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**Datasheet for the decision
of 19 May 2022**

Case Number: T 0315/19 - 3.2.02

Application Number: 14153323.2

Publication Number: 2756859

IPC: A61M15/06

Language of the proceedings: EN

Title of invention:

Low temperature electronic vaporization device

Patent Proprietor:

Juul Labs International Inc.

Opponent:

Kayser & Cobet
Patentanwälte Partnerschaft

Headword:

Relevant legal provisions:

EPC Art. 76(1), 99(1)
EPC R. 131(4)
RFees Art. 7(3)
RPBA 2020 Art. 13(2), 25

Keyword:

Divisional application - added subject-matter (yes)
Admissibility of opposition - (yes) - opposition fee
validly paid (yes)
Amendment after summons - exceptional circumstances (no)
- taken into account (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 0315/19 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 19 May 2022

Appellant: Kayser & Cobet
(Opponent) Patentanwälte Partnerschaft
Am Borsigturm 9
13507 Berlin (DE)

Representative: Siepmann, Felix
Abitz & Partner
Patentanwälte mbB
Arabellastraße 17
81925 München (DE)

Respondent: Juul Labs International Inc.
(Patent Proprietor) 560 20th Street
San Francisco, CA 94107 (US)

Representative: Thum, Bernhard
Thum & Partner
Thum Mötsch Weickert
Patentanwälte PartG mbB
Siebertstr. 6
81675 München (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 21 November
2018 rejecting the opposition filed against
European patent No. 2756859 pursuant to Article
101(2) EPC**

Composition of the Board:

Chairman M. Alvazzi Delfrate
Members: D. Ceccarelli
 C. Schmidt

Summary of Facts and Submissions

- I. The patent proprietor and the opponent appealed against the Opposition Division's decision, posted on 21 November 2018, to reject the opposition against European patent No. 2 756 859.

The patent is derived from a divisional application of European patent application No. 12 824 116.3 ("the parent application"), published as WO-A-2013/025921 under the PCT.

- II. The Board summoned the parties to oral proceedings and sent its preliminary opinion in a communication dated 14 February 2022. In this communication, the Board expressed the view that because of the omission of the term "viscous", claim 1 of the patent as granted appeared to include added subject-matter.

- III. Oral proceedings took place on 19 May 2022.

In the oral proceedings, the proprietor withdrew its appeal.

The appellant/opponent ("the appellant") requested that the decision under appeal be set aside and that the patent be revoked.

The respondent/proprietor ("the respondent") requested that the decision of the Opposition Division to maintain the patent as granted be confirmed (main request) or, as a precautionary measure, that the patent be maintained on the basis of one of auxiliary requests I to IV filed by letter dated 16 August 2019 or on the basis of one of auxiliary requests V to IX

filed by letter dated 25 February 2022.

IV. The following documents are mentioned in this decision:

A1: Bank statement dated 21 June 2017

D15: Bank statement dated 19 February 2019

V. Claim 1 of the **main request** reads as follows:

"A device (100, 200, 300; 400, 500, 600) for generating an inhalable aerosol, wherein the device comprises a mouthpiece (110, 310; 410, 510), a body (101), an electronic heater (105, 104, 210; 524) within said body (101) configured to heat a vaporizable material (270) and generate an inhalable aerosol, and a temperature regulator (815) within said body (101), **characterised in that** the device (100, 200, 300; 400, 500, 600) has three modes of operation which include a standby mode, an on mode, and an off mode; wherein the device (100, 200, 300; 400, 500, 600) is configured to convert from the standby mode to the on mode in response to at least one of: movement, removal from a charging cradle (724; 827), user touch, the user puffing on the device, or activation by pressing any button (102, 302; 802) on the device, and the device is configured to convert from the on mode to the standby mode after placement in a charging cradle (724; 827)."

Claim 1 of **auxiliary request I** reads as claim 1 of the main request with the addition of the following wording just before the characterising portion:

"and a battery (103, 803)"

and the following wording at the end of the claim:

", and
wherein the device comprises an LED indicator (460)
configured to indicate that the device is heating up,
to indicate the current battery level, and/or to
indicate that the device is being charged".

Claim 1 of **auxiliary request II** reads as claim 1 of the
main request with the addition of the following wording
just before the characterising portion:

"and a battery (103, 803)"

and the following wording at the end of the claim:

"wherein the device comprises an LED indicator (460)
configured to indicate that the device is heating up,
to indicate the current battery level".

Claim 1 of **auxiliary request III** reads as claim 1 of
the main request with the addition of the following
wording just before the characterising portion:

"and a battery (103, 803)"

and the following wording at the end of the claim:

", and
wherein the device comprises an LED indicator (460)
configured to indicate that the device is heating up,
to indicate the current battery level, and to indicate
that the device is being charged".

Claim 1 of **auxiliary request IV** reads as claim 1 of the
main request with the addition of the following wording
just before the characterising portion:

"and a battery (103, 803)"

and the following wording at the end of the claim:

"wherein the device comprises an LED indicator (460) configured to indicate that the device is heating up, to indicate the current battery level, and to indicate that the device is being charged, and wherein the device comprises a thermally conductive shell configured to distribute excess heat and configured to maintain a low exposed surface temperature".

Claim 1 of **auxiliary requests V to IX** respectively corresponds to claim 1 of the main request and auxiliary requests I to IV with the addition of the term "viscous" before the expression "vaporizable material".

VI. The appellant's arguments relevant to the decision are summarised as follows.

Admissibility of the opposition

The Opposition Division's decision that the opposition fee had been paid in time and that the opposition was admissible was correct. As further evidence for the timely payment, D15 had been filed on appeal. This document was a bank statement comprising a stamp and a signature from the bank confirming the payment order of the opposition fee made on 21 June 2017.

Admissibility of new arguments of the respondent

The respondent had filed new arguments with the

submission of 25 February 2022 (pages 2 to 7) on why the omission of the term "viscous" from claim 1 of the main request and auxiliary requests I to IV did not lead to added subject-matter. These new arguments, which could change the outcome of the case, were a change of the respondent's appeal case made after the summons to oral proceedings. They should not be admitted into the proceedings in accordance with Article 13(2) RPBA.

Main request and auxiliary requests I to IV - added subject-matter

Claim 1 of the main request and auxiliary requests I to IV was not limited to a vaporisable material which was viscous. The conventional understanding of the term "viscous" by the person skilled in the art was the property of a material with a high viscosity such as a slurry with a sticky consistency. The definition of a viscous vaporisable material excluded free-flowing liquids. The description and all the independent claims of the parent application as filed consistently taught a "viscous vaporizable material". The description disclosed embodiments usable with or without a cartridge containing the viscous vaporisable material. There was no teaching on any of these embodiments that the vaporisable material could be a free-flowing liquid.

The general mentioning of a "material" in paragraph [0005] of the parent application as filed was only a semantic simplification of the term "viscous vaporizable material" as this paragraph described the invention in general terms and did not specify the viscosity or any other properties of the material to be vaporised. The examples of the material were described

later in the description. Paragraphs [0099] and [0101] to [0103] mentioned materials that could be included in the viscous vaporisable material according to the invention as originally claimed.

Otherwise, the description of the parent application as filed always taught "viscous vaporizable material". Hence, the omission of the term "viscous" resulted in added subject-matter.

Admissibility of auxiliary requests V to IX

Auxiliary requests V to IX should not be admitted into the appeal proceedings in accordance with Article 13(2) RPBA. These requests were filed after the summons to oral proceedings in the absence of any exceptional circumstances. The discussion of added matter concerning the omission of the term "viscous" started at the very beginning of the first-instance proceedings, was present throughout the first-instance proceedings and continued with the appeal substantiation. The fact that the Board's preliminary opinion deviated from the decision under appeal could not be considered an exceptional circumstance. Page 34 of the respondent's letter dated 16 August 2019 did not indicate the auxiliary requests but mentioned a multitude of features which could be addressed in a multitude of auxiliary requests. It was not sufficient to point to potential auxiliary requests; it was necessary to file the requests for all the parties to have a fair chance to study them and present potential counter arguments.

VII. The respondent's arguments relevant to the decision are summarised as follows.

Admissibility of the opposition

The opposition was inadmissible because the opposition fee had not been paid within the opposition term. The fee was received by the EPO two days after the expiry of the opposition term. A1 did not include any indication of a bank or any other official feature that allowed recognising it as an official document. It could not prove that the payment had been ordered within the opposition term. D15 was filed after the conclusion of the first-instance proceedings and introduced alleged new evidence. It should be disregarded. Moreover, it indicated a "Valutadatum", i.e. the date on which the entry of money into an account is considered effective, which was still one day after the opposition term.

Admissibility of new arguments of the respondent

The respondent's arguments filed with the submission of 25 February 2022 (pages 2 to 7) did not constitute a change but merely a refinement of the respondent's appeal case in relation to the omission of the term "viscous" from claim 1 of the main request and auxiliary requests I to IV in response to the Board's preliminary opinion.

Main request and auxiliary requests I to IV - added subject-matter

The term "viscous" related to an inherent feature of any material, i.e. its viscosity, which also depended on temperature. For example, the viscosity of water

changed substantially even in a temperature range which belonged to the daily life of a person, i.e. between 0 and 100 °C. The same was true, for example, for polypropylene glycol and glycerin, mentioned in the parent application as filed. It followed that adding or omitting the term "viscous" did not change anything for the claim scope.

Moreover, paragraphs [0002] and [0005] of the parent application as filed respectively referred to the "burning of the material" and "aerosolizing a material" without any mention of a viscous material. The parent application as filed disclosed two embodiments of a device for generating an inhalable aerosol, depicted in Figures 2 and 5. Contrary to the Board's preliminary opinion, item 270 in Figure 2 was not an oven but a pod or cartridge to be inserted in the oven of the device. Such a cartridge was sealed, hence it could contain a liquid material without spilling, so that the device could function with a liquid vaporisable material. As a consequence, the relative viscosity of the material was not an essential feature. Paragraph [0099] generally indicated that "any material" could be incorporated into a device or cartridge of the invention and listed a number of solid materials compatible with the claimed device. Paragraphs [0101] and [0102] disclosed that the aerosolisable material included in the cartridge could be chopped tobacco material, which could be processed with other ingredients to obtain a paste-like material. Moreover, paragraph [0101] taught that glycerin, i.e. a liquid, could be used as a carrier for cured tobacco and flavourings. Paragraph [0103] disclosed further examples of liquid forming media. The same teaching was present in the patent as granted. Hence, the parent application as filed and the patent as granted provided their own definition of the term viscous vaporisable

material including liquid and non-liquid material. Also for this reason, adding or omitting the term "viscous" did not change anything for the claim scope.

It followed that the omission of the term "viscous" in claim 1 of the main request and auxiliary requests I to IV did not result in added subject-matter.

Admissibility of auxiliary requests V to IX

In claim 1 of each of auxiliary requests V to IX, it had been specified that the vaporisable material was "viscous".

The strict provision of Article 13(2) RPBA 2020 should not be applied as this appeal case was pending when this provision entered into force.

Moreover, even if Article 13(2) RPBA 2020 were applied, adding the term "viscous" did not change the substance of the case. The newly filed auxiliary requests V to IX had been anticipated in the respondent's letter dated 16 August 2019 (pages 13 and 34), so the filing of these requests could not be a surprise. Moreover, the requests had been filed immediately in reaction to the Board's preliminary opinion which surprisingly deviated from the impugned decision.

Before the entry into force of the RPBA 2020, anticipating the potential filing of auxiliary requests as done by the letter dated 16 August 2019 would have been sufficient for the Board to admit these requests.

For these reasons, auxiliary requests V to IX should be admitted into the appeal proceedings.

Reasons for the Decision

1. The invention

The claimed invention relates to a device for generating an inhalable aerosol, such as in an electronic cigarette.

The device comprises a mouthpiece, a body, an electronic heater within the body and a temperature regulator within the body.

The electronic heater is configured to heat a vaporisable material and generate an inhalable aerosol.

The device has three modes of operation which include a standby mode, an on mode and an off mode.

The device is configured to convert from the standby mode to the on mode in response to at least one of movement, removal from a charging cradle, user touch, the user puffing on the device or activation by pressing any button on the device.

The device is also configured to convert from the on mode to the standby mode after placement in a charging cradle.

Conversion to the standby mode helps saving battery power, whereas the claimed conversion from the standby mode to the on mode is for giving the user the impression of an uninterrupted puffing experience (paragraphs [0061] and [0062] of the patent).

2. Admissibility of the opposition

The respondent argued that the opposition fee had not been paid before the expiry of the opposition period.

The publication of the mention of the grant of the patent in suit in the European Patent Bulletin took place on 21 September 2016. Hence, in accordance with Article 99(1) EPC and Rule 131(4) EPC, the opposition period expired on 21 June 2017.

It is common ground that the opposition fee was not received by the EPO by that date.

However, under Article 7(3) (a) and (b) RFees in force at that time, the period for payment of a fee must be considered to be observed if evidence is provided to the EPO that the person who made the payment duly gave an order to a banking establishment in a contracting state to transfer the amount of the payment within the period within which the payment should have been made and paid a surcharge of 10% on the relevant fee.

On 23 June 2017, the opposition fee together with a surcharge of 10% was received by the EPO.

By letter dated 20 July 2017, the appellant provided a copy of a statement of a German bank (A1) indicating that the order to transfer the amount of the payment was given on 21 June 2017.

The Opposition Division considered this bank statement to be sufficient evidence that the person who made the payment duly gave an order to a banking establishment in a contracting state to transfer the amount of the payment within the period within which the payment

should have been made. Consequently, under Article 7(3) (a) and (b) RFees, it concluded that the period for payment of the opposition fee had been observed.

The respondent contested that A1 was sufficient evidence of the order of the payment. It argued that A1 did not include any indication of a bank or any other official feature that identified it as an official document.

On appeal, the appellant filed a further document (D15) showing bank transfers from a bank account of the HypoVereinsbank, including a bank transfer of the opposition fee and the surcharge, ordered on 21 June 2017. The respondent argued that this document should be disregarded as it had been filed late. However, the Board considers its filing, which took place with the statement of grounds of appeal, as a legitimate reaction to the respondent questioning the findings of the Opposition Division in the impugned decision. Under Article 12(4) RPBA 2007, the Board admits D15 into the appeal proceedings.

On the basis of A1 and D15, the Board is convinced that an order of payment to a banking establishment in a contracting state was given before the end of the opposition period. The date on which the money was effectively transferred to the bank account of the EPO ("Valutadatum" in D15) is of no relevance.

For these reasons, the Board concludes that the period for payment of the opposition fee was observed and that the opposition is admissible (Article 99(1) EPC and Rule 131(4) EPC).

3. Admissibility of new arguments of the respondent

The appellant argued that the respondent's arguments concerning the omission of the term "viscous" in claim 1 of the main request and auxiliary requests I to IV filed with the submission of 25 February 2022 should not be admitted into the proceedings in accordance with Article 13(2) RPBA 2020.

Under this article, any amendment to a party's appeal case made after notification of a summons to oral proceedings must, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

The Board notes that the issue of the omission of the term "viscous" was a matter of discussion throughout the first-instance and appeal proceedings. The respondent's arguments filed with the submissions dated 25 February 2022, in particular the reference to passages of the parent application as filed and the well-known viscosity of water and other liquids depending on the temperature, do not introduce new evidence. Furthermore, they are to be seen as a refinement of the respondent's arguments provided with its reply to the appellant's statement of grounds addressing points raised by the Board in its preliminary opinion. They do not amount to a change of the respondent's appeal case. Hence, the Board has no power to disregard them under Article 13(2) RPBA.

4. Main request and auxiliary requests I to IV - added subject-matter

The appellant argued that the subject-matter of claim 1

of the main request and auxiliary requests I to IV included added subject-matter.

The subject-matter of claim 1 of these requests is generally based on paragraph [0071] of the parent application as filed.

The appellant argued that there was no basis in the parent application as filed for an electronic heater configured to heat a vaporisable material without specifying that the material was "viscous".

All the independent claims of the parent application as filed define a heater "configured to heat a viscous vaporizable material and generate an inhalable aerosol". Also in the description, whenever heating of a material is mentioned (about 50 occurrences), it is specified that the material is viscous.

The respondent asserted that the term "viscous" referred to an inherent feature of every material and that adding or omitting this term did not change anything for the claim scope. This argument has no merit as it disregards the context of the patent in suit. For the person skilled in the art, the term "viscous" means that the material, in the condition of use of the device for generating an inhalable aerosol, cannot flow freely even if not otherwise constrained. This is because the person skilled in the art knows that with a device for generating an aerosol in the field of the invention, this kind of "viscous" materials as well as free-flowing liquids may be used, depending on the configuration of the device.

The structural features which a heater configured to heat a viscous material must comprise do not make it

necessarily suitable for heating a non-viscous, i.e. a free-flowing liquid, material. The components identified as the heater in the drawings (the oven for receiving pod 270 in Figure 2 and oven 524, Figure 5) are not disclosed to be suitable for heating a liquid material. Such a material, in the absence of specific constructional measures, could flow out of the mouthpiece of the shown devices. The respondent's reference to the embodiment of Figure 2 employing a cartridge is not convincing since, in use, the cartridge has to be pierced and liquid contained in it could also flow out of the mouthpiece in the absence of appropriate measures. The wrong reference to item 270 by the Board in the preliminary opinion, correctly noticed by the respondent, does not change this conclusion.

The respondent's reference to paragraphs [0002], [0005] and [0099] of the parent application as filed is not convincing either. In those paragraphs, materials to be aerosolised are mentioned. There is a difference between the material to be heated by the heater, i.e. the piece of material to be placed within the claimed device, and the materials which are then aerosolised, i.e. the materials which, when inhaled, provide an experience to the user (paragraph [0099]). These latter materials, to which paragraphs [0005] and [0099] of the parent application as filed refer, are intended to be included in the viscous vaporisable material to be heated, according to the terms in the parent application as filed. The same holds true for paragraphs [0101] to [0103], which mention several materials such as chopped tobacco material and glycerin. These materials are processed together with other materials to obtain the "viscous vaporizable material", e.g. with paste-like consistency as

mentioned in paragraph [0101], to be heated by the heater.

For these reasons, the Board concludes that the omission of the term "viscous" in claim 1 of the main request and auxiliary requests I to IV adds subject-matter as it conveys the technical information, which was not disclosed in the parent application as filed, that the heater may be configured to heat liquid materials.

It follows that the main request and auxiliary requests I to IV are not allowable for lack of compliance with Article 76(1) EPC.

5. Admissibility of auxiliary requests V to IX

Auxiliary requests V to IX were filed after notification of the summons to oral proceedings.

Under Article 13(2) RPBA 2020, any amendment to a party's appeal case made after notification of a summons to oral proceedings must, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

The respondent's argument that Article 13(2) RPBA 2020 should not be applied because this appeal was pending when this provision entered into force is without merit. Under Article 25(1) RPBA 2020, the revised version of the RPBA applies to appeals pending on the date of the entry into force. As regards Article 13(2) RPBA 2020, an exception is made only where the summons to oral proceedings or a communication of the Board under Rule 100, paragraph 2, EPC was notified before

the date of the entry into force (Article 25(3) EPC). This is, however, not the case for the current appeal.

In claim 1 of each of auxiliary requests V to IX, the vaporisable material has been defined to be "viscous". The respondent's argument that the addition of the term "viscous" did not change the substance of the case is without merit since the term "viscous" has a specific technical meaning in the context of the patent, as explained above. The respondent referred to the fact that the newly filed auxiliary requests V to IX had been anticipated with the letter dated 16 August 2019 (pages 13 and 34). In this letter, the respondent referred to a number of potential auxiliary requests which may include "the term viscous, the arrangement of the temperature regulator within the body, the term mode of operation etc. into the Main Request or - as far as necessary - in the Auxiliary Requests I to IV" (page 34 of this letter). However, none of such requests was filed before the notification of the summons to oral proceedings. There was no need for the appellant to prepare objections and arguments until the filing of a request. Thus, the Board has to conclude that the filing of auxiliary requests V to IX amounts to an amendment of the respondent's appeal case.

The respondent could not point to any exceptional circumstances, justified with cogent reasons, for the amendment of its appeal case.

The Board's preliminary opinion on an issue which was a matter of dispute throughout the first-instance proceedings and since the beginning of the appeal proceedings cannot amount to exceptional circumstances, irrespective of whether this preliminary opinion deviates from the impugned decision. The primary task

of the appeal proceedings is to review the decision under appeal (Article 12(2) RPBA 2020).

Finally, the respondent's reference to the practice of the boards before the entry into force of the RPBA 2020 is irrelevant.

The Board can understand that a previous practice may give rise to certain expectations. However, it must be borne in mind that when new legal provisions enter into force, previous old provisions and practice may be superseded. The Board has to apply the provisions in force at the time of the decision.

For these reasons, auxiliary requests V to IX are not admitted into the proceedings in accordance with Article 13(2) RPBA 2020.

6. Since the ground for opposition of added subject-matter (Article 100(c) EPC) prejudices the maintenance of the patent as granted and none of the respondent's auxiliary requests in the appeal proceedings meet the requirements of the EPC, the patent has to be revoked (Article 101(2) and (3)(b) EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



D. Hampe

M. Alvazzi Delfrate

Decision electronically authenticated