Unified Patent Court
Einheitliches Patentgericht
Juridiction unifiée du brevet

Action n°: UPC CFI 312 /2023

Revocation action 571761/2023

DECISION

of the Court of First Instance of the Unified Patent Court

Central division Paris Seat (Section 1)
delivered on 28 February 2025
concerning EP 3 504 989

KEYWORDS: revocation, claim interpretation, clarity, added matter, admission of auxiliary claims

CLAIMANT:

NJOY Netherlands B.V. Westerdoksdjik 423, 1013BX Amsterdam, Netherlands

represented by Attorney-at-law Hon.-Prof. Dr. Henrik Holzapfel, McDermott Will & Emery, Stadttor 1, 40219 Düsseldorf, Germany

At the hearing also represented by

- Mathias Karlhuber, Cohausz & Florack
- Laura Woll, McDermott Will & Emery
- Diana Pisani, McDermott Will & Emery
- Lisa Nassi, McDermott Will & Emery

DEFENDANT:

Juul Labs International, Inc. 560 20th Street, Building 104, San Francisco, California 94107, United States of America

Represented by Bernhard Thum, Thum & Partner | Thum, Mötsch, Weickert Patentanwälte PartG mbB, Siebertstr. 6, 81675 Munich, Germany

Also at the hearing represented by

- Andreas Mötsch, German and European Patent Attorney, Thum & Partner
- Dr. Jonas Weickert, German and European Patent Attorney, Thum & Partner
- Dr. Tilman Müller, Attorney at Law, Bardehle Pagenberg

PATENT AT ISSUE

European patent EP P 3 504 989, hereafter referred to as "EP 989" 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

21 November 2024

SUMMARY OF FACTS AND REQUESTS

1 The dispute

1.1 On 15 September 2023, Claimant brought a revocation action[1] against Defendant at the Paris Central Division of the Unified Patent Court (Action n°: UPC CFI 312/2023 Revocation action 571761/2023), requesting the Court to revoke European Patent No. EP 3 504 989.

1.2 On 26 October 2023, Defendant filed a Preliminary objection No. App_583478/2023 pursuant to Rules 19.1(a) and 48 of the Rules of Procedure

[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.

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_588423/2023 UPC_CoA_436/2023.

1.3 A Statement of Defence to Revocation dated 4 December 2023 was filed on 20 December 2023. At the same time and within the same submission, an Application to amend the Patent was filed. A Reply to the Defence was submitted on 21 February 2024, including a Defence to an Application to amend the Patent. The Court also received a Rejoinder to the Reply, dated 21 March 2024, that included a Reply to the Defence to an Application to amend the Patent. On 22 April 2024, Claimant filed a Reply to the Rejoinder and Reply to Defendant's Application to amend the Patent in suit.

1.4 On 31 May 2024, the Court received a further submission by Defendant entitled "Comments to Claimant's submission of 22 April 2024 including the 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.

1.6 By order of 5 July 2024, the Court – inter alia – set out the order allowing Defendant to identify, within the set of auxiliary requests already on file, those set of claims that it wants to pursue further until 20 July 2024.

1.7 On 22 July 2024, Defendant identified 8 auxiliary requests to be pursued during the oral hearing.

1.8 On 30 August 2024, the Court received the summaries sent by the parties.

1.9 The oral hearing was held on 21 November 2024.

1.10 On 26 and 28 November 2024 the parties filed the Presentations that the parties used during the hearing via e-mail.

1.11 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 EP 3 504 989 B1 Exhibit MWE 1 entitled VAPORIZATION DEVICE SYSTEMS was filed on 23 December 2014.

2.2 As indicated by Claimant in mn. 7 SfR and undisputed by Defendant, the Patent in suit was filed on 15 February 2019 as European patent application No. 19157427.6 Exhibit MWE 3, as a divisional application of European patent application no. 14873186.2 and European patent application No.18000692.6. EP 14873186.2 was originally filed as International Patent Application No. PCT/US2014/072230, published as WO 2015/100361 A1

Exhibit MWE 5, and claimed priority from US Provisional Patent Applications Nos. 61/920,225 Exhibit MWE 6 (filed on 23 December 2013), 61/936,593 Exhibit MWE 7 (filed on 6 February 2014) and 61/937,755 Exhibit MWE 8 (filed on 10 February 2014).

2.3 The publication of the mention of the grant of the Patent was made on 9 June 2021. Registered owner of the Patent is Defendant.

2.4 According to Claimant's Statement for Revocation (SfR; mn. 6) and undisputed by Defendant, EP989 at the time of filing the SfR was valid in the following member states of the UPCA: Belgium, France, Germany, Italy, Netherlands, Portugal and Sweden. According to Claimant's Statement for Revocation (SfR; mn. 6) and undisputed by Defendant, EP989 at the time of filing the SfR was also valid in Czechia, Greece, Ireland, Poland, Romania, Spain, Switzerland/Liechtenstein and the United Kingdom.

2.5 Oppositions 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 device for generating an inhalable aerosol, the device comprising:

a device body comprising a cartridge receptacle (21) having a notched body;

a separable cartridge (30) configured to be inserted into the cartridge receptacle (21), and an airflow path comprising:

a channel (40) comprising a portion of an air inlet passage (51);

a second air passage (41) in fluid communication with the channel;

a heater chamber (37) in fluid communication with the second air passage (51);

a first condensation chamber (45) in fluid communication with the heater chamber (37);

a second condensation chamber (46) in fluid communication with the first condensation chamber (45); and

an aerosol outlet (47) in fluid communication with the second condensation chamber (46);

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).

3 Requests

3.1 Claimant requests:

I - European patent n° EP 3 504 989 be revoked with effect for the territories of Belgium, France, Germany, Italy, the 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 20 to 49 to the proceedings.

IV - The Defendant be ordered to bear the legal costs of the proceedings.

3.2 Defendant requests:

(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 as submitted on 22 July 2024 (Auxiliary Requests I, II, III, IV, V, VI, VII, VIII).

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; ((2)c. as set forth in the Statement of Defence): 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 according to one of the proposed amendments of the claims of the patent in suit ((2)d. as set forth in the Statement of Defence)

(3) documents MWE 20 to MWE 43 not be admitted into the proceedings;

(4) the Claimant bear 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 Claimant states 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 123(2) EPC),
- lack of novelty (Article 138(1)(a) EPC, with reference to Articles 52(1) and 54(2) EPC),
- lack of inventive step (Article 138(1)(a) EPC, with reference to Articles 52(1) and 56 EPC).

4.2 Regarding the issue of "added matter", Claimant in particular argues that Claim 1 of the Patent contains subject matter extending beyond the disclosures of the grandparent application PCT/US2014/072230, in the form of the following :

"*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*)".

4.3 In the statement for revocation, the claimant indicates the following :

26 Claim 1 is based on claim 159 of the corresponding PCT, **Exhibit MWE 5**. The changes made are indicated below using strikethrough and underlining.

~~159~~. A ~~cartridge for a~~ device for generating an inhalable aerosol~~, with an airflow path~~ the device comprising:

a device body comprising a cartridge receptacle (21) having a notched body;

a separable cartridge (30) configured to be inserted into the cartridge receptacle (21), and

an airflow path comprising:

a channel (40) comprising a portion of an air inlet passage (51);

a second air passage (41) in fluid communication with the channel;

a heater chamber (37) in fluid communication with the second air passage (51);

a first condensation chamber (45) in fluid communication with the heater chamber (37);

a second condensation chamber (46) in fluid communication with the first condensation chamber (45); and

an aerosol outlet (47) in fluid communication with the second condensation chamber (46);

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).

4.4 Claimant argues that in its reply to an official communication (MWE 19), the patentee alleged that claim 1 is based on original claim 159 combined with paragraph [170] of the PCT application (MWE 5). According to the Claimant, original claim 159 of the PCT application specified the presence of the channel air inlet 50 and the air inlet passage 51, but didn't specify that the channel air inlet 50 is left exposed when the cartridge 30 is inserted into the notch body.

4.5 Claimant underlines that [170] of the grandparent application, in which the channel air inlet is left exposed, is referring to a specific embodiment that is depicted in figure 14 of this application. Claimant points out that this figure 14 is a particular embodiment in which the channel air inlet 50 in the cartridge 30 is left exposed due to a notch in the notch body of the cartridge receptacle 21, but that claim 1 of the patent is not limited to the configuration depicted in figure 14. Claimant stresses that patent claim 1 does not specifiy that the channel air inlet 50 is provided on the cartridge 30 or that the channel air inlet 50 is left exposed by a notch in the notched body. Claimant adds that even by considering that original grandparent claim 159 and paragraph

[00170] were combined, the original grandparent application does not contain a basis application for a more general claim feature that is not limited to the specific arrangement shown in FIG. 14 of the grandparent application.

4.6 Claimant deduces that Patent Claim 1 extends the disclosure of the patent beyond the subject matter disclosed in the grandparent application as filed.

4.7 Arguing that, according to European patent practice, original disclosure can be provided by literal and non-literal but direct and unambiguous disclosure, and that the original application as a whole (i.e. claims, descriptions and figures) must be taken into consideration, Defendant disagrees with the Claimant, who states that claim 1 would not be limited to the specific configuration of Fig. 14. Defendant confirms that paragraph [170] relates to an embodiment which is consistent with original claim 159, as illustrated by figures 5 to 15.

4.8 According to Defendant, Claimant missed the second sentence of [170], which precises that "the size of the channel air inlet 50 may be varied by altering the configuration of the notch in the cartridge receptacle 21". Defendant says that this second sentence relates merely to an optional feature, apparent from the use of the term "may be varied", and that the first sentence discloses the feature of a channel air inlet which is exposed when the cartridge is inserted into the notched body. Defendant adds that [170] discloses the feature of a channel air inlet which is exposed when inserted into the notched body.

4.9 Defendant asserts that, from original Figs. 10A and 14 and from original paragraph [00190], it is clear that air enters the air inlet passage through the channel air inlet. Defendant concludes that the feature, according to the channel air inlet (50) is left exposed when the separable cartridge (30) is inserted into the notched body of the cartridge receptacle (21), finds direct and unambiguous basis in the original application and is disclosed.

GROUNDS FOR THE DECISION

5 Late-filed facts and evidence

5.1 Defendant requests documents MWE 20 to MWE 43 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 20 to 49 to the proceedings.

5.2 Due to the front-loaded approach of the UPC system, Rule 44 RoP requires the Statement for revocation to contain an indication of the facts relied on (Rule 44 (f) RoP) and the evidence relied on, where available and an indication of any further evidence which will be offered in support (Rule 44 (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 for Revocation, which it has plenty of time to prepare. However, when submitting the Statement for Revocation, Claimant cannot anticipate which points Defendant will dispute or the means by which it will do so. Therefore, in its Reply to the Statement of Defence, Claimant is allowed to present arguments in response to arguments raised by Defendant in its Statement of Defence.

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 Defence and Hajaligol Declaration

5.5 In its Reply to the Statement of Defence dated 21 February 2024, Claimant filed 24 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 20) and all enclosures.

5.6 The Hajaligol report is admissible as far as it is a reaction to arguments submitted in the Statement of Defence. 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. Their submission is therefore admissible.

5.7 The "Hajaligol Declaration" is also admissible as far as it can be considered 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.

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

5.8 Rule 52 RoP delineates the scope of the Rejoinder to the Reply to the Defence to Revocation. According to Rule 52 RoP '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 (19 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. 20-36 of the Rejoinder are a response to 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, the response thereto should also be admitted. P. 20-36 are therefore admitted.

5.11 P. 36-74 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-13) is admissible, as it can be considered 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 21 March 2024 is also admissible as far as it is commenting on the Application to amend the patent. Therefore, p. 75 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 Defendant's Application to amend the Patent in suit. P. 15-60 deal with Defendant's Application to amend the Patent in suit and are therefore admissible, including MWE 46 to MWE 49 that form part of this Rejoinder.

5.16 According to Rule 32.3 second sentence RoP, the 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. 4 to 14 of Claimant's submission of 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 to 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 EP 989 pertains to vaporization device systems. According to [0002] EP989 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 EP 989 describes DE 196 19N536 A1 to disclose a device for inhaling a powder. The device comprises an inhaler that is inserted into a plate having multiple holes containing a powder. The powder is protected by a covering foil made of aluminium. The inhaler has a mouthpiece, a handle, a suction tube and a blade to pierce the covering foil.

7 The claimed subject matter

7.1 Claim 1 of the Patent can be divided into the following features:

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

1.2 a device body comprising a cartridge receptacle (21) having a notched body;

1.3 a separable cartridge (30) configured to be inserted into the cartridge receptacle (21), and

1.4.1 an airflow path comprising: a channel (40) comprising a portion of an air inlet passage (51);

1.4.2 a second air passage (41) in fluid communication with the channel;

1.4.3 a heater chamber (37) in fluid communication with the second air passage (51);

1.4.4 a first condensation chamber (45) in fluid communication with the heater chamber (37);

1.4.5 a second condensation chamber (46) in fluid communication with the first condensation chamber (45); and

1.4.6 an aerosol outlet (47) in fluid communication with the second condensation chamber (46);

1.4.7 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).

With the DtR Defendant suggests a different feature analysis, namely

- first the airflow path is numbered 1.4 as the generic term and
- second the last feature "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)" is numbered feature 1.5 instead of feature 1.4.7 since this feature describes the interaction of the channel air inlet and the separable cartridge.

For the purpose of the present decision, the Court will use the feature analysis as provided by the Claimant. The outcome of this decision is not dependent on whether or not the term "the airflow path" is identified as a generic term by way of using an individual number nor is it dependent on using a number of higher hierarchy-level (1.5 instead of 1.4.7) for the last feature group of the claim.

Some features of claim 1 of the Patent require interpretation.

Legal framework

7.2 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*).

7.3 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.

7.4 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 both 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.

7.5 In applying these principles, the aim is to combine adequate protection for the patent proprietor with sufficient legal certainty for third parties.

7.6 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.

7.7 The patent claim must be interpreted from the point of view of a person skilled in the art. The person skilled in the art (skilled person) is a legal 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.

The skilled person

7.8 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.

7.9 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 11)).

7.10 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.

7.11 Claimant states that, alternatively to a mechanical engineer, the skilled person could possess a Bachelor's or Master's degree in chemistry or physics or a related field or someone from a related field (mn 11 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 20 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

7.12 *Feature 1.2: "a device body comprising a cartridge receptacle (21) having a notched body"*

7.13 This feature defines the device body to have a notched body. The skilled person understands this to define a notch to be present on the device body, as this makes the device body a notched body. To the skilled person's understanding, feature 1.2 leaves it open, however, where on the device body the notch is present.

7.14 *Feature 1.4.7: "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)."*

7.15 To the skilled person's understanding, this feature provides a description of the configuration of the channel air inlet in the assembled state of the device for generating an inhalable aerosol. In the assembled state, the channel air inlet is left exposed.

7.16 Feature 1.4.7 makes reference to the notched body. To the skilled person, the reference to the notched body of the cartridge receptacle in feature 1.4.7 is simply made to define the body into which the separable cartridge is inserted. To the skilled person, feature 1.4.7 does not define the notch of the notched body as means for leaving the channel air inlet exposed.

7.17 To the skilled person's understanding, feature 1.4.7 also defines a spatial relationship of the channel air inlet and the air inlet passage that both form parts of the airflow path.

7.18 As one member of the airflow path, feature 1.4.6 defines an aerosol outlet in fluid communication with the second condensation chamber. To the skilled person's understanding the aerosol outlet is final part of the airflow path, namely the part where the aerosol to be generated by the claimed "device for generating an inhalable aerosol" leaves the device. To the skilled person's understanding the reference to the aerosol outlet being in fluid communication with the second condensation chamber indicates that the fluid that is to leave the aerosol outlet as inhalable aerosol flows there (directly or indirectly) from the second condensation chamber. To the skilled person understanding, within the airflow path defined in claim 1, the second condensation chamber is placed upstream of the aerosol outlet. Based on the same considerations, feature 1.4.5 to the skilled person's understanding defines within the airflow path defined in claim 1 the first condensation

chamber to be upstream of the second condensation chamber. Based on the same considerations, feature 1.4.4 to the skilled person's understanding defines within the airflow path defined in claim 1 the heater chamber to be upstream of the first condensation chamber. Based on the same considerations, feature 1.4.3 to the skilled person's understanding defines within the airflow path defined in claim 1 the second air passage to be upstream of the heater chamber. Based on the same considerations, feature 1.4.2 to the skilled person's understanding defines within the airflow path defined in claim 1 the channel to be upstream of the second air passage.

7.19 In the context of this understanding, the skilled person understands the reference in feature 1.4.7 to air that enters the air inlet passage through a channel air inlet to indicate that the channel air inlet is upstream of the air inlet passage. Air that is drawn into the device from the outside first flows through the channel air inlet, through which it then enters the air inlet passage.

7.20 In the context of this understanding, the skilled person understands the term "is left exposed" in feature 1.4.7 to indicated that the channel air inlet is exposed to the ambient air that surrounds the device when the separable cartridge is inserted into the notched body of the cartridge receptacle. According to the skilled person's understanding, the ambient air that surrounds the device enters the device via the channel air inlet.

8 Validity

8.1 The Patent as granted is not valid. It extends beyond the content of the grandparent application PCT/US2014/072330 =WO 2015/100361 A1, MWE 5.

Legal framework

8.2 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 directly and unambiguously derive, 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).

8.3 Given that the Patent is a 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 European application as filed No. 1915427.6 (MWE 3);
2. the Patent extends beyond the content of the parent application EP 18000692.6;
3. the European Patent extends beyond the content of the grandparent application EP 14873186.2 (MWE 5).

Granted claim 1 is not disclosed verbatim in the applications

8.4 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 the European application as filed No. 1915427.6 (MWE 3); nor in the parent application EP 18000692.6 nor the grandparent application EP 14873186.2.

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

8.5 Based on a comparison between claim 159 of (to which Defendant refers as basis for the granted claim 1)

159. A cartridge for a device for generating an inhalable aerosol with an airflow path comprising:

a channel comprising a portion of an air inlet passage;

a second air passage in fluid communication with the channel;

a heater chamber in fluid communication with the second air passage;

a first condensation chamber in fluid communication with the heater chamber;

a second condensation chamber in fluid communication with the first condensation chamber; and

an aerosol outlet in fluid communication with second condensation chamber.

and in particular with reference to the feature

"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)"

Claimant points out that claim 1 as granted (1) does not specify that the channel air inlet 50 (mn 32, SoR) is provided on the cartridge 30 and (2) does not specify that the channel 50 is left exposed by a notch in the notch body. To Claimant's view, even when combining the original grandparent claim 159 and paragraph [00170],

> **[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**.

relied upon by Defendant, there would be no basis in the original grandparent application for a more general claim feature that is not limited to the specific arrangement shown in FIG. 14 of the grandparent application.

8.6 Claimant has shown that there are differences between the basis of disclosure relied upon by the Defendant and the granted claim 1 that are to be considered for the patent to contain subject matter that extends beyond the content of the application as filed. As a consequence, it is 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 159) 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.

8.7 Original claim 159 of the grandparent application (MWE5) reads

> 159. A cartridge for a device for generating an inhalable aerosol with an airflow path comprising:
>
> a channel comprising a portion of an air inlet passage;
>
> a second air passage in fluid communication with the channel;
>
> a heater chamber in fluid communication with the second air passage;
>
> a first condensation chamber in fluid communication with the heater chamber;
>
> a second condensation chamber in fluid communication with the first condensation chamber; and
>
> an aerosol outlet in fluid communication with second condensation chamber.

8.8 Claim 159 makes no reference to a notch or a notched body. The question arises whether Defendant has shown that MWE 5 – while it does not disclose literally in claim 159 a notch or a notched body – in another way discloses for a channel air inlet through which air enters the air inlet passage which is left

exposed when the separable cartridge is inserted into the notched body of the cartridge receptacle, which is a feature of the granted claim.

8.9 Paragraph [00170], referred to by Defendant for that purpose, of the grandparent application (MWE5) reads

> **[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**.

8.10 Figure 14 of the document MWE5, the same that Fig. 14 of the patent, explicitly referred to in paragraph [00170] is the following :

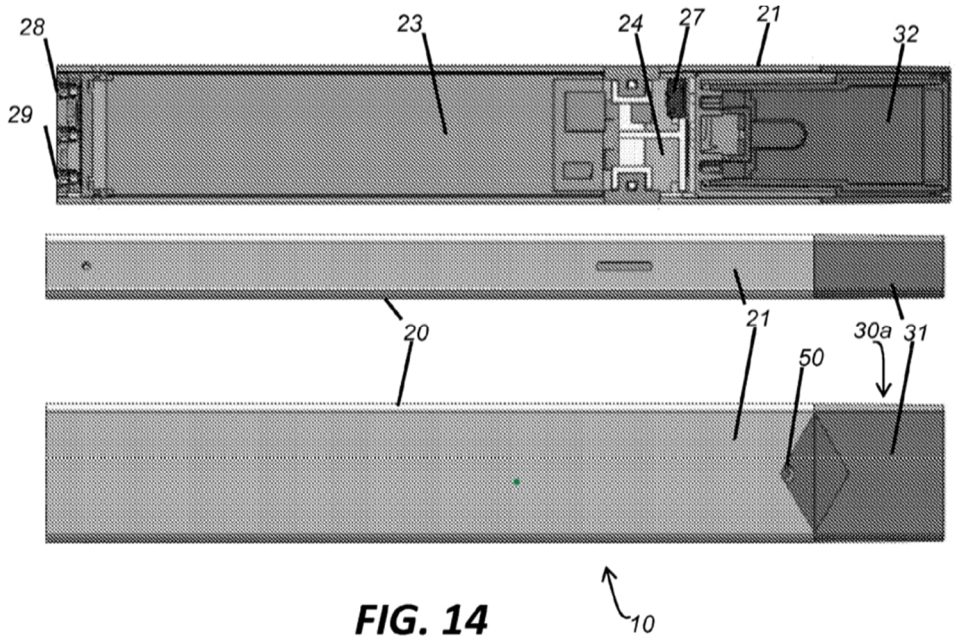


FIG. 14

8.11 Paragraph [00170] of MWE 5 is a text portion of the grandparent application that describes a particular embodiment, namely the one shown in Fig. 14. Paragraph [00170] explicitly states that it is referring to Fig. 14. The disclosure of [00170] to the skilled person hence is not a disclosure of generic features. As regards their disclosure, paragraph [00170] and Fig. 14 are intrinsically linked; only what the skilled person can take from them when looking at them jointly can be considered as being disclosed to the skilled person. Nothing in paragraph [00170] indicates to the skilled person that this paragraph is intended to disclose to the skilled person something else.

8.12 Paragraph [00170] describes Fig. 14 to show the channel air inlet 50 to be left exposed. From Fig. 14, referred to in that very sentence, the skilled person takes that it is the notch in the cartridge receptacle 21 that leaves the channel air inlet 50 to be left exposed. The presence of the notch and the effect of leaving the channel air inlet 50 exposed when the pod 30a (which the skilled

person understands to be a cartridge) is inserted into the notched body of the cartridge receptacle 21 hence are intrinsically linked to each other in the skilled person's understanding.

8.13 Granted claim 1 does not link the effect of leaving the channel air inlet 50 exposed when the cartridge is inserted into the notched body of the cartridge receptacle 21 to the notch. The amendment made to original claim 159 of the grandparent application MWE 5 hence 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.

8.14 Defendant further argues that the second sentence of paragraph [00170] relates merely to an optional feature, which Defendant sees apparent from the use of the term "may be varied." To the Defendant's view the first sentence discloses the feature of a channel air inlet which is exposed when inserted into the notched body.

8.15 This argument cannot convince. Already when evaluating the teaching of the first sentence of paragraph [00170] in conjunction with Fig. 14, the skilled person learns that it is the notch of the notched body that causes the effect described in that very sentence, namely leaving the channel air inlet 50 exposed when the pod 30a is inserted into the notched body of the cartridge receptacle 21 (the term "notched body" also explicitly being used in that very first sentence). In addition, when seen in conjunction with the first sentence, the term "may be varied" used in the second sentence is understood by the skilled person as a disclosure of how the effect of leaving the channel air inlet 50 exposed when the pod 30a is inserted into the notched body of the cartridge receptacle 21 can be increased or reduced. The second sentence hence is a reinforcement of the disclosure of what the first sentence says in conjunction with Fig. 14. The second sentence describes, how an effect that the skilled person already derives from the first sentence in conjunction with Fig. 14 can be increased or reduced.

8.16 For the reasons given above, the Patent cannot be maintained as granted in its entirety.

9 Defendant's Auxiliary Requests

Request (1)/ Request (2) a

9.1 The Patent cannot be maintained as granted in its entirety. Defendant's request (1), according to which the revocation action is to be dismissed, is

rejected. Similarly, request (2) a., according to which the patent be maintained as granted, is to be rejected.

Request (2) b. in the numbering of this decision

9.2 With request (2) b. in the numbering of this decision, Defendant requests to amend the patent based on the Auxiliary Requests I to VIII as submitted on 22 July 2024.

9.3 The Court uses the discretion given within Rule 9.2 RoP and – contrary to Claimant's request - will not disregard the auxiliary requests I to VIII filed by Defendant on 22 July 2024. The order of 05. July 2025 gave Defendant the option ("may identify") to narrow down the set of auxiliary requests already on file. The Court considers Defendant's motion to narrow down the auxiliary to the auxiliary requests I to VIII as expedient for an efficient procedure and hence beneficial to Claimant, too. Without the motion to file the auxiliary requests I to VIII, the originally filed auxiliary requests 1 to 55 (filed with DtR) would have remained on file to be dealt with in a manner that would yet have to be decided. 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 I in the version of 22. July 2024

9.4 Auxiliary request I in the version of 22. July 2024 (AR1 in the following) is allowable. The amendment to the patent applied for by way of this auxiliary request renders the reasons for revocation raised by the Claimant mood.

9.5 According to AR1, claim 1 is amended as follows (highlighting of amendments as provided by Defendant in submission of 22. July 2024):

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

a device body comprising a cartridge receptacle (21) having a notched body; and

a separable cartridge (30) configured to be inserted into the cartridge receptacle (21), andwherein the separable cartridge (30) comprises an airflow path,

anthe airflow path comprising:

a channel (40) comprising a portion of an air inlet passage (51);

a second air passage (41) in fluid communication with the channel;

a heater chamber (37) in fluid communication with the second air passage (51);

a first condensation chamber (45) in fluid communication with the heater chamber (37);

a second condensation chamber (46) in fluid communication with the first condensation chamber (45); and

an aerosol outlet (47) in fluid communication with the second condensation chamber (46);

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), wherein the notched body has a notch, wherein a size of the channel air inlet (50) is defined by a configuration of the notch.

2. The device of claim 1,

wherein the cartridge comprises a fluid storage compartment (32) and wherein the channel (40) is integral to an exterior surface of the cartridge, wherein the channel forms a first side of the air inlet passage (51), 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.

9.6 AR1 is Auxiliary Request 14 of the DfR. AR1 includes the amendments A1, A2, A3 and A10. Claimant presented his arguments against the allowability of these amendments in the RtD and the submission of 22. April 2024.

9.7 As a general remark, Claimant states that Fig. 14 includes a number of other features that are not specified in the granted patent claim 1, such as battery 21, printed circuit board 24, pressure sensor 27, charging contact 28, magnetic contact 29 and fluid storage compartment 32. Claimant argues that the skilled person considering paragraphs [00170] and [00171] of the Patent, in conjunction with FIG. 14, would be required to make a seemingly arbitrary selection of features, including the notch and its configuration and the heater, but disregarding the battery and so on, without any pointer or guidance from the Patent.

9.8 This argument does not convince. While being intrinsically linked to Fig. 14 (as indicated above) the teaching of paragraph [00170] is understood by the skilled person to be solely directed to the provision of a channel air inlet 50,

the effect of leaving it exposed and means for influencing its size. To the skilled person's understanding, none of the elements indicated by the Claimant (battery 21, printed circuit board 24, pressure sensor 27, charging contact 28, magnetic contact 29 and fluid storage compartment 32) directly influence the provision of a channel air inlet 50, the effect of leaving it exposed or the means for influencing its size. Hence, while Fig. 14 as a particular embodiment does indeed disclose this embodiment to have a battery 21, printed circuit board 24, pressure sensor 27, charging contact 28, magnetic contact 29 and fluid storage compartment 32, the skilled person understands that what is taught in paragraph [00170] is not linked to these additional elements. To the skilled person's understanding to obtain the technical effect intended with the provision of the features described in paragraph [00170] it is not necessary to also provide the further elements, namely a battery 21, printed circuit board 24, pressure sensor 27, charging contact 28, magnetic contact 29 and fluid storage compartment 32. This is further supported by the fact that these elements are not shown in the plan view of figure 14, that illustrates the notch and the channel air inlet, which indicates a lack on intrinsic link between these features and the particular configuration of the notch and the channel air inlet.

9.9 As regards the further features of Fig. 14 identified by Claimant, amending claim 1 in the manner proposed by Defendant with AR1 does not results in the skilled person being presented with information which is not directly and unambiguously derivable from that previously presented by the application. The amendment proposed by way of AR1 is made within the limits of what a skilled person directly and unambiguously derives, 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.

Added Subject Matter and Lack of Clarity for AR1

9.10 As regards possibly contravening Art. 76 (1), 84 and 123 (2) EPC, Claimant only provides arguments regarding the use of Amendment A1 in the context of Auxiliary Request 1 and 11 filed with the DtR and not as regards Auxiliary Request 14 of the DtR, which is the present AR1.

9.11 As regards Amendment A2, Claimant argues that amendment A2 does not specify how the notch configuration defines the size of the channel air inlet. According to Claimant's view the claim does not specify that the channel air inlet is left exposed by the notch.

9.12 This argument does not convince. Amendment A2 states that "a size of the channel air inlet (50) is defined by a configuration of the notch." According to the wording of the amended claim 1, the channel air inlet is the object that is being left exposed. The amendment A2 now specifies that the size of the channel air inlet (that is: the size of that object that is being left exposed) is defined by a configuration of the notch. To the skilled person's understanding this means that it is the notch that exposes the channel air inlet.

9.13 From the use of the term "altering the configuration of the notch" the skilled person understands that the teaching of paragraph [00170] is not limited to the particular V-shaped form of the notch as shown in Fig. 14, but that other sizes and shapes of notches are possible to leave exposed the channel air inlet. It is hence not necessary to include a description of the particular notch shown in Fig. 14 into claim 1.

9.14 By way of Amendment A2 the unallowable amendment identified above for the granted patent is turned into an allowable amendment.

9.15 Claimant further criticizes that amendment A2 seems to be defined by a result to be achieved, when the manner in which the notch defines the size of the channel air inlet could be defined by structural features. Claimant considers this to contravene Article 84 EPC. This argument does not convince. The term "configuration" in the term "configuration of the notch" is understood by the skilled person as the noun "configuration" in the sense of a general reference to the size and shape of the notch and hence as a general description of the structural features of the notch.

9.16 The Court does not consider the patent in the amended form as proposed by AR1 to contrave Art. 76 (1), 84 and 123 (2) EPC.

Novelty

9.17 The subject matter of claim 1 of AR1 is new over the disclosure of Chinese Patent Application Publication No. 101843368 A (hereinafter referred to as "Chen", particular reference being made to the English translation as provided by Exhibit MWE 10a) and the disclosure of U.S. Pre-grant Patent Application Publication No. 2011/0036346 A1 (hereinafter referred to as "Cohen").

Novelty over „Chen"

9.18 "Chen" does not disclose the feature "wherein the notched body has a notch, wherein a size of the channel air inlet (50) is defined by a configuration of the

notch." The subject matter of amended claim 1 according to AR1 hence is new over "Chen".

9.19 Claimant supports his statement that the subject matter of amendment A2 is disclosed by „Chen" by arguing that the notches ("semicircular holes") 21 of „Chen" interact with the cartridge ("mouthpiece") 1 of „Chen" to form a channel air inlet that is exposed when the cartridge is installed, and the configuration of the semicircular holes play a role in defining the size of that channel air inlet. Claimant hence only identifies notches that – to Claimant's view – at the same time are the channel air inlet.

9.20 As correctly stated by the Defendant, the notch is not the same as the channel air inlet. As stated above, the Amendment A2 to the skilled person's understanding means that it is the notch that exposes the channel air inlet.

9.21 Claimant has not shown that „Chen" discloses a notch that exposes the channel air inlet (and hence needs to be something different to the channel air inlet that is being exposed by the notch).

Novelty over „Cohen"

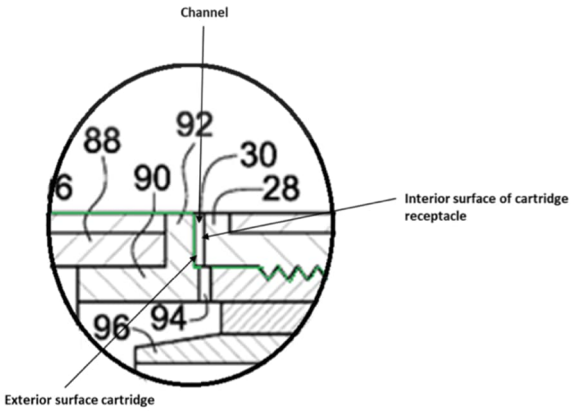
9.22 "Cohen" does not disclose the feature of granted claim 2, now added to claim 1, namely "wherein the cartridge comprises a fluid storage compartment (32) and wherein the channel (40) is integral to an exterior surface of the cartridge, wherein the channel forms a first side of the air inlet passage (51), 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.", because Cohen does at least not show "the channel (40) is integral to an exterior surface of the cartridge". The subject matter of amended claim 1 according to AR1 hence is new over "Cohen".

9.23 This features defines the air inlet passage to be made up of several sides. This feature defines that the channel forms a first side of the air inlet passage. This feature also defines that an internal surface of the cartridge receptacle in the device forms a second side that the channel.

9.24 In the context of this feature, the skilled person understands the term "channel" to be a surface feature of the exterior surface of the cartridge, like a groove, a trough, a depression, a dent, a furrow, a trench, a crease, and a gutter or the like ([0021] of the patent specification supporting this understanding of the skilled person). To the skilled person's understanding this surface feature provides the predominant portion of the air inlet passage, but to the skilled person is partially open, wherein an internal surface of the cartridge receptacle in the device that forms a second side of the air inlet

passage complements this partially open surface feature, closing it and hence completing the air inlet passage.

9.25 In the context of claim 2 of the granted patent (from which Amendment A2 stems) Claimant provides the following picture that is based on Fig. 8 of „Cohen“



Claimant states that when the atomizing unit 14 is inserted into the electronics section 12, the annular flange 92 of the atomization unit of the cartridge abuts the flange 28 of the electronic section of the device. To Claimant's view, in this arrangement, the surface of the annular flange 92 and the surface of the flange 28 contact each other and have side-openings within their walls that align and permit air to flow in and out. Specifically, claimant points out that the flange 28 includes a number of slots 30 built into its surface, such that when the flange 28 meets the annular flange 92, a corresponding number of openings are formed between the internal surface of the slots 30 (cartridge receptacle/electronics section) and the exterior surface of the annular flange 92 (cartridge/CAUCC).

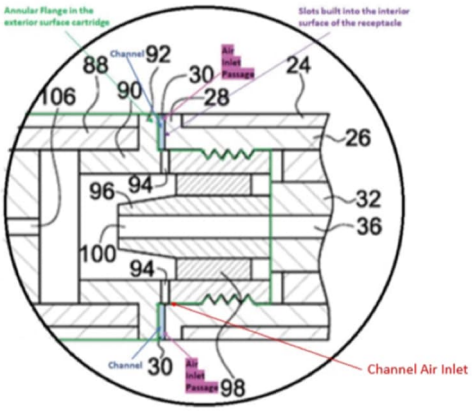
9.26 This understanding of the disclosure of „Cohen“ does, however, not show the feature of amendment A3. The flange 92 of the atomization unit is a flat surface. This flat surface does not show a channel as a surface feature, like a groove, a trough, a depression, a dent, a furrow, a trench, a crease, and a gutter or the like. The slots 30, referred to by Claimant, are surface features of the flange 28 and hence of the device body, but not of the cartridge.

9.27 The hole 94 also referred to by Claimant does not form a first side of the air inlet passage that then is supplemented by an internal surface of the cartridge receptacle in the device as a second side of the air inlet passage. The skilled person does not consider a hole, like the hole 94, to be a "channel" in the sense of a surface feature like a groove, a trough, a depression, a dent, a furrow, a trench, a crease, and a gutter or the like that needs to be

supplemented by an internal surface of the cartridge receptacle to form an air inlet passage.

9.28 Furthermore, "Cohen" does not disclose the feature-combination of feature 1.4.7 and the newly added feature "wherein the notched body has a notch, wherein a size of the channel air inlet (50) is defined by a configuration of the notch." The subject matter of amended claim 1 according to AR1 hence is new over "Chen" also for this reason.

9.29 As regard the channel air inlet, Claimant argues a channel air inlet to be formed by the radial holes 94. To illustrate his view, Claimant provides the following annotated excerpt from Fig. 8 of „Cohen":



9.30 If Claimant's view were to be followed, the channel would be arranged upstream of the channel air inlet.

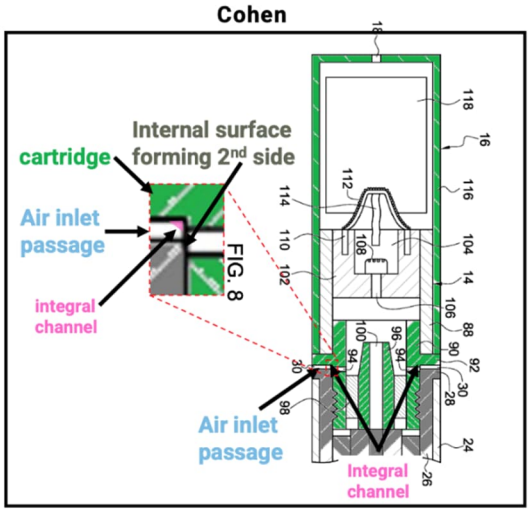
9.31 As regards feature 1.4.7 Claimant argues that „Cohen" anticipates Feature 1.4.7. Claimant indicates „Cohen"'s atomizer unit 14 and cartridge 16 in the fixed together to form ("combined atomizer unit-cartridge component" 14, 16 (herein referred to as a "CAUCC")) to include flange 92 on the exterior side of the atomizing unit 14. Claimant states that when the CAUCC 14, 16 and the receptacle of the electronic section 12 are joined, the flanges 28, 92 abut each other. To Claimant's view, air inlet passages are formed in this manner by respective slots 30 in the flange 28 of the first coupling 26 and an opposing surface of the flange 92 of the second coupling 90. These air passages to Claimant's view form exposed air inlet passages that allow passage of air from outside of the device into the device.

9.32 As indicated above, the skilled person understands the reference in feature 1.4.7 to air that enters the air inlet passage through a channel air inlet to indicate that the channel air inlet is upstream of the air inlet passage. Air that is drawn into the device from the outside first flows through the channel air inlet, through which it then enters the air inlet passage.

9.32.1 Applying claimant's understanding of the location of the channel air inlet, feature 1.4.7 is not shown in „Cohen", as it is downstream of the channel (which forms part of the air inlet passage) and not upstream of the channel as required by feature 1.4.7.

9.33 Moreover and in addition, applying claimant's understanding of the location of the channel air inlet this would not be left exposed when the separable cartridge is inserted into the notched body of the cartridge receptacle. As indicated above, according to the skilled person's understanding, the ambient air that surrounds the device enters the device via the channel air inlet. In Claimant's understanding, the channel air inlet would, however, be arranged deep down in the device and air would enter the device via the channel. Hence, „Cohen" does now show feature 1.4.7 also for this reason.

9.34 As regards a disclosure of an air inlet passage, in the hearing of 21. November 2024 Claimant provided the view that can best be presented by way of a figure presented by Claimant as part of their presentation in the hearing:



9.35 This manifests the view that according to Claimant's understanding the air enters the device via the air inlet passage (and not via a channel air inlet as required by claim 1).

9.36 Even if Claimant had meant the blue writing "Air inlet passage" to mean "Channel air inlet", „Cohen" would not disclose the subject matter of claim 1 of AR1. The notch is not the same as the channel air inlet. As stated above, the Amendment A2 to the skilled person's understanding means that it is the notch that exposes the channel air inlet. In „Cohen", the "notch" is provided by the slots 30 in the flange 28 (the part to which the black arrow next to the term "Air inlet passage" points in the above figure). Give that these slots 30 are the notches, they cannot be considered to be a channel air inlet.

9.37 Claimant has not shown that „Chen“ discloses a notch that exposes the channel air inlet (and hence needs to be something different to the channel air inlet that is being exposed by the notch).

Inventive step

9.38 Having regard to “Chen” or “Cohen”, the subject matter of claim 1 of AR1 is to be considered as involving an inventive step, because having regard to “Chen” or “Cohen, the subject matter of claim 1 of AR1 is not obvious to a person skilled in the art.

9.39 As indicated above, “Chen” does not disclose the feature “wherein the notched body has a notch, wherein a size of the channel air inlet (50) is defined by a configuration of the notch.” Claimant has not provided the Court with a convincing argument, how it would be obvious to the skilled person to provide this feature within the device disclosed in “Chen”.

9.40 As indicated above, “Cohen” does not disclose the feature of granted claim 2, now added to claim 1, namely “wherein the cartridge comprises a fluid storage compartment (32) and wherein the channel (40) is integral to an exterior surface of the cartridge, wherein the channel forms a first side of the air inlet passage (51), 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.” Claimant has not provided the Court with a convincing argument, how it would be obvious to the skilled person to provide this feature-combination within the device disclosed in “Cohen”.

9.41 As indicated above, “Cohen” does not disclose the feature-combination of feature 1.4.7 and the newly added feature “wherein the notched body has a notch, wherein a size of the channel air inlet (50) is defined by a configuration of the notch.” Claimant has not provided the Court with a convincing argument, how it would be obvious to the skilled person to provide this feature-combination within the device disclosed in “Cohen”.

10 Extend of protection

10.1 For the reasons given above, the European patent n° EP 3 504 989 is to be maintained with effect for the territories of Belgium, France, Germany, Italy, the Netherlands, Portugal and Sweden with the extent of the protection conferred by the set of claims as provided by Auxiliary Request 1 in the version filed on 22. July 2024 and repeated above.

10.2 For avoidance of doubt, the set of claims as provided by Auxiliary Request 1 in the version filed on 22. July 2024 is repeated below:

Claims according to Auxiliary Request I (clean)
[Auxiliary Request 14 as filed on 4 December 2023]

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

a device body comprising a cartridge receptacle (21) having a notched body; and

a separable cartridge (30) configured to be inserted into the cartridge receptacle (21), wherein the separable cartridge (30) comprises an airflow path,

the airflow path comprising:

a channel (40) comprising a portion of an air inlet passage (51);

a second air passage (41) in fluid communication with the channel;

a heater chamber (37) in fluid communication with the second air passage (51);

a first condensation chamber (45) in fluid communication with the heater chamber (37);

a second condensation chamber (46) in fluid communication with the first condensation chamber (45); and

an aerosol outlet (47) in fluid communication with the second condensation chamber (46);

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), wherein the notched body has a notch, wherein a size of the channel air inlet (50) is defined by a configuration of the notch,

wherein the cartridge comprises a fluid storage compartment (32) and wherein the channel (40) is integral to an exterior surface of the cartridge, wherein the channel forms a first side of the air inlet passage (51), 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.

2. The device of claim 1, wherein the second air passage (41) is formed through the material of the cartridge from an exterior surface of the cartridge to the fluid storage compartment (32).

3. The device of claim 1 or 2, wherein the channel (40) comprises at least one of a groove, a trough, a depression, a dent, a furrow, a trench, a crease, and a gutter.

4. The device of any of claims 1 to 3, wherein the channel (40) comprises walls that are either recessed into a surface where the channel (40) is formed or protrude from the surface where the channel (40) is formed.

11 Costs

11.1 Both parties only succeed in part. While the Claimant succeeds with his request to revoke the patent as granted, Defendant's application to amend

the patent is successful. In accordance with Article 69.2 UPCA and Rule 118.5 RoP, the Court orders that the parties bear their own costs.

DECISION

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

1. Maintains European patent n° EP 3 504 989 with effect for the territories of Belgium, France, Germany, Italy, the Netherlands, Portugal and Sweden as amended by Auxiliary Request 1 in the version filed on 22. July 2024 and repeated above.
2. Admits documents MWE 20 to MWE 43 and MWE 46 to 49 into the proceedings.
3. Does not admit pages 4-14 of Claimant's submission of 22 April 2024, including MWE 45.
4. Admits p. 15-60 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. Orders the parties to bear their own costs.

NAMES AND SIGNATURES	
Judges François Thomas, Presiding judge and judge-rapporteur: FRANÇOIS PAUL ETIENNE Thomas. Signature numérique de FRANÇOIS PAUL ETIENNE Thomas Date : 2025.02.28 11:49:47 +01'00' Maximilian Haedicke, Legally qualified judge: Maximilian Wilhelm Haedicke. Digital signiert von Maximilian Wilhelm Haedicke DN: cn=Maximilian Wilhelm Haedicke, c=DE Datum: 2025.02.28 13:10:11 +01'00' Max Tilmann, Technically qualified judge:	For the Deputy-Registrar Marielle BRASSEUR Date : 2025.02.28 14:41:12 +01'00'

Max Wilhelm Tilmann Digital unterschrieben von Max Wilhelm Tilmann Datum: 2025.02.28 12:06:42 +01'00'	

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, Rule 220.1(a), 224.1(a) RoP).

Information about enforcement
Art. 82 UPCA, Art. 37(2) UPCA, Rule 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, Rule 69 RegR.

ORDER DETAILS

Order no. ORD_10060/2025 in ACTION NUMBER: ACT_571761/2023
UPC number: UPC_CFI_312/2023
Action type: Revocation Action
Related proceeding no. Not provided Not provided
Not provided Not provided