



Action n°: UPC CFI 309 /2023

Revocation action 571669/2023

DECISION

of the Court of First Instance of the Unified Patent Court

Central division Paris Seat (Section 1)

delivered on 5 November 2024

concerning EP 3 498 115 B1

HEADNOTES:

1. Independent of an application to amend the patent as may be filed by the patent proprietor (R 50 (2) RoP) the Court, according to Art. 65 (3) UPCA, limits the patent by a corresponding amendment of the claims and revokes it (only) in part
2. According to the dispositive principle (procedural maxim) a dispute before the Court generally is controlled by the parties; Art. 76 (1) UPCA rules that the Court shall decide in accordance with the requests submitted by the parties. By the sequence of its requests a patent owner as Defendant to a revocation action may indicate that it requests the Court to consider its application(s) to amend the patent prior to the evaluation, if the patent as granted shall be revoked in part and limited by a corresponding amendment of the claims.
3. Art. 65.3 UPCA only pertains to the *granted* patent. Art. 65.3 UPCA contains no obligation to the Court to evaluate, if an application to amend the patent filed by the patent owner can be allowed in part. Within an application to amend the patent a certain claim set is either allowable (as such; the complete claim set proposed) or not.
4. The claim interpretation to be performed by the court is a question of law for the Court. The Court performs it at any stage of the proceedings.

KEYWORDS: Person skilled in the art; Added matter; Art. 138 (1) (c) EPC; Art 123 (2) EPC; claim interpretation; Art 65.3 UPCA; Question of law

CLAIMANT:

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PATENT AT ISSUE

European patent **EP 3 498 115 B1**, hereafter referred to as “EP115” or as “the Patent”.

PANEL/DIVISION

Panel 1 of the Central Division (Paris Seat)

DECIDING JUDGES

This decision has been delivered by the presiding judge and judge-rapporteur **François Thomas**, the legally qualified judge **Maximilian Haedicke** and the technically qualified judge **Max Tilmann**.

DATE OF THE ORAL HEARING

10 September 2024

SUMMARY OF FACTS AND REQUESTS

1 The dispute

- 1.1 On 13. September 2023 Claimant brought a revocation action¹ against Defendant at the Paris Central Division of the Unified Patent Court (Action n°: UPC CFI 309 /2023 Revocation action 571669/2023), requesting the Court to revoke European Patent No. EP 3 498 115 B1.
- 1.2 On 25. October 2023 the Defendant filed a Preliminary objection pursuant to Rules 19.1(a) and 48 of the Rules of Procedure of the Unified Patent Court ('RoP') denying the competence of the Court on the grounds of an allegedly false denomination of Defendant by Claimant. The Court rejected the Preliminary objection. This holding was confirmed on appeal. No. APL_588420/2023 UPC_CoA_433/2023.
- 1.3 A Statement of Defense to Revocation was filed on 4. December 2023. At the same time and within the same submission, an Application to amend the Patent was filed. A reply to the Defense was submitted on 22. February 2024, including a Defence to an Application to amend the Patent. The Court also received a Rejoinder to the Reply, dated 22. March 2024, that included a Reply to the Defence to an Application to amend the patent. On 22. April 2024 the Claimant filed a Rejoinder to the Reply to the Defence to an Application.
- 1.4 On 31. May 2024 the Court received a further submission by the Defendant entitled "Comments to Claimant's submission of 22. April 2024 including

¹ The Statement of Revocation, Defence to Revocation, Reply to the Defence to Revocation and Rejoinder to the Reply to the Defence to Revocation are herein referred to as 'SfR', 'DtR', 'RtD' and 'R', respectively.

reply to the Defendant's rejoinder and the reply to Defendant's application to amend the patent".

- 1.5 On 27. June 2024 the interim conference was held. By order of 5. July 2024, the Court – inter alia – set out the order that the Defendant may identify within the set of auxiliary requests already on file those set of claims that he wants to pursue further until 20 July 2024. On 22. July Defendant identified 12 auxiliary requests to be pursued during the oral hearing. On 5. July 2024 an order on the value of the litigation was submitted. On 30. August 2024, the Court received the summaries sent by parties.
- 1.6 The oral hearing in was held on 10 September 2024.
- 1.7 On 16. September 2024 and 19. September, respectively, the parties filed the Presentations that the Parties used during the hearing via e-mail.
- 1.8 For the submissions of the parties and previous orders issued by the Court, reference is made to the case file in the Case Management System.

2 The patent

- 2.1 The patent entitled VAPORIZATION DEVICE SYSTEMS was filed on 23. December 2014. The patent claims the priorities of US201361920225 P of 23. December 2013, US 201461936593 P of 6. February 2014 and US 201461937755 P of 10. February 2014.
- 2.2 As indicated by Claimant in mn 6 SfR and undisputed by the Defendant, the Patent EP 3 498 115 is based on a divisional application (application number of divisional application: 19153728.1) to the European application 18000692.6, which in itself was a divisional application to the European application 14873186.2. European application 14873186.2 being the "regional phase" to and originally filed as Internation Patent Application PCT/US2014/072230. The Patent hence is a so called "second generation divisional application". As done by the Claimant (mn 30 SfR), European application 18000692.6 will be referred to as the "parent application"; European application 14873186.2 will be referred to as the "grandparent application".
- 2.3 The publication of the mention of the grant of the Patent was made on 01. September 2021. Registered owner of the Patent is the Defendant.
- 2.4 According to the Claimant's Statement for Revocation) and undisputed by the Defendant, EP115 at the time of filing the SfR was valid in the following member states of the UPCA: Austria, Belgium, Denmark, Finland, France, Germany, Italy, Latvia, Luxembourg, Netherlands, Portugal and Sweden.

2.5 Opposition against the grant of the Patent at the European Patent Office (“EPO”) were pending at the time of filing the StR; Claimant is not party to the opposition proceedings.

2.6 Claim 1 of the Patent as granted reads:

A cartridge (30, 30a) for a device for generating an inhalable aerosol, wherein the cartridge comprises:

a fluid storage compartment (32);

*a heater (36) affixed to a first end of the fluid storage compartment;
and*

a mouthpiece (31) affixed to a second end of the fluid storage compartment,

wherein the heater comprises a first condensation chamber (45) and the mouthpiece comprises a second condensation chamber (46), and

wherein the first end of the cartridge is enclosed and

wherein the enclosed end of the cartridge includes the heater and the fluid storage compartment (32).

2.7 Claim 6 of the Patent as granted reads:

A device for generating an inhalable aerosol, the device comprising:

a cartridge (30, 30a) of any of claims 1 to 5; and a device body comprising a cartridge receptacle (21),

wherein the cartridge is detachable and

wherein the cartridge receptacle and the detachable cartridge form a separable coupling.

3 Requests

3.1 Claimant requests (to the extend still relevant):

- I. European patent n° EP 3 498 115 be revoked with effect for the territories of Austria, Belgium, Denmark, Finland, France, Germany, Italy, Latvia, Luxembourg, Netherlands, Portugal and Sweden.
- II. To dismiss Defendant's alternative requests to maintain the Patent in suit based on any of Defendant's proposed amendments of the claims of the Patent in suit, including all of Defendant's Auxiliary Requests, and Defendant's alternative requests (2)(c) and (d).
- III. To dismiss Defendant's request (3) and, in case that the Court deems it necessary, to admit Exhibits MWE 19 to 50 to the proceedings.
- IV. The Defendant be ordered to bear the legal costs of the proceedings.

3.2 Defendant requests (to the extend still relevant):

- (1) the revocation action be dismissed;
- (2) the patent in suit be maintained:
 - a. as granted;
 - b. in the alternative based on one of the proposed amendments of the claims of the patent in suit (Auxiliary Requests 1 to 12 as filed on 22. July 2024);
 - c. further in the alternative in parts based on the independent validity of one or more of its dependent claims in combination with independent claim 1 as granted; and
 - d. yet further in the alternative in parts based on the independent validity of one or more of its dependent claims as granted in combination with claim 1 of the proposed amendments of the claims of the patent in suit (Auxiliary Requests 1 to 12 as filed on 22. July 2024);
- (3) documents MWE 19 to MWE 44 not be admitted into the proceedings;
- (4) the Claimant bears the costs of the proceedings.

Regarding the submission of 22. April 2024, Claimant further requests to admit this submission also insofar as the submission is not limited to commenting on Defendant's Application to amend the Patent.

Regarding the submission of 31. May 2024, Defendant further requests admission of this response.

4 The arguments

4.1 Regarding the main claim 1, Claimant argues that the invention claimed therein is not valid for several reasons. Claimant argues that the following reasons for revocation apply:

- added matter (Article 138(1)(c) EPC, with reference to Articles 76(1) and added matter (Article 138(1)(c) EPC, with reference to Articles 76(1) and 123(2) EPC), 123(2) EPC),
- lack of novelty (Article 138(1)(a) EPC, with reference to Articles 52(1) and lack of novelty (Article 138(1)(a) EPC, with reference to Articles 52(1) and 54 EPC), and 54 EPC), and
- lack of inventive step (Article 138(1)(a) EPC, with reference to Articles 52(1) lack of inventive and 56EPC).

4.2 Regarding the issue of “added matter”, Claimant in particular argues that Claim 1 of the Patent contains subject matter extending beyond the disclosure of parent and grandparent applications, EP 3430921 A1 and PCT/US2014/072330 as originally filed, in the form of at least the following limitations

- the heater is affixed to a first end of the fluid storage compartment (feature 1.3); and
- the mouthpiece is affixed to a second end of the fluid storage compartment (feature 1.4).

Claimant further states that granted claim 1 omits the feature "the mouthpiece enclosing the second end of the fluid storage compartment" that was originally part of claim 1 as filed with the application as filed and argues that the patent application as originally filed (Exhibit MWE 3) did not, at any point, disclose a cartridge having the precise combination of features set out in present claim 1 without a mouthpiece that encloses a second end of the fluid storage compartment. There is no discussion of an alternative arrangement of the mouthpiece that does not enclose the second end.

4.3 In summary, Defendant argues that Claimant used the wrong starting point for assessing the original disclosure of claim 1 of the Patent. Original claims 149 and 158 of MWE 5 were to provide the generic disclosure basis for features 1.3 and 1.4. Additionally, [0042] and [0046] of MWE 5 were to recite the general disclosure regarding the fluid storage compartment teaching the heater to be affixed to the first end and the mouthpiece to be affixed to the second end. Paragraph [00179] of MWE 5 were to disclose the position of the heater and the mouthpiece on the fluid storage compartment in detail.

- 4.4 In the hearing on 10. September 2024 Claimant argued as regards the application to amend the patent that the application to amend ought to be considered to have contained no auxiliary request containing claim amendments at all as those auxiliary request that were filed ought to be rejected as being too many in number.
- 4.5 In the hearing on 10. September 2024 Claimant challenged the admissibility of the set of auxiliary claims 1 to 12 as filed on 22. July 2024. Claimant indicated that the order of 5. July 2024 set the date of 20. July 2024 for the filing of the auxiliary claims and that Defendant's filing on 22. July 2024 was too late.

GROUNDS FOR THE DECISION

5 Late filed facts and evidence

- 5.1 Defendant requests documents MWE 19 to MWE 44 not be admitted into the proceedings; Claimant requests to dismiss Defendant's request and, in case that the Court deems it necessary, to admit Exhibits MWE 19 to 50 to the proceedings.
- 5.2 Due to the front-loaded approach of the UPC system, R44 RoP requires the statement of revocation to contain an indication of the facts relied on (R44 (f) RoP) and the evidence relied on, where available and an indication of any further evidence which will be offered in support (R44 (g) RoP). Similarly, the RoP contain provisions which define the admissible content of the further submissions. The parties are under an obligation to set out their full case as early as possible (Preamble RoP 7, last sentence) and to provide all their legal and factual arguments, and any evidence supporting it in a timely manner.
- 5.3 Whenever possible, Claimant is obliged to submit its arguments, facts and attachments in its Statement of revocation which he has plenty of time to prepare. However, when submitting the Statement for revocation, Claimant cannot anticipate which points the Defendant will dispute and by what means. Therefore, Claimant is allowed, in its Reply to the statement of defense, to present arguments in response to arguments raised by Defendant in its Statement of defense.
- 5.4 A clear distinction between newly introduced arguments and arguments raised as a mere reaction to previously filed arguments cannot always be drawn. In order to secure fairness and equity of the proceedings (Preamble

RoP 5), especially to safeguard the fundamental right to be heard, a generous standard is to be applied. An argument which may be considered a further reaching response to the other party's previously raised argument is to be admitted.

Reply to the statement of defense and Hajaligol Declaration

- 5.5 In its Reply to the statement of defense dated 22. February 2024, the Claimant filed 27 new documents. Defendant requests not to admit any of the newly filed documents into the proceedings. This request especially pertains to the preclusion of the Hajaligol Declaration (MWE 19) and all enclosures.
- 5.6 The Hajaligol report is admissible as far as it is a reaction to arguments submitted in the Statement of defense. Therefore, the report is admissible as far as it contains arguments regarding the common general knowledge ('State of the art before the critical filing date of the Patents', mn. 21 -33). These arguments are raised in response to arguments raised by Defendant in its Statement of defence to revocation mn 16 et seq. Their submission is therefore admissible
- 5.7 The "Hajaligol Declaration" is also admissible as far as it can be considered to be a response to Dr. Collins proposed construction of the claim features of the patent in suit . The report takes issue with the Collins declaration and focuses on alleged contradictions. A clear distinction between newly added arguments and arguments which are used as a response to Dr. Collins' report cannot be drawn. In order to secure claimant's right to be heard, the entire Hajaligol report is admitted into the proceedings, including its attachments MWE 20 to MWE 44.

Rejoinder to the Reply to the Defence to revocation / Reply to the Defence to the Application to amend the patent

- 5.8 Rule 52 delineates the scope of the Rejoinder to the Reply to the Defence to revocation. According to Rule 52 'the defendant may lodge a Rejoinder to the Reply to the Defence to revocation together with any Reply to the Defence to an Application to amend the patent pursuant to Rule 43.3 and 55 (..). The Rejoinder shall be limited to a response to the matters raised in the Reply.'
- 5.9 Therefore, as far as the Rejoinder to the Reply to the Defence to revocation (22 March 2024) is concerned, the arguments regarding the admissibility of the Hajaligol Declaration are admitted. Page 1-19 of the Rejoinder are therefore admissible.

- 5.10 P. 19-35 of the Rejoinder are a response to the claimant's Reply to the Defence to revocation and to the arguments contained in the Hajaligol Declaration. As the content of the Hajaligol Declaration is admitted, also the response thereto is to be admitted. P. 19-35 are therefore admitted.
- 5.11 P. 35-96 of the Rejoinder are admitted. They focus on general issues concerning patentability, but at the same time, they constitute a response to the Hajaligol Declaration and to the Reply to the Defence to revocation. As previously mentioned, in order to safeguard the fundamental right to be heard, a generous standard is to be applied.
- 5.12 Similarly the expert report of Ramon Alacon (Exhibit TP-12) is admissible as it can be considered to be a reaction to the Hajaligol Declaration which is admitted to the proceedings, too.
- 5.13 According to Rule 55, 32.3 RoP, the 'proprietor may lodge a Reply to the Defence to the Application to amend the patent within one month of service of the Defence (...)'. Applying this rule, this submission of 22 March 2024 is also admissible as far as it is commenting on the Application to amend the patent. Therefore, P. 97 et seq. are admitted.

Reply to the Rejoinder and Reply to Defendant's Application to amend the Patent in suit

- 5.14 On 22. April 2024 claimant filed a 'Reply to the Rejoinder and Reply to Defendant's Application to amend the Patent in suit'.
- 5.15 According to Rules 55, 43.3, 32.3 RoP, Claimant may lodge a Rejoinder regarding the Defendant's Application to amend the Patent in suit. P. 15-80 deal with the Defendant's Application to amend the Patent in suit and are therefore admissible, including MWE 46 to MWE 50 that form part of this Rejoinder.
- 5.16 According to Rule 32.3 second sentence RoP '(t)he Rejoinder shall be limited to the matters raised in the Reply'. Claimant requests under Rules 58, 36, 9.1 RoP admission of its submission also insofar as the submission is not limited to 'the matters raised in the Reply.' This request is to be denied, including not allowing MWE 45 ("Second Hajaligol Declaration") into the proceedings. There is no good reason why an exception should be made to the general rule in Rule 32.3 second sentence RoP. Claimant had the opportunity to present its case. In the interest of efficient proceedings no further arguments can be introduced at this stage of the proceedings. Their admission would not be in line with the UPC's front-loaded approach. p. 1 to 14 of claimant's submission 22. April 2024 are therefore inadmissible.

Submission of 31. May 2024

- 5.17 Defendant's submission of 31 May 2024 is inadmissible, as there is no legal basis for it in the RoP. The submission stands in contrast the front-loaded approach of the UPC system. There are no good reasons why, as an exception, the submission should be admitted in this case.

6 **Technical introduction**

- 6.1 EP115 pertains to a vaporization device systems. According to [0002] EP115 it pertains to improvements in electronic inhalable aerosol devices, or electronic vaping devices, particularly to electronic aerosol devices which utilize a vaporizable material that is vaporized to create an aerosol vapor capable of delivering an active ingredient to a user.
- 6.2 EP115 describes WO 2013/083634 A1 to describe an aerosol generating device comprising a storage portion for storing aerosol-forming substrate. The device is to comprise: a vaporizer for heating the aerosol-forming substrate, a capillary material for conveying the liquid aerosol-forming substrate from the storage portion towards the vaporizer by capillary action, and a porous material between the capillary material and the vaporizer.
- 6.3 EP115 further describes EP 2 113 178 A1 to describe an electrically heated smoking system comprising a shell and a replaceable mouthpiece. The shell comprises an electric power supply and electric circuitry. The mouthpiece comprises a liquid storage portion and a capillary wick. The mouthpiece also comprises a heating element for heating the second end of the capillary wick, an air outlet, and an aerosol forming chamber between the second end of the capillary wick and the air outlet.

7 **The claimed subject matter**

- 7.1 The Patent includes in its granted version 7 claims.
- 7.2 Claim 1 of the Patent can be divided into the following features:

- 1.1. A cartridge suitable to be used in a device for generating an inhalable aerosol, the cartridge having*
- 1.2. a fluid storage compartment (32);*
- 1.3. a heater (36) affixed to a first end of the fluid storage compartment; and*
- 1.4. a mouthpiece (31) affixed to a second end of the fluid storage compartment;*

- 1.5 *the heater comprises a first condensation chamber (45);*
- 1.6 *the mouthpiece comprises a second condensation chamber (46),*
- 1.7 *the first end of the cartridge is enclosed,*
- 1.8 *the enclosed end of the cartridge includes the heater and the fluid storage compartment.*

7.3 Claim 6 of the Patent can be divided into the following features:

- 6. *A device for generating an inhalable aerosol comprising*
- 6.1 *the cartridge of claim 1;*
- 6.2 *a device body comprising a cartridge receptacle (21);*
- 6.3 *the cartridge is detachable;*
- 6.4 *the cartridge receptacle and the detachable cartridge form a separable coupling*

7.4 Several features of claim 1 of the Patent require interpretation.

Legal framework

7.5 The Court of Appeal of the UPC has laid down the following legal framework for the interpretation of patent claims (Order dated 26. February 2024 in UPC_CoA_335/2023, *NanoString/10x Genomics*, p. 26-27 of the original German language version, also see CoA UPC 13 May 2024, *VusionGroup/Hanshow*).

7.6 In accordance with Art. 69 EPC and the Protocol on its interpretation, a patent claim is not only the starting point, but the decisive basis for determining the scope of protection of a European patent. The interpretation of a patent claim does not depend solely on the strict, literal meaning of the wording used. Rather, the description and the drawings must always be used as explanatory aids for the interpretation of the patent claim and not only to resolve any ambiguities in the patent claim. However, this does not mean that the patent claim merely serves as a guideline and that its subject-matter also extends to what, after examination of the description and drawings, appears to be the subject-matter for which the patent proprietor seeks protection.

7.7 The patent claim is to be interpreted from the point of view of a person skilled in the art. When interpreting a patent claim, the person skilled in the art does not apply a philological understanding, but determines the technical meaning

of the terms used with the aid of the description and the drawings. A feature in a patent claim is always to be interpreted in light of the claim as a whole (CoA UPC 13 May 2024, *VusionGroup/Hanshow*, point 29). From the function of the individual features in the context of the patent claim as a whole, it must be deduced which technical function these features actually have individually and as a whole. The description and the drawings may show that the patent specification defines terms independently and, in this respect, may represent a patent's own lexicon. Even if terms used in the patent deviate from general usage, it may therefore be that ultimately the meaning of the terms resulting from the patent specification is authoritative.

- 7.8 In applying these principles, the aim is to combine adequate protection for the patent proprietor with sufficient legal certainty for third parties.
- 7.9 The relevant point in time for interpreting a patent claim for the assessment of validity is the filing (or priority) date of the application that led to the Patent.
- 7.10 The patent claim is to be interpreted from the point of view of a person skilled in the art. The person skilled in the art (skilled person) is a fiction which, in the interests of legal certainty, forms a standardized basis for the assessment of the legal concepts of "prior art", "novelty", "inventive step" and "enablement". The skilled person stands for the average expert who is typically active in the technical field of the invention, has had the usual prior training and has acquired average knowledge, skills and practical experience.
- 7.11 Claimant argued in the hearing that a claim interpretation presented by a party could be considered as late filed. At least as regards the claim interpretation to be performed by the court, this is a question of law for the Court. The Court performs it at any stage of the proceedings. Claimant referred to an order of the Local Division Mannheim of 27. June 2024 in UPC_CFI_210/2023. The particular order merely reflects on the issue, if in the case of technically complex subject-matter, statements on the interpretation of features of the asserted patent claim that are not readily understandable by themselves ought already to be made in the statement of claim. The particular order does not indicate a definite sanction, if such statements on the interpretation of features of the asserted patent claim were not made in the statement of claim.

The skilled person (person skilled in the art)

- 7.12 The person skilled in the art is a mechanical engineer with either a Bachelor's degree or as Master's degree in mechanical engineering and several years of experience in the technical field of electronic inhalable aerosol devices or electronic vaping devices, who may be assisted by an electrical engineer for those issues that relate to the electrical circuitry implemented in electronic inhalable aerosol devices or electronic vaping devices that he himself cannot handle.
- 7.13 Electronic inhalable aerosol devices or electronic vaping devices are consumer products. General tasks in designing electronic inhalable aerosol devices or electronic vaping devices relate to the outer physical shape and mechanical properties of the device; the materials to be used for the device; the inner physical shape of the device, also as regards fluid dynamics and thermodynamics. These tasks typically fall into the competence of a mechanical engineer and not so much into the competence of an electrical engineer, a chemist or a physicist (as suggested by Claimant (SfR, mn 9)).
- 7.14 A further task in designing electronic inhalable aerosol devices or electronic vaping devices relates to the electrical circuitry implemented in these devices. This additional design task can either be performed by a mechanical engineer with some years of experience in the technical field of vaporizers or by way of forming a team between the mechanical engineer and an electrical engineer.
- 7.15 Claimant states that alternatively to a mechanical engineer, the skilled person could alternatively possess a Bachelor's or Master's degree in chemistry or physics or a related field or someone from a related field (mn 9 SfR). This does not convince as it would render the selection of the skilled person too unspecific. Claimant does not provide any substantive reasons for suggesting these alternatives and hence does not provide any convincing arguments as to why Claimant's suggestion should prevail. Likewise, the statement by Mr. Hajaligol in mn 19 of MWE 19 also provides no further reasoning as to why Mr. Hajaligol is of the opinion that the person skilled in the art ought to be defined differently, hence – apart from a singular opinion - not providing any convincing arguments as to why Claimant's suggestion should prevail.

Claim interpretation from the point of view of the skilled person

Feature 1.3: *“a heater affixed to a first end of the fluid storage compartment”*

- 7.16 Feature 1.3 describes the heater to be affixed to a first end of *the fluid storage compartment (abbreviated as “FSC” in the following)*. In doing so, feature 1.3

(1) defines the manufacturing step of affixation to be the one to be used to provide the FSC with the heater and (2) defines the location of at least the majority of the parts that make up the heater to be at a first end of the FSC.

7.17 The term “affixed” to the skilled person indicates an attachment of one object (the heater) to another, already existing object. In contrast to other manufacturing methods, for example where an object is created as part of an object by way of machining or where an object is cast, “affixing” to the skilled person means the attachment of one existing object to another existing object.

7.18 This view is supported by the description of the Patent. For ease of reference Fig. 7A, 7B and 9 are copied in below.

7.19 Fig. 7A is an isometric view of an assembled cartridge. Fig. 7B is an illustrative exploded isometric view of a cartridge assembly.

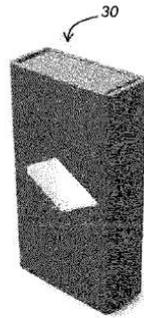


FIG. 7A

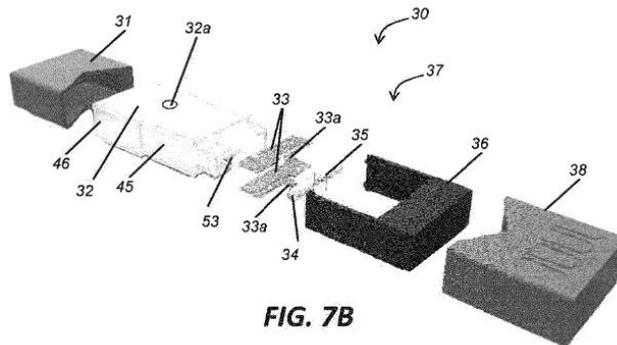
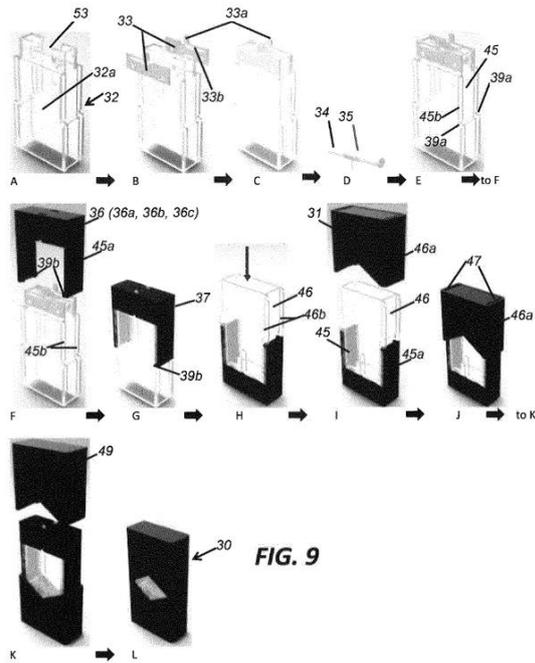


FIG. 7B

7.20 FIG. 9 provides an example of a method of assembling such a device. FIG. 9 is a sequence of the assembly method for the cartridge.



- 7.21 From [0138] the skilled person learns that it is intended that the cartridge may be configured for ease of manufacture and assembly. From this the skilled person understands that the intention of the reference in feature 1.3 to the heater being affixed to a first end of the FSC (and the intention of feature 1.4. *requiring a mouthpiece affixed to a second end of the FSC*) is to be seen as means to achieve an ease of manufacture and assembly of the cartridge in contrast of other, more difficult manufacturing ways of providing a cartridge with a heater and a mouthpiece.
- 7.22 Claim 1 leaves it open, if the heater is a unitary element that is affixed to the end of the FSC in one unitary piece or if the heater is made up of several elements that are individually affixed to other parts of the FSC. The embodiment shown in Fig. 7B and assembled according to Fig. 9 is a heater made up of several parts and shows the individual parts of the heater to be affixed to pieces of the FSC in successive steps. From this the skilled person learns that the affixation of the heater to the elements of the FSC must not necessarily be done in one step. But the embodiment shown in Fig. 7B and assembled according to Fig. 9 shows that even if the heater is affixed to elements of the FSC, each element of the heater is affixed to other elements (in contrast to an element that forms part of the heater being formed by other ways on the FSC). As regards the means of affixation, [0153] suggests the one or more free ends of the heater to be soldered in place (which is a means of permanent affixation), rested in a groove or snapped into a fitted location.

- 7.23 When taken literally, the term “affixed to a first end of the fluid storage compartment” could be understood to define the “a first end of the fluid storage compartment” to be an existing (part of an) object to which the heater is affixed, namely the FSC. Such an understanding of the term “first end of the FSC” is, however, in contradiction to the description. [0150] describes a small male snap feature 39b located at the end of the channel cover (of the heater) to be configured to fall into a female snap feature 39a, located mid-body on the side of the tank and creating a snap-fit assembly. To the skilled person this means that the actual point of attachment of the heater to the FSC takes place mid-body on the side of the tank; the term “tank” at least in [0150] being understood by the skilled person to be synonymous to the term “fluid storage compartment”. Using the description and the drawings as explanatory aids for the interpretation of the patent claim the skilled person understands that the term “to a first end of the FSC” in the term “affixed to a first end of the FSC” defines the location where the heater is after having being affixed rather than being a reference to an existing (part of an) object to which the heater is affixed.
- 7.24 From the embodiment described in [0150] the skilled person understands that feature 1.3 does not necessitate the complete heater to be located at the first end of the fluid storage compartment. While in the embodiment described in [0150] the majority of the parts that make up the heater is located at a first end of the FSC, the channel covers protrude from the end of the first cartridge and hence are not completely located at the first end of the cartridge. From this the skilled person understands that feature 1.3 relates to the of at least the majority of the parts that make up the heater to be at a first end of the FSC.

Feature 1.4: “a mouthpiece affixed to a second end of the fluid storage compartment;”

- 7.25 Feature 1.4 describes the mouthpiece to be affixed to a second end of FSC. In doing so, feature 1.4 (1) defines the manufacturing step of affixation to be the one to be used to provide the FSC with the mouthpiece and (2) defines the location of the free end of the mouthpiece that is intended to be inserted into the users mouth at a second end of the FSC.
- 7.26 As indicated above, the term “affixed” to the skilled person indicates an attachment of one object (the mouthpiece) to another, already existing object. As indicated above, this method is seen by the skilled person as the one to achieve an ease of manufacture and assembly of the cartridge in

contrast of other, more difficult manufacturing ways of providing a cartridge with a heater and a mouthpiece. As indicated above, when taken literally, the term “affixed to a second end of the fluid storage compartment” could be understood to define the “a second end of the fluid storage compartment” to be an existing (part of an) object to which the mouthpiece is affixed, namely the FSC. Such an understanding of the term “second end of the fluid storage compartment” is, however, in contradiction to the description.

7.27 [0174] describes a snap-fit coupling 39c, 39d of the mouthpiece to be similar of the snap-fit coupling 39a, 39b. In view of Fig. 9I and 9J that show the mouthpiece 31 to be slid onto the fluid storage compartment 32a in a manner similar to the heater 36 being slid onto the fluid storage compartment 32 in Fig. 9F, 9G and for Fig. 9I and 9J to show the mouthpiece to have lateral extensions (aerosol outlet channel covers 46a) similar to the lateral extensions (primary condensation channel covers 45a), the skilled person understands the reference in [0174] for the snap-fit coupling 39c, 39d to be similar to the snap-fit coupling 39a, 39b to include the possibility that describes a small male snap feature 39d located at the end of the aerosol outlet channel covers 46a to be configured to fall into a female snap feature 39c, located mid-body on the side of the tank and creating a snap-fit assembly. To the skilled person this means that the actual point of attachment of the mouthpiece to the FSC in this embodiment takes place mid-body on the side of the tank. On the other hand, the skilled person realizes especially from Fig. 7A, 9I and 9J that the mouthpiece is affixed to the in a particular orientation, namely in such a way that the free end of the mouthpiece that is intended to be inserted into the users mouth is located at a second end of the FSC. Like with feature 1.3, using the description and the drawings as explanatory aids for the interpretation of the patent claim the skilled person understands that the term “to a second end of the cartridge” in the term “affixed to a second end of the cartridge” defines the location of the free end of the mouthpiece that is intended to be inserted into the user’s mouth to be at a second end of the FSC.

7.28 Taking the description and the drawings as explanatory aids for the interpretation of the patent claim, in the features 1.3 and 1.4 both references to “end of the fluid storage compartment” (first end of the fluid storage compartment; second end of the fluid storage compartment) need to be interpreted and are interpreted in a similar way in order to be in line with the description. The need to apply this interpretation to two individual features

in the same way, reinforces the interpretation for the respective one of the two features.

7.29 The interpretation of further features of claim 1 and 6 is in dispute between the parties, like the interpretation of the term “fluid storage compartment” in feature 1.2 or the term “cartridge receptacle” in feature 6.2. The present decision does not depend on the interpretation of further features of claim 1 and 6. It hence does not need to be established, how the skilled person would interpret these further features when applying the above identified legal framework.

8 **Validity**

8.1 The Patent is not valid. It extends beyond the content of the application as filed and beyond the content of the earlier application as filed.

8.2 Legal framework

8.3 An amendment is regarded as introducing subject-matter which extends beyond the content of the application as filed, and therefore unallowable, if the overall change in the content of the application (whether by way of addition, alteration or excision) results in the skilled person being presented with information which is not directly and unambiguously derivable from that previously presented by the application, even when account is taken of matter which is implicit to a person skilled in the art. Any amendment can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing (or the priority date, where appropriate), from the whole of the documents as filed (*LD The Hague, UPC_CFI_131/2024 ACT_14945/2024; order of 19. June 2024; page 12, mn 3.4*).

8.4 Given that the Patent is a second generation divisional application the Patent is to be revoked, if any one of the following conditions applies:

1. the Patent extends beyond the content of the application as filed, namely European Patent Application 19153728.1 (MWE 3);
2. the Patent extends beyond the content of the earlier application European application 18000692.6 (the parent application; EP 3430921 A1 ; MWE 4), the European Patent in suit being granted on a divisional application to this earlier application;

3. the Patent extends beyond the content of the earlier application European application 14873186.2 (the grandparent application; WO 2015/100361 A1; MWE 5), the European Patent in suit being granted on a divisional application to a divisional application to this earlier application.

Granted claim 1 not disclosed verbatim in the applications

- 8.5 It is without dispute among the parties that the precise wording used for granted claim 1 in its combination and flow of words (claim 1 “verbatim”) can as such not be found in WO 2015/100361 A1 (MWE 5), i.e., the grandparent application 14873186.2, nor in the application as filed (MWE 3) and not in the parent application EP 3430921 A1 (MWE 4).

Starting from starting point used by Defendant within the grandparent application (MWE 5)

- 8.6 In mn 38 of the DtR, Defendant refers to the original claims 149 and 158 of WO 2015/100361 A1 (MWE 5) as a generic disclosure basis.

- 8.7 Claim 149 of MWE 5 reads:

149. A cartridge for a device for generating an inhalable aerosol comprising:
a fluid storage compartment;
a heater affixed to a first end; and
a mouthpiece affixed to a second end;
wherein the heater comprises a first condensation chamber and the mouthpiece comprises a second condensation chamber.

- 8.8 Granted claim 1 differs from the disclosure of claim 149 in that granted claim 1 specifies that

- the first end mentioned in claim 149 of MWE 5 is the first end of the fluid storage compartment, where claim 149 leaves open, which object provides the first end;
- the second end mentioned in claim 149 of MWE 5 is the second end of the fluid storage compartment, where claim 149 leaves open, which object provides the second end;
- the first end of the cartridge is enclosed and
- the enclosed end of the cartridge includes the heater and the fluid storage compartment.

- 8.9 Claim 158 of MWE 5 reads

158. A method of fabricating a cartridge for a device for generating an inhalable aerosol comprising:

- providing a fluid storage compartment;
- affixing a heater to a first end with a snap-fit coupling; and
- affixing a mouthpiece to a second end with a snap-fit coupling.

8.10 Granted claim 1 differs from the disclosure of claim 158 in that granted claim 1 specifies that

- the first end mentioned in claim 158 of MWE 5 is the first end of the fluid storage compartment, where claim 158 leaves open, which object provides the first end;
- the second end mentioned in claim 158 of MWE 5 is the second end of the fluid storage compartment, where claim 158 leaves open, which object provides the second end;
- the heater comprises a first condensation chamber;
- the mouthpiece comprises a second condensation chamber;
- the first end of the cartridge is enclosed;
- the enclosed end of the cartridge includes the heater and the fluid storage compartment.

8.11 The starting point chosen by Defendant is different from the granted claim 1 in several aspects and not only as regards the heater being affixed to a first end of the fluid storage compartment and the mouthpiece being affixed to a second end of the fluid storage compartment. It is the Defendant's burden of proof to show, that all the changes made to what he considers as a generic disclosure basis for granted claim 1 (the changes made to claim 149 or claim 158) do not result in the skilled person being presented with information which is not directly and unambiguously derivable from that previously presented by the application, even when account is taken of matter which is implicit to a person skilled in the art.

8.12 For the reasons given further below, the Patent extends beyond the content of the earlier application European application 14873186.2 (the grandparent application; WO 2015/100361 A1; MWE 5), even if using the starting point proposed by the Defendant.

(Omitted) Feature "the mouthpiece enclosing the second end of the fluid storage compartment"

8.13 Claimant states that the granted claim 1 extends the subject matter of the Patent beyond that disclosed in the application as originally filed, because the

requirement that “the mouthpiece enclosing the second end of the fluid storage compartment” that was part of claim 1 as filed with the application as originally filed, was removed (mn 56 SfR). Claimant states that the patent application as filed (MWE 3) did not disclose a cartridge having the precise combination of features set out in the present (granted) claim 1 without a mouthpiece that encloses a second end of the fluid storage compartment.

8.14 Defendant had not replied to this line of argument in the submissions and for the first time in the hearing of 10. September 2024 argued that not the originally filed claim 1 of European Patent Application 19153728.1 as filed (MWE 3) were to form the basis of the granted claim 1, but that the granted claim 1 was derived from “Aspects useful for understanding the invention” as they are given on pages 51 to 67 of MWE 3 and of those aspects from aspect 149 and aspect 158.

8.15 Aspect 149 reads (page 65 of MWE 3):

149. A cartridge for a device for generating an inhalable aerosol comprising:
a fluid storage compartment;
a heater affixed to a first end; and
a mouthpiece affixed to a second end;
wherein the heater comprises a first condensation chamber and the mouth-
piece comprises a second condensation chamber.

8.16 Aspect 158 reads (page 66 of MWE 3):

158. A method of fabricating a cartridge for a device for generating an inhalable aerosol comprising:
providing a fluid storage compartment;
affixing a heater to a first end with a snap-fit coupling; and
affixing a mouthpiece to a second end with a snap-fit coupling.

8.17 As indicated by Defendant in mn 39 DtR and contrary to Defendant’s statement in mn 41 DtR, the wording of either claim 149 and 158 of MWE 5 leave it undefined to the (respective end of) which component the heater and the mouthpiece are affixed to. The same must be true for “Aspect 149” and “Aspect 158”. Contrary to Defendant’s argument in mn 41 DtR, nothing can be gained from the fact that the “fluid storage compartment” is listed in the general flow of Aspect 149 and 158, respectively, prior to the heater (and it being affixed to a first end) and prior to the mouthpiece (and it being affixed to a second end). Like the “fluid storage compartment”, also the term “cartridge” is introduced into the claim prior to the features concerning the affixation of the heater and the mouthpiece to certain ends. Aspects 149 and 158 are hence ambiguous as to which object the ends belong, to which the heater and the mouthpiece are affixed; it could be the cartridge or it could be the fluid storage compartment. Aspects 149 and 158 leave this open.

- 8.18 The same ambiguity is present in [0042] and [0046] of MWE 3 (cf. MWE 5, [0042], [0046]; cf. MWE 4, [0042], [0046]). Like the “fluid storage compartment”, also the term “cartridge” is introduced into the respective paragraph prior to the features concerning the affixation of the heater and the mouthpiece to certain ends. [0042] and [0046] of MWE 3 (cf. MWE 5, [0042], [0046]; cf. MWE 4, [0042], [0046]) are hence ambiguous as to which object the ends belong, to which the heater and the mouthpiece are affixed; it could be the cartridge or it could be the fluid storage compartment. [0042] and [0046] of MWE 3 (cf. MWE 5, [0042], [0046]; cf. MWE 4, [0042], [0046]) leave this open.
- 8.19 Defendant’s statement in mn 42 DtR, according to which the first and second ends of the fluid storage compartment form the first end and the second end of the cartridge is unsupported by the wording of Aspects 149 and 158 as well as the wording of [0042] and [0046] of MWE 3 (cf. MWE 5, [0042], [0046]; cf. MWE 4, [0042], [0046]). The mere circumstance that these text passages describe the fluid storage compartment to be part of the cartridge does not make the first end of the fluid storage compartment the first end of the cartridge and does not make the second end of the fluid storage compartment the second end of the cartridge.
- 8.20 [00179] of MWE 3, further referred to by defendant, discloses a specific embodiment of a cartridge (which [00179] refers to as cartomizer and/or mouthpiece). The embodiment disclosed in [00179] by way of describing the succession of Fig. 9A to Fig. 9L is seen by the skilled person in conjunction with Fig. 7B and the description of Fig. 7B, for example in [00176] and [00177]. The last sentence of [00179] (the paragraph referred to by defendant) states that “Fig. 7B shows an exploded view of the assembled cartridge 30”, indicating to the skilled person by way of its placement at the end of [00179] that the features described in conjunction of Fig. 7B, and especially the features described in [00176] and [00177] belong to the disclosure of the embodiment of Fig. 9.
- 8.21 The particular design solution described in [00176], [00177] and [00179] and [00183] in conjunction with Fig. 7B, 9 of MWE 3 shows several particular design choices for elements that are only claimed in general in claim 1.
- 8.22 [00176] describes primary condensation channel covers 45a that slide over the rails 45b on the sides of the tank on the first half of the tank, creating a primary condensation channel / chamber 45. In the immediate next sentence, it is described that a small male snap feature 39b located at the

end of the channel cover is configured [to] fall into a female snap feature 39a located mid-body on the side of the tank, creating a snap-fit assembly. [00176] hence interlinks a method of affixing the heater to the tank with the existence of elements of the heater (the condensation channel covers) that are used to create the first condensation channel of the heater. [00177] attributes to this design of primary condensation channel covers 45a which slide over the rails 45b on the sides of the tank the advantage of creating an integrated, easily assembled, primary condensation chamber 45 and further identifies it as an advantage that this is provided all within the heater at the first end of the cartridge 30. From [00183] the skilled person learns that the mouthpiece 31 of the embodiment of Fig. 9 comprises raised internal edges and aerosol outlet channel covers 46a that may slide over the rails 46b located on the sides of the second half of the tank, creating aerosol outlet channels / secondary condensation chambers 46.

- 8.23 It can be left undecided for this case, if the skilled person would realize from the description of MWE 3 that the remaining specific design options chosen for the embodiment of Fig. 7B and 9, like the specific shape of the primary condensation channel covers or the design of the rails or the design of the male snap feature, can be exchanged with other particular design options.
- 8.24 In any case, however, the embodiment of Fig. 7B, 9A-L described in [00176], [00177] and [00179] and [00183] of MWE 3 only presents to the skilled person the information that the mouthpiece that comprises a second condensation chamber *encloses* the second end of the fluid storage compartment.
- 8.25 [00179] states that step J shows the mouthpiece 31 in place on the fluid storage compartment. Looking at Fig. 9J, the skilled person identifies the black colored, box shaped object with the reference sign 31 to practically enclose one half of the see-through fluid storage compartment (only a little triangular cut-out being left free).
- 8.26 Defendant does not point to any further parts of the disclosure that would show the skilled person a preferred embodiment, in which the mouthpiece is affixed to a second end of the fluid storage compartment without enclosing the fluid storage compartment.
- 8.27 This leads to the circumstance that any claim
- that refers to the mouthpiece being affixed to a second end of the fluid storage compartment and for the mouthpiece to comprise a second condensation chamber;

- while not defining, that the mouthpiece encloses the second end of the fluid storage compartment

results in the skilled person being presented with information, which is not directly and unambiguously derivable from that previously presented by the application, even when account is taken of matter which is implicit to a person skilled in the art. For a cartridge that has a mouthpiece being affixed to the second end of the fluid storage compartment (feature 1.4) and a mouthpiece that comprises a second condensation chamber (feature 1.6), the embodiment of Fig. 7B, 9A-L described in [00176], [00177] and [00179] and [00183] of MWE 3 only presents to the skilled person the information to have the mouthpiece enclose the second end of the fluid storage compartment.

8.28 The Patent hence extends beyond the content of the application as filed, namely European Patent Application 19153728.1 (MWE 3).

8.29 For similar reasons,

- the Patent extends beyond the content of the earlier application European application 18000692.6 (the parent application; EP 3430921 A1 ; MWE 4), the European Patent in suit being granted on a divisional application to this earlier application;
- the Patent extends beyond the content of the earlier application European application 14873186.2 (the grandparent application; WO 2015/100361 A1; MWE 5), the European Patent in suit being granted on a divisional application to a divisional application to this earlier application.

8.30 For a cartridge that has a mouthpiece being affixed to the second end of the fluid storage compartment (feature 1.4) and a mouthpiece that comprises a second condensation chamber (feature 1.6), the embodiment of Fig. 7B, 9A-L described in [00176], [00177], [00179] and [00183] of MWE 5 and described in [0152], [0153], [0155], [0159] of MWE 4 only presents to the skilled person the information to have the mouthpiece enclose the second end of the fluid storage compartment.

9 Defendant's Auxiliary Request (2) b. – Application to amend the patent

9.1 For the reasons given above, the Patent cannot be maintained as granted in its entirety; as regards claim 1 it is to be revoked. According to Art. 65 (3) UPCA, the patent shall be limited by a corresponding amendment of the claims and revoked in part, if the grounds for revocation affect the patent

only in part. The amendment of Art. 65 (3) UPCA is an amendment that the Court performs in a suitable manner.

- 9.2 *independent* of an application to amend the patent as may be filed by the patent proprietor (R 50 (2) RoP) the Court, according to Art. 65 (3) UPCA, limits the patent by a corresponding amendment of the claims and revokes it (only) in part. At least in a case like the present, where the patent proprietor shows an interest for the patent to be upheld even in part (request (2) c.), the Court needs to examine, if the grounds for revocation affect the patent only in part, and in the affirmative case the Court would need to limit the patent by performing a corresponding amendment of the claims and would need to revoke the patent in part.
- 9.3 According to the dispositive principle (procedural maxim) a dispute before this Court generally is controlled by the parties; Art. 76 (1) UPCA rules that the Court shall decide in accordance with the requests submitted by the parties. By the sequence of its requests (2) a., (2) b., (2) c. the Defendant indicates that it requests the Court to consider its application(s) to amend the patent prior to the evaluation, if the patent as granted shall be revoked in part and limited by a corresponding amendment of the claims.
- 9.4 The conditional application to amend the patent filed by Defendant on 4. December 2024 contained a set of auxiliary requests 1 to 57 with different claim sets for the amendment of the patent. Claimant's argument that the application to amend ought to be considered to have contained no auxiliary request containing claim amendments at all as those auxiliary request that were filed ought to be rejected as being too many in number, cannot convince. Auxiliary requests were filed by the Defendant. R 30 (1) (c) RoP that rules that the proposed amendments, if conditional like in the present case, must be reasonable in number in the circumstances of the case, does not set out the consequence that all amendments proposed should be dismissed en bloc as not meeting the criterion of being reasonable in number. The conditional amendments proposed by Auxiliary request 1 to 12 are considered to be reasonable in number in the circumstances of the present case.
- 9.5 The Court uses the discretion given within Rule 9.2 RoP and – contrary to Claimant's stipulation - will not disregard the auxiliary requests 1 to 12 filed by Defendant on 22. July 2024. The order of 5. July 2024 gave the Defendant the option ("may identify") until the 20 of July 2024 to narrow down the set

of auxiliary requests already on file, but did not rule that the Defendant must narrow down the set of auxiliary requests. Furthermore, the Court considers Defendant's motion to narrow down the auxiliary to the auxiliary requests 1 to 12 as expedient for an efficient procedure and hence beneficial to the Claimant, too. As indicated above, without the motion to file the auxiliary requests 1 to 12, the originally filed auxiliary requests 1 to 57 would have remained on file to be dealt with in a manner that would yet have to be decided at the hearing. Furthermore, given that 20. July 2024 was a Saturday and Monday, 22. July 2024, the next working, no substantial harm in the Claimant's position can be identified. Under normal business practice one might expect that Claimant's representative would have taken note of Defendant's submission only on Monday, 22. July 2024 anyways.

Auxiliary request 1 to 10

- 9.6 None of the claims of auxiliary requests 1 to 10 specify the mouthpiece to enclose the second end of the fluid storage compartment. Hence none of the claims of the auxiliary requests 1 to 10 introduce limitations that would lead to their subject matter being considered to *not* extend beyond
- the content of the earlier application European application 14873186.2 (the grandparent application),
 - the content of the application as filed, namely European Patent Application 19153728.1;
 - the content of the earlier application European application 18000692.6 (the parent application), the European Patent in suit being granted on a divisional application to this earlier application.
- 9.7 The application to amend the patent according to auxiliary requests 1 to 10 hence needs to be rejected.

Auxiliary request 11 and 12

- 9.8 Claim 1 of auxiliary request 11 and of auxiliary request 12 contains the limitation that "the mouthpiece (31) encloses the second end of the cartridge (30, 30a) and the second end of the fluid storage compartment (32)".
- 9.9 This wording is unclear. It is unclear, how the mouthpiece can enclose the second end of the fluid storage compartment and at the same time enclose the second end of the cartridge.
- 9.10 Claim 1 of auxiliary request 11 and auxiliary request 12 claims the mouthpiece to be a part of the cartridge. It is unclear, how the mouthpiece that is a part

of the cartridge can be designed to enclose an end of the object, to which itself is a part, namely the cartridge.

- 9.11 The clarity of the claim is a fundamental requirement for a claim to be considered allowable, especially in view of its function in defining the matter for which protection is sought. The necessity for claims within an application to amend under R50 RoP to pertain to the requirement of clarity is emphasized by the reference to Art. 84 EPC in R 50.2 RoP. RoP 50.2 (b) requires the application to amend to contain an explanation as to why the amendments satisfy the requirements of Article 84 EPC.
- 9.12 In mn 501 DtR, Defendant merely states the amendment A4 (that contains the language “the mouthpiece (31) encloses the second end of the cartridge (30, 30a) and the second end of the fluid storage compartment (32)”) to not introduce any unclarity and for the claim language to be clear. Providing such a statement does not fulfil the requirement to explain as to why the amendments satisfy the requirements of Article 84 EPC.
- 9.13 In mn 499 DtR Defendant refers to paragraphs [0023], [0041], [00183], [00187], [00241] of the original application documents as basis for the amendment. [0023], [0041], [00183], [00187], [00241] of MWE 3 in essence are verbatim repetitions of the phrase “the mouthpiece encloses the second end of the cartridge and the second end of the fluid storage compartment”. A mere repetition of an unclear phrase does not make it clear, however. Defendant does not argue that the context, in which the phrase is placed in [0023], [0041], [00183], [00187], [00241] would render it clear – and indeed [0023], [0041], [00183], [00187], [00241] do not make the phrase any clearer. Furthermore, Defendant leaves it unexplained, what indeed is meant by the double condition that the mouthpiece (1) encloses the second end of the cartridge and (2) encloses the second end of the fluid storage compartment.
- 9.14 The application to amend the patent according to auxiliary requests 11 and 12 hence needs to be rejected.

10 Defendant’s auxiliary request (2) c.

- 10.1 As the Defendant’s applications to amend the patent need to be rejected, the subject matter to be evaluated by the Court still is the patent as granted. Procedurally, after the Court has evaluated Defendant’s application to amend and has found that the patent cannot be amended as applied for by the Defendant, what needs to be examined by the Court and what remains to be examined by the Court is the unamended patent.

- 10.2 At least in the present case, the application to amend the patent by the Defendant cannot be seen as a motion to abandon the granted patent in its entirety, if the initial request to maintain the patent as granted (request (2).a) cannot be granted in its entirety. Nothing in the Defendant's submissions can be construed to indicate, that the Defendant wants to give up the subject matter of the subordinate claims of the granted patent, if claim 1 of the granted patent cannot be upheld.
- 10.3 After having established that Defendant's application to amend need to be rejected and hence left with the unamended patent as granted, the Court according to Art. 65 (3) UPCA evaluates, if the grounds for revocation affect the patent only in part.
- 10.4 This is done by examining, if the grounds for revocation affect each attacked claim of the patent, including each attacked subordinate claim. If the Court finds that the grounds for revocation do not affect a granted claim of the patent, the Court revokes the patent only in part, namely for those granted claims, which are affected by the grounds for revocation.
- 10.5 Claimant's attack against the admissibility of request (2) c. does not convince. In essence, Claimant argues that the – in his view – excessive scope of the task to evaluate, if the grounds for revocation affect each attacked claim of the patent, including each attacked subordinate claim, already renders this request inadmissible. It is, however, the Claimant that initially determines the scope of the case. By way of requesting the (entire) patent to be revoked, Claimant set the task to evaluate, if the grounds for revocation brought forward by Claimant do indeed affect the patent in its entirety or only in part.
- 10.6 Defendant's request 2c needs to be rejected.
- 10.7 The grounds for revocation brought forward by Claimant affect the Patent in its entirety. None of the further claims 2 to 7, which each build on claim 1, specify the mouthpiece to enclose the second end of the fluid storage compartment. Hence none of the further claims 2 to 7 introduce limitations that would lead to their subject matter – in combination with claim 1, on which they build - being considered to *not* extends beyond
- the content of the earlier application European application 14873186.2 (the grandparent application),
 - the content of the application as filed, namely European Patent Application 19153728.1;

- the content of the earlier application European application 18000692.6 (the parent application), the European Patent in suit being granted on a divisional application to this earlier application.

11 Defendant's auxiliary request (2) d.

- 11.1 Defendant's auxiliary request (2) d. further develops his request to amend the patent. Art. 65.3 UPCA only pertains to the granted patent. Art. 65.3 UPCA contains no obligation to the Court to evaluate, if an application to amend the patent filed by the patent owner can be allowed in part. Within an application to amend the patent a certain claim set is either allowable (as such; the complete claim set proposed) or not.
- 11.2 Under the premise that Art. 65 (3) UPCA relates only to the granted patent, each claim constellation covered by Defendant's request (2) d. must be considered as a further auxiliary request.
- 11.3 Defendant's request (2) d. needs to be rejected.
- 11.4 From the outset, Defendant's request (2) d. is unclear and already for this reason unallowable. Defendant did not file any particular claim-sets that would indicate to the Court, which combinations of claims the Defendant would want the Court to examine under request (2) d. in which order.
- 11.5 The wording "one or more of its dependent claims as granted in combination with claim 1 of the proposed amendments of the claims of the patent in suit" leaves it undefined, which combination of claims the Defendant would like the court to start with. Defendant's request (2) d. could – as an example - be understood to mean for the Court to start with granted claim 2 in combination with claim 1 of auxiliary request 1 as much as it could mean – as an example – granted claim 6 in combination with claim 1 of the auxiliary request 1. For an orderly procedure, the requests of a party need to be precise and without ambiguity. This criterion is not met by request (2) d.
- 11.6 In addition, according to R 50.2 RoP with R 30.1 (c) proposed amendments, if they are conditional like in the present case, must be reasonable in number in the circumstances of the case. In the particular case, the proposed twelve conditional amendments that form the twelve auxiliary requests of request (2) b. are considered to be the upper limit of what can be considered reasonable. The conditional amendments that are further proposed by request (2) d. are considered not reasonable in number and hence not allowed.
- 11.7 In addition, the auxiliary request (2) d. is not supported by any arguments from the Defendant. Defendant does not argue that any of the proposed

amendments that are contained in the auxiliary request (2) d.d would provide particular reason to uphold the patent in the thus amended form.

12 Costs

12.1 In accordance with Article 69 UPCA and Rule 118.5 RoP the Defendant, as the unsuccessful party, the Patent being revoked entirely, has to bear the legal costs of the Claimant.

DECISION

Having heard the parties on all relevant aspects of the case, the Central Division:

1. Revokes European patent n° EP 3 498 115 with effect for the territories of Austria, Belgium, Denmark, Finland, France, Germany, Italy, Latvia, Luxembourg, Netherlands, Portugal and Sweden.
2. Admits documents MWE 19 to 44 and MWE 46 to MWE 50 into the proceedings.
3. Does not admit pages 1 -14 of Claimant's submission of 22. April 2024, including MWE 45.
4. Admits p. 15-80 of Claimant's submission of 22. April 2024.
5. Does not admit Defendant's submission of 31. May 2024.
6. Orders that the Registry shall send a copy of this decision to the European Patent Office and to the national patent office of any Contracting Member States concerned, after the deadline for appeal has passed
7. Defendant bears the costs of the proceedings.

NAMES AND SIGNATURES	
Judges	For the Deputy-Registrar
Presiding judge:	
Legally qualified judge:	

Technically qualified judge:	
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Information about appeal

An appeal against the present Decision may be lodged at the Court of Appeal, by any party which has been unsuccessful, in whole or in part, in its submissions, within two months of the date of its notification (Art. 73(1) UPCA, R. 220.1(a), 224.1(a) RoP).

Information about enforcement

Art. 82 UPCA, Art. Art. 37(2) UPCS, R. 118.8, 158.2, 354, 355.4 RoP.

An authentic copy of the enforceable decision will be issued by the Deputy-Registrar upon request of the enforcing party, R. 69 RegR.

Order no. ORD_598482/2023 in ACTION NUMBER: ACT_571669/2023

UPC number: UPC_CFI_309/2023

Action type: Revocation Action

Related proceeding no. Not provided Not provided

Not provided Not provided