

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

R. J. REYNOLDS VAPOR COMPANY,
Petitioner,

v.

FONTEM HOLDINGS 1 B.V.,
Patent Owner.

Case IPR2016-01270
Patent 8,893,726 B2

Before JOSIAH C. COCKS, RAMA G. ELLURU, and JO-ANNE M.
KOKOSKI, *Administrative Patent Judges*.

ELLURU, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

INTRODUCTION

On February 2, 2017, R. J. Reynolds Vapor Company (“Petitioner”) filed a Request for Rehearing (“Request” or “Reh. Req.,” Paper 12) of our Decision (“Decision” or “Dec.,” Paper 11) denying *inter partes* review of claims 15 and 16 of U.S. Patent No. 8,893,726 (“the ’726 patent,” Ex. 1001). Claim 15, and thus its dependent claim 16, recites “the liquid storage body in physical contact with the atomizer.” For this limitation, Petitioner refers to Brooks’s teachings with respect to heating element 18. Pet. 37–42. According to Petitioner (Reh. Req. 2–3), the Decision misapprehended and overlooked Brooks’s disclosure of “[o]ther suitable heating elements include . . . porous substrates in intimate contact with resistance heating components.” Ex. 1006, 7:65–8:3 (emphasis added).

We have reviewed Petitioner’s Request and carefully considered Petitioner’s arguments. For the reasons discussed below, we deny Petitioner’s Request for Rehearing.

ANALYSIS

A request for rehearing must identify specifically all matters the party believes we misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. 37 C.F.R. § 42.71(d). Additionally, Petitioner, as the party challenging the Decision, has the burden of showing the Decision should be modified. *Id.*

When rehearing a decision on a petition, the Board will review the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). An abuse of discretion may be determined “if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial

evidence, or if the decision represents an unreasonable judgment in weighing relevant factors.” *Arnold Partnership v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004) (citing *In re Gartside*, 200 F.3d 1305, 1315–16 (Fed. Cir. 2000)).

Petitioner argues that the Board overlooked Brooks’s disclosure, as noted above. We are not persuaded by Petitioner’s argument.

We construed the term “physical contact,” recited in claim 15, to mean “separate components in direct contact.” Dec. 8. Petitioner’s Rehearing Request does not contest this construction.

For the claim 15 limitation “the liquid storage body in physical contact with the atomizer,” Petitioner refers to Brooks’s teachings with respect to heating element 18. Pet. 37–42. Relying on Brooks’s statement that “[o]ther suitable heating elements include . . . porous substrates in intimate contact with resistance heating components,” Petitioner equates Brooks’s “porous substrates” with the recited “liquid storage body” and the “resistance heating components” of heating element 18 with the recited “atomizer.” *Id.* at 38 (citing Ex. 1006, 7:65–8:3). As we explained in our Decision, Brooks repeatedly describes heating element 18 as both holding the liquid and atomizing it. Dec. 11–12. Thus, because we found that Brooks describes heating element 18 as both holding and atomizing the aerosol forming substances, we determined that Brooks does not disclose “the liquid storage body in physical contact with the atomizer,” i.e., separate components in direct contact. *Id.* at 11–13.

Petitioner’s Rehearing Request argues that we overlooked Brooks’ description of a *different* embodiment of heating element 18 when it states “[o]ther suitable heating elements include . . . porous substrates in intimate contact with resistance heating components.” Reh. Req. 1–2 (emphasis

added) (citing Ex. 1006, 7:65–8:3). We did not overlook this disclosure. Indeed, we stated “Brooks’s lone statement that ‘*[o]ther suitable heating elements include . . . porous substrates in intimate contact with resistance heating components*’ (Ex. 1006, 7:65–8:3 (emphasis added)) does not persuade us that ‘in intimate contact’ discloses that the porous substrate is separate from the resistance heating components of the heating element.” Dec. 13. We remain unpersuaded by this statement in light of the entirety of Brooks’s disclosure describing the same element, heating element 18, as both holding and atomizing aerosol forming substances. In other words, Brooks’s use of the phrase “in intimate contact” to refer to the physical relationship between its “porous substrates” and “resistance heating components,” without more, does not persuade us that the element are separate, but in direct contact.

Petitioner argues that our determinations with respect to Brooks’s disclosure are inconsistent with our analysis of the ’726 patent. Reh. Req. 4–5. Specifically, Petitioner argues that when we analyzed the disclosure of the ’726 patent, we noted “that the ‘direct contact’ relationship of the liquid storage body with the atomizer ‘indicates the two elements are separate’ structures.” *Id.* (citing Paper 11, 7). Petitioner’s argument is not sufficiently convincing.

We found that the ’726 patent specification’s use of the term “physical contact” in claim 15 was equated with the term “direct contact” used in the specification. Dec. 7. In addition, we determined that the “direct contact” of two elements indicates that the elements are separate components from one another. *Id.* Based on this determination, *as well as* the specification’s description that “[t]he atomizer 9 is in contact with the

liquid-supplying bottle 11” (Ex. 1001, 2:48–40) and a figure *showing that liquid-supplying bottle 11 and atomizer 9 are separate* (*id.* at Fig. 1, 2:36–39), we concluded that “physical contact” means “separate components in direct contact.” Dec. 7–8.

Petitioner further argues that “the porous substrate and resistance heating components of Brooks’s ‘intimate contact’ embodiment are necessarily separate structures because something cannot be in intimate contact with itself.” Reh. Req. 4–5. This is new argument, which we could not have overlooked or misapprehended. Petitioner also cites case law in support that it does not assert was cited in the petition. *See id.* Petitioner also cites to claims in Brooks in support of its argument that “in intimate contact” indicates separate elements, but this again is new argument. *See* Reh. Req. 6–7.

Nevertheless, we remain unpersuaded by Brooks’s disclosure referred to by Petitioner as a “different” embodiment. Brooks’s use of the term “in intimate contact, ” *by itself*, to describe the physical relationship between its “porous substrates” and “resistance heating components” is not the same as disclosing that the elements are in “direct contact.” Petitioner has not sufficiently shown that Brooks’s use of “in intimate contact” for this embodiment is any different than its repeated description of heating element 18 as both holding and atomizing the liquid. And, more importantly, there is no illustration in Brooks, as there is in the ’726 patent specification, of the relevant two elements (porous substrate and resisting heating element) being separate.

As a result, we did not abuse our discretion in denying institution of *inter partes* review of claims 15 and 16 on the asserted grounds of

anticipation by Brooks and obviousness based on Brooks, Cook, and/or Takeuchi.

CONCLUSION

Petitioner has not carried its burden of demonstrating that our Decision misapprehended or overlooked any matters or that the Board abused its discretion. 37 C.F. R. § 42.71(d).

ORDER

In consideration of the foregoing, it is
ORDERED that Petitioner's Request for Rehearing is *denied*.

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