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**Datasheet for the decision
of 1 December 2020**

Case Number: T 0783/17 - 3.2.01

Application Number: 07789552.2

Publication Number: 2007232

IPC: A24D1/02

Language of the proceedings: EN

Title of invention:

SLIT BANDED PAPER

Patent Proprietor:

Philip Morris Products S.A.

Opponent:

British American Tobacco (Investments) Ltd

Headword:

Relevant legal provisions:

EPC Art. 123(2), 84

RPBA 2020 Art. 11

Keyword:

Amendments - extension beyond the content of the application
as filed (no)

Claims - clarity (yes) - interpretation of ambiguous terms

Remittal - special reasons for remittal

Decisions cited:

Catchword:



Beschwerdekammern
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Case Number: T 0783/17 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 1 December 2020

Appellant: Philip Morris Products S.A.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 17 January 2017
revoking European patent No. 2007232 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman G. Pricolo
Members: V. Vinci
S. Fernández de Córdoba

Summary of Facts and Submissions

- I. The appeal was filed by the appellant (patent proprietor) against the decision of the opposition division to revoke the patent in suit pursuant Article 101(3)(b) EPC.
- II. The opposition division decided that the patent as granted and according to the auxiliary requests 2 to 4 and 6 to 9 did not fulfill the requirements of Article 123(2) EPC and that the subject-matter of claims 1 and 12 of the auxiliary request 5 lacked clarity in the meaning of Article 84 EPC.
- III. Oral proceedings were held before the Board on 1 December 2020. No one was present on behalf of the respondent (opponent) as announced by letter dated 17 November 2020.
- IV. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the second auxiliary request as main request or auxiliary according to one of the auxiliary requests 3 to 9 as filed during the opposition procedure or according to a new auxiliary request 10 as announced in the statement of grounds of appeal.
- V. The respondent requested in writing that the appeal be dismissed.
- VI. Claim 1 of the second auxiliary request reads as follows:

A wrapper of a smoking article, comprising:
a base web (100); and

at least one transverse banded region (10)(20)(30) comprising first (11)(21)(31), second (12)(22)(32) and third (13)(23)(33) zones, said first (11)(21)(31) and third (13)(23)(33) zones comprising add-on material, which reduces permeability of said wrapper, said first and third zones being separated by said second zone (12)(22)(32), said wrapper having greater permeability along said second zone (12)(22)(32) than along said first (11)(21)(31) and third (13)(23)(33) zones, said second zone having a width less than the width of either of the said first and third zones, characterised in that the add-on material is uniform across each of the first (11)(21)(31) and third (13)(23)(33) zones;

said first (11)(21)(31) and third (13)(23)(33) zones each have a width of 2 mm to 5 mm such that if either of said first or third zone were applied separately to wrappers of smoking articles the smoking articles would exhibit statistically significant occurrences of total burn through and statistically few or no occurrences of self-extinguishment under free burn conditions;

the sum of said widths of said first (11)(21)(31) and third (13)(23)(33) zones is such that if the first and third zones were applied to wrappers of smoking articles as a single continuous band, the smoking articles would exhibit statistically few or no occurrences of total burn through and statistically significant occurrences of self-extinguishment under free burn conditions, so that lit smoking articles comprising said first (11)(21)(31), second (12)(22)(32) and third (13)(23)(33) zones exhibit statistically reduced occurrences of self-extinguishment under free burn conditions, as compared to smoking articles

comprising wrappers whereon the first and third zones are applied as a single continuous band, while maintaining statistically few or no occurrences of total burn through.

Claim 17 of the second auxiliary request reads as follows:

A method of making a banded wrapper according to any preceding claim comprising:

supplying a base web (100); and

forming at least one transverse banded region (10) (20) (30) comprising first (11) (21) (31), second (12) (22) (32) and third (13) (23) (33) zones on the base web;

wherein the first (11) (21) (31) and third (13) (23) (33) zones are outward of the 6 second (12) (22) (32) zone, wherein the second zone (12) (22) (32) has a greater permeability compared to the first (11) (21) (31) and third (13) (23) (33) zones, wherein the width of the second zone (12) (22) (32) is less than those of the first (11) (21) (31) and third (13) (23) (33) zones, characterised in that the first (11) (21) (31) and third (13) (23) (33) zones are formed so that the add-on material is uniform across each of the first and third zones and in that the first (11) (21) (31) and third (13) (23) (33) zones are formed so that each of the first and third zones has a width of 2 mm to 5 mm such that if either of said first or third zone were applied separately to wrappers of smoking articles the smoking articles would exhibit statistically significant occurrences of total burn through and statistically few or no occurrences of self-extinguishment under free

burn conditions.

VII. The appellant's arguments can be summarised as follows:

The appellant contested the assessment of the opposition division that the omission of the indication of the width of the second zone in claims 1 and 17 results in an unallowable intermediate generalisation of a preferred embodiment disclosed in the originally filed application infringing Article 123(2) EPC. The appellant argued that the person skilled in the art would clearly and unambiguously recognize that it would be possible to depart from the preferred ranges assigned to the width of the second zone as disclosed in the specific embodiment of the invention presented on page 5, line 36 to page 6, line 2 of the originally filed specification and select any width for the second zone provided that, as clearly disclosed on page 3, lines 28-33, this width is less than the width of either of the first and third zones. The appellant pointed out that the width of the second zone is not functionally related or inextricably linked to the particular range claimed for the width of the first and third zones, but that the only essential condition required by the contested patent is that the second zone has a width less than the width of either of the first and third zones.

Regarding to the lack of clarity objected in respect of the expressions "statistically few or no occurrences" (claims 1 and 17) and "statistically reduced occurrences" (claim 1) raised by the opposition division in respect to the auxiliary request 5 which analogously applies to the second auxiliary request, the appellant observed that the claims have to be read by the person skilled in the art within their technical

context, namely the manufacturing of wrapper for smoking articles. An expert in this technical field is aware that, due to the fact that the tobacco material forming the rod of the smoking article is a natural product constituted by pieces and particles of different dimensions and characteristics randomly arranged along the length of the article, the smoldering behaviour of nominally identical smoking articles will inevitably slightly vary from article to article. The use of the expression "*statistically few or not occurrences*" takes such a possible slightly different and not fully predictable behaviour of nominal identical smoking articles into account and is interpreted by the person skilled in the art in statistically terms, namely as meaning that although no occurrences of self-extinguishing under free burn conditions and no occurrences of total burn through would represent the ideal and advisable situation, it should be expected and accepted that, for the reasons given above, few smoking articles of a certain batch will not show the expected ideal smoldering behaviour.

Having regard to the expression "*statistically reduced occurrences*" the appellant pointed out that it is clear when reading the claim as a whole, that what is meant is that reduced occurrences compared to the occurrences affecting smoking articles comprising wrappers on which the first and third zones are applied as a single continuous band take place.

At the oral proceedings the appellant further observed that the same arguments apply to the expression "*statistically significant occurrences*" which the person skilled in the art would read and understand in view of the testing standard applied for determining whether the smouldering and ignition behaviour of a

certain batch of smoking articles statistically complies with the safety regulations in place or not. Reference was made to the "*ASTM Standard E2187-04*" according to which it is required that at least 75% of a batch of 40 cigarettes laying on a substrate must self-extinguish in order to meet the safety regulations.

VIII. The respondent's arguments as submitted in writing can be summarized as follows:

Having regard to the objection under Article 123(2) EPC, the respondent supported the conclusion and the reasoning of the opposition division. It was argued that according to the preferred embodiment disclosed on page 5, line 36 to page 6, line 2 of the originally filed description a specific range of 1mm to 2mm for the width of the second zone is associated to a specific range of 2 mm to 5 mm given for the width of the first and third zones. The omission of the range for the width of the second zone in the claims leads to an unallowable intermediate generalisation infringing Article 123(2) EPC.

Regarding to the clarity objections, the opponent argued in writing that the expression "*few occurrences*" and "*statistically reduced occurrences*" are relative expressions deprived of any well-recognized meaning in the relative prior art. In the absence of any indication in the patent specification of the threshold to be applied in order to fall within the scope of the claims, these expressions result in a lack of clarity within the meaning of Article 84 EPC.

Reasons for the Decision

Article 123(2) EPC

1. In the contested decision, the Opposition Division rejected the patent proprietor's main request, to maintain the patent as granted, in view of added subject-matter (Article 100(c) EPC) for two reasons:

(i) the removal of the term "statistically" in independent claims 1 and 17; and

(ii) the unallowable intermediate generalisation resulting from the omission of the width for the second zone.

Further, the Opposition Division rejected the patent proprietor's second auxiliary request, corresponding to the main request in these appeal proceedings, for reason (ii) only.

Claims 1 and 17 of the main request in appeal proceedings differ from claims 1 and 17 of the patent as granted only in that the term "statistically" has been reinstated where it was present in originally filed claim 1. Accordingly, reason (i) no longer applies.

As regards reason (ii), the Board does not follow the conclusion of the opposition division that claims 1 and 17 of the auxiliary request 2 contain an unallowable intermediate generalisation. The reasons are the following:

- 1.1 As convincingly pointed out by the appellant, the passage of the description on which the amendments made to claims 1 and 17 in examination proceedings are based only proposes preferred ranges for the width of the first and third zones ("*..for example, 2mm to 5mm ..*") on one side and preferred ranges for the width of the second zone (" *..for example, 1mm to 2mm ..*") on the other side. As both ranges are indicated as being purely exemplary, the person skilled in the art, unlike the view of the respondent and of the opposition division, would directly and unambiguously derive that these exemplary ranges are not disclosed as being functionally related or inextricably linked to each other. As correctly put forward by the appellant, this conclusion is supported by the passage on page 3, lines 28-33 of the originally published application stating that the invention merely requires that the width of the second zone is less than the width of either the first and third zones. The omission in claims 1 and 17 of the particular range 1m to 2mm for the width of the second zone does not thus result in any new information with respect to the originally filed application.
- 1.2 The respondent did not raise any other objections of added subject-matter in respect of the main request in appeal proceedings.
- 1.3 The Board concludes therefore that the main request in appeal proceedings meets the requirements of Article 123(2) EPC.

Article 84 EPC

2. The objections of lack of clarity raised by the opposition division in respect of the expressions "*statistically few or no occurrences*" and

"*statistically reduced occurrences*" of claims 1 and 12 of the auxiliary request 5 underlying the contested decision analogously apply to claims 1 and 17 of the main request at stake which contains the same expressions.

- 2.1 However, unlike the assessment of the first instance, the Board is of the opinion that no lack of clarity in the meaning of Article 84 EPC arises. The reasons are the following:
- 2.2 The Board concurs with the respondent that the expressions "*statistically few or no occurrences*" itself expresses a relative concept, and that the patent specification does not contain any explanation as regards the number of occurrences of self-extinguishing in free burn condition or of burn through falling within the meaning of this expression.
- 2.3 However, the Board is convinced by the observation of the appellant that a specialist in the manufacture of wrappers for smoking articles knows that smouldering is a inherently chaotic process influenced by the slight differences affecting even nominally identically smoking articles, for example inhomogeneity of the smokable material and random distribution and concentration along the rod of the smoking article. This would inevitably lead to a non-uniform, and to a certain extent unpredictable, smouldering behaviour among a population of smoking articles which can thus be represented only by adopting a statistical approach.
- 2.4 In view of the above, the person skilled in the art reading the claim with a mind willing to understand and in the light of the particular technical field as depicted above, would interpret the expression

"*statistically few or no occurrences*" broadly and as meaning that statistically no or almost no occurrences of the event at stake will take place, namely a number of occurrences that will not prejudice compliance with the safety requirements while at the same time fulfilling the expectations of the user in respect of the self-extinguishing behaviour under free burn conditions.

2.5 The same reasoning and conclusion apply to the similar expression "*statistically significant occurrences*" which, in the Board's view, simply implies that some occurrences of the event at stake will take place without however limiting the claim, neither explicitly nor implicitly, to a specific threshold.

2.6 In conclusion the Board is of the opinion that the expressions "*statistically few or no occurrences*" and "*statistically significant occurrences*" do not render the claims unclear, i.e. the matter for which protection is sought is clear. However, these expressions have to be interpreted broadly in the sense that they do not define a specific upper or lower limitation, respectively, to the number of occurrences of the event to which they refer. In other words, the claims clearly define a broad subject-matter.

2.7 Having regard to the expression "*statistically reduced occurrence*" the Board concurs with the appellant that when reading the claim as a whole the person skilled in the art would realize that the term "reduced" is related to the smouldering behaviour of smoking articles comprising wrappers whereon the first and third zones are applied as a single continuous band. Therefore the use of the relative term "*reduced*" does not result in any unclear subject-matter because the

term of comparison is already specified in the claim.

3. For the reasons stated above the main request is considered to meet the requirements of Articles 84 and 123(2) EPC.
4. The opposition division has dismissed the second auxiliary request only on the ground pursuant to Article 123(2) EPC although, as explained above, the objections under Article 84 EPC in respect of auxiliary request 5 analogously apply to the second auxiliary request. The opposition division did not however decide on any substantial issue. In this respect, it has to be ascertained in particular what kind of delimitation over the prior art is permitted by the broad interpretation of the claims discussed above. The Board considers these circumstances to represent "special reasons" mentioned in Article 11 RPBA 2020 justifying the remittal of the case to the department of first instance in accordance with Article 111 EPC. In this respect it is observed that at the oral proceedings the appellant did not raise any objection to the remittal of the case to the opposition division.

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 for further prosecution.

The Registrar:

The Chairman:



D. Magliano

G. Pricolo

Decision electronically authenticated