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**Datasheet for the decision
of 31 March 2025**

Case Number: T 0386/24 - 3.2.04

Application Number: 19157427.6

Publication Number: 3504989

IPC: A24F40/00, A61M15/06, H05B1/02,
A61M11/04

Language of the proceedings: EN

Title of invention:
VAPORIZATION DEVICE SYSTEMS

Patent Proprietor:
Juul Labs International Inc.

Opponents:
Philip Morris Products S.A.
Smokeless.world GmbH
Nicoventures Trading Limited

Headword:

Relevant legal provisions:
EPC Art. 100(c), 76(1)
RPBA 2020 Art. 13(2)

Keyword:

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

Divisional application - subject-matter extends beyond content of earlier application (yes)

Amendment after summons - exceptional circumstances (no) - taken into account (no)

Decisions cited:

Catchword:



Beschwerdekammern
Boards of Appeal
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Case Number: T 0386/24 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 31 March 2025

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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
29 February 2024 concerning maintenance of the
European Patent No. 3504989 in amended form.

Composition of the Board:

Chairman A. Pieracci
Members: C. Kujat
M. Millet

Summary of Facts and Submissions

- I. The appeals lie from the interlocutory decision of the opposition division of the European Patent Office concerning maintenance of the European Patent No. 3 504 989 in amended form pursuant to Articles 101(3)(a) and 106(2) EPC.

The opposition division held inter alia that the patent as amended according to Auxiliary Request 20 (corresponding to Auxiliary Request 7 in the appeal proceedings) and the invention to which it related met the requirements of the EPC.

- II. The appellant proprietor requests that the decision under appeal be set aside and the patent be maintained as granted, or alternatively on the basis of auxiliary requests 1 to 7 filed with their grounds of appeal, or on the basis of auxiliary requests 8 to 127, filed with their reply of 5 November 2024, or on the basis of auxiliary requests 128 to 137, filed with letter of 12 March 2025.

The opponent 1 as appellant requests that the decision under appeal be set aside and that the European patent No. 3 504 989 be revoked.

The opponent 2 as a party to the appeal proceedings as of right has not submitted any comments or requests.

The opponent 3 as a party to the appeal proceedings as of right requests that the appeal be dismissed.

III. In preparation for oral proceedings the board issued a communication pursuant to Article 15(1) RPBA setting out its provisional opinion on the relevant issues. Oral proceedings were duly held on 31 March 2025 in the presence of the proprietor and opponent 1 as appellants, as well as opponent 3 as party as of right. With their letter of 24 March 2025, respondent opponent 2 informed the board that they would not attend the oral proceedings.

IV. Independent claim 1 of the relevant requests reads as follows (the feature references used by the parties are indicated in square brackets):

Main Request (patent as granted)

"**[F1]** A device for generating an inhalable aerosol, the device comprising:

[F1.1] a device body comprising a cartridge receptacle (21) having a notched body;

[F1.2] a separable cartridge (30) configured to be inserted into the cartridge receptacle (21), and

[F1.3] an airflow path comprising:

[F1.3.1] a channel (40) comprising a portion of an air inlet passage (51);

[F1.3.2] a second air passage (41) in fluid communication with the channel;

[F1.3.3] a heater chamber (37) in fluid communication with the second air passage (51);

[F1.3.4] a first condensation chamber (45) in fluid communication with the heater chamber (37);

[F1.3.5] a second condensation chamber (46) in fluid communication with the first condensation chamber (45);
and

[F1.3.6] an aerosol outlet (47) in fluid communication with the second condensation chamber (46);

[F1.4] wherein a channel air inlet (50) through which air enters the air inlet passage (51) is left exposed when the separable cartridge (30) is inserted into the notched body of the cartridge receptacle (21)."

Auxiliary Request 1

Claim 1 is as claim 1 for the Main Request but with feature F1.4 amended by additionally including the following feature:

"[F1.4.1] the notched body has a notch, wherein a size of the channel air inlet is defined by a configuration of the notch".

This amendment is referred to as **amendment A-I**.

Auxiliary Request 2

Claim 1 is as claim 1 for the Main Request but with feature F1.2 amended by additionally including the following feature:

"[F1.2.1] wherein the separable cartridge comprises an airflow path".

Further, features F1.1, F1.2 and F1.3 are adapted accordingly. This amendment is referred to as **amendment A-II**.

Auxiliary Request 3

Claim 1 is as claim 1 for the Main Request but with the features of granted claim 2 included in claim 1. These features are divided into four features F2.1 to F2.4:

"**[F2.1]** wherein the cartridge comprises a fluid storage compartment (32) and
[F2.2] wherein the channel (40) is integral to an exterior surface of the cartridge,
[F2.3] wherein the channel forms a first side of the air inlet passage (51),
[F2.4] and wherein an internal surface of the cartridge receptacle (21) in the device forms a second side of the air inlet passage (51) when the cartridge is inserted into the cartridge receptacle."

This amendment is referred to as **amendment A-III**.

Further, granted claim 3 is deleted. This amendment is referred to as **amendment A-IV**.

Auxiliary Request 4

Claim 1 is as claim 1 for the Main Request but with amendments A-I and A-II.

Auxiliary Request 5

Claim 1 is as claim 1 for the Main Request but with amendments A-I, A-III and A-IV.

Auxiliary Request 6

Claim 1 is as claim 1 for the Main Request but with amendments A-II, A-III and A-IV.

Auxiliary Request 7 (corresponding to Auxiliary Request 20 underlying the impugned decision)

Claim 1 is as claim 1 for the Main Request but with amendments A-I to A-IV.

Auxiliary Request 8

Claim 1 is as claim 1 for the Main Request but with feature F1.2 amended by additionally including the following feature:

"[F1.2.2] *wherein the cartridge receptacle (21) and the separable cartridge (30) form a separable coupling, wherein the separable coupling comprises a friction assembly, a snap-fit assembly or a magnetic assembly, and"*

This amendment is referred to as **amendment A-V**.

Auxiliary Request 9

Claim 1 is as claim 1 for Auxiliary Request 8 but with amendment A-I.

Auxiliary Request 10

Claim 1 is as claim 1 for Auxiliary Request 8 but with amendment A-II.

Auxiliary Request 11

Claim 1 is as claim 1 for Auxiliary Request 8 but with amendments A-I and A-II.

Auxiliary Request 12

Claim 1 is as claim 1 for the Main Request but with amendment A-IV.

Auxiliary Request 13

Claim 1 is as claim 1 for the Main Request but with amendments A-I and A-IV.

Auxiliary Request 14

Claim 1 is as claim 1 for the Main Request but with amendments A-II and A-IV.

Auxiliary Request 15

Claim 1 is as claim 1 for the Main Request but with amendments A-I, A-II and A-IV.

Auxiliary Request 16

Claim 1 is as claim 1 for Auxiliary Request 8 but with amendment A-IV.

Auxiliary Request 17

Claim 1 is as claim 1 for Auxiliary Request 16 but with amendment A-I.

Auxiliary Request 18

Claim 1 is as claim 1 for Auxiliary Request 16 but with amendment A-II.

Auxiliary Request 19

Claim 1 is as claim 1 for Auxiliary Request 18 but with amendment A-I.

Auxiliary Request 20

Claim 1 is as claim 1 for Auxiliary Request 16 but with amendment A-III.

Auxiliary Request 21

Claim 1 is as claim 1 for Auxiliary Request 20 but with amendment A-I.

Auxiliary Request 22

Claim 1 is as claim 1 for Auxiliary Request 20 but with amendment A-II.

Auxiliary Request 23

Claim 1 is as claim 1 for Auxiliary Request 22 but with amendment A-I.

Auxiliary Request 24

Claim 1 is directed to a combination of granted claims 1, 2 and 6. Claim 3 is deleted. This amendment is referred to as **amendment A-VI**.

Auxiliary Request 25

Claim 1 is as claim 1 for Auxiliary Request 24 but with amendment A-I.

Auxiliary Request 26

Claim 1 is as claim 1 for Auxiliary Request 24 but with amendment A-II.

Auxiliary Request 27

Claim 1 is as claim 1 for Auxiliary Request 24 but with amendment A-V.

Auxiliary Request 28

Claim 1 is as claim 1 for Auxiliary Request 24 but with amendments A-I and A-II.

Auxiliary Request 29

Claim 1 is as claim 1 for Auxiliary Request 24 but with amendments A-I and A-V.

Auxiliary Request 30

Claim 1 is as claim 1 for Auxiliary Request 24 but with amendments A-II and A-V.

Auxiliary Request 31

Claim 1 is as claim 1 for Auxiliary Request 24 but with amendments A-I, A-II and A-V.

Auxiliary Request 32

Claim 1 is as claim 1 for the Main Request but with feature F1.2 amended (amendment highlighted by the board):

"[F1.2'] a separable cartridge (30) configured to be inserted into the cartridge receptacle (21) in an opened state of the separable cartridge (30)".

This amendment is referred to as **amendment A-VII**.

Auxiliary Request 33-63

Claim 1 of these requests is as claim 1 for Auxiliary Requests 1-31 but with amendment A-VII.

Auxiliary Request 64

Claim 1 is as claim 1 for the Main Request but with the following feature added at the end of the claim:

"wherein the separable cartridge (30) is inserted into an open end of the cartridge receptacle (21) so that exposed first heater contact tips (33a) on heater contacts (33) of the separable cartridge (30) make contact with second heater contacts (22) of the device body, thus forming the device."

This amendment is referred to as **amendment A-VIII**.

Auxiliary Request 65-127

Claim 1 of these requests is as claim 1 for Auxiliary Requests 1-63 but with amendment A-VIII.

Auxiliary Request 128

Claim 1 is based on claim 1 of Auxiliary Request 7 and requires in addition that "[a size of the channel air inlet (50) is defined by a configuration of the notch] and by interaction of the channel (40) and the notch".

Auxiliary Request 129

Claim 1 is a combination of Auxiliary Requests 23 and 128.

Auxiliary Request 130

Claim 1 is a combination of Auxiliary Requests 31 and 128.

Auxiliary Request 131

Claim 1 is a combination of Auxiliary Requests 63 and 128.

Auxiliary Request 132

Claim 1 is a combination of Auxiliary Requests 127 and 128.

Auxiliary Request 133

Claim 1 is based on claim 1 of Auxiliary Request 7 and requires in addition that "[a size of the channel air inlet (50) is defined by a configuration of the notch and by interaction of the channel (40) and the notch] as shown in Figure 14".

Auxiliary Request 134

Claim 1 is a combination of Auxiliary Requests 23 and 133.

Auxiliary Request 135

Claim 1 is a combination of Auxiliary Requests 31 and 133.

Auxiliary Request 136

Claim 1 is a combination of Auxiliary Requests 63 and 133.

Auxiliary Request 137

Claim 1 is a combination of Auxiliary Requests 127 and 133.

- V. The relevant submissions of the parties will be discussed in detail in the reasons for the decision.

Reasons for the Decision

1. The appeal is admissible.
2. *Main Request; Auxiliary Requests 2, 3 and 6 - Amendments*

The appellant proprietor disputes the decision's finding that there is added subject-matter in the form of an unallowable intermediate generalisation in feature F1.4 of claim 1 according to the Main Request.

- 2.1 The opposition division came to the conclusion that feature F1.4 did not imply that the notch of the notched body exposes the channel air inlet. In their view, this limitation was inextricably linked to feature F1.4 in the context of the original disclosure because the feature was present in figure 14 and derivable from the last sentence in paragraph [00170], see paragraph 4.6.5 of the impugned decision.

2.2 It is common ground that claim 1 of the Main Request is based inter alia on a combination of claim 159 and paragraph [00170] of the earlier application WO 2015/100361 A1. It is also common ground that the pod mentioned in this paragraph is the separable cartridge in claim 1. The paragraph reads as follows:

"[00170] Referring to FIG. 14, it is apparent in the plan view that when the pod 30a is inserted into the notched body of the cartridge receptacle 21, the channel air inlet 50 is left exposed. The size of the channel air inlet 50 may be varied by altering the configuration of the notch in the cartridge receptacle 21."

2.3 During the oral proceedings before the board, the appellant proprietor declared to rely on their written submissions. According to their grounds of appeal, claim 1 implies that the notch exposes the channel air inlet because that is how the skilled person construes feature F1.4 (bridging paragraph between pages 11 and 12 of the statement of grounds of appeal: "... For the skilled person, the meaning of feature 1.4 is that the air inlet passage is left exposed since the body is a notched body, i.e., the notch of the notch body leaves the air inlet passage exposed. ..."). The board disagrees with the appellant proprietor that the exposure of the channel air inlet is a consequence of the insertion of the cartridge into the cartridge receptacle (see the second paragraph on page 15 of their statement of grounds of appeal). The board would accept such a consequence if the conjunction "if" were used in the claim. However, the conjunction "when" in claim 1 has a broader meaning, since it can also be understood in a temporal manner, i.e. expressing what occurs when an action happens. Thus, another sensible

reading of feature F1.4 is that the channel air inlet is left exposed at the time when the cartridge is inserted into the receptacle, but for other reasons than the presence of the notch in the receptacle. See e.g. the example of an "always-exposed" channel air inlet in paragraph 4.6.4 of the impugned decision. Summarizing the above, the board is not convinced that the only sensible reading of claim 1 is that the presence of the notch in the cartridge receptacle leads to the channel air inlet being left exposed.

- 2.4 However, the earlier application only discloses a specific exposure of the channel air inlet. The reason is that the first sentence of paragraph [00170] does not refer to a general air inlet, but to "the channel air inlet 50" (emphasis added by the board), i.e. the inlet shown in figure 14. Due to this explicit reference to figure 14, the features mentioned in paragraph [00170] must be considered as they are shown in that figure. The statement "the channel air inlet 50 is left exposed" in the first sentence of the paragraph refers to the plan view of figure 14, where this exposure is only depicted in a specific way, i.e. the notch in the cartridge receptacle 21 leaves the channel air inlet 50 exposed. Therefore, figure 14 does not provide a basis for an air inlet being left exposed in a general manner. Instead, the exposure of the channel air inlet is inextricably linked to the notch causing this effect. As granted claim 1 does not contain this link, it is directed to an unallowable intermediate generalisation of the joint disclosure of paragraph [00170] and figure 14 of the earlier application. As a consequence, claim 1 of the Main Request contains subject-matter which extends beyond the earlier application as filed, Articles 100(c) and 76(1) EPC.

2.5 During the oral proceedings before the board, the appellant proprietor declared to rely on their written submissions for Auxiliary Requests 1 to 6. It is common ground that the amendments A-II, A-III and/or A-IV in claim 1 of Auxiliary Requests 2, 3 and 6 do not affect feature F1.4, see pages 39 and 40 of the appellant-proprietor's reply of 5 November 2024. Therefore, the above objection applies to these requests *mutatis mutandis*.

3. *Auxiliary Requests 1, 4, 5, 7 to 127 - Amendments*

Auxiliary Request 7 corresponds to Auxiliary Request 20 underlying the impugned decision, see the penultimate paragraph on page 80 of the appellant-proprietor's statement of grounds of appeal. Appellant-opponent 1 disputes the decision's finding that there is no added subject-matter in claim 1 of this request, see paragraph 44 of the impugned decision.

3.1 Amended claim 1 of Auxiliary Request 7 contains inter alia feature F1.4.1, i.e. that *"the notched body has a notch, wherein a size of the channel air inlet is defined by a configuration of the notch"*. According to the appellant-proprietor, this amendment is disclosed in paragraph [00170] of the earlier application, see page 73 of their statement of grounds of appeal. In that respect, they particularly referred to the second sentence during the oral proceedings before the board and stated that all written information from said paragraph is contained in claim 1 of Auxiliary Request 7. The board does not share this view, because there is no literal disclosure of the term "define" in that paragraph. Instead, the second sentence of said paragraph reads: *"The size of the channel air inlet 50*

may be varied by altering the configuration of the notch in the cartridge receptacle 21."

3.2 In the absence of a literal disclosure of feature F1.4.1 in the earlier application, the board must determine the meaning of the term *"a size of the channel air inlet is defined by a configuration of the notch"*:

3.2.1 The board does not follow appellant-opponent 1 in that the term "define" excludes anything but what is explicitly mentioned in feature F1.4.1. Instead, the definition "to determine or identify the essential qualities or meaning of" in the Merriam-Webster Dictionary confirms that other factors may be admitted in defining the size of the channel air inlet. This definition is cited on page 14 of the proprietor's reply of 5 November 2024.

3.2.2 According to the appellant-proprietor, the term "define" in feature F1.4.1 merely has the meaning "is influenced by". In their view, the inclusive nature of that term allows for other factors which determine the size of the channel air inlet apart from the configuration of the notch mentioned in paragraph [00170]. The board disagrees, because it understands the definition in the Merriam-Webster dictionary in the sense that other admitted factors may only determine non-essential qualities. Applied to the definition of the size of the channel air inlet in feature F1.4.1, its essential qualities must still be determined by the configuration of the notch, while other potential factors may only have an impact on non-essential qualities of the channel air inlet.

- 3.2.3 This is not what a person skilled in the art derives from paragraph [00170].
As argued by opponent 1 (see the grounds of appeal, page 15 last paragraph) and discussed at the oral proceedings paragraph [00170] merely states that a size of the channel air inlet 50 may be varied by altering the configuration of the notch. This however does not exclude that other components apart from the notch can also affect substantially the size of the channel air inlet and thus that other components might also participate in defining the size of the channel air inlet, which does not correspond to the interpretation of feature 1.4.1 given above.

The board thus concludes that paragraph [000170] does not provide a direct and unambiguous disclosure of feature 1.4.1.

This conclusion is reached by the Board without needing to consider, to the benefit of the patent proprietor, to which extent figure 14 affects the teaching of the second sentence of paragraph [000170].

- 3.2.4 As a consequence, claim 1 of Auxiliary Request 7 contains subject-matter which extends beyond the earlier application as filed, Article 76(1) EPC.
- 3.3 With regard to Auxiliary Requests 1 to 6, the appellant proprietor declared during the oral proceedings before the board that they rely on their written submissions. Claim 1 of Auxiliary Requests 1, 4 and 5 also contains feature F1.4.1, see the table on page 44 of the appellant-proprietor's reply of 5 November 2024, where this is referred to as Amendment A-I. Therefore, the above objection applies to these requests *mutatis mutandis*.

3.4 During the oral proceedings, the appellant proprietor agreed with the board that none of Auxiliary Requests 8 to 127 overcomes the objection against feature F1.4.1. As the above objection applies to these requests *mutatis mutandis*, appellant-opponent 1's request of non-admission of Auxiliary Requests 33 to 63 and 65 to 127 does not need to be decided by the board.

4. *Auxiliary Requests 128 to 137 - Admissibility*

4.1 The appellant-proprietor filed auxiliary requests 128 to 137 with their letter of 12 March 2025 after the board had issued its communication pursuant to Article 15(1) RPBA. They request admission of these requests into the proceedings with the argument that there are exceptional circumstances due to new added-matter objections raised by the board in its communication, namely that claim 1 "seems to cover e.g. an embodiment in which a channel air inlet in the form of a trough (upstream from the air inlet passage) is located only in the cartridge receptacle and interacts with the notch such that the size of the trough (e.g. its length or width) is defined by the notch" (section 3.7 of the board's communication) and that "feature 1.4 is structurally and functionally linked to other features of the airflow path shown in figure 14" (section 2.5 of the board's communication).

The exceptional circumstances in the sense of Article 13(2) RPBA for admitting auxiliary requests 128 to 137 into the proceedings are present, so the patent proprietor, even if the objections are not essential for the Board to decide against the patent proprietor. This is so because the course of the proceedings has still been influenced by the objections raised in the communication of the board.

4.2 The board disagrees. As clearly apparent from what is outlined above, the board has not based its decision on the objections discussed in the board's communication which have been contested by the patent proprietor. The allegedly new objections in the board's communication thus do not provide as such exceptional circumstances in the sense of Article 13(2) RPBA justifying the filing of further auxiliary requests, since there is no link between such objections and the decision taken against the previous auxiliary requests.

4.3 Even if it were correct that the course of the proceedings has been influenced by the allegedly new objections raised by the board in its communication, this would still not provide exceptional circumstances in the sense of Article 13(2) RPBA.

The opinion of the board can change from what was preliminarily communicated to the parties pursuant to Article 15(1) RPBA and this in general does not give rise to exceptional circumstances as long as the board adheres to the admissible case of one of the parties on which the other parties could (and possibly should) have already reacted. This is the situation of the present case, in which the board in its decision follows the objection raised by opponent 1 in its statement setting out the grounds of appeal against the patent as maintained (see page 15 and 16, point 5.1.8.3), even if this issue was not addressed in the board's communication.

- 4.4 As the board's decision on unallowable amendments in the Main Request and in Auxiliary Requests 1 to 128 is based on arguments already contained in appellant-opponent 1's statement of grounds of appeal, there are no exceptional circumstances in the present case. The board therefore does not admit Auxiliary Requests 128 to 137 into the proceedings, Article 13(2) RPBA.
5. In conclusion, the board holds that claim 1 of the Main Request contains subject-matter which extends beyond the earlier application as filed, contrary to Articles 100(c) and 76(1) EPC. Further, claim 1 of Auxiliary Requests 1 to 127 contains subject-matter which extends beyond the earlier application as filed, contrary to Article 76(1) EPC. As present Auxiliary Request 7 corresponds to Auxiliary Request 20 in the opposition proceedings, the impugned decision must be set aside. Furthermore, Auxiliary Requests 128 to 137 were not admitted into the proceedings, Article 13(2) RPBA. Since all requests fail, the patent must be revoked.

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