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**Datasheet for the decision
of 4 September 2024**

Case Number: T 0991/22 - 3.2.01

Application Number: 14200318.5

Publication Number: 2910135

IPC: A24F47/00, A24D3/04, A24F1/10,
A61M11/04, A61M15/00

Language of the proceedings: EN

Title of invention:
Method and system for vaporization of a substance

Patent Proprietor:
Juul Labs, Inc.

Opponent:
Nicoventures Trading Limited

Headword:

Relevant legal provisions:
EPC Art. 100(c)

Keyword:
Amendments - added subject-matter (yes)

Decisions cited:

T 0883/18

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

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Case Number: T 0991/22 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 4 September 2024

Appellant: Juul Labs, Inc.
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
10 February 2022 concerning maintenance of the
European Patent No. 2910135 in amended form.**

Composition of the Board:

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

Summary of Facts and Submissions

- I. The appeal was filed by the appellant (proprietor) against the interlocutory decision of the opposition division finding that, on the basis of the auxiliary request 2, the patent in suit (hereinafter "the patent") met the requirements of the EPC.
- II. As regards the proprietor's main request to maintain the patent as granted, the opposition division held that the subject-matter of claim 1 extended beyond the content of the application as filed (Article 100(c) EPC).
- III. Oral proceedings were held on 4 September 2024 before the Board.
- IV. **The appellant (patent proprietor)** requested that the decision under appeal be set aside and the patent be maintained as granted.
- The respondent (opponent)** requested that the appeal be dismissed.
- V. Claim 1 of the patent as granted reads:
- 1.1 A portable vaporisation device (10) for generating an inhalable vapour, the device comprising:
 - 1.2 a mouthpiece (11) with an inhalation passage (23) for delivering an inhalable vapour to a user;
 - 1.3 a case (12) with a low temperature vaporisation chamber (15) and a hinged door; and
 - 1.4 a heater (16),

1.5 the chamber being configured to receive a smokeable material (30), access to the chamber being controlled by the hinged door, and

1.6 the heater (16) being operable to heat a smokeable material in the vaporisation chamber (15) to generate a vapour in the chamber,

1.7 wherein at least one of the mouthpiece (11) and the case (12) is provided with an air inlet (22),

1.8 the air inlet being configured such that, in use of the device, when a user draws on the device, fresh air enters through the air inlet, mixes with the vapour in the vaporisation chamber, and the inhalable vapour formed by the mixture is delivered to the user via the inhalation passage (23)

characterized in that

1.9 the portable vaporization device further comprises a control configured to allow the user to select a target temperature from a variety of temperature settings.

Reasons for the Decision

1. Added subject-matter - Article 100(c) EPC

The subject-matter of claim 1 extends beyond the content of the application as filed.

- 1.1 The appellant (patent proprietor) argued that in regard to the alleged intermediate generalisation identified by the opposition division in view of the fuel tank, igniter, and thermal regulator, it was clear to the skilled person that this was just one alternative disclosed in the original application documents, while the other alternatives (e.g., the battery-powered

electric heater and any other compact heat source) were likewise disclosed.

- 1.1.1 The unbiased skilled person would clearly understand from the original application documents (see page 1, first and second paragraphs) that the invention related to a portable vaporisation device having any kind of compact heating system which could either be fuel-based (e.g., a butane heating system), or be formed as a battery-powered electric heater, or it could even be formed as any other compact heat source.
The appellant noted that in the first paragraph of page 1 under "field of the invention", the type of heater was not specified and that the problem identified in the first paragraph under "description of related art" was independent from the type of heater.
This provided the general teaching to the skilled person that the vaporisation device of the application as filed may have a heating system of any one of the types referred to on page 8, fourth paragraph of the description as filed.
- 1.1.2 In regard to the disclosure for the thermal regulator, reference was made to page 7, 3rd paragraph of the original application documents. This passage disclosed that a thermal regulator was used in a preferred embodiment, and was not necessarily connected with a fuel based butane heater. Hence, this passage showed that the thermal regulator was not inextricably linked to a butane or other fuel-based heater.
Furthermore, the last sentence of the third paragraph of page 8 disclosed that the control means could effect a desired temperature electronically. This type of control means was to be used with battery-powered electric heater.

Finally, it was common general knowledge that a battery-powered electric heater could be easily controlled with a temperature sensor and an on-off-switch. When heating was required according to the sensed temperature, the electric heater could be switched on, when no more heating was required because a target temperature had been reached, the electric heater could be switched off. Such approaches were well-within the common knowledge and/or daily practice of the person skilled in the art in the field of designing electric cigarettes.

1.1.3 The appellant further noted that the section entitled "Summary of the Invention" of the original application documents was not the broadest teaching to the skilled person. This paragraph was limited to a fuel-based heater and ignored the explicitly disclosed alternatives. Therefore, it could not be considered as the only possible support for the claims in the original application documents.

1.1.4 The appellant referred to two related cases:

(a) T 0883/18, where claim 1 of EP 1 959 766 B2 directed to a device for generating an inhalable vapor comprising a "heater capable of heating a smokeable material in a cartridge to generate an inhalable vapor" was maintained.

The appellant noted that based on the very same original application documents, there had been no reason for the opposition division and for the Board to raise an added matter objection in view of a lack of a further specification of the heater type in this case.

(b) EP 3 488 716 of the same patent family, where the opposition division explicitly acknowledged that the original application documents provided disclosure for a battery-powered electric heater replacing a butane heating system.

1.1.5 In summary, it was fully in line with Article 123(2) EPC and did not lead to a generalisation at all, let alone to an inadmissible intermediate generalisation, that claim 1 as granted of the opposed patent referred to a "[the] heater (16) being operable to heat a smokeable material in the vaporisation chamber (15) to generate a vapour in the chamber" (feature 1.6), without referring to the specific heater type.

1.2 The Board is not convinced by the arguments brought forward by the appellant. In particular, there is no disclosure in the application as filed of the two following features in combination:

1.6 the heater (16) being operable to heat a smokeable material in the vaporisation chamber (15) to generate a vapour in the chamber, and

1.9 the portable vaporization device further comprises a control configured to allow the user to select a target temperature from a variety of temperature settings.

In the present case, no claims were filed with the application as filed such that basis for independent claim 1 is to be found in the description and the figures as filed.

However, the control configured to allow the user to select a target temperature from a variety of

temperature is disclosed in the application as filed only in relation with the fuel-based heater and not with any kind of heater and in particular not with a battery-powered electric heater.

- 1.2.1 The third paragraph on page 8 of the application as filed recited below only relates to temperature control means in relation with the fuel-based heater.

"In alternate embodiments, a control means would be used to select a variety of temperature settings. The user would choose which setting based on the type of cartridge used. The control means could effect a desired temperature mechanically, such as by changing flow rate of the valve, or electronically, such as by electromechanical valve and micro-controller intermediary".

The first part of the last sentence reciting "changing flow rate of the valve" clearly refers to the embodiment with a fuel-based heater disclosed in the second paragraph of page 7, as the valve is intended to regulate the flow of fuel. So does the second part of the last sentence, disclosing achieving a desired temperature electronically "such as by electromechanical valve and micro-controller intermediary", as also this electromechanical valve can only be read as a valve for regulating the flow of fuel. Hence, the selection of a desired temperature made "electronically" as disclosed in paragraph 3 of page 8 is specific to the fuel-based heater, and there is no basis for concluding that it is also intended for the alternative with a battery-powered electric heater (where no flow of fuel, and thus no valve, would be required).

- 1.2.2 The first two sentences of the third paragraph of page 7 states: *"In the preferred embodiment, a thermal regulator is used. In an alternate embodiment, the device is constructed without an active regulating element"*. These sentences cannot be taken in isolation out of their context. These two sentences disclose two alternative embodiments for a fuel-based heater with a thermal regulator and without an active thermal regulator. This is clear from the subsequent following sentence: *"In this case, the flow of butane is set at a low level"* and the preceding paragraph (second paragraph on page 7) which relates to a thermal regulator for a fuel-based heater.
- 1.2.3 For the question of added subject-matter, a direct and unambiguous disclosure is necessary in the application as filed. Whether it would be obvious for the skilled person to use electrical control means to regulate the temperature in battery powered electric heater is irrelevant for the question of added subject-matter.
- 1.2.4 The combination of the first two paragraphs of page 1 with the fourth paragraph of page 8 to arrive at the subject-matter of claim 1 does not provide a disclosure of the combination of features 1.6 and 1.9. Indeed, page 1 generally indicates that there is a need of providing a temperature control of the heater, and the fourth paragraph of page 8 discloses that a battery-powered electric heater may be used instead of the butane heating system. This provides however no disclosure of a control which is specifically configured to allow the user to select a target temperature from a variety of temperature settings also in case of a battery-powered electric heater being used.

1.2.5 As to the two cases cited by the appellant (T 0883/18, concerning EP 1 959 766 B2 and the opposition regarding EP 3 488 716), a closer look at these cases shows that in both cases, the patent application was filed with claims. Moreover, the independent claim 1 in these cases did not comprise the combination of a heater in general with a control configured to allow the user to select a target temperature from a variety of temperature settings.

In case T 0883/18 the discussion related to article 123(2) EPC concerned the feature of *"the air inlet or inlets directed downward through the mouthpiece, or along a diagonal through the mouthpiece"*. The heater was not discussed by the parties.

In the opposition related to EP 3 488 716, the patent was revoked. Under point 3.1.1 last paragraph, the opposition division stated that: *"The feature wherein the heater is a battery-powered electric heater can be derived from the description on page 7 of an embodiment in which a battery-powered electric heater replaces the butane heating system"*. However, in the present case the question is whether a heater in general is disclosed in combination with a control configured to allow the user to select a target temperature from a variety of temperature settings in the application as filed.

1.3 To conclude, the main request is not allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. Schalow

G. Pricolo

Decision electronically authenticated