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**Datasheet for the decision  
of 25 February 2025**

**Case Number:** T 1224/24 - 3.2.01

**Application Number:** 18912633.7

**Publication Number:** 3777577

**IPC:** A24F40/53, A61M11/04,  
A61M15/06, G05B19/042

**Language of the proceedings:** EN

**Title of invention:**

AEROSOL GENERATION DEVICE, CONTROL METHOD, AND PROGRAM

**Applicant:**

Japan Tobacco Inc.

**Headword:**

**Relevant legal provisions:**

EPC Art. 94(3), 97(1), 113(2), 153(4)

EPC R. 71(3), 71(5), 71(6), 101(1), 140, 159(1)(b), 103(1)(a)

**Keyword:**

Admissibility of appeal - appellant adversely affected despite decision to grant a patent (yes)

Deemed approval of the text for grant under Rule 71 (5) EPC (no)

Substantial procedural violation - patent granted without approval of the text for grant (yes)

**Decisions cited:**

T 2081/16, T 1003/19, T 0408/21, T 1823/23, T 0265/20,  
G 0001/10, J 0004/09

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

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Case Number: T 1224/24 - 3.2.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.01**  
**of 25 February 2025**

**Appellant:** Japan Tobacco Inc.  
(Patent Proprietor) 1-1, Toranomon 4-chome  
Minato-ku  
Tokyo 105-6927 (JP)

**Representative:** Hoffmann Eitle  
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81925 München (DE)

**Decision under appeal:**

**Composition of the Board:**

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

### Summary of Facts and Submissions

- I. The appeal lies from the decision of the examining division to grant a European patent on the basis of the application documents indicated in the communication under Rule 71(3) EPC dated 13 December 2023 following examination of European patent application No. 18 912 633.7, which was filed on 26.03.2018 as an international application with publication No. WO 2019/186669.
- II. The English translation of the international application as filed upon entry into the European phase was composed of a description of 89 pages, a set of 21 claims and 52 figures.
- III. With the request for entry into the European phase, the applicant specified the application documents on which the European grant procedure was to be based (Rule 159(1) (b) EPC), as follows:

Documents intended for proceedings before the EPO (R. 159 (1) (b) EPC) and for calculating the additional fee (Art. 2, item 1a, RFees):

		Page(s) from ... to ...	Number of pages
Description:	Amendments filed on entry into European phase	1-54	54
Claims:	Amendments filed on entry into European phase	1-2	2
Drawings:	Translation of international application as published	1-2,4-27,29-36,38,39,41-5 2	48
	Amendments filed on entry into European phase	3,28,37,40	4
Abstract:	Default count: one page		1
Total number of pages			109

- IV. The European patent application A1, published in accordance with Article 153(4) EPC, contained 52 figures.
  
- V. All communications from the examining division under Article 94(3) EPC, dated respectively 13 April 2022 and 17 May 2023, mentioned that, for the figures, the examination was carried out on the amended drawing sheets 1/4-4/4 filed with entry into the regional phase before the EPO.
  
- VI. With letter dated 13 September 2023, the applicant submitted further amendments to the claims and requested grant of a patent based on the submitted documents "and the remaining pending application documents".
  
- VII. In a communication under Rule 71(3) EPC dated 13 December 2023, the applicant was informed that the examination division intended to grant a European patent on the basis of the following documents:

**Description, Pages**

2-53	filed with entry into the regional phase before the EPO	
1, 1a	filed in electronic form on	16-09-2021

**Claims, Numbers**

1-14	filed in electronic form on	13-09-2023
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**Drawings, Sheets**

1/4-4/4	filed with entry into the regional phase before the EPO	
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with some amendments to the description (amended pages 1a and 53 and deletion of page 54) and to claim 1.

Apart from the four amended drawings submitted upon entry into the regional phase before the EPO, none of the remaining 48 originally filed drawings were

included in this list. Also the "Druckexemplar" sent as an annex to the applicant included only four Drawing Sheets, numbered 3/52, 28/52, 37/52 and 40/52, along with four figures numbered 3, 30, 39 and 42.

- VIII. The appellant subsequently filed a translation of the claims in the two other official languages and paid the fee for grant and publishing within the period indicated in the communication dated 13 December 2023.
- IX. On 3 May 2024 the examining division issued the decision to grant a European patent under Article 97(1) EPC, in the form specified in the communication under Rule 71(3) EPC.
- X. The applicant (appellant) filed an appeal against the decision to grant the patent. It requested that the decision under appeal be set aside and that the case be remitted to the examining division with the order to grant a patent based on the following documents:
- a description with pages 1 and 1a as filed on 16 September 2021 and pages 2 to 53 as filed with entry into the European phase, whilst taking into account the amendments applied to pages 1a and 53 with the communication under Rule 71(3) of 13 December 2023;
  - claims 1 to 14 as filed on 13 September 2023 and taking into account the amendments applied to claim 1 with the communication under Rule 71(3) of 13 December 2023; and
  - drawings including (original) sheets titled 1/52, 2/52, 4/52 to 27/52, 29/52 to 36/52, 38/52, 39/52 and 41/52 to 52/52 as well as (amended) sheets titled 3/52, 28/52, 37/52 and 40/52 that were all filed and specified pursuant to Rule 159(1)(b) EPC with entry into the European phase.

They also requested reimbursement of the appeal fee.

XI. In the statement of grounds of appeal, the appellant argued that the appeal is admissible, as they are adversely affected by the omission of 48 drawings sheets that were part of their request in the decision to grant a patent.

They also argued that the decision under appeal suffered from several substantial procedural violations:

- Lack of sufficient reasoning regarding why certain documents forming part of the request for grant were omitted from the text communicated under Rule 71(3) EPC,
- Violation to their right to be heard, as they were not provided with any explanation for the omission of the drawings and had no opportunity to comment on these omissions.
- The text communicated under Rule 71(3) EPC cannot be considered as the text "intended" to be granted. Therefore, no explicit or deemed approval to the text was given by the appellant - see decisions T 2081/16, T 1003/19, T 0408/21.

XII. In a communication, the Board provided its preliminary opinion, stating that the appeal appeared to be admissible and allowable, but the request for reimbursement of the appeal fee was to be rejected.

XIII. With letter dated 30 January 2025, the appellant withdrew their request for reimbursement of the appeal fee, and the board issued the present decision based on the written proceedings.

## Reasons for the Decision

1. Admissibility of the appeal.
  - 1.1 The appeal is admissible since the appellant is adversely affected by the omission of 48 out of 52 drawings in the decision to grant. The granted version of the patent corresponds neither to the text submitted by the applicant, nor to a text agreed upon or deemed approved by the applicant.
  - 1.2 In the letter dated 13 September 2023, the applicant requested the grant of the patent based on the amended claims 1-15 annexed to the letter and the "remaining pending application documents". To determine the precise meaning of this statement, it is necessary to refer to the file history. A review of the file history reveals that while several versions of the description and claims were submitted by the applicant on 16 September 2021, 2 August 2022, 10 August 2022, and 13 September 2023, the figures or drawing sheets were never amended or partially withdrawn. This indicates that the drawings forming part of the applicant's request for grant were those filed with the request for entry into the European phase—namely, the original drawing sheets 1/52, 2/52, 4/52 to 27/52, 29/52 to 36/52, 38/52, 39/52, and 41/52 to 52/52, along with the amended drawing sheets 3/52, 28/52, 37/52, and 40/52, which were submitted on 27 September 2020 upon entry into the European phase. All these drawings were correctly published in the A1 application.
  - 1.3 The communication under Rule 71(3) EPC dated 13 December 2023 proposed amendments to the description and to claim 1 but did not indicate that the text



intended for grant differed from the applicant's request regarding the drawings. Furthermore, no prior communication from the examining division proposed amendments to the drawings filed by the applicant, or contained any comments on them. All communications stated that, for the figures, the examination was carried out on the amended drawing sheets 1/4-4/4 as filed upon entry into the regional phase before the EPO. However, the file contains no explicit approval from the applicant for the removal of the remaining 48 originally filed drawings. It appears that neither the members of the examining division nor the appellant realized that the original drawing sheets 1/52, 2/52, 4/52 to 27/52, 29/52 to 36/52, 38/52, 39/52 and 41/52 to 52/52 were omitted and only the amended drawing sheets 3/52, 28/52, 37/52 - renumbered 1/4- 4/4 - were considered by the examining division.

- 1.4 According to Rule 71(3) EPC, first sentence: "*Before the Examining Division decides to grant the European patent, it shall inform the applicant of the text in which it intends to grant it and of the related bibliographic data.*" Rule 71(5) EPC further provides : "*if the applicant...pays the fees... and....files the translations..., he shall be deemed to have approved the text communicated to him under paragraph 3, and verified the bibliographic data.*" In accordance with T 1003/19 (catchword and point 2.4 of the reasons), T 1823/23 (point 1.9 of the reasons), T 2081/16 (point 1.4 of the reasons), the Board considers that the legal consequence set out in Rule 71(5) EPC can only apply if the communication under Rule 71(3) EPC reflects the examining division's intention regarding the application documents on which the patent is to be granted.

1.5 This conclusion is drawn from the unambiguous wording of Rule 71(3) EPC, which uses the verb "intends", clearly indicating the intention of the examining division. Deemed approval under Rule 71(5) EPC can only occur after a text compliant with Rule 71(3) EPC has been communicated to the applicant. Rule 71(5) EPC is not a stand alone provision. Simply paying the fee and filing translations does not trigger deemed approval regardless of the communicated text's content. The text must conform to Rule 71(3) EPC, to which Rule 71(5) EPC refers, and align with the examining division's intention regarding the application documents that form the basis for granting the patent. Otherwise, the subsequent fee payment and translation filing remain ineffective.

1.6 This conclusion does not absolve the applicant of the responsibility to carefully review the content of the communicated text. Rule 71(6) EPC namely allows the applicant to request reasoned amendments or corrections to the communicated text. However, this provision applies only to texts communicated in accordance with Rule 71(3) EPC, which reflect the examining division's intention regarding the application documents that form the basis for granting the patent. This specifically addresses situations where the communication refers to the correct documents intended for grant, but these documents contain clerical mistakes or inaccuracies that the applicant wishes to rectify, or the applicant is not satisfied with the amendments explicitly proposed by the examining division to the text they submitted. However, if the communicated text does not reflect the examining division's intention for granting the patent, neither the absence of a correction or amendment request under Rule 71(6) EPC, nor the payment of the fee and filing of translations under Rule 71(5)

EPC will have any legal consequence. The Board finds that this conclusion not only aligns with the clear wording of Rule 71(3) EPC, but also safeguards the applicant from being seriously prejudiced by the impossibility to request corrections under Rule 140 EPC (see G 1/10, points 8-12 of the Reasons).

1.7 Under normal circumstances, it can be assumed that the text referred to in a communication under Rule 71(3) EPC reflects the examining division's intention regarding the text on which the patent is to be granted. However, this is not the case when objective elements in the communication and/or in the text annexed to the it, such as significant discrepancies between the communication and the "Druckexemplar", or within the "Druckexemplar" itself, clearly indicate that the text does not correspond to the examining division's intention (see T 1003/19, points 2.4.3 and 2.4.4).

1.8 In the case at hand, it can only be concluded that the omission of the 48 drawings as originally filed was never intended by the examining division:

- As mentioned in point 1.3 above, in the course of the examining proceedings, the examining division never raised any objections to the original filed drawings, nor did it provide any reasons for deleting drawing sheets 1/52, 2/52, 4/52 to 27/52, 29/52 to 36/52, 38/52, 39/52 and 41/52 to 52/52. The Office's standard practice is to indicate amendments proposed by the examining division in the "comments" field of Form 2004C, used for communications under Rule 71(3) EPC, rather than including them only in the "Druckexemplar" annexed to the communication. In the case at hand, this field was used by the examining division to propose

minor changes to the description and to claim 1, but the need to amend or delete some of the drawing sheets forming part of the appellant's request for grant was not mentioned.

- As noted by the appellant, the description in the "Druckexemplar" annexed to the Rule 71(3) EPC communication still lists all figures 1-52 (see paragraph [0017]) and repeatedly refers to the deleted figures (see for instance paragraph[37], [69], [89], [100], [113], [122], [126], 134, [136], [152], [168] etc.). However, the "Druckexemplar" only contains 4 figures.
- The designation of the drawing sheets in the Rule 71(3) EPC communication as "1/4 - 4/4". is inconsistent with the drawing sheets included in the annexed "Druckexemplar", which are labelled "3/52", "28/52", "37/52" and "40/52".

1.9 Therefore, the Board concludes in the present case that neither the documents referred to in Form 2004C nor the "Druckexemplar" reflected the text in which the examining division intended to grant the patent. Hence the text communicated to the applicant with the communication of 13 December 2023 did not correspond to the text intended for grant under Rule 71(3) EPC.

1.10 If the applicant is not communicated the text intended for grant under Rule 71(3) EPC, the legal consequence outlined in Rule 71(5) EPC does not apply. Therefore, the applicant's subsequent filing of translations and payment of fees for grant and publishing do not imply approval of the communicated text.

1.11 Since the text on which the patent was granted did not align with the applicant's request, nor was it agreed upon or deemed approved by the applicant, the applicant

was adversely affected by the decision under Article 97(1) EPC. All other requirements under Rule 101(1) EPC being met, the Board concludes that the appeal is admissible.

2. Allowability of the appeal

2.1 A decision to grant under Article 97(1) EPC, based on a text that was neither submitted nor agreed upon by the applicant, as is this case (see points 1.1- 1.11 above), does not comply with Article 113(2) EPC. Therefore, the decision under appeal is to be set aside.

2.2 The Board is aware of decision T 0265/20, which also involves an appeal against the decision to grant a patent due to discrepancies between the appellant's explicit requests during the examination and the content of the B1 publication. Although the competent Board acknowledged the admissibility of the appeal, it did not follow the approach taken in decisions T 1003/19 and T 2081/16, and ultimately dismissed the appeal. However, the present Board, does not consider decision T 0265/20 to represent diverging case law, as the circumstances of the two cases are different :

- In the present case, only some drawing sheets were missing, whereas in T 0265/20 no drawings were included in the Rule 71(3) EPC communication. Thus, there was no inconsistency between the designation of the drawing sheets in the Rule 71(3) EPC communication and the "Druckexemplar", unlike in the current case.
- In the present case, the Board identified multiple objective elements indicating that the Rule 71(3) EPC communication did not reflect the examining division's intention regarding the application

documents intended for the grant of the patent. In contrast, in T 0265/20, the competent Board could not conclude "in the case at hand" that the "true will of the examining division is something that has to be taken into consideration when making a judgement regarding the deemed approval and its binding effect".

- The competent Board in T 0265/20 did not consider decisions T 1003/19 and T 2081/16 as diverging case law and thus did not refer the matter to the Enlarged Board of Appeal. Consequently, there is no reason to view decision T 0265/20 as diverging from the present decision, which aligns with T 1003/19 and T 2081/16 .

2.3 Finally, the board considers that the present decision does not deviate from G 1/10, which determined that Rule 140 EPC cannot be used to correct the text of a patent, but did not concern the interpretation of Rule 71 (5) EPC. Therefore, Article 21 RPBA does not apply. The Board fully agrees with and refers to the reasoning in T 2081/16 (point 3) and T 1003/19 (point 4).

### 3. Reimbursement of the appeal fee

3.1 The request for reimbursement of the appeal fee was withdrawn by the appellant and the Board on its own does not consider reimbursement equitable in this case, despite the substantial procedural violation affecting the decision under appeal (Rule 103(1)(a) EPC).

3.2 Indeed, the applicant had several opportunities during the examination proceedings to identify the error regarding the drawing sheets. All communications from the examining division under Article 94(3) EPC, dated 13 April 2022 and 17 May 2023, stated that the

examination of the figures was conducted solely on the amended drawing sheets 1/4-4/4, as submitted upon entry into the regional phase before the EPO. This error was also present in the communication under Rule 71(3) EPC dated 13 December 2023. The applicant could and should have identified the error at the latest when reviewing the text in the Rule 71(3) EPC communication. Consequently, the applicant did not take advantage of the available opportunities to participate in the initial proceedings (J 04/09, Reasons 4).

## **Order**

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

1. The decision under appeal is set aside.
2. The case is remitted to the examining division with the order to grant a patent on the basis of the following documents:
  - Description : pages 1, 1a and 2-53 as contained in the "Druckexemplar" annexed to the communication of the examining division under Rule 71(3) EPC of 13 December 2023
  - Claims 1-14 as contained in the "Druckexemplar" annexed to the communication of the examining division under Rule 71(3) EPC of 13 December 2023,
  - Figures: original drawings sheets 1/52, 2/52, 4/52 to 27/52, 29/52 to 36/52, 38/52, 39/52 and 41/52 to 52/52, as well as amended drawing sheets 3/52, 28/52, 37/52 and 40/52 filed upon entry into the regional phase before the EPO.

The Registrar:

The Chairman:



H. Jenney

G. Pricolo

Decision electronically authenticated