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**Datasheet for the decision  
of 2 September 2021**

**Case Number:** T 2099/19 - 3.2.01

**Application Number:** 15167334.0

**Publication Number:** 2944206

**IPC:** A24C5/32, A24F47/00

**Language of the proceedings:** EN

**Title of invention:**

SYSTEM FOR PERFORMING A PROCESSING STEP ON CIGARETTE PARTS OF  
AN ELECTRONIC CIGARETTE

**Patent Proprietor:**

Sluis Cigar Machinery B.V.

**Opponent:**

Lösch, Christoph Ludwig Klaus

**Headword:**

**Relevant legal provisions:**

EPC Art. 56

RPBA Art. 12(4)

**Keyword:**

Late filed facts and evidence - could have been filed in first instance proceedings (yes)

Inventive step - main request (yes)

**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 2099/19 - 3.2.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.01**  
**of 2 September 2021**

**Appellant:** Lösch, Christoph Ludwig Klaus  
(Opponent) LÖSCH Patentanwälte  
Albrecht-Dürer-Platz 4  
90403 Nürnberg (DE)

**Representative:** Lösch, Christoph Ludwig Klaus  
LÖSCH Patentanwälte  
Albrecht-Dürer-Platz 4  
90403 Nürnberg (DE)

**Respondent:** Sluis Cigar Machinery B.V.  
(Patent Proprietor) Constructieweg 45  
8263 BC Kampen (NL)

**Representative:** EP&C  
P.O. Box 3241  
2280 GE Rijswijk (NL)

**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
31 May 2019 concerning maintenance of the  
European Patent No. 2944206 in amended form.**

**Composition of the Board:**

**Chairman** G. Pricolo  
**Members:** A. Wagner  
A. Jimenez

## **Summary of Facts and Submissions**

- I. The appeal of the opponent lies against the decision of the opposition division to maintain the European Patent No. 2944206 in amended form on the basis of auxiliary request 4 filed during oral proceedings.
- II. In its decision, the opposition division held among others that the objections raised by the opponent under Article 100(a) EPC in combination with Article 56 EPC against the independent method claim 12 were not prejudicial to the maintenance of the patent according to auxiliary request 4. The independent claim 1 directed to a system was not objected to. The Opposition Division further found that auxiliary requests 1 to 3 were not allowable under Article 84 EPC, while the requirements of Article 84 EPC and Article 123(2) EPC were met for both the independent claims 1 and 12 of auxiliary request 4 (decision, chapter 17.1.1).
- III. In order to come to these conclusions the opposition division considered, among others, the following documents:
- D1: US 6,681,816 B2
  - D2: EP 1 996 467 B1
  - D3: WO 2009/040325 A2
  - D4: WO 2010/073118 A1
  - D5: WO 2013/182826 A1
  - D12: CN 102765690 A
  - D12A: Translation of D12
- IV. With the statement of grounds of appeal, the appellant (opponent) raised objections under Article 123(2) EPC,

Article 84 EPC and Article 56 EPC against claim 1 and under Article 56 EPC against claim 12. To support the inventive step objection against claim 1, the appellant (opponent) filed documents

D13: WO2006/058102 A2

D14: US 5,842,579

D15: US 2,748,346

V. Oral proceedings were held before the Board on 2 September 2021.

VI. 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, as a main request, or, in the alternative, that the patent be maintained in amended form in accordance with one of the auxiliary requests 1 to 19, 1' to 19' and 1" to 19", filed with the letter of 2 July 2021 (auxiliary requests 15, 17 and 19 and in the respective versions ' (prime) and " (double prime) being only those marked "corrected"), and auxiliary requests 28 and 29 filed with letter of 31 August 2021.

VII. Claims 1 and 12 of the main request read as follows (with the numbering of features adopted by the appellant):

Claim 1:

**1.1** System (1) for testing vaporizers (38) of an electronic cigarette, which vaporizers have a heating member and a cartridge, said system comprising:

**1.2** a transport device (4) comprising multiple holding units (5) for holding the vaporizers, wherein the holding units are positioned at a holding distance (6) from each other while forming a circular configuration, and the transport device comprises a transporter drive (8) by which the holding units are moved at a speed in a rotation direction (9) along a circular trajectory (10) having a centre (11),

**1.3** a supply unit (12) which places the vaporizers in the holding units of the transport device at a receiving location (13) along the circular trajectory so that the vaporizers are transported along at least part of the circular trajectory,

**1.4** a discharge unit (14) which removes the vaporizers from the holding units at a discharge location (15) along the circular trajectory,

**1.5** a pivot device (16) comprising multiple processing units (17) positioned along at least a part of the circular trajectory at a process distance (18) from each other which corresponds with the holding distance between the holding units (5) so that the processing units can be associated with the vaporizers held by the holding units, wherein:

**1.6** the pivot device is pivotable about a pivot axis (19) extending through the centre of the circular trajectory,

**1.7** the pivot device comprises a pivot drive (20) to alternately pivot the processing units from a first radial position (21) to a second radial position (22) in a first pivot direction (23) parallel to the circular trajectory and in the rotation direction of

the transport device and synchronously with the vaporizers transported by the transport device and subsequently back from the second radial position to the first radial position in a second pivot direction (24) parallel to the circular trajectory and opposite to the rotation direction of the transport device,

**1.8** in the first radial position, each processing unit is positioned in an associated position (25) relative to one of the vaporizers held by the holding units of the transport device, and

**1.9** each processing unit tests the vaporizers associated with said processing unit while the pivot device pivots from the first radial position to the second radial position synchronously with said associated vaporizers,

**1.10** the pivot device comprises an axial drive (26) which moves the processing units located near or at the first radial position towards said associated vaporizers into a second axial position (27), while maintaining the processing units in the second axial position during the pivoting to the second radial position, and subsequently moves the processing units located near or at the second radial position away from said associated vaporizers into a first axial position (28), while maintaining the processing units in the first axial position during the pivoting to the first radial position,

**1.11** the processing units located in the second axial position are in contact with said associated vaporizers and the processing units located in the first axial position are not in contact with said associated vaporizers, and

**1.12** each processing unit comprises a first electrical unit contact member (30) which in the second axial position is in contact with a first electrical cigarette contact member (32) provided on each of said associated vaporizers and in the first axial position is not in contact with said first electrical cigarette contact members.

Claim 12:

**12.1** Method for performing a processing step on cigarette parts (2) of an electronic cigarette with a system (1) for performing a processing step on cigarette parts (2) of an electronic cigarette, said system comprising:

**12.2** a transport device (4) comprising multiple holding units (5) for holding the cigarette parts, wherein the holding units are positioned at a holding distance (6) from each other while forming a circular configuration, and the transport device comprises a transporter drive (8) by which the holding units are moved at a speed in a rotation direction (9) along a circular trajectory (10) having a centre (11),

**12.3** a supply unit (12) which places the cigarette parts in the holding units of the transport device at a receiving location (13) along the circular trajectory so that the cigarette parts are transported along at least part of the circular trajectory,

**12.4** a discharge unit (14) which removes the cigarette part from the holding units at a discharge location (15) along the circular trajectory,



**12.5** a pivot device (16) comprising multiple processing units (17) positioned along at least a part of the circular trajectory at a process distance (18) from each other which corresponds with the holding distance between the holding units so that the processing units can be associated with the cigarette parts held by the holding units, wherein:

**12.6** the pivot device is pivotable about a pivot axis (19) extending through the centre of the circular trajectory,

**12.7** the pivot device comprises a pivot drive (20) to alternately pivot the processing units from a first radial position (21) to a second radial position (22) in a first pivot direction (23) parallel to the circular trajectory and in the rotation direction of the transport device and synchronously with the cigarette parts transported by the transport device and subsequently back from the second radial position to the first radial position in a second pivot direction (24) parallel to the circular trajectory and opposite to the rotation direction of the transport device,

**12.8** in the first radial position, each processing unit is positioned in an associated position (25) relative to one of the cigarette parts held by the holding units of the transport device, and

**12.9** each processing unit performs the processing step on the cigarette part associated with said processing unit while the pivot device pivots from the first radial position to the second radial position synchronously with said associated cigarette parts, and wherein said method comprises the step of performing said processing step on the cigarette parts

associated with said processing units while the pivot device pivots from the first radial position to the second radial position synchronously with said associated cigarette parts.

VIII. The appellant's (opponent's) arguments relevant to the present decision may be summarized as follows:

*Admissibility of the objections raised for the first time in appeal and admissibility of D13 to D15*

The objections should be admitted as auxiliary request 4 as maintained was only filed during oral proceedings. Neither the granted claims nor the claims of one of the auxiliary requests filed on 5 February 2019 in preparation to the oral proceedings corresponded to the claims as maintained.

Additionally the following applied with regard to each objection:

(a) *Claim 1: Article 123(2) EPC, Article 84 EPC*

According to G10/91, point 19 of the reasons, as emphasized by the appellant during oral proceedings before the Board (see also Item 19 of the reply of the appellant dated 10 July 2020), "*in case of amendments of the claims or other parts of a patent in the course of opposition or appeal proceedings, such amendments are to be fully examined as to their compatibility with the requirements of the EPC (e.g. with regard to the provisions of Article 123(2) and (3) EPC)*". During oral proceedings before the opposition division, there was no substantive discussion of the compliance of claim 1 of any of the requests with the provisions of Article 123(2) EPC. The objection raised in the statement of grounds of appeal were rectifying this default and did

not constitute a new ground for opposition. Furthermore the impugned decision already included a clear indication that an unallowable intermediate generalisation had occurred, when claiming a system for testing vaporisers that was devoid of vapour sensors and had processing units that comprised first electrical contact members only. In fact in the decision, point 14.2, discussing why auxiliary requests 1 and 2 did not meet the requirements of Article 84 EPC, the opposition division stated that the feature "first electrical unit contact member" was essential for the proper operation of the system and was intrinsically linked to the aspect of processing units for testing (paragraph [0051] of the application as originally filed). Thus the objection raised under Article 123(2) EPC in the statement of grounds of appeal was substantially not a new objection.

Moreover, an objection under Article 84 EPC against claim 1 of auxiliary requests 1 and 2 was already raised (ex officio) by the opposition division (see decision, point 14.2). The clarity objection raised in appeal, concerning the lack of essential features in claim 1 (a second electrical contact member and vapour sensors) was a mere development of said objection.

*(b) Claim 1: Article 56 EPC (D13/D14 with one of documents D1 to D5; one of documents D1 to D5 with D15)*

The filing of D13 to D15 was a legitimate reaction to reasons with which the appellant was firstly confronted with at the oral proceedings (see points 17.2 and 17.3 of the impugned decision), as a consequence of the proprietor's change of subject of the proceedings resulting from the filing of auxiliary request 4.

Moreover D13 to D15 were highly relevant for the outcome of the case.

*(c) Claim 12: Article 56 EPC - one of documents D1 to D5 with general knowledge*

The Opposition Division indicated in the preliminary opinion annexed to the summons (see decision, point 5) and then decided (decision, chapter 13) that granted claim 1 lacked novelty over D1 to D5. The objections of lack of inventive step were a mere development of the reasoning on novelty and could not be surprising for the respondent.

Furthermore, as submitted during oral proceedings before the Board, in the grounds of opposition, chapter "General considerations" on pages 4, 5, it was already implicitly suggested to consider D1 to D5 as closest prior art in respect of claim 12.

*Claim 12: Inventive step - D12 with D1*

The conclusion of the opposition division that the method of claim 12 as maintained involved an inventive step starting from D12 was wrong. In particular, the processing step in D12 was merely the oil injection into the oil cup funnels 112 and not, as stated in the decision, point 17.3, the filling and subsequent transportation of the atomizers around the rotating table 1.

D12 did not comprise a pivot device in the sense of claim 12. As the transport device 12 of D12 had to be accelerated and decelerated to allow the oil injection into the oil cup funnels 112, the problem to be solved was to reduce wear and abrasion caused by said stepped movement. D1 disclosed a walking device comprising the features 12.5 to 12.9 concerning the pivot device,

which were missing in D12. The walking device provided the advantage of a smooth movement (D1, column 6, lines 1-3) and thus of reduced wear and abrasion. Based thereon the person skilled in the art would replace the stationary oil injector 3 of D12 (fig. 2) by the pivot device of D1 (fig. 2).

IX. The respondent's (patent proprietor's) arguments relevant to the present decision may be summarised as follows:

*Admissibility of the objections raised for the first time in appeal and admissibility of D13 to D15*

(a) *Claim 1: Article 123(2) EPC, Article 84 EPC*

Claim 1 as maintained by the Opposition Division was the same as claim 1 of auxiliary request 3, filed with the proprietor's written submission dated 5 February 2019 two months in advance of the oral proceedings. Furthermore, the objections relating to the amendment specifying that the system was for testing vaporizers (Article 123(2) EPC, Article 84 EPC) could have been filed at a much earlier stage, as this amendment was already made in auxiliary request 1 filed with the response to the Notice of Opposition dated 14 March 2018. Finally, the opponent did not raise any objections under Article 84 and 123(2) EPC against the claims of auxiliary request 4 as stated under point 17.1.1 of the impugned decision. Hence the objections under Article 123(2) and 84 EPC should not be admitted into the proceedings.

(b) *Claim 1: Article 56 EPC (D13/D14 with one of the documents D1 to D5; one of the documents D1 to D5)*

*with D15)*

Similarly to the clarity objection, the opponent had enough time to raise this objection during opposition procedure but deliberately chose not to do so, (see decision, chapter 17.2.1). Furthermore D13 to D15, having less features in common with claim 1 than each of the documents D12 and D1 to D5, were not more relevant for the claimed device than the documents already on file. D13 and D14 related to a device for testing capacitors and were not suitable as closest prior art. Therefore the objections under Article 56 EPC should not be admitted into the proceedings.

*(c) Claim 12: Article 56 EPC - one of the documents D1 to D5 with general knowledge*

Method claim 12 as maintained was basically the same as granted method claim 15. D1 to D5 were filed with the grounds for opposition. Thus the appellant had the complete opposition proceedings available to raise the inventive step objection starting from one of the documents D1 to D5 combined with general knowledge.

*Claim 12: Inventive step - D12 with D1*

The skilled person would not combine D12 with D1 because (reply to the grounds of appeal, chapter 5.3.2):

The device of D12 had a simple construction (see abstract) while the device of D1 had a much more complex construction with a higher number of parts moving in multiple directions. Incorporating the device of D1 into the device of D12 therefore would not reduce but increase wear and abrasion.

The time for filling the atomizers 6 with the oil from

the funnels 112 which took about 3/4 of full rotation (D12A, paragraph [0039]) could not be speeded up by implementing the walking device of D1. Therefore the skilled person had no incentive to combine D12 and D1.

## **Reasons for the Decision**

1. **Admissibility of objections raised for the first time in appeal and admissibility of D13 to D15**
  - 1.1 The objections raised for the first time with the statement of grounds of appeal, and documents D13 to D15 filed therewith, are not admitted into the proceedings pursuant to Article 12(4) RPBA 2007.
  - 1.2 The objections are structured as follows:
    - (a) Claim 1 - Article 123(2) EPC and Article 84 EPC
    - (b) Claim 1 - Article 56 EPC in conjunction with D13 to D15 and
    - (c) Claim 12 - Article 56 EPC with one of the documents D1 to D5 as starting point in combination with common general knowledge.
  - 1.3 Even if auxiliary request 4 was filed only during oral proceedings before the opposition division, held on 5 April 2019, claim 1 of this request is identical to claim 1 of auxiliary request 3 filed two months before the oral proceedings, namely on 5 February 2019 which was also the final date set out with the summons for making written submissions and/or amendments. Hence, at least for claim 1 of auxiliary request 3, the opponent had enough time to prepare thoroughly for the oral proceedings (Case Law of the Board of Appeal of the European Patent Office, 9. Edition, III.C.6.3, first and second paragraphs).

Furthermore, method claim 12 as maintained corresponds to method claim 15 as granted wherein the wording "with a system according to any of the preceding claims" is replaced by the full text of granted claim 1.

- 1.4 From the above it follows that the subject-matter of the independent claims as maintained was already on file for a sufficiently long time before the oral proceedings for the opponent to prepare thoroughly for it. Accordingly the Board shares the view of the respondent (patent proprietor) that the objections (a) to (c) should have been raised during the opposition procedure.

Furthermore, with respect to each objection, the following is to be noted:

- 1.4.1 ad objections (a)

The objected amendment concerns the replacement of "performing a processing step on cigarette parts" by "testing vaporizers". The amendment was present in claim 1 of all three auxiliary requests 1 to 3 filed on 5 February 2019 (two months before oral proceedings before the opposition division). Auxiliary requests 1 to 3 were discussed during oral proceedings. According to the minutes, point 3.1, third paragraph, and point 3.2, first paragraph, both points referring to auxiliary requests 1 and 2, and point 4.1, second paragraph referring to auxiliary request 3, as well as according to the impugned decision, point 14.2.1, the opponent explicitly did not raise any objection against claim 1.

The argument of the appellant with reference to point 14.2 of the decision, according to which the clarity



objection implied an objection under Article 123(2) EPC against claim 1 of auxiliary request 1, is not convincing. The clarity objection was raised for the first time ex officio in the annex to the summons (see decision, chapter 14.2.1) and it would have been the opponent's responsibility to explicitly express any concerns under Article 123(2) EPC in connection with said objection. Moreover, the opposition division found that the clarity objection was overcome by the auxiliary request 4 and also at that time the opponent did not raise any objections (see point 17.1.1 of the decision).

As regards the reference to G10/91, point 19 of the reasons, according to which amendments to a patent "*are to be fully examined as to their compatibility with the requirements of the EPC (e.g. with regard to the provisions of Article 123(2) and (3) EPC)*" it suffices to note that this did not impose an obligation on the opposition division to start a discussion on whether the requirements of Article 123(2) EPC were met, or give detailed reasons in the decision, if, as in the present case, no objections were raised by the opponent and the opposition division considered that these requirements were met (decision, point 17.1.1).

#### 1.4.2 ad objections (b)

The inventive step objection against claim 1 is exclusively based on documents D13 to D15 filed for the first time with the statement of grounds of appeal. The filing of these documents cannot be regarded as a reaction to the arguments in the impugned decision, as the decision does not deal with inventive step in connection with claim 1, since no objections were raised by the opponent in this respect (see point

17.2.1 of the decision). In opposition proceedings the opponent objected inventive step of the subject-matter of claim 12 as maintained, and documents D13 to D15 cannot either be seen as a reaction to the finding of the opposition division that the subject-matter of independent claim 12 is not rendered obvious by the prior art. In fact, the appellant did not present any arguments on lack of inventive step for the subject-matter of claim 12 involving any of documents D13 to D15.

Accordingly the Board sees no reason why objections (b) and the related documents D13 to D15 could not have been filed during opposition procedure.

#### 1.4.3 ad objections (c)

D1 to D5 were filed with the grounds for opposition as allegedly being novelty destroying for granted claim 1. However D1 to D5 were never used for novelty or as closest prior art against the method claim, not even when the opposition division stated in the summons to oral proceedings that they shared the opponent's opinion in view of claim 1 (decision, Summary of facts and submissions, point 5, and chapter 13).

Furthermore, contrary to the assertion of the appellant, the general wording on page 4 and 5 in the grounds of opposition under the title "General considerations" does not constitute a substantiated inventive step objection.

As the subject-matter of the method claim 12 as maintained is substantially equivalent to the method claim as granted, it is not apparent why the inventive step objection based on D1 to D5 as closest prior art with common general knowledge could not be raised in the first instance proceedings.

**2. Claim 12: Inventive step - D12 with D1**

- 2.1 The Board confirms the decision of the opposition division that method claim 12 is inventive in view of a combination of D12 and D1.
- 2.2 D12 as closest prior art as well as the distinguishing features 12.5 to 12.9 are not disputed.
- 2.3 In the device of D12, the oil cup disc 11 and the inner disc 121 (corresponding the transport device) rotate synchronously in the same direction. The oil injector 3 is stationary and injects oil in the oil cup funnels 112. According to D12A, paragraph [0039], the oil needs the time of rotation of the two discs 11, 121 to flow from the oil cup funnel 112 to the atomizer 6.
- 2.4 Contrary to the appellant's opinion, the Board agrees with the reasoning under chapter 17.3 of the impugned decision that the processing step "oil injection" at the oil injector 3 in D12 can not be seen isolated from the teaching of D12 as a whole (in particular D12A, paragraph [0039], with figures 1 to 3). The flow time of the oil into the atomizer is decisive for the process speed. Thus even if the oil injection into the oil cup funnels may be speeded up, there is no benefit for the overall process speed. Consequently the skilled person has no incentive to combine D12 and D1.
- 2.5 The problem-solution approach formulated by the appellant is not convincing. The Board does not agree that the incorporation of a device having a large number of parts moving in different directions (D1, figure 2) into a device having a simple construction (D12, figure 2) with parts only moving in one direction is able to reduce wear and abrasion. Therefore a

skilled person would not replace the stationary oil injector 3 by the pivot device shown in D1, figure 2, in an obvious way.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated