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**Datasheet for the decision  
of 25 November 2022**

**Case Number:** T 1617/21 - 3.2.01

**Application Number:** 18173918.6

**Publication Number:** 3398460

**IPC:** A24F47/00

**Language of the proceedings:** EN

**Title of invention:**  
TOBACCO-CONTAINING SMOKING ARTICLE

**Patent Proprietor:**  
RAI Strategic Holdings, Inc.

**Opponent:**  
Philip Morris Products S.A.

**Headword:**

**Relevant legal provisions:**  
EPC Art. 100(c)

**Keyword:**  
Grounds for opposition - subject-matter extends beyond content  
of earlier application (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**

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**Case Number: T 1617/21 - 3.2.01**

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.01**  
**of 25 November 2022**

**Appellant:** RAI Strategic Holdings, Inc.  
(Patent Proprietor) 401 North Main Street  
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**Representative:** D Young & Co LLP  
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**Respondent:** Philip Morris Products S.A.  
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**Representative:** HGF  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 20 July 2021  
revoking European patent No. 3398460 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** G. Pricolo  
**Members:** J. J. de Acha González  
P. Guntz

## Summary of Facts and Submissions

- I. The appeal of the proprietor is directed against the decision of the Opposition Division to revoke European Patent No. 3 398 460.
- II. The Opposition Division held among others that the subject-matter of claim 1 of the granted patent went beyond the content of the grandparent application as originally filed (Articles 100(c) and 76(1) EPC).
- III. Oral proceedings before the Board were held on 25 November 2022 in the form of a videoconference with the consent of the parties.

The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained as granted.

In case the granted patent were found to meet the requirements of Article 100(c) EPC the appellant requested that the case be remitted to the Opposition Division for further prosecution.

The respondent (opponent) requested that the appeal be dismissed, or, in the alternative, that the case be remitted to the Opposition Division for further prosecution if the Board came to the conclusion that the granted patent met the requirements of Article 100(c) EPC.

- IV. Granted claim 1 reads as follows (featuring numbering according to the decision under appeal):
  - A)** *"A powered aerosol generating device (10) comprising*

- B1)** *a source of electrical power (36),*
- B2)** *at least one electrical resistance heating unit (72) for forming a thermally generated aerosol that incorporates components of tobacco.*
- B3)** *a controller mechanism (50) including a sensor (60) that is capable of selectively powering the electrical resistance heating element (72) at least during periods of draw,*
- B4)** *wherein the device (10) comprises an outer housing (20)*
- C1)** *and a cigarette (150) positioned within the outer housing,*  
**characterised in that**
- B5)** *at least a portion of the electrical resistance heating element (72) is elongated, and at least a portion thereof extends downstream within the outer housing (20) such that at least a portion of the resistance heating element (72) can extend into the cigarette (150),*
- C2)** *wherein the cigarette (150) comprises at least one form of tobacco (89) and*
- C3)** *an aerosol-forming material employed in addition to the tobacco (89),*
- C4)** *the tobacco (89) being wrapped in a paper wrapper (160),*
- C5)** *wherein the tobacco (89) is present in the form of a gathered sheet that acts as a substrate for the aerosol forming-material."*

## **Reasons for the Decision**

1. *Granted Patent - Inadmissible extension - Article 100(c) EPC*
- 1.1 The subject-matter of granted independent claim 1 goes beyond the content of the grandparent application as originally filed (WO 2008/108889 A).
- 1.2 In the contested decision, the Opposition Division considered that the combination of features B5 (relating to the elongated electrical resistance heating element with at least a portion thereof extending into the cigarette) and C5 (relating to tobacco being present in the form of a gathered sheet that acts as a substrate for the aerosol forming-material) of claim 1 had no basis in the grandparent application as originally filed, because these features were selected from separate lists of alternatives.
- 1.3 The appellant essentially argued that the subject-matter of granted claim 1 did not involve a selection out of multiple lists; rather, the grandparent application as originally filed already disclosed on page 37, line 32 to page 38, line 3, that in the context of a resistance heating element having an elongated nature, the tobacco should form a substrate for the aerosol forming material, and that for all device embodiments (figures 1 to 3) various forms of tobacco could be used. In this sense, page 19, lines 3 to 18 of the description of the grand parent application as originally filed represented a single explicit disclosure of tobacco present in the form of a

gathered sheet and acting as a substrate for the aerosol forming material.

1.4 The criterion for assessing whether the subject-matter of granted claim 1 goes beyond the content of the grandparent application as originally filed is, as acknowledged by both parties, the *gold standard*, i.e. whether the claimed subject-matter is derivable directly and unambiguously for the skilled person from the earlier application as originally filed (see e.g. point 4.3 in the Decision of the Enlarged Board of Appeal G 2/10, OJ EPO 2012, 376; together with point 4.6 in which the same concept of disclosure equally applies for assessing inadmissible extension of subject-matter in the patent granted from a divisional application with regard to its earlier application as originally filed).

1.5 The cited passage on page 19 of the description of the grandparent application reads as follows:

*"The substrate material can incorporate tobacco of some form, normally is composed predominantly of tobacco, and can be provided by virtually all tobacco material. The form of the substrate material can vary; but most preferably that material is employed in an essentially traditional cigarette, cigar or pipe filler form (e.g., as cut filler). The substrate material can be otherwise formed into desired configurations. The substrate material can be used in the form of a gathered web or sheet, using the types of techniques generally set forth in US Pat. No. 4,807,809 to Pryor et al. The substrate material can be used into the form of a web or sheet that is shredded into a plurality of longitudinally extending strands, using the types of techniques generally set forth in US Pat. No. 5,025,814*

*to Raker. The substrate material can have the form of a loosely rolled sheet, such that a spiral type of air passageway extends longitudinally through the aerosol-generation segment. Representative types of tobacco containing substrate materials can be manufactured from mixtures of tobacco types; or from one predominant type of tobacco ( e.g., a cast sheet-type or paper-type reconstituted tobacco composed primarily of burley tobacco, or a cast sheet-type or paper-type reconstituted tobacco composed primarily of Oriental tobacco)."*

The Board, in line with the respondent's submissions and the reasons under point 10.3.6 of the impugned decision, takes the view that it does not derive directly and unambiguously from this passage that the tobacco present in the cigarette of the smoking article is in the form of a gathered sheet that acts as a substrate for the aerosol-forming material.

In this context it must be noted that feature C5 requires *the* tobacco present in the cigarette (and which is wrapped in a paper wrapper according to feature C4) to be present in the form of a gathered sheet (feature C5). Since feature B5 recites that at least a portion of the resistance heating element (72) can extend into the cigarette, claim 1 requires that the resistance heating element extends into a cigarette that has tobacco in the form of a gathered sheet.

The substrate for the aerosol-forming material is described in the paragraph (page 18, line 16, page 19, line 2) preceding the above-mentioned paragraph, as being a material that incorporates within it or carries the aerosol-forming material. For example, the substrate can be, at least in part, a material that



incorporates tobacco (page 18, lines 22, 23). In this paragraph it is also disclosed that such a "substrate" is one among many possibilities for providing the aerosol-forming material in the smoking article, see e.g. page 18, lines 17-19, referring to a liquid material contained within a container or soaked within sponge-like materials. Further up in the description it is disclosed that the aerosol-generating material can be in intimate contact with the tobacco material or can be carried by a non-tobacco substrate and segregated from the tobacco in the smoking article (see third paragraph on page 17).

Accordingly, the substrate for the aerosol-forming material can take different forms; in particular it can be incorporated or carried by a tobacco or by a non-tobacco substrate.

When reading the above-mentioned paragraph on page 19, the skilled person is taught that said substrate can incorporate tobacco of some form, that it is normally composed predominantly of tobacco, and that it can be provided by virtually all tobacco material. The skilled person is further taught that the substrate material can be used in the form of a gathered web or sheet using the specific techniques set forth in US patent 4,807,809, or into the form of a web or sheet that is shredded into a plurality of longitudinally extending strands, or that it can have the form of a loosely rolled sheet.

However, there is no direct and unambiguous disclosure that when selecting, as a substrate material for the aerosol-forming agent, a gathered sheet, the latter also provides the tobacco which is present in the cigarette. In fact, the above mentioned paragraph only

describes a gathered sheet as one possible substrate for the aerosol-forming material but leaves open whether the gathered sheet includes tobacco and to what extent (according to the US patent 4,807,809 referred to, the sheet can also be a synthetic material; see column 7, lines 30 to 32), and in any case does not directly and unambiguously teach that it is such gathered sheet that provides the tobacco which is present in the cigarette according to the embodiment of figure 3 that discloses feature B5, i.e. an embodiment in which the resistance heating element extends into the cigarette.

It follows that the subject-matter resulting from the combination of features C5 and B5 is not directly and unambiguously derivable either implicitly or explicitly for the skilled person from the content of the grand parent application as originally filed.

2. The Board further notes that much of the discussion in the present proceedings was focused on the selection of features from plural lists (see e.g. page 2 of the statement of grounds of appeal; see point 1.2.2.9 of the respondent's reply). What counts here, more generally, is whether the skilled person is confronted with new technical information over the content of the grandparent application as filed. This question is to be replied in the affirmative, for the reasons given herein above, as the particular combination of features claimed, which results in "artificially creating a particular embodiment" as pointed out by the Opposition Division (end of paragraph 10.3.6), is not directly and unambiguously derivable.
3. The appellant also submitted that there were clear indications and pointers in the application as filed

that the gathered sheet of claim 1 should form the substrate incorporating tobacco and that it should be used in combination with an elongated resistance heating element.

However, the disclosure on page 19, line 8, relating to the substrate material being a gathered "web or sheet", is not specific to the web or sheet being made of tobacco, as substrate materials not made of tobacco are also contemplated in the grandparent application. The general statement on page 19, lines 3 to 5, that the substrate material can incorporate tobacco of some form, normally is composed predominantly of tobacco, and can be provided by virtually all tobacco material, might provide an "indication" that the gathered sheet "could" comprise tobacco, not, however, a direct and unambiguous disclosure of a gathered sheet acting as a substrate for the aerosol forming material providing the tobacco of the cigarette, let alone of it being the tobacco of a cigarette according to the embodiment of figure 3.

4. Consequently, the appeal is not allowable.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:



A. Voyé

G. Pricolo

Decision electronically authenticated