

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JT INTERNATIONAL S.A.
Petitioner,

v.

FONTEM HOLDINGS 1 B.V.
Patent Owner.

Case IPR2015-01587
Patent No. 8,365,742

PATENT OWNER'S MANDATORY NOTICES

Pursuant to 37 C.F.R. § 42.8, Patent Owner, Fontem Holdings 1 B.V. submits the following Mandatory Notices in response to the identified Petition for *Inter Partes* Review of U.S. Patent No. 8,365,742 (“the ‘742 patent” or “the involved patent”).

1. Real Party-In-Interest

In accordance with 37 C.F.R. § 42.8(b)(1), Patent Owner identifies the real party-in interest as Fontem Holdings 1 B.V.; 12th Floor, Barbara Strozzi laan 101; 1083 HN Amsterdam, The Netherlands. Fontem Holdings 1 B.V. is a Netherlands corporation and is a wholly owned subsidiary of Fontem Ventures B.V. also of 12th Floor, Barbara Strozzi laan 101; 1083 HN Amsterdam, The Netherlands, which is in turn a wholly owned subsidiary of Imperial Tobacco Group PLC. Imperial Tobacco Group PLC is an English corporation having a registered office at 121 Winterstoke Road, Bristol, UK BS3 2LL. Fontem Holdings 1 B.V. became the Patent Owner via an assignment executed December 9, 2013.

2. Related Matters

In accordance with 37 C.F.R. § 42.8(b)(2), Patent Owner identifies the following related judicial and appellate proceedings (involving, among other patents, the '742 patent or related U.S. Patent No. 8,156,944).

a. *Fontem Ventures B.V. and Fontem Holdings I B.V. v. NJOY, Inc.*, Civil Action No. 14-CV-1645 GW (MRWx), U.S. District Court for the Central District of California;

b. *Fontem Ventures B.V. and Fontem Holdings I B.V. v. CB Distributors, Inc. and DR Distributors, LLC*, Civil Action No. 14-CV-1649 GW (MRWx), U.S. District Court for the Central District of California;

c. *Fontem Ventures B.V. and Fontem Holdings I B.V. v. Vapor Corp.*, Civil Action No. 14-CV-1650 GW (MRWx), U.S. District Court for the Central District of California;

d. *Fontem Ventures B.V. and Fontem Holdings I B.V. v. FIN Branding Group, LLC and Victory Electronic Cigarettes Corporation*, Civil Action No. 14-CV-1651 GW (MRWx), U.S. District Court for the Central District of California;

e. *Fontem Ventures B.V. and Fontem Holdings I B.V. v. Ballantyne Brands, LLC*, Civil Action No. 14-CV-1652 GW (MRWx), U.S. District Court for the Central District of California;

f. *Fontem Ventures B.V. and Fontem Holdings I B.V. v. Spark Industries, LLC*, Civil Action No. 14-CV-1653 GW (MRWx), U.S. District Court for the Central District of California;

g. *Fontem Ventures B.V. and Fontem Holdings I B.V. v. Logic Technology Development LLC*, Civil Action No. 14-CV-1654 GW (MRWx), U.S. District Court for the Central District of California;

h. *Fontem Ventures B.V. and Fontem Holdings I B.V. v. VMR Products, LLC, dba V2Cigs*, Civil Action No. 14-CV-1655 GW (MRWx), U.S. District Court for the Central District of California.

i. *Ruyan Investment (Holdings) Limited v. Sottera, Inc. et al.*, Civil Action No. CV12-5454 GAF (FFMx), U.S. District Court for the Central District of California;

j. *Ruyan Investment (Holdings) Limited v. LOEC, Inc. et al.*, Civil Action No. CV12-5455 GAF (FFMx), U.S. District Court for the Central District of California;

k. *Ruyan Investment (Holdings) Limited v. CB Distributors, Inc. et al.*, Civil Action No. CV12-5456 GAF (FFMx), U.S. District Court for the Central District of California;

l. *Ruyan Investment (Holdings) Limited v. The Safe Cig LLC*, Civil Action No. CV12-5462 GAF (FFMx), U.S. District Court for the Central District of California;

m. *Ruyan Investment (Holdings) Limited v. Vapor Corp.*, Civil Action No. CV12-5466 GAF (FFMx), U.S. District Court for the Central District of California;

n. *Ruyan Investment (Holdings) Limited v. Finiti Branding Group LLC*, Civil Action No. CV12-5468 GAF (FFMx), U.S. District Court for the Central District of California;

o. *Ruyan Investment (Holdings) Limited v. Spark Industries LLC*, Civil Action No. CV12-5472 GAF (FFMx), U.S. District Court for the Central District of California;

p. *Ruyan Investment (Holdings) Limited v. Nicotek LLC*, Civil Action No. CV12-5477 GAF (FFMx), U.S. District Court for the Central District of California;

q. *Ruyan Investment (Holdings) Limited v. Logic Technology Development LLC*, Civil Action No. CV12-5482 GAF (FFMx), U.S. District Court for the Central District of California;

r. *Fontem Holdings I B.V. v. CB Distributors, Inc.*, Appeal No. 15-1511 from Patent and Trademark Office – Patent Trial and Appeal Board in no. IPR2013-00387 (item **w.** below), U.S. Court of Appeals for the Federal Circuit.

In addition, Patent Owner identifies the following related administrative matters:

s. U.S. Patent No. 8,156,944, issued April 17, 2012 to Lik Hon, filed October 29, 2008 as U.S. Patent Application No. 12/226,818, which is the parent of the '742 patent;

t. U.S. Patent Application Publication No. 20130125906, corresponding to U.S. Patent Application No. 13/740,011, filed January 11, 2013 and now pending, which is a continuation of the '742 patent;

u. U.S. Patent Application Publication No. 20140209110, corresponding to U.S. Application No. 14/244,376, filed April 3, 2014 and now pending, which is a continuation of U.S. Patent Application No. 13/740,011 (item **t.** above);

v. *Inter Partes* Reexamination No. 95/002,235 of U.S. Patent No. 8,156,944 before the U.S. Patent Office, filed by FIN Branding Group, LLC and currently stayed pending the outcome of item **w.** below;

w. *Inter Partes* Review No. IPR2013-00387 of U.S. Patent No. 8,156,944, filed by CB Distributors/DR Distributors, decided by the Patent Trial

and Appeal Board of the U.S. Patent and Trademark Office December 24, 2014
and currently on appeal before the U.S. Court of Appeals for the Federal Circuit;
and

x. Petition for *Inter Partes* Review No. of U.S. Patent No. 8,365,742 (the involved patent), Case No. IPR2015-00859, before the Patent Trial and Appeal Board at the U.S. Patent Office, filed March 10, 2015 by Petitioner VMR Products LLC.

3. Lead and BackUp Counsel

In accordance with 37 C.F.R. § 42.8(b)(3), Patent Owner identifies Michael J. Wise as lead counsel and Joseph P. Hamilton as backup counsel:

Michael J. Wise, Lead Counsel USPTO Reg. No. 34,047 PERKINS COIE LLP 1888 Century Park East, Suite 1700 Los Angeles, CA 90067 Phone: 310-788-3210 Facsimile: 310-788-3399 Email: Mwise@perkinscoie.com	Joseph P. Hamilton, Backup Counsel USPTO Reg. No. 51,770 PERKINS COIE LLP 1888 Century Park East, Suite 1700 Los Angeles, CA 90067 Phone: 310-788-3271 Facsimile: 310-788-3399 Email: JHamilton@perkinscoie.com
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4. Service Information

In accordance with 37 C.F.R. § 42.8(b)(4), Patent Owner identifies the following service information. Counsel for Patent Owner consents to service of all documents via electronic mail:

Post and Hand Delivery:	Patent Docketing PERKINS COIE LLP P.O. Box 1247 Seattle, WA 98111-1247
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Respectfully submitted,

Date: August 4, 2015

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Counsel for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify that on August 4, 2015, I served a true and correct copy of the foregoing **PATENT OWNER'S MANDATORY NOTICES** via electronic mail upon the following counsel of record for Petitioner JT International S.A.:

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