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**Datasheet for the decision  
of 8 October 2025**

**Case Number:** T 1160/23 - 3.2.04

**Application Number:** 16806064.8

**Publication Number:** 3364797

**IPC:** A24F40/46, A24F40/485

**Language of the proceedings:** EN

**Title of invention:**

HEATING SYSTEM AND METHOD FOR AN INHALER DEVICE

**Patent Proprietor:**

JT International SA

**Opponent:**

Philip Morris Products S.A.

**Headword:**

**Relevant legal provisions:**

EPC Art. 54, 56, 123(2), 84

EPC R. 80

RPBA 2020 Art. 13(2), 12(2), 12(4), 12(6)

**Keyword:**

Amendment occasioned by ground for opposition - (yes)

Novelty - (yes)

Inventive step - (yes)

Late-filed objection - should have been submitted in first-instance proceedings (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**

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**Chambres de recours**

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Case Number: T 1160/23 - 3.2.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.04**  
**of 8 October 2025**

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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
14 April 2023 concerning maintenance of the  
European Patent No. 3364797 in amended form.**

**Composition of the Board:**

**Chairman** A. Pieracci  
**Members:** J. Wright  
T. Bokor

## **Summary of Facts and Submissions**

- I. The appeal was filed by the opponent against the interlocutory decision of the opposition division finding that, on the basis of the auxiliary request 5'', the patent met the requirements of the EPC. The proprietor also lodged an appeal against the above decision. It subsequently withdrew its appeal (see point III. below), so it is now respondent.
- II. The opposition division decided that the subject matter of the claims as amended during the opposition proceedings was novel and involved an inventive step, that the claims as amended were clear and that their subject matter did not extend beyond the content of the application as filed.
- III. In preparation for oral proceedings, the Board issued a communication, dated 27 August 2025, setting out its preliminary opinion on the relevant matters. Oral proceedings before the Board were held on 8 October 2025. During the oral proceedings, the proprietor withdrew its appeal.
- 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, that is that the patent be maintained according to the version held allowable by the opposition division, auxiliary request 22' in appeal, in the alternative that the patent be maintained in amended form according to one of auxiliary requests 22'', 23, 24, 24', 25, 25', 26, 26' and 27.

V. The independent claim of auxiliary request 22' reads as follows:

"A cartridge comprising a supply reservoir (40) and a heating system (1) for an inhaler device (30), such as an e-cigarette or a personal vaporizer, for generating an aerosol or a vapour from a liquid (L) to be heated, the system comprising: at least one supply channel (3) for conveying a liquid to be heated from the supply reservoir (4) under capillary action or surface tension forces within the at least one channel (3), wherein the at least one supply channel (3) is formed or provided in a body member (2) which is configured to extend from the supply reservoir (4) to a vapour chamber (35) in the inhaler device (30) from which the aerosol or vapour is inhaled; and heating means (10) arranged at an outlet (6) of the at least one supply channel (3) and configured to heat the substance as it emerges from the outlet (6) of the at least one channel (3); characterized in that the heating means (10) comprises at least one electrical heating element (11) which is arranged substantially outside of the supply channel (3) and extends across an outlet opening (8) of the supply channel (3), wherein the body member (2) includes a groove or recess (9) at an outlet of each supply channel (3) for accommodating the at least one electrical heating element (11), wherein the groove or recess (9) preferably extends transverse to a longitudinal extent of the supply channel, further wherein the body member is attached to or incorporated in a housing of the cartridge which forms the reservoir (4) for storing or holding the liquid."

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

D1: EP 0 893 071 A1

D4: EP 3 127 441 A1

D5: WO 2011/042212 A1

D7: WO 2015/086316 A1

VII. The arguments of the parties relevant to the decision are set out below in the reasons for the decision.

### **Reasons for the Decision**

1. The appeal is admissible.

2. Auxiliary request 22' (as maintained), Rule 80 EPC

2.1 The appellant-opponent argued that the feature setting out that the groove or recess "preferably extends transverse to a longitudinal extent of the supply channel" defines an optional feature having no limitation on the claim, so objectively it cannot be seen as an appropriate and necessary response to overcoming a ground for opposition, Rule 80 EPC.

2.2 The respondent-proprietor argued that the amendment in question was essentially the incorporation of all the features of original claim 5 (groove or recess) into a new independent claim, including both its non-optional and optional features. By doing so, so it argued, the amendment overcame grounds of opposition under Article 100(a) EPC whilst avoiding possible problems of added subject matter under Article 123(2) EPC.

- 2.3 Rule 80 EPC sets out that: Without prejudice to Rule 138 EPC, the description, claims and drawings may be amended, provided that the amendments are occasioned by a ground for opposition under Article 100 EPC, even if that ground has not been invoked by the opponent. According to established jurisprudence (see Case Law of the Boards of Appeal, 11th edition, 2025 (CLBA) IV.C. 5.1.2 a), amendments [can] be refused if they [are] neither appropriate nor necessary.
- 2.4 It is not in dispute that claim 1 is amended by incorporating limiting technical features of original claim 5 (groove or recess), which objectively are seen as overcoming the ground of opposition under Article 100(a) EPC. Indeed, the opposition division decided that this claim overcame that opposition ground whereas it had found higher ranking requests did not.
- 2.5 The objection under Rule 80 EPC can therefore only concern the apparently optional feature added to the present claim. This part was present, word for word, in original claim 5. The Board agrees with the respondent-proprietor that, by incorporating all the features of original claim 5, essentially unamended, into the new independent claim, the amendment itself is more certain to avoid adding subject matter extending beyond the application as filed than might otherwise have been the case had some hypothetical amendment incorporated some but not all features of original claim 5 into the independent claim. That in making this amendment apparently optional features, already present in the application as filed, were incorporated into the new independent claim, does not change the fact that it is a more certain and thus appropriate way of ensuring no subject matter extending beyond the application as filed is added by way of an intermediate

generalisation. In this regard, the Board sees the amendment as a necessary and appropriate way of arriving at this certitude.

Therefore, the Board considers that the amendment meets the requirements of Rule 80 EPC.

3. Auxiliary request 22', claim 1, added subject-matter

3.1 In its communication, section 17.3, with reference to section 11, in particular 11.1, the Board considered the matter of added subject matter and found the arguments of the appellant-opponent not to be convincing. Section 17.3 reads as follows:

"17.3 Auxiliary request 22', added subject matter

17.3.1 The appellant-opponent raises an added subject-matter objection against this request by reference to part of its grounds of appeal. In particular it argues that there is no basis for the claim feature: "wherein the body member (2) includes a groove or recess (9) at an outlet of each supply channel (3) for accommodating *the at least one electrical heating element* (11) [...]", because in original claim 5 the feature reads: "wherein the body member (2) includes a groove or recess (9) at an outlet of each supply channel (3) for accommodating *the heating element* (11) [...]"[emphasis added by the Board]. In this regard, the appellant-opponent also cites the original description, page 3, lines 15 to 17 which use the term "the at least one heating element" but in conjunction with *the outlet region* of each supply channel rather than merely the outlet. The point being that the amendment changes the singular definite article "the" to "the at least one", thus including a plurality.

In the Board's view, when the skilled person reads the term "the heating element" in original claim 5 they would understand it to be "the at least one heating element" due to its back-referenced to claim 4 and thus to claim 1, where there the only heating element mentioned is the "at least one heating element (11)".

Were the skilled person to have any doubts about this (though the Board sees none), this seems to be consistent with what is written on page 3, lines 15 to 17, but for the change of the term "outlet" to "outlet region", which seems in the description to at least include "the outlet" (cf. the proprietor's reply to the opponent's appeal, point D, 2.2).

Therefore the added subject-matter objection of the appellant-opponent is not convincing.

17.3.2 The Board is also not convinced by the appellant-opponent's objection that there is no direct and unambiguous disclosure of a body member with a groove or recess as part of a cartridge in the application as filed. Rather, the Board agrees with the assessment of the opposition division (see reasons, 8.2.2) that this is to be found in the general part of the description, in particular on page 3, lines 12-25. Read in context, this belongs to the summary of the invention, page 1, line 29 to page 5, line 27, which discloses various possible embodiments of the heating system. One of these (page 3, lines 15 to 18) includes the groove or recess feature. On page 4, lines 10 to 15, a further idea is introduced: "In a preferred embodiment, the heating system is combined with or incorporated in a cartridge or reservoir assembly for the inhaler device or e-cigarette."

In the Board's view, the skilled person would understand from this paragraph that the heating system, using the definite article was the same heating system in its various forms and embodiments already mentioned in the preceding parts of the summary of the invention. Therefore, the Board considers that there is a direct and unambiguous disclosure of a cartridge comprising a heating system with a body member comprising a groove or recess, amongst other things, whether or not this feature can be identified in figures 6 to 11 of the application as originally filed.

17.3.3 The appellant-opponent has also raised the added subject-matter objection which it raised for auxiliary request 2.

In its appeal grounds, point 9.2.1.2, the appellant-opponent refers to point 4.2 of the same document, which is concerned with auxiliary request 2. As the Board has already explained in this communication (see section 11.1 [\*]), it is not convinced by the argument of the appellant-opponent that the feature "the at least one supply channel (3) is formed or provided in a body member (2) [...]" adds subject-matter extending beyond the application as filed".

3.2 \*The relevant parts of section 11 of the communication are reproduced below. They concern the same issue of added subject matter raised for auxiliary request 2' as was raised for auxiliary request 2:

"11. Auxiliary request 2, claim 1, added subject-matter

The opposition division found the subject-matter of auxiliary request 2 to meet the requirements of Article

123(2) EPC (see the impugned decision, reasons, section 4). The opponent challenges this finding (see its reply to the proprietor's appeal, section 5.2 and its appeal grounds section 4.2).

11.1 The challenge concerns whether there is a basis for the claim feature "the at least one supply channel (3) is formed or provided in a body member (2) [...]". The opponent argues that *formed* has a different meaning from *provided* in the application as filed. In particular, at least one channel is formed has a basis in several parts of the application as filed (for example claim 4), whereas there is only a basis for the term *provided* where *multiple channels* are concerned, namely on page 8, lines 13 to 16: "The heating system I comprises a body member 2 in which a plurality of supply channels 3 are provided or formed for conveying the liquid [ . . . ]" .

11.1.1 In the Board's view, giving terms their usual meaning and considering their context of defining a device, there would appear to be no difference between a channel or channels being *provided* and being *formed* in a body. In both cases the term defines a body in which a channel or channels is/are integrated. In other words the Board sees the terms as synonyms when read in their present claim context.

11.1.2 The appellant-opponent does not argue that this might not be the case. Rather, it argues that the terms have a special meaning in the description of the application as filed, the one (provided) only being used for a plurality of channels whereas the other (formed) being used for single or for multiple channels. Both defining that a channel or channels are integrated in the body.

11.1.3 The Board does not consider that the skilled person would attach any significance to how the terms (provided or formed) are used in the description in conjunction with whether one channel or more than one channel is concerned. This is all the more true since the application as filed (page 8, lines 13 to 16) appears to use both terms alternatively, that is as synonyms, in the case of multiple channels. Therefore, the Board does not find the opponent's argument convincing,

11.2 From the foregoing, the Board agrees with the opposition division's finding that auxiliary request 2 does not add subject-matter extending beyond the content of the application as filed."

3.3 Neither in written nor oral proceedings did the appellant-opponent comment on these aspects of the communication. Having reviewed the issue again, the Board confirms its preliminary opinion that the appellant-opponent's arguments are not convincing and so the opposition division's finding that auxiliary request 22' (then auxiliary request 5''') does not add subject matter extending beyond the application as filed is to be upheld.

4. Auxiliary request 22', clarity

4.1 In its communication (see sections 17.4 and 12), the Board considered that the clarity objections raised by the appellant-opponent were either not convincing or should have been raised in the opposition proceedings. The Board wrote the following in section 17.4:

"17.4 Auxiliary request 22', clarity

The appellant-opponent raises the same two clarity issues it raised against auxiliary request 2 (formed/provided and configured to extend...). As the Board has explained earlier in this communication (section 12 [\*\*]), it does not find the first of these convincing and intends not to admit the second of these into the proceedings because it could and indeed should have been raised in the opposition proceedings".

4.2 \*\*Section 12 of the communication, to which section 17.4 refers, reads as follows:

"12. Auxiliary request 2, claim 1, clarity,  
Article 84 EPC

12.1 The opposition division found that the amendments to auxiliary request 2 did not introduce a lack of clarity (see the impugned decision, section 4.2). In particular, the division did not consider that the terms formed/provided as used in the independent claims lead to the definition of two alternative embodiments (sub-section 4.2.3). The opponent takes the contrary view, leading to its identifying an inconsistency between the claims and the description where the terms are used to describe a single embodiment. This, according to the opponent, leads to a lack of clarity.

12.1.1 In the Board's view, the opposition division were correct to find that the terms formed/provided do not lead to the independent claims defining two embodiments. The division's finding boils down to it considering their being used as synonyms in the claim. As the Board has already explained above in the context of added subject-matter, it likewise sees *formed* and

*provided* as being used *synonymously* in the claims. Therefore, the argument of the opponent is moot.

12.2 In its reply to the proprietor's appeal, section 5.3 with its appeal grounds (section 4.3.1.10 to 4.3.1.12), the opponent raises a further clarity objection, namely against the claim feature of the body member being "configured to extend from the supply reservoir (4) to a vapour chamber (35)".

12.2.1 This objection appears to have been raised for the first time in appeal proceedings. According to the undisputed minutes of the oral proceedings (see section 9.1), the only clarity objection raised against this request related to the terms *formed/provided*. Nor is the Board aware of any clarity issues having been raised by the opponent or the opposition division for auxiliary request 2 in written proceedings.

12.2.2 However, the opponent has not identified this objection as being an amendment to its case. In the Board's view, the opponent could and indeed should have raised the objection in opposition proceedings, at the latest at the oral proceedings before the opposition division, had it wished to have the issue considered by the Board. Therefore, the Board does not intend to admit this objection into appeal proceedings, Articles 12(2) and 12(4) and 12(6) RPBA".

4.3 Neither in written nor at oral proceedings, did the parties comment on these aspects of the communication. Having reviewed them again, the Board decided to maintain the preliminary opinion expressed in its communication. Therefore, the Board considers that the appellant-opponent's objection that the terms *formed/provided* in claim 1 lead to a lack of clarity are moot.

Furthermore, it decided not to admit the clarity objection concerned with the body member being "configured to extend from the supply reservoir (4) to a vapour chamber (35)" into the proceedings.

5. Auxiliary request 22' (as maintained), novelty with respect to D4

5.1 In its communication, the Board addressed this issue in section 17.5. The Board was of the opinion that the opposition division had rightly found that D4 did not take away novelty of claim 1. Neither of the parties commented on this aspect of the communication in writing, nor at the oral proceedings before the Board. Rather, they referred to their written submissions.

5.2 In its communication, section 17.5, the Board wrote the following:

"17.5 Auxiliary request 22', novelty with respect to D4

The appellant-opponent argues with reference to the embodiment of figure 12. In this arrangement, the mouthpiece portion 34 can be considered to be a cartridge. The appellant-opponent agrees that, in this arrangement, the cartridge does not comprise the heating means 28. However, it refers to D4, paragraph [0053] which states that the mouthpiece portion may include the heating coil 28.

It then refers to a different embodiment - that of figure 2 with paragraph [0031] - where it is stated that the heating wire 28 may be located at least partially in the second open end 52 [of the capillary tube 46 shown in figure 2]. The appellant-opponent then

considers that locating the heating wire in the tube implies that it is mounted in a groove or recess.

In the Board's view, howsoever the arrangement of figure 2's embodiment may be, it does not constitute a direct and unambiguous disclosure of how the embodiment of an alternative arrangement of what is shown in figure 12 must be. Already for this reason, the argument of the appellant-opponent is not convincing.

Moreover, the Board is not convinced that, in order to partially locate a heater wire in a capillary tube a groove or recess is necessarily implied. Rather it agrees with the opposition division (impugned decision, reasons, point 9.1.2) that a heater wire can be partly located in a tube whilst being supported in a different way, such as by means of an external fixing element. Therefore, it is not implicit that D4 discloses a groove or recess as claimed.

For these reasons, the arguments of the appellant-opponent have not convinced the Board that the opposition division was wrong to find that the subject matter of claim 1 of auxiliary request 22' (5''' in opposition proceedings) was novel".

- 5.3 Having reviewed this part of the communication the Board sees no reason to deviate from its preliminary opinion. Therefore, the Board confirms the opposition division's finding that D4 does not take away novelty of claim 1.
6. Auxiliary request 22' (as maintained), claim 1, inventive step starting from D5 with the skilled person's common general knowledge

6.1 It is not disputed that D5 discloses a heating system for an inhaler device, for generating an aerosol and a supply channel for conveying liquid from a reservoir under capillary action or surface tension. As the opposition division explained (impugned decision, reasons, section 2.1.1), D5, figure 2 shows a heating system for an inhaler such as an e-cigarette or vaporiser. The arrangement has a supply channel (capillary tube 1; surrounding [wicking] layers 2, 3) for conveying a liquid 5 to be heated from a supply reservoir (storage at the bottom in figure 2) under capillary action or surface tension forces within the at least one channel. The Board adds that this is described in D5: abstract and page 4, second paragraph.

6.2 In its decision (see reasons, section 9.2), the opposition division considered that the subject matter of claim 1 differed from D5, not only in that the elements claimed were comprised in a cartridge, but also in that the body member included a groove or a recess at an outlet of each supply channel for accommodating the at least one electrical heating element.

The opposition division considered that, whilst it would be obvious from the skilled person's general knowledge to put elements of D5's aerosol generator in a cartridge, D5 did not render obvious the idea of a groove or recess: "since the supply channel of D5 is made of wicking material, which typically is soft and flexible, even in the event that a heating element was partially embedded in the supply channel, the skilled person would not necessarily link it with the presence of a groove" (see point 9.2.2, last sentence of the reasons of the appealed decision).

6.3 In its appeal, the opponent maintained that D5 disclosed a body member including a groove or a recess accommodating the at least one electrical heating element, the latter being arranged substantially outside the supply channel as defined in the claim. In this regard, the appellant-opponent argued that D5 disclosed a heating element which is *partially* embedded in the wicks 2 and 3 on page 3, last paragraph, first sentence: "The heating element may comprise a wire mesh heater embedded in a downstream end of the wicks", in conjunction with figure 2. According to the appellant-opponent, a groove or recess would be created by the soft wicks in the supply channels deforming to receive the partially embedded heating element, which, being only *partially embedded*, remains substantially outside the supply channel, as the claim requires.

6.4 The argument is predicated on the premise that D5 directly and unambiguously discloses the heating element to be *partially* embedded in the wicks. The Board is not convinced that this is the case.

6.4.1 The appellant-opponent argued that, when the skilled person reads the word "embedded" in the cited sentence, they understand it to cover a heating element which is wholly or *partially embedded*.

It may well be that the skilled person understands that the word *embedded* could be applied to a heater classed as being partially or completely embedded. Assuming this to be so, it is more general than either specific class. According to established jurisprudence, a generic disclosure does not take away the novelty of the disclosure of a species or subclass. Therefore, read on its own, the cited "embedded mesh heater" sentence on page 3 does not directly and unambiguously

disclose that the heating element is *partially* embedded in the wicks.

6.4.2 Nor is the Board convinced that the skilled person's understanding would be different when reading the sentence in conjunction with the information conveyed by figure 2. Figure 2 shows the heating element 7 to be completely outside the wicking material 2 and 3, so it is not even partially embedded. However, the citation on page 3 of the description might suggest it can be embedded in the wicking material. Contrary to how the appellant-opponent has argued, the skilled person would not unambiguously understand from these two, apparently antithetical, pieces of information a hybrid configuration where the heating element was partially embedded in the wicking material and partially outside it. Rather, at most the skilled person might understand that there could be an alternative arrangement to what is actually shown in figure 2 where the heating element could be somehow embedded in the wicks 2 and 3. However, as with the text taken on its own, this would not be a direct and unambiguous disclosure of a heating element which was *partially* embedded.

6.4.3 By the same token, the Board is not convinced by the opponent's argument that, in the sentence discussed above ([...] a wire mesh heater embedded in a downstream end of the wicks), the wording "downstream end" points to the embedding being *partial*. This is because, the wording "downstream end" itself is ambiguous: It may designate a downstream region of the wicks adjacent to their extremities, or the extremities themselves. If the former is meant, the heating element could be completely embedded in this region of the wicks. Therefore, it cannot be inferred that the heating element is partially embedded in the wicks,

simply because this happens at the *downstream end* of the wicks.

6.5 Consequently, the Board is not convinced that D5 directly and unambiguously discloses a heating element partially embedded in the wicks. Since D5's disclosing the latter was the premise on which the appellant-opponent built its argument that D5 could disclose a groove or recess accommodating a heating element that is also arranged substantially outside the supply channel, the argument is not convincing. Therefore, the appellant-opponent's inventive step objection starting from D5 with common general knowledge fails.

7. Auxiliary request 22' (as maintained), claim 1, inventive step starting from D1 with the skilled person's common general knowledge

7.1 It is not disputed that D1 discloses a supply reservoir (liquid container 32) and a heating system (heater frame 94 with heater plate 76) for an inhaler device (see for example column 10, lines 3 to 15 with figure 7). The Board considered the question of inventive step starting from D1 in section 19 of its communication. The Board wrote the following:

"19. Auxiliary request 22', claim 1, inventive step starting from D1

19.1 The opposition division (see the impugned decision, reasons, section 9.3) found that D1 did not disclose a cartridge nor that it disclosed a heating element arranged substantially outside the supply channel. The appellant-opponent does not dispute the question of obviousness of this feature but rather

argues that it is disclosed in D1's figure 7 embodiment.

19.2 In this regard, the appellant-opponent cites column 10, lines 3 to 15 and appears to consider that the supply channels 36 end at the top of the liquid container 32 so that the heater frame 92, with its plate heaters is positioned substantially outside the supply channels.

19.3 Read in context, the Board agrees with the proprietor (see its reply to the opponent's appeal, pages 30 and 31) that the figure 7 embodiment is a modification of the embodiment of figure 5 (which also has a plate-like heater). There the heater plate 76 is entirely within the supply channel 36. Moreover, as the proprietor also points out, the passage cited by the appellant-opponent defines that "Furthermore, air passageways 94 are formed between adjacent capillary tubes 36 arranged in the heater frame 94 in a manner to extend in the longitudinal direction of the capillary tube." As seen in figure 7, because these air passages are both in the frame 94 and between the tubes 36, the tubes 36 must extend completely through the frame 94, so that the [heating element] plate 76 is completely contained within the tubes 36, rather than being substantially outside them as claimed.

19.4 The appellant-opponent (appeal grounds 9.4.4.2, 9.4.4.4 and 9.4.4.5) has also emphasised that the frame 92 is mounted to the outlet ports 36a, arguing on this basis that the heater frame 94 must be over the ports 36a, resulting in the heater plates being substantially outside the supply channels 36 as claimed.

19.5 In the Board's view, the cited passage (column 10, lines 3 to 15) appears to erroneously refer to the outlet ports 36a of the tubes 36 in figure 7. The Board agrees with the proprietor (see its reply to the opponent's appeal, section 5.3.1.4) that, as best seen in D1, figure 1, the capillary tube 36 has an inlet port 36a (in the liquid container 32) and an outlet port 36b, where vapour is produced. Whilst the reference 36a cannot be seen on figure 7, the reference 36b can. It coincides with the far end of the heater frame 92, with its heater plate 76. In other words, the frame is not fitted on top of the tubes 36 to cover their outlet ports but the tubes 36 extend completely through the heater frame 92 and have outlet ports [36b] flush with the top of the heater frame.

19.6 Therefore, the arguments of the appellant-opponent have not convinced the Board that D1 discloses a heater element arranged substantially outside a supply channel. Consequently, the appellant-opponent's arguments do not demonstrate that the opposition division were wrong to find the subject-matter of claim 1 to involve an inventive step starting from D1".

7.1.1 Thus the preliminary opinion expressed in the Board's communication was negative for the appellant-opponent. Neither in written proceedings nor at the oral proceedings did the appellant-opponent comment on this part of the opinion. Having reviewed it, the Board also sees no reason to deviate from it. Therefore, the Board confirms that D1 does not disclose a heater frame 92 that is fitted on top of the tubes 36 to cover their outlet ports but rather that the tubes 36 extend completely through the heater frame 92 and have outlet ports flush with the top of the heater frame.

7.1.2 Thus, contrary to how the appellant-opponent argued in its appeal grounds, the Board finds that D1 does not disclose a heating element 76 arranged substantially outside the supply channels 36 by way of its being positioned above them.

7.2 At the oral proceedings before the Board, the appellant-opponent argued for the first time, with reference to figure 7, that if the heating elements 76 ended at the top of the supply channels (tubes 36), as the Board had contended in its preliminary opinion, then the heating elements would still be arranged substantially outside the supply channels due to them passing laterally through the supply channels and then extending sideways beyond them.

7.2.1 The appellant-opponent argued that this new argument was not an amendment to its case because it did not change the position expressed in its appeal grounds that D1's heating element was arranged substantially outside the channels.

7.2.2 It may be true that the appellant-opponent's position (D1 discloses heating elements substantially outside the channel) is common to its arguments brought before the opposition division and in appeal proceedings. However, this commonality extends only to their conclusions, the argument brought at the oral proceedings is nevertheless new. This is because the same conclusion is arrived at by a significantly different and as such new interpretation of D1. In particular, the opponent asserts a new spatial relationship between D1's heating element 76 and its channels (tubes 36): namely that the former passes through and extends laterally from the tubes whereas hitherto the opponent had always asserted that the

heating element 76 was not *in* the tubes 36 but rather wholly outside and above them.

- 7.2.3 This new argument thus embraces a new geometric interpretation of D1's heating system compared to what the opponent had previously presented. Therefore, contrary to the appellant-opponent's view, the Board considers the argument to be an amendment to its case.
- 7.2.4 Being made after the Board's communication, the amendment is subject to the Board's discretion to admit it under Article 13(2) RPBA, according to which [it] shall, in principle not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.
- 7.2.5 In the present case, the appellant-opponent argued that such exceptional circumstances existed because the Board's communication had expressed a negative opinion on its arguments in its appeal grounds on inventive step starting from D1. In particular (see the communication, section 19.6) those arguments had not convinced the Board that D1 disclosed a heater element arranged substantially outside a supply channel. In consequence, the Board considered that the appellant-opponent's arguments did not demonstrate that the opposition division were wrong to find the subject-matter of claim 1 to involve an inventive step starting from D1.
- 7.2.6 In the Board's view, the fact that the Board was not convinced by the appellant-opponent's challenge in its appeal grounds to the opposition division's finding against it in opposition proceedings, does not constitute an exceptional circumstance. Rather, it is a normal circumstance in which the present proceedings

developed as a result of the Board reviewing the impugned decision in the light of the parties appeal submissions and formulated its preliminary opinion, without introducing new issues (see CLBA, V.A.4.5.4.f).

- 7.2.7 For these reasons, the Board decided not to admit the appellant-opponent's new argument (D1's heater element is *in* the channels yet its lateral extension makes it *substantially outside* of them), that was first brought at the oral proceedings before the Board, Article 13(2) RPBA.
- 7.3 In the light of the above, the Board confirms the provisional opinion expressed in its communication that the appellant-opponent's arguments do not demonstrate that the opposition division was wrong to find that the subject-matter of claim 1 involves an inventive step starting from D1.
8. Auxiliary request 22' (as maintained), claim 1, inventive step starting from D7 with the skilled person's common general knowledge or with D5
- 8.1 The Board considered these matters in its communication (see sections 20 and 21). The Board wrote the following:
- "20. Auxiliary request 22', claim 1, inventive step starting from D7 with the skilled person's general knowledge
- 20.1 It is not disputed that D7 discloses a cartridge for an E-cigarette inhaler (see page 11, lines 5 to 28 and page 15, lines 1 to 3). The main elements can be seen in figures 1 and 5. A heating system for the inhaler generates an aerosol. It comprises a supply

channel 6 which conveys a liquid L to be heated from a reservoir 4 by capillary action or surface tension (see page 12, lines 2 and 3).

20.2 The opposition division considered (see its decision, reasons, bottom half of page 21) that D7 did not disclose a groove or recess or an electrical heating element arranged substantially across an outlet opening of the supply channel, with which the proprietor agrees (reply to opponent's appeal, page 34, 5.4.1).

20.3 The appellant-opponent sees the second heating zone 15 in the annular cavity 16 as a groove or recess in the vapour chamber 20 in which the second heating element 18 is accommodated.

20.4 As to the appellant-opponent's argument that there may in fact be no difference between the subject-matter of claim I and D7 because its heating coil 18 may extend across the outlet opening, this appears to be a new case, boiling down to a novelty objection which was not raised in the opposition proceedings (see the undisputed minutes, page 11, top of page 11). The Board sees no reason as to why this should be admitted into the appeal proceedings, Articles 12(4) and 12(6) RPBA.

For completeness, the Board adds that it is not convinced that the feature is even ambiguously hinted at in D7: Figure 1 is a schematic drawing so the skilled person would not expect the heater wire 18, shown as round dots, to necessarily be depicted on the same scale as the other parts of the device. Moreover, the device of figure 1 is shown in more detail in figure 5 (see page 10 lines 7 and 8) and in that figure

the coils 18 are not shown near, let alone extending across the channels 6.

20.5 Without prejudice to the question as to whether D7 discloses a groove or recess at an outlet of the supply channel, the differing claim feature would be one of at least one electrical heating element extending across an [channel] outlet opening. In this regard, the arguments of the appellant-opponent have not convinced the Board that the decision erred in finding D7 would not be prejudicial to maintenance of the patent when considered as the starting document for assessing inventive step. (cf. decision, reasons 9.3).

20.6 According to the appellant-opponent (appeal grounds, points 9.4.5.10- 9.4.5.12), the effect of this feature would be to reduce the length of the second heating zone and so the objective technical problem can be formulated as how to [modify D7 to] provide a more compact heating system. The appellant-opponent argues that it would be obvious to solve this problem and thus arrive at this differing feature simply by moving the heating coil 18 to extend across the outlet openings 6.

20.7 The Board first notes that nothing in the patent specification explains that the effect of having the heating element extend across an outlet opening of the supply channel makes the device more compact. Paragraph [0009] of the patent merely says that this arrangement is preferred. Paragraph [0011] seems to suggest that this would mean that the heating element could be arranged outside the supply channel which is already the case in D7.

20.8 The appellant-opponent has argued (appeal grounds 9.4.5.11) that moving the coil 18 from where it is

located wound around the central core of the body 7 would imply that the latter could be made shorter. This does not convince the Board that, objectively, this would solve the technical problem of making a heating system more compact (opponent's appeal ground, point 9.4.5.12).

20.8.1 If it is true that moving the heater coil 18 from where it is arranged along the length of the body 7 would allow the devices length to be reduced, by the same logic, it would require a greater dimension (width) at its new position. Therefore, the objective technical problem proposed (making D7's device more compact) is not convincing. Therefore, the Board considers that the appellant-opponent's inventive step argument is moot.

20.9 In the light of this, it can be left undecided whether (opponent's appeal grounds, point 9.4.5.15) D7's teaching (page 5, lines 24 to 28) that the heating element 18 may be something different than a coil would lead the skilled person to think its location could be different, or whether mounting the heating element across the outlet openings would be straightforward.

21. Auxiliary request 22', claim 1, inventive step starting from D7 in combination with D5

21.1 According to the undisputed minutes of the oral proceedings before the opposition division (points 21.1 to 21.4), no objection was raised against this request starting from D7 in combination with D5. Nor is it reflected in the impugned decision. Therefore, it would seem to the Board that the appellant-opponent raises it for the first time in its appeal grounds (page 21, section 9.4.6), contrary to Article 12(2) RPBA.

21.2 Therefore, the Board finds that the objection is an amendment to the appellant-opponent's case, albeit one which the appellant-opponent has neither identified as an amendment nor provided reasons for submitting it for the first time in appeal, Article 12(4) RPBA.

21.3 The Board sees no reason as to why this objection could not have been raised in the opposition proceedings, indeed the Board thinks it should have been, had the opponent wished to have it considered in the appeal proceedings. Therefore, it intends not to admit it into the appeal proceedings, Article 12(6) RPBA.

21.4 It follows that the appellant-opponent's arguments have not demonstrated to the Board that the opposition division was wrong to decide that the patent in amended form according to auxiliary request 22' meets the requirements of the EPC. This means that the Board is of the opinion that both appeals should be dismissed."

8.2 In the absence of any comments from the parties in writing and at the oral proceedings before the Board to sections 20 and 21 of its communication, and having reviewed them, the Board confirms that the arguments of the appellant-opponent have not convinced the Board that the opposition division (see its decision, reasons section 9.3) erred in finding that inventive step starting from D7 was not prejudicial to maintaining the patent in amended form according to auxiliary request 22' (5'' in opposition). Moreover, the Board confirms its provisional opinion by deciding that the inventive step objection starting from D7 in combination with D5 is not admitted into the proceedings, Articles 12(4) and 12(6) RPBA.

9. Since none of the objections of the appellant-opponent against the opposition division's decision to maintain the patent in an amended form according to what is now auxiliary request 22' succeed, the Board must dismiss the appeal. Therefore the Board has no reason to examine or decide on any of the respondent-proprietor's lower ranked requests.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:



G. Magouliotis

A. Pieracci

Decision electronically authenticated