

Paper No. \_\_\_\_  
Filed: September 21, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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**NU MARK LLC,**  
Petitioner,

v.

**FONTEM HOLDINGS 1 B.V.,**  
Patent Owner.

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Case **IPR2016-01705**  
Patent No. **9,339,062**

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**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 above-captioned Petition for *Inter Partes* Review of U.S. Patent No. 9,339,062 (“the ‘062 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., a Netherlands corporation, located at 12th Floor, Barbara Strozzi laan 101, 1083 HN Amsterdam, The Netherlands. Fontem Holdings 1 B.V. is a wholly owned subsidiary of Fontem Ventures B.V., also located at 12th Floor, Barbara Strozzi laan 101, 1083 HN Amsterdam, The Netherlands. Fontem Ventures B.V. is an indirect wholly owned subsidiary of Imperial Brands PLC. Imperial Brands PLC is an English corporation having a registered office at 121 Winterstoke Road, Bristol, UK BS3 2LL. Fontem Holdings 1 B.V. has granted Fontem Ventures B.V. an exclusive license to the ‘062 patent. Fontem Holdings 1 B.V. became the Patent Owner via an assignment executed December 9, 2013.

## **2. Related Proceedings**

In accordance with 37 C.F.R. § 42.8(b)(2), Patent Owner identifies the following related judicial proceedings (involving, among other patents, the ‘062

patent, U.S. Patent Nos. 8,375,957 and 9,370,205, which are priority cases to the '062 patent, and U.S. Patent Nos. 8,863,752, 9,326,550, and 9,326,551, which share priority claims with the '062 patent):

**a.** *Fontem Ventures B.V. and Fontem Holdings I B.V. v. R.J. Reynolds Vapor Company*, Civil Action No. 16-CV-4534 GW (MRW), U.S. District Court for the Central District of California;

**b.** *Fontem Ventures B.V. and Fontem Holdings I B.V. v. Nu Mark LLC*, Civil Action No. 16-CV-2291 GW (MRW), U.S. District Court for the Central District of California;

**c.** *Fontem Ventures B.V. and Fontem Holdings I B.V. v. Nu Mark LLC*, Civil Action No. 16-CV-4537, U.S. District Court for the Central District of California;

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

**e.** *Fontem Ventures B.V. and Fontem Holdings I B.V. v. LOEC, Inc., dba blue cigs*, Civil Action No. 14-CV-1648 GW (MRW), U.S. District Court for the Central District of California;

**f.** *Fontem Ventures B.V. and Fontem Holdings I B.V. v. CB Distributors, Inc. and DR Distributors, LLC, dba 21st Century Smoke, LLC*, Civil

Action No. 14-CV-1649 GW (MRW), U.S. District Court for the Central District of California;

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

**h.** *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 (MRW), U.S. District Court for the Central District of California;

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

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

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

**l.**     *Fontem Ventures B.V. and Fontem Holdings 1 B.V. v. VMR Products, LLC, dba V2CIGS*, Civil Action No. 14-CV-1655 GW (MRW), U.S. District Court for the Central District of California;

**m.**     *Fontem Ventures B.V. and Fontem Holdings 1 B.V. v. NJOY, Inc.*, Civil Action No. 14-CV-8144 GW (MRW), U.S. District Court for the Central District of California;

**n.**     *Fontem Ventures B.V. and Fontem Holdings 1 B.V. v. LOEC, Inc., dba blue cigs*, Civil Action No. 14-CV-8149 GW (MRW), U.S. District Court for the Central District of California;

**o.**     *Fontem Ventures B.V. and Fontem Holdings 1 B.V. v. CB Distributors, Inc. and DR Distributors, LLC, dba 21st Century Smoke, LLC*, Civil Action No. 14-CV-8154 GW (MRW), U.S. District Court for the Central District of California;

**p.**     *Fontem Ventures B.V. and Fontem Holdings 1 B.V. v. Vapor Corp.*, Civil Action No. 14-CV-8155 GW (MRW), U.S. District Court for the Central District of California;

**q.**     *Fontem Ventures B.V. and Fontem Holdings 1 B.V. v. Fin Branding Group, LLC and Victory Electronic Cigarettes International Group, Ltd.*, Civil Action No. 14-CV-8156 GW (MRW), U.S. District Court for the Central District of California;

**r.** *Fontem Ventures B.V. and Fontem Holdings 1 B.V. v. Ballantyne Brands, LLC*, Civil Action No. 14-CV-8157 GW (MRW), U.S. District Court for the Central District of California;

**s.** *Fontem Ventures B.V. and Fontem Holdings 1 B.V. v. Spark Industries, LLC*, Civil Action No. 14-CV-8158 GW (MRW), U.S. District Court for the Central District of California;

**t.** *Fontem Ventures B.V. and Fontem Holdings 1 B.V. v. Logic Technology Development LLC*, Civil Action No. 14-CV-8160 GW (MRW), U.S. District Court for the Central District of California; and

**u.** *Fontem Ventures B.V. and Fontem Holdings 1 B.V. v. VMR Products, LLC, dba V2CIGS*, Civil Action No. 14-CV-8161 GW (MRW), U.S. District Court for the Central District of California.

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

**v.** U.S. Patent No. 8,375,957, issued February 19, 2013 to Lik Hon, filed January 15, 2009 as U.S. Patent Application No. 12/226,819, which is a priority case to the '062 patent;

**w.** U.S. Patent No. 9,370,205, issued June 21, 2016 to Lik Hon, filed January 30, 2013 as U.S. Patent Application No. 13/754,521, which is a priority case to the '062 patent;

**x.** U.S. Patent No. 8,863,752, issued October 21, 2014 to Lik Hon, filed June 11, 2016 as U.S. Patent Application No. 13/915,427, which shares priority claims with the '062 patent;

**y.** U.S. Patent No. 9,326,550, issued May 3, 2016 to Lik Hon, filed May 22, 2015 as U.S. Patent Application No. 14/720,288, which shares priority claims with the '062 patent;

**z.** U.S. Patent No. 9,326,551, issued May 3, 2016 to Lik Hon, filed May 22, 2015 as U.S. Patent Application No. 14/723,209, which shares priority claims with the '062 patent;

**aa.** U.S. Patent Application Publication No. 2016-0262458, by Lik Hon, filed May 18, 2015 as U.S. Patent Application No. 15/158,421, which shares priority claims with the '062 patent;

**bb.** Petition for *Inter Partes* Review of U.S. Patent No. 8,375,957 (item **v.** above), Case No. IPR2015-00098, before the Patent Trial and Appeal Board at the U.S. Patent Office, filed October 21, 2014 by Petitioner Logic Technology Development, LLC;

**cc.** Petition for *Inter Partes* Review of U.S. Patent No. 8,375,957 (item **v.** above), Case No. IPR2015-01513, before the Patent Trial and Appeal Board at the U.S. Patent Office, filed June 26, 2015 by Petitioner JT International S.A.;

**dd.** Petition for *Inter Partes* Review of U.S. Patent No. 8,863,752 (item **x.** above), Case No. IPR2015-01301, before the Patent Trial and Appeal Board at the U.S. Patent Office, filed May 29, 2015 by Petitioners NJOY, Inc.; CB Distributors, Inc.; DR Distributors, LLC; FIN Branding Group, LLC; Electronic Cigarettes International Group, Ltd. f/k/a Victory Electronic Cigarettes Corporation; and, Logic Technology Development LLC;

**ee.** Petition for *Inter Partes* Review of U.S. Patent No. 8,863,752 (item **x.** above), Case No. IPR2015-01604, before the Patent Trial and Appeal Board at the U.S. Patent Office, filed July 20, 2015 by Petitioner JT International S.A.;

**ff.** Petition for *Inter Partes* Review of U.S. Patent No. 8,375,957 (item **v.** above), Case No. IPR2016-01307, before the Patent Trial and Appeal Board at the U.S. Patent Office, filed June 28, 2016 by Petitioner Nu Mark LLC;

**gg.** Petition for *Inter Partes* Review of U.S. Patent No. 8,863,752 (item **x.** above), Case No. IPR2016-01309, before the Patent Trial and Appeal Board at the U.S. Patent Office, filed June 28, 2016 by Petitioner Nu Mark LLC;

**hh.** Petition for *Inter Partes* Review of U.S. Patent No. 9,370,205 (item **w.** above), Case No. IPR2016-01642, before the Patent Trial and Appeal Board at the U.S. Patent Office, filed August 18, 2016 by Petitioner Nu Mark LLC;



**ii.** Petition for Inter *Partes* Review of U.S. Patent No. 9,326,550 (item **y.** above), Case No. IPR2016-01707, before the Patent Trial and Appeal Board at the U.S. Patent Office, filed August 31, 2016 by Petitioner Nu Mark LLC; and

**jj.** Petition for Inter *Partes* Review of U.S. Patent No. 9,326,551 (item **z.** above), Case No. IPR2016-01706, before the Patent Trial and Appeal Board at the U.S. Patent Office, filed August 31, 2016 by Petitioner Nu Mark LLC.

### **3. Lead and Back-up 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 and Tyler R. Bowen as back-up 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: M Wise@perkinscoie.com	Joseph P. Hamilton Back-up 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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	<p>Tyler R. Bowen Back-up Counsel USPTO Reg. No. 60,461</p> <p>PERKINS COIE LLP 2901 North Central Avenue Suite 2000 Phoenix, AZ 85012 Phone: (602) 351-8448 Email: <a href="mailto:TBowen@perkinscoie.com">TBowen@perkinscoie.com</a></p>
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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 documents via electronic mail.

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Respectfully submitted,

Date: September 21, 2016

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Counsel for Patent Owner

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that service on Petitioner was made as follows, in accordance with 37 CFR 42.6(e):

*Date of service:* September 21, 2016

*Manner of service:* 1. Electronic submission through the USPTO Patent Trial and Appeal Board End-to-End System  
2. Electronic mail

*Document(s) served:* **PATENT OWNER'S MANDATORY NOTICES**

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