of the opposition division (see first paragraph on page 6 of the decision under appeal), that the information provided by such a voucher or certificate is only accessible to the user when the whole image of the sole indicia is visible, *i.e.* when the pull-off flap 34 is removed. The argument of the appellant that the non-visible part is anticipated by the visible part of the indicia of D2 is thus an allegation that cannot be followed.

- 1.4.3 In sum, the board agrees with the appellant that the subject-matter of claim 1 differs from the known container of D2 in "what" is revealed to the user, namely that **two visually distinct indicia** are provided in a first and second portion of the removable portion of the wrapper, while D2 only discloses one single indicia.

1.4.4 However, in light of the above, it cannot be concurred with the appellant that the container of claim 1 of the main request differs from the container of D2 in "how" such information is revealed, since both containers reveal all the information contained by the one or two indicia in exactly the same way, namely when the removable portion of the wrapper is removed. It follows that full control of "how" all the information of the indicia is revealed, is achieved by the package of D2.

1.4.5 The board concurs with the opposition division that the distinguishing feature and the alleged effect of creating an element of surprise based on "what" is communicated to the customer do not provide a technical contribution to the prior art. In particular, the board is of the view that such alleged effect is purely a mental effect experienced by the user and does not involve any technical considerations. Therefore, the presence of an inventive step cannot be justified by this sole distinguishing feature and effect.

### ***Second technical problem***

1.5 In a second line of argumentation, the appellant indicated that the provision of the second indicia (distinct from the first indicia) in the manner defined in claim 1 may function as means for indicating a flaw in the manufacture of the container, and thus a means for indicating a potential compromise in the quality of the consumer goods. The distinguishing feature performs thus a technical task to solve the **objective technical problem of adapting a wrapper for a bundle of consumer goods to provide means for indicating that the quality of the consumer goods may have been compromised.**

- 1.6 The board notes that this line of argument based on a different effect and problem to be solved by the distinguishing feature has been submitted by the appellant for the first time with the statement setting out the grounds of appeal.
  
- 1.7 The appellant argued that it learnt for the first time from the written decision of the opposition division that the subject-matter of claim 1 of the main request lacked an inventive step starting from document D2 as the closest prior art, in particular that the technical effect relating to improved communication was considered not to make a technical contribution. Prior to oral proceedings, the opposition division had only raised novelty objections against the subject-matter of claim 1. Therefore, the statement of grounds of appeal was the first opportunity the appellant had to raise a new argument based on the second technical effect.
  - 1.7.1 The board is not persuaded by the appellant's justification, for the following reasons.
  
  - 1.7.2 It is to be noted that an objection on lack of inventive step starting from D2 as the closest prior art had already been raised by the respondent at the outset of the opposition proceedings (see page 5 of the notice of opposition), arguing that the alleged distinguishing feature had no technical contribution.
  
  - 1.7.3 The board also notes that in the framework of this objection, the closest prior art (D2), the claim interpretation, and the distinguishing feature of the claim were duly identified and remained unchanged throughout the whole proceedings, and that the opposition division followed the inventive step objection in its decision.

1.7.4 Under these circumstances the board is of the view that the appellant could not have been surprised by the decision under appeal. It cannot be generally considered an undue burden for a patent proprietor to promptly react and present the arguments considered necessary (in the present case by presenting an alternative technical problem) in its attempt to demonstrate the inventiveness of the subject-matter of a claim in view of a particular objection which has been raised, regardless of whether the objection is ultimately followed by the opposition division or not.

1.8 The appellant further argued that in any case, the introduction of the second technical effect in the statement setting out the grounds of appeal is a new argument and that the board does not have any discretionary power not to admit these new arguments. Indeed, according to G 4/92 new arguments can be put forward at any time and according to T 1914/12 the board must admit new arguments and has no discretion not to admit them. In support of this point, the appellant indicated that Article 114(2) EPC gives discretionary power to disregard facts or evidence only, and that such discretionary power does not extend to late arguments based on facts that are already in the proceedings.

According to Article 23 RPBA, the binding nature of the RPBA should not lead to a situation which would be incompatible with the spirit and purpose of the Convention. Therefore, the board should not rely too heavily on the RPBA without giving sufficient consideration to the fundamental requirements of the EPC.

Finally, the appellant held that in any case, the second technical effect should not be considered as an amendment in the sense of Article 12(4) RPBA, but rather as a new argument based on facts that were already in the proceedings, and therefore to be seen as a mere development of the previous plea that the subject-matter of claim 1 was inventive. In particular, the problem of indicating a compromise in the quality of the product could be seen as a particular case of the more general problem of enhancing communication with the user.

- 1.8.1 The board disagrees with the appellant's arguments.
- 1.8.2 There is no question that new arguments can be put forward at any time in accordance with G 4/92, but the relevant question is whether new arguments can be considered by a board of appeal or not. The board is further not convinced that the findings of T 1914/12 can be applied to the present case, since the case at hand underlies the RPBA 2020 and not the RPBA 2007.
- 1.8.3 Article 12(2) RPBA 2020 specifies that a party's appeal case shall be directed to the requests, facts, objections, **arguments** and evidence on which the decision under appeal was based. According to Article 12(4) RPBA 2020, any part of a party's appeal case which does not meet the requirements of Article 12(2) RPBA 2020 is to be regarded as an amendment, which may be admitted only at the discretion of the board. In the board's view, these provisions of the RPBA 2020 are not at odds with Article 114(2) EPC, which focuses on the discretionary power to disregard late-filed facts and evidence, whereas the RPBA focuses rather on the discretionary power of a board of appeal to not admit

an amendment which may, for example, consist of new arguments as in the present case.

1.8.4 The board is also convinced that, contrary to the argument of the appellant, the technical problem of indicating a flaw in the production process that could compromise the quality of the product cannot be seen as a particular case of enhancement of communication with the user. In particular the indicia allegedly solving this second technical problem could be meaningless to a final user. In this sense, the board finds that in the present case the choice of the new second technical problem cannot be regarded as a mere development of a previous argument, but rather shifts the case in a completely different direction, which could force an opponent to an additional search directed to that problem.

1.9 In light of the above, the board is of the view that the appellant not only could but most importantly should have formed its complete case already during opposition proceedings, at the latest during the discussion of inventive step at the oral proceedings before the opposition division. Due to the appellant's course of action, the discussion of inventive step based on the second alleged effect and problem to be solved could not be dealt with by the opposition division and consequently the decision under appeal is not based thereon. Since the appellant has not convincingly demonstrated that this part was admissibly raised and maintained in opposition proceedings and that it was not a mere development of the previous arguments, it results in an amendment which, according to Article 12(4) RPBA 2020 may only be admitted at the discretion of the board.

- 1.10 The appeal proceedings, which are largely determined by the factual and legal scope of the preceding proceedings, are not intended as an opportunity to bring an entirely fresh case to the board. This means that an appellant is not at liberty to shift its case as it pleases, and so to compel the board either to give a first ruling on the critical issues or to remit the case to the opposition division. Conceding such freedom to an appellant would run counter to orderly and efficient appeal proceedings, which are primarily directed to reviewing the correctness of the decision under appeal according to Article 12(2) RPBA 2020.
- 1.10.1 **Against this background, the board, exercising its discretion under Article 12(4) RPBA 2020, does not admit this new line of argument on inventive step based on a second technical problem brought forward for the first time with the statement setting out the grounds of appeal into the proceedings.**
- 1.11 Notwithstanding the above, as also discussed during the oral proceedings with the appellant, it is undisputed that the second indicia could be anything including a dot since it remains unspecified in claim 1, and that it can be located anywhere on the second part of the removable portion. This implies for the board that the mere provision of a second indicia (distinct from the first indicia) on its own cannot be associated with the technical effect underlying the newly formulated problem of providing means for indicating that the quality of the consumer goods may have been compromised. Thus, even if it would have been admitted, the second problem formulated by the appellant could not have led to the acknowledgement of inventive step.



- 1.12 In sum, the board concludes that the appellant has not provided convincing and/or admissible arguments that could show that the opposition division erred in its finding that the subject-matter of claim 1 of the main request does not involve an inventive step in view of the teaching of D2.
2. *Auxiliary requests 1 and 1A - Inventive step, Article 56 EPC*
- 2.1 The subject-matter of claim 1 of auxiliary requests 1 and 1A substantially differs from claim 1 of the main request and from the package of D2 in that the first portion of the removable portion of the wrapper (*i.e.* the portion which is visible before the removable portion is removed) is free of any indicia.
- 2.2 The appellant submitted similar reasons to those already presented for the main request with regard to the inventive step of claim 1 of auxiliary requests 1 and 1A. In particular, the first alleged technical effect of creating an element of surprise was enhanced with respect to the main request and the release of information was now completely controlled due to the absence of any kind of indicia on the visible first part of the removable portion of the wrapper.
- 2.3 In addition, similarly as for the main request, the appellant also relied on a second technical effect directed to the indication of a potential compromise in the quality of the consumer goods, and repeated the same arguments.
- 2.4 The board is not persuaded by the appellant's arguments and is of the view that the subject-matter of claim 1

of auxiliary requests 1 and 1A does not involve an inventive step.

- 2.4.1 With regard to the first technical effect, the board, for the same reasons as for the main request (see in particular points 1.3 and 1.4 above), cannot concur with the appellant that claim 1 of auxiliary requests 1 and 1A differs from the container of D2 in "how" the information is revealed, since both containers reveal all the information contained by the indicia in the exact same way, namely when the removable portion of the wrapper is removed.
- 2.4.2 The board concurs with the opposition division (see point II.17.2 of the reasons for the decision under appeal) that the distinguishing feature of claim 1 of auxiliary request 1 (*i.e.* that the visible part is free of indicia and that the indicia is only provided on the second portion of the removable wrapper) and the alleged effect of creating an enhanced element of surprise based on "what" is communicated to the customer is not linked with a technical contribution to the prior art. In analogy with the main request, the board is of the view that such an alleged effect is purely a mental effect experienced by the user and does not involve any technical considerations. Therefore, the presence of an inventive step cannot be justified by this sole distinguishing feature and effect.
- 2.4.3 With regard to the second technical effect the board does not admit this new line of argument under Article 12(4) RPBA 2020 for the same reasons as set out in points 1.5 to 1.10 above.
- 2.5 In sum, the board concludes that the appellant has not submitted admissible and convincing arguments that

could demonstrate that the subject-matter of claim 1 of auxiliary requests 1 and 1A is inventive over D2.

3. *Conclusion*

In the absence of any allowable set of claims submitted by the appellant, the appeal is to be dismissed.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:



G. Nachtigall

G. Patton

Decision electronically authenticated