

**Internal distribution code:**

- (A) [ - ] Publication in OJ
- (B) [ - ] To Chairmen and Members
- (C) [ - ] To Chairmen
- (D) [ X ] No distribution

**Datasheet for the decision  
of 25 July 2023**

**Case Number:** T 1704/21 - 3.2.01

**Application Number:** 16725451.5

**Publication Number:** 3297458

**IPC:** A24B3/14, A24D1/00, A24C5/01,  
A24D1/20

**Language of the proceedings:** EN

**Title of invention:**

METHOD FOR MANUFACTURING INDUCTIVELY HEATABLE TOBACCO RODS

**Patent Proprietor:**

Philip Morris Products S.A.

**Opponent:**

JT International S.A.

**Headword:**

**Relevant legal provisions:**

EPC Art. 100 (a), 56, 100 (b)

**Keyword:**

Grounds for opposition - insufficiency of disclosure (no)  
Inventive step - (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**

**Boards of Appeal**

**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

**Case Number: T 1704/21 - 3.2.01**

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.01**  
**of 25 July 2023**

**Respondent:** Philip Morris Products S.A.  
(Patent Proprietor) Quai Jeanrenaud 3  
2000 Neuchâtel (CH)

**Representative:** Grünecker Patent- und Rechtsanwälte  
PartG mbB  
Leopoldstraße 4  
80802 München (DE)

**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)

**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
26 July 2021 concerning maintenance of the  
European Patent No. 3297458 in amended form.**

**Composition of the Board:**

**Chairman** G. Pricolo  
**Members:** J. J. de Acha González  
O. Loizou

## **Summary of Facts and Submissions**

I. The appeal of the opponent lies against the interlocutory decision of the Opposition Division to maintain the European patent N° 3297458 in amended form according to the auxiliary request 6 filed during the oral proceedings before it.

II. The following documents are relevant for the present decision:

D1: US 2008/0173502 A1;  
D2: EP 0430559 A2;  
D3: US5613505 A;  
D5: EP0558447 A1;  
D6: W02006059134 A1; and  
D7: US200410767 4 A1.

III. Oral proceedings before the Board were held on 25 July 2023 in the form of a videoconference with the consent of the parties.

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 of the opponent be dismissed, i.e. that the patent be maintained in amended form on the basis of auxiliary request V, or, in the alternative, on the basis of one of auxiliary requests VI to X filed with their reply.

IV. Independent claim 1 of the main request reads as follows (feature numbering according to the contested decision):

- 1A** *Method for manufacturing inductively heatable tobacco rods, the method comprising the steps of:*
- 1B** *- providing a continuous profile of a susceptor (1);*
- 1BB** *- cutting the continuous profile of susceptor into individual susceptor segments (10);*
- 1C** *- guiding an aerosol-forming tobacco substrate (2) along a tobacco substrate converging device;*
- 1D** *- positioning the individual susceptor segments in the aerosol-forming tobacco substrate;*
- 1E** *- converging the aerosol-forming tobacco substrate to a final rod shape,*
- 1F** *wherein the step of positioning the individual susceptor segments in the aerosol-forming tobacco substrate is performed before performing the step of converging the aerosol-forming tobacco substrate to its final rod shape.*

## **Reasons for the Decision**

### *Main request*

Claims 1 to 12 of the main request correspond to granted claims 1 to 12 of the contested patent.

- 1. *Insufficiency of disclosure - Article 100(b) EPC*
- 1.1 The patent discloses the invention according to claim 1 in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

1.2 The appellant pursued the line of argumentation duly considered by the Opposition Division in the contested decision regarding the specific sequence of the positioning and converging steps (see point 8.1.1 of the contested decision). The appellant additionally submitted in the statement of grounds of appeal that there was a contradiction in this respect between the description of the patent and the wording of claim 1, which as such was clear. The positioning step according to claim 1 was before the converging step and not during it as shown in the description. The objection of lack of proper disclosure on how the positioning of the individual susceptor segments was implemented was also maintained in appeal (see point 8.1.2 of the decision).

The view of the Opposition Division is correct and the Board adopts it as its own to be part of the reasoning of this decision (see points 8.2.1 and 8.2.2 of the decision under appeal). As regards the alleged contradiction between claim 1 and the description, this matter qualifies however as an objection under Article 84 EPC which does not constitute a ground for opposition.

1.3 Additionally, the appellant submitted for the first time with its statement of grounds of appeal that the skilled person would not be in a position to perform the step of cutting the continuous profile of susceptor into individual susceptor segments as recited in feature 1BB of claim 1. In their view, the way the cutting step should be implemented was not properly disclosed in the patent in suit.

This is not persuasive irrespective of the admissibility objection raised by the respondent for this objection. Claim 1 is very broad with respect to the cutting step of the continuous profile of susceptor into segments and is not limited to any specific way. Accordingly and as pointed out by the Board in its communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (see point 1.2.2 of the communication) the skilled person, bearing in mind their common general knowledge, is undoubtedly in a position to cut the continuous profile of susceptor into individual susceptor segments as claimed. Moreover, during the oral proceedings and when arguing on inventive step of the subject-matter of granted claim 1, the appellant themselves admitted that the step of cutting a continuous profile of susceptor into segments was something that the skilled person knew how to perform (see below under inventive step).

2. *Inventive step - Article 100(a) and 56 EPC*

2.1 The subject-matter of claim 1 is not rendered obvious in view of the following combinations of prior art:

- D1 in combination with common general knowledge D5, D6 or D7;
- D2 in combination with D1, D5, D6 or D7; and
- D3 in combination with D1, D5, D6 or D7.

2.2 The subject-matter of claim 1 differs from the method disclosed in D1 on account of features 1BB, 1D and 1F.

The appellant argued that the difference was solely represented by features 1BB and 1F, since feature 1F included implicitly feature 1D. This is however equivalent to saying that the differences are indeed features 1BB, 1D and 1F. Accordingly, the view of the

Opposition Division in the decision was not contested in this respect (see point 21.1.3 of the contested decision).

- 2.2.1 As put forward by the Opposition Division in the decision under appeal, the technical effect associated with these differences is the possibility of variations in length of the susceptor to be positioned in the tobacco substrate. Indeed the method of D1 does not allow a variation of the length of the susceptor relative to the tobacco substrate because the continuous sheets of tobacco and susceptor are continuously joined together and cut after being converged into the final rod shape.

The formulation of the problem adopted by the Opposition Division is therefore correct, i.e. how to adapt or modify the method disclosed in D1 in order to improve manufacturing flexibility.

Neither the common general knowledge nor any of D5, D6 and D7 teaches the skilled person to solve the posed objective technical problem by performing the step of cutting the susceptor into individual susceptor segments before positioning them in the aerosol-forming tobacco substrate.

- 2.2.2 The appellant argued again as they did in opposition proceedings. The technical effect mentioned above was in their view not commensurate with the claimed scope because there was no difference between performing the cutting step before or after positioning it in the aerosol-forming tobacco substrate. In particular, the relative length of the susceptor segments with respect to the tobacco substrate was left open in claim 1 such that the subject-matter of the claim covered lengths of

the susceptor segments, which were equal to or shorter than the length of the tobacco substrate. The improvement in flexibility should not be taken into account if it was not necessarily obtained when implementing the method of claim 1.

Accordingly, the objective technical problem solved by the claimed method should be formulated as providing an alternative method for manufacturing inductively heatable tobacco rods.

Bearing in mind that problem the skilled person would directly adapt the method of D1 to perform the cutting step before the positioning based on common general knowledge - such adaptation only requiring an additional conventional cutting device upstream of the converging step.

Also D5 would prompt the skilled person to cut a continuous profile of susceptor into individual segments in order to obtain the intermittent insertion of a solid element into the tobacco substrate (see figures 3A, 3B and 4).

The skilled person would also consider the teaching of D6 even if it addressed the production of filter rods because it belonged to the same field and purpose: method for manufacturing tobacco rods and related articles and inserting elements within the filter rod. The method for manufacturing rods were not specific to the kind of substrate employed. D6 disclosed in this regard that the elements to be inserted could be positioned intermittently along the continuously manufactured filter rod. Accordingly, when starting from the continuous profile of susceptor from D1, the skilled person would be motivated to similarly adapt the method of D1 for embedding intermittently the

susceptor elements into the tobacco substrate and would inevitably implement a pre-cutting step of the susceptor profile.

Further, D7 disclosed, even when also directed to the production of filter rods, both alternatives. Namely one in which a strip of metallic material was gathered with a filter material and converged to form a filter rod before being severed together (see figure 3 and paragraph [0060]), and another one, in which each filter mouthpiece was provided with a relatively short strip having a length which was the fraction of the length of the mouthpiece (see figure 2 and paragraph [0061]). The skilled person would then adapt in an obvious manner the production line shown in figure 3 of D7 by adding a pre-cutting step in order to insert individual shorter strips. Such adaptation would prompt the skilled person to do the same to the manufacturing method shown in D1.

2.2.3 The line of argumentation of the appellant starting from D1 is not convincing for the following reasons.

Firstly, the formulation of the objective technical problem as an alternative is not convincing. As stated above the technical effect on the variation of the length of susceptor segments to be positioned on the tobacco substrate is a consequence of the possibility of cutting the continuous profile of susceptor at any desired length independently of the length of the final tobacco rod. This would not be possible without steps 1BB and 1D. The fact that the subject-matter of the claim includes a method in which the length of the susceptor is equal to or shorter than the length of the tobacco rod and that the segments could be positioned contiguously in the tobacco substrate, does not exclude

the adaptability of the method claimed to such variations.

For this reason alone the inventive step objections of the appellant starting from D1 do not succeed.

Secondly, the combination with common general knowledge is based on hindsight. The skilled person could perform the cutting upstream of the converging step but they would lack any motivation to do so starting from the method of D1 and bearing in mind their common general knowledge.

Finally, the combinations with any of the disclosures of D5, D6 or D7 can neither succeed since none of the documents discloses or hints the skilled person to perform a cutting step to the continuous profile of susceptor into individual susceptor segments prior to the positioning of the individual susceptor segments in the aerosol-forming substrate. These combinations are also based on hindsight.

In particular, the injection nozzle 20 shown in figures 3A, 3B and 4 of D5 enables a continuous or intermittent insertion of a liquid from container 24 inside the tobacco substrate - not of a susceptor provided as a continuous profile that has been cut before insertion - by continuous or sequential command of a dosing device 23.

Analogously as for D5, there is no disclosure or hint in D6 that the additive inserted into the filter substrate originates from a continuous profile which has been cut previous to its injection.

The passages cited in D7 make reference to a metallic strip positioned in a filter mouthpiece of a cigarette which is used to identify presence of cigarettes within a container. Said strip, as argued by the respondent, is not in a position to act as a susceptor for

inductively heating tobacco of the cigarette. Moreover and irrespective of this, the document is silent on how the shorter strips referred to by the appellant are obtained. There is no disclosure, suggestion or hint for cutting a continuous profile of metallic material in shorter strips before positioning them in the filter material. The strips could be produced in any other suitable way before putting them in the filter material.

- 2.3 The appellant also maintained the objections on inventive step starting from D2 and D3. They argued that the Opposition Division erred when considering that neither D2 nor D3 were suitable starting points for assessing the obviousness of the subject-matter of granted claim 1. Any document belonging to the same technical field as the patent in suit could be used as the closest prior art. D2 and D3 disclosed inductively heatable tobacco rods comprising a susceptor positioned in the aerosol-forming tobacco substrate and therefore constituted suitable starting points. Neither D2 nor D3 disclosed any specific method for manufacturing the inductively tobacco rod. Accordingly, the invention according to claim 1 merely aimed at providing a suitable method for the production of the tobacco rods disclosed in D2 or D3. Such claimed method was hinted in any of D1, D5, D6 or D7 to the skilled person taking into consideration the arguments put forward above for each of the documents.

- 2.3.1 The arguments of the appellant regarding D2 or D3 do not persuade.

According to established case law, the closest prior art for assessing inventive step is a prior art

document disclosing subject-matter conceived for the same purpose or aiming at the same objective as the claimed invention and having the most relevant technical features in common, i.e. requiring the minimum of structural modifications while corresponding to a similar use. As evaluated by the Opposition Division, D1 discloses a method of manufacturing tobacco rods whereas the starting point of the opponent from D2 and D3 is merely a finished product without specifying any manufacturing method of such product. The Opposition Division was consequently correct in this regard.

Even if the skilled person were to start from any of the smoking articles disclosed in D2 and D3, the line of argumentation of the opponent does not either succeed since, as pointed out further up, none of the documents D1, D5, D6 and D7 discloses nor hints to a pre-cutting step of a continuous profile of a susceptor into individual susceptor segments before positioning the individual susceptor segments in the tobacco substrate before converging it to its final rod shape.

3. It follows from the above that the appeal of the opponent is not allowable.

## **Order**

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

The appeal of the opponent is dismissed.

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated