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Datasheet for the decision of 7 December 2020

Case Number: T 1826/18 - 3.2.01

Application Number: 12750766.3

Publication Number: 2753201

IPC: A24F47/00

Language of the proceedings: EN

Title of invention:
HEATING SMOKABLE MATERIAL

Patent Proprietor:
Nicoventures Trading Limited

Opponent:
Philip Morris Products S.A.

Headword:

Relevant legal provisions:
EPC Art. 100(b), 100(a)
EPC R. 124(1)
RPBA 2020 Art. 13(2)
RPBA Art. 12(4)

Keyword:
Grounds for opposition - insufficiency of disclosure (no) - lack of novelty (no)
Minutes of oral proceedings - request to record statement in the minutes (refused)
Amendment after summons - exceptional circumstances (no)
Late-filed evidence - admitted (no)

Decisions cited:
T 0340/12, T 0724/08, T 1314/12, T 2471/13, G 0009/91, G 0010/91, T 0928/98, T 0263/05, T 0550/04, T 0071/06, T 0061/07, T 0916/09

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

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 1826/18 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 7 December 2020

Appellant: (Opponent)	Philip Morris Products S.A. Quai Jeanrenaud 3 2000 Neuchâtel (CH)
Representative:	Gritschneder, Sebastian Abitz & Partner Patentanwälte mbB Arabellastraße 17 81925 München (DE)
Respondent: (Patent Proprietor)	Nicoventures Trading Limited Globe House 1 Water Street London WC2R 3LA (GB)
Representative:	Dehns St. Bride's House 10 Salisbury Square London EC4Y 8JD (GB)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 7 May 2018 rejecting the opposition filed against European patent No. 2753201 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman	G. Pricolo
Members:	S. Mangin
	A. Jimenez

Summary of Facts and Submissions

I. The appeal was filed by the appellant (opponent) against the decision of the opposition division to reject the opposition filed against the patent in suit (hereinafter "the patent").

II. The opposition division decided that
(1) 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.
(2) the subject-matter of the claims as granted was novel over D1 and D2 and involved an inventive step in view of D1-D5.

III. Oral proceedings were held before the Board on 7 December 2020.

IV. The appellant (opponent) requested that the decision under appeal be set aside and that the European patent No 2753201 be revoked.

The respondent (patent proprietor) requested that the appeal be dismissed or, in the alternative, that the patent be maintained on the basis of auxiliary requests 1-21 filed with the reply to the statement of grounds of appeal.

V. Independent claim 1 of the patent reads:

M1. An apparatus (1) comprising a heating chamber (4) configured to
M2. heat smokable material (5) in the chamber without combusting the smokable material,

M3. the apparatus being operable in a first configuration to allow a gaseous flow between an interior of the chamber and an exterior of the chamber and
M4. operable in a second configuration to prevent the gaseous flow by hermetically sealing the chamber, wherein
M5. the apparatus comprises a heater (3) configured to heat the smokable material inside the chamber to volatilize at least one component of the smokable material.

Independent claim 15 of the patent reads:

M1' A method for heating smokable material (5) in
M2' a hermetically sealable heating chamber (4) without combusting the smokable material, comprising: heating smokeable material inside the heating chamber to volatilize at least one component of the smokable material:
M3' operating in a first configuration of the chamber to allow a gaseous flow between an interior of the chamber and an exterior of the chamber: and
M4' operating in a second configuration of the chamber to prevent the gaseous flow by hermetically sealing the chamber.

VI. In the present decision, reference is made to the following documents:

D1: WO 2008/121610 Al
D2: DE 10 2006 041 042 B4
D3: US 4,945,931 A
D4: US 5,865,186 A
D5: EP 1 618 803 Al
D6: WO 2012/026963 A2

D7: WO 2011/098635 Al
D7a: EP 2 534 954 Al
D8: US 2010/0031957 Al
D9: US 4,284,089 A
D10: US 2,104,266 A

Reasons for the Decision

1. Sufficiency of disclosure - Article 100(b) EPC

The Board confirms the opinion of the opposition division (reference is made to point 12, page 3 of the decision of the opposition division). The invention is sufficiently clear and complete for a skilled person to carry out the invention.

The appellant is of the opinion that claim 1, directed to an apparatus but comprising method features (M3 and M4), defines a broad scope of protection that is not justified by the disclosure of structural features of the apparatus in the patent. Furthermore, the skilled person cannot determine which features are needed to obtain the benefit of the invention and whether they operate within the scope of protection of the claims. In particular the term "operable" in feature M4 of claim 1 does not allow for a clear definition of the term and does not allow for an unambiguous determination of the scope of claim 1.

As the opposition division rightly pointed out, the functional features M3 and M4 leading to a broad claim and the lack of a clear definition of the term "operable" may at most render the scope of claim 1 unclear. However, the skilled person is able to carry out the invention in particular in view of figures 10 and 20 and paragraphs [0048] and [0069] of the patent.

Furthermore, the appellant failed to explain why the skilled person, who has at his disposal the common general knowledge, would not be able to realize, in practice, the functional features M3 and M4 in alternative ways as compared to the particular embodiment described in the patent. Accordingly, there is no issue of the skilled person not being able of carrying out the invention over the whole - allegedly broad - area claimed.

2. Novelty over D1 and D2 - Article 100(a) EPC

The Board confirms the opinion of the opposition division: The subject-matter of claims 1 and 15 is novel over D1 and D2.

2.1 In accordance with the opposition division, the Board concludes that D1 and D2 do not disclose feature M4 of claim 1 and M4' of claim 15.

Feature M4 reads: *"the apparatus is operable in a second configuration to prevent the gaseous flow by hermetically sealing the chamber".* Feature M4 thus requires an action of sealing the chamber during use to prevent the gaseous flow.
The mere presence of "frangible barrier" 35 and 45 or a "foil seal" 150 in figure 4 of D1 or a hermetically sealed cartridge 7 in figure 2 of D2, which need to be broken before being able to effectively use the apparatus does not anticipate feature M4.
Paragraph [0234] of D1 *"Filter element 80 may have foil seal 150 to seal the assembled pre-use configuration 160"* and paragraph [0235] *"The full insertion of filter element 80 also forces penetrating element 60 through the frangible barriers 35 and 45 to unseal these elements for an unobstructed air flow pathway from air*

inlet 140 to particle delivery aperture 180" confirm that the frangible barriers and the foil seal are present in a configuration before the apparatus can be effectively used.
Similarly, paragraphs [0010] and [0032] of D2 disclose that the sealed cartridge is broken through the sharp ends of the ring 15 when the mouthpiece is screwed on. Before the mouthpiece is screwed on, the apparatus of D2 cannot be used.

In both D1 and D2, there is no active sealing of the heating chamber during use to prevent gaseous flow. Therefore, feature M4 is neither anticipated by D1 nor by D2.

2.2 The appellant is of the opinion that the term "operable" means "able to be used" but does not require that it is effectively used.
Furthermore, the appellant is of the opinion that the apparatus of D1 and D2 are operable before the seals are broken.
The appellant refers to D1, paragraph [0235] and argues that before the seals are broken, the user can rotate the filter element 80 and the second housing 100 to select a desired air inlet aperture dimension thereby operating the apparatus before the seals are broken.
Similarly, the appellant refers to D2, paragraph [0022] and argues that the user can adjust the settings of the control unit and thereby operate the apparatus before the cartridge is unsealed.

2.3 The Board agrees with the appellant's that the term "operable" means "able to be used". However, the Board considers that features M3 and M4 of the claim have to be interpreted in connection with the intended use of the apparatus as defined by the claim, which is to heat

smokable material in the chamber without combusting it such as to volatilize at least one component of the smokable material and then delivering it to the exterior, i.e. the apparatus must be "operable", or "able to be used" for this intended use in both the first and the second configurations, respectively. Features M3 and M4 cannot be interpreted broadly as referring to any use of the apparatus that is not the intended use.
In D1 and D2, when the heating chamber is sealed, i.e. before the seals are broken, the user can manipulate the apparatus and make some adjustments to the apparatus. However, the apparatuses of D1 and D2 are not operable in the sense of feature M4. Indeed this would require hermetically sealing the respective chamber also when the apparatuses are in use for heating smokable material in the chamber without combusting it such as to volatilize at least one component of the smokable material and then delivering it to the exterior. This is not possible in D1 and D2, because when the seals are broken, there are no structural means that would allow re-establishing a hermetic seal.

The above reasoning applies mutatis mutandis to feature M4' of independent method claim 15.

3. Objections on inventive step based on D1-D5

3.1 In its grounds of appeal the appellant only made a general reference to its submissions in the preceding opposition proceedings. Under point VII of the statements of the grounds of appeal, pages 18 and 19, the appellant states: *"Should the Board come to the unlikely conclusion that the subject-matter of the independent claims of EP1 are novel in view of the*

cited prior art, we hereby indicate that these claims lack inventive step in view of all above cited prior art documents in combination with the common general knowledge or in combination with any one of other cited documents. The objections of lack of inventive step as already put forward during the previous opposition proceedings are maintained but are not repeated herein in order to avoid unnecessary repetitions". The Appellant further states in its conclusion under point IX *"Independent claims 1 and 15 of EP1 lack inventive step in view of the cited prior art, in particular in view of a combination of D9 and D10, D3 and D1, D4 and D1 or D2, and D5 and D1 or D2".*

As pointed out in the Board's communication pursuant to Article 15(1) RPBA, the above statements regarding the lack of inventive step in view of D1-D5 amount to no more than a mere assertion that the contested decision was incorrect, without stating the legal or factual reasons why that decision should be set aside. Consequently, the appellant has left it entirely to the Board and the respondent to conjecture in what respect the appellant might consider the decision under appeal regarding inventive step over documents D1-D5 to be defective.
Therefore, the Board considers that the inventive step objections in view of D1-D5 submitted with the statement of grounds of appeal do not meet the requirements of Article 12(2) RPBA 2007 (which applies here), according to which the statement of grounds of appeal shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on, and thus are not taken into consideration in accordance with Article 12(4) RPBA 2007, last sentence.

3.2 It is noted that, in its reply to the Board's communication pursuant Article 15(1) RPBA, the appellant did not address the above issue and concentrated on the admission of documents D6-10 and the related novelty and inventive step objections. During oral proceedings the appellant submitted that it was intended to argue only
- starting from figure 11 of D1 in combination with the skilled person's general knowledge, and
- starting from D4 in combination with D1 or D2.

Considering that these objections were not substantiated at any time during the appeal proceedings, these submissions constitute an amendment to the appellant's appeal case made at the oral proceedings. In accordance with Article 13(2) RPBA 2020 (which applies here as the summons to oral proceedings were issued after entry into force of the revised RPBA, see Article 25(3) RPBA 2020), an amendment to a party's appeal case made after notification of a summons to oral proceedings shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

3.3 The appellant argued that the two above mentioned lines of attack were only submitted in oral proceedings to focus the written submissions on the lack of novelty in view of D6, D7 and D8 and the lack of inventive step in view of D9 and D10 and thereby avoid lengthening unnecessarily the statement of grounds of appeal.

3.4 The Board considers that these do not constitute exceptional circumstances justified with cogent reasons by the appellant. Indeed whilst a concise statement of ground of appeal is certainly desirable, this cannot be

at the detriment of the legal requirement (Rule 99 EPC and Article 12 RPBA) that the statement of ground of appeal must be complete, i.e. in the present case that it should include all the lines of attacks that the appellant intends to rely upon.

4. Admission of documents D6-D10 - Article 12(4) RPBA 2007

The Board does not admit in the appeal proceedings documents D6-D10 and the related novelty and inventive step attacks.

4.1 Together with its statement of grounds of appeal the appellant submitted documents D6-D10. In the case before the Board the statement of grounds of appeal were submitted before 1 January 2020 hence the question whether or not new submissions should be admitted must be decided on the basis of Article 12(4) RPBA 2007, which gives the Board discretion not to admit, on appeal, documents that could have been presented in the opposition proceedings (Article 25(2) RPBA 2020).

4.2 The appellant argued that documents D6-D10 should be admitted in the appeal proceedings for the following reasons:
(i) - It came as a surprise to the appellant that in the decision of the opposition division, a “pre-use configuration” could not be considered as an “operable configuration”.
(ii)- The appellant was not aware of documents D6-D10 during opposition proceedings.
(iii)- Documents D6-D10 were prima facie relevant. In particular D6, figure 8, and pages 35-36 disclosed all the features of claims 1 and 15. The appellant referred to T 340/12, whereby "the board admitted the late-filed document into the proceedings and stated that in this

case the prima facie high relevance of the document should take precedence over the procedural aspect of its late filing" and page 1263, Chapter V.A.4.13.2 of the 9th edition of the Case Law of the Board of Appeal.
(iv) Documents D6-D10 were filed at the very beginning of the appeal proceedings and did not introduce any particularly complex technical or legal issues such that they could be dealt with without adjournment of the oral proceedings.
(v)- There was no abuse of procedure. Documents D6-D10 were not filed belatedly for any strategic measure in order to surprise the respondent or in order to unduly improve the appellant's case against the respondent. The appellant further noted that the respondent already considered these documents in the letter of 1 February 2019.

4.3 The Board is not convinced by the above arguments. The Board judges that the prior art documents D6-D10 filed with the statement of grounds and the objections based thereon could and should have been filed in first-instance proceedings.

(i) The patent proprietor (respondent in these appeal proceedings) in its reply to the notice of opposition pages 4-6 had already raised the issue that in D1 and D2 the heating chamber is hermetically sealed in its pre-use configuration and not in an operable configuration.
Regarding the first novelty attack based on figure 4 of D1, the patent proprietor argued: *"Moreover, it is contended that the skilled person would not interpret the word "operable", in the context of the present invention, to be associated with "assembly" rather than with use in operation".* Then further stated: *"The preceding paragraph [0234] refers to the state before*

*the frangible barriers are broken as a **pre-use** configuration"* and referring to feature M4, *"The skilled person would read this feature as an action (i.e. the act of sealing" the chamber)"*

Regarding the second novelty attack based on figure 4 of D1, the respondent argued: *"As with the First Novelty Attack, we contend that the skilled person would not consider a pre-use configuration in the context of operation of the claimed invention".*

Finally, regarding the lack of novelty in view of D2, the respondent stated: *"The skilled person would not consider a pre-use configuration of D2 to anticipate the claims of the present invention".*

This view was also confirmed by the opposition division in its preliminary opinion in the annex to the summons to oral proceedings. While the opposition division did not use the wording "pre-use configuration" as opposed to "operable", in the summons, their preliminary opinion was in essence the same: *"The aspect of these claims pertaining to the apparatus being operable in two different configurations (essentially a sealed and a non-sealed configuration) cannot be seen in D1 and D2. The smokable material therein is provided in a sealed cartridge which upon rupture allows the apparatus to volatize the smokable material. An operation of the apparatus in a sealed configuration cannot be seen in D1 and D2".*

Accordingly, the Board cannot recognise that only with the decision of the opposition division the opponent (now appellant) was made aware that the "pre-use configuration" could not be considered as an "operable configuration". On the contrary, this interpretation was consistently adopted by the patent proprietor and the opposition division throughout the first instance proceedings.

(ii) Moreover, documents D6-D10 are patent specifications all published before mid-2012 thus more than 4 years before the notice of opposition. Therefore, these documents were retrievable during opposition proceeding from any comprehensible patent database available.

(iii) In exercising its power of discretion, the Board could make admitting a citation into appeal proceedings dependent on whether it is prima facie relevant but the Board is not obliged to do so, because otherwise an opponent could easily submit a (highly) relevant citation for the first time in the statement setting out the grounds of appeal and expect the citation to be admitted into the appeal proceedings on grounds of relevance only(T724/08, T1314/12 and T2471/13).

The Board notes that the circumstances in T340/12 referred to by the appellant are different to the present case. In T340/12, the appellant initially did not object to the admissibility of D36 submitted with the statement of grounds of appeal, but instead requested remittal of the case. Furthermore, in their discussion regarding remittal, the Board took the view that a fresh case had not arisen with the inventive step attack in view of D6 with D36 compared to the inventive step in view of D6 in combination with D27 present in opposition proceedings. The Board consequently refused the respondent's request for remittal.

In the present case the respondent has objected to the admission of the documents D6-D10 with its reply to the statement of grounds and further requested remittal should the documents be admitted. Moreover, the novelty objections based on documents D6-D8 and inventive step

D9 in combination with D10 constitute a fresh case, as these attacks are substantially different from the ones in opposition proceedings based on D1-D5.

(iv) and (v) While documents D6-D10 have been submitted in appeal proceedings with the statement of grounds of appeal and no abuse of procedure can be recognised, according to Article 12(4) RPBA 2007, the Board cannot recognise any valid reasons for not submitting these documents and the related attacks in opposition proceedings.
In G 9/91 and G 10/91 (OJ 1993, 408, 420) in particular, it was held that the main purpose of the inter partes appeal procedure is to conduct a final review of the decision given at the previous instance and thereby provide the losing party with an opportunity to challenge the decision against it and obtain a judicial ruling on whether it is correct. The appeal proceedings are thus largely determined by the factual and legal scope of the preceding opposition proceedings.
Consequently, the appeal proceedings should not be considered as a continuation of the opposition proceedings, whereby new novelty and inventive step attacks are submitted based on new documents.

5. Request to record the interpretation of the term "operable" in the minutes - Rule 124(1) EPC

The Board refused the request of the appellant to have the interpretation of the word "operable" minuted as the purpose of the minutes is to record the relevant aspect of the appeal procedure.

According to the jurisprudence of the Boards of Appeal, (see T 928/98, T 263/05 (OJ 2008, 329), T 550/04,

T 71/06, T 61/07 and T 916/09) it is not the function of the minutes to record statements which a party considers will be of use to it in any subsequent proceedings in national courts, for example in infringement proceedings as to the extent of protection conferred by the patent in suit. This is because such statements are not "relevant" to the decision which the board has to take, within the meaning of Rule 124(1) EPC. Such matters are within the exclusive jurisdiction of the national courts (Reference is made to the Case Law of The Board of Appeal III.C.7.10.2).

In any case, point 2 of the present decision gives an interpretation of the term "operable" for the purpose of determining whether documents D1 and D2 anticipate features M4 and M4'.

6. It follows from the above that the appellant's case is not convincing and the contested decision confirmed.

Order

For these reasons it is decided that:

The appeal is dismissed

The Registrar: The Chairman:

D. Magliano G. Pricolo

Decision electronically authenticated