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**Datasheet for the decision
of 26 June 2025**

Case Number: T 1693/23 - 3.2.04

Application Number: 18214917.9

Publication Number: 3494817

IPC: A24F40/40, A24F40/42

Language of the proceedings: EN

Title of invention:

METHOD AND SYSTEM FOR VAPORIZATION OF SUBSTANCE

Patent Proprietor:

JT International SA

Opponent:

Philip Morris Products S.A.

Headword:

Relevant legal provisions:

EPC Art. 100(c), 76(1)

Keyword:

Divisional application - subject-matter extends beyond content
of earlier application (yes)

Decisions cited:

G 0002/10

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 1693/23 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 26 June 2025

Appellant:
(Patent Proprietor)

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Appellant:
(Opponent)

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Representative:

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Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office posted on
7 July 2023 concerning maintenance of the
European Patent No. 3494817 in amended form.**

Composition of the Board:

Chairman

A. Pieracci

Members:

G. Martin Gonzalez

C. Heath

Summary of Facts and Submissions

- I. The opponent appeals the interlocutory decision of the opposition division to maintain the patent according to an auxiliary request 2 before it.

The patent proprietor withdrew their appeal with letter of 3 March 2025.

- II. The opposition division held inter alia that dependent claims 5 and 6 of all requests analysed in the appealed decision, namely the main request (patent as granted) and auxiliary requests 1 and 2 (auxiliary request 2 corresponds to the maintained claims), did not contain added subject-matter extending over the contents of the great-grandparent application (WO 2007/012007).

- III. The proprietor originally - as appellant - requested that the decision under appeal be set aside and the patent maintained as granted (main request), or that the patent be maintained in accordance with one of auxiliary requests 1-7, filed with the grounds of appeal. These requests correspond to same numbered auxiliary requests before the opposition division and thus auxiliary request 2 corresponds to a request to dismiss the opponent's appeal. Proprietor auxiliary requested oral proceedings. After withdrawing the appeal, the proprietor did not modify their original requests.

The appellant opponent requests that the decision under appeal be set aside and revocation of the opposed patent in its entirety. They auxiliary request oral proceedings.

- IV. In preparation for oral proceedings the board issued a communication setting out its provisional opinion on the relevant issues.

Following the proprietor's letter of 18 June 2025 indicating that they will not attend the oral proceedings scheduled for 10 July 2025, the board cancelled the oral proceedings and hereby issues its decision in writing.

- V. Dependent claims 5 and 6 of all proprietor's requests read as follows:

5. "The portable hand-held device of claim 4, wherein the tobacco comprises at least one of glycerin and flavoring."

6. "The portable hand-held device of any one of claims 4 and 5, wherein the tobacco is chopped tobacco chopped into fine pieces less than 3 mm in diameter."

- VI. In the present decision, reference is made to the following document:

WO 2007/012007 - Great-grandparent application of the opposed patent.

- VII. The parties' arguments relevant to the decision are discussed in detail in the Reasons for the Decision.

Reasons for the Decision

1. Background

The invention relates to a low temperature vaporisation device for use with tobacco products. The device of the invention has a main body with a vaporisation chamber and a heater, see patent specification para 0001. The vaporisation chamber comprises a cavity, a tobacco cartridge can be inserted into the cavity of the vaporisation chamber for vaporising smoking material, see paras 0016 and 0042. The bottom of the cartridge may have receptacles which, when combined with complementary features on the surface cavity of the vaporisation chamber, would allow more surface contact and hence improved heat conduction, see para 0045 and claim 1.

2. Added subject-matter of claims 5 and 6 - All requests

2.1 The appellant opponent contests the conclusions of the opposition division regarding added subject-matter of dependent claims 5 and 6, which are identical across all requests.

2.2 The opposition division held that dependent claims 5 and 6 of the main request did not contain added subject-matter over the contents of the great-grandparent application WO 2007/012007 (see appealed decision sections 8.4.7 and 8.4.8). Since dependent claims 5 and 6 are unchanged across all requests, the division's conclusion applies to all requests.

2.3 In its written communication in preparation for the oral proceedings, the board provided its preliminary opinion on this issue (sections 5.5 and 6.1), stating:

"5.5 There also appears to be no direct and unambiguous basis for the isolation of features in granted **claims 5 and 6** from the original disclosure of the type of smokeable material in the test cartridge described on original p. 9, ln. 4-11, as explained in III.4 and III. 5 of the opponent's reply of 27 March 2024. While the skilled person may recognise the specific combination as an example and that other combinations may be used (see proprietor's reply of 21 October 2024, sections 2.10-2.11), the specific combinations now claimed by claims 5 and 6 do not seem to have a direct and unambiguous basis in the original great-grandparent application."

"6.1 None of the auxiliary requests effectively address the added subject-matter objections regarding dependent **claims 5 and 6**. Thus, none of the proprietor's requests appear allowable."

2.4 Having reviewed its preliminary opinion, the board finds no reason to depart from it. Page 9, lines 4-11 of the great-grandparent application, cited as the basis for the contested claims, reads:

"Here, tobacco or tobacco material is defined as any combination of natural and synthetic material that can be vaporized for pleasure or medicinal use. As an example, one test cartridge was prepared as embodiment of the present invention using flue-cured tobacco, glycerin, and flavorings. Those skilled in the art of tobacco product manufacture

are familiar with these and other ingredients used for cigarettes, cigars, and the like. The test cartridge was produced by chopping tobacco into fine pieces (less than 3mm diameter, preferably less than 2mm), adding the other ingredients, and mixing until even consistency was achieved."

This passage discloses only one single example - "one test cartridge" - containing all three components: "flue-cured tobacco, glycerin, and flavourings" (emphasis by the board). In contrast, the subject-matter of claims 5 and 6 encompasses combinations containing only glycerin without flavouring, or vice versa, or using tobacco that is not flue-cured - none of which are directly and unambiguously disclosed in the cited passage.

2.5 The opposition division (see section 8.4.7 of the decision) and the patent proprietor (see reply of 21 October 2024, sections 2.10-2.11) argue that the skilled person, based on common general knowledge, would recognise that the specific combination disclosed could be generalised - for example, by replacing flue-cured tobacco with generic tobacco, or by omitting either glycerin or flavouring.

2.6 However, this line of reasoning does not meet the required standard for allowable amendments. In assessing whether or not subject-matter has been added the board applies the "gold standard" i.e. what is within the limits of what a skilled person would derive *directly and unambiguously*, using common general knowledge, seen objectively and at the date of filing, from the whole of the original application documents (**G2/10**). As consistently held in the case law, a clear distinction has to be made between the questions

whether a particular embodiment was directly and unambiguously disclosed by an application and whether that embodiment was merely rendered obvious by the application disclosure (see Case Law of the Boards of Appeal (CLB), 10 edition 2022, II.E.1.3.4.a). Similarly, as also repeatedly emphasized in the case law, a distinction must be made between what the original documents of a patent directly and unambiguously disclose to a skilled person and what said skilled person on the basis of this disclosure may do upon reflection and using his imagination. His thinking is not part of the content of the original documents of the patent (CLB II.E.1.3.4.b).

In the present case, the great-grandparent application discloses only one specific composition with three components. Omitting one of them results in a different composition. The arguments advanced by the opposition division and the patent proprietor reflect either obvious modifications of the only disclosed embodiment or hypothetical variants which could be conceived by the skilled person - neither of which meets the required standard of direct and unambiguous disclosure. Granted claims 5 and 6 therefore constitute added subject-matter.

- 2.7 The board therefore concludes that all of the proprietor's requests add subject-matter extending beyond the content of the great-grandparent application WO 2007/012007, contrary to Article 100(c) EPC and Article 76(1) EPC.

3. The board is therefore unable to uphold the conclusion of the decision under appeal that the maintained claims do not contain added subject-matter, and must set that decision aside. Furthermore, in view of the amendments made by the respondent proprietor, the patent and the invention to which it relates do not meet the requirements of the Convention, and the patent must be revoked pursuant to Article 101(3)(b) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



G. Magouliotis

A. Pieracci

Decision electronically authenticated