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**Datasheet for the decision
of 21 February 2019**

Case Number: T 0972/16 - 3.2.04

Application Number: 08844115.9

Publication Number: 2205105

IPC: A24B13/00, A24B15/28, A23L27/00

Language of the proceedings: EN

Title of invention:
SMOKELESS ORAL TOBACCO COMPOSITION AND METHODS OF MAKING THE
SAME

Patent Proprietor:
British American Tobacco (Investments) Limited

Opponent:
Swedish Match North Europe AB

Headword:

Relevant legal provisions:
EPC R. 101(1)
EPC Art. 56

Keyword:

Admissibility of appeal - (yes)

Inventive step - (yes)

Decisions cited:

T 0095/10, T 1002/92, T 0611/90

Catchword:



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Case Number: T 0972/16 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 21 February 2019

Appellant: British American Tobacco (Investments) Limited
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Appellant: Swedish Match North Europe AB
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
18 February 2016 concerning maintenance of the
European Patent No. 2205105 in amended form.

Composition of the Board:

Chairman J. Wright
Members: C. Kujat
C. Heath

Summary of Facts and Submissions

I. The appellant-opponent lodged an appeal, received 18 April 2016, against the interlocutory decision of the Opposition Division of the European Patent Office posted on 18 February 2016 concerning maintenance of the European Patent No. 2205105 in amended form, and paid the appeal fee at the same time. Their statement setting out the grounds of appeal was filed on 17 June 2016.

The appellant-proprietor also lodged an appeal against the above decision on 27 April 2016, paying the appeal fee at the same time. They filed their statement of grounds of appeal on 20 June 2016. The appellant-proprietor withdrew their appeal with letter of 1 February 2019. Therefore the appellant-opponent is the sole appellant and the proprietor is respondent.

II. Opposition was filed against the patent as a whole and based inter alia on Article 100(a) together with Articles 52(1) and 56 EPC for lack of inventive step. In its decision, the division held, inter alia, that the patent as amended according to an auxiliary request (main request in appeal) met all the requirements of the EPC because, amongst other reasons, the subject matter of claim 1 of that request involved an inventive step. In its decision, the opposition division referred to the following document, amongst others:

D1: US 4515769

III. In the course of the appeal proceedings the appellant-opponent submitted the following evidence:

D9 : New Encyclopedia Britannica, 15th edition, volume 3, page 424 "cocoa butter".

D10: WO 99/41993

D11: EP 0664959 A

D12: Geoff Talbot (editor) "Science and Technology of Enrobed and Filled Chocolate, Confectionary and Bakery Products", 1st Edition, published 26 June 2009, Chapter 15.4, pages 322 to 324, K. Smith, "Cocoa butter and polymorphism."

D9 to D11 were filed with the appellant-opponent's grounds of appeal and D12 was filed with their letter of 17 January 2017.

- IV. In a communication of 22 November 2018 in preparation for oral proceedings scheduled for 18 April 2019, the Board gave a preliminary opinion on the case.
- V. With a letter of 10 December 2018, the appellant-opponent informed the Board that they would not attend oral proceeding. Following established case law, this is equivalent to a withdrawal of the request for oral proceedings (see CLBA, III.C.2.3.1 and the decisions cited).
- VI. The appellant-opponent requests that the decision under appeal be set aside and that the patent be revoked in its entirety.
- VII. The respondent-proprietor requests that the appeal of the opponent be held non-admissible, in the alternative that the appeal of the opponent be dismissed (maintenance of the patent as upheld by the opposition division).

VIII. The independent claims of the main request (as upheld by the opposition division) read as follows:

Claim 1: "A moist smokeless tobacco product, comprising moist smokeless tobacco, and a flavourant, characterised in that the flavourant is comprised in a matrix comprising a water-soluble carbohydrate based material or gelatine, the matrix being encapsulated in a hydrophobic encapsulating agent, wherein the melting point of the encapsulating agent is above 30°C and below 40°C".

Claim 8: "A method of producing a moist smokeless tobacco product, characterised in that the method comprises providing a flavourant in a matrix comprising a water-soluble carbohydrate-based material or gelatine, and encapsulating said matrix in a hydrophobic encapsulating agent, wherein the melting point of the encapsulating agent is above 30°C and below 40°C".

IX. The appellant-opponent argued as follows:

The [appellant-opponent's] appeal is admissible. The subject matter of the claims of the main request (as maintained) lack inventive step starting from D1 with the skilled person's general knowledge (D9 and D12) or with D10 and D11.

X. The respondent-proprietor argued as follows:

The appellant-opponent's appeal is not admissible because it is a fresh case. The appellant-opponent's arguments are based on new documents and have, prima facie, not proven that the claims of the main request lack inventive step. It follows that these documents

and the associated arguments should not be admitted into the proceedings and the patent should be maintained in the version held allowable by the impugned decision.

Reasons for the Decision

1. Admissibility of the opponent's appeal

1.1 The Board set out the following reasoned (preliminary) opinion in its communication of 22 November 2018 (see sections 4.1 to 4.4) as to why they considered the opponent's appeal to be admissible:

"4.1 Admissibility of the opponent's appeal under Rule 101(1) EPC

The impugned decision is appealable, Article 106 EPC. As required by Article 107 EPC, the appellant-opponent is adversely affected by the impugned decision to maintain the patent in amended form, since they requested the patent to be revoked in its entirety (see impugned decision, point 2). Furthermore, the appellant-opponent filed a notice of appeal and statement of grounds of appeal within the prescribed time limits, meeting the formal requirements of Article 108 with Rule 99 EPC.

4.2 The proprietor argues that the opponent's grounds of appeal provide no argumentation which addresses the reasons for the impugned decision, thus would not meet the requirements of Article 108, third sentence EPC with Rule 99(2) EPC. The argument boils down to the appeal being a "fresh case" vis-à-vis the opposition.

4.3 *It is established case law that an appeal raising a case different from that on what the decision under appeal was based ("fresh case") but on the same opposition ground, is in principle admissible (cf. Case Law of the Boards of Appeal, 8th edition, 2016 (CLBA) IV.E.2.6.5 a) and the decisions cited therein, in particular T 661/90 [T611/90], reasons point 2). The Board sees no reason to diverge from this well established approach.*

4.3.1 *The Board notes that in the present case, the appellant-opponent addresses the same opposition ground - lack of inventive step - which was contentious in opposition proceedings and which forms an important part of the reasoning of that decision in respect of the present second auxiliary request (referred to as the first auxiliary request in opposition, section 17).*

4.3.2 *Applying the approach outlined above, the Board is of the preliminary opinion that the appeal of the opponent is admissible.*

4.4 *The appellant-proprietor has cited other jurisprudence which they consider demonstrates the opponent's appeal as inadmissible. In particular they refer to CLBA, IV.E. 2.6.3 b) , grounds to be analysed vis-a-vis reasons in decision, in particular T 213/85 and T 95/10, the second and third reasons for finding lack adequate substantiation.*

The Board notes that those cases dealt with the situation where the grounds of appeal did not address the decisive issue of the decision but merely other issues of the opposition proceedings (see for example T 95/10, reasons point 1, T 213/85, headnote). As already explained, in the present case the impugned decision

dealt with inventive step, as does the opponent's appeal. Therefore, the above jurisprudence cited by the appellant-proprietor appears not to be relevant for the present case".

- 1.2 Neither the appellant-opponent (see their letter of 10 December 2018) nor the respondent-proprietor (see letters of 10 January 2019 and 1 February 2019) have commented on the Board's opinion in this respect. Absent any such comments, the Board sees no reason to deviate from its preliminary opinion. Therefore, the Board concludes that the appeal of the opponent is admissible.

2. Main request, claim 1, inventive step

- 2.1 The appellant-opponent set out arguments in their grounds of appeal as to why they considered the impugned decision was wrong to maintain the patent in amended form according to the present main request (auxiliary request 2 in opposition proceedings). These arguments were new in appeal and based on D1 in combination with the skilled person's common general knowledge as exemplified by D9 and additionally D12 and D1 combined with either D10 or D11.

- 2.2 In its communication of 22 November 2018 (see section 5), the Board presented their (provisional) opinion that these arguments did not take away inventive step of claim 1, and that none of the documents D9 to D12 should be admitted into the proceedings. In this regard the Board's opinion read as follows:

5. Admissibility of arguments/evidence filed first with appeal

5.1 *It may be necessary for the Board to decide on admittance of D9, D10 and D11 and the associated arguments, filed with the appellant-opponent's grounds of appeal. Also D12, filed with a subsequent letter.*

5.2 *Documents D9, D10 and D11 (and associated arguments) were filed for the first time with the grounds of appeal and therefore outside the opposition period. Therefore they are late filed and their admittance is subject to the Board's discretion, Article 114(2) EPC with Article 12(4) RPBA.*

According to settled jurisprudence of the Boards of appeal, admissibility of late filed evidence/associated arguments depends, inter alia, on whether the late submission is justified, for example by developments in the proceedings, and whether the documents are prima facie highly relevant so that their admittance would be likely to change the outcome of the proceedings, see CLBA IV.C.1.1.4, in particular T 1002/92, grounds for the decision, point 3.3.

In the present case, there appears to have been no development in the proceedings that would justify filing evidence so late, as the claim set of this request was filed on 10 December 2013.

5.3 *Prima facie relevance of D9, D10, D11 and D12*

Claim 1 differs from claim 1 of the main request in defining (added feature emphasised by the Board in underscore) that the melting point of the encapsulating material is above 30°C and below 40°C.

Following the discussion of claim 1 vis-à-vis D1 for the main request [the Board considered D1 to disclose

the remaining features of claim 1 of the present main request, see communication, section 2], the Board is of the provisional opinion that D1 does not disclose the encapsulating material (e.g. polyvinyl acetate) to have a melting point below 40°C. As already explained, D1 discloses (column 8, lines 42 to 60) encapsulating materials that melt above 30°C and stay solid at mouth temperature, which is close to 40°C.

5.4 Formulation of the objective technical problem

5.5 It is true that the effect of choosing a set of compounds melting between 30°C and 40°C has the effect that they will melt in the mouth. The patent (see published specification, paragraph [0038]) gives no particular advantage to this release arrangement, it is merely said to be a thermal release arrangement [on placing in the mouth].

5.6 The impugned decision see reasons, point 17.4) and the appellant-opponent (see appellant-opponent's grounds of appeal, point 4.4) formulated the problem as being to "provide an alternative [flavour] release [arrangement]" for the encapsulated flavourant in a smokeless tobacco product. This appears not to be disputed by the appellant-proprietor, who merely comments that there are numerous ways of achieving an alternative release (see letter of 1 November 2016, page 5, third paragraph). The Board also considers that finding an alternative flavour release arrangement is a realistic formulation of the objective technical problem.

5.6.1 In considering the prima facie relevance of the new arguments presented by the appellant-opponent, it will need to be discussed whether, starting from D1 and

faced with the objective (alternative flavour release) problem, these new arguments would lead to the invention as claimed as a matter of obviousness. In the Board's provisional opinion they would not.

5.6.2 According to the established jurisprudence, see CLBA, I.D.3.4.3, although a person skilled in the art is completely free in choosing a starting point, afterwards they are bound by that choice.

5.7 In the present case D1 discloses an encapsulated flavourant for an orally used product that will not immediately dissolve in the mouth but which gives a flavour burst when chewed (abstract). D1 consistently presents this as an important aspect of the disclosure. In particular (column 1, lines 46 to 52, column 3, lines 16 to 22) the water insoluble material should give a delayed release of substantially all flavourant achieved (see column 4, lines 16 to 22 and column 5, lines 11 to 13) only after breaking the encapsulating material by chewing. To this end the encapsulating material (see example, column 8, lines 50 to 55) will resist being dissolved under the temperature condition of the mouth but releases flavour on fracturing. In summary (column 16, line 59 to column 17, line 2) D1's invention uses an insoluble outer coating that delays release of flavourant "until fractured".

5.8 In the Board's view, when seeking an alternative flavour release arrangement for the products of D1, the skilled person would not consider using an encapsulating substance that melted in the ambient conditions of the mouth. To do so would, prima facie, appear to go against an important aspect of D1's teaching, namely that the encapsulation stays intact until broken by chewing. Therefore, in the Board's

preliminary opinion, none of the documents D9 (see entry "cocoa butter"), D10 (see for example claim 1) and D11 (see page 8, lines 1 and 2, lines 22 to 23 and 38 to 40), all of which relate to cocoa butter which is known to melt at between 30 and 40°C, are prima facie relevant as combinatory documents with D1.

5.9 Therefore, the Board is of the preliminary opinion that D9, D10 and D11 should not be admitted into the proceedings.

2.3 However relevant the teaching of non-patent literature D12 might appear to be (filed with letter of 17 January 2017), it was published in 2009 so is not prior art. Therefore, the Board does not intend to admit it into the proceedings, either".

3. As with the issue of admissibility, neither the appellant-opponent (see their letter of 10 December 2018) nor the respondent-proprietor (see letters of 10 January 2019 and 1 February 2019) have commented on the Board's opinion in respect of inventive step of claim 1 of the main request (see in particular the communication, point 5.6.1). Since there are no such comments, the Board sees no reason to change its preliminary opinion. Therefore, the Board concludes that the arguments brought in appeal by the appellant-opponent against claim 1 of the main request have, prima facie, not proven a lack of inventive step (cf. impugned decision, point 17.5). Therefore these arguments and associated documents cannot be admitted into the proceedings.

3.1 Since claim 8 recites the same features as claim 1, albeit expressed in terms of method steps, the above conclusion also applies to this claim and for the same

reasons. The remaining claims are dependent on claims 1 or 8. Therefore, the appellant-opponent's inventive step arguments in respect of these claims (using the same prior art/general knowledge as for claim 1) are moot. The appellant-opponent has not presented any other arguments in respect of this request.

4. For these reasons, the arguments presented by the appellant-opponent have not convinced the Board that the impugned decision was wrong in finding that the patent as amended according to the present main request meets the requirements of the EPC.
5. The Board also notes that the appellant-opponent's announcement that they would not attend oral proceedings is equivalent to a withdrawal of the request for oral proceedings (see CLBA, III.C.2.3.1 and the decisions cited). Furthermore, the Board likewise interprets the respondent-proprietor's statement (see letter of 10 January 2019, last paragraph) as a withdrawal of their request for oral proceedings conditional on their present main request being held to be allowable. Since this is the case, the Board is in a position to decide without oral proceedings.
6. It follows from the above that the Board must dismiss the opponent's appeal.

Order

For these reasons it is decided that:

The appeal is dismissed

The Registrar:

The Chairman:



G. Magouliotis

J. Wright

Decision electronically authenticated