

**Internal distribution code:**

- (A) [ - ] Publication in OJ
- (B) [ - ] To Chairmen and Members
- (C) [ - ] To Chairmen
- (D) [ X ] No distribution

**Datasheet for the decision  
of 12 October 2021**

**Case Number:** T 1595/18 - 3.2.01

**Application Number:** 11820510.3

**Publication Number:** 2608686

**IPC:** A24F47/00, A61M15/06

**Language of the proceedings:** EN

**Title of invention:**

INHALATION DEVICE INCLUDING SUBSTANCE USAGE CONTROLS

**Patent Proprietor:**

JT International S.A.

**Opponent:**

Philip Morris Products S.A.

**Headword:**

**Relevant legal provisions:**

EPC Art. 52(1), 54, 113(1), 111(1)

EPC R. 103(1) (a)

RPBA 2020 Art. 11

**Keyword:**

Novelty - main request (no)

Right to be heard - substantial procedural violation (yes)

Appeal decision - remittal to the department of first instance  
(yes)

Reimbursement of appeal fee - (yes) - equitable by reason of a  
substantial procedural violation - opportunity to comment (no)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

Case Number: T 1595/18 - 3.2.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.01**  
**of 12 October 2021**

**Appellant:** JT International S.A.  
(Patent Proprietor) 8, rue Kazem Radjavi  
1202 Geneva (CH)

**Representative:** Hoffmann Eitle  
Patent- und Rechtsanwälte PartmbB  
Arabellastraße 30  
81925 München (DE)

**Appellant:** Philip Morris Products S.A.  
(Opponent) Quai Jeanrenaud 3  
2000 Neuchâtel (CH)

**Representative:** Morf, Jan Stefan  
Abitz & Partner  
Patentanwälte mbB  
Arabellastrasse 17  
81925 München (DE)

**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
23 April 2018 concerning maintenance of the  
European Patent No. 2608686 in amended form.**

**Composition of the Board:**

**Chairwoman** S. Fernández de Córdoba  
**Members:** V. Vinci  
S. Mangin

## **Summary of Facts and Submissions**

- I. The appeals filed by the patent proprietor and by the opponent are directed against the interlocutory decision of the opposition division to maintain the European patent No. 2 608 686 in amended form.

In its decision the opposition division held that the main request did not comply with the requirements of Article 123(2) EPC, that claim 9 of the auxiliary request 1 lacked novelty and that the patent as amended according to the auxiliary request 2 filed at the oral proceedings met all the requirements of the EPC. In particular, the opposition division concluded that the subject-matter of independent claims 1 and 10 of the auxiliary request 2 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 documents:

D6: US 626 0549 B1  
D7: WO 2007/078273 A1  
D9: WO 2008/016156 A1  
D18: US 2001/0017193 A1

- II. The appellant 1 (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained according to the main request or, as an auxiliary measure, according to the auxiliary request 1, said main and auxiliary request 1 corresponding to the auxiliary requests 1 and 2 underlying the appealed decision respectively. As a further auxiliary measure, appellant 1 requested the maintenance of the patent on the basis of the auxiliary request 2 submitted with letter of 4 October 2021 or of the auxiliary requests II to VII filed in preparation of the oral proceedings

in opposition procedure.

The appellant 2 (opponent) requested that the decision under appeal be set aside and that the European patent be revoked. As an auxiliary measure, remittal of the case to the department of first instance and reimbursement of the appeal fee were requested.

Summons to oral proceedings were issued on 17 June 2020. With a communication under Article 15(1) RPBA dated 23 June 2020, the Board informed the parties of its preliminary, non binding assessment of the appeals.

Oral Proceedings pursuant to Article 116 EPC were held before the Board on 12 October 2021.

III. Claim 1 according to the main request reads as follows (labelling of the features added by the Board):

(F1) *"An inhalation apparatus (100) comprising:*

(F2) *a first cartridge (114) comprising*

(F2-1) *a first release device (118) configured to*

(F2-2) *release a first substance into a housing (112);*

(F3) *a sensor(240, 291, 292, 293, 294, 295); and*

(F4) *a controller (124, 224) configured to*

(F4-1) *receive data from the sensor (240, 291, 292, 293, 294, 295);*

(F4-2) *determine an amount of first substance released by the first cartridge (114) based on the data; and*

(F4-3) *estimate a remaining amount of first substance in the first cartridge (114) based on the determined amount of first substance."*

Claim 1 according to the 1st auxiliary request reads as follows (labelling of the features added by the Board):

(F1) *"A smoke inhalation apparatus (100) comprising:*

(F2) *a first cartridge (114) comprising*

(F2-1) *a first release device (118) configured to*

(F2-2) *release variable amount of a first substance into a housing (112);*

(F3) *a sensor(240, 291, 292, 293, 294, 295); and*

(F4) *a controller (124, 224) configured to*

(F4-1) *receive data from the sensor (240, 291, 292, 293, 294, 295);*

(F4-2) *determine an amount of first substance released by the first cartridge (114) based on the data; and*

(F4-3) *estimate a remaining amount of first substance in the first cartridge (114) based on the determined amount of first substance."*

## Reasons for the Decision

### APPEAL OF THE APPELLANT 1 (PATENT PROPRIETOR)

#### Main Request: Lack of Novelty pursuant to Articles 52(1) and 54 EPC

1. The appellant 1 (patent proprietor) contested the conclusion of the opposition division in the decision under appeal that the subject-matter of claim 1 according the first instance auxiliary request 1, corresponding to the main request filed in appeal, lacked novelty in view of document D6, and in particular that features F4 to F4-2 with the functionality associated therewith were considered to be directly and unambiguously derivable from this prior art document.
  - 1.1 It was argued that D6 is only interested in collecting and recording information on how many times the inhalation apparatus disclosed therein has been activated by the user and in estimating how many inhalations are still available in the canister based on the known total number of single inhalation doses originally contained therein. The appellant 1 (patent proprietor) put forward that contrary to the teaching of D6, claim 1 clearly specifies in feature F-4 and F4-2 that the apparatus according to the contested patent has a "controller configured to ..... determine an amount of first substance released by the cartridge" rather than to simply count the number of activations of the apparatus. It was further argued that the signal provided by the flow sensor (127) to the controller of D6 (chip 111) consists in a single piece of information relating to the activation or deactivation (on or off status) of the release device by the user rather than a

plurality of "data" to be processed in order to directly determine the actual amount of first substance released at each activation and to estimate the remaining amount in the cartridge, as clearly stated in claim 1, feature F4-2 and F4-3.

- 1.2 The Board is not convinced by the arguments submitted by the appellant 1 (patent proprietor) for the following reasons:

The reasoning of the appellant 1 (patent proprietor) which identifies a distinguishing feature/functionality in the fact that the apparatus according to D6 - contrary to the claim language - does not determine an amount of first substance released by the first release device, but only detects and records the number of activations is not convincing. In this respect, the Board shares the view of the appellant 2 (opponent) that claim 1 does not contain any limitation as to whether the determination and estimation of the amounts of the first substance released and remaining in the cartridge is carried out directly and indirectly. By counting/recording the activating signals provided by the flow-sensor (127), i.e. how many times the device has been used/activated, the controller of D6 indirectly determines the amount of the first substance released as the number of recorded activations multiplied by the known predetermined amount released at each activation and, consequently, the remaining amount thereof as the total amount of first substance originally contained in a new cartridge minus the aforesaid determined amount. This functionality resulting in an indirect determination of the amounts of first substance released is disclosed in column 8, lines 22-26 and in column 9, lines 8 to 30 of D6 and fulfills the teaching of features F4-2 and F4-3 of



claim 1 which must be read broadly by the person skilled in the art as defining both a direct and an indirect determination process.

- 1.3 Furthermore, as correctly pointed out by the opposition division and by the appellant 2 (opponent), the flow sensor (127) of the apparatus disclosed in D6 detects the start of an inspiration by the user and sends a corresponding activation signal to the microprocessor (see column 8 lines 22-28 and column 9, lines 61-67). Contrary to the view of the appellant 1 (patent proprietor) this activating signal is an information falling within the meaning of the "data" sent by the sensor to the controller of claim 1 in the meaning of features F3 and F4 and F4-1. In the Board's view and regardless of whether the allegation of the appellant 1 (patent proprietor) that the sensor (127) of D6 only provides on/off status information, what is disputed by the appellant 2 (opponent), the term "data" does not necessarily imply a complex set of information suitable for directly determining the amount of first substance released at each activation, as asserted by the appellant 1 (patent proprietor), but also covers the simple information that the release device has been activated (status=on) by the user upon inhalation or deactivated (status=off) as it is the case in D6. In this respect the Board is convinced that nothing in the claim language supports the view of the appellant 1 (patent proprietor) that feature F4-2 should be interpreted narrowly as meaning that the actual amount of first substance released by the first cartridge is estimated at each activation by the user. The formulation of feature F4-2 rather teaches that the total amount of the first substance released by the first cartridge after a certain number of activations is determined. The argument of the appellant 1 (patent

proprietor) that the apparatus of D6 releases a predetermined and known amount of a first substance at each activation, whereby its sensor is not suitable for delivering data to the controller for determining an actual variable amount of first substance released at each activation as it is the case of the apparatus of claim 1 is moot because, regardless of whether this assertion is correct or not, the intended limitation is not expressed in claim 1 which covers the possibility of releasing a predetermined fixed amount at each activation either. Such an interpretation of the claim is fully supported, as convincingly put forward by the appellant 2 (opponent), by the paragraph [008] of the opposed patent stating that *"The controller can collect data and control the cartridge and the releasing device to deliver a predetermined amount of the substance to the user"*.

1.4 In view of the reasons above, claim 1 of the main request lacks novelty in the meaning of Articles 52(1) and 54 EPC in view of D6 as correctly assessed by the opposition division in the contested decision.

1.5 Therefore, regardless of the assessment of the further objections raised by the appellant 2 (opponent) against claim 1 at stake, the Board sees no reason for deviating from the decision of the opposition division that the main request is not allowable which is hereby confirmed.

**APPEAL OF THE APPELLANT 2 (OPPONENT)**

**Alleged substantial procedural violation: Article 113 EPC**

2. The appellant 2 (opponent) alleged that the reason provided by the opposition division in the decision under appeal in support of its positive assessment of novelty of the subject-matter of claim 1 of the auxiliary request 2 on which basis the patent was maintained, namely that *"...the requirements of Article 54 EPC are met at least because smoke devices presume to have a heater. However, neither D6 nor D18 disclose heaters."* has never been discussed during the oral proceedings. It was thus argued that in view of this circumstance the appellant 2 (opponent) became aware of this for them surprising distinguishing feature only when the written decision was issued, whereby they were deprived of the opportunity to present any comments and/or suitable counter-arguments in support of their view that claim 1 lacked novelty over D6 and D18 and eventually to adapt its lines of attack regarding inventive step to the assessment of the distinguishing features by the opposition division already during the first instance proceedings. It was also argued that the fact that the contested patent itself, namely in dependent claim 8 and in paragraph [0010] of the description, presents a heater as a non-mandatory feature of the smoke inhalation apparatus according to the patent as maintained, demonstrated that the appellant 2 (opponent) could not have been expected to implicitly identify in the heater the distinguishing feature with respect to the MDI (metered doses inhalator) device of D6 or D18. The appellant 2 (opponent) thus concluded that the above circumstances result in a violation of its right to be heard which

amounts to a substantial procedural violation with respect to Article 113(1) EPC justifying remittal of the case to the first instance and the reimbursement of the appeal fee according to the provisions of Rule 103(1) (a) EPC.

- 2.1 The appellant 1 (patent proprietor) replied that from page 4 of the minutes (see statements made at 14:55) it can be deduced that the discussion on novelty of the subject-matter of claim 1 of the first instance 2nd auxiliary request related to the structural differences between a smoke inhalation apparatus and a MDI device of the kind disclosed in D6 and D18. The appellant 1 (patent proprietor) essentially argued that it was implicit from this discussion that the presence of a heater represented a clear distinguishing feature of the smoke inhalation apparatus of claim 1 with respect to the MID devices of the opposed prior art in which no smoke, intended as the result of a combustion, but only a release of the medicament contained in the cartridge takes place without any means for increasing the temperature of the first substance. Regarding the preferred features of claim 8 and the passage in paragraph [0011] of the contested patent, the appellant 1 (patent proprietor) argued that they were not inconsistent with the implicit mandatory presence of a heater, because rendering optional the presence of a heater in the first release inhalation device according to claim 8 did not exclude that a heater may be provided in the claimed smoke inhalation apparatus outside the first release device, i.e. a heater positioned downstream thereof. Furthermore, it was argued that the fact that the arguments presented by the appellant 2 (opponent) at the oral proceedings in support of the alleged lack of inventive step were not based of any one of documents D6 and D18 as closest

prior art but on document D7 which relates to a smoke inhalation apparatus comprising a heater (and not to a MDI device) in combination with D9 would prove that it was clear to the appellant 2 (opponent) that the opposition division considered the presence of a heater as a distinguishing feature of the subject-matter of claim 1 with respect to D6 and D18.

- 2.2 The Board acknowledges that the appellant 1 (patent proprietor) did not contest that the heater was not explicitly mentioned either by the division or by the parties during the novelty discussion at the oral proceedings as representing an alleged structural distinguishing feature of the smoke inhalation apparatus of claim 1 as maintained with respect to the MDI apparatuses of D6 or D18. The allegation of the appellant 1 (patent proprietor) that a smoke inhalation apparatus always comprises a heater has not been proven by any evidence and, as correctly observed by the appellant 2 (opponent), it is not even supported by the contested patent that in paragraph [0011] lines 48-56 and in claim 8 teaches that *"The first release device 118 can include one or a combination of a heating element, a vibration generator such as an ultrasonic or a piezoelectric transducer, an atomizer, or any other actuator to energize particles of the first substance..."*. This statement clearly indicated that in a smoke inhalation apparatus as the one according to the contested patent as maintained the first release device does not mandatorily comprises a heater. The counter-argument of the appellant 1 (patent proprietor) that the cited paragraph of the patent and the additional features of claim 8 are not in contradiction with the reasoning of the opposition division, i.e. with the allegation that a heater is always provided in a smoke inhalation device, is not convincing because no

embodiment implying a heater provided outside the release device, as suggested by the appellant 1 (patent proprietor), is presented in the contested patent. It cannot thus be concluded that the fact that the differences between smoke inhalation apparatus devices and MDI devices have been generally discussed at the oral proceedings could and should have led the appellant 2 (opponent) to implicitly assume that the presence of a heater in the smoke inhalation apparatus of claim 1 was considered by the opposition division as an implicit distinguishing feature. Finally the Board concurs with the observation of the appellant 2 (opponent) that a discussion on the structural differences between a smoke inhalation apparatus and a MDI devices could have been based on many other distinguishing aspects or functionality, i.e. the possibility of releasing a variable amount or not, and not necessarily on the question whether a heater was provided or not. In the Board's view this explains the choice of the appellant 2 (opponent) to select a document relating to a MDI device as closest prior art in the inventive step discussion without necessarily implying that this choice was determined by the fact that it was clear from the discussion of lack of novelty that the heater had been considered to represent a distinguishing technical feature with respect to D6 and D18.

2.3 The Board is thus convinced that the appellant 2 (opponent) actually learned of the reason for considering the subject-matter of claim 1 of the patent as maintained novel in view of D6 and D18 only from the decision, whereby it was deprived of the opportunity to provide any comments or counter-arguments regarding the issue of lack of novelty and to adapt its inventive step attacks to the finding of the opposition division.

These circumstances result in a violation of the right to be heard amounting to a substantial procedural violation with respect to Article 113(1) EPC justifying the remittal of the case to the first instance pursuant to Article 111(1) EPC and the reimbursement of the appeal fee to the appellant 2 (opponent) under Rule 103(1)(a) EPC, the substantial deficiencies in the first instance proceedings presented above representing "*special reasons*" in the meaning of Article 11 RPBA 2020.

## 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.
3. The request of the appellant 2 (opponent) for reimbursement of the appeal fee is allowed.

The Registrar:

The Chairwoman:



A. Vottner

S. Fernández de  
Córdoba

Decision electronically authenticated