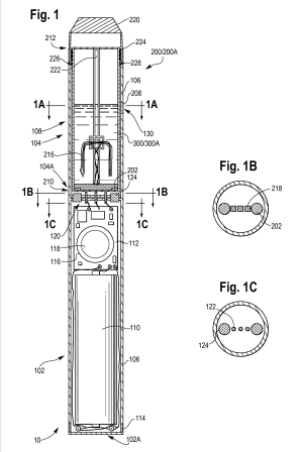
UPC CFI, Central Division Paris, 29 November 2024, NJOY Netherlands v VMR Products

Appeal inadmissible due to lack of payment of court fees: IPPT20250401, UPC CoA, NJOY v VMR

Vaporizer



PATENT LAW – PROCEDURAL LAW

Revocation EP 740 dismissed (Article 65 UPCA). No alleged lack of inventive step

- **The validity of the independent claim 1 justifies validity of the dependent claims 2 – 6.**

Admissible late filed documents in the Reply to defence to revocation (R. 44 RoP)

- **It must be concluded that the documents introduced by the Claimant in the Reply to defence to revocation – […] – are admissible, given that it contains arguments regarding the common general knowledge and the claim construction which are intended to contrast and react to the arguments raised by the Defendant in its Defence to revocation and […] opinion, filed in support of these latter arguments.**

The admissibility of these late filed documents shall also extend to arguments that, while not constituting a direct response to the Defendant's arguments, are closely related to them.

Reply to Rejoinder to the Reply to the Defence to revocation inadmissible (R. 51 RoP, R. 52 RoP).

- **Pursuant to Rule 51 'RoP' the Reply to the Defence to revocation is the last written pleading that the Claimant may lodge to present its case. Respectfully the Defendant may lodge a Rejoinder to the Reply according to Rule 52 'RoP' which is its last written pleading. There is no good reason why an exception should be made to these general rules. 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 system.**

Person skilled in the art (Article 56 EPC) of electronic inhalable aerosol devices

- **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 for routine work, but does not have inventive imagination, thinking and skills. 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.**

37. The Court considers that the person skilled in the art is a mechanical engineer with either a Bachelor's degree or a 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 issues that relate to the electrical circuitry implemented in electronic inhalable aerosol devices or electronic vaping devices that he himself cannot handle.

Common general knowledge ('CKG') is not all publicly available knowledge (Article 56 EPC, Article 54 UPCA)

- **Neither an individual product nor a patent application as such are a familiar source of information**
- **In general common general knowledge is information which has been commonly known to the skilled person from written sources or from practical experience in the relevant technical field. The 'CGK' includes knowledge which is directly available from familiar sources of information relating to the specific technical field at the prior date but is not to be confused with publicly available knowledge, which may not be general and common.** A familiar source of information typically is a source to which a skilled person regularly turns for guidance on standard design solutions that are generally applicable, such as standard textbooks, encyclopaedias, manuals, handbooks, dictionaries and databases which the skilled person knows and can use as a suitable and reliable source for the respective information in the respective technical field. A familiar source of information should not be confused however with all publicly available prior art documents.
- In any case, the 'CGK' is subject of evidence. Pursuant to **Art. 54 of the UPCA**, the burden of proving the existence of the 'CGK' lies with the party invoking it. Without bearing the burden of proof, the opposing party may present evidence to establish the 'CGK', including evidence to the contrary.

No lack of inventive step (Article 56 EPC)

- **An assessment based on different starting points will be more complete and objective than problem-solution approach, which is only one possible way for assessment of the inventive step.** There is no legal rule that requires its application or restricts the application of other approaches. This panel considers that an

assessment based on different starting points as suggested by the Claimant will be more complete and objective.

- **Starting from 'Cross' the skilled person has to redesign the whole structure of the device and search for solution how to secure the cartomizer above the battery segment which is not commonly and generally known.** Turning to 'Cross' in combination with 'CGK' is a step taking in hindsight by the Claimant, therefore features 1.7, 1.7.1, 1.8, 1.8.1 and 1.8.2 are not obvious in view of 'Cross' combined with 'CGK'.
- **Skilled person will not combine Cross with DiFonzo. When faced with problems which relate to providing a secure connection between the cartomizer and the chamber, the skilled person, however, does, not look in the different technical field of accessories (power connectors) for laptops.**
- **Starting from Pan: given that the power supply in a vaporizer is very limited, a skilled person would not consider applying a solution that introduced further power requirements into the device (the power to drive the electromagnet) suitable for a vaporizer.**

90. One of the problems to be solved in 'Pan' is described in [0007] is that the existing electronic cigarette devises are too complex to be implemented as an ordinary consuming product and too costly for manufacturing and maintenance. 'Pan' discloses connection between the electric connectors by means of screw thread or DC socket ([0010], [0030], [0031], [0033], dependent claim 14) which have the technical effect to provide secure and not expensive connection. As detailed above in para. 77 and 78, reflections on the applicability of the solution described in 'DiFonzo' to technical fields other than that of laptops do not form part of the disclosure of 'DiFonzo' and nothing in 'Pan' motivates the skilled person to look in the technical field of accessories to laptops.

Source: **Unified Patent Court**

UPC Court of First Instance,
Central Division Paris, 29 November 2024
(Catallozzi, Zhilova, Tilmann)
DECISION
of the Court of First Instance of the Unified Patent Court Central division (Paris seat)
issued on 29. November 2024
concerning the Generic application No. App_159/2024
lin the revocation action No. ACT_571537/2023 UPC_CFI_307/2023
HEADNOTES:
The common general knowledge is information which has been commonly known to the skilled person from written sources or from practical experience in the relevant technical field available at the prior date: it includes knowledge which is directly available from familiar sources of information relating to the specific technical field but does not necessarily include all the publicly available knowledge, which may not be general and common.

KEY WORDS:
common general knowledge, late filed documents, validity of the patent
CLAIMANT:
NJOY Netherlands B.V. - Westerdoksdijk 423, 1013BX Amsterdam, Netherlands
Represented by Attorney-at-law Hon.-Prof. Dr. Henrik Holzapfel, McDermott Will & Emery, Stadttor 1, 40219 Düsseldorf, Germany assisted by Laura Woll, Diana Pisani, Lisa Nassi of McDermott Will & Emery co-represented by Mathias Karlhuber, Cohausz & Florack
RESPONDENT:
VMR Products LLC - 560 20th Street - California 94107 - San Francisco - US
Represented by Bernhard Thum, Thum & Partner | Thum, Mötsch, Weickert Patentanwälte PartG mbB, Siebertstr. 6, 81675 Munich, Germany assisted by Jonas Weickert and Andreas Mötsch, Thum & Partner co-represented by Tobias Wuttke, Bardehle Pagenberg Partnerschaft mbB
PATENT AT ISSUE:
European patent **EP 2 875 740** B1, hereafter referred to as "EP '740" or as "the Patent".
DECIDING JUDGES:
Panel 2 of the Central Division (Paris Seat)
Paolo Catallozzi Presiding judge
Tatyana Zhilova Legally qualified judge and judge-rapporteur
Max Tilmann Technically qualified judge
DATE OF THE ORAL HEARING
15. October 2024
LANGUAGE OF THE PROCEEDINGS
English
SUMMARY OF FACTS AND PARTIES' REQUESTS:
1. On 15. September 2023 NJOY Netherlands B.V. filed a revocation action against VMR Products LLC concerning the patent at issue (EP '740) before this Central Division Paris, registered as No. ACT_571537/2023, UPC_CFI_307/2023. The Defendant is the registered proprietor of the patent at issue.
2. The parties are competitors in the market for electronic vapour products. Claimant NJOY Netherlands B.V. is a subsidiary of a company incorporated under the laws of the State of Delaware (USA), and belongs to the Altria Group, Inc, incorporated under the laws of the State of Virginia (USA). Defendant VMR Products LLC is a subsidiary of Juul Labs, Inc, a corporation organized under the laws of the State of Delaware (USA).
3. EP '740 was filed on 14. March 2014 claiming the priorities of US 201361903344 P of 12. November 2013 and US 201461937851 P of 10. February 2014. The patent was published on 24. October 2018. According to the Claimant and undisputed by the Defendant, EP '740 at the time of filing the statement of claim was in effect in the following contracting member states of the UPCA: France and Germany. No opposition has been filed before the European Patent Office for the patent in suit.

No opt-out from the exclusive jurisdiction of the UPC had been declared.

4. The Claimant challenges the validity of the patent on the grounds of lack of inventive step. The Defendant contests the alleged grounds for revocation. In the alternative, if the Court finds that there is a lack of inventive step, the Defendant submits 41 auxiliary requests to amend the patent to overcome the lack of inventive step. By a further application, registered as App_44412/2024, the Defendant has reduced the number of auxiliary requests to six (AR I to VI).

5. The written procedure was closed on 13. June 2024.

6. The Claimant requests the following decision in merit:

(1) European patent n° EP 2 875 740 B1 to be revoked entirely with effect for the territories of France and Germany.

(2) The Defendant's alternative requests to maintain the patent based on any of Defendant's proposed amendments of the claims of the patent (selected set of Auxiliary Requests I to VI, App_44412/2024) to be dismissed.

(3) Defendant to be ordered to bear the legal costs of the proceedings.

7. The Defendant requests the following decision in merit.

(1) The revocation action be dismissed;

(2) The Patent be maintained:

a) as granted; or

b) in the alternative based on one of the proposed amendments of the claims of the Patent (selected set of Auxiliary Requests I to VI, App_44412/2024);

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 the proposed amendments of the claims of the Patent (selected set of Auxiliary Requests I to VI, App_44412/2024);

(3) The Claimant be ordered to bear the costs of the proceedings.

8. The interim conference was held on 2. July 2024.

9. By Order of the judge-rapporteur and the technically qualified judge, issued on 9. September 2024, the value of the proceedings was set for the purpose of applying the scale of ceilings for recoverable for this case to be more than EUR 250.000 and less than EUR 500.001,00.

10. Finally, the oral hearing was held in present on 15. October 2024 at the Court premises.

GROUNDS FOR THE DECISION

A. Procedural issues

I. Late filed facts and evidence

11. In the Reply to Defence to revocation and Defence to the Application to amend the patent, lodged on 6. February 2024, the Claimant develops further arguments for the alleged lack of the inventive step based on newly filed documents (Exhibits MWE 11- MWE 28) and makes a procedural request, that the Court admit these exhibits into the proceedings.

12. Defendant requests documents MWE 11 to MWE 28 not be admitted into the proceedings; Claimant requests to dismiss Defendant's request.

13. As a rule, the parties are obliged to present their complete case as early as possible (**Preamble to the RoP**, para. 7, last sentence).

14. **Rule 44 'RoP'** states that the statement for revocation shall contain *"... (e) one or more grounds for revocation, which shall as far as possible be supported by arguments of law, and where appropriate an explanation of the claimant's proposed claim construction; (f) an indication of the facts relied on; (g) the evidence relied on, where available, and an indication of any further evidence which will be offered in support ...*".

15. Similar requirements are set for the content of the statement of claim in the infringement proceedings. **Rule 13 'RoP'** provides that this written pleading shall contain "*an indication of the facts relied on*" [lett. (l)], "*the evidence relied on*" [lett. (m)] and "*the reasons why the facts relied on constitute an infringement of the patent claims, including arguments of law and where appropriate an explanation of the proposed claim interpretation*" [lett. (n)].

16. However, those provisions must also be interpreted in the light of the principle of proportionality, as set out in **the Preamble of the 'RoP'**, which requires that the parties should not be burdened with tasks that are unnecessary to achieve the stated objective. In this regard, it must be noted that **Rule 44 'RoP'** requires an "*indication*" of the facts relied on and this seems to support an interpretation of the relevant provisions contrary to an overly strict application of the 'front loaded' procedural system.

17. Furthermore, account must also be taken of the need, which is served by the principle of procedural efficiency, to avoid excessive and overly detailed allegations of fact and the production of multiple documents in relation to matters that can be presumed to be known to the opposing party and not to be disputed by them, provided that their allegation and evidence is preserved if challenged, thus considering the natural course of procedural dynamics.

18. Moreover, excessive and redundant allegations of facts and production of documents may also hinder the effective exercise of the effective exercise of the right of defence, imposing on the opposing party a burden of studying the appeal and the evidence presented, and hindering the efficient functioning of the judicial response, by overburdening the Court with unnecessary activities.

19. Additionally, it can be argued that a document may be introduced into the proceedings at a later stage if it was created or became available to the party during the proceedings, given the principle of fairness which protects a party that has acted in a diligent way.

20. It may therefore be concluded that, the claimant in revocation actions is required to specify in detail the grounds of invalidity that allegedly affect the contested

patent, as well as the prior art documents relied upon to support any allegation of lack of novelty or inventive step. This defines the subject matter of the dispute and enables the defendant to understand the allegations made against it and to prepare an adequate defence, as well as allowing the Court to determine the scope of its jurisdiction in relation to the claim.

21. Consequently, the claimant cannot introduce new grounds of invalidity of the attacked patent or introduce new documents considered novelty destroying or convincing starting points for the assessment of lack of inventive step in subsequent written acts. This would result in a broadening or, in any case, a modification of the subject matter of the dispute, constituting an amendment of the case and falling within the scope of **Rule 263 'RoP'**, which may only be permitted by the Court upon specific request and after it has been shown that the requirements of that Rule have been met.

22. Similarly, the claimant must specify in the statement of claim the facts that it considers necessary to prove in order to succeed in its claim, together with the relevant evidence.

23. However, it should be noted that in certain situations, following the defence raised by the defendant, the claimant may need to allege new facts, insofar as they are considered capable of supporting the main facts already timely alleged and disputed by the defendant. In this case, the need to respond to the defendant's defence, the terms of which cannot be foreseen ex ante by the claimant, justifies the introduction of such new facts in the reply to defence to revocation.

24. Likewise, the need to produce new evidence may arise from the defendant's defence which disputes the facts alleged by the claimant or the probative value of the evidence already filed in Court.

25. This is consistent with the principles set by the Court of Appeal (**decision issued on 21 November 2024, UPC_CoA_456/2024**) according to which while the parties are required to set out their case as early as possible in the proceedings nevertheless specific new arguments may be admitted into the proceedings in consideration of specific circumstances of the case.

26. Applying these principles to the present case, it must be concluded that the documents introduced by the Claimant in the Reply to defence to revocation – consisting of the declaration released by […] and of the documents referred to in that statement […] – are admissible, given that it contains arguments regarding the common general knowledge and the claim construction which are intended to contrast and react to the arguments raised by the Defendant in its Defence to revocation and […] opinion, filed in support of these latter arguments. The admissibility of these late filed documents shall also extend to arguments that, while not constituting a direct response to the Defendant's arguments, are closely related to them.

II. Admissibility of further requests

27. On 8. April 2024, the Claimant filed 'Reply to the Rejoinder and Reply to Defendant's Application to amend the Patent' (App_18674/2024).

i. According to **Rule 32.3 'RoP'**, the Claimant may lodge a Rejoinder regarding the Defendant's Reply to the Defence to amend the patent. The part which deals with Defendant's Application to amend the patent is therefore admissible, including MWE 31, 33 and 34 that form part of this Rejoinder.

ii. The 'Reply to the Rejoinder' is inadmissible. Pursuant to **Rule 51 'RoP'** the Reply to the Defence to revocation is the last written pleading that the Claimant may lodge to present its case. Respectfully the Defendant may lodge a Rejoinder to the Reply according to **Rule 52 'RoP'** which is its last written pleading. There is no good reason why an exception should be made to these general rules. 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 system.

B. Issues on merit

I. Legal framework

28. 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, UPC_CoA_335/2023**, p. 26-27 of the original German language version, also see Court of Appeal, **order issued on 13 May 2024, UPC_CoA_1/2024**).

29. 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.

30. A feature in a patent claim is always to be interpreted in the light of the claim as a whole (see **Court of Appeal, order issued on 13 May 2024, UPC_CoA_1/2024**, 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. In applying these principles, the aim is to combine adequate protection for the patent proprietor with sufficient legal certainty for third parties.

31. 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.

32. The patent claim is to be interpreted and assessed from the point of view of a person skilled in the art.

II. The concept of person skilled in the art and the common general knowledge

33. The identification of the person skilled in the art and the common general knowledge ('CGK') can conveniently be done in one go.

34. 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 for routine work, but does not have inventive imagination, thinking and skills. 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.

35. Parties do not agree completely on the qualification of the skilled person.

i. The Claimant states that the relevant person skilled in the art, would possess at least a Bachelor's degree in mechanical engineering, or alternatively in electrical engineering, or in chemistry, or in physics, or in a related field, and over three years of relevant industry experience. This statement is supported also by […]

ii. To define the person skilled in the art the Defendant has submitted the Expert opinion by […]. An average person skill in the art would have had a B.S. in mechanical engineering, electrical engineering, or an equivalent degree, and either at least two years of experience designing electro-mechanical consumer products or an advanced degree in mechanical engineering, electrical engineering, or an equivalent degree.

36. With regard to the interpretation of the claims, the following must be borne in mind: 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. 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.

37. The Court considers that the person skilled in the art is a mechanical engineer with either a Bachelor's degree or a 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 issues that relate to the electrical circuitry implemented in electronic inhalable aerosol devices or electronic vaping devices that he himself cannot handle.

38. The 'CGK', in general, is information which has been commonly known to the skilled person from written sources or from practical experience in the relevant technical field. The 'CGK' includes knowledge which is directly available from familiar sources of information relating to the specific technical field at the prior date but is not to be confused with publicly available knowledge, which may not be general and common. A familiar source of information typically is a source to which a skilled person regularly turns for guidance on standard design solutions that are generally applicable, such as standard textbooks, encyclopaedias, manuals, handbooks, dictionaries and databases which the skilled person knows and can use as a suitable and reliable source for the respective information in the respective technical field. A familiar source of information should not be confused however with all publicly available prior art documents.

39. In any case, the 'CGK' is subject of evidence. Pursuant to **Art. 54 of the UPCA**, the burden of proving the existence of the 'CGK' lies with the party invoking it. Without bearing the burden of proof, the opposing party may present evidence to establish the 'CGK', including evidence to the contrary.

III. Technical field and prior art discussed in the patent at suit

40. The patent relates to a vaporizer. According to [0001] of EP '740, the vaporizers that the patent pertains to may also be referred to as electronic cigarettes.

41. Electronic cigarettes have recently emerged as a new product for providing nicotine through a smokeless inhalation process. Typically, implementations consist of a power supply (typically a battery) and an atomizing device. In reusable electronic cigarettes the two items are separated into a battery and a cartomizer, to allow the disposal and replacement of a nicotine containing fluid cartomizer while preserving the more costly battery and associated circuitry (microcontroller, switch, indicating LED, etc.) for additional use. In disposable electronic cigarettes, the two items are combined to integrate the functions into one unit that is discarded after either the battery energy or the nicotine containing liquid is exhausted. ([0002] of EP '740).

42. The electronic cigarette liquid used to vaporize ingredients such as nicotine is generally a solution of propylene glycol (PG), vegetable glycerine (VG), or polyethylene glycol 400 (PEG400), as well as their mixtures to which a flavour and/or nicotine has been added. The solution is often sold in a bottle (for refilling by the user) or in disposable cartridges or cartomizers. Many different flavours are incorporated into these liquids, including those that resemble the taste of regular tobacco, menthol, vanilla, coffee, cola and/or various fruits. Various nicotine concentrations are also available, and nicotine-free solutions are also common. ([0003] of EP '740).

43. EP '740 describes as prior art EP 2 654 471 to disclose an electrically operated smoking system

comprising a storage portion for storing an aerosol-forming substrate, an aerosol generating element for generating an aerosol from the aerosol-forming substrate and a control circuitry in communication with the storage portion or the aerosol generating element.

44. The patentee states in [0005] of EP '740 that the electronic cigarettes described in the prior art do have a number of advantages, but there is still opportunity for improvement, particularly concerning secure connection of the cartomizer to the cigarette.

IV. The invention

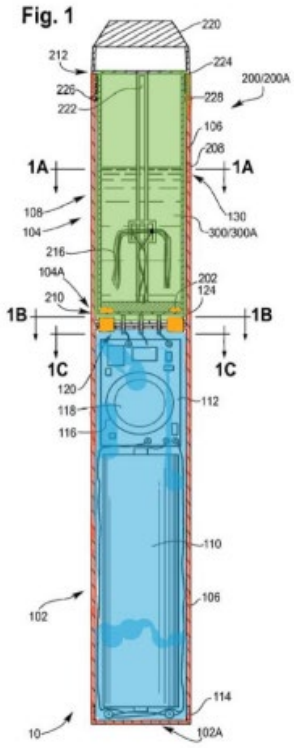
45. Given this background, the patented device can be referred to the closed type of cigarettes consisting of two parts: a battery segment and a cartomizer, described in the Expert opinion by […]. By the closed type of cigarettes, the e-liquid is provided in a sealed cartridge that would be disposed of and replaced when empty. Closed systems were targeted at mass market consumers and were designed to closely resemble a traditional tobacco cigarette in size and appearance.

46. The problem to be solved by the invention, as defined in [0005], is how to provide a secure connection between the cartomizer and the chamber of the vaporizer. The statement of the Defendant that the overall common technical problem is to provide a vaporizer with an improved user experience is not considered appropriate because it is overly broad, vague and not supported by the description.

47. The patented invention is defined by claim 1 of EP '740, the only independent claim having the following features:

1.1	A vaporizer comprising
1.2	A shell having a battery segment and a cartomizer receiving segment
1.2.1	The cartomizer receiving segment defining a chamber having an insertion end distal to the battery segment of said shell and a base end proximate to the battery segment
1.2.2	The chamber dimensioned to receive a cartomizer inserted into the chamber at the insertion end of the chamber;
1.3	A battery housed within the battery segment
1.4	electrical contacts provided between the base end of the chamber and the battery segment, the electrical contacts including a positive contact and a negative contacts insulated from the positive contact;
1.5	electrical circuitry housed within the battery segment of said shell and operable to direct an electrical current between the battery and the electrical contacts;
1.6	Wherein said electrical contacts and battery each in electrical connection with said electronic circuitry; and
1.7	wherein the cartomizer is securable within the chamber as a cartomizer surface and a magnetically attracted chamber surface are placed adjacent to one another,
1.7.1	said chamber surface is a chamber magnet provided proximate to the base end of the chamber, the chamber magnet insulated from the electrical contacts,
1.8	**characterized in that** it further comprises an additional chamber magnet provided proximate to the base end of the chamber,
1.8.1	the additional chamber magnet insulated from the electrical contacts and the chamber magnet,
1.8.2	the additional chamber magnet having a polarity opposite to that of the chamber magnet.

48. FIG. 1 from the patent (colours added by the panel) illustrates a front view of an embodiment of an electronic cigarette having shell 106 (red), battery housing segment 102 (blue), cartomizer receiving segment 104 (green), magnets 124/202 (orange).



49. The patent comprises 5 dependent claims (claims 2 to 6) establishing different embodiments of the vaporizer of claim 1.

50. Claim 1 of the patent in suit requires the following interpretation of some terms regarding its features:

- 'vaporizer' means the whole device including battery segment, the chamber defined by the cartomizer receiving segment and the cartomizer (during the oral hearing the parties agreed undisputable that the patent covers the cartomizer as well as the chamber);
- 'cartomizer surface' means a surface of the cartomizer which interacts with a chamber surface the chamber;
- 'distal' means situated away from the centre of a body;
- 'proximate' means closely neighbouring, immediately adjacent, next, nearest in the space.

51. Interpretation of feature 1.2. "*A shell having a battery segment and a cartomizer receiving segment*"

and feature 1.2.1 "*The cartomizer receiving segment defining a chamber having an insertion end distal to the battery segment of said shell and a base end proximate to the battery segment*":
i. Feature 1.2.1 in conjunction with feature 1.2 to the skilled person's understanding defines a general structure of the vaporizer. Feature 1.2 defines the vaporizer's two segments, namely a battery segment and a cartomizer receiving segment, which are housed within one shell. While the wording of the claim does not exclude the shell to have further segments, the skilled person notices that claim 1 speaks only in feature 1.2 about the general structure of the shell and by way of identifying only two segments in this feature places emphasize on these two segments. To the skilled person's understanding, the battery segment and the cartomizer receiving segment are the two basic segments of one shell.
ii. Feature 1.2.1 builds on this understanding. It specifies that the cartomizer receiving segment defines a chamber and for the chamber to have two ends, an insertion end and a base end. In general, when an object (the chamber) is defined by reference to two ends, the skilled person understands this to be a reference to ends that are arranged opposite to each other. Since the claim language and the description do not provide any guidance to a different understanding, the skilled person will also apply this general understanding to the wording of feature 1.2.1. To the skilled person's understanding, the insertion end of feature 1.2.1 is arranged opposite the base end of feature 1.2.1.
iii. By way of using the term pairing 'distal / proximate' feature 1.2.1 to the skilled person's understanding defines a general placement of the chamber relative to the battery segment and an orientation of the chamber. In order for one end of the chamber (the insertion end) to be considered to be distal from the battery segment and in order for the opposite end of the chamber (the base end) to be considered – also in relation to the insertion end – proximate to the battery segment, the chamber must have (1) a general shape and (2) a general placement relative to the battery segment that allow two opposite ends to be distinguished and for one of the two ends to be considered to be further away (distal) from the battery segment compared to the other (that is arranged proximate).
52. The achieved technical effect by the invention is defined in [0016]: "*Because of the opposing polarities of magnets 124/202, the cartomizer 200 may only be inserted and secured in one direction or orientation, thereby facilitating alignment of cartomizer 200 with chamber 108. Ensuring cartomizer 200 is properly oriented within chamber 108 in turn ensures proper contacting of cartomizer 200 with connector 120, and therefore proper functioning of electronic cigarette*".

V. The inventive step attack

53. The Claimant argues that the patent is not valid for the lack of inventive step, citing several prior art documents:

• U.S. Patent Application Publication No. 2005/0268911 ('Cross'), published on 8 December 2005. (Exhibit MWE 6);
• U.S. Patent Application Publication No. 2007/0072442 ('DiFonzo'), published on 29 March 2007. (Exhibit MWE 7);
• Korean Patent Application Publication No. 10-2012-0074625 ('Lee'), published on 6 July 2012. (machine translation Exhibit MWE 8a);
• U.S. Patent Application Publication No. 2013/0042865 ('Monsees') published on 21 February 2013 (Exhibit MWE 9);
• U.S. Patent Application Publication No. 2010/0242974 ('Pan'), published on 30 September 2010 (Exhibit MWE 10).

54. For the inventive step attack to the independent claim 1 the Claimant refers to 'Cross' and 'Pan' as two different starting points to be considered in combination with CGK and/or 'DiFonzo'. 'Monsees' and 'Lee' are considered by the Claimant as disclosing the dependent claims. The Defendant considers that referring to different starting points is a not permissible approach and accepts as appropriate the problem-solution approach starting from one single prior art document defined as closest prior art.
55. The assessment of the inventive step must be carried out in accordance with **Article 56 'EPC'**, which states that '[a]n invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art'. Hence, it is necessary to determine whether, given the state of the art, a person skilled in the art would have arrived at the technical solution claimed by the patent using its technical knowledge and carrying out simple operations. Inventive step is assessed in terms of the specific problem encountered by the person skilled in the art (see **Paris LD, decision issued on 3 July 2024, UPC CFI 230/2023**).
56. In order to assess whether or not a claimed invention is obvious to a person skilled in the art, it is first necessary to determine one or more teachings in the prior art that would have been of interest to a person skilled in the art who, at the priority date of the patent in suit, was seeking to develop an invention or process similar to that disclosed in the prior art. Then, it must be assessed whether it would have been obvious for the skilled person to arrive at the claimed solution of the underlying technical problem on the basis of a realistic disclosure of the selected prior art documents (see, **Munich CD, decision issued on 17 October 2024, UPC CFI 252/2023**; **Dusseldorf LD, decision issued on 10 October 2024, UPC CFI 363/2023**). The problem-solution approach is only one possible way for assessment of the inventive step. There is no legal rule that requires its application or restricts the application of other approaches. This panel considers that an assessment based on different starting points as suggested by the Claimant will be more complete and objective.

VI. Starting from 'Cross'

Cross' as starting point for the assessment of inventive step

57. 'Cross' provides disclosure of devices for producing multiple doses of a condensation aerosol of a drug to administer physiologically active compounds to a patient for the treatment of diseases and disorders ([0001] to [0004]).

58. The objective technical problem solved by 'Cross' is how to produce an inhalation device that can repeatedly deliver precise, reproducible and/or controlled amounts of a physiologically active substance ([0006]).

59. Defendant's arguments to discard 'Cross' as starting point do not convince. Defendant did not point to any feature of Claim 1 that differentiates the general field of technology of the claimed vaporizer from that of 'Cross'. Defendant's reference to [0001] of EP '740, which specifies that vaporizers may also be referred to as electronic cigarettes, for the use of "*may*" is not understood by the skilled person to mean that the term "*vaporizers*" only refers to electronic cigarettes.

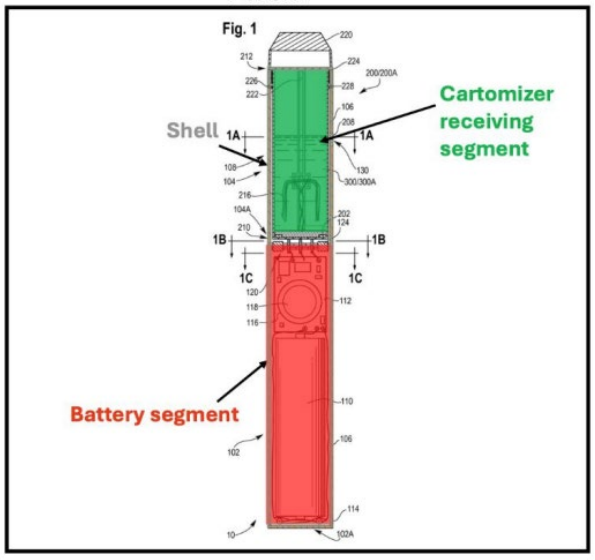
60. Furthermore, it should be noted that 'Cross' expressly points out that the device is suitable for inhalation of non-therapeutical compounds such as nicotine given as example ([0074], [0075]).

61. 'Cross' generally pertains to a vaporizer that comprises many of the features of the invention at suit and can be considered as a realistic starting point for the assessment of the inventive step.

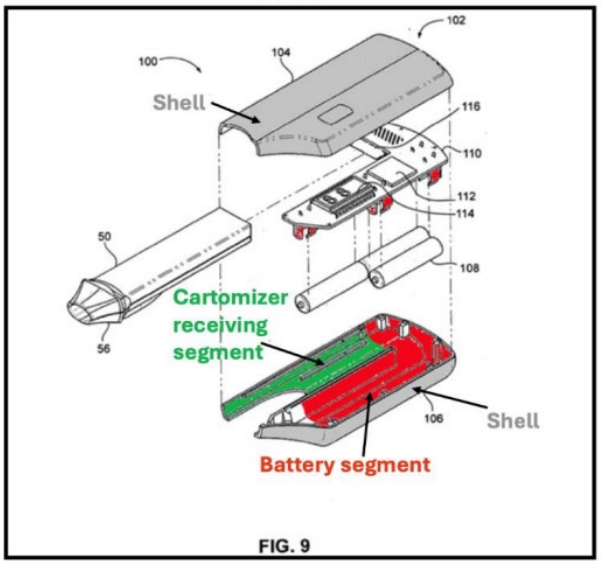
Disclosure of 'Cross'

62. 'Cross' discloses a vaporizer having a battery segment and a cartomizer receiving segment, disposed in a shell consisting of an upper and a lower part. The main difference between the patent at suit and 'Cross', which impresses at first glance, is the different location of both segments. In the claimed invention, they are positioned one above the other, whereas in 'Cross' they are positioned side by side. The figures below provided by the Claimant at the oral hearing illustrate both devices.

Patent



Cross



63. Features 1.1, 1.2., 1.2.2., 1.3., 1.5 and 1.6 are given in 'Cross' and undisputed by the parties. In 'Cross' the chamber is also dimensioned to receive a cartomizer inserted into the chamber at its insertion end. The battery is housed within the battery segment. Electrical circuitry housed within the battery segment of the shell and operable to direct an electrical current between the battery and the electrical contacts is provided. 'Cross' discloses said electrical contacts and battery to each be in electrical connection with said electronic circuitry.

64. Feature 1.4. is also given in 'Cross' albeit contested by the Defendant. The vaporizer functions by converting the substance, which is applied as a layer on the cartomizer, into inhalable aerosol by heating. 'Cross' discloses electrical contacts to be provided between the base end of the chamber and the battery segment, including a positive contact and a negative contacts insulated from the positive contact. A connector 116 is provided for connecting the dispensing unit with the cartridge and which also connects controller 112 and power source 108 to cartridge 50. The connector is arranged at what is considered the base end of the chamber. Contrary to Defendant's statement, the base end is not the (external) end of the shell, namely an end of the outer casing formed by the first and second shells 104, 106 but is the base end of the chamber and hence an object inside the shell. It is at this end (of the chamber) that the connector 116 is arranged in the assembled stage of the device. For illustration purposes, reference is made to the annotated copy of Fig. 9 as provided by defendant in mn. 153 of the Statement of Defence.

Distinguishing features

65. Feature 1.2.1 is not given in 'Cross' and this is disputed between the parties. The cartomizer receiving segment in 'Cross' defines a chamber, namely that space within the shell into which the cartridge is placed. The chamber has an insertion end and an end that is opposite the insertion end, where the connector is arranged. Due to the parallel orientation of the two segments in 'Cross' where the entire longitudinal side of the cartomizer segment is adjacent to the longitudinal side of the battery

segment, no distal/proximate positioning appears. This difference does not, however, disqualify 'Cross' as a starting point, but must be considered as distinguishing element within the assessment of the inventive step.

66. It is without dispute between the parties that 'Cross' does not disclose features 1.7, 1.7.1, 1.8., 1.8.1 and 1.8.2., namely these are the features whose obviousness must be assessed.

'Cross' combined with common general knowledge ('CGK')

67. In the Statement for revocation the Claimant states that magnetic connectors were well-known in the field of electronic cigarettes at the priority date but does not provide any evidence.

68. To establish the 'CGK' Claimant has submitted the Declaration of […] and the Defendant has submitted the Expert opinion by […].

69. […] refers to three Chinese utility model applications/patent applications (MWE 18 'Zhenzhong', MWE 19 'Shi' and MWE 20 'Lin') that describe the use of magnetic connectors for coupling an e-cigarette cartomizerto a corresponding vaporizer. In its Reply to the Defence to Revocation the Claimant refers as well to those utility model applications accepting them as a part of the CGK.

70. […] describes two different types of systems for electronic cigarettes known at the time of the invention: open and closed. At the priority date some electronic cigarettes were 3-piece comprised of a rechargeable battery portion (device), an atomizer portion, and a liquid containing cartridge. Other electronic cigarettes were 2-piece designs where the atomizer portion and liquid containing cartridge were combined into a single cartridge style unit, commonly called a "*cartomizer*." Screw type or bayonet style connectors are typically used to connect the different pieces of any kind of electronic cigarette.

71. The three utility model applications referred to by […] could not be considered as a familiar source of information, hence, they are not suitable to be part of the 'CGK' at the earliest priority date of the patent in suit. From the skilled person's expectation, a singular patent application/utility model application suggests him a particular solution, but not standard design solutions that are generally applicable. As said above (s. para 38) the 'CGK' should not be confused however with all documents which are publicly available at the prior date.

72. The same is true for the individual product that […] refers to in mn 71 of MWE 11 and for the reference to the US patent application 'Conley'. Even if it were held to the benefit of the Claimant that these two prior art references did show the above-described design solution, neither an individual product nor a patent application as such are a familiar source of information. Hence, it is not suitable to turn to these prior art references as evidence to show that the above-mentioned design solution belonged to the 'CGK' at the earliest priority date of the patent in suit.

73. The Claimant states that magnetic connectors were commonly used to couple components in everyday electromechanical devices, but it does not provide any evidence that design solutions from everyday electro-mechanical devices have found their way into the common general knowledge of the skilled person in the present technical field.

74. Starting from 'Cross' the skilled person has to redesign the whole structure of the device and search for solution how to secure the cartomizer above the battery segment which is not commonly and generally known. Turning to 'Cross' in combination with 'CGK' is a step taking in hindsight by the Claimant, therefore features 1.7, 1.7.1, 1.8, 1.8.1 and 1.8.2 are not obvious in view of 'Cross' combined with 'CGK'.

'Cross' combined with 'DiFonzo'

75. The subject matter of 'DiFonzo' relates to an electromagnetic connector for a power adapter connecting a laptop computer to a powersupply ([0002]). Furthermore Claim 1 of 'DiFonzo' is entitled "*apparatus for electrically connecting an electronic device to an electrical relation*".

76. Despite these generally worded terms, 'DiFonzo' is a document that generally relates to accessories of laptops. Whenever an example is given to the "*electronic device*", 'DiFonzo' refers to a laptop. The Claimant states as well that the 'DiFonzo' device is in the field of computer power supplied. Reflections on the applicability of the solution described in 'DiFonzo' to technical fields other than that of laptops do not form part of the disclosure of 'DiFonzo'.

77. The technical field of accessories to laptops is not the technical field of the patent in suit, which relates to vaporizers. Hence, to find 'DiFonzo', the skilled person would need to look in a different technological field. Nothing in 'Cross' motivates the skilled person to look in the technical field of accessories to laptops. Turning to 'DiFonzo' is a step taken in hindsight by the Claimant.

78. Furthermore, the solution of 'DiFonzo' requires an electromagnet to be present (see for example claim 1 of 'DiFonzo'). Electromagnets need electrical power to generate their magnetic field. Given that the power supply in a vaporizer is very limited, a skilled person would not consider applying a solution that introduced further power requirements into the device (the power to drive the electromagnet) suitable for a vaporizer. To maximize the time between the exchange of batteries, the skilled person would want to minimize the power requirements within the vaporizer and would not turn to 'DiFonzo'.

79. The Claimant argues that the skilled person ought to be expected to look for suggestions in neighbouring fields, if the same or similar problems arise in such fields (mn. 68 to 75 Reply to the Statement of Defence). When faced with problems which relate to providing a secure connection between the cartomizer and the chamber, the skilled person, however, does, not look at power connectors.

80. For these reasons features 1.7, 1.7.1, 1.8., 1.8.1 and 1.8.2. are not obvious in view of 'Cross' combined with 'DiFonzo'.

VII. Starting from 'Pan'

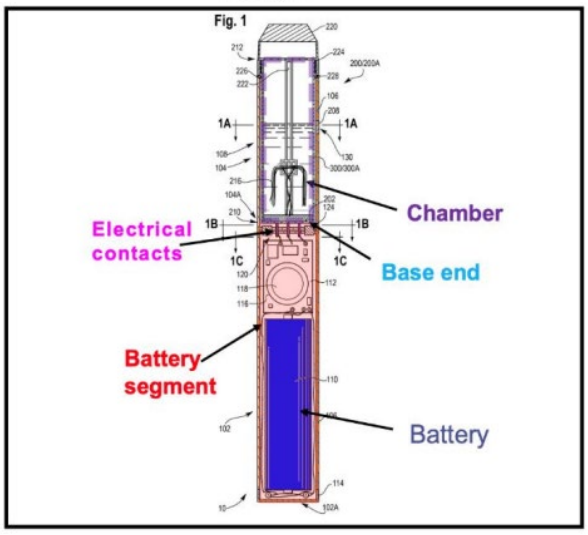
Disclosure of 'Pan'

81. 'Pan' relates to an electronic cigarette and discloses a vaporizer with all features of the claimed invention except for features 1.7, 1.7.1, 1.8, 1.8.1 and 1.8.2. 'Pan' generally pertains to a vaporizers that comprises a shell having a battery segment and a cartomizer receiving segment, disposed one above other, whereby the cartomizer receiving segment defines a chamber having an insertion end and a base end, the chamber being dimensioned to receive a cartomizer inserted into the chamber at the insertion end of the chamber, and comprises a battery housed within the battery segment. Therefore 'Pan' is very close to the invention and is a realistic starting point for the assessment of inventive step.

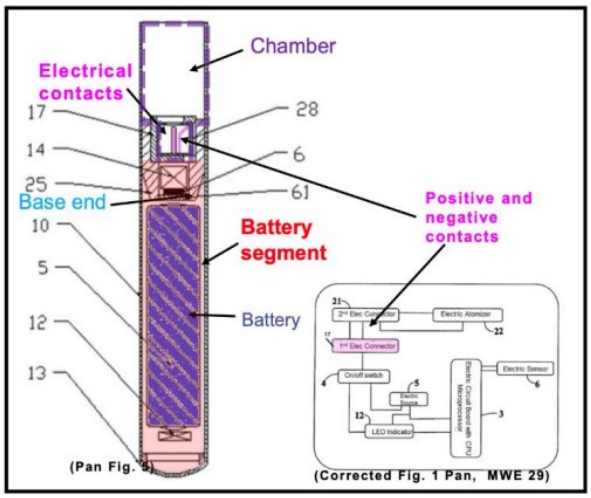
82. There is no dispute between the parties that features 1.1, 1.2., 1.2.1, 1.2.2., 1.3., 1.5 and 1.6 are present in 'Pan'.

83. Feature 1.4. is also disclosed in 'Pan' where electrical contacts are provided between the base end of the chamber and the battery segment, whereby the electrical contacts include a positive contact and a negative contacts insulated from the positive contact. The figures below provided by the Claimant at the oral hearing illustrate both devices.

Patent



Pan



84. In Pan electrical contacts highlighted by the Claimant in pink in the right hand picture above and consisting of a central, pin-shaped contact and a further, thin spring-like contact at the side of the central, pin-shaped contact are provided, one of these to the skilled person's understanding being a positive contact, the other one to the skilled person's understanding being a negative contact insulated from the positive contact.

85. It is without dispute between the parties that 'Pan' does not disclose features 1.7, 1.7.1, 1.8., 1.8.1 and 1.8.2., namely these are the features whose obviousness must be assessed.

'Pan' combined with common general knowledge

86. The reasons set out in paras. 67 – 74 are also relevant to 'Pan'.

87. For completeness it may be added that no evidence is provided that 'CGK' is established regarding solution to

• have the cartomizer be securable within the chamber as a cartomizer surface and a magnetically attracted chamber surface are placed adjacent to one another

• namely by making said chamber surface a chamber magnet provided proximate to the base end of the chamber, the chamber magnet being insulated from the electrical contacts, and by

• providing an additional chamber magnet proximate to the base end of the chamber, the additional chamber magnet being insulated from the electrical contacts and the chamber magnet, the additional chamber magnet having a polarity opposite to that of the chamber magnet.

88. Therefore, the invention is not obvious in view of 'Pan' combined with CGK.

'Pan' combined with 'DiFonzo'

89. For similar reasons as indicated above in conjunction with 'Cross', starting from 'Pan' the skilled person would not turn to 'DiFonzo' for guidance on how to further improve the device known from 'Pan'.

90. One of the problems to be solved in 'Pan' is described in [0007] is that the existing electronic cigarette devises are too complex to be implemented as an ordinary consuming product and too costly for manufacturing and maintenance. 'Pan' discloses connection between the electric connectors by means of screw thread or DC socket ([0010], [0030], [0031], [0033], dependent claim 14) which have the technical effect to provide secure and not expensive connection. As detailed above in para. 77 and 78, reflections on the applicability of the solution described in 'DiFonzo' to technical fields other than that of laptops do not form part of the disclosure of 'DiFonzo' and nothing in 'Pan' motivates the skilled person to look in the technical field of accessories to laptops. As explained above under para. 79, given that the power supply in a vaporizer is very limited, a skilled person would not consider applying a solution that introduced further power requirements into the device (the power to drive the electromagnet) suitable for a vaporizer.

91. Therefore, the invention is not obvious in view of 'Pan' combined with 'DiFonzo'.

VIII. Conclusion

92. The alleged lack of inventive step of claim 1 of the patent over 'Cross' or 'Pan' combined with 'DiFonzo' and/or the CGK is not proved.
93. The validity of the independent claim 1 justifies validity of the dependent claims 2 – 6.
94. The revocation action should be dismissed, and the patent should be maintained as granted. There is no need to discuss the auxiliary requests to amend the patent.

C. Costs

95. With regard to costs, the Court decides that the Claimant, as the unsuccessful party, shall bear the costs of the proceedings in accordance with **Art. 69 of the UPCA** up to the ceiling of EUR 500.001,00.

DECISION:

Based on the foregoing, the Paris Central Division of the UPC, rules as follows:
1. The revocation action filed by NJOY Netherlands B.V. against VMR Products LLC concerning the European patent EP 2 875 740 B1 is dismissed.
2. European patent EP 2 875 740 B1 is maintained as granted.
3. The Claimant bears the cost of the proceedings.

issued on 29. November 2024
Paolo Catallozzi Presiding judge
Dr. Tatyana Zhilova Legally qualified judge and judge-rapporteur
Max Tilmann Technically qualified judge
Margaux Grondein Clerk

Information about appeal

An appeal against the present Decision may be lodged at the Court of Appeal, by the unsuccessful party within two months of the date of its notification (**Art. 73(1) UPCA**, **R. 220.1(a), 224.1(a) RoP**).

ORDER DETAILS

Order no. ORD_598496/2023 in ACTION NUMBER: ACT_571537/2023
UPC number: UPC_CFI_307/2023
Action type: Revocation Action
Related proceeding no. Not provided
