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**Datasheet for the decision  
of 11 March 2022**

**Case Number:** T 0121/20 - 3.2.01

**Application Number:** 13744143.2

**Publication Number:** 2809186

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

**Language of the proceedings:** EN

**Title of invention:**  
ELECTRONIC CIGARETTE

**Patent Proprietor:**  
Altria Client Services LLC  
Li, San  
Karles, George  
Mishra, Munmaya K.  
Kobal, Gerd  
Oliveri, Douglas  
Bajec, Martha  
Flora, Jason

**Opponent:**  
JT International S.A.

**Headword:**

**Relevant legal provisions:**

EPC Art. 123(2), 83, 56  
RPBA 2020 Art. 11, 12(4), 13(2)

**Keyword:**

Amendments - extension beyond the content of the application  
as filed (yes)  
Remittal - special reasons for remittal - (no)  
Sufficiency of disclosure - (yes)  
Amendment to case - reasons for submitting amendment in appeal  
proceedings (yes)  
Amendment after summons - exceptional circumstances (no)  
Inventive step - (yes) - ex post facto analysis

**Decisions cited:**

T 2271/18, T 1989/18, T 1024/18, T 1363/10

**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 0121/20 - 3.2.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.01**  
**of 11 March 2022**

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

**Representative:** Bandpay & Greuter  
30, rue Notre-Dame des Victoires  
75002 Paris (FR)

**Respondent:** Altria Client Services LLC  
(Patent Proprietor 1) 6601 West Broad Street  
Richmond, Virginia 23230 (US)

**Respondent:** Li, San  
(Patent Proprietor 2) 1313 Goswick Ridge Road  
Midlothian, Virginia 23114 (US)

**Respondent:** Karles, George  
(Patent Proprietor 3) 4025 Huntsteed Way  
Richmond, Virginia 23233 (US)

**Respondent:** Mishra, Munmaya K.  
(Patent Proprietor 4) 1631 Sabot Creek Drive  
Manakin Sabot, Virginia 23103 (US)

**Respondent:** Kobal, Gerd  
(Patent Proprietor 5) 3124 Rock Cress Lane  
Sandy Hook, Virginia 23153 (US)

**Respondent:** Oliveri, Douglas  
(Patent Proprietor 6) 6126 Autumn Bluff Road  
Powhatan, Virginia 23139 (US)

**Respondent:** Bajec, Martha  
(Patent Proprietor 7) 3432 Stuart Avenue  
Richmond, Virginia 23221 (US)

**Respondent:** Flora, Jason  
(Patent Proprietor 8) 8139 Grimsby Road  
Richmond, Virginia 23235 (US)

**Representative:** Docherty, Andrew John  
Marks & Clerk LLP  
Aurora  
120 Bothwell Street  
Glasgow G2 7JS (GB)

**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 4 November 2019  
rejecting the opposition filed against European  
patent No. 2809186 pursuant to Article 101(2)  
EPC.**

**Composition of the Board:**

**Chairman** G. Pricolo  
**Members:** A. Wagner  
P. Guntz

## **Summary of Facts and Submissions**

I. The appeal of the opponent lies against the decision of the opposition division to reject the opposition filed against European patent No. 2809186 pursuant to Article 101(2) EPC.

II. In its decision, the opposition division held that none of the grounds of opposition raised by the opponent under Article 100(a) EPC with Article 56 EPC, under Article 100(b) EPC and under Article 100(c) EPC was prejudicial to the maintenance of the patent as granted.

III. The following documents cited in opposition proceedings are relevant for this decision:

D3: US 7 878 962 B2

D4: US 2009/0126745 A1

D5: US 2006/0191546 A1

D6: US 2010/ 0083959 A1

D8: EP 2 260 733 A1

E1: CN 102266125

E1': Machine Translation of E1

E2: US 2012/145169 A1

E3: CN 20 21 22 097 U

E4: EP 0 845 220 A1

E6: JP 2006-320287

E7: US 4,961,438 A

E8: US 7,726,320 B2

E10: WO 2010/045670 A1

E11: WO 2010/045671 A1

E16: <http://www.mhlw.go.ip/stf/houdou/2r98520000001v0j.html> (printout retrieved on 04.01.2018)

E17 : <https://www.taeco.jp/contents/law.html> (printout retrieved on 04.01.2018)

E18: US 2011/0303231

E19: information letter from the Federal office of

E20: JP H06-114105

IV. With its statement of grounds of appeal the appellant (opponent) filed the following document:

E1": Human English translation of E1

V. Oral proceedings by videoconference were held before the Board on 11 March 2022.

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

The respondent (patent proprietor) requested that the appeal be dismissed or, in the alternative, that the patent be maintained in amended form on the basis of the first auxiliary request filed with letter of 11 February 2022, or one of auxiliary requests 2 to 8 filed as auxiliary requests 1 to 7, respectively, with the reply to the statement of grounds of appeal, whereby remittal to the opposition division was requested should the main request not be granted by the board.

VII. Claim 1 of the main request (patent as granted) reads as follows:

"An electronic smoking article (60) comprising:  
an outer tube (6) extending in a longitudinal direction;  
an inner tube (62) within the outer tube (6);

a liquid supply (22) comprising a nicotine-free liquid material, the liquid supply (22) contained in an outer annulus (620) between the outer tube (6) and the inner tube (62);

a heater (14) located in the inner tube (62); and  
a wick (28) in communication with the liquid supply (22) and surrounded by the heater (14) such that the wick (28) delivers liquid material to the heater (14) and the heater (14) heats the liquid material to a temperature sufficient to vaporize the liquid material and form a nicotine-free aerosol in the inner tube (62);

characterized in that the electronic smoking article (60) further comprises:

a fibrous element (300) located downstream of the heater (14) and including nicotine dispersed in the fibrous element (300) such that the aerosol can pick up the nicotine as the aerosol passes through the fibrous element (300)."

- VIII. Claim 1 of auxiliary request 1 is identical to claim 1 of auxiliary request 4 (see below) but for the removal of the expression "substantially uniformly throughout" and the insertion of the term "in" instead.
- IX. Claim 1 of auxiliary request 2 (filed as auxiliary request 1 with the statement of grounds of appeal) differs from claim 1 as granted in that it specifies in its characterising portion that the fibrous element includes nicotine dispersed "throughout all or a portion of" the fibrous element.
- X. Claim 1 of auxiliary request 3 (filed as auxiliary request 2 with the statement of grounds of appeal) differs from claim 1 as granted in that it specifies in its characterising portion that the fibrous element

includes nicotine dispersed "substantially uniformly throughout" the fibrous element.

- XI. Claim 1 of auxiliary request 4 (filed as auxiliary request 3 with the statement of grounds of appeal) differs from claim 1 of the main request by the characterising portion which reads as follows:

"characterized in that the electronic smoking article (60) further comprises:  
a fibrous element (300) located downstream of the heater (14) and including an additive, wherein the additive is nicotine and is dispersed substantially uniformly throughout the fibrous element (300) such that the aerosol can pick up the nicotine as the aerosol passes through the fibrous element (300)."

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

*Main request - added subject-matter*

The closest to granted claim 1 which could be directly and unambiguously derived from the text of the application as filed corresponded to the combination of original claims 1, 6 (dependent on claim 1), 7 (dependent on claim 6) and 25 (dependent on claim 7). Nevertheless, this combination of original claims at best disclosed that the fibrous element comprised nicotine as an additive. The word "additive" designated a component which was added to the fibrous element. However, the wording of the granted claim allowed that the nicotine may be naturally present in the fibrous element, and this was not disclosed in the application as filed.



The opposition division's view that the term "dispersed" itself included the aspect of the nicotine being an additive (decision, chapter 13.5.1) was erroneous. The word "dispersed" related to the position of the nicotine and not to its origin. It did not entail the concept of "something being added" but meant that the nicotine was distributed across at least a portion of the fibrous element.

The new line of argumentation of the respondent (patent proprietor) submitted during oral proceedings before the board should not be admitted into the proceedings. The argument that in the original application "additive" meant "added to the aerosol" and not "added to the fibrous element" constituted an amendment to the respondent's case at a very late stage of the proceedings.

Furthermore the argument was not convincing as e.g. the wording of original claim 6 explicitly recited that "*the fibrous element further comprises at least one additive*".

#### *Remittal in case the main request is refused*

There was no reason for a remittal as all issues were discussed. In particular the inventive step discussion remained more or less the same for the auxiliary requests on file.

#### *Admission of auxiliary request 1*

Auxiliary request 1 was filed after the summons to oral proceedings. According to Article 13(2) RPBA 2020, auxiliary request 1 should not be taken into account as there were no exceptional circumstances, which had been justified with cogent reasons by the respondent.

Auxiliary request 1 addressed an objection raised in opposition proceedings and discussed in the statement of grounds of appeal. Thus, auxiliary request 1 could have been filed with the respondent's reply to the statement of grounds of appeal.

*Admission of auxiliary request 4 (filed as auxiliary request 3)*

Auxiliary request 4, submitted only at the appeal stage, was not an appropriate reaction to a late development in the opposition proceedings. The request represented an amendment to the party's case and should thus not be admitted into the proceedings.

*Auxiliary request 4 - added subject-matter*

Nicotine-free aerosol in the inner tube:

The application as filed, in particular the passages cited by the opposition division (claim 25, para. [0146]), did not comprise any support for this feature. In particular, a nicotine-free liquid material did not imply a nicotine-free aerosol.

Nicotine dispersed in the fibrous element:

Original claim 24 disclosed that "*at least one additive is dispersed substantially uniformly throughout the fibrous element*". Original claim 24 thus related to the class of additives in its entirety, not to any additive considered in isolation from the others. This meant that embodiments wherein some of the additives were dispersed uniformly throughout the fibrous element, while the others were not, were excluded. However the wording of claim 1 covered such kind of "hybrid"

fibrous element wherein nicotine was dispersed uniformly throughout the fibrous element while other additives, if present, were not.

Furthermore original claim 24 was disclosed specifically in combination with claim 6, not in combination with claim 7 or 25 (i.e. not with liquid material being nicotine-free and a nicotine additive).

Para. [0121] mentioned by the opposition division did not serve as a basis, as it related to a specific embodiment wherein the fibrous element was formed of a plug of fibrous material. However, claim 1 encompassed embodiments not comprising any plug of fibrous material at all.

Furthermore according to para. [0121], the additive was dispersed in the fibrous material, not in any other part of the fibrous element, e.g. in spaces 344 formed within the fibrous element as shown in figure 20. However, this possibility was encompassed by claim 1.

Pick-up of nicotine by the aerosol:

The feature according to which the aerosol picked up the nicotine was disclosed in the application as originally filed, para. [0144], only in combination with specific forms of nicotine (liquid, salt or powder form) and only in combination with specific aerosol formers. Claim 1 thus included an inadmissible intermediate generalisation in this respect.

#### *Sufficiency of disclosure*

The application as filed did not comprise any teaching on how the nicotine had to be dispersed in the fibrous element such that "*the aerosol can pick up the*

*nicotine*". Para. [0115] referred to by the opposition division only recited that "*the additive 348 [can] be nicotine in a liquid, salt or powder form*". An indication how nicotine specifically in a salt form or powder form was "*dispersed in the fibrous element such the aerosol can pick up the nicotine*" was missing.

*Auxiliary request 4 - clarity*

The new interpretation of the claim that the term "additive" meant "added to the aerosol" given by the respondent during the appeal hearing gave rise to a clarity objection. The boundaries of the claimed subject-matter were undefined as the meaning of the term "additive" was unclear. It could be read such as to mean "added to the fibrous element" but allegedly had to be understood as "added to the aerosol". This objection was a direct reaction to the respondent's new argument on added matter.

*Auxiliary request 4 - Inventive step*

Claim 1 was not inventive over

- E1 with general knowledge as e.g. disclosed in D3, D4, D5, D6 or D8 or in combination with one of the documents E8, E20, E6, E16, E17 and/or E19;
- E18 (alternatively E2, E3 being similar to E18 concerning the relevant features) in combination with one of the documents E8, E20, E4, E6, E7, E10, E11;
- E8 in combination with one of the documents E1, E2, E3, E18.

*Starting from E1:*

E1 contained a general teaching of a smoking device which comprised a fibrous element (drug cartridge 12)

including a medicine. Claim 1 only differed in that the additive in the fibrous element was nicotine. The technical problem was to provide an alternative, nicotine-containing, electronic smoking article. The skilled person would consider adding nicotine in the fibrous element because it was common general knowledge that electronic smoking articles, including smoking cessation devices, could be provided with or without nicotine. Examples of smoking cessation devices comprising nicotine were found in D3, D4 (paras. [0006, 0035]), D5, D6 and D8 (para. [0027] of D8 showing compositions with and without nicotine). Claim 1 did not define the level of nicotine in the fibrous element. Even a very low amount fell under the claim. Accordingly, the device of E1 was suitable for smoking cessation. E1 did not contain any adverse teaching preventing the article from being used, as an alternative, with nicotine (see the translation E1"). Finally, including nicotine had no technical effect.

Alternatively, the combination of E1 with E8, E20 or E6 led in an obvious way to the claimed subject-matter. All three secondary documents disclosed the same concept of nicotine in a fibrous element through which a nicotine-free aerosol passed and picked up the nicotine. In E8 (column 24, line 62, to column 25, line 8, with figure 2), the cartridge 85 comprised a nicotine-free liquid. After being heated, the aerosol was provided with nicotine by passing the fibrous element 89 which comprised nicotine as an additive (column 11, lines 49 to 54).

The disclosure of E20 (figure 2) was summarized in D5, para. [0006]. Therein it was described that an aerosol passed through tobacco 5 to pick up nicotine.

E6 (figure 3b) disclosed a filter 6, i.e. a fibrous element, containing additives 6a such as nicotine

(para. [0026]).

Claim 1 of auxiliary request 4 simply combined these disclosures without any synergetic effect.

A skilled person faced with the technical problem of providing a nicotine-containing aerosol had only two options where to add the nicotine in the device of E1: either in the liquid material or in the fibrous element 12. Choosing one option out of two did not involve an inventive step. The option to add the nicotine to the fibrous element was even more obvious for regulatory reasons reflected in E16, E17 or E19. From E16 and E17 the skilled person was taught that if nicotine was added to the liquid material approval by the Pharmaceutical Affairs Law was needed, from E19 (page 1, section 1, first paragraph) the skilled person was advised against adding nicotine to the liquid material ("*Il déconseille en particulier de recourir à des liquides de recharge contenant de la nicotine*").

*Starting from E18 (E2, E3):*

The smoking devices of E18, E2 and E3 had the same structure, all being similar to the structure of the claimed device. The inventive step argumentation for all three documents was the same and was provided exemplary for E18.

The distinguishing features were the fibrous element with nicotine dispersed therein while the liquid material was nicotine-free. However these features did not provide any technical effect. At the end a smoking aerosol with nicotine was provided. The alleged technical effect mentioned in the patent in suit, para. [0117] was a mere speculation not substantiated by any experimental data.

The objective technical problem was to provide an

alternative for producing the nicotine-containing aerosol.

The skilled person would consider E8 (paragraph bridging columns 24, 25, figure 2) which taught providing a nicotine-free liquid material together with a fibrous element with nicotine dispersed therein. Alternatively, E20 would be considered as explained in the inventive step attack combining E1 with E20. In addition, it was commonplace in the field of electronic smoking articles to provide an aerosol-forming liquid material together with a fibrous element (E7: "filter plug 28" and "aerosol generating material 18", E4: "a liquid material" and "a filter 58", E10, E11 (elements 61, 62 in both documents), E6 (figure 1).

A fibrous element with nicotine dispersed therein could easily be implemented in the device disclosed in E18. The skilled person would place such a fibrous element in the space between elements 10, 11 in figure 2 and would thereby arrive at the claimed subject-matter.

*Starting from E8:*

The claimed device differed from the device known from E8, in particular the embodiment shown in figure 2, in that it comprised an alternative aerosol-generating configuration. The technical problem consisted in providing an alternative form of aerosol generation. The skilled person confronted with this technical problem would consider E1/E1" (figure 1), E2 (figure 3), E3 (figure 4) or E18 (figures 1, 2 with paras. [0020] and [0021]), all documents disclosing an aerosol-generating configuration according to claim 1. The skilled person faced no difficulty in combining the teaching of E8 with any one of the documents E1, E2, E3 or E18 as these documents simply provided equivalent,

alternative aerosol generating modules to the module already disclosed in E8.

*Adaptation of the description*

At least paragraph [0033] needed to be adapted to be consistent with claim 1.

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

*Main request - Added subject-matter*

Given that there was basis for the additive being nicotine, it followed that, in accordance with English linguistics, established patent drafting practice and common sense, the term "nicotine" could be used in place of "additive".

During oral proceedings, the respondent submitted that the term "additive" meant that nicotine was added to the aerosol, not to the fibrous element. Basis for this interpretation was provided throughout the original description, e.g. in para. [0016] ("*the fibrous element 300, 300' can alter the character of the aerosol by providing additives and/or can provide additional flavors, aromas, and alter the mouth feel of the aerosol during smoking*") or para. [0139] ("*the additive may diffuse into the aerosol as it passes through the fibrous element 300, 300'*") or para. [0146] ("*However, adding nicotine to the aerosol after formation of the aerosol...*"). The fact that the nicotine, i.e. the additive, was added to the aerosol was reflected in the characterizing portion of granted claim 1. The term "additive" was thus not required.



*Remittal in case the main request is refused*

Since the opposition division did not decide on any of the auxiliary requests on file, the case should be remitted for further prosecution should the auxiliary requests become relevant. It was unfair to the parties for these requests to be decided upon for the first time in appeal, without the opportunity for appeal.

*Admission of auxiliary request 1*

Auxiliary request 1 addressed the objections upheld by the board in the preliminary opinion. The request did not introduce any new amendment but corresponded to auxiliary request 4 on file (filed as auxiliary request 3), albeit with the amendment "substantially uniformly throughout" removed from claim 1.

The remaining amendment in auxiliary request 1 addressed an objection that was raised for the first time during oral proceedings before the opposition division. As stated in the impugned decision, the objection was found not valid. The objection became relevant for the first time in view of the preliminary opinion of the board. Auxiliary request 1 was thus filed at the first opportunity.

*Admission of auxiliary request 4*

The request was filed in response to objections of added matter raised by the appellant. One of these objections, namely that claim 1 did not define nicotine as an additive, was submitted for the first time at the opposition hearing. The opposition division did not find this objection valid. The appeal proceedings were thus the first opportunity to file the respective amendment.

*Auxiliary request 4 - added subject-matter*

Nicotine-free aerosol in the inner tube:

Paras. [0144] and [0146] provided basis for forming an aerosol without nicotine. Forming the aerosol in the inner tube was the clear and unambiguous consequence of the described embodiments and operation when using a nicotine-free liquid material.

Nicotine dispersed in the fibrous element:

Claim 1 of auxiliary request 4 included all features of original claim 24. The original claim structure did not exclude the combination of the features of claim 7 and 25 with the features of claim 24. From the application as a whole the combination was disclosed.

The features mentioned in para. [0121] and recited by the appellant (e.g. plug) were not inextricably linked to the feature "dispersed in the fibrous element" as was derivable from the general wording of claim 24.

Pick-up of nicotine by the aerosol

The appellant (opponent) did not provide a functional or structural relationship between the extracted language of para. [0144] and features not included in the claim. Instead it was implied that since certain features were disclosed in proximity to each other, they were inextricably linked, however this was not the case.

*Sufficiency of disclosure*

The passages cited in the impugned decision (point 14.2) provided ample teaching to allow a skilled reader to implement the claimed invention.

*Auxiliary request 4 - clarity*

The objection under Article 84 EPC was not admissible. It was raised for the first time during the appeal hearing and constituted an amendment to the appellant's appeal case.

Auxiliary request 4 was submitted as auxiliary request 3 with the statement of grounds of appeal. The new clarity objection should have been raised with the appellant's reply dated 7 February 2021 in which auxiliary request 3 was addressed.

*Inventive step*

*Starting from E1:*

E1/E1" was not a promising starting point because it not only failed to teach an essential element of the present invention (nicotine) but even taught that its omission was essential. The human translation E1", which should not be admitted into the proceedings as it was filed at a very late stage of the proceedings, made clear that E1 was directed to smoking cessation (para. [0001]) and related specifically to the provision of an electronic cigarette wherein the liquid was nicotine-free (para. [0008, 0009]). However, claim 1 necessarily required the inclusion of nicotine. The purpose of E1/E1" and the patent in suit were thus conflicting.

Even if the skilled person considered adding nicotine to the device of E1, they would simply add the nicotine to the "e-liquid" because this was where nicotine was

traditionally added in e-cigarettes, see E2 (figure 3 "tobacco tar cotton 4", E3 (figure 4) or E18 (para. [0021] with figure 2).

Furthermore the skilled person did not have any motivation to combine the teaching of E1 with any of the documents D3 to D6, D8, E6, E8, E20, E16, E17 or E19. The point was not whether the skilled person could have arrived at the invention but whether they would have modified the device of E1 because the prior art incited them to do so in expectation of some improvements or advantages. That was not the case here. E1 instead taught that adding nicotine was disadvantageous.

Additionally the smoking devices of E8, E20 and E6 were of a different construction compared with the device of E1. A number of technical incompatibilities existed which prevented a skilled person from combining the teaching of E1 with one of these secondary documents. The arguments of the appellant with regard to E16, E17 or E19 referred to a commercial motivation for modifying the device of E1. However commercial considerations were not relevant when assessing whether the skilled person would modify a prior art document to arrive at the claimed invention.

*Starting from E18:*

E18 (E2, E3 respectively) constituted a viable starting point as the disclosed device and the claimed device were of a similar structure.

Contrary to the appellant's opinion, the distinguishing features that first the aerosol was prepared and nicotine was added later had the technical effect that the impact on the throat was minimized (patent in suit, para. [0117]).

E8 was a tobacco heating device with the concept "heat not burn" and was technically incompatible with an e-cigarette as disclosed in E18, E2 or E3. There was no guidance on which features should or should not be imported into E18 from E8. The same was valid for the device disclosed in E20.

The further attacks of E18 (E2, E3) combined with E4, E6, E7, E10 or E11 were not sufficiently substantiated.

*Starting from E8:*

E8 disclosed a device that primarily heated tobacco (see e.g. title "*Tobacco-containing smoking article*" or column 4, lines 7 to 10 "*Thus, it would be highly desirable to provide a smoking article that provides a smoker with an ability to enjoy using tobacco without the necessity of burning any significant amount of tobacco.*"). The device had a different structure as the claimed device and therefore did not constitute a promising starting point.

E1, E18, E2 and E3 referred to another type of smoking device. The number of structural differences did not allow any feature implementation into E8. Therefore E8 could no more be combined with E1, E18, E2, E3 than vice versa.

*Adaptation of the description*

Following T1989/18 there was no general provision in the EPC that required an adaptation of the description.

## Reasons for the Decision

### 1. Main request - Article 100(c) EPC

- 1.1 The subject-matter of claim 1 of the main request (patent as granted) extends beyond the content of the application as filed.  
The passages mentioned in the following refer to the A1-publication WO2013/116558 of the application as originally filed.
- 1.2 The wording of claim 1 as granted does not reflect that nicotine is necessarily an additive added to the fibrous element. To the contrary, the claim also allows nicotine to be naturally present in tobacco. Granted claim 1 encompasses the possibility of tobacco fibres included in the fibrous element. Such an embodiment is originally not disclosed.
- 1.3 Basis for the feature "a fibrous element including nicotine" is allegedly to be found in original claims 7 and 25. Claim 7 recites a list of additives, one of those being nicotine; and claim 25, dependent on 7, specifies that the additive is nicotine. However, as claim 7 is dependent on claim 6, reciting that the fibrous element further comprises at least one additive, nicotine is only presented as an additive to the the fibrous element. The claims are consistent with the description, wherein likewise nicotine is only presented as an additive which is added to the fibrous element, see e.g. para. [0122] ("*Detachable fibrous elements 300' can be purchased in packs including a plurality of fibrous elements 300', each having the same or different additives 348 so that the smoker can choose the preferred fibrous element 300' and additive 348.*"), para. [0124] ("*Such additive materials include*

*flavor materials, [...], nicotine in liquid, salt or powder form, and other smoke modifiers." and "Any appropriate additive material or combination of materials may be contained in the fibrous element 300, 300'." or para. [0144] ("Additional additives can be included in the fibrous element 300, 300' along with the nicotine if desired.").*

1.4 In the impugned decision, point 13.5.1, the opposition division followed the argument of the patent proprietor that the term "dispersed" includes the aspect of the nicotine being an additive. However, the board agrees with the appellant (opponent) that the term "dispersed" does not imply that nicotine is an additive. Nicotine naturally present in tobacco is also dispersed in the tobacco fibres without being an additive.

1.5 During oral proceedings before the board, the respondent (patent proprietor) argued for the first time that "additive" has to be understood as "something added to the aerosol".

Contrary to the respondent's opinion the new argument constitutes an amendment of the party's case according to Article 13(2) RPBA 2020. Even if the argument "additive added to the aerosol" was submitted in the framework of the same objection and the same features, it amounts to a new interpretation of the claim being based on new facts (different passages in the description) and thus changes the respondent's case. As no exceptional circumstances for the late submission have been brought forward by the respondent, the new argument was not admitted into the proceedings.

In any case, the board takes the view that the claim can only be read as requiring nicotine being present in the fibrous element.

## **2. Remittal in case the main request is refused**

2.1 The board rejected the request to remit the case to the first instance for further prosecution of the auxiliary requests.

2.2 According to Article 11, first sentence, RPBA 2020, the board shall remit a case for further prosecution only if special reasons present themselves for doing so. This does not apply in the present case.

2.3 According to established case law, there is no absolute right to have each request decided on at two instances (see e.g. T 1363/10, reasons, 4.2). Moreover, the impugned decision dealt with all the grounds for opposition raised by the opponent with the conclusion that these do not prejudice the maintenance of the patent.

A remittal would therefore only primarily serve the purpose of having the amendments in the auxiliary requests being considered by the opposition division, as it could be expected that the opposition division would not come to a different conclusion with respect to the other issues as inventive step. Moreover, the parties have had sufficient opportunities to present their submissions as regards the auxiliary requests in these appeal proceedings.

## **3. Admission of auxiliary request 1**

3.1 According to Article 13(2) RPBA, auxiliary request 1 submitted with letter of 11 February 2022, after notification of the summons to oral proceedings, is not admitted into the proceedings. The respondent (patent proprietor) did not convincingly justify the late



filing of the auxiliary request 1.

3.2 Auxiliary request 1 is based on auxiliary request 3 filed with the reply to the statement of grounds of appeal (which is now auxiliary request 4 underlying this decision) albeit with the amendment "substantially uniformly throughout" removed from claim 1. The respondent essentially submitted that the amendment was in reaction to the board's preliminary opinion as set out in the communication under Article 15(1) RPBA, from which it appeared that among the various objections of added subject-matter raised by the appellant against claim 1 as granted, only the objection concerning the omission of the feature that nicotine was present as an additive was convincing. Accordingly, it became clear that the amendment of claim 1 of auxiliary request 3 that nicotine as an additive was dispersed "substantially uniformly throughout" the fibrous element was not necessary for meeting the requirements of Article 123(2) EPC.

3.3 The preliminary opinion provided by the board is, however, predominantly intended to give the parties an opportunity to thoroughly prepare their arguments in response to it but not to file new submissions, such as new sets of claims. In particular, amendments submitted in response to such a preliminary opinion, which does not introduces any new issue but simply gives an opinion on the issues raised by the parties, cannot give rise to "exceptional circumstances" within the meaning of Article 13(2) RPBA 2020 (see T2271/18, Reasons 3.3, second paragraph). Finally, it would be against the principle of fair proceedings if the board would allow a party to take advantage of such a preliminary opinion to put them in a better position as

compared to the position they took in reply to the other party's case.

4. **Auxiliary requests 2 and 3**

Auxiliary request 2 and 3 are not allowable for the same reasons as the main request. Claim 1 does not recite that nicotine in the fibrous element is an additive and, thus, contravenes the requirements of Article 123(2) EPC.

5. **Admission of auxiliary request 4**

5.1 The board exercises its discretion under Article 12(4) RPBA 2020 and admits auxiliary request 4 into the proceedings.

5.2 Auxiliary request 4, submitted as auxiliary request 3 with the statement of grounds of appeal, addresses a specific objection raised by the appellant (opponent) for the first time during the opposition oral proceedings. As the opposition division did not find the objection convincing, there was no need for the respondent (patent proprietor) to file any amendments at that time. However, the objection was maintained by the appellant with the statement of grounds of appeal, and therefore the board concurs with the respondent that the first opportunity to file amendments addressing said objection was with their reply.

5.3 The objection concerns added subject-matter by omitting that nicotine is an additive (see point 1 of this decision). Claim 1 being amended over claim 1 as granted by reciting that the additive is nicotine and is dispersed substantially uniformly throughout the

fibrous element, clearly addresses this objection and does not give rise to further issues.

**6. Auxiliary request 4 - Article 123(2) EPC**

Auxiliary request 4 meets the requirements of Article 123(2) EPC.

**6.1 Nicotine-free aerosol in the inner tube**

Original claim 1 discloses a heater located in the inner tube, which heater heats the liquid material to vaporize the liquid material and to form an aerosol in the inner tube. Thus the aerosol is formed in the inner tube.

According to original claim 25 - incorporated in claim 1 - the liquid material is nicotine-free. It is clear for a skilled person that an aerosol formed from a nicotine-free liquid is itself nicotine-free.

**6.2 Nicotine dispersed in the fibrous element**

The skilled reader retrieves the specific combination of features of original claims 6, 7 (dependent on 6) and 25 (dependent on 7), that the additive is nicotine and the liquid material is nicotine free and of original claim 24 (dependent on 6), that the additive is dispersed substantially uniformly throughout the fibrous element, in particular from figure 20 with paras. [0121, 0144, 0145].

Contrary to the appellant's opinion, para. [0121] discloses that the nicotine can be dispersed in a space 344 within the fibrous element, thus not obligatorily in the fibrous material. Para. [0121] does not literally use the word "dispersed" in context with the space 344, but "placed within the space", which however

has identical meaning.

Even if the board may agree with the appellant's argument that the embodiments of figure 20, 21 only disclose the fibrous element as a plug, the plug is not inextricably linked to the dispersal, as is clear from original claims 6 and 24. These claims comprise the general disclosure of an additive dispersed substantially uniformly throughout the fibrous element independently of the plug design.

### 6.3 Pick-up of nicotine by the aerosol

As correctly pointed out by the the opposition division, no statement is present in the application as originally filed from which any intrinsic combination of certain nicotine forms and certain aerosol forms can be derived.

Paras. [0144] and [0145] give several examples on how the nicotine might be provided in the fibrous element. However, the manner of providing nicotine is not inextricably linked to the feature that the aerosol can pick up the nicotine when passing through the fibrous element.

The general disclosure of the disputed feature is e.g. derivable from the original description

- para. [0137]: "*Aerosol passing through the fibrous element 300, 300' can be modified depending on the pH of the materials used to form the fibrous element 300, 300' and the additives 348 contained therein.*" or

- para. [0139]: "*If the additive includes volatile materials, such as menthol or other volatile flavors, the additive may diffuse into the aerosol as it passes through the fibrous element 300, 300'. Finally, portions of the aerosol may be deposited in or condense in the fibrous element 300, 300' causing additives to*

*dissolve therein. The additives may then be delivered when a smoker takes a puff on the electronic smoking article 60."*

## **7. Sufficiency of disclosure**

7.1 The board confirms the decision of the opposition division (point 14) that the patent discloses the invention in a manner sufficiently clear and complete for it to be carried out by a skilled person. The feature "*dispersed [...] such that the aerosol can pick up the nicotine as the aerosol passes through the fibrous element*" is not insufficiently disclosed.

7.2 Contrary to the opponent's arguments, a skilled person is aware of how an aerosol can pick up nicotine while passing through a fibrous element. Actually many electronic smoking devices are based on sucked air picking up nicotine or additives by passing through a permeable element before being inhaled by a user, see e.g D5 (figures 6 with para. [0076]), D6 (para. [0010]) or E20 (figures 1 and 2 with para. [0006] of D5).

## **8. Admission of the new objection under Article 84 EPC**

8.1 The objection under Article 84 EPC submitted for the first time during oral proceedings before the board is not admitted into the proceedings pursuant to Article 13(2) RPBA.

8.2 The appellant (opponent) argued that the new objection was a direct reaction to the new argument of the respondent (patent proprietor) that "additive" had to be understood as "something added to the aerosol". However said new argument was not admitted into the

proceedings either. Furthermore, the new argument was based on an interpretation of claim 1 which is not justified (see point 1.5 of this decision). Accordingly the board sees no reason, and in particular no exceptional circumstances, to admit the late filed clarity objection.

**9. Auxiliary request 4 - inventive step**

9.1 The subject-matter of claim 1 is inventive over all attacks brought forward by the appellant (opponent).

9.2 The appellant provided three main lines of attack, the first starting from E1, the second from one of the documents E18, E2 or E3 and the third starting from E8.

It is noted that the respondent's request for non-admission of E1", E18, E19 and E20 into the appeal proceedings does not have to be addressed. The admission of the human translation E1" of document E1, filed with the appellant's statement of grounds of appeal, and of documents E18, E19 and E20, which were late filed by the opponent (now appellant) and admitted into the opposition proceedings, has no effect on the board's conclusion that auxiliary request 4 meets the requirements of Article 56 EPC.

**9.3 E1/E1" as closest prior art**

9.3.1 It is undisputed that claim 1 differs from the device of E1 at least by the feature "*nicotine dispersed in the fibrous element (300) such that the aerosol can pick up the nicotine as the aerosol passes through the fibrous element (300)*".

- 9.3.2 E1 taken alone or with common general knowledge would not motivate the skilled person to modify the device in such a way that they arrive at the claimed subject-matter. The board agrees with the findings of the opposition division (decision, chapter 17.3) and the arguments of the respondent that, independently from the problem posed, the concept per se of adding nicotine to the device of E1 goes against the overall teaching thereof, bearing in mind that E1 relates to a device for aiding a smoker in the cessation of smoking. In particular, E1" states in paras. [0005] and [0006] that due to the existence of nicotine in the tobacco liquid, devices of the state of the art (e.g. D4 cited by the appellant) cannot allow quick smoke cessation.
- 9.3.3 None of the secondary documents E8, E20, E6 or E16/E17/E19 overcomes the main teaching of E1/E1" not to add nicotine at all. The board considers that the argument of the appellant (opponent) to simply add nicotine at least in small amounts to the fibrous element 12 of E1 is based on hindsight. Even if the board would follow the appellant's (opponent's) approach that the objective technical problem had to be seen in providing a nicotine-containing aerosol, there is no motivation to modify the device of E1 rather than using simply one of the alternative devices as e.g. disclosed in D4, E8, E20 or E6.
- 9.3.4 Further reasons against an obvious combination of E1 with E8 are that E8 discloses a tobacco heating system wherein tobacco is heated instead of being burned (see e.g. column 4, lines 3 to 10) and that the device of E8 is not intended for smoking cessation at all. Even if in E8 a tobacco extract may be used (column 11, line 49ff) instead of tobacco 89 (figure 2), the

structural differences as well as the different uses between the devices of E1 and E8 would not render obvious to replace the drug cartridge 12 of E1 (figure 1) by tobacco, nor to add tobacco extract to it. Furthermore the fibrous element in E8 that would structurally correspond to the fibrous element 12 of E1 is a filter 200, 215 as commonly used in a cigarette (E8, column 15, lines 59 to 67) being nicotine-free.

- 9.3.5 The combination with E20 is not obvious for similar reasons as for E8. Also E20 is directed to a heat-not-burn device, wherein an aerosol passes tobacco 5 (figures 1 and 2) to pick up nicotine. The device of D20 is technically different from the electronic smoking device of E1 with the liquid and the wick surrounded by the heater. Even if the skilled person would combine E1 with E20, they still would not arrive at the claimed subject-matter as E20 does not disclose nicotine as an additive but only as being naturally present in tobacco.
- 9.3.6 E6 discloses another structurally complete different form of aerosol generation. Heat is generated by the reaction of a liquid 16 and a reactant 12 (figure 3b). and conducted to a heat storage body 8. During inhalation of air, the air is heated by the heat storage body 8 and then passes a filter 6 (para. [0031]). The filter contains additives such as nicotine (para. [0026]) and is the sole location in the device where additives for flavouring the aerosol may be stored. During suction the additive is heated by the heated air to evaporate, so that the aspirator obtains a desired flavour. The appellant's argumentation that the skilled person simply needs to replace the essential drug cartridge 12 of E1 by the filter 6 of E6 without considering the overall structure of the



devices is based on an ex-post facto analysis.

9.3.7 Concerning E16, E17, E19, the appellant's (opponent's) argument that the skilled person would be incited to add the nicotine into the fibrous element, rather than to provide it as a liquid material, for regulatory reasons, is not convincing. The teaching of E16, E17, E19, in particular of E19 (first paragraph of chapter 1 "Résumé"), is not to consume nicotine at all for health reasons and is not restricted to nicotine in liquids. Furthermore starting from E1", wherein it is explicitly mentioned that no nicotine is the most advantageous, E16, E17, E19 rather confirm the nicotine-free solution.

9.4 **E18 as closest prior art (E2, E3 respectively)**

9.4.1 E18 (figures 1 and 2), E2 (figure 3) and E3 (figure 4) all refer to an electronic cigarette of the same type as the electronic smoking article claimed in the patent. They all disclose devices with nicotine contained in the liquid material.

9.4.2 It is undisputed that claim 1 differs from E18 (E2, E3) in that the liquid material is nicotine-free and that the device comprises a fibrous element including an additive being nicotine dispersed substantially uniformly throughout the fibrous element.

9.4.3 While the appellant (opponent) sees the objective technical problem in providing an alternative way to generate nicotine containing aerosol, the respondent (patent proprietor) argues that by first generating the aerosol and then later adding nicotine the problem of throat irritation is minimized.

9.4.4 Even if the board would consider the objective technical problem as proposed by the appellant (opponent), none of the attacks based on E18 in combination with one of the documents E8, E20 or E6 is convincing. There is no motivation to modify the device of E18 rather than using simply one of the alternative devices disclosed in E8, E20 or E6.

9.4.5 Furthermore as explained in points 9.3.4 and 9.3.5 the smoking devices of E8 and E20 are tobacco heating devices which are technically different from the electronic smoking device of E18 with the liquid material and the wick surrounded by the heater. Only in an ex-post-facto analysis the skilled person would arrive at the claimed subject-matter by removing the nicotine from the liquid and placing a fibrous element including nicotine as an additive in the space between the elements 10 and 11 of E18 (figure 2).

As regards E6, the skilled person would recognise that the fibrous element 6 of E6 comprising nicotine corresponds to the liquid used in E18 and does not constitute an additional element to be used in addition to a nicotine-containing liquid.

9.4.6 The attacks starting from E18 (E2, E3) combined with one of the documents E4, E7, E10 or E11 are not convincing. In the appellant's statement of grounds of appeal (last page, first paragraph), it is only generally stated that it is commonplace in the field of electronic smoking devices to provide an aerosol-forming liquid material together with a fibrous element. Any reasoning why the skilled person should consider E4, E7, E10 or E11 or should be motivated to pick out a single feature out of the disclosed devices (e.g. E4 "liquid material" and "filter 58", E7 "filter

plug 28") and how the skilled person then arrives at the claimed subject-matter is missing.

## **9.5 E8 as closest prior art**

9.5.1 Claim 1 differs from E8 in that the electronic smoking article comprises a different aerosol-generating configuration including an inner tube within an outer tube, defining an outer annulus, a liquid supply contained in the outer annulus, a heater located in the inner tube and a wick being surrounded by the heater.

9.5.2 The appellant's argument that the skilled person would simply import the entirety of the aerosol-forming unit of one of the secondary documents E18 (E2, E3) or E1 into the main concept of E8 to solve the problem of providing an alternative form of aerosol generation is not convincing.

While the device of E8 is a tobacco heating system including tobacco and is based on the heat-not-burn principle, the secondary documents instead disclose an e-cigarette using a liquid with nicotine. The aerosol-forming unit with the distinguishing features as identified in point 9.5.1 is typical for an e-cigarette and does not seem to be applicable to a tobacco heating system as disclosed in E8. As in the other attacks starting from E1 or E18, the skilled person would rather use the devices disclosed in E18 or E1 which provide a ready-to-use solution, instead of modifying the device of E8.

## **10. Adaptation of the description**

10.1 The board judges that the description needs to be adapted to claim 1 of auxiliary request 4. For example, para. [0033] of the patent in suit cited by the

appellant (opponent) is in contradiction with claim 1 of auxiliary request 4. The paragraph recites that "*the liquid material includes a tobacco-containing material [...] and may contain nicotine*" while claim 1 defines "*a nicotine-free liquid material*". At least this passage raises doubts about the scope of claim 1 and should thus be adapted. In this regard, the parties agreed to a remittal to the opposition division for the adaptation of the description.

- 10.2 The board does not follow decision T 1989/18, referred to by the respondent arguing at the oral proceedings that no adaptation would be necessary, according to which inconsistencies in the description could not affect clarity of the claims since, according to Article 84 EPC, these in themselves had to be clear.

In this respect the present Board agrees with the reasoning set out in decision T 1024/18 (see point 3.1 of the reasons), that the provision of Article 84 EPC relates to claims in general and actually covers three distinct requirements on claims, namely their clarity, their conciseness and their support by the description. According to the present board, the criterion that the claims be "supported by the description" is not in any way subordinate to the requirement of "clarity" of the claims, but is a requirement of its own (as is conciseness of the claims). The requirement in Article 84 EPC of the claims to be supported by the description includes the requirement that the description is consistent with the claims not only in some part but throughout. Thus, when amendments are made to the claims (amendment to the granted claims in the present case), the description must be made consistent therewith in the sense that a reader is not presented

with any information conflicting with the wording of the claims.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent on the basis of auxiliary request 4, submitted as auxiliary request 3 with the reply to the statement of grounds of appeal, and a description to be adapted.

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated