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**Datasheet for the decision
of 16 November 2021**

Case Number: T 1460/18 - 3.2.01

Application Number: 09770392.0

Publication Number: 2337462

IPC: A24D1/02, A24B15/28

Language of the proceedings: EN

Title of invention:

CIGARETTE PAPER COATED WITH COATING MATERIALS FOR LOW IGNITION
PROPENSITY AND A FIRE-SAFE CIGARETTE COVERED BY THE SAME

Patent Proprietor:

KT & G Corporation

Opponent:

Julius Glatz GmbH

Headword:

Relevant legal provisions:

EPC Art. 100(a), 54, 56, 100(b), 100(c)

Keyword:

Grounds for opposition - insufficiency of disclosure (no) -
added subject-matter (no)
Novelty - main request (yes)
Inventive step - main request (yes)

Decisions cited:

Catchword:



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Case Number: T 1460/18 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 16 November 2021

Appellant: Julius Glatz GmbH
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 23 May 2018
rejecting the opposition filed against European
patent No. 2337462 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman G. Pricolo
Members: M. Geisenhofer
A. Jimenez

Summary of Facts and Submissions

I. The appeal was filed by the opponent (appellant) against the decision of the opposition division to reject the opposition filed against the European patent EP 2 337 462.

II. The opposition division came to the conclusion that

- the claimed subject-matter was novel and involved an inventive step over the cited prior art (Article 100(a) EPC in combination with Articles 54 and 56 EPC);
- the patent disclosed the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC); and
- the subject-matter of the claims as granted did not extend over the disclosure of the application as originally filed (Article 100(c) EPC).

III. The following documents are mentioned in the present decision:

D5	DE 28 39 958 A1
D6	US 2002/0179105 A1
D7	EP 1 321 048 A1

IV. At the oral proceedings held before the Board,

- the appellant (opponent) requested that the decision under appeal be set aside and that the European patent be revoked;
- the respondent (patent proprietor) requested that the appeal be dismissed and the patent be

maintained as granted (main request), or in the alternative that the patent be maintained in amended form based on the auxiliary request filed during opposition proceedings on 23 January 2018.

- V. Independent claim 1 according to the **main request** (patent as granted) reads as follows:

"A cigarette paper coated with a coating material for Low Ignition Propensity (LIP), the coating material for Low Ignition Propensity (LIP) containing at least one selected from the group consisting of sorbitan monostearate, sorbitan isostearate, propylene glycol stearate and glyceryl stearate, wherein the coating material for LIP is coated on both sides of the cigarette paper and wherein the coating material for LIP has a thickness of 0.5 - 20 μm ."

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

- (a) The application as originally filed discloses all individual features mentioned in claim 1 but not the combination thereof such that claim 1 lacks a basis in the application as filed.
- (b) The stearates mentioned in claim 1 can only be applied using a solvent that is toxic such that the resulting cigarette does not comply with health standards in Europe and hence cannot be carried out.
- (c) The subject-matter of claim 1 is known from D5, at least not inventive over D5 in combination with D7.

- (d) Further, the subject-matter of claim 1 lacks an inventive step over D6 in combination with D5 and D7, and D7 in combination with D5 and D6.

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

- (a) Claim 1 is based on originally filed claim 1 and paragraphs [13], [15], [20] and [26] of the description, and hence was not unallowably amended.
- (b) The patent in suit provides enough information to the skilled person to carry out the invention irrespective whether the resulting product complies with local health standards.
- (c) D5 does not disclose a thickness of 0.1 - 20 μm as required by claim 1 such that D5 does not anticipate the subject-matter of claim 1.
- (d) The kind of substance used as a coating material and its thickness are intrinsically linked features that cannot be considered independently. Since none of the documents in the prior art teaches to use sorbitan monostearate, sorbitan isostearate, propylene glycol stearate and glyceryl stearate for a coating with a thickness of 0.5 - 20 μm , claim 1 is based on an inventive step.

Reasons for the Decision

Main request

Amendments (Article 100(c) EPC)

1. Claim 1 as granted (main request) is based on claim 1 and paragraphs [15], [20] and [26] of the description of the application as originally filed.
 - 1.1 Claim 1 as originally filed is directed to a cigarette paper coated with a coating material for Low Ignition Propensity (LIP), the coating material for Low Ignition Propensity (LIP) containing at least one selected from the group consisting of diutan gum, dammar gum, gellan gum, sorbitan monostearate, sorbitan isostearate, propylene glycol stearate, glyceryl stearate, stearyl alcohol and Alpha-tocopheryl acetate, or a mixture thereof.

The features of claim 1 are moreover identically reflected in paragraph [15] of the application as filed.
 - 1.2 Paragraph [20] discloses that the coating material is applied with a predetermined width spacing on the outside, the inside or on both sides.

Contrary to the appellant's understanding, this disclosure cannot be seen in a limited manner as referring to particular embodiments defining where the coating is applied but which are not specifically linked to any of the materials mentioned in paragraph [15]. By generally stating "the coating material", paragraph [20] makes it clear that any of the coating materials mentioned in the previous paragraphs, thus in particular any of the stearate coating materials

mentioned in paragraph [15], can be applied on the outside, the inside or on both sides of the cigarette paper. Hence, there is a clear and unambiguous disclosure in the application as filed of the combination of features

- that the coating material contains at least one selected from the group consisting of sorbitan monostearate, sorbitan isostearate, propylene glycol stearate and glyceryl stearate, and
- that the coating material for LIP is coated on both sides of the cigarette paper.

- 1.3 Paragraph [26] finally provides the information that the coating material shall be provided with a thickness of 0.5 - 20 μm .

Contrary to the appellant's assertion that this paragraph does not specifically refer to the above mentioned combination of features, the Board takes the view that, since the paragraph starts with "the present invention provides a cigarette paper coated with a coating material for Low Ignition Propensity (LIP) having a thickness of 0.5 - 20 μm ", it must be placed in the general context of the invention and thus as applying to all coating materials (in particular the stearates defined in paragraph [15] and in claim 1 as originally filed) irrespective of their location (i.e. on the outside, the inside or on both sides of the cigarette paper).

- 1.4 The combination of features of claim 1 as granted thus finds its basis in the application as filed.

2. The appellant further objected that also dependent claims 2 to 6 contained subject-matter extending beyond the content of the application as filed, because they

referred back to claim 1 which contained added subject-matter.

This objection fails because, as explained above, claim 1 does not contain added-subject-matter.

3. The appellant further submitted that sorbitan monostearate was not disclosed as a preferred coating material in the application as filed and therefore claim 2, which was restricted to this specific coating material, introduced added subject-matter. However, the Board fails to see how the restriction to one of the materials already mentioned in claim 1 can introduce added subject-matter. Claim 2 merely recites one alternative of claim 1 but does not introduce the technical information that this alternative might be preferable for technical reasons over the other alternatives of claim 1.
4. Further, in respect of dependent claim 3, the appellant submitted that the reference to claim 1 alone introduced added subject-matter, since granted claim 3 could only be based on original claims 2, 3 and 4, whereby granted claim 3 should refer back to granted claim 2. The Board accepts that the additional feature of granted claim 3, according to which the coating material is formed in a form of a band on the cigarette paper, is disclosed in claim 4 of the application as filed which also refers back to claim 2 which is limited to three coating materials, one of those being sorbitan monostearate as defined in granted claim 2. The additional feature of granted claim 3 is however also disclosed in a more general context in paragraph [22] of the description of the application as filed, i.e. in a context in which it is clear for a skilled

person that there is no mandatory link with the feature of the coating material being sorbitan monostearate.

Sufficiency of disclosure (Article 100(b) EPC)

5. The patent as granted discloses the claimed invention in a manner sufficiently clear and complete for the skilled person to carry it out.
- 5.1 As set out in paragraph [0021] of the description as granted, the coating material can be dissolved in water or an organic solvent such as alcohol and benzene.
- 5.2 The appellant alleges that the stearates defined in claim 1 as granted cannot be dissolved in water but require other solvents which are however toxic, the resulting cigarette hence not complying with European health standards such that they cannot be produced and sold.
- 5.3 Whether the resulting product complies with local health standards is not decisive for the question whether the invention can be carried out. As the appellant admits, it is possible to dissolve the stearates defined in claim 1 and hence to apply them to the cigarette paper such that a cigarette paper according to claim 1 and a cigarette according to claim 6 of the main request can be reproduced.

Novelty (Article 100(a) EPC in combination with Article 54 EPC)

6. The subject-matter of claim 1 of the main request is novel over D5.

- 6.1 It is undisputed that D5 discloses a coating for a cigarette paper including glyceryl monostearate (page 7, third paragraph and "Beispiel 4" on page 13) which is applied to both sides of the paper (first line on page 7).
- 6.2 As pointed out by the opposition division in the decision under appeal, D5 does not disclose coatings having a thickness in the claimed range of 0.5 - 20 μm . This was no longer disputed by the appellant during oral proceedings. D5 in fact discloses a coating having a thickness of about 50 μm (see example 1) but only in combination with the coating material comprising nicotine hydrogen tartrate.

Inventive step (Article 100(a) EPC in combination with Article 56 EPC)

7. The subject-matter of claim 1 of the main request is inventive when starting from D5 as the closest prior art.
- 7.1 As set out above with regard to novelty over D5, the subject-matter of claim 1 differs from the cigarette paper known from D5 in that the coating material has a thickness of 0.5 - 20 μm .
- 7.2 In the Board's view, the skilled person has no teaching available in the prior art that would suggest to reduce the coating's thickness of 50 μm in D5 to a value falling within the range of 0.5 - 20 μm .
- 7.2.1 The appellant argues that the patent in suit does not provide any information with regard to a technical advantage obtained by the claimed thickness. The patent

would further not provide an advantage obtained by the materials defined in independent claim 1 either since table 2 and figures 2 - 5 do not refer to a cigarette paper provided with a coating containing one of the stearates of claim 1 applied in a thickness as claimed in claim 1 and applied to both sides of the paper. The patent in suit thus does not disclose that a cigarette paper according to claim 1 has any technical advantage over other cigarette papers.

The choice of the materials defined in claim 1, the thickness of the coating defined in claim 1 and the location where to apply the coating are hence unmotivated choices which do not influence the burn behaviour of the cigarette paper.

The objective technical problem to be solved cannot therefore be regarded as providing an improved burn behaviour of the paper but as providing an alternative to the known substances used for the coating, to where to apply the coating and to the coating thickness.

7.2.2 Even if the distinguishing features would not result in an improved burn behaviour and thus the problem solved might be regarded as finding an alternative cigarette paper, this does not mean that the solution according to claim 1 is rendered obvious by the prior art. In fact, the skilled person is aware that different materials have different burn behaviour (see also table 2 and figures 2 - 5 of the patent in suit) and that the thickness of the coating also alters the coating's physical and chemical behaviour such that the skilled person would not arbitrarily choose any possible combination of material and coating thickness. Having regard to D5 alone, there is thus no reason why the skilled person would provide the specific coating

materials mentioned in claim 1 in a thickness in the range of 0.5 - 20 μm .

7.2.3 Albeit D7 discloses a coating's thickness of 2 - 10 μm , this thickness is only disclosed in combination with the particular coating materials disclosed in paragraph [0019]. Since paragraph [0019] does not mention stearates, the skilled person would not consider that the range of thickness directly applies to the glyceryl monostearate coating of D5.

8. The subject-matter of claim 1 of the main request is also inventive when starting from D6 as the closest prior art.

8.1 It is undisputed that D6 discloses a cigarette paper with a coating including a burn rate retarding substance which is applied to both sides of the paper (cf. paragraph [0051]).

8.2 The subject-matter of claim 1 however differs from the cigarette paper known from D6 in that

- the coating material contains at least one selected from the group consisting of sorbitan monostearate, sorbitan isostearate, propylene glycol stearate and glyceryl stearate; and
- the coating material has a thickness of 0.5 - 20 μm .

8.3 The appellant again argues that both differences may be considered independently since the coating material does not depend on the coating thickness and vice versa. The skilled person would hence seek an alternative for the coating material and would chose independently therefrom an alternative thickness for the coating.

- 8.4 This argument fails to convince for the same reasons given above when starting from D5. There is no reason why the skilled person would provide the specific coating materials mentioned in claim 1 in a thickness in the range of 0.5 - 20 μm .
9. The subject-matter of claim 1 of the main request is also inventive when starting from D7 as the closest prior art.
- 9.1 It is undisputed that D7 discloses a cigarette paper with a coating made from a burn adjusting agent, the coating having a thickness of 2 - 10 μm (cf. paragraph [0017]).
- 9.2 The subject-matter of claim 1 differs from the cigarette paper known from D7 in that
- the coating material contains at least one selected from the group consisting of sorbitan monostearate, sorbitan isostearate, propylene glycol stearate and glyceryl stearate; and
 - the coating material is applied to both sides of the paper.
- 9.3 The appellant again considers both features as being independent from each other and argues that D5 would render it obvious to use as burn adjusting agent a glyceryl stearate whereas D6 would render it obvious to apply the coating to both sides of the paper.
- 9.4 The Board considers - as set out above - the material to be intrinsically linked to the thickness in which the material is applied. If the skilled person would use the glyceryl stearate known from D5 as burn adjusting agent, he/she would apply it in the same

thickness as in D5, i. e. in a thickness of 50 μm , thus not falling within the scope of claim 1 of the main request.

10. Further lines of argument were not raised by the appellant such that the Board sees no reason to deviate from the opposition division's decision according to which none of the grounds for opposition prejudices the maintenance of the patent as granted.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



A. Voyé

G. Pricolo

Decision electronically authenticated