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**Datasheet for the decision
of 14 October 2024**

Case Number: T 1191/22 - 3.2.01

Application Number: 15867132.1

Publication Number: 3228198

IPC: A24F47/00

Language of the proceedings: EN

Title of invention:

ATOMIZATION DEVICE AND ELECTRONIC CIGARETTE CONTAINING SAME

Patent Proprietor:

Joyetech (Changzhou) Electronics Co., Ltd.

Opponent:

Weickmann & Weickmann Patent- und
Rechtsanwälte PartmbB

Headword:

Relevant legal provisions:

EPC Art. 52(1), 54
EPC R. 80, 103(4)(c)

Keyword:

Novelty - main request (no) - auxiliary request (yes)
Reimbursement of appeal fee - (no)

Decisions cited:

T 0937/00, T 0256/19

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 1191/22 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 14 October 2024

Appellant: Joyetech (Changzhou) Electronics Co., Ltd.
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
18 March 2022 concerning maintenance of the
European Patent No. 3228198 in amended form.**

Composition of the Board:

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

Summary of Facts and Submissions

- I. The appeal filed by the appellant (patent proprietor) is directed against the interlocutory decision of the opposition division maintaining the European patent No. 2 908 673 in amended form.

A notice of appeal was filed by the opponent, but the appeal of the opponent was withdrawn with letter dated 27 June 2022 and no statement of grounds of appeal was filed. Apart from the filing of the notice of appeal and of the withdrawal of the appeal, no submissions were made by the respondent (opponent) in these appeal proceedings.

In its decision the opposition division held that the ground for opposition pursuant to Article 100(a) in association with Article 54 EPC was prejudicial to the maintenance of the patent as granted. Furthermore, the opposition division did not admit the auxiliary requests 1 and 2 into the proceedings for lack of compliance with the requirements of Rule 80 EPC and decided to maintain the patent in amended form according to the auxiliary request 3. Novelty of independent claim 1 of the patent as granted was assessed in view of the following prior art document:

D9: EP 2 599 513 A1

- II. With the communication according to Rule 100(2) EPC dated 19 April 2024 (re-issued on 27 June 2024 because erroneously not sent to the opponent), the Board informed the parties of its preliminary assessment of the case according to which the decision under appeal was likely to be set aside and the patent could be

maintained according to the auxiliary request 1 filed with the statement of grounds of appeal.

With a letter dated 17 June 2024 filed in response to the communication of the Board, the appellant (patent proprietor) withdrew their request for oral proceedings and requested a decision based on the state of the file and the partial reimbursement of the appeal fee pursuant to Rule 103(4) EPC.

With a communication of the registry dated 5 July 2024, the parties were informed that a decision would be issued in due time based on the appeal written submissions of the parties and that the request for partial reimbursement of the appeal fee of the appellant (patent proprietor) could not be granted.

With a letter dated 7 October 2024 following a telephone conversation with the registrar dated 27 September 2024, the respondent (opponent) also withdrew their request for oral proceedings and requested a decision based on the state of the file.

III. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or, in the alternative, according to the auxiliary requests 1 and 2 filed with the statement of grounds of appeal, the auxiliary request 2 corresponding to the version of the patent as maintained by the opposition division. Further auxiliarily, it was requested to reverse the decision of the opposition division not to admit the auxiliary request 1 and to remit the case to the opposition division for further prosecution. Following withdrawal of the request for oral proceedings, partial reimbursement of the appeal fee pursuant Rule 103(4)

EPC was requested.

IV. Independent claim 1 according to the patent as granted reads as follow:

"An atomizing device (13, 23, 33, 43) comprising:

1.1 a heating member (133, 233, 333, 433); and

*1.2 a temperature control switch (139, 239, 339, 439);
wherein*

1.3a the temperature control switch is positioned adjacent to the heating member, or

1.3b the heating member is sleeved on the temperature control switch, 1.4 the heating member is coupled to the temperature control switch in series, and

1.5 the heating member and the temperature control switch are electrically coupled to a power supply device;

characterized in that:

1.6 the temperature control switch is provided for directly controlling a temperature of the heating member; and

1.7 when a temperature t_s of the temperature control switch is less than an operating temperature T_M of the temperature control switch, the temperature control switch is switched on,

1.8 when the temperature t_s is greater than the

operating temperature T_M , the temperature control switch is switched off.

Independent claim 1 according to the auxiliary request 1 differs from independent claim 1 as granted in that the alternative corresponding to feature 1.3a is deleted. Furthermore, in the set of claim according to auxiliary request 1 new independent claims 12 to 15 are added, wherein:

independent claim 12 corresponds to a combination of the additional features of granted claims 8 and 2, wherein claim 8 has been restricted only to the alternative 1.3a of granted claim 1,

independent claim 13 corresponds to a combination of the additional features of granted claims 8 and 4, wherein claim 8 has been restricted only to the alternative 1.3a of granted claim 1;

independent claim 14 corresponds to a combination of the additional features of granted claims 8 and 5, wherein claim 8 has been restricted only to the alternative 1.3a of granted claim 1; and

new independent claim 15 corresponds to a combination of the additional features of granted claims 8 and 7, wherein claim 8 has been restricted only to the alternative 1.3a of granted claim 1.

Reasons for the Decision

MAIN REQUEST - PATENT AS GRANTED

Article 52(1) and 54 EPC: Novelty

1. The subject-matter of claim 1 as granted does not meet the requirements of Articles 52(1) and 54 EPC as correctly found by the opposition division.

1.1 The appellant (patent proprietor) did not submit any comments in response to the preliminary opinion of the Board regarding the objection of lack of novelty over document D9 as set forth in the communication pursuant to Rule 100(2) EPC dated 19 April 2024. Therefore, the Board has no reason to deviate from its preliminary conclusion regarding this issue which is herewith confirmed and reads as follows:

1.2 With their appeal, the appellant (patent proprietor) contested the conclusion of the opposition division that the subject-matter of claim 1 as granted lacked novelty over document D9. It was alleged that this prior art document did not directly and unambiguously disclose features 1.7 and 1.8 of claim 1 requiring that:

"when a temperature t_s of the temperature control switch is less than an operating temperature T_M of the temperature control switch, the temperature control

switch is switched on", and

"when the temperature t_s is greater than the operating temperature T_M , the temperature control switch is switched off",

respectively.

1.3 The appellant (patent proprietor) argued that the skilled person reading the claim in the light of the description understood that the term "*temperature control switch*" in independent claim 1 referred to a self-activating switch that switched at some inherent threshold temperature. In their opinion and in contrast thereto, D9 disclosed a temperature switch comprising a bimetallic regulator 10 which could be adjusted by means of a temperature selector 6 arranged on a rotary shaft 18 carried by a holding strip 17. Hence, so the appellant (patent proprietor), there was no intrinsic threshold temperature of the bimetallic regulator 10 of D9 that defined the switching point.

1.4 The appellant's (patent proprietor's) argument is not convincing because the claim does not specify at all that the threshold temperature is an intrinsic property of the control switch. Further, the switching capacity of the bimetallic regulator is also due to its intrinsic property of deforming of an amount depending on temperature (and indeed a bimetallic strip switch is contemplated in the patent itself, see paragraph [0074]). The fact that the threshold of the bimetallic regulator 10 of D9 can be set by means of the temperature selector 6 does not deprive the bimetallic regulator 10 of its properties i) of being a self-activating switch, due to the bimetallic properties, and ii) of switching at some threshold temperature,

which is inherent to the switch configuration as set by a temperature selector. Finally, claim 1 also encompasses embodiments in which the threshold of the temperature switch may be adjusted (e.g. by means of a control circuit or other means; note also that according to the patent in suit a processor can control the switch, paragraph [0087]), as it is the case of the switch of document D9.

- 1.5 Although this is not relevant for the assessment of novelty over D9 in view of the above, it is additionally noted that in any case the appellant's (patent proprietor's) attempt to read the claim in a restricted manner based on specific embodiments is flawed because the description does not support a reading in which there is only a fixed operating temperature TM of the temperature control switch.
- 1.6 Independent claim 1 as granted thus lacks novelty over D9 as correctly assessed by the opposition division, whereby the main request is not allowable.

AUXILIARY REQUEST 1

- 2. This auxiliary request corresponds to the auxiliary request 1 underlying the decision under appeal.
- 2.1 In section 5 of the contested decision, entitled "Admissibility", the Opposition Division decided "not to admit the auxiliary request 1 into opposition procedure under Rule 80 EPC" . In the Board's view, section 5 somewhat confuses the admissibility of auxiliary request 1, which might indeed have been an issue as the request was filed during oral proceedings and could have been objected as late-filed pursuant to Rule 116 EPC and possibly not admitted (e.g. because

prima facie not allowable), with the allowability thereof in the sense of meeting the requirements of Rule 80 EPC. In this respect, the Board agrees with the reasoning in decision T 256/19 (see point 4.7), according to which Rule 80 EPC is a non-discretionary provision with a substantive requirement that relates to the allowability of a patent as amended rather than to admissibility, i.e. whether or not an amended version of the patent should be admitted into the opposition or appeal proceedings.

In any case, the finding of the opposition division contested by the appellant was that auxiliary request 1 was not admitted because it did not meet the requirements of Rule 80 EPC.

2.2 It has thus to be examined whether the amendments introduced in this auxiliary request were occasioned by a ground for opposition under Article 100 EPC - as required by Rule 80 EPC and submitted by the appellant (patent proprietor).

2.3 Independent claim 1 of the auxiliary request 1 corresponds to claim 1 of the version of the patent found allowable by the opposition division. Compared with independent claim 1 of the patent as granted, the alternative reflected by feature 1.3a is deleted, thereby restricting the protection afforded by independent claim 1 to the second alternative recited in feature 1.3b. Therefore, the amendment introduced in independent claim 1 of auxiliary request 1 has to be regarded as having been occasioned by a ground for opposition, namely by the ground for opposition pursuant to Article 100(a) in association with Article 54 EPC. This was indeed recognized by the opposition

division that considered novel and inventive the identical independent claim 1 of the patent as maintained. However, the opposition division took the view that the amendment consisting in the introduction of new independent claims 12 to 15 was not originated by a ground for opposition and therefore concluded that the auxiliary request 1 did not comply with the requirements of Rule 80 EPC.

2.4 This cannot be followed:

It is firstly noted that, as stated e.g. in decision T 937/00 (point 2.1 of the reasons), there are no objection of principle to a patentee amending its claims in response to an opposition so that they comprise several independent claims directed to different objects originally covered by a single generic claim of a given category, when such claim cannot be maintained.

In the present case, the Board is satisfied with the argument of the appellant (patent proprietor) that it is the legitimate interest of the patent proprietor to protect their invention to the maximum possible extent, thereby excluding in a post-grant opposition proceedings only subject-matter which was initially covered by the granted claims and which cannot be maintained in view of a ground of opposition, in the present case the first alternative aspect of the invention reflected by feature 1.3a which had to be deleted in view of the disclosure of D9. The Board takes the view that the introduction of independent claims 12 to 15 in the auxiliary request 1 is a legitimate reaction of the appellant (patent proprietor) triggered by the successful ground of opposition pursuant to Article 100(a) EPC which was

considered prejudicial to the maintenance of the patent as granted wherein a single independent claim covered both alternatives of the invention according to features 1.3a and 1.3b. By introducing independent claims 12 to 15, which are a combination of granted dependent claims, namely of claim 8 with claims 2, 4, 5 and 7 respectively, the appellant (patent proprietor) legitimately preserved the alternative aspect of the invention corresponding to feature 1.3a of claim 1 by introducing further limitations with respect to the disclosure of D9. The Board cannot see in this approach of the appellant (patent proprietor) any abuse of the opposition proceedings as alleged by the opposition division.

2.5 The Board additionally notes that the decision of the opposition division not to admit the auxiliary request 1 was also motivated with other reasons, namely i) lack of convergence of the independent claims, ii) unallowable use of multiple independent claims (Article 84 and Rule 43(2) EPC) and iii) alleged negative impact on procedural efficiency in view of the presence of multiple independent claims. These further reasons are however all deriving from the wrong assumption that Rule 80 EPC does not allow for restricting the claimed subject-matter by way of formulating multiple independent claims and cannot therefore hold.

2.6 In view of the above the Board judges that the opposition division was wrong in non admitting auxiliary request 1 in the opposition proceedings because it did not meet the requirements of Rule 80 EPC, irrespective of whether the finding was one of inadmissibility (which would anyway be flawed as based on wrong premises) or on non-allowability (which is in

substance incorrect for the reasons given above).

2.7 Hence, the auxiliary request 1 is admitted into the appeal proceedings (Article 12(6) RPBA.)

3. The Board notes

i) that the decision under appeal in respect of the auxiliary request 1 only deals with its admissibility under Rule 80 EPC,

ii) that the respondent (opponent) has withdrawn their request for oral proceedings and has requested a decision on the state of the file, and

iii) that in the absence of any submissions and in particular of a reply in due time to the communication of the Board, informing the parties that it intended to set aside the decision of the opposition division and remit the case to the department of first instance with the order to maintain the contested patent on the basis of the auxiliary request 1 and a description to be adapted, there is no case of the respondent (opponent) in appeal as regards auxiliary request 1.

3.1 Under these circumstances, and considering that the Board of its own motion sees no reason not to allow the auxiliary request 1, the claims according to the auxiliary request 1, with a description to be adapted, can form the basis for the maintenance of the patent in amended form.

Request for partial reimbursement of the appeal fee

4. The request for oral proceedings of the appellant (patent proprietor) was not withdrawn within one month

of the communication issued by the Board in preparation for the oral proceedings, as prescribed by Rule 103(4) (c) EPC. In fact, in the present appeal proceedings, no date for oral proceedings had been set, and hence no communication in preparation for the oral proceedings had been issued by the Board. Therefore, the request for partial reimbursement of the appeal fee cannot be granted.

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 claims of the auxiliary request 1 filed with the statement of grounds of appeal and a description to be adapted thereto.
3. The request for partial reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



M. Schalow

G. Pricolo

Decision electronically authenticated