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**Datasheet for the decision
of 21 March 2025**

Case Number: T 2425 / 22 - 3.2.04

Application Number: 17184107.5

Publication Number: 3311681

IPC: A24D3/06

Language of the proceedings: EN

Title of invention:

SMOKING ARTICLE INCLUDING A FLAVOUR DELIVERY MEMBER

Patent Proprietor:

Philip Morris Products S.A.

Opponent:

Nicoventures Trading Limited

Headword:

Relevant legal provisions:

RPBA 2020 Art. 12(6)

EPC Art. 56, 83

Keyword:

Late-filed objection - error in use of discretion at first instance (no)

Inventive step - (yes)

Sufficiency of disclosure - (yes)

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 2425/22 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 21 March 2025

Appellant: Philip Morris Products S.A.
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
6 September 2022 concerning maintenance of the
European Patent No. 3311681 in amended form.

Composition of the Board:

Chairwoman K. Kerber-Zubrzycka
Members: S. Hillebrand
C. Kujat

Summary of Facts and Submissions

- I. The appeal was filed by the Opponent against the interlocutory decision of the Opposition Division finding that the patent in suit in an amended form according to auxiliary request 2d met the requirements of the EPC.

In particular, the Opposition Division held that

- the patent, on the basis of auxiliary request 2, disclosed the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
- the subject-matter of claim 1 according to auxiliary request 2 was novel and involved an inventive step;
- the subject-matter of claims 5, 7 and 14 according to this request extended beyond the content of the earlier application (auxiliary requests 2a - 2c also having at least one of claims 5, 7, 14);
- the subject-matter of the claims according to auxiliary request 2d did not extend beyond the content of the earlier application.

- II. In a communication pursuant to Rule 15(1) RPBA, the Board expressed the preliminary opinion that auxiliary request 2c complied with the provisions of the EPC.

- III. Oral proceedings were held before the Board on 21 March 2025 in the form of a videoconference with all parties participating remotely.
- During oral proceedings, the Board held only auxiliary request 2d allowable with regard to the provisions of Article 76(1) EPC and the proprietor withdrew their own appeal against the decision of the Opposition Division.

IV. The appellant (opponent) requests that the decision under appeal be set aside and that the patent be revoked.

The respondent (proprietor) requests that the appeal be dismissed, in the alternative that the decision under appeal be set aside and that the patent be maintained in amended form according to one of auxiliary requests 2e, 2f, 3, 3a - 3f, 4, 4a - 4f, 5, 5A - 5D, 6, 6A - 6D, 7, 7A - 7D, 8, 8A - 8D, of which 3, 3a - 3d, 4, 4a - 4d, 5, 5A, 5B, 6, 6A, 6B, 7, 7A, 7B, 8, 8A, 8B had already been submitted in opposition proceedings and the remaining auxiliary requests were filed with the proprietor's reply to the opponent's appeal.

V. Independent claim 1 of auxiliary request 2d reads as follows (designation of features added by the Board):

A A filter (103) for a smoking article (100), the filter comprising:

B a filter segment (201) comprising filter material (203) comprising fibres of continuous tow material, the filter segment (201) having a cross sectional area measured perpendicular to the longitudinal direction of the filter; and

C a flavour delivery member (205) embedded in the filter segment (201) and surrounded on all sides by the filter material (203),

D the flavour delivery member (205) comprising structural material enclosing liquid flavourant for flavouring smoke during smoking, wherein the flavour delivery member releases at least a portion of the liquid flavourant when the filter is subjected to external force;

E wherein a cross sectional area of the flavour delivery member (205) measured perpendicular to the longitudinal direction of the filter is about 30%, or greater, of the cross sectional area of the filter

segment (201),

F wherein the filter material (203) of the filter segment comprises fibres of between about 5.0 and about 12.0 denier per filament and between about 12000 and about 30000 total denier;

G and wherein the filter (103) comprises a space or cavity downstream or upstream or both downstream and upstream of the filter segment.

Claims 5, 6, 9 and 10 of auxiliary request 2d read as follows

5. A filter (103) according to any preceding claim, wherein the filter (103) comprises a hollow tube downstream or upstream or both downstream and upstream of the filter segment (201).

6. Use of a filter (103) according to any preceding claims in a smoking article (100) in which tobacco material is heated, rather than combusted, to form an aerosol.

9. A smoking article (100) according to claim 8, wherein the ventilation zone provides a degree of ventilation above about 60%.

10. A smoking article (100) according to any of claims 7 to 9, wherein the tobacco packing density in the smoking article is equal to or larger than about 200 mgcm³.

VI. In the present decision, reference is made to the following documents:

D1: US 2005/0066982 A1

D2: US 7 243 659 B1

D6: US 6 502 582 B1

D7: WO 2009/093051 A2

D8: US 2011/0271968 A1.

VII. The appellant's arguments can be summarised as follows: Further objections with regard to subject-matter added by dependent claims 5, 6, 9, and 10 of auxiliary request 2d, which were intended to be detailed during oral proceedings, should have been admitted by the Opposition Division.

The invention according to auxiliary request 2d is not sufficiently disclosed to be carried out by a person skilled in the art.

The subject-matter of its claim 1 does not involve an inventive step with regard to the disclosure of D1 and in the light of general knowledge as presented in D6, D7 and D8.

The respondent's arguments can be summarised as follows:

The further objections were filed at the very last moment during oral proceedings and not prima facie detrimental.

As found by the Opposition Division, auxiliary request 2d met the requirements of the EPC, in particular those of original disclosure, sufficiency of disclosure and inventive step. With regard to the latter, the appellant's arguments were based on hindsight.

Reasons for the Decision

1. The appeal is admissible.

2. The patent and its technical background

The patent deals with a filter for smoking articles, in which a capsule containing a liquid flavour is embedded. The filter comprises fibres of continuous tow material and a cavity (which can also be filled with any material).

The capsule has a relatively large cross-sectional area of more than 30% of that of the filter segment providing for some exciting effects and experiences according to paragraphs [0012] and [0013] of the patent. In any case, it can accommodate a relatively large amount of flavouring liquid within the filter. The accommodation of the big capsule in the filter is realised by embedding it in tow material with den values characteristic for a relatively low density.

3. Admission of further objections with regard to added subject-matter

3.1 In opposition proceedings, the appellant had raised objections against granted dependent claims 5, 7 and 14, which were also part of auxiliary request 2. These were considered and confirmed in oral proceedings by the Opposition Division, see sections 8, 8.1 and 8.2 of the minutes. As a consequence, auxiliary request 2d, which did not include these dependent claims, was found to meet the requirements of Article 76(1) EPC (section 8.3 of the contested decision). At this moment, the opponent raised for the first time further objections against dependent claims 5, 6, 9, 10 of auxiliary request 2d, which the Opposition Division did not admit as being late filed and not *prima facie* relevant, section 24 of the contested decision.

The Board shall not admit these objections unless the decision not to admit them suffered from an error in discretion, Article 12(6), first paragraph RPBA (any justifying circumstances not being apparent).

3.2 The amendment of claim 1 according to auxiliary request 2 did not give rise to new objections under Article 76(1) EPC, but cleared existing ones. Since the same objections against claims 5, 6, 9, 10 of auxiliary

request 2d would also apply to corresponding granted claims 6, 8, 11 and 12 (being part of auxiliary request 2 as well), oral proceedings did not provide the first opportunity to present them after discussion of the main request and auxiliary request 2, as argued by the appellant. They are definitely late-filed, because they could have been raised earlier together with the objections against the other dependent claims 5, 7 and 14 of the patent as granted and of auxiliary request 2.

- 3.3 The Board agrees with the Opposition Division that it is not prima facie evident without entering into further detailed examination of the parent application with regard to new aspects, that the additional features of the dependent claims in question were not disclosed in combination with the features of the independent claim. Even if claim 5 of auxiliary request 2d and claim 7 of the granted patent and auxiliary request 2 have some features (hollow tube) in common, the Opposition Division held the latter already to extend beyond originally disclosed subject-matter because it contained the same features as claim 5 of auxiliary request 2, without having taken a closer look at the disclosure of the tube feature.
- 3.4 Since the Opposition Division applied thus correctly the criteria of time of submission and prima facie relevance when deciding not to admit further objections against claims 5, 6, 9, 10 of auxiliary request 2d, these objections are also not part of the appeal proceedings.
- 3.5 According to the appellant, the Opposition Division should have exercised its discretion differently. It is, however, the very nature of discretion that it can be exercised differently, also known as "discretionary

power". A discretionary decision can only be challenged if it was taken in accordance with the wrong principles, without taking the right principles into account or in an arbitrary or unreasonable way, thereby exceeding the proper limits of the discretion (see CLB 10th edition 2022 V.A.3.4.1b).

4. **Sufficiency of disclosure**

4.1 In section 3 of its communication according to Article 15(1) RPBA, the Board gave the following preliminary opinion on this requirement.

"Presently, the Board follows the reasoning of the Opposition Division in section 15.2.2 of the impugned decision according to which the skilled person is aware of physical limits for embedding a relatively large flavour delivery member in fibres. In other words, the skilled reader would not take from the open-ended range given in claim 1 for the relation between the cross-sections of member and filter segment that also unrealistic values such as of over 90%, which can objectively not be carried out, were encompassed."

4.2 Since the appellant did not comment on this opinion and referred to their written submissions during oral proceedings, the Board confirms after a further review that the invention as defined by auxiliary request 2d is disclosed in a manner sufficiently clear and complete to be carried out by a person skilled in the art, Article 83 EPC.

4.3 **Inventive step**

4.4 Example 3 of D1, paragraph [0093] provides the most detailed description of a filter with similar features as in claim 1 and is therefore considered to represent

the closest prior art.

- 4.4.1 Example 3 refers to the filter of example 1 shown in figure 2. In its mouth-end tow cellulose acetate material a flavour capsule is inserted by hand such that the capsule is "imbedded". The capsule can be obtained from Mane Aromatic Flavors as reference E127384 (menthol). Such capsules are described in paragraph [0073] as being generally spherical in shape and comprising a rigid outer shell as structural material, in which liquid flavourant (medium chain tryglycerides and flavour agents) is enclosed, see also paragraph [0076]. They come in diameters of 3.5 mm or of 4 mm resulting in cross-sectional areas of about 9.6 mm² and 12.6 mm², respectively.
- 4.4.2 The diameter of the filter according to example 1 is not directly disclosed. However, the tobacco weight of about 0.600 g is indicative for a "normal" cigarette diameter of 7.6 mm or above (see D2, column 4, lines 19 - 21 and table 1). This is more at the side of a standard size diameter (about 8.6 mm) than at that of a slim size diameter (about 5.4 mm) as can be derived from the corresponding ranges of circumferences between 17 mm - 27 mm disclosed in paragraph [0032] of D1. Also when looking at the superslim product "Control" having a much lower rod weight of 416 mg according to the table of D7, pages 13/14, it can at least be excluded that the filter of example 1 is for such a slim product having a circumference of 16.8 mm at the lower end of the range according to paragraph [0032] of D1. But since the exact filter diameter of example 1 is not known, it cannot be determined with certainty whether its corresponding cross-sectional area is less than 70% of one of the capsule's known cross-sectional areas.

- 4.4.3 According to paragraph [0089] of D1, the mouth end tow material in which the capsule is embedded has fibres of 2.5 den per filament and 35000 den in total, both values being outside of the claimed ranges.
- 4.5 Therefore, the subject-matter of claim 1 differs from the filter according to D1, examples 3 and 1 at least in features E (ratio of cross-sections) and F (denier values).

The technical effects of the distinguishing features are presented in paragraphs [0012] to [0017] of the patent. Relatively large dimensions of the flavour delivery member are desirable for various reasons, i.a. because a user can easily locate and break the member in the filter. On the other hand, this increases the risk of damage during manufacture or handling and the resistance to draw (RTD) air through the filter, since a large cross-sectional area of the filter is completely blocked by the flavour delivery member. Furthermore, the filter material around the flavour delivery member tends to deform and build a bulge. The claimed ranges of denier per filament (between 5.0 and 12.0) and total denier (between 10000 and 30000) point towards less and thicker fibres, a lower total density providing a lower RTD compared to D1 whilst still providing sufficient structural support for the flavour delivery member (see paragraphs [0015], [0016] of the patent). According to paragraph [0017], the use of such more flexible filter material facilitates embedding of the flavour delivery member and prevents deformation of the filter around the member. The problem to be solved can therefore be considered as better adapting the filter of D1 to the incorporation of large flavour capsules, e.g. those with a diameter

of 4 mm or even higher.

- 4.6 In D1 itself, there is no hint or incentive to change the specific den values of example 1 (figure 2) in such a way that they would fall into the claimed ranges in order to achieve the above effects and solve the corresponding problem.

It might be generally suggested by D1, paragraph [0082] to swap the particle removal efficiency of mouth end and tobacco end filter sections 36, 38 of example 1 and thus the respectively used filter materials so that the mouth end filter section 36 would have a higher value of 8 den per filament and a total den of 32000 (paragraph [0089]). But this modification would not result in the subject-matter of claim 1, since the total den value would still be outside the claimed range of lower than 30000. More importantly, example 3 relies explicitly on example 1 and not on example 2, which embodies this alternative configuration, see paragraph [0091]. Therefore, D1 can even be considered as teaching away from the claimed solution.

- 4.7 The appellant draws on paragraph [0032] of D1, which reminds the person skilled in the art not to exclude smaller filter diameters of about 5,4 mm (corresponding to the disclosed circumference of 17 mm) and to consider a "slim" size for the filter of example 3. In a necessary second step, also the den values of the filter would then have to be adapted to those typically used for slim size cigarettes, which are within the claimed ranges.

This argumentation appears, however, to be based on the knowledge of the claimed ranges and a search for them in the prior art. Since the choice of a smaller filter diameter aggravates rather than solves the problems related to the integration of large capsules, it does

not seem to represent a straight-forward option for the skilled person.

- 4.8 The Board has no doubts that filter materials of low density and in particular having values of total den under 30000 were generally known at the priority date of the patent. This alone ("could") does, however, not motivate the person skilled in the art to modify the filter material of example 1 of D1 such that it falls within the claimed range ("would").
In particular, none of the cited documents D6 to D8 suggest that the filter materials disclosed therein provide advantages for filters containing relatively large flavour delivery members.
- 4.9 For the above reasons, the subject-matter of claim 1 according to auxiliary request 2d involves an inventive step in the light of the cited prior art.

5. **Result**

With their appeal, the opponent challenges without success the findings of the Opposition Division that auxiliary request 2d meets the requirements of the EPC, in particular those of Articles 83 and 56. Because the Opposition Division correctly exercised its discretion not to admit further objections under Article 76(1) EPC against auxiliary request 2d, this led to the dismissal of the opponent's appeal against the intermediate decision of the Opposition Division to maintain the patent in amended form of auxiliary request 2d.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairwoman:



G. Magouliotis

K. Kerber-Zubrzycka

Decision electronically authenticated