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**Datasheet for the decision
of 30 June 2023**

Case Number: T 1124/21 - 3.2.01

Application Number: 14706694.8

Publication Number: 2961285

IPC: A24D1/00, A24F13/10, A24F47/00

Language of the proceedings: EN

Title of invention:
AN INHALATION DEVICE AND COMPONENT FOR AN INHALATION DEVICE

Patent Proprietor:
Nicoventures Trading Limited

Opponent:
Philip Morris Products S.A.

Headword:

Relevant legal provisions:
EPC Art. 83, 54(2), 56
RPBA 2020 Art. 13(2)

Keyword:

Sufficiency of disclosure - (yes)

Novelty - (yes)

Inventive step - (yes)

Amendment after summons - exceptional circumstances (no)

Decisions cited:

Catchword:



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Case Number: T 1124/21 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 30 June 2023

Respondent: Nicoventures Trading Limited
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Appellant: Philip Morris Products S.A.
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Representative: HGF
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
10 May 2021 concerning maintenance of the
European Patent No. 2961285 in amended form.**

Composition of the Board:

Chairman G. Pricolo
Members: M. Geisenhofer
A. Jimenez

Summary of Facts and Submissions

I. The appeals were filed by the patent proprietor and the opponent against the interlocutory decision of the opposition division finding that, on the basis of auxiliary request 1 (then on file), the patent in suit met the requirements of the EPC.

II. The opposition division decided that the patent disclosed the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art, but that the subject-matter of the claims as granted (main request) was not novel over document

D3 US 4 484 590.

The opposition division further held that the auxiliary request 1 complied with the requirements of Articles 84, 83 and 123(2)EPC. They further held that the subject-matter of the claims according to auxiliary request 1 was novel over D3 and also novel over *inter alia* documents

D1 WO 2011/095410 A1 and

D5 US 4 677 995,

and inventive over the combination of document D1 with common general knowledge.

III. Oral proceedings were held before the Board.

(a) The appellant-patent proprietor withdrew their appeal during oral proceedings and hence became

respondent, the appellant-opponent remaining the sole appellant.

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

(c) The respondent requested that the patent be maintained in amended form on the basis of the seventh auxiliary request filed with the reply to the statement of grounds of the appellant-opponent.

IV. Claim 1 according to the seventh auxiliary request reads as follows:

"A component for an inhalation device, comprising a first end for connection to a body of an inhalation device and a second end, a passage extending through the component from the first end to the second end for the flow of inhalant therethrough, characterised in that the first end includes a blind cavity (38), separate to the passage and containing an organoleptic material (41), the organoleptic material (41) includes at least one open hollow space formed therein (42)."

V. The appellant's arguments can be summarised as follows:

(a) The invention according to the seventh auxiliary request was not disclosed in a manner sufficiently clear and complete for it be carried out by a person skilled in the art. The expression *"organoleptic material"* used in claim 1 was that broad that one single embodiment for a suitable material was not sufficient.

- (b) The term "*open hollow space*" was so unclear that it also encompassed the voids between the cuttings of tobacco. The subject-matter of claim 1 of the seventh auxiliary request was hence not novel over D1, D3 and D5, respectively.
- (c) The subject-matter of claim 1 of the seventh auxiliary request was rendered obvious by a combination of D1 with the common knowledge of the skilled person, and by a combination of D3 with the common knowledge of the skilled person.
- (d) The line of argument on inventive-step starting from D3 should be admitted into the proceedings albeit only substantiated during oral proceedings before the Board.

VI. The respondent's arguments can be summarised as follows:

- (a) The description identified at least one way to carry out the invention. The term "*organoleptic material*" was broad but did not require a plurality of examples to be identified in the patent.
- (b) Neither D3, nor D1 or D5 disclosed an organoleptic material including an open hollow space therein. The voids between the cuttings of tobacco could not be considered to be an open hollow space in the sense of the patent such that the subject-matter of claim 1 of the seventh auxiliary request was novel.
- (c) The objection of lack of inventive step starting from D3 was first raised during oral proceedings before the Board and therefore should not be admitted.

(d) Starting from D1 as closest prior art, the skilled person had no teaching at hand to provide an open hollow space within the tow of D1.

Reasons for the Decision

1. The seventh auxiliary request was filed by the patent proprietor with their reply to the appellant's grounds of appeal on 4th February 2022.
 - 1.1 This request corresponds to auxiliary request 7 filed in opposition proceedings. Claim 1 thereof combines the subject-matter of granted claims 1 and 2.
 - 1.2 The appellant submitted that the proprietor failed to substantiate the auxiliary request which should therefore not be admitted into the proceedings (see reply dated 21 January 2022, point 4).
 - 1.3 However, the request was substantiated, in particular having regard to novelty and inventive step, in the patent proprietor's reply dated 4 February 2022 (see point 12). There is therefore no reason not to admit auxiliary request 7 in the appeal proceedings (Article 12(3) and (5) RPBA 2020).

Sufficiency of disclosure (Article 83 EPC)

2. The appellant raised an objection of lack of sufficiency referring to the arguments raised with regard to the previous main request which was withdrawn during oral proceedings.

2.1 The appellant argued that the term "*organoleptic material*" was so broad that the disclosure of the unique particular material mentioned in the patent (see paragraph [0055]: cellulose acetate impregnated with menthol flavourant) was not sufficient to enable the skilled person to carry out the invention over the entire breath of the claim.

2.1.1 The Board notes that paragraph [0055] describes - as correctly recognized by the appellant - a suitable organoleptic material. The patent hence discloses at least one way for carrying out the invention.

2.1.2 The term "*organoleptic material*" is indeed broad. However, it is not that broad that it would cover a plurality of types of organoleptic materials so fundamentally different that the skilled person would be unable to carry out the invention without a disclosed example for each of these types. It is hence sufficient to provide one possible material.

2.1.3 The appellant disagrees and refers to three different possible physical states for the material (gaseous, liquid and solid) and hence deduces that the patent should provide an example for each of these physical conditions. Otherwise, the the claim should be restricted to solid materials.

2.1.4 The Board disagrees that in the present case it should be specified of which physical condition the organoleptic material is.

Indeed, the skilled person derives from the feature "*organoleptic material includes at least one open hollow space formed therein*" that the organoleptic material can neither be gaseous nor liquid since these

physical conditions of the material would not allow for forming (and maintaining) an open hollow space within the material.

- 2.2 The appellant further criticized with regard to the main request that the independent claim did not define a cavity or similar hollow void in the organoleptic material that would allow the inhalant to enter the blind hole and to take up the flavour provided by the organoleptic material.

Since claim 1 of the seventh auxiliary request requires that the "*organoleptic material includes at least one open hollow space formed therein*", such a void is present in claim 1 and therefore this objection is rendered moot.

- 2.3 The patent hence discloses the invention according to the seventh auxiliary request in a manner sufficiently clear and complete for it to be carried out.

Novelty (Article 54 EPC)

3. The appellant alleged that the subject-matter of claim 1 was not novel over document D3.

- 3.1 It was disputed between the parties whether the storage compartment (17) in the component shown in figure 8 of document D3 is a blind cavity containing organoleptic material, and whether the organoleptic material includes at least one open hollow space formed therein.

- 3.2 The storage compartment (17) has an opening ("filler hole" 25) at one side whereas the opposite side is in use closed by a cover (47). Albeit the opening (25) is

in use covered by slide member (19), the storage compartment forms a blind cavity included in the component.

The storage compartment is filled with tobacco, which undisputedly is an organoleptic material.

- 3.3 The appellant argued that the term "*open hollow space*" used in claim 1 is unclear and vague since every space is hollow. The identified term therefore merely refers to any kind of void. Since tobacco is not a homogenous material but is always provided with voids between the tobacco cuttings, these voids could be considered as open hollow spaces in the sense of claim 1.
- 3.3.1 Claim 1 requires that "*the organoleptic material includes at least one open hollow space formed therein*". The skilled person would understand that the open hollow space must intentionally be created in the organoleptic material. The voids between tobacco cuttings, however, are a characteristic of the tobacco as such which cannot be avoided or influenced in their geometry. These voids are therefore not "formed" in the material.
- 3.3.2 Furthermore, the claim requires the space to be included in the organoleptic material (i. e. the tobacco) and not between the ingredients forming that material (i. e. the tobacco cuttings). The space must thus be part of the macro structure and not only an inherent characteristic of the material.
- 3.3.3 The voids between tobacco cuttings finally are not hollow spaces since the term "*hollow space*" implicitly requires a delimitation of the space from the solid parts in the form of a wall or similar surface. The

tobacco cuttings do not delimit a space but are arranged in a three-dimensional compound without forming a hollow space therebetween.

- 3.4 The subject-matter of claim 1 hence differs from the component known from D3 in that the organoleptic material includes at least one open hollow space formed therein, claim 1 being therefore novel over D3.

4. The appellant further alleged that the subject-matter of claim 1 was not novel over documents D1 and D5 either. In a first understanding of D1, the component consisted of parts (9) and (7), whereas in a second understanding of D1, the component corresponded to only part (8) shown in figures 3 and 4.
 - 4.1 For the same reasons provided with regard to novelty over D3, neither the cellulose acetate tow (see page 6, lines 9 - 12) filling the compartment (18) of D1, nor the granular flavourant (see page 6, lines 30-33) in chamber (17) include an open hollow space formed therein. Indeed the spaces between the fibres of the cellulose acetate tow or between the grains of the granular flavourant do not provide an open hollow space.

 - 4.2 The same applies to the carrier medium (163) of D5 (see column 2, lines 48 - 49 and column 4, lines 34 - 42).

 - 4.3 The subject-matter of claim 1 hence differs from the components of D1 and D3 in at least that the organoleptic material includes at least one open hollow space formed therein, claim 1 being therefore also novel over D1 and D5.

- 4.4 Since the novelty objection based on D1 is not convincing in any of the two interpretations of D1, it can be left undecided whether one of these lines of arguments was raised late and therefore should not be admitted into the procedure as requested by the respondent.
5. The subject-matter of claim 1 is hence novel over each of documents D1, D3 and D5 in the sense of Article 54 EPC.

Inventive Step (Article 56 EPC)

6. The appellant alleged that the subject-matter of claim 1 is not inventive starting from document D1 as closest prior art.
- 6.1 The appellant argued in its grounds of appeal under section 11.3.1 with regard to inventive step referring to *"similar reasons to those explained above with respect to the Main Request and Auxiliary Request 1"*.
- 6.2 Since neither the main request nor the first auxiliary request contain the additional feature of claim 1 of auxiliary request 7 *"organoleptic material includes at least one open hollow space formed therein"* the reasoning referred to fails to substantiate why this feature would be obvious.
- 6.3 The Board sees therefore no reason to question inventiveness of the claimed subject-matter when starting from D1.

7. The appellant further alleged that the subject-matter of claim 1 was not inventive over a combination of D3 with the common general knowledge.
- 7.1 This line of argument was raised for the first time during oral proceedings before the Board. It is hence an amendment of the appellant's appeal case such that it is at the Board's discretion pursuant to Article 13(2)RPBA 2020 to admit this line of argument into the proceedings.
- 7.2 The appellant neither established exceptional circumstances nor justified raising the line of argument only at the oral proceedings with cogent reasons. The Board hence did not admit the inventive step argument starting from D3.
8. Further objections against the claims were not raised by the appellant.
9. The respondent filed a replacement page with an adapted description. The amendments to the description were not objected by the appellant either.

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 as amended in the following version:

- Description: page 2 as filed during the oral proceedings, pages 3-12 of the patent specification
- Claims: n°1 to 14 according to the seventh auxiliary request filed with the reply to the statement of grounds on 4 February 2022
- Drawings of the patent specification.

The Registrar:

The Chairman:



A. Voyé

G. Pricolo

Decision electronically authenticated