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**Datasheet for the decision
of 20 March 2026**

Case Number: T 1265/24 - 3.2.01

Application Number: 17899488.5

Publication Number: 3586652

IPC: A24D3/04, A24D1/00, A24D1/02

Language of the proceedings: EN

Title of invention:
SMOKING ARTICLE PROVIDED WITH FILTER

Patent Proprietor:
Japan Tobacco, Inc.

Opponent:
Grünecker Patent- und Rechtsanwälte PartG mbB

Headword:

Relevant legal provisions:
EPC Art. 54, 112
EPC R. 103(1) (a)
RPBA 2020 Art. 11

Keyword:

Novelty - unusual parameter

Referral to the Enlarged Board of Appeal - (no) - uniform application of law - point of law of fundamental importance

Reimbursement of appeal fee - (no) - substantial procedural violation (no)

Remittal - (yes)

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 1265/24 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 20 March 2026

Appellant:
(Patent Proprietor)

Japan Tobacco, Inc.
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Representative:

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Respondent:
(Opponent)

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80802 München (DE)

Representative:

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Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office posted/
electronically transmitted on 14 August 2024
concerning maintenance of the European Patent
No. 3586652 in amended fo rm.**

Composition of the Board:

Chairman

G. Pricolo

Members:

M. Geisenhofer

O. Loizou

Summary of Facts and Submissions

I. The appeal was filed by the patent proprietor (appellant) against the interlocutory decision of the opposition division finding that, on the basis of the auxiliary request 29, the patent in suit met the requirements of the EPC.

II. Independent claim 1 of the patent as granted reads as follows:

*"A smoking article (1) provided with a filter (12) comprising:
an aerosol generating member (11);
a filter (12) comprising a filter material (121) and one or more filter wrappers (122) wound around an outer circumferential surface of the filter material; and
an outer wrapper (13) wound around the outer circumferential surfaces of an end part of the aerosol generating member and the filter;
characterised in that
the outer circumferential surface of the outer wrapper has an arithmetic mean roughness of less than 2.0 μm ,
and
the filter wound with the outer wrapper has a compression recovery of 60% or more after a compression load of 2.5 N is applied to a range of a length of 10 mm in the diameter direction thereof."*

III. In the contested decision, the opposition division held that since the parameters "arithmetic mean roughness" and the "compression recovery" were unusual parameters, the features of the characterising portion of claim 1 were inherently present in the prior art and were to be disregarded in the substantive analysis of the claim

(cf. reasons for the decision 2.1.1, last paragraph).
On that basis, the opposition division concluded that
any one of documents

D1 WO 2015/108078 A1,
D2 JP 2016 523565 A,
D10 WO 2016/063182 A1 and
D12 EP 2 740 370 A1

disclosed smoking articles according to granted
independent claim 1.

The opposition division further held that the subject-
matter of claim 1 of auxiliary requests 1 - 28 lacked
novelty over at least one of documents D1, D2, D10 and
D12, or at least lacked an inventive step over these
documents.

IV. Oral proceedings were held before the Board.

(a) The appellant (patent proprietor) requested that
the decision under appeal be set aside, the
opposition be rejected and the patent be maintained
as granted (main request), or in the alternative
that the patent be maintained in amended form based
on one of auxiliary requests 1 - 28 filed with the
statement of grounds.

They further requested reimbursement of the appeal
fee.

(b) The respondent (opponent) requested that the appeal
be dismissed and as an auxiliary request that the
questions posed with letter of 4 November 2025 be
referred to the Enlarged Board of Appeal.

Both parties further requested as an auxiliary measure the remittal of the case to the opposition division.

V. The appellant's arguments (as far as they were relevant for the present decision) can be summarized as follows:

- (a) The parameters "arithmetic mean roughness" and "compression recovery" used in claim 1 of any of the requests were not unusual parameters.
- (b) Even if a parameter was unusual, it could not be simply ignored when assessing novelty as done by the opposition division in their decision.
- (c) The burden of proof did not shift to the patent proprietor but was still with the opponent, who had to demonstrate that the claimed subject-matter was anticipated by the prior art.
- (d) There was no need to seek clarification on the question when a parameter is unusual by referring questions to the Enlarged Board of Appeal.
- (e) The subject-matter of claim 1 was novel over D1, D2, D10 and D12, respectively.

VI. The respondent's arguments (as far as they were relevant for the present decision) can be summarized as follows:

- (a) The parameters "arithmetic mean roughness" and "compression recovery" were unusual parameters in the technical field of producing cigarettes.

- (b) If the Board intended to depart from established case law, then the questions formulated on page 2 and 6 of the letter dated 4 November 2025 should be referred to the Enlarged Board of Appeal.
- (c) In case of unusual parameters, the burden of proof was with the patent proprietor to demonstrate that the prior art did not disclose them.
- (d) There were anyway strong presumptions and pointers in the prior art that the "arithmetic mean roughness" and "compression recovery" of the products disclosed in D1, D2, D10 and D12, respectively, were within the ranges given in claim 1. Hence these documents anticipated novelty of the claimed subject-matter in accordance with the main request and any of the auxiliary requests.

Reasons for the Decision

Main Request

Novelty (Article 54 EPC)

1. Claim 1 of the main request recites the features
"the outer circumferential surface of the outer wrapper has an arithmetic mean roughness of less than 2.0 μm "
and
"the filter wound with the outer wrapper has a compression recovery of 60% or more after a compression load of 2.5 N is applied to a range of a length of 10 mm in the diameter direction thereof"
which refer to the parameters "arithmetic mean roughness" and "compression recovery".

Parameter "arithmetic mean roughness"

2. The parameter "arithmetic mean roughness" is not an unusual parameter, contrary to the opposition division's decision.
- 2.1 The Board notes that this parameter is a parameter measured by a test method defined in the standard ISO 4287:1997. This was not disputed by the respondent.
- 2.1.1 The respondent, however, argued that the patent in suit did not correctly refer to this standard in paragraph [0020] but designates an incorrect standard ("ISO 1997").

The Board agrees that the relevant standard is not correctly cited in paragraph [0020]. However, the parameter "arithmetic mean roughness" is anyway a conventional parameter well known to the skilled person, and a skilled person would have no difficulties in retrieving the correct ISO norm.

- 2.1.2 The respondent argued that the question of whether this was an usual parameter could only be answered in the context of the particular technical field under consideration. The parameter "arithmetic mean roughness" was typical for metal surfaces but unusual in the technical field at hand, i.e. in the field of producing cigarettes.
 - (a) The Board agrees that the technical field must be taken into consideration when deciding whether a parameter is usual or not.

(b) However, the skilled person's knowledge in the relevant technical field in the case at hand cannot be seen as excluding knowledge of the "arithmetic mean roughness" solely on the basis that this parameter is not cited in any of the patent publications in the IPC class A24 (TOBACCO; CIGARS; CIGARETTES; SIMULATED SMOKING DEVICES; SMOKERS' REQUISITES), as alleged by the respondent.

(c) Indeed the manufacture of smoking articles also requires knowledge of the materials commonly used for the manufacture of cigarettes, in particular of paper as this is a commonly used material for cigarettes' wrappers. The arithmetic mean roughness is indeed one of the parameters used for qualifying papers; it is in particular a parameter related to the ability to provide printings thereon, which depends on the surface's roughness.

2.1.3 The respondent also argued that the parameter "arithmetic mean roughness" would not be used in the paper industry but only for classifying metal surfaces. D1 disclosed in its translation into English in the paragraph bridging pages 4 and 5 a reference to the "*Beck-type smoothness measurement method*" which would be the parameter typically used for measuring the surface roughness of a wrapper. This method involved a pressure test of a paper sample on a plate which is a different test method to the method defined in ISO 4287:1997.

(a) The Board disagrees. This passage in D1 only provides proof that the skilled person is aware of more than one method for classifying paper surfaces with regard to their roughness.

(b) The Board further notes that the respondent did not provide evidence that ISO 4287:1997 is restricted to metal surfaces and/or that the test described therein cannot be applied to paper surfaces.

(c) The Board hence is not convinced by this argument but considers that the test described in ISO 4287:1997 can be applied to any kind of material, including also surfaces of a paper material.

2.2 The Opposition division hence erred when considering the parameter "arithmetic mean roughness" mentioned in claim 1 to be an unusual parameter.

2.2.1 It is not allowable to base the decision on novelty with regard to the feature "*the outer circumferential surface of the outer wrapper has an arithmetic mean roughness of less than 2.0 μm* " on vague assumptions, or even disregard the feature in its entirety.

2.2.2 On the contrary, it must be assessed whether a prior art document discloses this feature directly and unambiguously, i.e. it has to be beyond doubt - not merely probable - that a prior art wrapper has an arithmetic mean roughness as required by claim 1.

Parameter "compression recovery"

3. The parameter "compression recovery" is an unusual parameter, as correctly held by the opposition division.

3.1 The Board agrees with the appellant that the compressibility of a product is a basic mechanical property that can be measured by the skilled person,

hence also in the field of tobacco products as in the case at hand.

- 3.2 However, the parameter "compression recovery" does not just reflect the material's ability to be deformed under load. It also reflects the material's ability to restore (at least partly) its initial shape upon removal of the load whereby this ability is quantified. As set out in paragraph [0021] and [0022] of the patent it involves a calculation formula using the areas under the load-deformation curve when applying the load and when releasing the load. These curves depend inter alia on the size of the probe, and the velocity with which the load is applied.
- 3.3 Such a complex and elaborate calculation of a parameter for the material's ability to be deformed cannot be considered to be well-known to the skilled person but - in the absence of an evidence to the contrary - must be considered to be unusual.
- 3.3.1 The appellant argued that the patent in suit provided sufficient information in paragraphs [0021]-[0023], [0088]-[0090] and figures 1 and 5 such that a person skilled in the art could evaluate the parameter for a given product.
- 3.3.2 This is, however, not relevant for the question whether the parameter is unusual but it is relevant for the question whether the test can be carried out by a skilled person.
- 3.3.3 The appellant further argued that a plurality of documents referring to the parameter "compression recovery" and its synonyms could be found in relevant

classes of the IPC, however without providing any of these documents.

3.3.4 The Board hence shares the opposition division's view that the parameter "compression recovery" is unusual in the tobacco field.

4. The opposition division, however, erred as regards the consequences of this finding.

4.1 The opposition division assumed that the feature *"the filter wound with the outer wrapper has a compression recovery of 60% or more after a compression load of 2.5 N is applied to a range of a length of 10 mm in the diameter direction thereof"*

could be disregarded since any prior art document would inherently fulfil this condition. They considered the burden of proof to shift on the patent proprietor that the prior art did not disclose the compression recovery defined in claim 1.

4.2 According to established case law of the Boards of Appeal (cf. Case Law of the Boards of Appeal, 11th edition, chapter III.G.5.2.2 d)) only in case of a strong presumption that the claimed subject-matter defined by an unusual parameter was inherently disclosed in the prior art, the patent proprietor could not merely claim the benefit of the doubt but had to demonstrate that the chosen parameter-based definition distinguished the claimed subject-matter from the prior art.

4.2.1 The opposition division did not establish such strong presumption but held that the presence of a plasticizer in the filter tow alone would be sufficient to achieve

the desired "compression recovery" (reasons for the decision 2.1.1.4, third paragraph).

(a) The Board finds that in absence of any information about the specific effect of a plasticizer in the filter, it cannot be concluded that the sole presence of a plasticizer, and in any amount, would allow to achieve the required compression recovery of 60% as required by claim 1. The claim refers to a minimum compression recovery of 60% which implies that at least a certain minimum amount of plasticizer must be used to surpass the required minimum compression recovery.

(b) Furthermore, the Board is of the opinion that a material's ability to recover its shape not only depends on the amount of plasticizer but also on a plurality of further parameters, including:

- further components in the tow,
- physical structure of the tow,
- physical behaviour of the wrapper,
- geometry of the cigarette,
- parameters of the test method (load, velocity of loading).

(c) Without considering these further parameters, it is not possible to provide a meaningful comparison between the article defined in the patent in suit and the prior art, leading to a "strong presumption" that the prior art would also fulfil the range for the unusual parameter defined in claim 1.

4.3 The opposition division's decision is hence based on an investigation that was not sufficiently detailed when comparing the materials used in the prior art and in

the patent in suit to establish a strong pointer that the prior art products have a compression recovery as defined in claim 1.

Remittal of the Case to the Opposition Division

5. Both the appellant and the respondent requested the case to be remitted to the opposition division for further prosecution.
- 5.1 The Board considers the fact that the opposition division's decision on novelty is based on the wrong assumptions that the parameter "arithmetic mean roughness" is unusual and that there is a strong presumption that the required "compression recovery" is inherent to any filter tow as special reasons in the sense of Article 11 RPBA which justify a remittal of the case to the opposition division for further prosecution.
- 5.2 Such a remittal is not only justified in view of the assessment of novelty but also to deal with the ground of opposition under Article 100(b) EPC. The opposition division stated that the invention was sufficiently disclosed (cf. reasons for the decision 15.3) but did not provide reasons in this respect, in particular why they were not convinced by the opponent's argument that the patent does not provide sufficient information to carry out the tests required for a measurement of the parameters "arithmetic mean roughness" and "compression recovery".

Request for Referral to Enlarged Board of Appeal

6. With letter dated 4 November 2025 filed in response to the communication of the Board dated 4 September 2009, in which the Board expressed its preliminary opinion on the case, the respondent submitted arguments and also requested that the following questions be referred to the Enlarged Board of Appeal if the Board intended to deviate from the assessment of unusual parameters in accordance with established case law:

1. Does the evaluation whether a parameter is unusual depend on whether it was used in the context of the underlying field of technology of a claim comprising the parameter (cf. T 131/03, sect. 2.3; T 1085/20, sect. 3.4)?

2. Is it indicative for considering a parameter to be unusual, if it is not generally used within the prior art of the underlying field of technology (cf. T 0555/18, sect. 1.5.5)?

3. Is it sufficient for considering a parameter to be unusual, if it is not used within the prior art of the underlying field of technology (cf. T 131/03, sect. 2.3)?

4. Does the underlying field of technology have to encompass the subject matter of the patent claim under evaluation?

5. Is the scope of the search performed by the Office regarding the patent claim under evaluation indicative of the underlying field of technology?

6. Is the "second hierarchical level of the [IPC-]Classification" (cf. WIPO Guide to the IPC (2025), p. 4), e.g. A23, D21, an appropriate context frame for defining underlying field of technology?

7. Is it sufficient to establish a strong presumption that unusual parameters as used to define the claimed subject-matter are inherently disclosed in the prior art for finding a lack of novelty, in the absence of a substantiation why the parameters distinguish the claimed subject-matter from the prior art?

- 6.1 According to Article 112(1)(a) EPC, the Board of Appeal shall, during proceedings on a case and either of its own motion or following a request from a party to the appeal, refer any question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes, in order to ensure uniform application of the law, or if a point of law of fundamental importance arises.
- 6.2 In the Board's view, an answer to questions 1 to 7 is not justified by a need to ensure uniform application of the law. Nor do questions 1 to 7 give rise to a point of law of fundamental importance.
- 6.2.1 In fact, questions 1 to 6 all relate to the criteria for assessing whether a parameter is "unusual" or not. Such assessment, however, cannot be made on an abstract basis but depends on the pertinent circumstances of each case which provide the basis on which a board of appeal or other deciding body is required to judge.

- 6.2.2 Question 7 also is to be answered depending on the specific circumstances of the case, as the assessment of whether i) there is indeed a strong presumption and whether ii) unusual parameters are inherently disclosed in the prior art based on the strong presumption can only be made on a case-by-case basis.
- 6.2.3 Finally the Board sees no deviation from established case law in arriving at its decision. In fact, as explained above, the Board considers that, based on the specific circumstances of this case, the parameter "arithmetic mean roughness" is not unusual, and as regards the parameter "compression recovery" whilst unusual no strong presumption was established by the opposition division.

Request for Reimbursement of the Appeal Fee

7. At the oral proceedings the appellant requested reimbursement of the appeal fee in view of an alleged substantial procedural violation in view of insufficient reasoning in the contested decision. It was argued that the decision did not sufficiently reason why there was a "strong presumption" that the prior art disclosed the claimed values for the parameter "compression recovery".
- 7.1 However, it is clear from the contested decision that the opposition decision justified the strong presumption based on the assumption that the compression recovery depended solely on the presence of a plasticiser. As explained above, this is not sufficient for arriving at a "strong presumption".

7.2 There is therefore no lack of reasoning in the decision, but an error in judgement, which does not justify a reimbursement of the appeal fee pursuant to Rule 103(1)(a) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside. The case is remitted to the opposition division for further prosecution.
2. The request for referral to the Enlarged Board of Appeal is refused.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



M. Schalow

G. Pricolo

Decision electronically authenticated