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**Datasheet for the decision  
of 26 April 2021**

**Case Number:** T 2358/19 - 3.2.01

**Application Number:** 09732942.9

**Publication Number:** 2276360

**IPC:** A24F47/00

**Language of the proceedings:** EN

**Title of invention:**

AN ELECTRICALLY HEATED SMOKING SYSTEM

**Patent Proprietor:**

Philip Morris Products S.A.

**Opponents:**

JT International S.A.

British-American Tobacco (Investments) Limited

**Headword:**

**Relevant legal provisions:**

EPC Art. 100(c), 111(1)

**Keyword:**

Grounds for opposition - added subject-matter (no)  
Appeal decision - remittal to the department of first instance  
(yes)

**Decisions cited:**

G 0002/10

**Catchword:**



**Beschwerdekammern**

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Case Number: T 2358/19 - 3.2.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.01**  
**of 26 April 2021**

**Appellant:** Philip Morris Products S.A.  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 26 June 2019  
revoking European patent No. 2276360 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman**            G. Pricolo  
**Members:**            S. Mangin  
                              S. Fernández de Córdoba

## **Summary of Facts and Submissions**

- I. The appeal was filed by the appellant (patent proprietor) against the decision of the Opposition Division to revoke the patent in suit (hereinafter "the patent").
- II. During the opposition proceedings, opponents 1 and 2 raised the grounds for opposition under Articles 100(a) EPC (lack of novelty and lack of inventive step), 100(b) EPC and 100(c) EPC.

The Opposition Division held that:

- (a) The subject-matter of claim 1 of the main request as well as auxiliary requests 1-3 filed during the opposition proceedings extended beyond the content of the application as filed, and
- (b) claim 1 of auxiliary requests 4 and 5 filed during the oral proceedings in opposition was not clear (Article 84 EPC).
- III. Oral proceedings were held before the Board on 26 April 2021.
- IV. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained based on the main request or one of the 1st, 2nd, 3rd, 4th or 5th auxiliary requests filed in opposition or based on the 6th auxiliary request submitted with the statement of grounds of appeal.

The respondents (opponents) requested that the appeal be dismissed.

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

An electrically heated smoking system (101) for receiving an aerosol-forming substrate, the system comprising:

- at least one heating element for heating the substrate to form an aerosol;
- a power supply for supplying power to the at least one heating element;
- electrical hardware connected to the power supply and the at least one heating element;

characterised in that the system further comprises:

- an interface (105) configured to establish a communications link to upload data to and download data from an Internet-enabled host(109), and
- wherein the electrical hardware is programmable by software downloadable from the Internet-enabled host via the communications link and wherein the system is only enabled after registration with an Internet application on the Internet enabled host via the communications link.

VI. Claim 13 of the main request reads as follows:

A method of enabling an electrically heated smoking system for receiving an aerosol-forming substrate comprising:

- at least one heating element for heating the substrate to form an aerosol,
- a power supply for supplying power to the at last one heating element,
- electrical hardware connected to the power supply and the at least one heating element and an interface, the method comprising:
  - establishing a communications link via the interface between the system and an Internet-

enabled host to upload data to and download data from the host, and  
- registering the system with an Internet application on the Internet enabled host via the communications link in order to enable the system for use.

## **Reasons for the Decision**

Main request - Added subject-matter - Article 100(c) EPC

1. The subject-matter of claims 1 and 13 does not extend beyond the content of the application as originally filed.
  
2. The appellant contested the finding of the Opposition Division that the introduction in claim 1 of the feature reading:  
*"wherein the system is only enabled after registration with an Internet application on the Internet enabled host via the communications link",*  
introduced subject-matter extending beyond the content of the application as filed.  
The Opposition Division essentially argued that the application as filed only supported an enablement prior to use as a security feature whereas the introduction of the above-mentioned feature implied an enablement prior to use without involving any security considerations, e.g. for marketing purposes.
  
- 2.1 The respondents, in agreement with the reasoning of the Opposition Division, submitted that the passage on page 10, lines 3-7 of the application as originally filed,  
*"Fifthly, the connection could be used for a user to register the device with an Internet application*

*supported on the PC. For example, this could be used as a security feature if the device is supplied by post, so that the device is only enabled after registration",* could not form the basis for the above-mentioned amendment. In their view, the feature *"used as a security feature if the device is supplied by the post"* was inextricably linked to the feature *"wherein the device is only enabled after registration"*. The former feature not being introduced into claim 1 led to an intermediate generalisation contrary to Article 123(2) EPC.

The respondents were of the opinion that in the sentence on page 10, lines 4-5 of the application as originally filed, the expression *"this could be used as a security feature if the device is supplied by post"* was the main clause and represented the heart of the sentence and the expression *"so that the device is only enabled after registration"* was the subordinate clause and provided a description or qualification of the main clause. The subordinate clause was entirely dependent on the main clause, such that the main clause could not be omitted.

Additionally, in their view, the expression *"for example"* at the beginning of the sentence related to the main clause and the subordinate clause in combination and not just to the main clause, such that *"this could be used as a security feature if the device is supplied by post"* could not be regarded as an optional feature.

Enabling after registration was therefore disclosed as part of a security feature, which would require specific configuration of the device for remote registration. By extracting *"enabling registration"* without the other interlinked features, claim 1 as



granted encompassed numerous other configurations, such as monitoring a user's use of their registered device, enabling communication with the user, e.g. for marketing purposes, and enabling the device such that data could be received by the device, for example to update software, none of which were disclosed in the application as filed.

Finally the respondents noted that the interpretation of the term "enabled" was inextricably linked to the configuration as a security feature. Without the context "as a security feature", the meaning of the term "enabled" was not clear. With this context it could be understood that "enabled" related to enabling the first use of the device (i.e. prior to it having ever been used before) in order to provide the security during postal delivery. Without this defining context "enabled" would have a much broader and less clear interpretation, encompassing for example "Internet-enabled" "in order to upload data or download data" as explained on page 1, line 33 - page 2, line 6 of the application as filed, or providing additional functionalities such as an MP3 player as described on page 10, line 28 of the application as filed.

The respondents were further of the opinion that the passage on page 10, lines 3-7 referred to "*an Internet application supported on the PC*" whereas claim 1 read "*an Internet application on the Internet enabled host*", leading to added subject-matter. In the latter case, the application ran on the host (PC) itself; in the former case the application ran on a server and the host only had to "support" the application.

2.2 Claim 1 under consideration is identical to claim 1 as granted. The Board does not agree with the Opposition

Division and the respondents and judges that the amendments made to claim 1 during examination proceedings comply with the "gold standard" (see G 2/10, OJ 2012, 376), which, according to established case law, is to be used for assessing compliance with Article 123(2) EPC. In accordance with the "gold standard", any amendment to the parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings) is subject to the mandatory prohibition on extension laid down in Article 123(2) EPC and can therefore, irrespective of the context of the amendment made, only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of these documents as filed. After the amendment the skilled person may not be presented with new technical information.

- 2.2.1 While the Board concurs with the respondents that in the sentence on page 10, lines 4-5, "this could be used as a security feature if the device is supplied by post" is the main clause, and "so that the device is only enabled after registration" is a subordinate clause qualifying the main clause, the Board considers that introducing in claim 1 the feature "wherein the system is only enabled after registration" without the main clause does not present the skilled person with new technical information (i.e. the amendment complies with the "gold standard").

The Board concurs with the appellant that the feature that the system is only enabled after registration is itself a security feature. Registering the system will inevitably provide information that someone is in possess of the system. This means that information

regarding the device, the user or the Internet enabled host or a combination thereof is transferred and this information can be used as a - unspecified - security feature. In this respect it is noted that the type of security feature is neither defined in the passage cited on page 10 nor in any other parts of the application as originally filed, and therefore this term has to be interpreted broadly, in the sense as mentioned above. Accordingly, the Board disagrees with the respondents' view that the "security feature" in the context of supplying the system by post can only be interpreted narrowly as implying e.g. providing personal data of the intended recipient. The security feature might only consist in ensuring that the system is ready for use and not lost.

The Board acknowledges that registration can be used for other purposes as well, for example for marketing purposes, as pointed out by the Opposition Division in the impugned decision. This is neither excluded from claim 1 nor from the passage on page 10 of the application as originally filed. However, even in the context of a registration for marketing purposes, a transfer of information (e.g. in the form of an email address) takes place, that would allow for some kind of security feature.

Furthermore, the Board takes the view that the expression "wherein the system is only enabled" implies that the electrically heated smoking system as a whole can only be used once it has been registered. As a matter of fact, the reference to the "system" in this expression is as a reference to the electrically heated smoking "system" (to which claim 1 is directed) having the combination of features defined in the claim. Hence, the above-mentioned expression cannot be

understood as possibly referring to some ancillary functionalities of the electrically heated smoking system, such as uploading and downloading data from the Internet or functioning as an MP3 player.

2.2.2 The feature of claim 1 reciting *"an Internet application on the Internet enabled host"* does not introduce added subject-matter either. As compared to the original wording on page 10 of the description, namely *"an Internet application supported on the PC"*, the omission of the term "supported" does not provide any new technical information to the skilled person. In fact, in the context of the application as filed, i.e. in the absence of any further details on the Internet application, the skilled person would not make any distinctions between the Internet application being "on" the host and the Internet application being "supported on" the host. In both cases, the relevant information is that the host is connected to the Internet and the user accesses the Internet application via the host.

3. Furthermore the respondents were of the opinion that, in addition to the reasons submitted for claim 1, method claim 13 introduced added subject-matter in view of the feature:  
*"registering the system with an Internet application on the Internet enabled host via the communications link in order to enable the system for use".*

3.1 While on page 10, lines 3-7, the application as originally filed disclosed that *"the device is only enabled after registration"*, claim 13 did not include the word "only", thus implying that the system referred to in method claim 13 might support multiple

alternative mechanisms for enablement, with registration being just one of these mechanisms.

- 3.2 The Board does not agree. Claim 13 is a method claim and defines a step of "*registering the system with an Internet application on the Internet enabled host via the communications link in order to enable the system for use*". In the context of method claim 13, the registering is thus a step that needs to be performed in order to enable the system for use. Even if the scope of protection of method claim 13 might encompass the use of a system that might support other mechanisms for enablement in addition to registration, this does not imply that i) registration is not a necessary step for enablement and ii) that the omission of the term "only" conveys such new technical information, i.e. that the omission of the term "only" conveys to the skilled person the technical information that the system might have other mechanisms for registration. In the Board's view the respondents' argument in this respect are speculative.

As for the objections to claim 13 which were made for claim 1, the above reasoning under point 2 applies to claim 13.

4. Remittal to the Opposition Division for further prosecution - Article 111(1) EPC

The appellant requested the case to be remitted to the Opposition Division for further prosecution, as patentability over the cited prior art and sufficiency were neither considered at the oral proceedings in opposition nor commented upon in the decision under appeal.

Both respondent 1 and respondent 2 agreed to the remittal of the case to the Opposition Division for further prosecution.

Under these circumstances the Board decided to make use of its discretion to remit the case to the Opposition Division for further prosecution (Article 111(1) EPC).

## Order

### For these reasons it is decided that:

- The decision under appeal is set aside.
- The case is remitted to the Opposition Division for further prosecution.

The Registrar:

The Chairman:



D.Magliano

G. Pricolo

Decision electronically authenticated