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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

% *Date of Decision: 10th September, 2026*

CNR No. DLHC010418402025

\+ C.A.(COMM.IPD-PAT) 24/2025 and I.A. 7074/2026

ITC LIMITED .....Appellant

Through: Mr. J. Sai Deepak, Senior Advocate with Ms. Amrita Majumdar, Mr. Samik Mukherjee, Ms. Kritika Kaur and Mr. Avinash K. Sharma, Advocates.

versus

PHILIP MORRIS PRODUCTS S.A. & ORS. .....Respondents

Through: Mr. Sanjeev Tiwari, Mr. Manish Aryan, Mr. Nishant Rai and Ms. Yojana Sonkvsare, Advocates for R-1.
Ms. Nidhi Raman, CGSC with Mr. Om Ram and Ms. Nikita Singh, Advocates for R-2 and R-3.

CNR No. DLHC010220082025

\+ W.P.(C)-IPD 25/2025 and C.Ms. 102-103/2025 & 69/2026

ITC LIMITED .....Petitioner

Through: Mr. J. Sai Deepak, Senior Advocate with Ms. Amrita Majumdar, Mr. Samik Mukherjee, Ms. Kritika Kaur and Mr. Avinash K. Sharma, Advocates.

versus

THE ASSISTANT CONTROLLER OF PATENTS AND DESIGNS & ORS. .....Respondents

Through: Ms. Nidhi Raman, CGSC with Mr. Om Ram and Ms. Nikita Singh, Advocates for R-1 and R-2.
Mr. Sanjeev Tiwari, Mr. Manish Aryan, Mr.

Nishant Rai and Ms. Yojana Sonkvsare, Advocates for R-3.

CORAM:
HON'BLE MS. JUSTICE JYOTI SINGH

JUDGEMENT

JYOTI SINGH, J.

1. This judgment disposes the writ petition and the Appeal filed by the Appellant, challenging two orders, both dated 30.01.2025. In the writ petition filed under Article 226 of the Constitution of India, challenge is laid to the order whereby two Interlocutory Petitions ('IPs') have been dismissed as also order dismissing the post-grant opposition of the Appellant. In the appeal filed under Section 117A of The Patents Act, 1970 ('1970 Act'), order rejecting the post-grant opposition is challenged. For the sake of convenience and uniformity, ITC Limited is hereinafter referred to as the Appellant; Philip Morris Products as Patentee and Controller of Patents & Designs as the Controller.

2. Case of the Appellant, to the extent necessary, is that Appellant is an Indian conglomerate company operating in India for more than 100 years and has diversified presence in Fast Moving Consumer Goods ('FMCG') sector with branded packaged foods, personal care products, education and stationery products, agarbattis and safety matches, cigarettes and cigars, as well as in other businesses such as hotels, paperboards and specialty papers, packaging, agri-business, information technology etc. Appellant is a market leader in manufacturing and sale of cigarettes in India and is also engaged in the research and development of cigarettes and tobacco products with access to latest technologies in manufacture of cigarettes. Patentee is located in

Neuchâtel, L, Switzerland and the patent granted in its favour was opposed by the Appellant in post-grant opposition under Section 25(2) of 1970 Act.

3. Instant proceedings relate to an invention titled "*HEATED AEROSOL GENERATING ARTICLE WITH THERMAL SPREADING WRAP*", in respect of which patent was granted in favour of the Patentee on 14.12.2021. Patent Application was filed as a National Phase Application bearing no. 201617018958 with nationalization date being 02.06.2016, claiming priority from Priority Application EP13195877.9 filed on 05.12.2013 and term of the patent expires on 04.12.2034. The prosecution details of IN'384250 (IN'250) are as follows:-

Date of grant of Impugned Patent as IN 384250	14.12.2021
Date of post-Grant publication of IN 384250 in Patent Journal	17.12.2021
Date of expiry of IN 384250	04.12.2034

Indian Application No.	201617018958
PCT Application No.	PCT/EP2014/076646
Date of PCT application	04.12.2014
Date of Indian Application	02.06.2016
Date of Section 11A Publication	31.08.2016
Date of issuance of First Examination Report (FER)	01.01.2020
Date of Response to FER	18.06.2020
Date of issuance of Hearing Notice	06.10.2021
Date of Hearing	09.11.2021
Date of Written Submissions	19.11.2021

4. It is stated that Appellant filed post-grant opposition under Section 25(2) of 1970 Act read with Rule 57 of the Patents Rules, 2003 ('2003 Rules') objecting on grounds of 'lack of novelty' under Section 25(2)(b); 'prior use/prior knowledge' under Section 25(2)(d); 'lack of inventive step' under Section 25(2)(e); 'insufficiency of disclosure' under Section 25(2)(g); and 'not an invention' under Section 25(2)(f). Prior arts D1 to D6 were cited by the Appellant in the written statement of Opposition and additional documents D7 to D10 were cited under Rule 62(4) of 2003 Rules on 31.05.2024. The prior art documents are as follows:-

i. US2010200006A1 entitled "Tobacco-Containing Smoking Article" published on 12.08.2010, referred to as "Dl".
ii. EP2486812A1 entitled "Smoking article" published on 15.08.2012 referred to as "D2".
iii. US5551451A entitled "Fuel element composition" published on 03.09.1996, referred to as "D3".
iv. US4955397A entitled "Cigarette" published on 11.09.1990, referred to as "D4".
v. EP0174645A2 entitled "Smoking article" published on 19.03.1986, referred to as "D5".
vi. EP2552246A2 entitled "Smoking Article With Heat Resistant Sheet Material" published on 06.02.2013, referred to as "D6".
vii. US20110192408A1 titled "Non-combustion flavor inhalation article" published on 11.08.2011, referred to as "D7".
viii. US6129087A titled "Reduced ignition propensity smoking articles" published on 10.10.2000, referred to as "D8".

ix. US20090320865A1 titled "Flame-retardant and Fireproof Cigarette" published on 31.12.2009, referred to as "D9".

x. US2718889A titled "Heat absorbing and transferring band for cigarettes" published on 27.09.1955, referred to as "D10".

5. It is stated that reply statement was filed by the Patentee on 17.02.2023 and the post-grant opposition was heard on 06.06.2024, whereafter both parties filed written submissions on 21.06.2024. Patentee filed two auxiliary claim sets along with written submissions, which were in addition to existing claims and not proposed at the hearing on 06.06.2024. Objection was raised by the Appellant vide letters dated 22.07.2024 and 26.07.2024 and thereafter Interlocutory Petition ('IP') dated 14.08.2024 was filed. Meanwhile, on 25.07.2024, Controller issued notice to the parties for re-hearing on 20.08.2024, but there was no clarity on the claims which the Patentee intended to pursue.

6. It is stated that ultimately Patentee did not pursue the amendment sought and instead filed fresh written submissions in respect of existing granted claims on 04.09.2024, making submissions beyond reply statement and earlier written submissions. In light of this, second IP dated 21.09.2024 was filed by the Appellant seeking rejection of the fresh written submissions. However, vide order dated 30.01.2025, both the IPs were dismissed and on the same day, by a separate order, post-grant opposition was also rejected by the Controller. Appellant filed the present writ petition challenging both orders as also the appeal, separately and substantively challenging rejection of the post-grant opposition as also seeking revocation of IN'250 in entirety. Before proceeding further, it will be relevant to extract hereunder, the granted set of claims:-

"*1. A heated aerosol-generating article (1000, 2000) for use with an electrically-operated aerosol-generating device (3010) comprising a heating element (3100), the aerosol-generating article (1000, 2000) comprising:*

an aerosol-forming substrate (1020, 2020) radially encircled by a sheet of thermally-conductive material (1222, 2222), in which the aerosol-forming substrate (1020, 2020) comprises a gathered sheet of aerosol-forming material circumscribed by a wrapper (5060), the wrapper (5060) being the sheet of thermally-conductive material which acts as a thermally-conducting flame barrier for spreading heat and mitigating against the risk of a user igniting the aerosol-forming substrate (1020, 2020) by applying a flame to the aerosol-generating article (1000, 2000).

2. The heated aerosol-generating article (1000) as claimed in claim 1, wherein the aerosol-generating article (1000) comprises a plurality of elements (1020, 1030, 1040, 1050), including the aerosol-forming substrate (1020), assembled within a cigarette paper (1060) to form a rod, the sheet of thermally-conductive material (1222) being located within the cigarette paper (1060).

3. The heated aerosol-generating article (2000) as claimed in claim 1, wherein the aerosol-generating article (2000) comprises a plurality of elements (2020, 2030, 2040, 2050), including the aerosol-forming substrate (2020), assembled within a cigarette paper (2060) to form a rod, the sheet of thermally-conductive material (2222) being located radially external to the cigarette paper (2060).

4. The heated aerosol-generating article (1000, 2000) as claimed in claim 1, wherein the aerosol -generating article (1000, 2000) is in the form of a rod having a mouth end (1012, 2012) and a distal end (1013, 2013) upstream from the mouth end (1012, 2012), in which a portion of the thermally-conductive material (1222, 2222) covers the distal end (1013, 2013) of the rod.

5. The heated aerosol-generating article (1000) as claimed in claim 1, wherein the aerosol-generating article (1000) is in the form of a rod having a mouth end (1012) and a distal end (1013) upstream from the mouth end (1012), in which a spacer element (1040) is located within the rod upstream of the aerosol-forming substrate (1020).

6. The heated aerosol-generating article (1000) as claimed in claim 1, wherein the aerosol-generating article (1000) is in the form of a rod having a mouth end (1012) and a distal end (1013) upstream from the mouth end (1012), in which the aerosol-forming substrate (1020) is located at the distal end (1013) of the rod.

7. The heated aerosol-generating article (1000, 2000) as claimed in claim 1, wherein the sheet of thermally-conductive material is or comprises

metal foil.

8. The heated aerosol-generating article (1000, 2000) as claimed in claim 7, wherein the sheet of thermally conductive material is a sheet of material formed by co-lamination of metal foil with paper, or a sheet material formed by co-lamination of metal foil with reconstituted tobacco.

9. The heated aerosol-generating article (1000, 2000) as claimed in claim 7, wherein the metal foil is aluminium foil (1222, 2222).

10. The heated aerosol-generating article (1000, 2000) as claimed in claim 1, for use with an aerosol-generating device (3010) comprising an insertable heating element (3100) for insertion into a distal end (1013, 2013) of the heated aerosol generating article (1000, 2000).”

ARGUMENTS IN WRIT PETITION:

Submissions on behalf of the Appellant

7. As per the specifications of IN’250, the problem to be solved is to reduce the propensity of ignition of aerosol-generating articles by using a wrapper circumscribing the gathered sheet of aerosol-forming material, which may be a metal foil or may comprise a metal foil, e.g., the wrapper may be aluminium foil or a coal laminated sheet comprising a layer of aluminium foil. Therefore, as per the Patentee, the technical advancement is that the wrapper of thermally conductive material circumscribing the gathered sheet of aerosol-forming material helps to reduce the likelihood of ignition of the aerosol-forming substrate of the heated aerosol-generating article, if a user chooses to light up the article like a conventional cigarette applying flame. As per the claims specification, if a user was to apply flame to the article, the thermally conductive material would conduct heat away from the point of application with the flame, thereby reducing likelihood of ignition of substrate material. Thus, when a user applies flame to such a rod forming part of heated aerosol-generating article, he may experience difficulty in igniting the heated aerosol-material and may therefore be discouraged from smoking in an unintended way. Claim 1 is an independent

claim directed at *'A heated aerosol-generating article'* and Claims 2-10 are directly or indirectly dependent on Claim 1.

8. The controversy started with the Patentee filing two sets of auxiliary claim amendments with written submissions dated 21.06.2024, recognizing the inherent weakness of its case. Controller ought to have disregarded the auxiliary claims' amendment sought in light of Interlocutory Petition dated 14.08.2024 (IP-1) filed by the Appellant, however, notice was issued to both parties on 06.06.2024 to file their written submissions, which they did. Appellant sent two letters dated 22.07.2024 and 26.07.2024 objecting to a re-hearing once proceedings in the post-grant opposition were concluded on 06.06.2024, in which parties were directed to file their written submissions as also to understand the purpose of scheduling a fresh hearing on 20.08.2024, but to no avail. This procedure is unknown to law and the only remedy available to the Patentee was to file an application for leave to amend and follow the procedure laid down in Rule 81(3)(a) (b) and (c) of 2003 Rules, having regard to the provisions of Section 57(3) of 1970 Act, which he did not follow. Controller thus erred in permitting re-hearing after conclusion of hearing on post-grant opposition.

9. Rule 62(5) of 2003 Rules categorically provides that Controller shall hear the parties, decide the opposition and notify its decision to the parties after giving reasons thereof. Proposing amendments to the claims without application in the prescribed manner along with prescribed fee is contrary to the statutory scheme. It is only the Controller who can amend the claims under Section 25(4) and it is not open to a patentee to seek voluntary amendment without an application under Section 57(3) of 1970 Act. Despite these anomalies, Controller proceeded to hold a hearing on 20.08.2025.

10. On the day of scheduled hearing, Appellant was not allowed to address arguments on IP-1 while the Controller indulged the Patentee by permitting filing of fresh written submissions to defend the auxiliary claims. Importantly, Patentee gave no indication whether it would pursue the amendment or defend the existing claims and resultantly, it was not clear to the Appellant whether opposition would be decided on granted claims on record or on the auxiliary claim amendments and in fact, Appellant was under the *bona fide* impression that IP-1 will be first heard on this issue. While traversing the fresh written submissions, Appellant found that the contents were beyond the earlier written submissions dated 21.06.2024, oral submissions made on 20.08.2024 and pleadings of the Patentee in reply statement, more particularly, paragraphs 56 and 57, which triggered the filing of Interlocutory Petition dated 21.09.2024 (IP-2) to strike off the fresh written submissions. Both IP-1 and IP-2 were erroneously dismissed by the Controller vide order dated 30.01.2025 and that too, treating both as relating to auxiliary claim amendments, overlooking that IP-2 was for striking off the fresh written submissions.

11. Disadvantage and prejudice suffered by the Appellant owing to fresh written submissions, is not merely procedural. Reading of impugned order dated 30.01.2025, whereby post-grant opposition was rejected, shows that Controller's decision is substantially based on the fresh written submissions and that too without providing an opportunity to the Appellant to respond to them, which violates principles of natural justice. Two observations in the impugned order are based entirely on the fresh written submissions and have prejudiced the Appellant and are as follows:-

Impugned Order dated 30.01.2025	Fresh Written Submissions Dated 04.09.2024 filed by Patentee
D1 in para [0099] describes that the wrapping material 160 can vary. The wrapping material 160 can be a paper wrapping material of the type traditionally used for cigarette manufacture. The wrapping material 160 also can be composed of a laminate of metallic foil and paper. Whereas the thermally conducting sheet in the opposed patent is a metallic foil. Therefore, it is clear that a laminate will have different thermal conductivity than a metal foil which is only composed of metal in contrast to the laminate which is made of different sheet of metal and paper. Therefore, D1 fails to teach this functional limitation of the claim 1 of the opposed patent.	*There is a mention of laminates of paper and metal foil in D1, wherein it is clearly mentioned that the wrapping material is paper or laminate of paper at para [075]:* *there is a difference between a laminate comprising paper and metal foil AND a metal foil.* *To establish clarity about the distinctness between the two, it should be understood that a metal foil is completely made of metal and retains its inherent properties associated with the respective corresponding metal it is made from, whereas a laminate foil comprises many layers fused together, of which metal may be one of the layers. The layers in a laminate are of the order of few microns and are fused together to create a laminate which has properties altered from the material of the individual layers comprising the laminate.* *Further, an ignition temperature of a laminate foil is generally below a flame temperature of a smoking lighter or a matchstick, whereas the ignition temperature or at least the melting point of a metal foil is the same as that of the corresponding metal of which the metal foil is made. In other words, a laminate foil comprising metal may melt or ignite at a temperature of the flame of a matchstick and the like, but a metal foil will not.* [Paras 38-41]
In particular, D1 does not talk about gathered sheet of tobacco in the sense defined by the specification of the opposed patent let alone disclosing the aerosol forming material is gathered.	*There are two separate segments within a single wrapper:* *c. Upstream segment 95* *i. 89: tobacco* *d. Downstream segment 98* *i. 101: aerosol forming material* *D1 discloses cut-filler tobacco as one of the Segments*

In fact, D1 clearly states that two separate ingredients i.e., an aerosol-forming material positioned within the outer housing which is in fluid communication with said tobacco material. [Para-[0019] and [0020].	*In D1, the wrapper holds together two separate segments. There are two separate segments within a single wrapper:* *A.Upstream segment 95* *i.89: tobacco* *b.Downstream segment 98* *i.101: aerosol forming material*

12. Admittedly, Patentee did not press the auxiliary claims' amendment in the hearing held on 20.08.2024 and restricted its case to the granted claims and thus only IP-2 was to be decided. However, the Controller mechanically dismissed both the IPs treating them as those directed against auxiliary claims. Since there was gross violation of principles of natural justice and procedure, writ jurisdiction of this Court was rightly invoked in addition to challenging the order rejecting the post-grant opposition on merits and is maintainable. Moreover, the order rejecting the IPs is not an 'order' under Section 25(4) against which an appeal lies under Section 117A of 1970 Act.

13. It is trite that writ petition is ordinarily not maintainable when an efficacious alternate remedy is available. *Arguendo,* even if the remedy of appeal was available and writ petition has been filed, both the appeal and the writ petition are being heard together and therefore, no prejudice is caused to the Patentee. In fact, if the writ petition is allowed, it will obviate the need of a merit based detailed adjudication by the Court. The objection on maintainability of the appeal overlooks the settled law that if there are violations of principles of natural justice, then existence of alternate remedy does not act as a bar. ***[Ref.: Whirlpool Corporation v. Registrar of Trade Marks, Mumbai and Others, (1998) 8 SCC 1*** and ***Best Agrolife Limited v. Deputy Controller of Patents and Another, 2022 SCC OnLine Del 1982]***. Patentee's and Controller's argument that IPs form part of the same opposition proceedings and therefore, the decision on the IPs is also a decision under Section 25(4) and hence the only remedy is an appeal, is legally flawed since under Section 25(4), Controller can only maintain, amend or revoke the patent, whereas the prayers in the two IPs were to reject the auxiliary claim amendments and strike off the fresh written submissions,

respectively, which is not within the purview of Section 25(4).

14. Argument of the Respondents that Controller can always consider new pleadings or written submissions while passing an order under Section 25(4) is contrary to the judgment of the Supreme Court in ***Shivaji Balaram Haibatti v. Avinash Maruthi Pawar, (2018) 11 SCC 652***, holding that parties cannot travel beyond pleadings. Purpose of pleadings is to ensure that litigants come to trial with all issues clearly defined, as held by the Supreme Court in ***Bachhaj Nahar v. Nilima Mandal and Another, (2008) 17 SCC 491.***

Submissions on behalf of the Controller

15. The writ petition is not maintainable and be dismissed without going into merits. Impugned orders were passed under Section 25(4) and Section 117A(2) explicitly provides for an appeal challenging any decision, order or direction of the Controller. Further, there were no extraordinary circumstances or compelling reasons, justifying invoking the writ jurisdiction of this Court. Entertaining this writ petition would set a dangerous precedent where parties will choose to file a writ petition or an appeal at their option, which will violate the statutory scheme and result in a situation never intended by the legislature. In any case, there is no provision in the 1970 Act, which provides for filing interlocutory petitions in post-grant opposition proceedings and this was a wrong path that the Appellant chose on its own volition. Appellant could only have challenged the final order rejecting the post-grant opposition.

16. Impugned order dismissing the IPs arises out of the same opposition proceedings and cannot be separately challenged. In fact, filing of the IPs was itself misconceived as there is no provision under the 1970 Act

envisaging filing of interlocutory petitions by an opponent at the post-grant opposition stage. Appellant artificially and erroneously bifurcates a consolidated statutory proceeding into two segments. Section 117A(2) explicitly permits a statutory appeal against the 'final' order passed under Section 25(4) and Legislature has consciously and deliberately omitted any reference to interim or interlocutory orders passed during the pendency of the opposition. An appeal has a wider scope and in the instant case, the appeal takes within its sweep challenge to procedural violations, if any, as also alleged violations of principles of natural justice. Extraordinary writ jurisdiction should not be used as appellate jurisdiction to correct procedural orders or interlocutory dismissals by statutory authorities.

17. Without prejudice, even on merits the Appellant has no case. There was no violation of any procedure or principles of natural justice. Appellant was granted ample opportunities to rebut patentee's fresh written submissions after conclusion of each hearing. After the post-grant opposition was heard on 06.06.2024, Appellant filed written submissions on 21.06.2024 and Patentee filed its written submissions on the same day with two auxiliary claim sets. Appellant filed IP-1 on 14.08.2024 opposing the amendment post-conclusion of the hearing of the post-grant opposition. On 20.08.2024, hearing was conducted which was duly attended on behalf of the Appellant and on 21.09.2024, IP-2 was filed for striking off fresh written submissions. Hearing was scheduled for 29.10.2024, but Appellant sought adjournment and hearing was adjourned to 21.11.2024, on which date the Appellant was heard. On the same day rejoinder was filed by the Appellant, followed by post-hearing submissions on 06.12.2024 and thus it cannot be asserted that opportunity of hearing was denied. In any case, once the

Patentee gave up the amendments sought and decided to restrict its case to the granted claims on record, there was no prejudice caused to the Appellant. The argument that the impugned order is based on and influenced by the pleas in the fresh written submissions, is misconceived. The impugned decision is well-reasoned and taken after considering *inter alia* the prior arts cited, respective submissions of the parties, both factual and legal, claims specifications and recommendations of the Opposition Board, which is self-explicit from a plain reading of the order.

Submissions on behalf of the Patentee

18. Post-grant opposition proceedings are governed by Section 25(2) and 25(6) of the 1970 Act read with Rules 55A to 62 of the 2003 Rules and there is no provision in either, envisaging filing of written submissions or IPs and yet the Controller afforded opportunity to both parties to file written submissions and also entertained Appellant's IPs. Writ petition is an abuse of process of law since Patentee did not take steps to add the auxiliary claim sets under Section 57(3), after the advice of the Controller in this regard and hence, IP-1 was rendered infructuous and rightly dismissed. Both sides were afforded opportunity of hearing before the post-grant opposition was rejected by a separate and detailed speaking order and only because the outcome was not favourable to the Appellant, objection of violation of principles of natural justice is being raised. The impugned orders were passed after careful consideration of the granted claims and objections raised and after filing the Appeal laying a substantive challenge to these orders, Appellant cannot pursue the writ petition as a parallel proceeding. The contents of the fresh written submissions were not new or outside the earlier pleadings and in fact the distinction in metal foil and laminate is found in the

complete claims specifications itself and was only explained in the written submissions for the benefit of the Controller, owing to the points brought out by the Appellant in the post-grant opposition.

ARGUMENTS IN APPEAL:

Submissions on behalf of the Appellant

19. Appeal lays a challenge to order dated 30.01.2025 passed by the Controller under Section 25(4) of 1970 Act rejecting the post-grant opposition filed by the Appellant in respect of IN'250 granted in favour of the Patentee. Impugned patent IN'250 relates to heated aerosol generating article for use with an electrically operated aerosol-generating device comprising a heating element, the aerosol-generating article comprising an aerosol-forming substrate radially encircled by a sheet of thermally conductive material and as claimed, the problem it resolves is reduction in the propensity of ignition of aerosol-generating articles by using a wrapper circumscribing the gathered sheet of aerosol-forming material, which may be a metal foil or may comprise of a metal foil e.g. aluminium foil or a co-laminated sheet comprising a layer of aluminium foil. The patent comprises a set of 10 claims, where Claim 1 is an independent claim and Claims 2-10 are directly or indirectly dependent on Claim 1. Appellant filed a post-grant opposition under Section 25(2) of the 1970 Act, since the granted patent lacks novelty in view of prior arts D1 and D7 under Section 25(2)(b); lacks prior use/prior knowledge under Section 25(2)(d); lacks inventive step under Section 25(2)(e); is not an invention under Section 25(2)(f) and there is insufficiency of disclosure under Section 25(2)(g), however, the same has been dismissed erroneously by the Controller.

20. Prior art D1 discloses a smoking article incorporated within an electrically powered aerosol-generating device comprising a heating element for forming thermally generated aerosol incorporating components of tobacco and thus, destroys novelty by anticipating all elements of Claim 1. D1 teaches that the tobacco rod can be wrapped in conventionally known wrapping materials like paper and metal foil. Figure 2 of D1 shows that the tobacco rod is wholly circumscribed by a wrapping material composed of laminate of metallic foil and paper. D1 also discloses aerosol-forming substrate comprising a gathered sheet of aerosol-forming material. The feature claimed to be novel and inventive is the thermally conductive material acting as a flame barrier for spreading heat and mitigating against the risk of a user igniting the aerosol-forming substrate by applying flame to the aerosol-generating article, is merely a functional feature and inherent to such metal foil wrappers and thus Patentee has made no contribution to the art.

21. Controller erred in holding that the patent is novel over D1, overlooking that all features of Claim 1 are disclosed in D1. Even the Opposition Board erred inasmuch as after acknowledging that D1 discloses all features of Claim 1 viz., (a) aerosol-forming substrate comprising a gathered sheet of aerosol-forming material; and (b) aerosol-forming substrate radially encircled by a sheet of thermally conductive material i.e. metallic foil taught in D1, it held that the invention was novel, solely relying on thermal conductivity feature, which is only a functional aspect.

22. Prior art D7 is also a novelty destroying prior art, which anticipates all elements of independent Claim 1 of the patent. D7 relates to a heated aerosol-generating article for use with an electrically operated aerosol-

generating device and teaches that the tobacco rod is wrapped in wrapping material made of aluminium foil. Figure 3 of D7, illustrates that the tobacco sheet is wholly circumscribed by a wrapping material made of aluminium foil. D7 discloses aerosol-forming substrate comprising a tobacco sheet and describes wounding of multiple layers in para [0034], which is equivalent to concept of gathered sheets, since 'wounding of multiple layers' is a type of gathering which happens in a structured way. D7 also teaches that the wrapper can be a metal foil with high thermal conductivity such as aluminium foil [para 0084] and the desire to avoid confusion of tobacco sheet [para 0004 to 0009]. D7 also teaches that aluminium foil has high heat conductivity in the range of 236W/m.K. Patentee has simply worded Claim 1 in a manner that it appears novel, but actually there resides no novelty in this feature and the claim is entirely anticipated by D7.

23. Granted patent also lacks obviousness/lack of inventive step and D1 is the closest prior art, disclosing a smoking article incorporated within an electrically powered aerosol-generating device and a wrapping material as a laminate of metallic foil and paper. *Arguendo*, even if the flame barrier function/property of the thermally conducting material is not explicitly disclosed in D1, it would be obvious to a person skilled in the art to expect such wrappers to act as flame barriers, as this is an inherent property of such thermally conducting materials. D7 also destroys the obviousness of the patent as it relates to a heated aerosol-generating article for use with an 'electrically' operated aerosol-generating device and Figure 3 of D7 teaches a roll including a tobacco sheet, where the roll is obtained by wrapping the outside of the hollow cylindrical shaped tobacco sheet with a heat conductive rapid material. D7 teaches that wrapper can be a metal foil with

high thermal conductivity such as aluminium foil and the desire to avoid combustion of tobacco sheet. A person skilled in the art knows that materials with high thermal conductivity such as aluminium foil are capable of spreading/conducting heat easily and are not easy to ignite as they have a high ignition temperature. Person skilled in the art would obviously know that a metal/aluminium foil can be used as a barrier to spread heat and mitigate the risk of ignition if flame is applied to the substrate. Furthermore, para [0034] describes a wounded sheet of tobacco, which is equivalent to a gathered sheet, another feature, which according to the Patentee is inventive in the granted patent.

24. D1 in combination with D3, which teaches metal/aluminium foil laminate as a wrapper for encircling the aerosol-generating substrate and its use for preventing excessive combustion, makes the claims in the patent obvious. Although D2 does not explicitly disclose that the smoking article is used with an electrically operated device as also the thermally conducting flame barrier, however, feature of flame barrier is inherent in the disclosed wrapper and person skilled in the art can use the disclosed article without any modification to reach the claimed invention. There resides no inventiveness in using a thermally conductive wrapper known to conduct heat to encircle the tobacco rod as use of such wrappers was known in the art and is in fact disclosed in D1 and D2.

25. D5, similar to D4's teaching, teaches a smoking article, which utilizes a combustible fuel element, preferably of a carbonaceous material, in conjunction with a physically separate aerosol-generating means that is in conductive heat exchange relationship with the fuel element, which is about 20mm long and as disclosed in paras [0020 and 0021], the foil lined paper

tube at the mouth end piece of the article surrounds aerosol-generating means and the rear non-lighting end of fuel element. This increases the heat transfer to the aerosol generator and the foil helps to extinguish the fire cone. Therefore, patentee has merely put to use a well-known property of metallic foils, which is known to have high thermal conductivities. The problem to be solved was to prevent an unintended use i.e., accidental ignition of aerosol-generating article and it is only natural for a skilled person to select the material which is capable of dissipating or spreading heat and aluminium foils have been frequently used for high thermal conductivity.

26. D6 relates to a heated or combustible smoking article with a tipping paper formed of a sheet material. It discloses use of sheet material as an outer wrapper for a heated smoking article since the wrappers are sufficiently heat resistant. D7 read with teachings of D1 makes the invention obvious. D7 clearly teaches that the wrapper can be a metal foil with high thermal conductivity such as aluminium foil and the desire to avoid combustion of tobacco sheet and para [0034] thereof describes a wounded sheet of tobacco, which is equivalent to a gathered sheet. Likewise, teachings of D1 with prior arts D8-D10 show that thermally conductive material is or comprises metal foil, preferably formed by co-lamination of metal foil with paper or a sheet material formed by co-lamination of metal foil with reconstituted tobacco and thus, the claims in the claimed invention do not recite any inventive feature. No technical advancement in the art has been shown by the patentee and all that is claimed is an article, which is already in the public domain.

27. Claim 1 is directed to aerosol-generating article and not aerosol-

generating device and does not recite any constructional feature. Positioning of the thermal conductive wrapping material at the distal end of the article is defined in Claim 4. In any case, comparison of aerosol-generating article alone in IN'250 with cigarette coupled to a device, is erroneous. Claim 1 of corresponding US application was held to be obvious in view of D1 in non-final rejection, which was later abandoned by the patentee. Most importantly, Controller failed to identify the person skilled in the art, contrary to the decision in ***F.Hoffmann-La Roche Ltd. & Anr. v. Cipla Ltd., 2015 SCC OnLine Del 13619*** and *sans* this exercise, there could be no determination of whether the use of thermally conductive wrappers for heat spreading and ignition mitigation would have been obvious in light of cited prior art and consequently, of motivation and obviousness. Independent Claim 1 is extremely broad and does not define any constructional feature and features allegedly different from D1 are defined in dependent claims and not in independent Claim 1 viz., positioning of thermally conductive rapid material at the distal end is defined in dependent Claim 4; plurality of elements and outer cigarette paper is defined in dependent Claims 2 and 3; and insertable heating element is defined in dependent Claim 10.

28. Controller has erred in excluding additional documents D7-D10 filed by the Appellant under Rule 62(4) of 2003 Rules on 31.05.2024, which clearly demonstrated lack of inventive step in the granted patent. D7 relates to heated aerosol-generating article for use with an electrically operated aerosol-generating device (Figure 2 of D7 and para [0029]) and teaches that the wrapper can be a metal foil with high thermal conductivity such as aluminium foil and the desire to avoid combustion of the tobacco sheet. D7 also teaches that aluminium foil has high heat conductivity, which reduces

propensity of ignition of smoking articles by using materials such as metal foil of aluminium and its fire proof and flame retardant properties. Non-consideration of D7 owing to erroneous interpretation of paragraph 40 of the judgment in ***Pharmacyclics LLC v. Union of India and Ors., W.P.(C) 12105/2019, decided on 20.11.2019,*** has prejudiced the Appellant. 2003 Rules do not carve out any distinction between first scheduled date of hearing and adjourned date of hearing and Rule 62(4) only uses the term 'hearing'. Moreover, this Rule has to be read with Rule 129A, which provides for adjournment and uses the term 'hearing'. It is overlooked that the observation in paragraph 40 applies to Rule 60, which concerns 'further evidence' and not to publications under Rule 62(4) and paragraph 41 supports this position. D7 was the prior art relied upon by Board of Appeal for revoking the EP counterpart of IN'250 for lack of novelty.

Submissions on behalf of the Controller

29. Controller rightly excluded consideration of additional documents D7-D10, which were filed beyond the permissible time limit. Time for any publication under Rule 62(4) is five days prior to hearing as notified under Rule 62(1), which means the first scheduled hearing date and not the adjourned date of hearing. Section 25(2) provides one year for filing post-grant opposition and therefore, an opponent has an opportunity to file revocation under Section 64(1). Under Rule 57, opponent files evidence and has further opportunity under Rule 59, which mandates that reply statement and evidence should be strictly confined to evidence under Rule 58. Additionally, opponent can file further evidence under Rule 60. The first hearing in the matter was scheduled for 30.04.2024 and thus relying on the judgment in ***Pharmacyclics (Supra),*** Controller rightly held that five-day

notice period for filing new publications under Section 62(4) has to be calculated with respect to first scheduled date of hearing and excluded the time barred additional documents. Allowing evidence to be filed piecemeal before every adjourned hearing would defeat the objective of expeditious disposal and allow parties to indefinitely prolong proceedings.

30. Even on merits, Appellant has no case. Controller has passed a detailed and speaking order holding that the granted patent neither lacks novelty nor inventive step and none of the other objections were made out. Appellant's challenge to novelty is primarily based on D1 and Controller has rightly found that D1 does not anticipate the claimed invention as both are structurally and functionally different. Structurally, patent claims require an aerosol forming substrate comprising a gathered sheet of aerosol forming material. D1 discloses tobacco rod or gathered web which is not the specific gathered sheet configuration in the patent i.e. a sheet folded and convoluted to occupy tri-dimensional space and does not anticipate the specific structural limitations of the gathered sheet in Claim 1.

31. Functionally, there is a critical technical difference in the purpose of the wrapper, which in D1 is designed to be in contact with an internal heating element and is meant to transfer heat inward to the tobacco substrate to facilitate aerosol generation, in stark contrast to the wrapper in the granted patented which functions as a thermally conducting flame barrier designed to dissipate heat in the event flame is applied with lighter etc. and thus protects the substrate from ignition or combustion. Controller correctly held that the flame barrier quality is a functional limitation derived from article's special construction since invention lies not in the material itself, but in the inventive manner in which the material is positioned and employed to solve

a specific technical problem of preventing external ignition, which is distinct from its inherent physical properties. Controller noted positional difference in the wrapping material of D1 on a visual comparison of Figure 2 of the patent and Figure 3 of D1, which revealed that the wrapping material in D1 is located deep inside the device or near the mouthpiece and observed that no user will apply flame around the wrapping material of D1 given its internal or proximal location and hence, D1 fails to disclose a wrapper positioned and configured to act as a flame barrier against external ignition sources, which confirms the novelty of claimed invention.

32. Appellant's contention on lack of inventive step owing to D1 with D2-D6, also lacks merit as the prior arts are in distinct fields of invention and teach away from the granted claims. D2-D6 relate exclusively to combustible smoking articles, where the objective is to burn the tobacco or fuel element, whereas D1 and granted Claim 1 relate to electrically heated, non-combustible aerosol generating articles and a person skilled in the art in electrically heated devices would not look to the field of combustible cigarettes for solutions to the technical problems solved in Claim 1. Furthermore, D2-D6 teach the use of metal foils to retain heat or transfer heat from a fuel source to the tobacco to promote combustion. The objective of granted claims is to use the foil to shield the tobacco from external flame and prevent combustion. Combining a teaching that promotes heat transfer for combustion with a device designed to avoid combustion would be counter intuitive. The prior arts clearly teach away from the invention and there is no motivation for a person skilled in the art to combine these disparate references to arrive at the claimed invention.

33. Appellant's objection under section 3(d) is equally misplaced. Firstly,

as recorded in the impugned order, there was no discussion on the subject before the Controller during the hearing and thus it is not open to plead this ground. Secondly, the subject matter of the granted patent is a heated aerosol generating article with a specific mechanical construction comprising gathered sheet substrate radially encircled by a thermally conductive flame barrier. This constitutes a new product or article of manufacture and is not merely the use of a substance. Controller examined the complete specification and correctly determined that the disclosure was sufficient. The claims specification, particularly, through Figures 2-4 and the accompanying description, clearly delineates the construction of the article, positioning of the wrapper and its function as a flame barrier. The disclosure provides adequate technical details to enable a person skilled in the art to perform the invention, thereby satisfying the requirements of the provisions of 1970 Act and for all these reasons, the appeal deserves to be dismissed.

Submissions on behalf of the Patentee

34. Controller rightly excluded documents D7 to D10 filed by the Appellant under Rule 62(4) of 2003 Rules as time barred documents. Appellant failed to file evidence or submissions under Rule 59 within the prescribed time limit, in response to reply statement under Rule 58 by the Patentee on 17.02.2023 and to overcome this lacuna, additional documents were filed under Rule 62(4), which were rightly not accepted inasmuch as the five day notice period is with respect to first scheduled hearing date, which was 30.04.2024 and not the adjourned hearing date and this issue has been settled by this Court in ***Pharmacyclics (Supra),*** on which the Controller has relied.

35. On merits, the objections in the post-grant opposition are untenable in

law. The invention claimed under the patent relates to an aerosol-generating article having an aerosol-forming substrate adapted to release volatile compounds to form an aerosol through heating rather than combustion of the substrate. Such an article in the claims, with corresponding support in PCT publication contrasts with conventional cigarettes which are ignited and combusted and rely on the ignition by flame from a match or lighter. The heated aerosol-generating article does not include a combustible heat source and is adapted for use with an electrically operated aerosol-generating device with an insertable heating element and also contrasts with articles incorporating a combustible heat source to generate heat necessary for volatile compounds to be released from the aerosol-forming substrate as also an article heated from outside through a wrapper.

36. Claims in the granted patent include an aerosol-forming substrate comprising a gathered sheet of aerosol-forming material, which is one that is convoluted, folded or otherwise compressed or constricted transversely, as supported in the PCT application. The aerosol-forming substrate is radically encircled by a sheet of thermally-conductive material and is not heated through this sheet. The wrapper acts as a thermally-conducting flame barrier for spreading heat and mitigating the risk of a user igniting the aerosol-forming substrate in the event user applies flame to the aerosol-generating article and the technical problem that the invention solves is to avoid combustion of the substrate, which in turn reduces generation of various smoke constituents associated with combustion and pyrolytic degradation of tobacco in conventional cigarettes. It also overcomes the poor user experience from using aerosol-forming articles when they are ignited rather than heated.

37. Appellant had restricted his arguments in the post-grant opposition to only two grounds i.e. lack of novelty and lack of inventive step and both objections are misconceived. It is trite that a claim is judged novel unless a single prior art reference discloses every element of the challenged claim and enables a person skilled in the art to reach the invention, which means that anticipation requires presence of a single prior art disclosure of each and every element of the claimed invention and even a minor or insubstantial difference between the claimed invention and prior art will mean that there is no anticipation. The Manual of Patent Office Practice & Procedure (Patent Manual) in para 09.03.02 under the Head 'Novelty', describes that "*A prior art is considered as anticipating novelty if all the features of the invention under examination are present in the cited prior art document. The prior art should disclose the invention either in an explicit or implicit manner. Mosaicing of prior art documents is not allowed in the determination of novelty."* This is the well recognized 'all elements' rule.

38. In the instant case, none of the cited prior arts singly disclose all elements of the patented claims. Appellant relied on D1 for proving lack of novelty *qua* Claim 1. Board of Opposition found that D1 only discloses the metallic foil as serving to transfer heat from the heating elements to the tobacco enclosed by the wrapping material and does not explicitly teach that the taught metal foil wrapper is a thermally conducting flame barrier configured to spread heat and to mitigate against risk of ignition of the aerosol-forming substrate by application of flame to the heated aerosol-generating article and has rightly given weightage to the functional limitation of Claim 1. This also negates the argument of the Appellant that claim has been granted for functionality standalone. In any case, functional

limitation is recognized by Patent Manual under Head 09.03.05.05 stating that "*for the existence of a combination invention requires that the relationship between the features or groups of features be one of functional reciprocity or that they show a combinative effect beyond the sum of their individual effects. The features should be functionally linked together which is the actual characteristic of a combination invention"*. Patentee has limited its claim to the function of thermally-conductive wrapper in such a way that the overall aerosol-generating article cannot be ignited when flame is applied.

39. The problem statement of D1 is that smoking articles that employ tobacco substitute materials or sources of heat other than burning tobacco cut filler to produce tobacco-flavored vapors or visible aerosols have not received widespread commercial success and thus it tries to provide a smoker with an article, which has the ability to use tobacco without necessity of burning significant amount of tobacco. So, the problem of D1 was never of igniting the smoking article by someone inadvertently or accidentally applying flame. Further, the tobacco material in D1 is in the form of a tobacco rod circumscribed by a wrapping material and positioned between the second resistance heating element and the mouth-end of the outer housing. The aerosol-generating device and the whole arrangement of D1 is complex as it uses three heating elements to heat the tobacco rod whereas the heating element used in claimed invention is only one. Moreover, the arrangement of the heating element in D1 is tubular which circumscribes the whole rod unlike the claimed invention. Even the substrate material in D1, which is a gathered sheet or web, is different and cannot be equated with the aerosol forming substrate in the claimed invention.

Illustratively, D1 describes that the cartridge can contain an upstream segment composed of tobacco filler or processed tobacco filler material incorporating aerosol-forming material and a downstream segment composed of a substrate such as fibres of polyethene terephthalate carrying flavors and/or aerosol forming material. It is clear that the substrate can be gathered sheet and not the whole tobacco plus the substrate.

40. Paras [0098] and [0099] in D1 describe that the wrapping material is wrapped around the tobacco in such a way that each end of tobacco rod is open and exposes the tobacco therein and allows passage of drawn air. According to the teaching of D1, the wrapping material can be a paper or a metallic foil and the wrapper acts as a heat sink (medium), which passes the heat inside the tobacco rod from the heating element of the aerosol-generating device of D1 to generate aerosol. The wrapper around the tobacco is meant to be in contact with the heating element whereas that in the claimed invention it acts as a flame barrier and is not in contact with the heating element. The wrapper used in Claim 1 is a heat dissipating device, which acts as a thermally-conducting flame barrier for spreading heat and mitigating against the risk of a user igniting the aerosol-forming substrate by applying flame to aerosol-generating article. Thus, applying the all-element rule, D1 fails to disclose all features of Claim 1 and the wrapper in D1 will not enable a person skilled in the art to make the aerosol-generating article as in Claim 1 of the claimed invention, where the wrapper has a different purpose than actual heating by a heating element and thus does not kill the novelty. Moreover, Appellant has not challenged the dependant Claims 2-10, which ought to have been done to invalidate the patent, since Patentee has protection in 10 different embodiments.

41. Controller has rightly rejected the objection of the Appellant on ground of lack of inventive step. For determination of inventive step/non-obviousness, technology in two or more prior arts must originate within an analogous art and once the analogous art is identified, it should be combined by a person skilled in the art before the priority date of the claimed invention in question. A claimed invention is obvious when there is a teaching, suggestion or motivation to combine prior art teachings. In the instant case, prior arts D2 to D6 are not analogous art to the subject matter disclosed in D1, which relates to electronic cigarettes wherein tobacco is heated and not burned or combusted, whereas D2 to D6 are related to conventional cigarettes, which burn the tobacco in a conventional way. Thus, identification of D2-D6 for combining with D1 is impermissible in law. D1 contains no indication of being concerned with mitigation of risk of ignition of the tobacco in the event flame is applied to the cigarette and there is no teaching of how wrapping material might be adapted to perform this function.

42. Prior art D2 relates to tobacco products such as smoking articles, such as cigarettes. D2 discloses numerous embodiments of smoking articles, which fall into two groups: (a) first group, in which a lighting end segment 22, heat generation segment 35 and aerosol-generating segment 51 are successively axially aligned relative to each other; and (b) second group, in which the lighting end segment 22 is omitted. However, all smoking articles rely on ignition and combustion of part of the smoking article in a manner similar to conventional cigarettes and none are heated aerosol-generating articles within the meaning of Claim 1. For ready reference, Figure 1 is as follows:

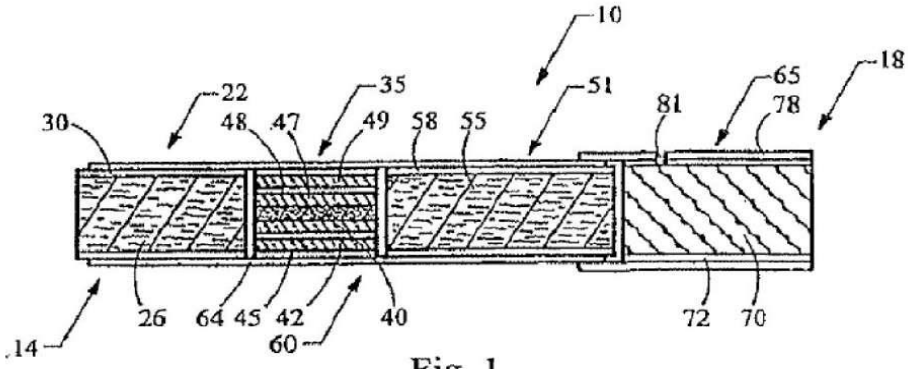


Fig. 1

43. The Figure demonstrates that lighting end segment 22 includes smokable material 26. The heat generation segment 35 has a heat source 40 circumscribed by insulation 42. Aerosol-generating segment 51 includes a substrate material 55 acting as a carrier for an aerosol-forming agent or material. Para [0024] of D2 discloses the wrapping material having heat conductive properties and being in the form of metal or metal foil, where the metal foil can conduct heat from the heat generation segment 35 to the aerosol-generating segment 51 to volatilise aerosol-forming components contained therein. Para [0026] discloses that the wrapping material 58 can be adapted to facilitate transfer of heat from the heat generation segment 35 to aerosol generating segment 51. Para [0036] discloses that to use the smoking article is lit at the lighting end 14 using a match or cigarette lighter in the same manner as in the conventional cigarettes. The smoking article relies only on ignition and burning of the substrate and is thus not a heated aerosol-generating article. The wrapping material in D2 performs a function different from the wrapper in Claim 1, where the sheet acts as thermally-conducting flame barrier. Second group of D2 lacks the lighting end segment 22 of the smoking articles as below:-

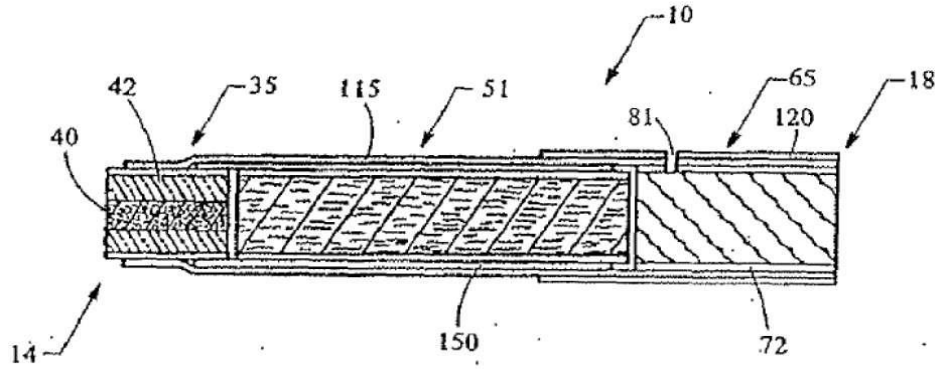


Fig. 7

44. For the smoking articles, as visible from the above Figure, the heat generation segment 35 forms the lighting end 14. The smoking articles 10 disclosed in D2 rely on ignition and combustion of part of the smoking articles. For the smoking articles in Figure 1 lighting end segment 22 is lit while for smoking articles of Figure 7, heat generation segment 35 is lit. As the smoking article of D2 rely on combustion to generate heat, they are clearly not adapted for use with an electrically operated aerosol-generating device comprising a heating element and for this reason, skilled person would not use D2 as a starting point to arrive at the invention even in combination with D1 and hence, Claim 1 is inventive over D2, when seen alone.

45. Prior art D3 relates to smoking articles (cigarettes), particularly, those employing tobacco and the summary under D3 discloses that the invention is directed towards improvement in fuel element compositions by reducing release of carbon monoxide during combustion of fuel elements and thus the smoking articles in D3 do not relate to the field of *"heated aerosol-generated articles"* within the meaning of Claim 1, specifically those adapted to release volatile compounds to form an aerosol through heating

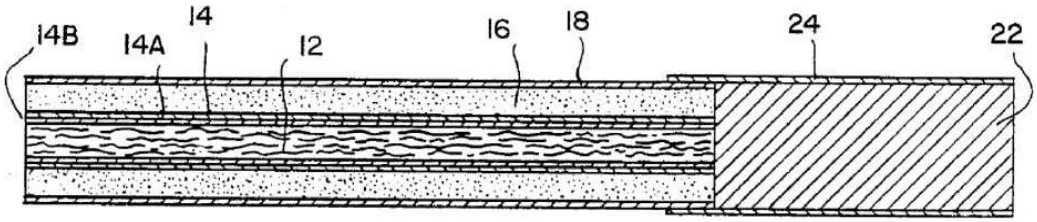
rather than combustion of an aerosol-forming substrate. Further, as the cigarettes of D3 rely on combustion, they are not adapted for use with an electrically operated aerosol-generating device comprising a heating element and therefore, skilled person will not consider D3 to address the problem of the claimed invention.

46. There is no teaching in D3 of the barrier tube or wrapper having capability to reduce the risk of ignition of the substrate in the event flame is applied to the cigarette. Rather, D3 discloses use of metal foil for the barrier tube wrapper to reduce or eliminate any migration of the aerosol former from the substrate to the other components of the cigarettes and lacks any teaching of a wrapper being a thermally conducting flame barrier for spreading heat and mitigating against the risk of a user igniting the aerosol forming substance by applying flame to the aerosol-generating article. Even the presence of metal as part of barrier tube wrapper does not prevent ignition of the material enclosed therein.

47. Prior art D4 relates to smoking articles in which ignition and combustion of part of the smoking articles is intended and therefore, none of the smoking articles of D4 are "*heated aerosol-generated articles"*. Figure 2 shows a smoking article 10 having a tobacco rod 12 circumscribed by a metallic foil 14. D4 is silent about the form of the tobacco in the tobacco rod. Cylinder 16 of non-tobacco fuel surrounds the foil 14 with the cylinder circumscribed by an air-permeable wrapper 18. Lines 20 to 23 disclose the metallic foil 14 as preferably being a laminate of layer of paper 14A and a layer of aluminium 14B. In use, the non-tobacco fuel cylinder combusts or burns with heat from the fuel cylinder getting transferred through foil 14 to heat the tobacco rod 12. D4 therefore, relies on combustion and ignition of

part of smoking article and does not relate to *heated aerosol-generated articles* and thus the smoking article is not adapted for use with an electrically-operated aerosol-generating device comprising a heating element. The wrapper in D4 is formed of or includes metal and at least part of the article is ignited or burnt and the metal wrapper is not configured to act as a thermally-conducting flame barrier. A person skilled in the art will not be motivated to reach the invention from the teachings of D4. The relevant Figure is as follows:

FIG. 2



48. D5 prior art relates to smoking articles intended to produce an aerosol resembling tobacco smoke but contains minimal amount of incomplete combustion or pyrolysis products *albeit* it relates to smoking articles in which ignition and combustion of part of the smoking articles is intended but none of them are *"heated aerosol-generated articles",* within the meaning of Claim 1 of the patent. The smoking article of Figure 1 below has a combustible carbonaceous fuel element 10 followed by an aerosol-generating means 12 and fuel element is made of charcoal and is intended to be lit/ignited. The aerosol-generating means is in the form of glass beads 20 coated with aerosol-forming substance such as glycerine. An aerosol delivery passage 26 extends between aerosol-generating means 12 and a mouth end 15 of the article and a foil lined paper tube 14 circumscribes part of fuel element 10 and all of the aerosol-generating means 12, porous

disc 22 and aerosol delivery passage 26. The tube 14 increases heat transfer to the aerosol generator and the foil helps to extinguish the fire cone due to heat loss through the foil. Therefore, D5 also does not relate to the field of *"heated aerosol-generated articles"*. The presence of foil in the tube does not prevent ignition of material enclosed by the tube and therefore, D5 relates to smoking articles in which ignition and combustion is intended and they are not adapted for use with electrically operated aerosol-generating device and lack any teaching of a wrapper having the property of acting as thermally-conductive flame barrier. The relevant figure is as follows:-

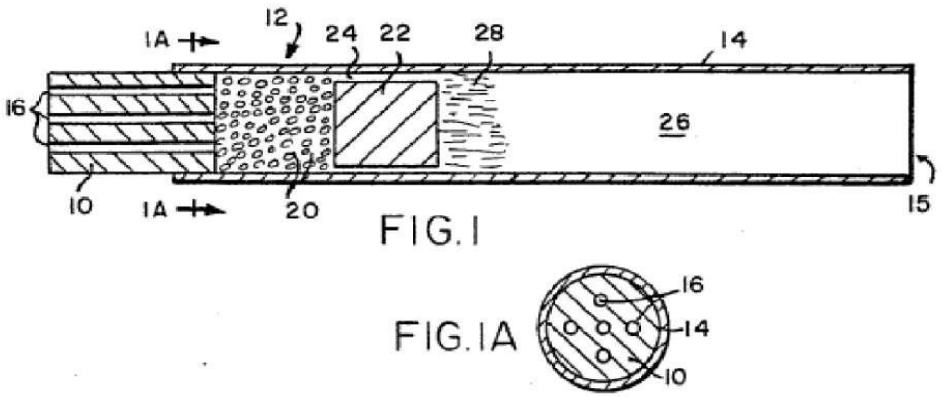


FIG.1

FIG.1A

49. Prior art D6 relates to smoking articles having heat resistance sheet material in which ignition and combustion of part of the smoking article is intended and none of the smoking article are *"heated aerosol-generated articles"*. Figure 2 below shows a smoking article having a combustible heat source 22, an aerosol-generating substrate 24, an expansion chamber 26 and a mouth piece 28 coaxially aligned with each other. An outer wrapper 30 circumscribes part of the combustible heat source 22 and all of the aerosol-generating substrate 24, expansion chamber 26 and mouth piece 28. The combustible heat source is disclosed as being a pyrolysed porous carbon-based heat source. The aerosol-generating substrate is disclosed in the form

of *"longitudinally aligned filaments of extruded tobacco material."* The outer wrapper is formed of a fibrous based layer 12 coated with an inner coating layer 14 and an outer coating layer 16, which is disclosed as being heat resistance but none of the materials show that outer wrapper 30 is thermally conductive. A heat conducting element 40 in the form of a tube of aluminium foil surrounds and is in contact with a rare portion 22b of the combustible heat source 22 and a front portion 24a of the aerosol-generating substrate. D6 does not relate to *"heated aerosol-generated articles"* within the meaning of Claim 1 of the patent and the smoking articles are not adapted for use with electrically operated aerosol-generating device comprising a heated element and there is no teaching in D6 that the heat conducting element 40 of aluminium foil has the capability of reducing risk of ignition in the event of a flame being applied. D6 at best relates to combustible articles having a wrapper formed of or including metal, with at least part of the article being ignited and burnt during use and the wrapper is not configurated to act as a thermally conducting flame barrier. Figure 2 of D6 is as follows:-

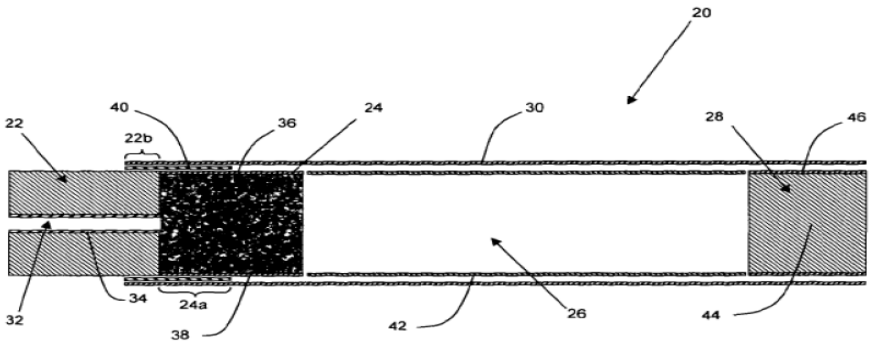


Figure 2

50. Claims of the subject patent, therefore, involve inventive steps over the disclosure of cited documents D1 to D6 and even the Board of

Opposition opined that Claims 1 to 10 involve inventive steps and Section 25(2)(e) is not applicable. In ***Novartis AG v. Union of India and Others, (2013) 6 SCC 1,*** the Supreme Court observed that 'obviousness' is judged based on hypothetical construct of a person of ordinary skill in the art, who must belong to the relevant field; looks at the prior art; and is well aware of the fact that even a small structural change in a product or procedure can produce dramatic functional changes. In the instant case, a person skilled in the art will not be motivated to look for D1 to D6 as starting points to reach the patented invention. Thus, the post-grant opposition was rightly rejected and the Appeal be dismissed, being devoid of merit.

51. Heard learned Senior Counsel for the Appellant/Writ Petitioner and counsels for Respondents and examined their rival submissions.

WRIT PETITION:

52. The writ petition is opposed by the Respondents, both on maintainability and merits. On maintainability, the argument is that impugned order dated 30.01.2025 dismissing the two IPs having been passed under Section 25(4) of 1970 Act is an appealable order under Section 117A(2) of 1970 Act assuming the IPs could be filed and hence, writ jurisdiction cannot be invoked. Appellant contends that if there is violation of principles of natural justice, writ petition is the appropriate remedy and, in any case, existence of alternate remedy is not always a bar in entertaining the petition.

53. Similar issue arose before this Court in ***Best Agrolife (Supra),*** where Respondents had raised an objection to the maintainability to the writ petition filed by the Petitioner challenging the order of the Controller dismissing pre-grant opposition and allowing the grant of patent, on the

ground that an alternative efficacious remedy was available to the Petitioner in terms of post-grant opposition under Section 25(2) of 1970 Act as also revocation petition under Section 64. Referring to and relying on several judicial precedents, Court rejected the preliminary objection observing that there cannot be a debate that the 1970 Act provides remedy of post-grant opposition and/or revocation to a "person interested", who is unsuccessful in a pre-grant opposition, however, if Petitioner is able to substantiate violation of principles of natural justice and/or failure in exercising jurisdiction and/or non-consideration of vital grounds/documents, Petitioner cannot be non-suited in a writ petition. Appellant herein has alleged that there was violation of principles of natural justice by the Controller while considering the IPs. Hence, in light of the judgement in ***Whirlpool Corporation (Supra),*** where the Supreme Court perspicuously explained the scope and ambit of judicial interference in a writ jurisdiction where an alternative remedy is available to a party as also ***Best Agrolife (Supra),*** writ petition is held to be maintainable.

54. Broadly speaking, three-fold issues arise for consideration in the writ petition. First is whether the Controller was right in deciding IP-I dated 14.08.2024, filed by the Appellant opposing the request of the patentee to take on record two auxiliary claim sets and IP-II dated 21.09.2024 for rejecting the second written submissions filed by the patentee on 04.09.2024, allegedly being beyond the earlier written submissions dated 21.06.2024, pleadings in reply statement and oral submissions made during the hearing on 20.08.2024, by a common order and treating both as oppositions to the auxiliary claim amendments. Perusal of the impugned order dated 30.01.2025, whereby the two IPs were dismissed under Rule

58(2) of the Patent Rules, 2016, substantiates the case of the Appellant that Controller has decided IP-II under an erroneous impression that it concerned the claim amendments, contrary to the reliefs prayed therein. Appellant is thus entitled to be heard on the grievance raised in IP-II.

55. Parties made extensive arguments on both the IPs before this Court. Main plank of Appellant's argument was that contents of second written submissions are beyond the earlier pleadings/written submissions and no opportunity was given to rebut, which has caused grave prejudice. Appellant has filed a comparative table as Document-A to the written submissions dated 23.01.2026, which is extracted in the earlier part of the judgment, to demonstrate that fresh points were included in the second submissions, which became the basis of rejection of post-grant opposition, such as the composition, properties and role of the wrapper material.

56. Having perused the order, written submissions and the claims specifications, I am unable to agree with the Appellant on this issue. Controller has observed that D1 in para [0099] describes that the wrapping material can vary and can be a paper material of the type traditionally used for cigarette manufacture and can also be composed of a laminate of metallic foil and paper, whereas the thermally-conducting sheet in the opposed patent is a metallic foil and it is clear that a laminate will have different thermal conductivity than a metal foil, which is only composed of metal and therefore, D1 fails to teach this functional limitation of Claim 1 of the opposed patent. In the written submissions dated 04.09.2024, Patentee stated that there is a mention of laminate of paper and metal foil in D1 and there is a difference between a laminate comprising paper and metal foil and a metal foil since metal foil is made of metal and retains the inherent

properties associated with the metal it is made of, whereas laminate foil comprises many layers fused together, of which metal may be one of the layers. Further, ignition temperature of a laminate foil is generally below the flame temperature of a smoking lighter or matchstick, whereas ignition temperature or at least melting point of metal foil is the same as that of the metal of which the metal foil is made.

57. Firstly, it is elementary knowledge in science that metal foil is a homogeneous single-material system whereas metal-paper laminate is a multilayer system and thus, metal foil will exhibit intrinsic properties of the metal it is made of while the laminate's properties will depend on properties of the constituent layers. Thus, Appellant cannot urge that this observation was influenced by Patentee's second written submissions. Secondly and more importantly, this distinction is embedded in the claim language itself which expressly identifies metal foil and metal foil laminates with paper or re-constituted tobacco as alternative for the thermally-conductive material.

58. Appellant next joins issue with Controller's finding that D1 does not disclose gathered sheet of tobacco unlike the one in the specification of the opposed patent. On analysis of the prior art it emerges that Controller's finding that D1 fails to disclose that the aerosol-forming substrate comprises a gathered sheet of aerosol-forming material is based on para [0089] of D1, which makes a reference to a web of re-constituted tobacco sheet that is gathered so as to possess a plurality of longitudinally extending passage ways, which can be treated with mixture of propylene glycol, flavouring agent and tobacco extract and is not purely based on the written submissions of the Patentee. Controller has further compared the gathered sheet of the

aerosol-forming material of granted patent as defined in lines 31-33 of complete specifications, which states that the sheet of tobacco material is convoluted, folded or otherwise compressed or constricted substantially transversely to the cylindrical axis of the rod and then applied the common general knowledge that gathered sheets of tobacco material are widely used in the tobacco industry and the term has a clear and agreed meaning in the art i.e. a sheet which is gathered when it is folded and convoluted to occupy a tri-dimensional space. In the second written submissions, Patentee has merely explained the scope and technical significance of the gathered sheet in the claim specification as an argument and there is nothing which is outside the claims or beyond pleadings and hence, there is no merit in the objections raised in IP-II. I will advert to the technical aspect of the difference in the wrapper material and gathered sheet in detail in the later part of the judgement.

59. There is also no legal infirmity in dismissal of IP-I, filed against the proposed amendment to the existing claims by adding two auxiliary claim sets. As a matter of record, on 25.07.2024 Controller issued second hearing notice to the parties scheduling the hearing on 20.08.2024 to discuss the two auxiliary claim sets and during the hearing, Patentee was advised by the Controller to follow the procedure of amendment governed by Section 57 of 1970 Act, more particularly, in sub-Section (3) thereof. Patentee did not follow the amendment procedure and decided to proceed with the existing claims and filed written submissions on 04.09.2024 on that basis. Since patentee did not press the amendment, there was no reason to hear the opposition and IP-I was rightly dismissed. Thus, there is no merit in the writ petition and the same deserves to be dismissed.

APPEAL

60. This appeal is filed by the Appellant challenging order dated 30.01.2025 dismissing its post-grant opposition against opposed patent IN 384250 titled "*HEATED AEROSOL GENERATING ARTICLE WITH THERMAL SPREADING WRAP*", granted in favour of the patentee on 14.12.2021. The post-grant opposition was filed on 16.12.2022 and grounds of opposition were lack of novelty under Section 25(2)(b), prior use/prior knowledge under Section 25(2)(d), lack of inventive step/obviousness Section 25(2)(e), not an invention under Section 25(2)(f) and insufficiency of disclosure Section 25(2)(g) of 1970 Act. Appellant cited prior art documents D1 to D6 to oppose the patent at the initial stage. Opposition Board made recommendations in favor of the Patentee that the invention claimed in the patent was novel and inventive and rejected the grounds of the Appellant through its joint recommendation dated 12.10.2023. The first hearing in the matter was scheduled for 30.04.2024, however, Appellant sought adjournment and on 31.05.2024, filed additional documents D7 to D10 under Rule 62(4) of 2003 Rules. Controller excluded these documents from consideration as being time barred observing that five days' notice period envisaged in the said rule has to be computed with respect to the first scheduled date of hearing and not the adjourned date, relying on the judgment in ***Pharmacyclics LLC (Supra).*** It was held that the first scheduled date of hearing being 30.04.2024, the deadline for filing any additional document expired on 25.04.2024 and the additional document filed thereafter on 31.05.2024, could not be accepted. Post-grant opposition was rejected taking into consideration prior arts D1 to D6 only. It needs a mention that Controller has in paragraph 5 of the impugned order noted that

during the hearing, counsel for the Appellant did not address arguments on objections under Section 3(d), 3(f) and 3(g) of 1970 Act. For this reason, this Court is also not delving into these objections and be it noted that the arguments canvassed on behalf of the respective parties were largely restricted to objections of novelty and lack of inventive steps.

61. The granted patent relates to aerosol-generating articles in which an aerosol-forming substrate is adapted to release volatile compounds to form an aerosol through heating rather than combustion of the substrate. The article is referred to as a "*heated aerosol-generating article*" in the claims, with corresponding support found in lines 10-19 of the PCT publication and does not include a combustible heat source as also contrasts heated aerosol-generating articles in conventional cigarettes, which are ignited and combusted. The heated aerosol-generating article is adapted for use with an electrically operated aerosol-generating device having an insertable heating element to heat the aerosol-forming substrate of the article. The technical problem sought to be resolved and/or technical advancement claimed is: (a) avoiding combustion of aerosol-forming substrate may reduce generation of various smoke constituents associated with combustion and pyrolytic degradation of tobacco in conventional cigarettes (lines 8 to 10 of PCT publication); and (b) aerosol-forming substrates designed for use in heated aerosol-forming articles typically provide a poor user experience if they are ignited rather than heated (lines 27 to 29 of PCT publication).

62. Therefore, the technical problem being addressed is how to mitigate against the risk of a user igniting the aerosol-forming substrate in a heated aerosol-generating article used in an electrically operated aerosol-generating device and the invention lies in the wrapper (5060), circumscribing the

aerosol forming substrate comprising a gathered sheet of aerosol forming material, which is of thermally conductive material that acts as a thermally-conducting flame barrier for spreading heat and mitigating against the risk of a user igniting the aerosol-forming substrate (1020, 2020) in the event the user applies flame to the aerosol-generating article. The granted set of claims have been extracted in the earlier part of the judgement. The heated aerosol-generating article illustrates in Figure 2 an embodiment of a heated aerosol-generating article (1000, 2000) comprising:

an aerosol-forming substrate (1020, 2020) radially encircled by

a sheet of thermally-conductive material (1222, 2222)

in which the aerosol-forming substrate (1020, 2020) comprises

a gathered sheet of aerosol-forming material

circumscribed by

a wrapper (5060), being the sheet of thermally-conductive material

which acts as a thermally-conductive flame barrier for spreading heat and mitigating against the risk of a user igniting the aerosol-forming substrate (1020,2020) by applying a flame to the aerosol-generating article (1000, 2000).

63. Figure 2 illustrates that article 1000 comprises four elements: aerosol-forming substrate 1020, a hollow cellulose acetate tube 1030, a spacer element 1040 and a mouth piece filter 1050, which are arranged sequentially and in coaxial alignment and are assembled by a cigarette paper 1060 to form the aerosol-generating article. The article 1000 has a mouth end 1012, which a user inserts into his/her mouth during use and a distil end 1013 located at the opposite end of the article to the mouth end. Aerosol forming

substrate comprises a rod formed from a crimped and 'gathered sheet' of homogenised tobacco wrapped in aluminium foil 1222 to form a plug (lines 17-18 of specifications). In an industry gathered sheet means a sheet convoluted, folded or otherwise compressed or constricted transversely. Substrate is not heated through the sheet of thermally-conducting material (wrapper) which circumscribes the gathered sheet and instead the wrapper acts as a flame barrier for spreading heat and mitigating the risk of a user igniting the aerosol-forming substrate in the event the user applies flame to the article. Figure 2 is as follows:-

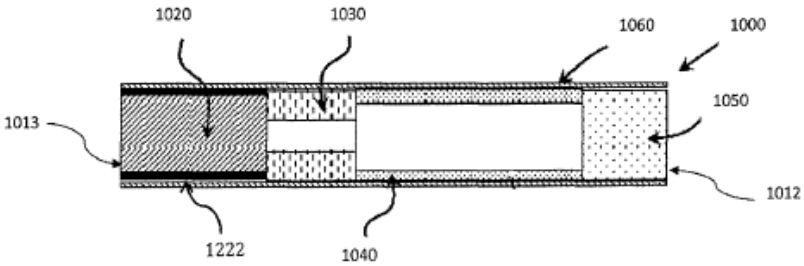


FIGURE 2

64. Coming to the first objection of lack of novelty. It is settled that a claim is not anticipated unless a single prior art discloses all elements of the questioned claim, which means that all limitations of the claim should be present in the single prior art document and even a minor difference between the two will mean that there is no anticipation and the claim is novel. This 'all element' rule finds strength from para 09.03.02.6 under 'Novelty' in the Patent Manual, which provides that a prior art is considered as anticipating novelty if all features of the invention under examination are present in the cited prior art document. The prior art should disclose the invention either in an explicit or implicit manner and mosaicing of prior art documents is not

allowed in determination of novelty.

65. Appellant challenges novelty in Claim 1 of the granted patent citing D1 titled *"Tobacco Containing Smoking Article",* stating that D1 anticipates all elements of Claim 1 of impugned patent. Appellant highlighted that D1 discloses a smoking article incorporated with an electrically powered aerosol-generating device, which also comprises of a heating element for forming thermally-generated aerosol incorporating tobacco components. D1 relates to a cigarette that is smoked by coupling the cigarette to an electrically powered aerosol-generating device that acts as a holder. In one further embodiment, tobacco material is in the form of a rod circumscribed by wrapping material and positioned between the second resistance heating element and the mouth-end of the outer housing [para 0024]. The substrate material can be used in the form of gathered web or sheet, using techniques set forth in U.S. Pat. No. 4,807,809 to Pryor et al. [para 0064]. The wrapping material is wrapped around the tobacco 89 so as to form a generally cylindrical rod-shaped cigarette rod or tobacco rod. The tobacco is generally positioned within the hollow region within the tube and the wrapping material is formed such that each end of the tobacco rod is open to expose the tobacco and to allow passage of drawn air [para 0098]. A representative device possesses a source of electrical power e.g. a battery, a controller mechanism including a sensor and at least one heating device for forming a thermally-generated aerosol, which incorporates components of tobacco Para [0013].

66. Appellant referred to paras [0098] as also [0099] to emphasize that the wrapping material in D1 can vary and can be a paper of the type traditionally used for cigarette manufacture or can be composed of a

laminate of metallic foil and paper and as such, heat generated in the second heating element can heat the metallic foil of the laminate and consequently, the tobacco contained within it. Paras [0013], [0024], [0064], [0098], [0099] and [0075] are extracted hereunder for ready reference:-

> *"**Para [0013]** In one embodiment, the present invention relates to a cigarette that is smoked by coupling that cigarette to an electrically powered aerosol generating device that acts as a holder for that cigarette. The cigarette possesses at least one form of tobacco, and that tobacco is wrapped in a paper wrapper. If desired, various forms of tobacco, or various forms of tobacco containing compositions, can be positioned at specific locations within the cigarette. The cigarette also incorporates aerosol-forming material, and that aerosol-forming material can be an ingredient that is employed in addition to the tobacco. The cigarette may also possess a mouth-end piece that is used by the smoker to inhale components of tobacco, components derived from tobacco, and other components, preferably in the form of a visible aerosol, generated at least in part by the action of heat upon components of that cigarette. A representative device possesses a source of electrical power (e.g., a battery), a controller mechanism including a sensor that is capable of selectively powering certain components of the device (e.g., electrical resistance heating elements) at least during periods of draw, and at least one heating device (e.g., an electrical resistance heating unit) for forming a thermally generated aerosol that incorporates components of tobacco. During use, the cigarette is positioned within the outer housing of the smoking article, and after use, the used cigarette is removed from the smoking article. When desired, another cigarette is positioned within the device for further use.*
>
> *xxx xxx xxx*
>
> ***Para [0024]** In one further embodiment, the tobacco material is in the form of a tobacco rod circumscribed by a wrapping material and positioned between the second resistance heating element and the mouth-end of the outer housing. A cartridge comprising an aerosol-generating material circumscribed by a wrapping material can be positioned between the tobacco rod and the second resistance heating element. Preferably, a filter element is attached to the end of the tobacco rod closest to the mouth-end of the outer housing.*
>
> *xxx xxx xxx*
>
> ***Para [0064]** The substrate material can incorporate tobacco of some form, normally is composed predominantly of tobacco, and can be provided by virtually all tobacco material. The form of the substrate*

material can vary; but most preferably that material is employed in an essentially traditional cigarette, cigar or pipe filler form (e.g., as cut filler). The substrate material can be otherwise formed into desired configurations. The substrate material can be used in the form of a gathered web or sheet, using the types of techniques generally set forth in U.S. Pat. No. 4,807,809 to Pryor et al. The substrate material can be used into the form of a web or sheet that is shredded into a plurality of longitudinally extending strands, using the types of techniques generally set forth in U.S. Pat. No. 5,025,814 to Raker. The substrate material can have the form of a loosely rolled sheet, such that a spiral type of air passageway extends longitudinally through the aerosol-generation segment. Representative types of tobacco containing substrate materials can be manufactured from mixtures of tobacco types; or from one predominant type of tobacco (e.g., a cast sheet-type or paper-type reconstituted tobacco composed primarily of burley tobacco, or a cast sheet-type or paper-type reconstituted tobacco composed primarily of Oriental tobacco).

xxx xxx xxx

Para [0075] *Certain embodiments of the smoking article of the invention incorporate a cigarette rod as a necessary component. That is, the smoking article of the invention can incorporate a tobacco rod wrapped in paper or other wrapping material. The wrapping material used as a wrapper for containing the tobacco, and hence used for cigarette manufacture, can vary. Exemplary types of wrapping materials are set forth in U.S. Pat. No. 4,938,238 to Barnes et al. and U.S. Pat. No. 5,105,837 to Barnes et al. Wrapping materials, such as those set forth in U.S. Patent Appl. Pub. No. 2005/0005947 to Hampl, Jr. et al. and PCT Appl. Pub. No. WO 2005/039326 to Rasouli et al., can be employed as inner wrapping materials of a so-called "double wrap" configuration. An exemplary type of heat conductive wrapping material is set forth in U.S. Pat. No. 5,551,451 to Riggs et al.; and other suitable wrapping materials are set forth in U.S. Pat. No. 5,065,776 to Lawson et al. and U.S. Pat. No. 6,367,481 to Nichols et al.; each of which is incorporated herein by reference. Exemplary wrapping materials, such as laminates of paper and metal foil, and papers used as the outer circumscribing wrapper of the heat generation segment, have been incorporated within the types of cigarettes commercially marketed under the trade names "Premier" and "Eclipse" by R. J. Reynolds Tobacco Company. Other representative wrapping materials, and processed wrapping materials, suitable for use for cigarette manufacture are set forth in U.S. Pat. No. 5,220,930 to Gentry; U.S. Pat. No. 6,976,493 to Chapman et al.; and U.S. Pat. No. 7,047,982 to Seymour et al; and U.S. patent application Ser. No. 11/377,630 filed Mar. 16, 2006 to Crooks et al.; each of which is incorporated herein by reference. Paper materials can be composed of*

materials, or treated with films, in order to provide resilience, particularly when the paper material is used to contain tobacco materials that are substrates for relatively high amounts of liquid materials (e.g., aerosol-forming materials). For example, such papers can be treated with coatings of nitrocellulose or ethylcellulose. Alternatively, paper materials can be highly absorbent in nature, and can act as substrates for liquid materials (e.g., aerosol-forming materials, liquid flavoring agents, or mixture of aerosol-forming materials and tobacco extracts).

xxx xxx xxx

Para [0098] *Typically, the wrapping material **160** is wrapped around the tobacco **89** so as to form a generally cylindrical rod-shaped cigarette rod or tobacco rod. That is, the wrapping material **160** is formed into a generally tubular shape, and the tobacco is positioned within the hollow region within that tube. Preferably, the wrapping material **160** is formed such that each end of the tobacco rod is open to expose the tobacco contained therein, and to allow the passage of drawn air therethrough.*

Para [0099] *The wrapping material **160** can vary. The wrapping material **160** can be a paper wrapping material of the type traditionally used for cigarette manufacture. The wrapping material **160** also can be composed of a laminate of metallic foil and paper, and as such, heat generated by the second heating element can heat the metallic foil of the laminate and hence heat the tobacco contained within that laminate. See, for example, the types of wrapping materials, wrapping material laminates and wrapping material configurations set forth U.S. patent application Ser. No. 11/377,630 filed Mar. 16, 2006 to Crooks et al."*

67. As noted above, the Opposition Board recommended in favour of the Patentee observing that subject matter of independent Claim 1 of the opposed patent was new over disclosure of D1, which teaches a heated aerosol-generating article configured to generate aerosol when heated for an electrically operated aerosol-generating device comprising a heating element. The heated aerosol-generating article comprises an aerosol-forming substrate (89) radially encircled by a sheet (160) of thermally-conductive material, the aerosol-forming substrate comprising a gathered sheet of aerosol-forming material circumscribed by a wrapper, being a sheet of thermally-conductive material comprising an aerosol-forming substrate,

comprising a gathered tobacco sheet circumscribed by a wrapper, wherein the wrapper comprises a metallic foil configured to conduct heat. D1 further teaches to assemble the substrate and at least one other element within the wrapper, where the wrapper is a laminate of metallic foil and paper and only discloses the metallic foil as serving to transfer heat from the heating element to the tobacco. D1 does not explicitly teach that the taught metal foil wrapper is a thermally-conducting flame barrier configured to spread heat and mitigate against risk of ignition when flame is applied to the heated aerosol-generating article. Taking into account, the respective contentions of the Appellant and the patentee as also Board's recommendations, Controller rejected the ground of novelty citing prior art D1 and hence, the ground under Section 25(2)(b). Relevant part of the order is as follows:-

> *"After carefully studying the disclosure of D1, I found that that D1 fails to disclose the following features of claim 1.*
>
> ***1). aerosol-forming substrate comprises a gathered sheet of aerosol-forming material; and***
>
> ***2). thermally-conductive material which acts as a thermally-conducting flame barrier for spreading heat and mitigating against the risk of a user igniting the aerosol-forming substrate by applying a flame to the aerosol-generating article.***
>
> *D1, fails to disclose that the aerosol forming substrate comprises a gathered sheet of aerosol forming material. In fact, D1 clearly states that two separate ingredients i.e.,* ***an aerosol-forming material*** *positioned within the outer housing which is in fluid communication with said* ***tobacco material****.* ***[Para-[0019] and [0020]****. D1, does not disclose that the aerosol material is a gathered sheet. The reference of gathered sheet in D1 is in para [0089] with regard to a web of reconstituted tobacco sheet that is gathered so as to possess a plurality of longitudinally extending passageways. The gathered sheet of aerosol forming material of the opposed patent is defined on page 4 lines 31-33 of Complete specification which states that the sheet of tobacco material is convoluted, folded, or otherwise compressed or constricted substantially transversely to the cylindrical axis of the rod. Gathered sheets of tobacco material are widely used in the tobacco industry and as such the term "gathered sheet' has a clear and agreed meaning in the art, this being that a sheet is gathered*

when it is folded and convoluted to occupy a tri-dimensional space. In particular, D1 does not talk about gathered sheet of tobacco in the sense defined by the specification of the opposed patent let alone disclosing the aerosol-forming material is gathered.

D1 also fails to disclose explicitly a thermally conducting material ***which acts as a thermally-conducting flame barrier for spreading heat and mitigating against the risk of a user igniting the aerosol-forming substrate by applying a flame to the aerosol-generating article****.*

With regard to the above feature, the opponent has simply submitted that this feature is a functional aspect of the sheet and would be inherent to such metal foil wrappers. This argument cannot be followed. The making of a heated aerosol generating article using a thermally conducting sheet in a such a way that it will spread the heat if unknowingly a user apply a flame to the aerosol generating article. The claim 1 of the opposed patent is limited by this feature, therefore this feature cannot be ruled out from the scope of the claim 1. As no mapping of this feature with respect to D1 has been provided by the Opponent in the opposition documents or hearing, this feature is not disclosed by D1 and therefore D1 does not anticipate claim 1.

Diagram to Diagram Comparison

Fig. 2 of the Opposed Patent	*Fig. 3 of the cited documents D1*

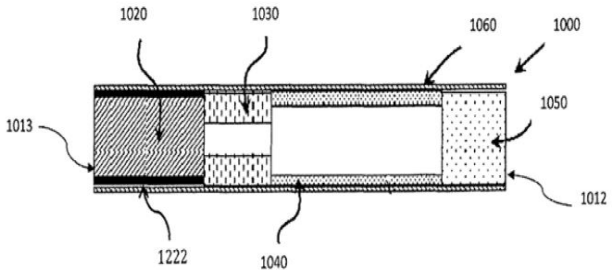


FIGURE 2

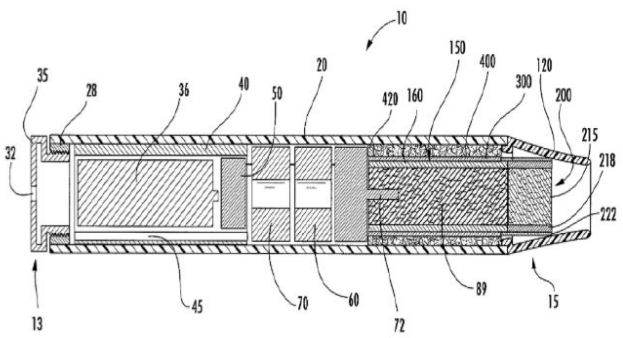


FIG. 3

Figure 2 illustrates an embodiment of a heated aerosol-generating article 1000 comprising a rod as described herein. The article 1000 comprises four elements; an aerosol-forming substrate 1020, a hollow cellulose acetate tube 1030, a spacer element 1040, and a mouthpiece filter 1050. These four elements are arranged sequentially and in coaxial alignment and are assembled by a cigarette paper 1060 to form the aerosol-generating article 1000. ***The article 1000 has a mouth-end 1012****, which a user inserts into his or her mouth during use, and a* ***distal end 1013*** *located at the opposite end of the article to the mouth end 1012. The embodiment of an aerosol-generating article illustrated in Figure 2 is particularly suitable for use with an electrically-operated aerosol-generating device comprising a heater for heating the aerosol-forming substrate.*

Mouth Piece-15

Distal end-13

Wrapping material-160

Tobacco-89

From the above diagram to diagram comparison of the opposed patent with D1 it is clear that this wrapping 160 material is wrapped around tobacco 89 very, which is very close to the mouth piece 15 whereas in the opposed patent thermally conducting-sheet 1222 (bold black in the above fig. 2) is wrapped around aerosol-forming substrate 1020 at distal end 1013. Therefore, no user will apply a flame around the wrapping material 160 of D1 which is near to mouth piece 15. Therefore, construction and working of aerosol generating article of the opposed patent and D1 is starkly different.

Also, the wrapping material 160 in D1 is designed to be in contact with a heating element. Para [0101] of D1 describes that the wrapping material 160 can be in electrical contact with the electrical circuitry associated with the electrical resistance heating element 72, which will provide the heat to the tobacco-89. Also, in some embodiment of D1 wrapper 160 is in direct contact with third heating element-300.

D1 in para [0099] describes that the wrapping material 160 can vary. The wrapping material 160 can be ***a paper wrapping material*** *of the type traditionally used for cigarette manufacture. The wrapping material 160 also can be composed of* ***a laminate of metallic foil and paper****. Whereas the thermally conducting sheet in the opposed patent is a metallic foil. Therefore, it is clear that a laminate will have different thermal conductivity than a metal foil which is only composed of metal in contrast to the laminate which is made of different sheet of metal and paper. Therefore, D1 fails to teach this functional limitation of the claim 1 of the opposed patent.*

In view of my above reasoning, I find claim 1 of the subject patent is novel over prior art D1. Therefore, the ground under Section 25(2)(b) is rejected."

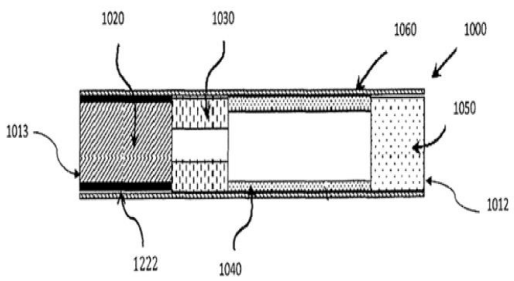
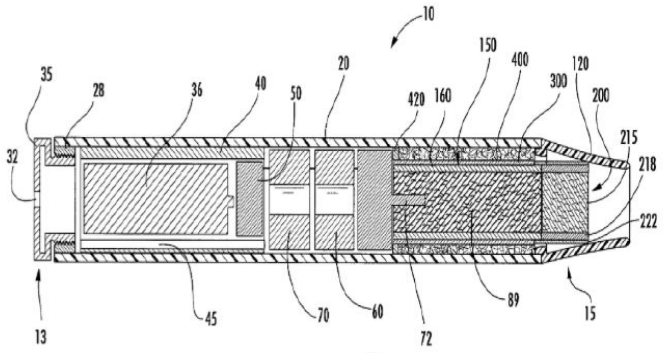
68. The cited prior art D1 allegedly destroying novelty relates to smoking articles that employ tobacco materials and the problem that it resolves is captured in para [0010] as follows:-

*"**Para [0010]** Smoking articles that employ tobacco substitute materials and smoking articles that employ sources of heat other than burning tobacco cut filler to produce tobacco-flavored vapors or tobacco-flavored visible aerosols have not received widespread commercial success. Thus, it would be highly desirable to provide a smoking article that provides a smoker with an ability to enjoy using tobacco without the necessity of burning any significant amount of tobacco. In particular, it would be highly desirable to provide a tobacco-containing smoking article, such as an article having the general appearance of a cigarette, cigar, or pipe, that possesses the ability to provide a smoker many of the benefits and advantages of conventional tobacco smoking without necessarily delivering considerable quantities of incomplete combustion and pyrolysis products."*

69. On a plain reading of para [0010], it is clear that problem of D1 was never of igniting the smoking article when flame is applied. On perusal of the summary and other disclosures in D1, I agree with the Controller and the Patentee that D1 fails to disclose certain features of Claim 1 viz., aerosol-forming substrate comprises a gathered sheet of aerosol-forming material; and (b) thermally-conductive material, which acts as a thermally conducting flame barrier for spreading heat and mitigates against the risk of a user igniting the aerosol-forming substrate when flame is applied to the aerosol-generating article. D1 has two separate ingredients i.e., 'an aerosol-forming material' positioned within the outer housing, which is in fluid communication with the 'tobacco material' [paras 0019 and 0020]. Reference of gathered sheet in D1 is in para [0089] as a web of re-constituted tobacco sheet that is gathered so as to possess a plurality of

longitudinal extending passageways, [0089]. Appellant admits that D1 fails to disclose explicitly a thermally-conducting material acting as a flame barrier to spread heat and mitigate risk of igniting the substrate when flame is applied and the contest is that this feature is a functional aspect of the sheet and inherent to metal foil wrappers.

70. Controller has rightly disagreed with the Appellant on this aspect and observed that making of the heated aerosol-generating article using a thermally-conducting sheet is in a way that it spreads heat, if unknowingly flame is applied to the aerosol-generating article and Claim 1 is limited by this feature as also that Appellant has not mapped the feature between the granted patent and D1. There is merit in Patentee's argument that where a structural element is associated with a functional element, the latter limits the claim to structures that are capable of performing that function. In the instant case, the structural aspect is the wrapper with its feature of being thermally-conductive and it limits the scope of Claim 1 by its functionality of acting as a flame barrier. Controller has also compared the construction and working of aerosol-generating article in D1 and Claim 1 of the patent. Comparative table of Figures 2 and 3 are as follows:-

Figure 2 of Claim 1	**Figure 3 of D1**
 FIGURE 2	 FIG. 3

71. Perusal of Figure 2 of Claim 1 reflects that the four elements i.e., aerosol-forming substrate, hollow cellulose acetate tube, a spacer element and a mouth piece filter are sequentially arranged in co-axial arrangement and are assembled by a cigarette paper. The article has a mouth end which a user inserts in his mouth during use and the thermally-conducting sheet around aerosol-forming substrate at the distal end. The embodiment of aerosol-generating article is suitable for use with electrically operated aerosol-generating device comprising a heater for heating the aerosol-forming substrate. The wrapping material in Figure 3 of D1 is very close to the mouth piece and hence, no user will apply flame around the wrapping material of D1, thus evidencing that the wrapper around the tobacco rod is not for dissipating heat if ignited by a flame and it rather acts as a heat sink to concentrate the heat into the tobacco rod for generating aerosol vapor.

72. There are other significant differences in D1 and Claim 1 of the patent. Para [0025] of D1 makes it clear that the aerosol-generating device and the entire arrangement in D1 is complex and it uses three heating elements to heat the tobacco rod whereas the heating element in the claimed invention is only one. The arrangement of heating element in D1 is in a tabular form which circumscribes the whole tobacco rod or part of it which is not the feature of Claim 1. While para [0064] of D1 provides that the substrate can be in the form of web or gathered sheet, as rightly flagged by the Patentee, Appellant is unable to establish that it can be equated with the gathered sheet in the claimed invention.

73. Another significant difference is in the wrapper and this is one of the bone of contentions between the parties. In D1 the wrapping material can be a paper or metallic foil and para [0099] shows that the second heating

element heats the paper or the foil, as the case may be, to pass heat to the tobacco, which then generates aerosol on being heated. The wrapper therefore acts as a heat sink (medium) which passes the heat inside to the substrate inside the tobacco rod and is meant to be in contact with the heating element. Contrasted with this, the wrapper in Claim 1 is a heat dissipator and acts as a thermally conducting flame barrier for spreading heat and mitigating against the risk of user igniting the aerosol-forming substrate, in the event the flame is applied inadvertently or accidently to the aerosol-generating article and this is where the novelty resides.

74. Patentee is right that Appellant's understanding that flame barrier properties are inherent in a laminate foil is not wholly sound. Controller's observations on the difference in a laminate foil and metal foil are scientifically correct and based on very elementary knowledge in science. Laminate is a fusion of layers of different metals and/or metal and paper etc. and will have a different thermal-conductivity than a metal foil, whose displayed properties will be those of the constituent metal. Controller has correctly noted that D1 in para [0099] describes that wrapping material can vary and can be a paper wrapping material of the type traditionally used for cigarette manufacture or can be composed of a laminate of metallic foil and paper. Indisputably, the wrapping material in D1 is designed to be in contact with the heating element and para [0101] describes that the wrapping material can be in electrical contact with electrical circuit associated with electrical resistance heating element, which will provide heat to the tobacco and in some embodiments of D1, wrapper is in direct contact with the third heating element. It is in this backdrop, that the Controller observed that the wrapping material in D1 can be a laminate and consequently, concluded that

it will have different thermal-conductivity as compared to wrapping material in the opposed patent, which is a metal foil with a different thermal-conductivity. If the very placement of wrapping material is such that there is no scope of applying flame at that end, naturally the problem that D1 resolves has nothing to do with the feature in a wrapper that spreads heat and mitigates against the risk of a user igniting the substrate, if flame is applied to the aerosol generating article. Patentee does not claim the known properties of a thermally-conducting wrapper and the novelty resides in limiting the claim such that there is no ignition/combustion in the aerosol-generating substrate when flame is applied to the aerosol-generating article and therefore, the functional element serves as a screening assay. Even during the hearing before this Court, Appellant has been unsuccessful in traversing this fine and significant distinction between the granted Claim 1 and D1 and thus I find no infirmity in the view of the Controller that the claimed invention in the granted patent is novel over prior art D1.

75. The only other objection seriously pressed by the Appellant was lack of inventive step/obviousness under Section 2(1)(ja) of 1970 Act. Before proceeding to deal with the rival submissions, it will be useful to have a quick look on the principles laid down from time to time for determining inventive step or the lack thereof. Section 2(1)(ja) of the 1970 Act defines 'inventive step' as a feature of invention that involves technical advance as compared to existing knowledge or having economic significance or both that makes the invention not obvious to a person skilled in the art. In ***Avery Dennison Corporation v. Controller of Patents and Designs, 2022 SCC OnLine Del 3659***, this Court referred to various approaches on this aspect such as: problem/solution approach; could-would approach; and the

teaching, suggestion and motivation approach, whereafter the Court looked at the tests formulated by the House of Lords in ***Windsurfing International Inc. v. Tabur Marine Ltd., [1985] RPC 59***, as modified by the Court of Appeals in ***Pozzoli SPA v. BDMO SA, [2006] EWHC 1398 (Ch),*** and I quote:-

> *"1. Identifying the inventive concept embodied in the patent;*
>
> *2. Imputing to a normally skilled but unimaginative addressee what was common general knowledge in the art at the priority date;*
>
> *3. Identifying the differences if any between the matter cited and the alleged invention; and*
>
> *4. Deciding whether those differences, viewed without any knowledge of the alleged invention, constituted steps which would have been obvious to the skilled man or whether they required any degree of invention."*

76. Recently, the Division Bench of this Court in ***F.Hoffmann (Supra)***, added another step and cumulatively, the five-steps which are a guiding light for Controllers for determining inventive step are as follows:-

> *"Step No. 1 - To identify an ordinary person skilled in the art;*
>
> *Step No. 2 - To identify the inventive concept embodied in the patent;*
>
> *Step No. 3 - To impute to a normal skilled but unimaginative ordinary person skilled in the art what was common general knowledge in the art at the priority date;*
>
> *Step No. 4 - To identify the differences, if any, between the matter cited and the alleged invention and ascertain whether the differences are ordinary application of law or involve various different steps requiring multiple, theoretical and practical applications; and*
>
> *Step No. 5 - To decide whether those differences, viewed in the knowledge of alleged invention, constituted steps which would have been obvious to the ordinary person skilled in the art and rule out hideside approach."*

77. Coming back, Appellant cited prior arts D1-D6 as also D7-D10, however, D7-D10 filed as additional documents under Rule 62(4) of 2003 Rules, were not considered by the Controller. Citing D1, Appellant argued that the feature of the wrapper in Claim 1 of granted patent to act as a

thermally-conducting flame barrier and mitigate the risk of ignition or combustion, is a functional aspect and an inherent property of the wrapper/sheet material used and cannot impart or be qualified as a technical advancement. Use of heat conductive material circumscribing a tobacco rod will inevitably serve the purpose of dissipating heat and conducting it away and thus, there resides no inventiveness in using a thermally-conductive wrapper of metal foil once it is well known in the art that the property of conducting heat is an inherent property of the metal foil. The claimed invention is therefore at best a mere application of a known inherent property of a thermally-conducting material. A skilled person in the art, in view of D1 and the citations referred therein would be aware of the properties of thermally-conductive materials such as metal foils and expect them to act in a manner as claimed. Materials such as aluminium foils have varied applications owing to the ability to spread and conduct heat and are used in fire suits, chimneys etc. This position was seriously controverted by the Patentee as captured in the impugned order and as referred to above. Prior arts D2-D6 were also cited to bring home the point that the granted claims lack inventive step.

78. Opposition Board looked at prior arts D1-D6 and rendered a report in favour of the Patentee recommending that subject matter of Claims 1-10 has inventive step and thus Section 25(e) is inapplicable. The essential reasoning in the recommendations is that D1 does not explicitly teach that gathered tobacco sheet is folded/convoluted substantially and transversally to the cylindrical axis of the rod. D1 teaches to assemble the aerosol-forming substrate and at least one other element within the wrapper where the wrapper is a laminate comprising metallic foil and paper and the foil only

transfers heat from the heating element to the tobacco and does not teach that the wrapper is a thermally-conducting flame barrier.

79. It was observed that D2 teaches about the wrapping material having heat conductive properties and can comprise of metal or metal foil or laminated material and that metal foil can conduct heat from the generating segment to the aerosol-generating segment but fails to teach that the wrapper sheet is made of thermally-conductive material, which acts as a flame barrier for spreading heat and mitigating the risk of ignition, when flame is applied to heated aerosol-generating article. D3 discloses a paper-aluminium foil-paper, which aids in minimizing any transfer of the aerosol-forming material on the substrate to the fuel element, acting as an insulating jacket and/or potentially staling of other components but fails to teach that the conducting material acts as a flame barrier. Similarly, D4 also does not teach this feature of the claimed invention *albeit* it teaches a smoking article comprising a tobacco rod with a metallic foil subscribing a tobacco rod and a cylinder of non-tobacco fuel surrounding the metal foil wrapper tobacco rod. The Board further opined that D5 and D6 also do not teach the property of the wrapper sheet to act as a flame barrier.

80. Basis the respective stands of the parties and Board's recommendations, Controller concluded that Claim 1 of the subject patent was inventive over prior arts D1-D6. Controller observed that a person starting from the teachings of D1 and even combining them with those of D2-D6 will not arrive at the claimed invention as none of them teach or suggest: (a) aerosol-forming substrate comprises a gathered sheet of aerosol-forming material; and (b) thermally-conducting material, which acts as a thermally-conducting flame barrier for spreading heat and mitigating the risk

of user igniting the aerosol-forming substrate when flame is applied to the aerosol-generating article. Relevant part of the order of the Controller is as follows:-

> *"I state that D1 have been sufficiently discussed under head "Novelty". Now I will discuss arguments with respect to cited documents D2-D6 and then combine these arguments with the disclosure of documents D1-D6 to arrive at the question, whether the subject matter of granted claim 1 is inventive or not.*
>
> *For assessing inventive step, it is essential that invention as a whole should considered. In other words, it is not sufficient to draw the conclusion that a claimed invention is obvious merely because individual parts of the claims taken separately are known or might be found to be obvious. For the purpose of establishing obviousness of the invention to a person skilled in the art, mosaicing multiple documents of prior arts is permissible, if the cited prior art provides lead to the skilled person to combine the teachings thereunder, at the time of filing or priority date of patent application. (Manual of Patent office practice and procedure).*
>
> *As described above under head novelty that D1 fails to disclose the following features of claim 1 of the opposed patent.*
>
> *1). aerosol-forming substrate comprises a gathered sheet of aerosol-forming material; and*
>
> *2). thermally-conductive material which acts as a thermally-conducting flame barrier for spreading heat and mitigating against the risk of a user igniting the aerosol-forming substrate by applying a flame to the aerosol-generating article.*
>
> *The Opponent in para 11.16 admits that:*
>
> *a). D2 does not explicitly disclose that the smoking article is used with an electrically operated smoking device and*
>
> *b). the wrapper made of thermally-conductive material acts as a thermally-conducting flame barrier for mitigating against risk of a user igniting the aerosol-forming substrate.*
>
> *As smoking article in D2 uses combustible heat source a person skilled in the art will not have any incentive to combine the teachings of D2 with D1. The smoking articles of D2 rely on the combustion of part of the article to generate heat, they are clearly not adapted "**for use with an electrically-operated aerosol-generating device comprising a heating element**". For these reasons, the skilled person would not consider D2 when seeking to address the problem outlined above, which relates to improvements in heated aerosol-generating articles.*

D2, in para [0024] discloses a representative wrapping material 58 for the substrate material 55 can possess heat conductive properties, and can have the form of a metal or metal foil (e.g., aluminium) tube, or a laminated material having an outer surface comprised of paper and an inner surface comprised of metal foil. The metal foil can conduct heat from the heat generation segment 35 to the aerosol-generating segment 51. The heat generation segment 35 includes a combustible heat source-40. (See para [0019 of D2). Such a combustible heat source is not contemplated in D1 and the skilled person would consequently not consider a wrapper redistributing heat from a combustible heat source for applications where the heat source is the heating element of an aerosol generating device as in the case of D1.

Exhibit-3/D3

D3 is directed to improvements in fuel element compositions, whereby the carbon monoxide generated during combustion of the fuel element is reduced over previously known fuel compositions, and the fuel composition affords reduced thermal energy output during smoking, particularly during puffing, which in turn, reduces the carbon monoxide (CO) levels produced during the burning of the fuel element and assists in preventing the overheating of the smoking article or components thereof. (See for example summary). D3 is not at all related to electrically operated aerosol generating article rather D3 is concerned with reducing the carbon monoxide generated during combustion of a fuel element prepared from the composition. Therefore, a person skilled in the art will not look up to D3.

*The Opponent admits in para 11.22 of written statement of post-grant opposition that the Opponent states that **D3 does not explicitly disclose that the smoking article is used with an electrically operated smoking device**. D3 relates to cigarettes in which ignition and combustion of part of the cigarette is intended (specifically, combustion of fuel element 10). So, D3 does not relate to the field of heated aerosol-generating articles" within the meaning of claim 1.*

Exhibit-4/D4

*Similar to D3, D4 also relates to combustible heat source smoking article having a cylindrical tobacco rod circumscribed by a metallic foil, a cylinder of carbon fuel surrounding the wrapped tobacco rod, an air permeable wrapper circumscribing the cylinder of carbon fuel, and a filter plug coaxially located at one end of the tobacco rod and surrounding said cylinder of carbon fuel. (See Summary of D4). In use of the smoking article, the non-tobacco fuel cylinder **combusts or burns** and the heat from the burning non-tobacco fuel cylinder is transferred through the foil metal foil to the tobacco rod to heat the tobacco rod.*

So, even D4 does not relate to the field of "heated aerosol-generating articles" within the meaning of claim 1. It is important to note here that the metallic foil is known and the claimed invention does not seek to get patent protection on metallic foil. It is how it has made the aerosol generating article with the use of thermally conducting material which lower the propensity of ignition by redistributing the heat away from the point where flame is applied and act as a barrier.

Exhibit-5/D5

D5 in para [0018] describes aerosol generating article that has diameter of a conventional cigarette, includes a short, combustible carbonaceous fuel element 10, an abutting aerosol generating means 12, and a foil lined paper tube 14, which forms the mouth end piece 15 of the article. In this embodiment, fuel element 10 is a "blowpipe" charcoal, i.e. carbonized wood, which is provided with five longitudinally extending holes 16. See Figure 1A. The fuel element 10, which is about 20 mm long, optionally may be wrapped with cigarette paper to improve lighting of the charcoal fuel. This paper may be treated with known burn additives.

*Therefore, the smoking articles of D5 rely on the combustion of part of the article to generate heat, they are clearly not adapted "**for use with an electrically-an operated aerosol-generating device comprising a heating element**". For these reasons, the skilled person would not consider D5 when seeking to address the problem outlined above, which relates to improvements in heated aerosol-generating articles.*

Exhibit-6/D6:

The Opponent in para 11.32 of the written statement argues that D6 discloses use of sheet material as an outer wrapper for a heated smoking article which comprises a heat source and an aerosol- generating substrate. According to the Opponent, since the wrappers are sufficiently heat resistant to withstand the heat generated by the heat source of such smoking articles during use. D6 relates to smoking articles in which ignition and combustion of part of the smoking article is intended (specifically, combustion of combustible heat source 22). The combustible heat source 22 is disclosed as being a pyrolysed porous carbon-based heat source. So, D6 does not relate to the field of "heated aerosol-generating articles" within the meaning of claim 1.

Therefore, a person starting from the teaching of document D1 and combining the teachings of Documents D2-D6 would not arrive at the claimed invention as none of these documents teaches or suggest the following features of claim 1.

1). aerosol-forming substrate comprises a gathered sheet of aerosol-forming material; and

2). thermally-conductive material which acts as a thermally-conducting flame barrier for spreading heat and mitigating against the risk of a user igniting the aerosol-forming substrate by applying a flame to the aerosol-generating article.

In view of my above reasoning, I find claim 1 of the subject patent is inventive over prior art D1 to D6. Therefore, the ground under Section 25(2)(e) is rejected."

81. Having examined the rival submissions and on perusal of the prior arts as also granted claims, Court agrees with the patentee that D1 alone or in combination with D2 to D10 does not make the granted invention obvious. Under the head of novelty, Court has already returned a finding that D1 fails to disclose or teach the feature "aerosol-forming substrate comprises a gathered sheet of aerosol-forming material" circumscribed by a wrapper. At best, D1 is a cigarette/cartridge having both tobacco and aerosol as two separate segments within a single wrapper i.e. upstream segment (tobacco) and downstream segment (aerosol-forming material). D1 also fails to disclose the thermally-conductive material, which acts as a thermally-conducting flame barrier for spreading heat and mitigating against risk of a user igniting the aerosol-forming substrate in the event flame is applied to the aerosol-generating article. Moreover, the paper wrapper disclosed in D1 as a substitute/equivalent of a metallic wrap, would connote that the wrapper is not meant to be a thermally-conducting flame barrier. Para [0099] mentions that heat generated by second heating element can heat the metallic foil laminates/wrapping material and hence the tobacco therein, which means that the function of the wrapping material is to conduct heat from the heating element to the tobacco rod and therefore, D1 teaches away from the function of the wrapper in the granted claim. As stated in lines 6-7 of PCT publication, heated aerosol-generating article does not include a

combustible heat source. For ready reference, background section of specification is as follows:

> ***"BACKGROUND OF INVENTION***
>
> *Aerosol-generating articles in which an aerosol-forming substrate, such as a tobacco containing substrate, is heated rather than combusted are known in the art. The aim of such heated aerosol-generating articles is to reduce known harmful smoke constituents produced by the combustion and pyrolytic degradation of tobacco in conventional cigarettes. A conventional cigarette is lit when a user applies a flame to one end of the cigarette and draws air through the other end. The localised heat provided by the flame and the oxygen in the air drawn through the cigarette cause the end of the cigarette to ignite, and the resulting combustion generates an inhalable smoke. By contrast in heated aerosol-generating articles, an inhalable aerosol is typically generated by the transfer of heat from a heat source to a physically separate aerosol-forming substrate or material, which may be located within, around or downstream of the heat source. During consumption, volatile compounds are released from the aerosol-forming substrate by heat transfer from the heat source and entrained in air drawn through the aerosol-generating article. As the released compounds cool, they condense to form an aerosol that is inhaled by the consumer.*
>
> *Heated aerosol-generating articles comprising tobacco for generation of an aerosol by heating rather than burning are known in the art. For example, WO2013/102614 discloses an aerosol-generating system comprising a heated aerosol-generating article and an aerosol-generating device having a heater for heating the heated aerosol-generating article to produce an aerosol.*
>
> *Tobacco used as part of an aerosol-forming substrate in heated aerosol-generating articles is designed to produce an aerosol when heated rather than when burned. Thus, such tobacco typically contains high levels of aerosol formers, such as glycerine or propylene glycol. If a user were to light a heated aerosol-generating article and smoke it as if it were a conventional cigarette that user would not receive the intended user experience. It would be desirable to produce a heated aerosol-generating article that has a lowered propensity for flame ignition. Such a heated aerosol-generating article would be preferably difficult to light during attempts to light the article with a lighter, such as a flame, in the manner of traditional cigarettes."*

82. Summary section of the granted patent also states *"the heated aerosol-generating article is not an aerosol-generating article comprising a*

combustible heat source", which contrasts with conventional cigarettes, which rely on ignition by application of flame. Importantly, the aerosol-forming substrate in Claim 1 is radially encircled by a sheet of thermally-conductive material and is not heated through the wrapper, which circumscribes the gathered sheet of aerosol-forming material. Para [0010] of D1 contains the problem statement it tries to solve i.e. smoking articles that employ tobacco substitute materials and smoking articles that employ sources of heat other than burning tobacco cut filler to produce tobacco-flavoured vapours or tobacco-flavoured visible aerosol have not received widespread commercial success. As rightly pointed out by the Patentee, the problem of D1 was never to ignite the smoking article by someone inadvertently or accidently applying flame to the aerosol-generating article. Para [0025] of D1 discloses that smoking articles can further include a third resistance heating element within the outer housing and are operatively positioned to heat the tobacco rod and therefore, the whole arrangement uses three heating elements to heat the tobacco rod in contrast to one heating element in the opposed patent. The wrapper used in Claim 1 is a heat dissipating device, which acts as thermally-conducting flame barrier, but the wrapper in D1 is designed in a way that it acts as a heat sink (medium), which passes heat inside the tobacco rod from the heating element of the aerosol-generating device of D1 to generate aerosol. The wrapper is meant to be in contact with the heating element whereas the wrapper around the aerosol-forming substrate in Claim 1 is not in contact and serves the purpose of a flame barrier mitigating the risk of ignition.

83. Appellant's argument on the difference in metal foil and laminate has been discussed in the earlier part of the judgement. It may only be added that

Appellant is not correct in contending that the functional limitation of providing a flame barrier against ignition due to flame application such as when cigarette is lit, is not an inherent property of a laminate disclosed in the prior art. No material was placed on record to establish this point. Also, ignition temperature of the laminate foil is generally below flame temperature of a conventional lighter or a matchstick used to light a cigarette and is known to burn and/or melt if flame is applied. In my view, D1 fails to disclose all features of Claim 1 including the specific wrapper and a person skilled in the art will not be able to reach the granted invention from the teachings of D1 and to this extent there is no infirmity in the view of the Controller. Patentee also rightly claims that the technical advantages of the granted invention are that avoiding combustion of the substrate may reduce generation of various smooth constituents associated with combustion and pyrolytic degradation of tobacco in conventional cigarettes as also that aerosol-forming substrates designed for use in heated aerosol-forming articles provide poor user experience if they are ignited rather than heated.

84. Prior art D2 discloses numerous embodiments of smoking articles falling into two groups. Figures 1, for reference has been extracted above. The first group is in which a lighting end segment, heat generation segment and aerosol-generating segment are successively, axially aligned relative to each other and in the second group, the lighting end segment is omitted. D2 concerns rod shaped smoking articles comprising heat generation segment (combustible fuel) and aerosol generating segment (glycerine and flavours), which further incorporates a substrate material that acts as a carrier. D2 discloses a wrapping material possessing heat conducting properties and being in the form of a metal or metal foil. Para 24 discloses that where the

wrapping material includes a metal foil, the foil can conduct heat from the heat generation segment to the aerosol generating segment to volatilise aerosol forming components contained therein. Para 26 discloses that the wrapping material can be adapted to facilitate the transfer of heat from the heat generation segment to the aerosol generating segment and para 36 discloses that, in use, the smoking article is lit at the lighting end, using a match or a cigarette lighter, in a similar manner in which a conventional cigarette is lit. Para 36 specifically discloses that the smoking material of the lighting and segment begins to burn when the user inhales the thermally decomposed product. Para 37 discloses that burning of lighting end segment causes the heat source of the heat generation segment to be heated, ignited and burnt. Smoking articles rely on ignition and burning of substrate material and are not heated aerosol generating articles as in Claim 1. For this, reference be made to Para [0036] which reads: "*During use, the smoker lights the lighting end 14 of the smoking article 10 using a match or cigarette lighter, in a manner similar to the way that conventional smoking articles are lit.*"

85. Similarly, in the second group of smoking articles in D2, as evident from Figure 7 above, the lighting end segment is absent. The heat generation segment 35 forms the lighting end 14 and all the smoking articles rely on ignition and combustion of part of the smoking article. Therefore, seen holistically, D2 does not relate to the field of heated aerosol generating articles within the meaning of Claim 1, as rightly put forth by the Patentee. Moreover, since the smoking articles rely on combustion, they are not adapted for use within an electrically operated aerosol generating device comprising a heating element and it is thus unlikely that the skilled person

would consider D2 when seeking to address the problem at hand and/or arrive at the invention as it does not belong to the field of *"heated aerosol-generating articles"*. Controller has rightly observed and it is an admitted position that D2 does not explicitly disclose that the smoking article is used with an electrically operated smoking device or that the wrapper made of thermally conductive material acts as a thermally conducting flame barrier for mitigating against risk of a user igniting the aerosol forming substrate. It is also rightly found that since the smoking article in D2 uses combustible heat source, a person skilled in the art will not have any incentive to combine the teachings of D2 with D1. The heat generation segment 35 in D2 includes a combustible heat source, which is not contemplated in D1 and skilled person would not consider a wrapper redistributing heat from a combustible heat source for application where the heat source is the heating element of an aerosol generating device as in the case of D1.

86. Prior art D3 also does not relate to the field of "*heated aerosol-generating articles"* and relates to smoking articles (cigarettes) in which ignition and combustion of part of the smoking article is intended and required for use and operation of the smoking article. The smoking article has a fuel element located at one end and a substrate containing one or more aerosol forming material located downstream of the fuel element. It is further disclosed that the barrier tube can be paper and metal foil laminate, advantageously with the foil on the inside to assist in reducing or eliminating any migration of the aerosol former from the substrate to other components of the cigarette. It is further disclosed that paper wrapper circumscribes the fuel element near the lighting end of the cigarette, with wrapper 18 combined with the barrier tube 17 and preferably formed of

paper-aluminium foil-paper layers, to help minimize any transfer of aerosol forming materials to the substrate 16 to the fuel element 10. D3 clearly relates to cigarettes in which ignition and combustion of part of the cigarette is intended and is thus not adapted for use with an electrically operated aerosol-generating device comprising a heating element. There is no teaching in D3 that the barrier tube or wrapper has the capacity to reduce risk of ignition of the substrate in the event a flame is applied to the cigarette.

87. Consistent with D3 relying on combustion, presence of metal as part of barrier tube wrapper does not prevent ignition of material enclosed therein and only prevents excessive combustion. Clearly, the metal wrapper in D3 is not configured to act as flame barrier and is directed to improvement in fuel element compositions, as noted by the Controller, whereby carbon monoxide generated during combustion is reduced over previously known fuel compositions, which affords reduced thermal energy output during smoking, particularly, during puffing, which in turn reduces carbon monoxide levels and assists in preventing over heating of a smoking article or a component thereof. Therefore, a person skilled in the art would not use D3 as a starting point to arrive at the invention. Controller is right in concluding that Claim 1 is inventive over D3. For ready reference, Figure 1 is extracted hereunder:-

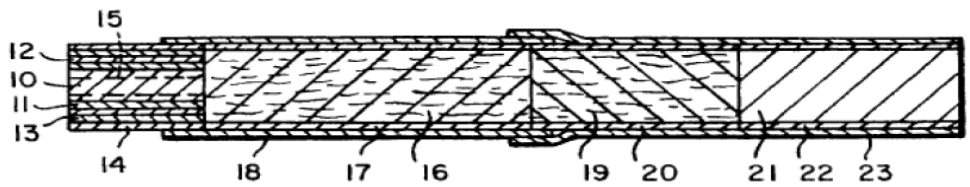


FIG. 1

88. As for prior art D4, it relates to smoking article having a cylindrical tobacco rod circumscribed by a metallic foil, a cylinder of carbon fuel surrounding the wrapped tobacco rod, an air permeable wrapper and a filter plug co-axially located at one end of the tobacco rod and surrounding the carbon fuel cylinder. From the summary of D4, it is evident that while in use, the non-tobacco fuel cylinder combusts or burns and the heat from the burning non-tobacco fuel cylinder is transferred through the foil which is of metal to the tobacco rod to heat the rod. Therefore, even D4 does not relate to the field of heated aerosol-generating article and is concerned with articles in which ignition and combustion of at least a part is intended. Further, since reliance is on combustion to generate heat, the smoking articles are not adapted for use with an electrically operated aerosol-generating device comprising a heating element. The articles have a wrapper formed of or including metal and are ignited and burnt during use and are thus not configured to act as thermally-conducting flame barrier. The skilled person would not use D4 to arrive at the invention and therefore, cannot be an impediment to the inventiveness of Claim 1 of the granted patent.

89. Prior art D5 also does not relate to the field of heated aerosol-generating articles but relates to smoking articles in which ignition and combustion at least of a part is intended. The smoking article has a combustible carbonaceous fuel element, followed by an aerosol generating means stop. The fuel element is made of charcoal and intended to be lit or ignited. The aerosol generating means is in the form of glass beads coated with an aerosol forming substrate, such as glycerine and the beads are located between fuel element and a porous disc. An aerosol delivery passage extends between the aerosol generating means and a mouth end of the

article. A foil lined paper tube circumscribes part of fuel element and all the aerosol generating means, porous disc and aerosol delivery passage. Lines 2-8 of D5 disclose that the foil lined tube increases heat transfer to the aerosol generator and helps to extinguish the fire cone due to heat loss through the foil. The aerosol generating article being reliant on combustion, is not adapted for use with an electrically operated aerosol generating device, comprising a heating element. There is no teaching in D5 of a foil lined tube displaying properties of reducing risk of ignition of the aerosol-generating means, in the event flame is applied to the smoking articles and instead teaches use of a foil as part of the tube, which serves the purpose of transferring heat. Controller rightly notes that para [0018] of D5 describes aerosol-generating article that has diameter of a conventional cigarette with a short, combustible carbonaceous fuel element, an abutting aerosol-generating means and a foil lined paper tube. In this embodiment, fuel element is a blowpipe charcoal, which is provided with extended holes and the fuel element optionally may be wrapped with cigarette paper to improve lighting of the charcoal fuel. This paper may be treated with known burn additives and does not teach a skilled person to reach up to the invention under the granted patent.

90. Likewise, D6 relates to smoking article with a heat resistance sheet material provided as an outer wrapper for a smoking article. None of the articles of D6 are heated aerosol-generating articles and instead relate to cigarettes in which ignition and combustion is intended. The combustible heat source is disclosed as being a pyrolysed porous carbon-based heat source, as given in Figure 2 and does not relate to the field of heated aerosol-generating articles. The aerosol generating substrate 24 is disclosed

in the form of a longitudinally aligned filaments of extruded tobacco material. The outer wrapper 30 is formed of a fibrous base layer 12 coated with an inner layer 14 and an outer coating layer 16. The outer wrapper is disclosed as being heat resistant and none of the materials disclosed even remotely suggest that the wrapper is thermally conductive. A heat conducting element in the form of a tube of aluminium foil surrounds and is in contact with a rear portion of the combustible heat source 22 and a front portion 24a of the aerosol generating substrate 24. For ready reference, the figure is extracted hereunder:

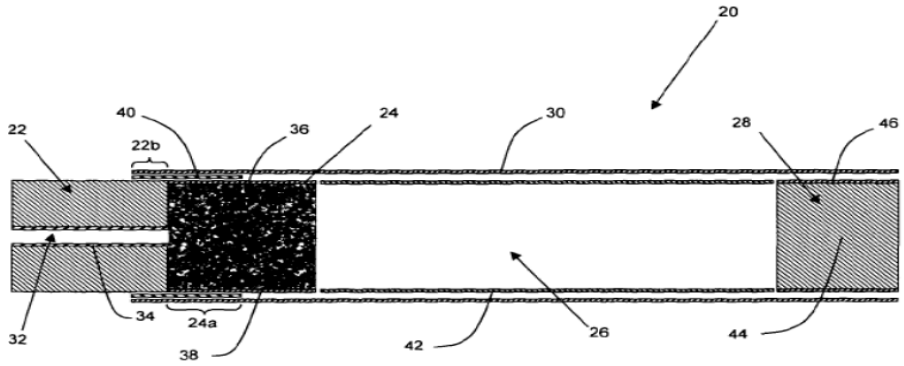


Figure 2

91. There is no teaching in D6 of the heat conducting element of aluminium foil having a feature of reducing risk of ignition of aerosol-generation substrate when flame is applied to the smoking article and at best the heat conducting element may serve to transfer heat from combustion of the heat source to aerosol-generating substrate and *sans* any teaching of the wrapper being the sheet of thermally-conductive material acting as a flame barrier for spreading heat and mitigating against ignition, it cannot be said that a person skilled in the art would start with D6 in the context of the granted invention. In light of the aforesaid teachings of prior arts D1-D6, it

cannot be urged by the Appellant that the Controller has erred in concluding that Claim 1 of the subject patent is inventive over the said prior arts. Therefore, there is also no merit in the contention of the Appellant that the Controller has not followed the guidelines laid down in ***F.Hoffmann (Supra),*** for determining the inventive step or lack thereof.

92. Insofar as additional documents D7 to D10 are concerned, Controller excluded them from consideration as being time barred under Rule 62(4) of 2003 Rules, relying on the judgement in ***Pharmacyclics LLC (supra).*** The understanding of the Controller was that the deadline for filing the publication is five days prior to the first scheduled date of hearing and not adjourned date. In the instant case the first scheduled date of hearing was 30.04.2024 and the five days limit expired on 25.04.2024. D7-D10 were filed on 31.05.2024 and hence, not accepted by the Controller. In para 40 of the judgement in ***Pharmacyclics LLC (supra),*** on which reliance is placed by the Controller and the Patentee, Court posed a question whether if a hearing is adjourned, further evidence ought to be permitted, prior to the next hearing and held that from the scheme of the 1970 Act it was clear that filing of further evidence would not be permissible after first notice of hearing and as per Rule 60, the hearing would be the first notice of hearing. It was observed that this interpretation would ensure that parties do not unduly delay the hearing of oppositions by seeking adjournments and utilising the adjourned period to dig up more evidence, especially, when such evidence has not been considered by the Opposition Board. Therefore, as per this judgement the cut-off date for filing further evidence under Rule 60 is the first scheduled date of hearing and the rationale is to ensure that opposition proceedings are not unduly delayed, keeping in backdrop the

timeline for filing a post-grant opposition.

93. There can be no quarrel on the point that post-grant oppositions must be decided expeditiously and which is why timelines are provided in the 1970 Act and the Rules. However, it may not be right to hold that as a matter of rule, publication can never be permitted under Rule 62(4) after the first date of hearing. But an important caveat needs to be added that an opponent cannot be granted adjournments and/or allowed to file publications after the first date of hearing, as a matter of right and each case has to be tested by the Controller on its own facts, keeping in mind the special circumstances brought forth to seek leave to file the publications at that stage, so as to curb any tendency of taking unnecessary adjustments and prolonging the proceedings. In the instant case, first hearing notice was issued on 13.02.2024 scheduling the hearing for 30.04.2024. At request of the Appellant filed on 26.04.2024, the hearing was adjourned to 06.04.2024 and the publications being D7-D10 were filed on 31.05.2024. It cannot be held in these facts that Appellant attempted to delay the proceedings. Moreover, these are prior arts in the same field and it is therefore necessary to consider them to determine if the patent was rightly granted. Considering this is an appeal, Court has considered D7, which was the only additional document, on which arguments were addressed on behalf of the parties.

94. Document D7 relates to a non-combustion flavour inhalation article. Appellant asserts that D7 makes the granted Claim 1 obvious to a person skilled in the art, inasmuch as it relates to a heated aerosol-generating article for use with an electrically operated aerosol-generating device. D7 also teaches a roll including a tobacco sheet which is obtained by wrapping the outside of the tobacco sheet shaped into a hollow cylindrical shape with a

heat conductive wrapping material, which is an aluminium foil or an aluminium laminated paper. D7 as per the Appellant, teaches that the wrapper can be a metal foil with high thermal conductivity and can avoid combustion of tobacco sheet. It also teaches that aluminium foil has high conductivity in the range of 236 W/m.K. A person skilled in the art knows that materials with high thermal conductivity are capable of spreading/conducting heat easily and are not easy to ignite as they have a high ignition temperature due to high heat spreading/conduction capability and therefore, it will be obvious to a skilled person in the art to use metal/aluminium foil as a barrier configured to spread heat and avoid ignition of the tobacco sheet for avoiding combustion. D7 also discloses aerosol-forming substrate comprises tobacco sheet and para [0034] describes wounded sheet of tobacco in multiple layers, which is equivalent to the concept of gathered sheets. Thus, according to the Appellant, D7 explicitly discloses most features of the impugned patent.

95. D7 is a Japan Tobacco Patent Application titled *"Non-combustion flavour inhalation article"* and was published on 11.08.2011. D7 expressly discloses heated/non-combustion article having a tobacco sheet, metal foil surrounding the tobacco sheet and a heating device. Potentially, D7 is closest prior art having an aerosol-forming substrate and a sheet of thermally-conductive material. However, there is a critical difference in D7 and Claim 1 of the granted patent. Claim 1 is not merely a combination of tobacco sheet with metal foil and heater. The sheet of thermally-conductive material, which acts as a thermally-conducting flame barrier for spreading heat and mitigating against the risk of a user igniting the aerosol-forming substrate by applying flame is the important feature in Claim 1. There is a

specific structural-functional relationship. D7's principal teaching is a non-combustion flavour inhalation article and D7 clearly fails to teach that metal foil surrounding the tobacco sheet and heated by a heater is a flame barrier, intended to deal with a user applying flame to the article and configured for spreading heat from such a flame, thereby intending to mitigate ignition of the aerosol-forming substrate. In a nut shell, the distinction is very instructive with regard to the wrapper acting as a flame barrier, spreading heat from applied flame and mitigation of ignition in Claim 1 and therefore, D7 does not anticipate the said claim.

96. Structurally, D7 may be close to Claim 1, however, the stated objective of D7 is to provide a non-combustion flavour inhalation article that allows tobacco components/flavour to be inhaled without generating smoke or combustion products and D7 achieves this objective by controlling the heater temperature. Therefore, D7's teaching is essentially to control the electrical heater temperature so that the tobacco does not combust whereas Claim 1 addresses a thermally-conductive wrapper acting as a flame barrier spreading heat and mitigating ignition.

97. D7 teaches that aluminium foil is used as heat-conductive wrapper, which uniformly transfers controlled heat to tobacco sheet but does not disclose the aluminium wrapper spreading heat laterally to reduce ignition of tobacco sheet when external heat is applied, which is the relationship recited in Claim 1. Appellant lays emphasis on the aluminium wrapper to bring home the point that it has high thermal conductivity and thus not easy to ignite and consequently, acts as a flame barrier. To my mind, these are two separate problems. Firstly, thermal-conductivity may not be the same as flame barrier behaviour of a wrapper, though they are related. Thermal

conductivity describes how readily heat travels through aluminium, which has a high thermal conductivity of roughly 200-235 W/m.K. Flame barrier behaviour describes how a material behaves when exposed to flame e.g. whether it ignites, supports combustion, melts, shrinks etc. Aluminium foil is itself non-combustible but because it is very thin, it can heat up rapidly and may melt or lose its barrier function under sufficiently intense or long flame exposure. D7 discloses that aluminium foil is conductive but that does not establish that the foil is configured as a flame barrier or receives heat from an externally applied flame and/or spreads that flame derived heat and prevents a temperature rise in the tobacco substrate, thereby mitigating ignition.

98. Moreover, D7 appears to avoid combustion principally through controlled heating below the relevant combustion/smoke generating temperature, rather than by teaching an external flame protection mechanism. Pithily put, the purpose of conductive wrapper in D7 is *"Uniform heat transfer"* whereas in Claim 1 it is *"Flame barrier/heat spreading"*. In D7, external flame contemplation is not identified whereas it is expressly identified in Claim 1. The risk addressed in D7 is combustion during heating while that in Claim 1 is ignition from user applied flame. In fact, the argument of the Appellant is more in the nature of hindsight reconstruction of the opposed patent, which is impermissible in law. It is also to be noted that Appellant is unable to establish how the mere fact that aluminium conducts heat is necessarily a motivation to use this feature for specific problem of flame induced ignition. To sum up, D7 does not disclose or render obvious the claimed flame barrier function and Appellant's reliance on D7 is based on impermissible conflation of thermal-conductivity

of aluminium with specific technical function required by Claim 1. While disclosure of tobacco sheet surrounded by thermally-conductive wrapper being aluminium foil is not disputed, however, importantly D7 fails to teach that the wrapper material functions as thermally-conducting flame barrier for spreading heat and mitigating against the risk of a user igniting the aerosol-forming substrate by applying flame to the aerosol-generating article, as expressly claimed in Claim 1 of the granted patent. Appellant's leap from aluminium's thermal-conductivity to the claimed flame barrier function is in fact an inference and not a disclosure and therefore, Appellant is not correct in arguing that D7 anticipates Claim 1 of the granted patent.

99. For all the aforesaid reasons, this Court is of the view that the impugned orders both dated 30.01.2025 warrant no interference and accordingly, the writ petition and the appeal are both dismissed. Pending applications stand disposed of accordingly.

JYOTI SINGH, J.

SEPTEMBER 10, 2026/*S.Sharma/HS*