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**Datasheet for the decision
of 9 April 2025**

Case Number: T 2427/22 - 3.2.04

Application Number: 17167035.9

Publication Number: 3222159

IPC: A24F47/00, A61M15/06

Language of the proceedings: EN

Title of invention:
NON-BURNING TYPE FLAVOR INHALER

Patent Proprietor:
Japan Tobacco Inc.

Opponents:
Philip Morris Products S.A.
Weickmann & Weickmann Patent- und
Rechtsanwälte PartmbB

Headword:

Relevant legal provisions:
EPC Art. 100 (c), 76(1)

Keyword:

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

Decisions cited:

Catchword:



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Case Number: T 2427/22 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 9 April 2025

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
13 September 2022 concerning maintenance of the
European Patent No. 3222159 in amended form.**

Composition of the Board:

Chairman A. Pieracci
Members: S. Hillebrand
 C. Heath

Summary of Facts and Submissions

- I. The appeals were filed by opponent 1 and the patent proprietor against the interlocutory decision of the Opposition Division finding that the patent in suit, which stems from a divisional application, in an amended form according to auxiliary request 29 met the requirements of the EPC.

In particular, the Opposition Division held that

- the subject-matter of claim 1 according to the main request (as granted) and auxiliary requests 1 - 28 extended beyond the content of the earlier application and/or the application as filed;
- the subject-matter of claim 1 according to auxiliary request 29 did not extend beyond the content of either application and the scope of protection conferred by the patent.

- II. In a communication pursuant to Rule 15(1) RPBA, the Board expressed the preliminary opinion that not only the subject-matter of claim 1 as granted (main request), but also that of claim 1 as upheld by the Opposition Division (auxiliary request 29) appeared to extend beyond the content of the earlier application (Articles 100(c), 76(1) EPC). Furthermore, there was concern that granted claim 1 might have been limited to an undisclosed embodiment, thereby causing an unfortunate trap situation, in which re-establishment of Article 76(1) EPC's requirement of original disclosure would inevitably lead to an extension of the patent's scope of protection (Article 123(3) EPC) and thus to the revocation of the patent.

III. Oral proceedings were held before the Board in the form of a videoconference on 9 April 2025 with appellant-opponent 1 attending.

Party as of right opponent 2 and appellant-proprietor had announced with respective letters of 26 February 2025 and of 3 April 2025 that they would not attend. As both parties had been duly summoned, oral proceedings took place in their absence, Article 15(3) RPBA.

IV. Appellant-proprietor requests that the decision under appeal be set aside and that the oppositions be rejected, in the alternative that the patent be maintained on the basis of one of auxiliary requests 1 - 4, 4', 5, 6 - 24, 24', 25, 25', 26, 26', 27, 27', 28, 28', 29 - 31, of which 1 - 4 and 6 - 29 had already been submitted during opposition proceedings, 5 has been filed for the first time with the statement of grounds, 30 and 31 have been submitted with the reply to opponent 1's appeal brief and 4', 24' - 28' with letter of 31 July 2023.

Appellant-opponent 1 requests to set aside the decision under appeal and to revoke the patent. They request further not to admit any of auxiliary requests 1 - 28', 30, 31.

Party as of right opponent 2 also requests to set aside the decision under appeal, to revoke the patent and not to admit auxiliary request 5.

V. Independent claim 1 of the main request (patent as granted) reads as follows (designation of features added by the Board):

(A) A non-burning type flavor inhaler (100)

(B) configured to generate an aerosol atomized by

- (C) an atomizer comprising a heat source (80) without burning, comprising:
- (D) a power source (10) configured to supply power to the heat source (80);
- (E) a light-emitting element (40); and
- (F) a controller (50) configured to control the light-emitting element (40), characterized in that
- (G) the controller (50) controls the light-emitting element (40) in a predetermined light-emitting mode in a non-puff state not inhaling the aerosol, wherein the predetermined light-emitting mode comprises:
 - (G1) a first predetermined light-emitting mode applied until a number of puff reaches a certain number that is three or more,
 - (G2) a second predetermined light-emitting mode applied after the number of puff exceeds the certain number, and
 - (G3) the first predetermined light-emitting mode is different from the second predetermined light-emitting mode.

Dependent claims 2, 3 and 7 of the main request read as follows:

"2. The non-burning type flavor inhaler (100) according to claim 1, wherein the controller (50) terminates a control according to the predetermined light-emitting mode when the number of puff reaches a predetermined number which is a maximum number, for which the second predetermined light-emitting mode is applied, or more."

"3. The non-burning type flavor inhaler (100) according to claim 2, wherein the controller (50) is configured to turn off the power of the non-burning flavor inhaler (100) when a predetermined operation is performed by a user, even before the number of puff reaches the predetermined number."

"7. The non-burning type flavor inhaler (100) according to any one of claims 1 to 6, wherein the controller (50) is configured to turn off the non-burning type flavor inhaler (100) when the number of puff reaches a predetermined number which is a maximum number, for which the second predetermined light-emitting mode is applied, or more."

Claim 1 of auxiliary requests 1, 2, 4, 4', 5 - 7, 10, 14, 17, 19, 21, 22 comprises the features of granted claim 1 and the following respective features:

(1) "[A non-burning type flavor inhaler (100)] having a shape extending from a non-inhalation end toward an inhalation end along a predetermined direction";

(2) "[A non-burning type flavor inhaler (100) ... comprising:] said atomizer";

(4, 4') "... [the predetermined light-emitting mode comprises] ... and an emission start mode for notifying a user that puff action is ready to start, and the first predetermined light-emitting mode, the the second predetermined light-emitting mode and the emission start mode are different from each other";

(5) "... [the controller (50) controls the light-emitting element (40) in a predetermined light-emitting mode in a non-puff state not inhaling the aerosol] and a predetermined light-emitting mode in a puff state [, wherein the predetermined light-emitting mode] in a non-puff state [comprises: a first predetermined light-emitting mode]";

(6) "[A non-burning type flavor inhaler (100) configured to generate], for a puff action series, [an aerosol atomized by an atomizer comprising a heat source (80) without burning,] the puff action series consisting in repeating a predetermined number of puff actions";

(7) "wherein the second light-emitting mode is an

emission end mode to notify a user of the timing to end a puff action".

(10) "wherein when a predetermined time elapses after a number of puff actions exceeds a predetermined number, a heat source control unit (53) for controlling a power amount supplied to the heat source (80) is configured to turn off the non-burning type flavor inhaler(100)";

(14) "wherein the aerosol can be generated after transition to the second predetermined light-emitting mode";

(17) "wherein the controller (5) is configured to control the light-emitting element (40), when a number of puff actions reaches a predetermined number of puff actions, according to an emission end for notifying a user of the timing to end a puff action";

(19) "wherein the controller (50) is configured to turn off the non-burning type flavor inhaler (100) when the number of puff reaches a predetermined number of puff actions";

(21) "... [an aerosol atomized by an atomizer comprising a] single [heat source (80) without burning]";

(22) "wherein the heat source (80) is provided with a power amount by controlling a width of pulses of a voltage applied to the heat source (80)".

Claim 1 of auxiliary requests 3 and 15 comprises the features of granted claim 1, whereby the certain number of puffs that is three or more in feature G1 is respectively replaced by

(3) "... [a certain number that is] seven [or more];

(15) "... [a certain number that is] four [or more]".

Claim 1 of auxiliary requests 8, 9, 11 comprises the features of the following respective claims as granted:

(8) claims 1 and 2;

- (9) claims 1 and 7;
- (11) claims 1, 2 and 3.

Claim 1 of auxiliary requests 16, 18, 20, 21', 30 comprises the features of claim 1 according to auxiliary requests 4, 17, 16, 21, 4 and 5 respectively, and the following respective features:

- (16) (4) + "wherein the emission start mode precedes the first predetermined light-emitting mode";
- (18) (17) + "wherein the emission end mode is different from the first light-emitting mode and the second light-emitting mode"
- (20) (16) + "wherein the emission start mode is for notifying a user that a puff action is ready to start"
- (21') (20) + "[an atomizer comprising] only one [single heat source (80)]";
- (30) (4) + (5) + "wherein the first light-emitting mode is applied after the emission start mode and following a first puff".

Claim 1 of auxiliary requests 12, 13, 23, 24, 25, 26, 27, 28 combines the features of claim 1 according to the following respective auxiliary requests:

- (12) (1) + (2) + (3) + (4);
- (13) (4) + (7);
- (23) (16) + (22);
- (24) (5) + (15);
- (25) (6) + (16) + (24);
- (26) (6) + (17) + (19) + (24)
- (27) (10) + (19) + (22) + (25)
- (28) (1) + (2) + (17) + (27)

Claim 1 of auxiliary requests 24', 25', 26', 27', 28' correspond respectively to claim 1 of auxiliary requests 24, 25, 26, 27, 28 with the addition of the feature that "[the predetermined light-emitting mode] in a non-puff state [comprises]"

Claim 1 of auxiliary request 29 maintained by the Opposition Division and of auxiliary request 31 comprises the features of claim 1 according to auxiliary requests 24', 30, respectively, whereby the term "exceeds" in feature G2 is replaced by
(29) (24') + "[applied after the number of puff] reaches [the certain number]"
(31) (30) + "[applied after the number of puff] reaches [the certain number]".

VI. In the present decision, reference is made to the earlier application published as EP 3 039 973 A1.

VII. Appellant-proprietor's arguments can be summarised as follows:

The subject-matter of claim 1 is entirely backed up by original disclosure of the earlier application. In particular, the expression "until the number of puffs reaches three" does not mean until the point in time, at which the number of puffs reaches three, but rather as long as the number of puffs has not reached four, a third puff state being still "valid" during a following fourth non-puff state.

Leaving aside a first light-emitting mode in a puff state inhaling aerosol was based on paragraphs [0004], [0005], [0022], [0068], [0069] of the earlier application, which only describe the second light-emitting mode in a non-puff state figuring in claim 1. The Opposition Division's findings in relation to objection vi (missing shape of the inhaler) are not part of the appeal proceedings. They are furthermore correct since these features are neither relevant, nor limiting. Also a flexible tube extends along a predetermined direction.

The arguments of appellant-opponent 1 and opponent 2

can be summarised as follows:

The subject-matter of both, granted claim 1 and claim 1 of auxiliary request 29 upheld by the Opposition Division extend beyond the content of the earlier application for a variety of reasons. This applies also to all other auxiliary requests.

Reasons for the Decision

1. Both appeals are admissible.
2. **The patent and its technical background**
 - 2.1 The patent deals with a non-burning type flavour inhaler. As this could probably include a kind of medical inhaler with flexible tube and/or mask, the shape of the inhaler is defined in paragraph [0001] as extending from a non-inhalation end towards an inhalation end along a predetermined direction.
 - 2.2 The inhaler comprises conventional components such as an atomizer, which has a heat source for atomizing an aerosol source into aerosols, and a power source for the heat source. In addition, there is a light emitting element controlled by a controller in a first light-emitting mode in a puff state (hereinafter LEM-PS) different from a second light emitting mode in a non-puff state (hereinafter LEM-NPS), paragraph [0009]. The first mode LEM-PS can be constant or changing with the number of puffs and shall somehow symbolize the light of a burning cigarette during inhalation. The second mode LEM-NPS changes along with the number of puffs or puff actions so that a user can easily grasp a progress state in consumption of the aerosol source, paragraphs [0023], [0024].

2.3 The first and second light-emitting modes in granted independent claim 1 are, however, not the above LEM-PS and LEM-NPS, but a first and a second sub-mode of LEM-NPS. They are defined in granted claim 1 as

- applied until the number of puffs reaches a certain number which is three or more (first sub-mode, feature G1)
- applied after the number of puffs exceeds the certain number (second sub-mode, feature G2).

Puffs are also labelled "puff states" in the patent. They alternate with "non-puff states". A "puff action" seems to be composed of a non-puff state and the subsequent puff state.

3. **Framework of the appeal proceedings**

3.1 According to the appellant-proprietor, objection vi relating to the shape of the inhaler being absent in claim 1 was not part of the appeal proceedings because appellant-opponent 1 had not substantiated it in their statement of grounds, whereas opponent 2 was not in a position to challenge findings of the impugned decision being "party to the proceedings only as of right" (letter of 31 July 2023, section 1.4).

3.2 A party as of right to appeal proceedings as well as a respondent is of course entitled to challenge any reasoning of the Opposition Division in order to demonstrate that the outcome of the Opposition Division's decision was correct, even if for different reasons (CLB, 10th edition, V.A.2.4.3b), fourth paragraph). The appellant-proprietor is not adversely affected in terms of an inadmissible reformatio in peius by a different reasoning leading to the same conclusion with regard to added subject-matter as in the impugned decision. Consequently, the Board has

taken into account objection vi which has been duly raised by opponent 2 in their reply to the proprietor's appeal in section 2.1 of the communication according to Article 15(1) RPBA.

4. **Main request - added subject-matter**

4.1 In sections 2.1 to 2.4 of the above communication, the Board has dealt with the question whether there was a basis in the disclosure of the earlier application for omitting features from original claim 1 in granted claim 1, corresponding to the objections ii, iv, vi and "control unit" raised by the opponents. In particular, the Board had come to the preliminary conclusion that objections vi and ii concerning the omission of the shape of the inhaler and of the LEM-PS and were justified for the following reasons.

"2.1 Objection vi

The earlier application relates to a non-burning type flavour inhaler extending from a non-inhalation end toward an inhalation end along a predetermined direction (paragraphs [0001], [0007], [0020], [0024], claim 1, figure 1). There does not seem to be any suggestion towards other types of inhalers also suitable for inhaling flavoured substances and having other shapes, e.g. a flexible section in form of a flexible tube. These other types appear, however, to be encompassed by granted claim 1."

"2.4 Objection ii

2.4.1 According to original claim 1, the control unit controls the light-emitting element in a first light-emitting mode in a puff state inhaling the aerosol

(LEM-PS) and in a second light-emitting mode different from the first light-emitting mode in a non-puff state not inhaling the aerosol (LEM-NPS). The first light-emitting mode LEM-PS has been omitted in granted claim 1 along with the feature that it is different from the second mode LEM-NPS still figuring in granted claim 1. Although the aspect of being different has been raised separately as objection ix against auxiliary request 29 (see point 3.2, below), it appears to be sensible to the Board to deal with both objections relating to the same feature of original claim 1 in one go.

2.4.2 There does not seem to be any basis for an inhaler not having two different light emitting modes LEM-PS and LEM-NPS in the earlier application. In case that the LEM-PS mode is not constant but changes depending on the number of puff actions as claimed for the LEM-NPS, the concept of change may be basically the same in both modes, e.g. increasing or decreasing the number of light emitting elements, the amount of light, changing the colour of emitted light, paragraphs [0068] - [0071]. However, also in this case the LEM-PS still seems to be different from the LEM-NPS e.g. with regard to the amount of light, the number of light-emitting elements, their colour, a sequence of turning on and off the elements, paragraphs [0063] - [0067], [0007], [0009], [0010], [0021] of the earlier application."

4.2 Appellant-proprietor did not comment on this preliminary view in writing and did not attend oral proceedings. After a further review, the Board confirms its findings in section 2.6 of its communication that the subject-matter of claim 1 according to the main request extends beyond the content of the earlier application (Articles 100(c), 76(1) EPC) because claim 1 covers an inhaler

- the shape of which does not extend from a non-inhalation end toward an inhalation end along a predetermined direction (objection vi);
- comprising a control unit which does not control the light emitting element in a light-emitting mode in a puff state (LEM-PS) different from the pre-determined light-emitting mode in a non-puff state (LEM-NPS) (objections ii, ix).

4.3 For the sake of completeness, the Board wishes to clarify that it did not and does not agree with the main lines of the appellant-proprietor's arguments with regard to objections vi and ii.

In particular, the Board holds that a flexible section in form of a flexible tube does not extend along a predetermined direction (objection vi).

Furthermore, paragraphs [0004], [0005] of the earlier application describe prior art and paragraphs [0022], [0068], [0069] do not present the LEM-NPS as singular or alternative light emitting mode, but consistently as second mode provided in addition to and being different from the first mode LEM-PS, see the paragraphs cited above in the context of objections ii, ix (section 2.4.1 of the communication).

5. **Auxiliary requests - added subject-matter**

5.1 Irrespective of the non-admission of some of the auxiliary requests requested by the opponents (point IV, above), none of them complies with the provisions of Article 76(1) EPC for at least one of the above reasons.

5.2 Claim 1 of auxiliary requests 2 - 4, 4', 5 - 11, 13 - 24, 24', 25, 25', 26, 26', 27, 27', 29 - 31 does not define the shape of the inhaler (objection vi), claim 1

of auxiliary requests 1 - 4, 4', 6 - 23 does not include the LEM-PS (objection ii) and claim 1 of auxiliary requests 24, 24', 25, 25', 26, 26', 27, 27', 28, 28', 29 to 31 does not specify that the LEM-NPS is different from the LEM-PS (objection ix).

6. **Result**

With their appeal, opponent 1 successfully challenges the findings of the Opposition Division that the subject-matter of auxiliary request 29 meets the requirements of the EPC, in particular those of Article 76(1) EPC. Consequently, the corresponding interlocutory decision of the Opposition Division to maintain the patent in the amended form of auxiliary request 29 has to be set aside. That also the subject-matter of claim 1 according to all other requests submitted by the appellant-proprietor extends beyond the content of the earlier application leads to the revocation of the patent.

There is no reason for staying the present proceedings until **G 1/24** is decided, as suggested by appellant-proprietor in their letter of 8 April 2025 since the above grounds do neither rely on claim interpretation in the light of the description and figures in general, nor on section 2.5.4 of the communication under Article 15(1) RPBA dealing with objections iii and vii (number of puffs) in particular.

Order

For these reasons it is decided that:

- 1. The decision under appeal is set aside.**
- 2. The patent is revoked.**

The Registrar:

The Chairman:



G. Magouliotis

A. Pieracci

Decision electronically authenticated