

Internal distribution code:

- (A) ☐ Publication in OJ
(B) ☐ To Chairmen and Members
(C) ☐ To Chairmen
(D) ☒ No distribution

**Datasheet for the decision
of 4 March 2025**

Case Number: T 1609/22 - 3.2.04

Application Number: 14781973.4

Publication Number: 3041374

IPC: A24D1/02

Language of the proceedings: EN

Title of invention:

COATED PLUG WRAP FOR A SMOKING ARTICLE

Patent Proprietor:

Schweitzer-Mauduit International, Inc.

Opponents:

Miquel y Costas & Miquel, S.A.
Julius Glatz GmbH

Headword:

Relevant legal provisions:

EPC 1973 Art. 123(2)

Keyword:

Patent as granted - Added subject-matter (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

Case Number: T 1609/22 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 4 March 2025

Appellant: Schweitzer-Mauduit International, Inc.
(Patent Proprietor) 100 North Point Center East, Suite 600
Alpharetta, GA 30022 (US)

Representative: Wall, Leythem
Oxon IP B.V.
Evert Van De Beekstraat 354
1118 CZ Schiphol (NL)

Respondent: Miquel y Costas & Miquel, S.A.
(Opponent 1) Tuset, 10. Planta 7
08006 Barcelona (ES)

Representative: Ungria López, Javier
Avda. Ramón y Cajal, 78
28043 Madrid (ES)

Respondent: Julius Glatz GmbH
(Opponent 2) Staatsstrasse 37-41
67468 Neidenfels (DE)

Representative: Schön, Christoph
Dr. Schön, Neymeyr & Partner mbB
Bavariaring 26
80336 München (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 17 June 2022
revoking European patent No. 3041374 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman	A. Pieracci
Members:	S. Oechsner de Coninck
	M. Millet

Summary of Facts and Submissions

- I. The proprietor appeals against the decision of the opposition division revoking European patent No. 3041374 pursuant to Article 101(3)(b) EPC.
- II. The following document was additionally cited in appeal:
D48: I.M. Hutten, "Handbook of Nonwoven Filter Media", Butterworth-Heinemann, page 175 (2007)
- III. The Board issued a communication in preparation for oral proceedings and setting out its provisional view on the relevant issues.
- IV. Oral proceedings were held in person on 4 March 2025.
- V. The appellant patent proprietor requested that the decision under appeal be set aside and the patent be maintained as granted (main request) or on the basis of one of the auxiliary requests 1 to 23 re-filed with the grounds of appeal.
- VI. The respondents (opponents 1 and 2) requested that the appeal be dismissed.

VII. The independent claim 1 of the relevant requests is as follows:

- Main request (as granted - with feature numbering used in the decision under appeal added by the Board):

A *"A coated plug wrap for a smoking article, wherein
the coated plug wrap comprises:*
B *a base paper comprising hardwood pulp fibers or a
combination of hardwood pulp fibers and softwood
pulp fibers,*
C *the hardwood fibers present in an amount greater
than 50 % by weight based on the total dry weight
of the fibers, and*
D *a coating on at least one surface of the base
paper*
E *in an amount such that the coated plug wrap has a
tensile strength of at least about 100 g/mm as
measured by ISO 1924-2,*
F *wherein the coating comprises an acrylate, a
styrene, a butadiene, a starch, a starch
derivative, a cellulose derivative, an alginate,
a polyvinyl alcohol, a polyvinyl acetate, a
gelatin, a gum, or a combination thereof,*
G *characterised in that the coated plug wrap has a
permeability of less than about 5 Coresta units."*

- Claim 1 according to auxiliary requests 1 to 23 contains the same feature E: *"in an amount such that the coated plug wrap has a tensile strength of at least about 100 g/mm as measured by ISO 1924-2"*

- VIII. The appellant proprietor argued as follows:
- Claim 1 as granted does not contain subject-matter extending beyond the content of the application as filed.
 - The same applies to claim 1 according to auxiliary requests 1 to 23.

- IX. The respondents argued as follows:
- Claim 1 according to the main and auxiliary requests 1 to 23 contains added subject-matter.

Reasons for the Decision

1. Main request - added subject-matter
-
- 1.1 The Board concurs with the opposition division's decision that the further definition of the coating according to feature E in granted claim 1 implies a link between the amount of coating and the tensile strength of the coated plug wrap not disclosed in the application as filed and that infringes Art. 123(2) EPC.
- 1.2 The amended feature E introduces an additional limitation in terms of a result to be achieved by a selected amount of coating provided on the base paper. A certain amount of coating should be selected in order to obtain some properties expressed as an open upper range of values of tensile strength, at least 100 g/mm, using a certain measurement norm, and obtained on the finished plug wrap once coated with this certain amount.

- 1.3 The appellant first considers that paragraph 071 of the application as filed would be read by the skilled person as relating to a plug wrap which is coated.
- 1.3.1 The Board disagrees and rather concurs with the respondents, that the skilled person would not undoubtedly have read this paragraph in relation to a plug wrap which is coated.
- 1.3.2 Contrary to the appellant's opinion, all the paragraphs 062 to 071 of the application as filed disclosing certain properties of the plug wrap establish a clear distinction whether these properties concern the base paper itself, the uncoated plug wrap, the coated plug wrap or the coating itself. This is inter alia so for the ranges of basis weight in paragraph 063, the thicknesses values for these different components of the plug wrap in paragraph 065, and the permeability values in paragraph 066. This is again the case for the oil resistance of paragraph 067 or the sizing values in paragraph 68 explicitly related to the coated plug wrap.
- 1.3.3 It follows that the skilled person reading the whole content of the disclosure of the application as filed is expected to find a clear indication of which kind of plug wrap uncoated or coated or sub-component, base paper or coating or both is concerned to exhibit certain properties. This is especially so for all properties applicable individually or in group, such as the weight, the thickness, the permeability or the strength. By contrast, paragraph 071 remains unspecific in its first sentence on whether the plug wrap is coated or not. Thus in the above explained context of the application as filed, the Board considers that the

skilled person would not have directly and unambiguously derived that the specific ranges of tensile strength expressed in paragraph 071 clearly and without any doubt concern a plug wrap that is coated.

- 1.3.4 It thus follows, that the lack of direct and unambiguous disclosure of a coated plug wrap having certain tensile strength is enough to establish that claim 1 as granted contains added subject-matter.
- 1.4 The Board furthermore concurs with the negative finding made by the opposition division that a relationship between an amount of coating and certain values of tensile strength was directly and unambiguously derivable from the disclosure of the application.
 - 1.4.1 The appellant considers that paragraphs [0007] and [0041] of the application as filed would establish a clear link between the coating and the strength properties of the coated plug wrap.
 - 1.4.2 Paragraph 007 explains the general objective of the patent to provide for a coated plug wrap for a smoking article that is of appropriate strength and inhibits or prevents flavours from escaping through the plug wrap to the tipping paper.

Thus this paragraph discloses that a coated plug wrap as finished product is sought that amongst other has an appropriate strength, prevents flavourings from escaping, prevents air from diluting the aromas. Neither the question of selecting any particular amount or type of coating is addressed nor which kind of strength, -e.g. tensile, buckling or shearing- or target values are disclosed.

- 1.4.3 Paragraph 041 further relied upon indicates that the amount of coating applied to the base paper to produce the coated plug wrap will depend on various factors, including the type of coating that is used and the desired result. Again the amount of coating is only related to its type in order to achieve an undefined or generic "desired result". Therefore the Board disagrees with the appellant that this paragraph would be a suitable disclosure for the more specific tensile strength, less so its range of values. The same paragraph goes on disclosing several weight amounts of coating provided on the base paper, based on its dry weight, without any reference to any kind of contribution to structural strength of the plug wrap.
- 1.4.4 Even assuming the disclosure of paragraph 071 would concern a plug wrap that is coated, its disclosure content generally concerns the tensile strength but fails to establish a relationship with the selection of coating in a certain amount.
- 1.4.5 The appellant considers that strength is one of the desired result to be achieved in the application as filed, and therefore the skilled person would have clearly derived the relationship between the amount of coating and strength from the application as a whole.
- 1.4.6 The Board remains unconvinced, especially as the paragraphs 007, 041 or 071 referred to fail to establish any explicit or implicit relationship between a certain amount of coating and a sought tensile strength of the whole plug wrap once this quantity has been provided on the base paper. It is in particular irrelevant whether the skilled person knows that a coating in varying amount would achieve different

strengths properties, the claim as amended is much more specific and requires that the application establishes a direct and unambiguous relationship between an amount of coating and numeric values or ranges of tensile strength properties of the coated plug wrap. Such relationship is in fact missing from the whole disclosure of the application as filed as correctly assessed by the opposition division.

- 1.4.7 The further passages of the application as filed referred to by the appellant also fail to provide the required direct and unambiguous disclosure of the specific relationship introduced in feature E. Paragraphs 003 and 004 do not relate to coated plug wrap less so to any particular amount of coating. Paragraph 062 generally indicate to provide a smoking article with unspecific "desired properties" for certain applications. In paragraph 018 the suitable mechanical strength and wet tensile strength for a coated plug is again broadly expressed amongst other advantages on retention of flavours, and fails to establish a specific relationship between a certain amount of coating and desired values of tensile strengths.
- Thus assuming the skilled person from the whole context of these passages may have inferred that the tensile strength belongs to the properties the coated plug wrap seeks to obtain, such a general understanding is unable to establish the required selection of any amount of coating for that purpose.

- 1.5 The appellant further relies on D48 to evidence the influence of the coating to strengthen a wrapped filter. Independently from the disputed question of its admission into the proceedings, this document only express the general knowledge that coating has an influence on strength in chapter 4.4 on page 175, but fails to establish a general relationship between the provision of a certain amount of coating and specific values of tensile strength once applied on a base paper.
- 1.6 It follows from the above that the opposition division has correctly assessed the question of added subject-matter for at least the amendment of feature E of claim 1 made during prosecution of the application.
2. Auxiliary requests 1 to 23
- 2.1 Irrespective of the question of their admission into the proceedings, challenged by the respondents, it is undisputed that all requests contain the same amended feature E and that none of these requests overcome the above objections of added subject-matter explained here above for claim 1 of the main request.
3. In the light of the above, the Board confirms the opposition division's decision to revoke the patent pursuant to Article 101(3) (b) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed

The Registrar:

The Chairman:



G. Magouliotis

A. Pieracci

Decision electronically authenticated