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EUROPEAN PATENT OFFICE

M U N I C H

Ihr Zeichen *Your Ref.:* 2 782 463

Unser Zeichen *Our Ref.:* 42952-EP

September 15, 2017

**European Patent 2 782 463 (12 805 612.4-1656)**

**Patentee: Philip Morris Products S.A.**

**Opponent: Withers & Rogers LLP**

**Regarding the opposition by Withers & Rogers LLP, dated March 28, 2017 and the EPO's Communication of May 9, 2017:**

**I. Request**

On behalf of the Patentee we request that the opposition be rejected and European Patent 2 782 463 (in the following referred to as the patent in dispute) be maintained in the form as granted.

As an auxiliary measure we request oral proceedings in the event the Opposition Division were not to maintain the patent in dispute in unchanged form based on the written submissions.

Patentee reserves the right to optionally submit one or more auxiliary requests in the future.

**Abitz & Partner**

Abitz & Partner  
Patentanwälte mbB

Registergericht  
München PR 18

**Dr.-Ing. Walter Abitz**  
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Dipl.-Phys.  
**Martin Gritschneider**  
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In Kooperation mit:  
**Gritschneider  
und Partner**

Rechtsanwälte  
Steuerberater

Attorneys at Law  
Tax Consultants

Registergericht  
München PR 259

RAI Strategic Holdings, Inc.  
Exhibit 2032  
Philip Morris Products, S.A. v. RAI Strategic Holdings, Inc.  
IPR2020-00919

## II. No addition of subject-matter

On page 2 of the opposition substantiation the Opponent alleges that the limitation of granted claim 1 of the patent in dispute to include the feature "*the extractor remains coupled to the aerosol-generating device in both first and second positions*" is not originally disclosed in the application as filed, i.e. WO 2013/076098 (designated as document A1 by the Opponent). The Opponent only refers to original claim 11 to support the allegation.

It is submitted that the disclosure in original claim 11 (see page 27, lines 14 to 28 of A1) provides sufficient basis for the limitation of claim 1 as granted. It is also submitted that the description at least at page 2, lines 13 to 22, and especially lines 20 to 22 of A1, provides sufficient basis for the limitation of claim 1 of the patent in dispute.

Thus, no subject-matter extending beyond the content of the application as filed has been added and claim 1 as granted is in compliance with Art. 123(2) EPC.

## III. Sufficiency of disclosure

On page 3 of the opposition substantiation the Opponent alleges that claims 1 and 2 of the patent in dispute contravene Art. 83 EPC. Both allegations are unsubstantiated as will be shown in the following.

With respect to claim 1 of the patent in dispute the Opponent alleges that the claim covers embodiments wherein the extractor is not coupled in any way to the aerosol-generating substrate, whereas the description only provides examples wherein the extractor is coupled to a smoking article comprising the substrate.

As an initial point, the argumentation used by the Opponent confirms that the patent in dispute indeed contains in the specification a variety of examples how to carry out the invention, meaning that Art. 83 EPC is fulfilled.

It is also emphasized that the "*patent must be construed by a mind willing to understand, not a mind desirous of misunderstanding*", meaning that technically illogical interpretations should be excluded (see Case Law of the Boards of Appeal

of the European Patent Office, Eighth Edition, July 2016, II.A.6.1., first paragraph; page 287 of the English edition).

The skilled person is aware that claim 1 requires an extractor that has an operating position, wherein the substrate is in contact with the heater, and an extraction position, wherein the substrate is separated from the heater. The skilled person is also aware that the description enables several embodiments of an extractor that has an operating position and an extraction position to be produced, as defined in claim 1. A mind willing to understand would not seek to construct illogical embodiments of the invention; rather, as we have stated above, he or she would recognize that there are examples in the specification to exercise the claimed invention. As such, the patent in dispute meets all of the requirements of Art. 83 EPC.

With respect to claim 2 of the patent in dispute the Opponent states that claim 2 refers to "*the aerosol-generating article*" although an aerosol-generating article has not been introduced before in claims 1 or 2. It is submitted that this is a clarity argument. However, lack of clarity is not a ground for opposition according to Art. 100 EPC.

For the sake of argumentation, however, it is further submitted that the skilled person knows what is an aerosol-generating article. S/he knows from her/his technical background as well as from the disclosure of the patent in dispute (see, e.g., paragraph [0009] in column 2 on page 2) that the aerosol-generating substrate as defined in claim 1 may be part of an aerosol-generating article. Accordingly, the skilled person recognizes that in claim 2 of the patent in dispute it should read "*receiving an aerosol-generating article*" instead of "*receiving the aerosol-generating article*" (see page 15, column 27, line 19 of the patent in dispute). Accordingly, the skilled person has no problems in interpreting claim 2 correctly and, thus, claim 2 is not only sufficiently disclosed but it also does not lack clarity.

Hence, it is submitted that claims 1 and 2 of the patent in dispute are in compliance with Art. 83 EPC.

#### IV. Novelty

Document WO 96/39879 A1 (E1), either alone or in combination with the therein referenced document US 5,591,368 B1 (E2), has been cited by the Opponent as relevant for novelty of various claims of the patent in dispute. However, neither E1 alone nor a combination of E1 and E2 takes away novelty of any of the claims of the patent in dispute.

##### **IV.1. Novelty of independent claim 1**

Regarding novelty of claim 1 of the patent in dispute, the Opponent alleges on pages 4 to 6 of the opposition substantiation that E1 discloses “*a heater (115) for heating the aerosol-forming substrate (203) and configured for penetrating an internal portion (211) of the aerosol-forming substrate (203)*” (designated on page 4 of the opposition substantiation as feature 1b by the Opponent) by means of incorporation of the disclosure of E2. This allegation, however, is incorrect.

As we will discuss below, the alleged incorporation of portions of E2 into the disclosure of E1 is not proper. But as an initial matter, this argumentation from the Opponent confirms that E1 alone does not take away novelty of claim 1 of the patent in dispute because at least feature 1b is not disclosed in E1.

Regarding the alleged combination of E1 and E2 we note, to begin with, that E1 at page 11, lines 15 to 23 only gives a generic reference to a total of 8 different documents. A precise reference to Figs. 13 and 14 of E2, as alleged by the Opponent, is not made there or anywhere else within E1.

In case a combination of two documents has to be made for the novelty assessment the EPO case law applies particular requirements in order to assert lack of novelty. In decision T 610/95 of the Boards of Appeal of the EPO, “*in view of the objection of lack of novelty, the question to be answered was whether or not the proposed solution in the patent was derivable directly and unambiguously from the disclosure of citation (2), which contained **cross-references** to the entire content of **three patent specifications** without giving priority to any of these references. Each of these references offered a plurality of different options for preparing pressure-sensitive layers of medical dressings. The board held that, under these circumstances, it could not be said that the use of the specific product acting as pressure-sensitive material in*

*the claimed invention was directly and unambiguously derivable from the wholly general reference to the three different prior documents quoted in citation (2) and had therefore already been made available to the public*" (see Case Law of the Boards of Appeal of the European Patent Office, Eighth Edition, July 2016, I.C.4.2.; page 105, fourth paragraph of the English edition).

The situation underlying T 610/95 thus is highly similar to the present situation. E1 contains on its page 11, lines 15 to 23 cross-references to the entire content of 8 patent specifications without giving priority to any of these references and without giving a direct and unambiguous indication of which features of these documents should be incorporated. Moreover, as described in more detail below, E2 offers a plurality of different options, one of which can be found in its Figs. 13 and 14, for designing the heating element. Thus, the use of a specific heating element of E2 is not directly and unambiguously derivable from the general reference to the 8 different prior art documents quoted in E1. Accordingly, for this first reason claim 1 of the patent in dispute is novel over a combination of E1 and E2.

Additionally, even if it was proper to look to E2 as asserted by the Opponent, then such combination still is not novelty-destroying for claim 1 because an unreasonable number of selections has to be made in order to arrive at this particular combination.

At page 7, lines 8 to 11 of E1 it is disclosed that a preferred embodiment according to E1 comprises "*a mechanism such as a plunger*". This means that E1 does not require the presence of such a plunger. Thus, in a first selection step the preferred embodiment comprising the plunger as shown in Figs. 2A to 2D of E1 has to be chosen.

Page 11, lines 2 to 8 of E1 disclose that a heater which radially surrounds the cigarette as shown in Fig. 2A of E1 is the presently preferred embodiment. In a further preferred embodiment eight heating blades 120 are used (see page 11, lines 8 to 11 of E1). Accordingly, in a second selection step it has to be chosen not to use the preferred heating element of Fig. 2A but to use another non-preferred heating element.

Further, in the following lines 15 to 23 on page 11 of E1 there is provided a long list of

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