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**Datasheet for the decision
of 18 February 2022**

Case Number: T 1028/17 - 3.2.01

Application Number: 09737837.6

Publication Number: 2282649

IPC: A24F47/00

Language of the proceedings: EN

Title of invention:

AN ELECTRICALLY HEATED SMOKING SYSTEM HAVING A LIQUID STORAGE
PORTION

Patent Proprietor:

Philip Morris Products S.A.

Opponent:

JT International S.A.

Interveners:

British American Tobacco (Germany) GmbH
British American Tobacco (Czech Republic), s.r.o.

Headword:

Relevant legal provisions:

EPC Art. 105, 111, 123(2)

RPBA 2020 Art. 12(2)

Keyword:

Amendments - main request - extension beyond the content of
the application as filed (yes)

Intervention of the assumed infringer - in appeal proceedings
Appeal decision - remittal to the department of first instance
(yes) - remittal of the interventions only to the department
of first instance (no)

Decisions cited:

G 0001/94

Catchword:



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Case Number: T 1028/17 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 18 February 2022

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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
11 January 2017 concerning maintenance of the
European Patent No. 2282649 in amended form.

Composition of the Board:

Chairman G. Pricolo
Members: V. Vinci
A. Jimenez

Summary of Facts and Submissions

- I. The appeal filed by the patent proprietor (appellant) is directed against the interlocutory decision of the opposition division to maintain the European patent No. 2 282 649 in amended form.

In its decision the opposition division held that the ground for opposition under Article 100(c) in combination with Article 123(2) EPC was prejudicial to the maintenance of the patent as granted and maintained the patent in amended form according to the auxiliary request 1 filed during the oral proceedings. In particular, the opposition division held that the subject-matter of independent claims 1 and 10 according to the auxiliary request 1 was novel and involved an inventive step in the meaning of Articles 52(1), 54 and 56 EPC in view of the following prior art:

E1B: EP 2 022 350 A
E2: EP 0 845 220 A
E3: EP 0 893 071 A
E4: US 2 057 353 A
E5B: WO EP 2 022 349 A
E6: US 4 947 874 A
E7: US 5 144 962 A

With the communication according to Article 15(1) RPBA dated 07 April 2020 the Board informed the parties of its preliminary assessment of the case.

On 22 February 2021 two notices of intervention of assumed infringers pursuant to Article 105 EPC were filed.

Oral proceedings pursuant to Article 116 EPC were held before the Board on 18 February 2022 by videoconference.

- II. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or, in the alternative that the patent be maintained in amended form on the basis of auxiliary requests 1-6 filed on 08.12.2017 with the reply to the statement of grounds of the appellant (opponent) or on the basis of auxiliary request 7, filed on 13 September 2021 with the reply to the interventions, or on the basis of auxiliary requests 8-28 filed as auxiliary requests 7-27 on 08.12.2017 with the reply to the statement of grounds of the appellant (opponent). They further requested that the case be not remitted to the opposition division or, in case the Board did not intend to decide on the complete case, at least the appeal of the opponent be decided.

The appellant (opponent) requested that decision under appeal be set aside and that the patent be revoked. Alternatively, they requested that the case be remitted to the opposition division to decide on the fresh ground for opposition and the new objections raised by the interveners.

The interveners 1 and 2 (parties as of right 1 and 2) requested that the decision be set aside and the patent be revoked or that the case be remitted to the opposition division for further prosecution.

- III. Independent claim 1 as granted reads as follows:

"An electrically heated smoking system comprising a

shell (101) and a replaceable mouthpiece (201), the shell (101) comprising an electric power supply (103) and electric circuitry (105); the mouthpiece comprising a liquid storage portion (203), a capillary wick (207) having a first end (207a) and a second end (207b), the first end extending into the liquid storage portion for contact with liquid (205) therein, at least one heating element (209) for heating the second end of the capillary wick, an air outlet (211), and an aerosol forming chamber (213) between the second end of the capillary wick and the air outlet; wherein, when the shell and mouthpiece are engaged, the at least one heating element (209) is in electrical connection with the power supply (103) via the circuitry (105), the circuitry (105) is arranged to provide an electric current pulse to the at least one heating element (209) when a user initiates a puff, and a flow route for air is defined from at least one air inlet (115) to the air outlet (211) via the aerosol forming chamber (213), the flow route channelling the air flow around the heating element (209) and the second end (207b) of the capillary wick."

Dependent claim 3 as granted reads as follows:

"An electrically heated smoking system according to claim 1 or claim 2, wherein the electric circuitry (105) comprises a sensor to detect air flow indicative of a user taking a puff."

Dependent claim 5 as granted reads as follows:

"An electrically heated smoking system according to any preceding claim, wherein the liquid storage portion (203) is not refillable."

Dependent claim 6 as granted reads as follows:

"An electrically heated smoking system according to any one of claims 1 to 4, wherein the liquid storage portion (203) is refillable."

Dependent claim 7 as granted reads as follows:

"An electrically heated smoking system according to any preceding claim, wherein the liquid storage portion (203) is in the form of a cartridge and is arranged such that ambient air drawn through the at least one air inlet (115) passes around the cartridge before reaching the air outlet (211)."

Dependent claim 8 as granted reads as follows:

"An electrically heated smoking system according to any preceding claim, wherein the electric current pulse provided to the at least one heating element (209) when a user initiates a puff is of a predetermined time period."

Dependent claim 9 as granted reads as follows:

An electrically heated smoking system according to any preceding claim, wherein the electric circuitry (105) comprises a manually operable switch for a user to initiate a puff.

Independent claim 10 as granted reads as follows:

"A mouthpiece (201) for engaging with a shell (101) to form an electrically heated smoking system, the shell having an electric power supply (103) and electric circuitry (105), the mouthpiece comprising:

a liquid storage portion (203); a capillary wick (207) having a first end and a second end, the first end (207a) extending into the liquid storage portion for contact with liquid therein; at least one heating element (209) for heating the second end (207b) of the capillary wick; an air outlet (211); and an aerosol forming chamber (213) between the second end of the capillary wick and the air outlet, wherein, when the shell and mouthpiece are engaged, the at least one heating element (209) is in electrical connection with the power supply (103) via the circuitry (105), the circuitry is arranged to provide an electric current pulse to the at least one heating element when a user initiates a puff, and a flow route for air is defined from at least one air inlet (115) to the air outlet (211) via the aerosol forming chamber, the flow route channelling the air flow around the heating element (209) and the second end (207b) of the capillary wick."

Dependent claims 12 and 13 as granted recite the same additional features of claims 5 and 6 respectively and are made dependent on claims 10 or 11.

Independent claim 15 as granted reads as follows:

"A method of operating an electrically heated smoking system, the electrically heated smoking system comprising a shell (101) and a replaceable mouthpiece (201), the shell comprising an electric power supply (103) and electric circuitry (105); the mouthpiece comprising a liquid storage portion (203), a capillary wick (207) having a first end and a second end, the first end (207a) extending into the liquid storage portion for contact with liquid therein, at least one heating element (209) for heating the second end (207b)

of the capillary wick, an air outlet (211), and an aerosol forming chamber (213) between the second end of the capillary wick and the air outlet, comprising:

engaging the shell (101) and mouthpiece (210) such that the at least one heating element is in electrical connection with the power supply via the circuitry, and initiating a puff on the mouthpiece (201) and providing an electric current pulse from the electric circuitry to the at least one heating element when a puff is initiated on the mouthpiece, wherein a flow route for air is defined from at least one air inlet (115) to the air outlet (211) via the aerosol forming chamber (213), the flow route channelling the air flow around the heating element and the second end of the capillary wick."

Dependent claim 17 as granted recites the same additional features of claim 3 and depends on claim 15 or 16.

Dependent claims 19 and 20 as granted recite the same additional features of claims 5 and 6 respectively and are made dependent on claims 15 to 18.

Dependent claims 14 and 21 as granted recite the same additional features of claim 7 and are dependent on independent claims 10, 11 or 12 and 15 to 20 respectively.

Dependent claim 22 as granted recites the same additional features of dependent claim 8 and is made dependent on claims 15 to 21.

Dependent claim 23 as granted recites the same additional features as claim 9 and depends on claims 15

to 22.

The auxiliary request 1 corresponds to the main request in which claim 15 is amended by introducing the features of claim 17 as granted.

The auxiliary request 2 corresponds to the request deemed to be allowable by the opposition division. In this request the method claims are deleted.

The auxiliary request 3 corresponds to the claims as granted wherein in dependent claims 5 to 9 the back reference is changed to claim 1 only. In a similar way the back references in dependent claims 12 to 14 are changed to claim 10 only, and in dependent claims 19 to 23 to claim 15 only.

Reasons for the Decision

ADMISSIBILITY OF THE INTERVENTIONS

1. The admissibility of the interventions was not contested by the appellant (patent proprietor). The Board considers that all the requirements of Article 105(1) EPC are met and does not see any reason to question it.

MAIN REQUEST: PATENT AS GRANTED

Article 123(2) EPC

2. The Board observes that although some objections raised under Article 123(2) EPC with the interventions are of different nature and/or substantiated by slightly

different arguments, they still relate to claims that have been considered by the opposition division in their decision, i.e. claims 7, 8, 21 and 22. For this reason the Board considers it appropriate to decide on all the issues raised under Article 123(2) EPC taking the submissions made both with the appeals and the interventions into account and thereafter to move to the question of the remittal. This approach was proposed at the beginning of the oral proceedings and was accepted by all the parties.

Independent claim 15

- 2.1 The appellant (patent proprietor) contested the decision of the opposition division to reject the main request under Article 123(2) EPC for the reason that some features of independent method claim 15 had no basis in the originally filed application.
- 2.2 In its decision the opposition division followed the argument of the appellant (opponent) asserting that while nowhere in the originally filed description or figures there was disclosed or shown that the activation means was disposed on the mouthpiece, this limitation was inherent to the functioning of the smoking system as presented in the contested patent and directly and unambiguously implied by the wording of granted claim 15, whereby its subject-matter extended beyond the content of the originally filed application contrary to the requirements of Article 123(2) EPC.
- 2.3 The Board does not share this conclusion of the opposition division for the following reasons:

The Board concurs with the appellant (patent proprietor) that no explicit reference either to the

activation means nor to its alleged positioning on the mouthpiece can be found in claim 15. As convincingly pointed out by the appellant (patent proprietor), the only relevant passage of the claim in this respect reads:

"providing an electric current pulse from the electric circuitry to at least one heating element when the puff is initiated on the mouth piece".

2.4 This wording might only implicitly indicate to the person skilled in the art that some kind of activation means responding to or correlated with the initiation of the puff by the user is provided. However, no limitation regarding the positioning of said activation means, in particular that they should be arranged on the mouthpiece, can be directly and unambiguously derived.

2.5 The appellant (opponent) put forward that the passage of claim 1 mentioned above, when interpreted in the light of the operation of the smoking system as described in the contested patent, directly and unambiguously implied that some kind of activating means had to be provided and mandatorily located on the mouthpiece. However, this argument is not convincing because as the formulation at stake is clear in itself and does not contain any reference to any kind of *"activation means"*, the Board does not see how the alleged limitation could be read in the claim. In this respect the Board observes that there is no technical reason preventing to locate the activating means at a place other than on the mouthpiece, for example directly after the air inlets of the shell. Moreover, the wording of claim 1 does not exclude the possibility to use activation means manually operated by the user

just before initiating a puff (see claim 9), whereby it is evident that the activation means can be also located at any accessible place of the smoking system and not necessarily on the mouthpiece. Therefore there is no reason to read in claim 15 the limitation alleged by the appellant (opponent).

2.6 The alleged lack of support in the originally filed application objected by the opposition division thus relates to information/features which are either explicitly nor implicitly defined in the claim, whereby, contrary to the conclusion reached in the decision under appeal, no infringement of Article 123(2) EPC arises.

2.7 With the reply to the statement of the grounds of appeal submitted by the appellant (patent proprietor), the appellant (opponent) reiterated the objection raised during the written opposition procedure that no method claim was originally presented in the application as originally filed, whereby the granted independent method claim 15 resulted in an unallowable intermediate generalisation of the operation of the smoking system of claim 1 as presented in the description which infringed Article 123(2) EPC. As no further argument has been submitted by the appellant (opponent) in this respect in reaction to the preliminary assessment of the Board, the conclusions presented therein are hereby confirmed and read as follows:

The wording of method claim 15 reflects, without omissions, the wording of claim 1 which has not been objected under Article 123(2) EPC, and claims the use of the apparatus features defined in the apparatus claim. This use is fully supported by the description

of the operation of the smoking system presented in the application as originally filed, whereby no issue under Article 123(2) EPC is identified by the Board.

Dependent claims 5, 6, 12, 13, 19 and 20

2.8 In their written submissions the appellant (opponent), by merely referring back to the arguments presented in their notice of opposition, contested the view of the opposition division that the alternatives claimed in these dependent claims, i.e. the use of a not refillable (see for example claim 5) or of a refillable (see for example claim 6) liquid storage portion, were fully supported by the passage on page 4 of the description, lines 33-35. In this respect the appellant (opponent) argued that the dependencies of these disputed dependent claims on claims 1 to 4, 10 or 11 and 15 to 18 respectively resulted in undisclosed combinations of features. No further arguments in support of this objection were submitted by the appellant (opponent) at the appeal oral proceedings.

2.9 The Board thus sees no reason to deviate from the conclusion of the opposition division and concurs with the appellant (patent proprietor) that the person skilled in the art, in view of the whole disclosure and technical context of the patent, promptly realizes that there is no technical reason not to assume that the alternative embodiments of the liquid storage portion under discussion are applicable to all the embodiments originally disclosed.

Dependent claims 7, 14 and 21

2.10 The appellant (opponent) and the interveners (parties as of right 1 and 2) argued that the path of airflow as

defined by these dependent claims was only disclosed in combination with a second embodiment of the invention according to which the cartridge is positioned downstream of the second end of the wick and the heating coil (see page 8, lines 29-32). However, as the independent claims 1, 10 and 15, on which these dependent claims depended, respectively, covered only the first embodiment according to which the cartridge is positioned upstream of the second end of the wick (see description page 8, lines 25-28 and figure 1), it was concluded that contrary to the assessment of the opposition division, an issue under Article 123(2) did arise.

- 2.11 The interveners (parties as of right 1 and 2) further observed that the passage on page 8, lines 29-32 cited by the appellant (patent proprietor) as support for the introduction of these dependent claims referred to a path of *"vapour or aerosol"* while the claims at stake referred to a path of *"ambient air"*. Furthermore, it was argued that while the cited passage on page 8 disclosed a plurality of air inlets, the wording of these dependent claims *"at least one air inlet"* encompassed the possibility of providing a single air inlet, said possibility not having been originally disclosed. Finally, the interveners (parties as of right 1 and 2) objected that the specific positioning of the air inlets according to the embodiment shown in figures 1 to 3, to which the passage of the description at stake referred to, represented an essential technical feature of the claimed smoking system which was omitted in these dependent claims, thereby introducing an unallowable intermediate generalisation of the disclosed embodiment infringing Article 123(2) EPC.

2.12 The Board is not convinced by the arguments presented by the appellant (opponent) and interveners (parties as of right 1 and 2) and find that these dependent claims meet the requirements of Article 123(2) EPC for the following reasons:

While is it true that the whole passage on page 8, lines 25-32 of the originally filed description encompasses two alternative embodiments, the second of which, due to the different relative positioning of the liquid cartridge portion in the smoking system, does not follow under the wording of independent claims claim 1, 10 and 15, the person skilled in the art directly and unambiguously recognizes that the path of vapour/aerosol referred to in lines 29-32 in connection with the second embodiment also applies to the first embodiment described on the preceding lines 25-28 and covered by the independent claims. As correctly pointed out by the opposition division this is confirmed by the representation of the air path in figure 3, showing the first embodiment of the smoking system, said path being fully consistent with the wording of the dependent claims at stake. Furthermore, the Board is convinced that, despite the slightly different terminology adopted in the two passages on page 8, lines 25-32 describing the first and the second embodiment (i.e. *"ambient air"* vs. *"vapour or aerosol"*), the person skilled in the art has no doubt that according to both embodiments an initial flow of ambient air introduced through the air inlet/s is at least in part converted in vapour or aerosol inside the smoking system, i.e. in a mixture of ambient air and aroma particles, before reaching the air outlet. The person skilled in the art would thus read the expressions *"ambient air"* and *"vapour or aerosol"* of the passage of the description at stake as being equivalent in the technical context

of the patent, whereby no additional information is caused by the use of the term "*ambient air*" instead of "*vapour or aerosol*" in these dependent claims. Regarding the possibility to have a single air inlet encompassed by claims 7 and 14 and 21 which is actually not supported by the passage of the description at stake, the Board notes that the expression "*at least one air inlet*" was present in claim 1 as filed. Finally, the passage on page 8 in question does not indicate any specific position of the air inlet/s but only the required path of the ambient air/vapour flow, whereby the allegation of the interveners (parties as of right 1 and 2) that in view of the representation in figure 3 the omission of the position of the air inlets in claims 7, 14 and 21 led to an unallowable intermediate generalisation is not justified.

In conclusion, dependent claims 7 and 14 meet the requirements of Article 123(2) EPC as correctly assessed by the opposition division. The same conclusion applies for dependent method claim 21.

Dependent claims 8 and 22

- 2.13 The contested dependent claims 8 and 22 of the main request contain the reference to "*a predetermined time period*". The appellant (opponent) and the interveners (parties as of right 1 and 2) objected that in the passage of the description on page 4, lines 1-3, cited by the appellant (patent proprietor) as basis for the introduction of these claims it was stated that "*the predetermined time period of the electric current pulse is pre-set, depending on the amount of liquid desired to be vaporised*" whereby, in their view, the omission of the information that the pre-setting is made dependent on the amount of liquid desired to be

vaporized resulted in an unallowable intermediate generalisation infringing Article 123(2) EPC.

2.14 The Board disagrees for the following reasons:

As convincingly argued by the appellant (patent proprietor), the person skilled in the art recognizes that the only technical limitation implied by the passage of the description cited above merely consists in the suggested possibility of pre-setting a predetermined duration of the electric current pulse. The alleged additional information that this selection is made on the basis of the amount of liquid desired to be vaporized is "de facto" inherent to the pre-set pulse time because there is an inextricable link between the length of the electric pulse provided to the heater at each puff and the amount of liquid that will be vaporized in this time interval. Therefore the omission in claims 8 and 23 of the dependency alleged by the appellant (opponent) and interveners (parties as of right 1 and 2) does not lead to any unallowable generalisation contrary to Article 123(2) EPC.

Dependent Claims 9 and and 23

2.15 The Board follows the view of the interveners (parties as of right 1 and 2) that the dependency of claim 9 on claim 3 results in the protection for an electrically heated smoking system provided with both a sensor to detect air flow indicative of a user taking a puff and a manually operable switch for a user to initiate a puff. However, such a combination of features is not disclosed in the application as originally filed which presents the use of a sensor or manual switch only as alternatives. This is not contested by the appellant (patent proprietor) who however argued that the issue

at stake resulted in a lack of clarity rather than in added subject-matter. In this respect it was argued that the person skilled in the art recognized that an activating sensor and a manual switch do not make any technical sense when provided in combination and would thus still read the claims as if they presented these solutions in alternative in accordance with the whole disclosure of the contested patent.

2.16 The Board does not agree because, contrary to the opinion of the appellant (patent proprietor), the dependency of claim 9 on claim 3 clearly defines an electrically heated smoking system provided with a sensor and a manual switch in combination. Furthermore, the person skilled in the art has no technical reason to rule out such a combination which is indeed not originally disclosed as recognized by the appellant (patent proprietor).

2.17 In view of the above and contrary to the assessment of the opposition division in the decision under appeal, claim 9 does not thus meet the requirements of Article 123(2) EPC. The same conclusion applies to claim 23 in view of its dependency on claim 17. For this reason the main request is not allowable.

AUXILIARY REQUESTS 1 AND 2

3. The same issue raised under Article 123(2) EPC in respect of the main request analogously applies for the same reasons to the auxiliary requests 1 and 2. This is not contested by the appellant (patent proprietor). The auxiliary requests 1 and 2 are thus not allowable for the same reasons given in respect of the main request.

AUXILIARY REQUEST 3

4. The amendment of the back references in claims 5 to 9, 12 to 14 and 19 to 23 clearly solves the issues raised in respect of the corresponding claims of the main request. Furthermore the conclusions presented in respect to claim 15 and to the other disputed dependent claims under points 2. to 2.14 above apply likewise with the same reasons to the corresponding claims of the auxiliary request 3 which thus complies with the requirements of Article 123(2) EPC.

REMITTAL

Remittal of the entire case

5. In support of their request to remit the entire case to the first instance the appellant (opponent) and the interveners (parties as of right 1 and 2) pointed out that a new ground for opposition under Article 100(b) in combination with Article 83 EPC had been raised with the interventions, referred to the conclusion of G1/94 stating under section 13. that *"... for the exceptional situation of the introduction of new grounds in ordinary appeal proceedings, if a fresh ground for opposition is raised by the intervener, the case should be remitted to the first instance for further prosecution unless special reasons present themselves for doing otherwise [...]"*, and expressed the view that in the case at stake no *"special reasons present themselves for doing otherwise"*.
- 5.1 The appellant (patent proprietor) drew the Board's attention to the final statement in section 13. of G1/94 indicating as special reason for not remitting the case the circumstance that *"the patentee himself*

does not wish the case to be remitted" as it was the case here. Furthermore, the appellant (patent proprietor) argued that the new ground for opposition appeared artificial as allegedly proved by the fact that only 1 page among more than 60 pages of each intervention was dedicated to its substantiation. The appellant (patent proprietor) pointed out that the new novelty and inventive step attacks submitted with the interventions were essentially based, with few exceptions, on documents already considered by the opposition division and deemed not to be particularly relevant, and that the disputed interpretation of claim 1 regarding the positioning of the "*liquid storage portion*" was already object of extensive discussion and decided by the opposition division. The appellant (patent proprietor) thus concluded that the Board had all the elements for deciding the case. Finally, the appellant (patent proprietor) put forward that the need of legal certainty and procedural economy aspects also clearly spoke against a remittal of the case.

- 5.2 The Board does not agree with the arguments provided by the appellant (patent proprietor) for the following reasons:

In the Board's view G1/94 (see relevant sections 12. and 13.) must be read in a strict manner, i.e. for the specific case of a fresh ground for opposition being raised by the intervener in appeal proceedings. In this legal context, which reflects the one of the present case, the wish of the patent proprietor not to remit invoked by the appellant (patent proprietor) can only be regarded as a mere example of a possible reason not to remit, in the sense that the patent proprietor might deliberately accept the risk to see the patent possibly revoked in appeal based on this fresh ground or

consider that this fresh ground is flawed, as in the case where the patent proprietor gives the consent for a fresh ground for opposition raised in appeal without intervention. However, by no means can G1/94 be read as implying that the wish of the patent proprietor not to remit the case is the only criterion to be considered and shall prevail on the wishes of the other parties or other factors, and even less as implying that this wish is binding for the Board in such a way that the Board shall not remit. In fact, on one side, as stressed by the interveners (parties as of right 1 and 2), such an interpretation of G1/94 would be clearly contrary to the right of the parties to be treated equally and to have a fair trial and, on the other side, would deprive the Board of the discretion to remit the case conferred to it by Article 111 EPC. Therefore the Board shares the view of the appellant (opponent) and of the interveners (parties as of right 1 and 2) that the principle underlying G1/94, section 13. is that the wish of the patent proprietor is only one of the factors to be considered in presence of a fresh ground for opposition raised by an intervention and that other circumstances should be weighed by the Board in order to assess whether there are "*special reason*" for remitting the case, i.e. the interest of the public and of the other parties involved and/or the question of whether the intervention creates a complete fresh case that, in view of the scope of the appeal proceedings, would normally require a first instance decision to be eventually reviewed in appeal. In this respect and in agreement with the appellant (opponent) and interveners (parties as of right 1 and 2), the Board observes that beside the fresh ground for opposition which cannot be disregarded only because it has been allegedly briefly substantiated, the interventions introduce four new novelty attacks in part based on new evidence and a

correspondingly large number of fully new inventive step attacks. Furthermore, the interventions contain new extensive observations regarding possible alternative constructions of the independent claims also in view of an alleged broader interpretation (compared with those defended at the opposition proceedings) provided by the appellant (patent proprietor) during the infringement proceedings. All these submissions lead to a fresh case.

5.3 Regarding the need of legal certainty invoked by the appellant (patent proprietor) and the delaying of the proceedings which would be caused by a remittal of the case, the Board notes that as pointed out in G1/94, section 8., an unavoidable delay is always intrinsic in the filing of an intervention in response to infringement proceedings started by the patent proprietor. However, since infringement proceedings are still pending, accelerated opposition and appeal proceedings are available in order to minimize such a delay if the parties wish so.

5.4 In conclusion the Board agrees with the appellant (opponent) and the interveners (parties as of right 1 and 2) that the framework of the appeal has substantially changed relative to the first instance decision due to the interventions. This takes precedence over any other possible consideration also in view of Article 12(2) RPBA 2020 according to which, in view of the primary object of the appeal proceedings to review the decision under appeal in a judicial manner, a party's appeal case shall be directed to the requests, facts objections, arguments and evidence on which the decision under appeal was based. This is clearly not the case here at least in view of the new arguments (i.e. regarding the interpretation of the

claims), evidence and attacks.

- 5.5 Therefore, in view of all the above, the Board concludes that in the present case the wish of the appellant (patent proprietor) not to have the case remitted does not represent a prevailing and special reason in the meaning of G1/94, section 13. for not doing so, but that other considerations render a remittal appropriate.

Remittal of the interventions only

- 5.6 The appellant (patent proprietor) submitted that they did not see any reason preventing the Board from deciding at least on the original appeals, thereby splitting the case between the original appeal case which could be immediately decided by the Board and the interventions to be firstly assessed by the opposition division. In particular it was argued that, as for Article 123(2) EPC, there was no reasons not to review the contested decision of the opposition division on lack of novelty in view of E1B and the following assessment of inventive step starting from E1B as closest prior art in combination with E3, E4 or E6. As regards the interpretation of claim 1, i.e. the technical meaning to be conferred to the term "*liquid storage portion*" in the technical context of the patent and the location of this feature in the smoking system actually implied by the wording of the claims, the appellant (patent proprietor) explained that these issues were already extensively discussed at the first instance and decided by the opposition division, thereby assessing a claim's construction which could now be reviewed by the Board irrespective of the allegedly new observations introduced in this respect by the interveners (parties as of right 1 and 2) which

could be considered by the first instance upon remittal of the sole interventions.

5.7 The Board does not agree for the following reasons:

The appellant (patent proprietor) proposes an unusual and artificial splitting up of the case implying that the Board has to decide in isolation only on the issues originally raised with the appeals without considering the submissions provided with the interventions. In the Board's view such an artificial splitting may very likely lead to a partial and possibly inconsistent final assessment of the case which would be detrimental to legal certainty. The Board concurs with the appellant (opponent) and interveners (parties as of right 1 and 2) that the new observations submitted with the interventions regarding claims interpretation might potentially lead to different conclusions regarding lack of novelty over E1B with respect to the conclusions which would be reached without considering these new elements. In this respect the interveners (parties as of right 1 and 2) convincingly argued that in order to decide on the disputed technical meaning of the term "*liquid storage portion*" the content of the whole available state of the art dealing with a similar technical feature should be considered and could play a role. The Board also agrees with the appellant (opponent) and interveners (parties as of right 1 and 2) that the problems and the risks of inconsistencies presented above would be further enhanced when deciding inventive step because it is evident that this decision cannot prescind from a global assessment of all the available prior art documents as is required in order to correctly determine the closest prior art and hence the resulting distinguishing features. The Board also notes that such a splitting of the case would not serve

procedural economy and would not shorten the overall duration of proceedings, which would anyway have to be continued before the opposition division for assessment of the interventions. Therefore, for the reasons given above, the Board considers that a decision on the original appeal case only while remitting the assessment of the interventions to the opposition division is not conceivable.

- 5.8 In conclusion, in view of all the above, the Board in exercise of the discretion conferred by Article 111 EPC decides to remit the entire case to the opposition division for further prosecution on the basis of the auxiliary request 3.

Order

For these reasons it is decided that:

1. The decision is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated