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**Datasheet for the decision
of 5 August 2010**

Case Number: T 0479/09 - 3.2.04

Application Number: 03752865.0

Publication Number: 1509097

IPC: A24F 17/00

Language of the proceedings: EN

Title of invention:
Pads of cigarette rolling papers

Patentee:
Sustainable Trading Limited

Opponent:
Reemtsma Cigarettenfabriken GmbH

Headword:

-

Relevant legal provisions:

-

Relevant legal provisions (EPC 1973):

EPC Art. 100(a)(b)

Keyword:

"Sufficiency of disclosure (yes)"
"Novelty and inventive step (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 0479/09 - 3.2.04

DECISION
of the Technical Board of Appeal 3.2.04
of 5 August 2010

Appellant: Reemtsma Cigarettenfabriken GmbH
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Representative: Both, Georg
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Respondent: Sustainable Trading Limited
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Representative: Buckley, Guy Julian
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
19 December 2008 concerning maintenance of the
European patent No. 1509097 in amended form.

Composition of the Board:

Chairman: M. Ceyte
Members: C. Scheibling
T. Bokor

Summary of Facts and Submissions

- I. In its interlocutory decision posted 19 December 2008, the Opposition Division found that, taking into consideration the amendments made by the patent proprietor, the European patent and the invention to which it relates met the requirements of the EPC. On 19 February 2009 the Appellant (opponent) filed an appeal and paid the appeal fee simultaneously. The statement setting out the grounds of appeal was received on 28 April 2009.
- II. The patent was opposed on the grounds based on Article 100(a) (lack of novelty, inventive step and industrial application) and (b) EPC. The objection based on lack of industrial application was withdrawn during the oral proceedings before the Board.
- III. The following documents played a role in the present proceedings
- D1: US-A-5 762 074
D2: US-A-5 322 076
D5: www.wrap.org.uk/downloads/glossary-into-sheet
(a brief dictionary of paper and print terms)
- IV. Oral proceedings before the Board took place on 5 August 2010.

The Appellant (Opponent) requested that the decision under appeal be set aside and that the patent be revoked.

He mainly argued that the weight of the cigarette paper expressed in the units gm^2 or g m^2 has the dimension of a moment of inertia. Therefore the skilled person would be completely confused and unable to carry out the claimed invention.

The sole feature not explicitly expressed in D1 is the specific weight of the cigarette paper. The claimed weight range is however an inherent property of reconstituted tobacco cigarette paper.

Claim 1 does not exclude the presence of other components, such as a gum layer. Furthermore, D1 indicates that the stack of cigarette papers can be bound like the 3M® Post-it™ office paper pads and thus by a repositionable pressure sensitive adhesive applied between each sheet.

Therefore, the subject-matter of claim 1 is not novel or at least does not involve an inventive step with respect to D1.

The Respondent (Patentee) contested the arguments of the Appellant and submitted that:

The units gm^2 or g m^2 are commonly used to express the weight of paper in grams per square metre.

The reference made in D1 to the 3M® Post-it™ paper pads is ambiguous and can only refer to the way the stack of cigarette papers is presented, i.e. as a bound pad.

D1 fails to disclose or suggest that a repositionable pressure sensitive adhesive may be used to adhere the individual sheets together into a stack, let alone that a repositionable pressure sensitive adhesive used to adhere the sheets may be used to seal the tobacco in the rolled cigarette. In D1 it is the gum which is applied to each sheet which is used to seal the tobacco in the rolled cigarette.

The Respondent (Patentee) requested that the decision under appeal be set aside and the patent be maintained on the basis of the set of claims filed as auxiliary request 3 during the oral proceedings before the Board and promoted to main and sole request.

V. Claim 1 reads as follows

"1. A pad of cigarette rolling papers for making self-rolled cigarettes consisting of

- i) a base sheet (2) having a top side and a bottom side, and
- ii) a stack (1) of cigarette papers comprising an uppermost paper, a lowermost paper and a plurality of papers between said uppermost and lowermost papers, wherein each cigarette paper in the stack consists of
 - a) cigarette paper having a weight of from 5 to 40 gm², wherein each paper sheet (3) of said stack (1) has a top side (6) facing away from said base sheet (2) and a bottom side (4) facing said base sheet, and
 - b) a layer of repositionable pressure sensitive adhesive (7), wherein each paper of said stack (1) is of substantially the same shape and size, wherein the lowermost paper sheet of said stack (1) is adhered to the top side of said base sheet (2), and wherein at least a portion of the bottom side (4) of each paper (3) of said stack (1) located above said lowermost paper is provided with the layer of repositionable pressure sensitive adhesive (7) that adheres said sheet to the paper sheet (5) immediately below it."

Reasons for the Decision

1. The appeal is admissible.

2. *Objection under Article 100b) EPC 1973*

The Appellant argued that "all disclosure in the patent specification relating to the claimed pad gives the weight of the cigarette paper in the units gm^2 or g m^2 . The dimension expressed by this unit is ... the dimension of a moment of inertia" and that therefore, the skilled person would be completely confused and unable to carry out the invention.

This point of view cannot be shared. Any skilled person in the paper industry will have no problem in understanding the units involved as the units gm^2 or g m^2 are well understood and commonly used to mean grams per square metre, all the more, because as indicated inter alia in D5 which is a glossary defining paper print terms "gm2" is a way of expressing the weight of paper in grams per square metre.

3. *Novelty and inventive step*

- 3.1 Interpretation of claim 1

The term "consisting of" is commonly and consistently used in claims and patent literature to indicate that the list of features introduced by this term is exhaustive. Furthermore, there is no embodiment disclosed in the patent specification which could lead to another interpretation of this term, i.e. to assume that other components might be present too.

Therefore, the Board sees no reason to give this term a different meaning than the usual one.

3.2 Novelty

D1 (column 2, lines 44 to column 3, line 1; column 4, lines 15 to 21 and 51 to 56) discloses a pad of cigarette rolling papers for making self-rolled cigarettes comprising a stack (18) of cigarette papers comprising an uppermost paper, a lowermost paper and a plurality of papers between said uppermost and lowermost papers, wherein each sheet of cigarette paper in the stack (18) has a layer of gum (16) applied along a long edge (12) of each sheet (10) and wherein each paper of said stack (18) is of substantially the same shape and size and is provided with tearable adhesive (22) applied to one side of the stack formed by the contiguous long edges (12) of the stacked sheets (10), thereby binding each of the plurality of sheets (10) into a stack (18).

Thus, the pad of cigarette rolling papers of claim 1 mainly differs from that of D1 in that

- it comprises a base sheet,
- the cigarette paper has a weight of from 5 to 40 gm²,
- there is no layer of gum applied to a long edge of each sheet,
- the lowermost paper sheet of said stack is adhered to the top side of said base sheet, and at least a portion of the bottom side of each paper of said stack located above said lowermost paper is provided with a layer of repositionable pressure sensitive adhesive that adheres said sheet to the paper sheet immediately below it.

The Appellant argued that the claimed weight range is inherent to reconstituted tobacco sheets. He referred in this respect to D2 which indicates that the weight of reconstituted tobacco paper sheets ranges from 30 g/m² to 100 g/m² and usually from 40 g/m² to 80 g/m² (column 7, line 64 to column 8, line 2). However, in the Board's opinion, the disclosed ranges in D2 are significantly different from those claimed, so that the claimed weight range of 5 to 40 g/m² is not inherent to reconstituted tobacco paper sheets.

Consequently, the subject-matter of claim 1 is novel with respect to D1.

3.3 Inventive step

The problem to be solved by the claimed invention with respect to D1 as closest prior art could be seen in providing a pad of cigarette rolling papers which is easier and more comfortable to use.

In D1 it is stated on column 2, line 64 to column 3, line 1: "The bound pad is formed by applying a tearable adhesive to one side of the stack, thereby binding each of the plurality of sheets into a bound stack of individual removable sheets (most analogous to the currently popular 3M® Post-it™ office note pads)".

The Appellant submitted that this passage suggests the skilled person an alternative way of forming a bound stack of rolling papers which would be easier and more comfortable to use.

Although it is not quite clear what the above quoted passage is intended to mean but as rightly stated in the decision of the opposition division, there is certainly no suggestion in D1 to substitute the tearable adhesive applied to one long side of the stack with a layer of repositionable pressure sensitive adhesive applied between each sheet of cigarette paper.

Moreover as indicated in section 3.1 above, by using the term "consisting of" the use of a gum layer in addition to the layer of a repositionable pressure sensitive adhesive is clearly excluded in claim 1. In D1 however a layer of gum is present in all embodiments in order to seal the cigarettes once rolled (column 2, lines 45 to 48, column 4, lines 4 to 6 and 53 to 56, Figures 2 and 3B).

Thus even if the skilled person had thought of applying a repositionable pressure sensitive adhesive for adhering the sheets together in a stack, he would have made use of a layer of gum applied along the opposite long edge of the sheet for sealing tobacco in the rolled of cigarette as taught by D1. Nothing in this prior art would have led him to the idea of using the repositionable pressure sensitive layer used to adhere the sheets together in a stack for sealing tobacco in the rolled of cigarette.

Accordingly, in the Board's judgement the subject-matter of claim 1 involves an inventive step (Article 56 EPC). The opposition grounds thus do not prejudice the maintenance of the patent as amended.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance with the order to maintain the patent as amended in the following version:

Description: columns 1, 2 of the patent specification
columns 3 to 8 filed during the oral
proceedings before the Board

Claims: 1 to 5 filed during the oral proceedings

Drawings: Figures 1 to 3 (page 9) of the patent
specification.

The registrar:

The Chairman:

G. Magouliotis

M. Ceyte