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**Datasheet for the decision
of 12 December 2024**

Case Number: T 1770/22 - 3.2.01

Application Number: 14747264.1

Publication Number: 3021691

IPC: A24B13/00, A61K31/465

Language of the proceedings: EN

Title of invention:

METHODS AND SYSTEMS FOR INCORPORATING NICOTINE INTO ORAL
PRODUCTS

Patent Proprietor:

Altria Client Services LLC

Opponent:

Fertin Pharma A/S

Headword:

Relevant legal provisions:

EPC Art. 54

RPBA Art. 11 (2007)

Keyword:

Main request - Novelty over D3 (yes)

Remittal to the opposition division (yes)

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 1770/22 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 12 December 2024

Appellant: Altria Client Services LLC
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Respondent: Fertin Pharma A/S
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 25 May 2022
revoking European patent No. 3021691 pursuant to
Article 101(3)(b) EPC.**

Composition of the Board:

Chairman H. Geuss
Members: S. Mangin
A. Jimenez

Summary of Facts and Submissions

- I. The appeal was filed by the appellant (patent proprietor) against the decision of the opposition division to revoke the patent in suit (hereinafter "the patent").
- II. The opposition division held that the subject-matter of claim 1 of the main request (patent as granted) was not novel over D3 (WO 2007/104574 A2) and that auxiliary requests 1-3 did not meet the requirements of article 123(2) EPC.
- III. Oral proceedings were held before the Board on 12 December 2024.
- IV. The appellant (patent proprietor) requested that the decision under appeal be set aside and the patent be maintained as granted or, as an auxiliary measure, that the patent be maintained in amended form on the basis of one of auxiliary requests 1 to 3 which also form the basis of the appealed decision.

The respondent (opponent) requested that the appeal be dismissed.

- V. Claim 1 of the **main request** reads as follows:

A method for forming an oral product, comprising mixing liquid nicotine with cellulosic fiber to form a cellulosic fiber-nicotine mixture, wherein either

(A) said liquid nicotine is mixed with said cellulosic fiber such that the liquid nicotine absorbs into pores of the cellulosic fiber to form said cellulosic fiber-

nicotine mixture; and wherein the method further comprises loosely depositing the cellulosic fiber-nicotine mixture within a container; or

(B) the method further comprises

(a) mixing said cellulosic fiber-nicotine mixture with one or more binders to form an oral product pre-molding mixture, the one or more binders comprising a chewing gum base; and

(b) molding the oral product pre-molding mixture into an oral product;

wherein the cellulosic fiber in (A) and (B) comprises fibers selected from the group consisting of wood pulp, cotton, sugar beets, bran, citrus pulp fiber, grass fibers, Salix, tea, Populus, bamboo fibers, and combinations thereof.

VI. The following documents are referred to in the present decision:

D7: Information leaflet Avicel

PL2: WO 2004/064811 A1

Reasons for the Decision

1. Main request - Novelty over D3

The subject-matter of claim 1 is novel over D3.

The question to be answered is whether microcrystalline cellulose (MCC), which is disclosed in example 1 of D3 falls within the scope of claim 1.

1.1 The appellant (patent proprietor) argued that the subject-matter of claim 1 was not a method for making

cellulosic fibers. Hence, how the enumerated fibers of claim 1 were made and whether the method of making these cellulosic fibers included a chemical treatment was irrelevant to the issue of novelty for the claimed method. The claimed method as defined in claim 1 was directed to a method of making an oral tobacco product by mixing a cellulosic fiber selected from the group consisting of one of nine enumerated cellulosic fibers (and combinations thereof) with liquid nicotine such that the liquid nicotine absorbed into pores of the cellulosic fiber to form a cellulosic fiber-nicotine mixture.

The expression "consisting of" in claim 1 should leave no doubts as to the scope of the limitation of the nine enumerated cellulosic fibers and combinations thereof. MCC was a different material from any of the enumerated cellulosic fibers and was not one of the nine enumerated fibers that were used in the claimed method as defined in claim 1. MCC was pure crystalline cellulose while the molecules that made the cellulosic fibers enumerated in claim 1 were larger molecules having crystalline portions and amorphous portions in the chain. Moreover, the cellulosic fibers of claim 1 had other substances such as lignin. To get from the cellulosic fibers of claim 1 to the pure MCC of D3 first all the additional substances like lignin had to be removed and also the cellulose molecules had to be broken down to separate the amorphous cellulose and the crystalline cellulose and then the amorphous cellulose had to be removed to get the pure crystalline cellulose, i.e., the MCC of D3. The appellant referred to the paragraph bridging pages 5 and 6 of D3 and to D7, disclosing the way Avicel, which was an MCC, was produced to show that MCC was different to cellulosic fibers.

Hence, claim 1 was limited only to the enumerated cellulosic fibers regardless of how the cellulosic fibers were made and MCC was very different to any of the enumerated cellulosic fibers in terms of structure, composition and properties (for example the release rate of nicotine).

The scope of the claims was determined by the language of the claims. Paragraph [0013] simply stated another possible embodiment of the disclosure which was not part of the claimed invention as defined in claim 1 of the patent as granted. The appellant noted that this paragraph enhanced their argument that MCC was a different material which was not claimed. MCC could have been easily included in claim 1 if wanted.

- 1.2 The respondent argued that the subject-matter of claim 1 was not novel over D3 as example 1 of D3 disclosed the nicotine in the gum being prepared by sorbing liquid nicotine onto microcrystalline cellulose (MCC), specifically Avicel PH-102.

Avicel was a commonly used branded MCC product, and as evidenced by D7, Avicel PH-102 was made from wood pulp (see page 02) and it had a size of ca. 100µm (see page 06).

According to the opposed patent, the cellulose used in the purposed invention could be made from wood pulp (see claim 1 and [0013]). The patent disclosed that the cellulose used in the alleged invention could be processed to be in the form of e.g. MCC (see [0013]) and disclosed that a size between 75-125µm was suitable (see [0030]). Thus, the cellulose used in example 1 of D3 was the same as that defined in claim 1, and was

used in the same way as defined in claim 1 - nicotine was sorbed onto it, and it was incorporated into a molded chewing gum product.

According to claim 1, the method merely required cellulosic fibers such as wood pulp. It was disclosed in [0013] of the opposed patent that the cellulosic fibers could be chemically treated prior to use. MCC was a treated wood pulp (see e.g. D7 which characterizes Avicel PH-102 used in D3) which was expressly mentioned in [0013]. "Wood pulp" according to claim 1 thus included chemically treated wood pulp such as MCC.

The respondent emphasized that MCC was a cellulosic fiber as disclosed in paragraph [0013] of the patent (*"For example cellulosic fiber used in the methods systems, and oral products provided herein can be CMC, HPMC, HPC, MCC or other treated cellulosic material"*) and as disclosed in the paragraph bridging pages 9 and 10 of PL2.

The respondent further argued that the expression "consisting of" in claim 1 only categorized the group of potential fibers. This is terminology used in US patent law. "Cellulosic fiber" merely comprised fibers of "wood pulp, cotton, sugar , etc.". It did not consist of "wood pulp, cotton, sugar , etc.".

1.3 The Board is not convinced by the arguments of the respondent.

Firstly, the Board notes that claim 1 is clear and that there is no contradiction between the subject-matter of claim 1 and paragraph [0013] of the patent.

Claim 1 defines the cellulosic fibers in (A) and (B) comprising fibers selected from an exhaustive list of materials and combination thereof. The expression "consisting of" limits the materials to the ones listed in the claim and their combinations.

Paragraph [0013] of the patent discloses cellulosic fibers used in the methods for forming an oral product. The first list of examples provided in paragraph [0013] encompass cellulosic fibers disclosed in claim 1. The second list of examples, which concerns the chemically treated cellulosic fibers has not been claimed. The first list of cellulosic fibers is distinct from the second list of chemically treated cellulosic fibers.

While Avicel may be a cellulosic fiber as disclosed in paragraph [0013] and may originate from wood pulp (reference is made to D7), the chemical treatment of the high-purity alpha-cellulose wood pulps resulting in Avicel (MCC) is such that a distinct product to what the skilled person understands under "wood pulp cellulosic fiber" is produced. As mentioned by the appellant, the structure and the composition of Avicel and wood pulp cellulosic fibers are very different.

Therefore, the subject-matter of claim 1 does not encompass MCC and the subject-matter of claim 1 is not anticipated by example 1 of D3.

2. Remittal to the Opposition Division

The respondent requested to remit the case to the Opposition Division if inventive step was to be discussed (point 4.2 of the respondent's reply to the statement of grounds of appeal). The appellant agreed with the respondent's request.

The Board noted that the Opposition Division did not give an opinion on the further novelty objections (apart from the novelty over D3) and the inventive step objections in the contested decision. Under these circumstances, special reasons present themselves for for remitting the case to the Opposition division.

Therefore, the Board remitted the case to the Opposition Division in agreement with the parties.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



M. Schalow

H. Geuss

Decision electronically authenticated