

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

U.S. Patent No.: 8,365,742

Issue Date: Feb. 5, 2013

Title: Aerosol Electronic Cigarette

Inter Partes Review No. IPR2016-01532

**PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT NO. 8,365,742 PURSUANT TO
35 U.S.C. §§ 311-319 AND 37 C.F.R. § 42**

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35 U.S.C. §§ 311-319	1, 11, 16

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REGULATIONS

37 C.F.R. § 42	1, 11, 15, 19
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EXHIBITS LIST

Exhibit No.	Description
Exhibit 1001:	U.S. Pat. No. 8,365,742 to Lik Hon
Exhibit 1002:	U.S. Pat. Pub. No. 2009/0095311 to Li Han
Exhibit 1003:	Chinese Pat. Appl. No. 200620090805.0
Exhibit 1004:	English translation of Chinese Pat. Appl. No. 200620090805.0
Exhibit 1005:	PCT publication corresponding to PCT/CN2007/001575
Exhibit 1006:	English translation of PCT ‘575
Exhibit 1007:	PCT publication corresponding to PCT/CN2007/001576
Exhibit 1008:	English translation of PCT ‘576
Exhibit 1009:	U.S. Pat. Appl. No. 12/226,818 Filed October 29, 2008, including English translation of the PCT publication (also included as Ex. 1006), Application Data Sheet, and Preliminary Amendment
Exhibit 1010:	U.S. Pat. Appl. No. 13/079,937 with Preliminary Amendment Filed April 5, 2011
Exhibit 1011:	Amendment with Substitute Specification Filed in USSN 13/079,937 on August 7, 2012
Exhibit 1012:	Declaration of Dr. Robert Sturges
Exhibit 1013:	Board’s Decision Denying Institution in IPR2015-00859
Exhibit 1014:	Rulings On Claims Construction, <i>Fontem Ventures, B.V. et al. v. NJOY, Inc. et al.</i> , No. 2:14-cv-01645 (C.D. Cal., filed March 5, 2014)
Exhibit 1015:	U.S. Pat. No. 8,156,944
Exhibit 1016:	Complaint, <i>Fontem Ventures B.V. et al. v. R.J. Reynolds Vapor Company</i> , No. 2:16-cv-02286 (C.D. Cal., filed April 4, 2016)

I. INTRODUCTION

Pursuant to 35 U.S.C. §§ 311-319 and 37 C.F.R. § 42, R.J. Reynolds Vapor Company (“Petitioner”) respectfully requests *Inter Partes* Review (“IPR”) of claims 2 and 3 of U.S. Pat. No. 8,365,742 to Lik Hon, titled “Aerosol Electronic Cigarette” (“‘742 patent,” Ex. 1001), which is currently assigned to Fontem Holdings 1 B.V. (“Patent Owner”). The Petitioner authorizes the Patent and Trademark Office to charge Deposit Account No. 23-1925 for the fees set in 37 C.F.R. § 42.15(a) for this Petition, and further authorizes payment of any additional fees to be charged to this Deposit Account.

Challenged claims 2 and 3 of the ‘742 patent are invalid as anticipated under 35 U.S.C. § 102(b) by the parent application of the ‘742 patent, which published on April 16, 2009 (US2009/0095311 (“the ‘311 publication”), Ex. 1002). *See* Ex. 1012 at ¶¶ 21-39. In order to survive this invalidity ground, the Patent Owner must demonstrate that claims 2 and 3 are entitled to a filing date prior to April 17, 2010. This, the Patent Owner cannot do, because claims 2 and 3 are not entitled to a filing date any earlier than April 5, 2011, the filing date of U.S. Serial No. 13/079,937 (“the ‘937 application”), which matured into the ‘742 patent.¹

¹Claims 2 and 3 are not even entitled to the April 5, 2011 filing date because the as-filed ‘937 application does not provide written description support for claims 2 and 3. After filing the ‘937 application, the Applicant attempted to cure the § 112

The only sufficiently early parent application on which Patent Owner could attempt to rely in an effort to avoid the invalidating ‘311 publication is U.S. Serial No. 12/226,818 filed October 29, 2008 (*i.e.*, the “parent ‘818 application”), but the parent ‘818 application fails to provide written description support for broad claims 2 and 3 of the ‘742 patent. Claims 2 and 3 of the ‘742 patent broadly encompass an electronic cigarette where the battery assembly and the atomizer assembly are located in either the same or separate shells of the claimed housing. In contrast, the parent ‘818 application narrowly describes the “invention” as an electronic cigarette with the battery assembly and the atomizer assembly located in the same one-piece shell. *See* Ex. 1012 at ¶¶ 42-54. *See, e.g., PowerOasis, Inc. et al. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306 (Fed. Cir. 2008) (“It is elementary patent law that a patent application is entitled to the benefit of the filing date of an earlier filed application only if the disclosure of the earlier application provides support for the claims of the later application, as required by 35 U.S.C. § 112”) (citations omitted). Nowhere does the parent ‘818 application describe or contemplate an electronic cigarette of the “invention” having the battery assembly and atomizer

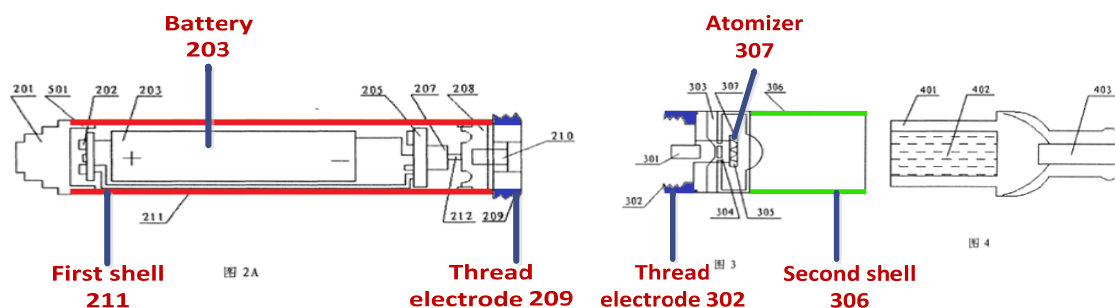
problem with a “substitute” specification that substantially re-wrote and attempted to significantly broaden the written description of the originally described invention.

assembly located in separate shells. *See, e.g., Anascape, Ltd. v. Nintendo of Am., Inc.*, 601 F.3d 1333, 1339 (Fed. Cir. 2010) (“A patentee is not deemed to disclaim every variant that it does not mention. However, neither is a patentee presumed to support variants that are not described.”); *PowerOasis, Inc.*, 522 F.3d at 1306 (“Entitlement to a filing date does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed.”) (citations omitted).

The lack of written description support in the parent ‘818 application for broad claims 2 and 3 of the ‘742 patent is illustrated by the following sequence of events:

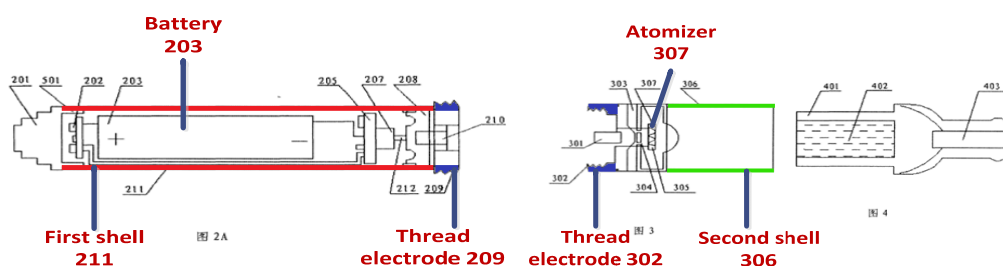
May 16, 2006: The Applicant filed a Chinese priority application, CN 200620090805.0, Ex. 1003; English translation, Ex. 1004. In relevant part, the Chinese priority application describes an electronic cigarette where the battery assembly and the atomizer assembly are located in separate shells. As illustrated in the annotated figures below, the battery assembly is located in a “first shell” 211, the atomizer assembly is located in a “second shell” 306, and a cigarette liquid bottle 401 is located in a third piece, a cigarette bottle assembly. Ex. 1004 at 4:37-40; 5:16-17, 29-30; Ex. 1003 at Figs. 2A, 3-4. The first and second shells are “connected through the thread electrode” (*see* 209, 302), and the cigarette bottle

assembly is plugged into an end of “second shell” 306. Ex. 1004 at 4:32-34; 5:30-32; Ex. 1003 at Figs. 2A, 3-4.



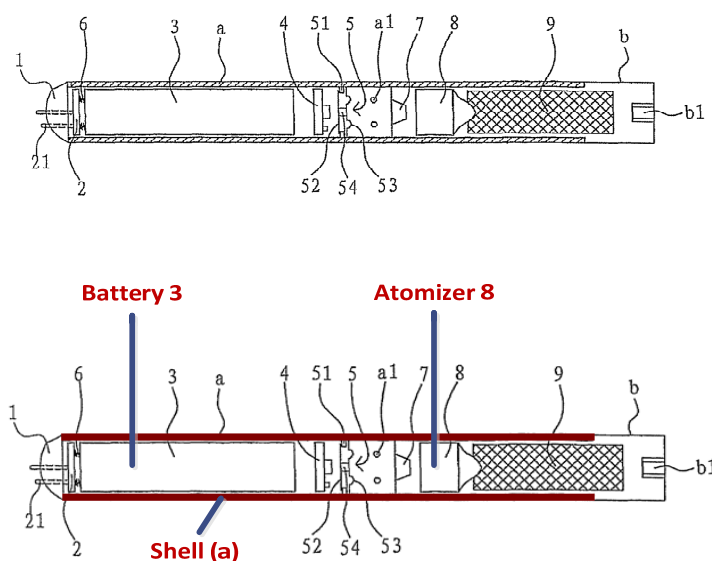
May 15, 2007: The Applicant filed two PCT applications claiming priority to the above-referenced Chinese application, PCT/CN2007/001575 (“PCT ‘575”; Ex. 1005; English translation, Ex. 1006) and PCT/CN2007/001576 (“PCT ‘576”; Ex. 1007; English translation, Ex. 1008). However, the disclosures of PCT ‘575 and PCT ‘576 are materially different.

Consistent with the Chinese priority application, the PCT ‘576 (see figures below), describes an electronic cigarette in which the battery assembly and the atomizer assembly are located in separate shells. Ex. 1008 at Figs. 2A, 3-4.



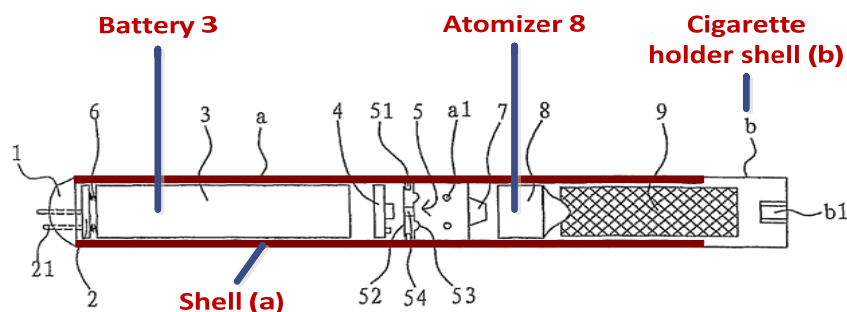
The ‘742 patent does not claim priority to PCT ‘576. Ex. 1001 at 1.

In contrast to the Chinese priority application, the PCT ‘575 (see figures below), which the Applicant later nationalized as the parent ‘818 application, describes and illustrates the “invention” as an electronic cigarette having a one-piece shell (*i.e.*, shell (a)) in which both the battery assembly and the atomizer assembly are located. Ex. 1005 at Fig. 1.



October 29, 2008: Seeking patent protection for the electronic cigarette described in PCT ‘575, the Applicant nationalized PCT ‘575, which became the parent ‘818 application. Ex 1009. Although the Application Data Sheet claims priority to the Chinese priority application (*Id.* at 4), the Applicant did not amend the specification to include disclosure from the Chinese priority application into the parent ‘818 specification. The Applicant also submitted a Preliminary Amendment adding new claims. *Id.* at 6-11. Consistent with the written description of the parent ‘818 application, sole independent claim 1 (and the other

claims by virtue of their dependency) required that “the said battery assembly connects with the said atomizer assembly and both are located in the said shell (a).” *Id.* at 7; 27 (Fig. 1).



The parent ‘818 application further states that “the purpose of this invention” is to simplify the “complicated” three-section structure of the prior art electronic cigarettes, and that a “benefit” of the “invention” is that there is “just one connection between two parts” (*i.e.*, between one-piece shell (a) and cigarette holder shell (b)):

“The electronic cigarettes currently available on the market . . . are **complicated** in structure. Their cigarette bodies can be roughly divided into **three sections, which have to be connected through via plugging or thread coupling before use.**”²

Ex. 1009 at 13, last paragraph.

“The purpose of **this invention** is fulfilled with the following technical solution: an aerosol electronic cigarette includes a battery

² Emphasis added unless otherwise noted.

assembly, an atomizer assembly and a cigarette bottle assembly, and also includes **a shell**, which is hollow and integrally formed. The **said battery assembly connects with said atomizer assembly and both are located in said shell.**”

Id. at 14, 2nd paragraph.

“This invention **will bring the following benefits: . . . (2)** For this invention, **the** battery assembly and atomizer assembly are directed installed inside the shell, **and** then connected with the cigarette bottle assembly. That is, there is just one connection between two parts, resulting in a very simple structure. **For use or change, you just need to plug the cigarette holder into the shell, providing great convenience.**”

Ex. 1009 at 16, last paragraph.

In order for there to be “just one connection between two parts” between the shell and the cigarette bottle assembly, the shell in which the battery assembly and the atomizer assembly are installed must be a one-piece shell. *See also id.* at 17 and 27 (Figures 1 and 2 illustrating “**the electronic cigarette of this invention**” as including a one-piece shell (a) in which both the battery assembly and atomizer assembly are located); 18-19 (“As shown in Figure 1-10, this utility model provides an aerosol electronic cigarette, which includes a battery assembly, an

atomizer assembly and a cigarette bottle assembly, and also **includes a shell (a), which is hollow and integrally formed. The battery assembly connects with the atomizer assembly and both are located in the shell.**”); 20 (“Of this embodiment, **the battery assembly and atomizer assembly are mutually connected and then installed inside the integrally formed shell (a) to form a one-piece part.**”); 23 (claim 1); 31 (Figure 19 illustrating one-piece shell (a)).

April 5, 2011: The Applicant filed the ‘937 application (which matured into the ‘742 patent) as a divisional of the parent ‘818 application. Ex. 1010; Ex. 1001 at 1. The Applicant also submitted a Preliminary Amendment amending the specification to “incorporate[] by reference” the parent ‘818 application, the PCT ‘575 application, and the Chinese priority application. Ex. 1010 at 6. The Applicant canceled claims 1-29, and added new application claim 30, which required “a shell that is hollow and integrally formed: the said battery assembly connects with the said atomizer assembly, and both are located in the said shell.” *Id.* at 7.

August 7, 2012: During prosecution of the ‘937 application, the Applicant submitted a “substitute specification.” The substitute specification broadened the disclosure of the ‘937 application by deleting text that narrowly described the “invention” as an electronic cigarette having the battery assembly and atomizer assembly located in the same, one-piece shell. *See* Ex. 1011. The Applicant also

submitted new application claims 31 and 32 (which issued as claims 2 and 3, respectively, of the ‘742 patent) with commensurately broadened scope, reciting, *inter alia*, “a battery assembly and an atomizer assembly within a housing,” instead of in the same “said shell” or “said shell (a).” *Id.* at 4 (emphasis added).

These were broadening revisions. Nonetheless, the Applicant told the Examiner that the substitute specification merely “corrects various grammatical and punctuation errors” and “deletes extraneous and redundant content.” *Id.* at 2. But, that was not the case. The deletions to the specification were significant, and intended to broaden the “invention” from an electronic cigarette where the battery assembly and the atomizer assembly are located in the same one-piece shell to an invention where the battery assembly and atomizer assembly may be located in either the same or separate shells. *See Anascape Ltd.*, 601 F.3d at 1338 (“A description can be broadened by removing limitations. The limitation to a single input member capable of movement in six degrees of freedom was removed. . . and new claims were provided of commensurately broadened scope. This is classical new matter.”); *see also Verizon Servs. Corp. et al. v. Vonage Holdings Corp. et al.*, 503 F.3d 1295, 1308 (Fed. Cir. 2007) (“When a patent thus describes the features of the ‘present invention’ as a whole, this description limits the scope of the invention.”).

The broad scope of claims 2 and 3, which encompass an electronic cigarette with the battery assembly and atomizer assembly located in either the same or separate shells, does not have written description support in the parent ‘818 application, which narrowly describes the “invention” as an electronic cigarette where the battery assembly and the atomizer assembly are located together in the same one-piece shell. As such, claims 2 and 3 are not entitled to the filing date of the parent ‘818 application, and are therefore anticipated by the ‘311 publication under 35 U.S.C. § 102(b).³

³ There is no inconsistency with the parent ‘818 application (which was published as the ‘311 publication) anticipating, but not providing written description support, for claims 2 and 3 of the ‘742 patent. The parent ‘818 application’s disclosure of the battery/atomizer assemblies in the same shell anticipates but does not provide written description support for the broad claims that encompass an electronic cigarette where the battery/atomizer assemblies are either in the same or separate shells. *See Research Corp. Techs., Inc. v. Microsoft Corp.*, 627 F.3d 859, 872 (Fed. Cir. 2010) (broad claims of the ‘772 patent were not entitled to the priority date of the parent application, and, as a result, the patent that issued from the parent application anticipated those claims).

II. MANDATORY NOTICES UNDER 37 C.F.R. § 42.8(A)(1)

A. Real Party-in-Interest (§ 42.8(b)(1))

For purposes of 35 U.S.C. § 312(a)(2) and 37 C.F.R. § 42.8(b)(1) only, Petitioner, R.J. Reynolds Vapor Company, identifies the real parties-in-interest as R.J. Reynolds Vapor Company, RAI Strategic Holdings, Inc., RAI Innovations Company (the direct parent company of R.J. Reynolds Vapor Company and RAI Strategic Holdings, Inc.), R.J. Reynolds Tobacco Company, and RAI Services Company. Each of the foregoing entities is a direct or indirect wholly owned subsidiary of Reynolds American Inc. Although Petitioner does not believe that Reynolds American Inc. is a real party-in-interest (*see* Patent Trial Practice Guide 77 Fed. Reg., Vol. 77, No. 157 (2012) at 48759-60), Reynolds American Inc. and each of its other wholly owned subsidiaries (direct and indirect) nevertheless agree to be bound by any final written decision in these proceedings to the same extent as a real party-in-interest. *See* 35 U.S.C. § 315(e).

B. Related Matters (37 C.F.R. § 42.8(b)(2))

1. Related Matters

Petitioner is not aware of any reexamination certificates or pending prosecution concerning the ‘742 patent. Petitioner is a defendant in the following litigation involving the ‘742 patent: *Fontem Ventures B.V. et al. v. R.J. Reynolds Vapor Company*, No. 2:16-cv-02286 (C.D. Cal., filed April 4, 2016). Claims 2 and 3 of the ‘742 patent have been asserted against the Petitioner. Also, Petitioner filed

a petition for IPR, IPR2016-01268, challenging claims 2 and 3 of the ‘742 patent.

In addition to the foregoing, the Petitioner is aware of the following additional matters involving the ‘742 patent and other related matters listed in the tables below.

Pending Litigations and IPRs

Case Name	Filed
<i>Fontem Ventures BV et al. v. Nu Mark LLC</i> , 2-16-cv-02291(C.D. Cal.)	April 4, 2016
Petition for <i>Inter Partes</i> Review by NU MARK LLC, IPR2016-01303 (PTAB) (challenging claims 2-3 of the ‘742 patent)	June 28, 2016
<i>Nu Mark LLC v. Fontem Holdings 1 B.V.</i> , IPR2016-01307 (PTAB) (U.S. Patent No. 8,375,957)	June 28, 2016
<i>Nu Mark LLC v. Fontem Holdings 1 B.V.</i> , IPR2016-01309 (PTAB) (U.S. Patent No. 8,863,752)	June 28, 2016

Pending Patent Applications

Serial No.	Filed
U.S. Patent Application No. 13/740,011, which claims priority to the ‘742 patent	January 11, 2013
U.S. Patent Application No. 15/167,659, which claims priority to the ‘742 patent	May 27, 2016
U.S. Patent Application No. 15/167,690, which claims priority to the ‘742 patent	May 27, 2016
U.S. Patent Application No. 15/158,421, which claims priority to the same foreign application as does the ‘742 patent	May 18, 2016
U.S. Patent Re-Examination No. 95/002,235, which claims priority to the ‘742 patent	September 13, 2012

Terminated Litigations and Previous IPR Petitions

Case Name	Filed
<i>Fontem Ventures BV et al v. NJOY, Inc.</i> , No. 2:14-cv-01645 (C.D. Cal.)	March 5, 2014
<i>Fontem Ventures BV et al v. LOEC, Inc. et al</i> , No. 2:14-cv-01648 (C.D. Cal.)	March 5, 2014
<i>Fontem Ventures BV et al v. CB Distributors, Inc. et al</i> , No. 2:14-cv-01649 (C.D. Cal.)	March 5, 2014
<i>Fontem Ventures BV et al v. Vapor Corp.</i> , No. 2:14-cv-01650 (C.D. Cal.)	March 5, 2014
<i>Fontem Ventures BV et al v. FIN Branding Group, LLC et al</i> , No. 2:14-cv-01651 (C.D. Cal.)	March 5, 2014
<i>Fontem Ventures BV et al v. Ballantyne Brands, LLC</i> , No. 2:14-cv-01652 (C.D. Cal.)	March 5, 2014
<i>Fontem Ventures BV et al v. Spark Industries, LLC</i> , No. 2:14-cv-01653 (C.D. Cal.)	March 5, 2014
<i>Fontem Ventures BV et al v. Logic Technology Development LLC</i> , No. 2:14-cv-01654 (C.D. Cal.)	March 5, 2014
<i>Fontem Ventures BV et al v. VMR Products, LLC</i> , No. 2:14-cv-01655 (C.D. Cal.)	March 5, 2014
<i>JT International S.A. v. Fontem Holdings I B.V.</i> , IPR2015-01587 (PTAB) (challenging claims 1-3 of the '742 patent)	July 14, 2015
<i>VMR Products, LLC v. Fontem Holdings I B.V.</i> , IPR2015-00859 (PTAB) (challenging claims 1-3 of the '742 patent).	March 10, 2015
<i>CB Distributors, Inc. v. Fontem Holdings I B.V.</i> , IPR2013-00387 (PTAB) (U.S. Patent No. 8,156,944)	June 27, 2013
<i>Logic Technology Development, LLC v. Fontem Holdings I B.V.</i> , IPR2015-00098 (PTAB) (U.S. Patent No. 8,375,957)	October 21, 2014
<i>NJOY, Inc. v. Fontem Holdings I B.V.</i> , IPR2015-01301 (PTAB) (U.S. Patent No. 8,863,752)	May 29, 2015
<i>JT International S.A. v. Fontem Holdings I B.V.</i> , IPR2015-01513 (PTAB) (U.S. Patent No. 8,375,957)	June 26, 2015
<i>JT International S.A. v. Fontem Holdings I B.V.</i> , IPR2015-01604 (PTAB) (U.S. Patent No. 8,863,752)	July 20, 2015

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D. Service Information

Service of any documents via hand delivery, express mail or regular mail may be made to the lead and backup counsel at the postal mailing address above. Petitioner also consents to service by email at the above-designated email addresses.

III. GROUNDS FOR STANDING

As required by 37 C.F.R. § 42.104(a), Petitioner certifies that the ‘742 Patent is available for *inter partes* review and that Petitioner is not barred or estopped from requesting *inter partes* review on the grounds identified herein.

IV. IDENTIFICATION OF CHALLENGE AND STATEMENT OF THE PRECISE RELIEF REQUESTED (37 C.F.R. § 42.104 (B))

Ground 1: Claims 2 and 3 of the ‘742 patent are unpatentable under 35 U.S.C. § 102 (pre-AIA) as anticipated by U.S. Pat. Pub. No. 2009/0095311 (“the ‘311 publication,” Ex. 1002). Claims 2 and 3 of the ‘742 patent are not entitled to a priority date earlier than April 17, 2010, and therefore, the ‘311 publication, which was published on April 16, 2009, qualifies as prior art under § 102(b).

This Petition is accompanied by the Declaration of Dr. Robert Sturges (“Sturges Decl.”). Ex. 1012.

Statement of Non-Redundancy: On July 2, 2016, Petitioner filed another Petition for IPR on the ‘742 patent (IPR2016-01268). The present Petition is not redundant of the ground presented in the previously filed petition, which assumed without conceding that claims 2 and 3 are entitled to the priority of the filing date of PCT/CN2007/001575, and which asserts unpatentability under 35 U.S.C. § 103. In contrast, the present Petition asserts one ground of unpatentability under § 102(b) and alleges that claims 2 and 3 are not entitled to a priority date any earlier than April 17, 2010.

V. THRESHOLD REQUIREMENT FOR *INTER PARTES* REVIEW

This Petition meets the threshold requirement for *inter partes* review because it establishes “a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). For the ground of unpatentability proposed below, there is a reasonable likelihood that Petitioner will prevail with respect to at least one of the challenged claims.

VI. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

A. Summary of the Argument

Claims 2 and 3 of the ‘742 patent are not entitled to the priority date of the parent ‘818 application because the parent application does not provide written description support for “a battery assembly and an atomizer assembly within a housing.” Ex. 1001 at 6:27-52. Rather than describing the broadly claimed “housing,” which encompasses the battery assembly and the atomizer assembly located in either the same or separate shells of the “housing,” the parent ‘818 application narrowly describes the “invention” as one in which the battery and atomizer assemblies are located together in the same, one-piece shell. With respect to the “invention,” no other structure for the battery assembly and the atomizer assembly is described in the parent ‘818 application. Accordingly, claims 2 and 3 are broader than the invention described in the parent ‘818 application, and thus are not entitled to its October 29, 2008 filing date. Thus, the published parent

application (*i.e.*, the ‘311 publication, Ex. 1002), which discloses an electronic cigarette that is within the scope of the broadly claimed invention of claims 2 and 3, is invalidating prior art under 35 U.S.C. § 102(b).

Accordingly, Petitioner respectfully requests that the Board find that claims 2 and 3 of the ‘742 patent are invalid under 35 U.S.C. § 102(b).

B. Background of the ‘742 Patent

The ‘742 patent is generally directed to an electronic cigarette.

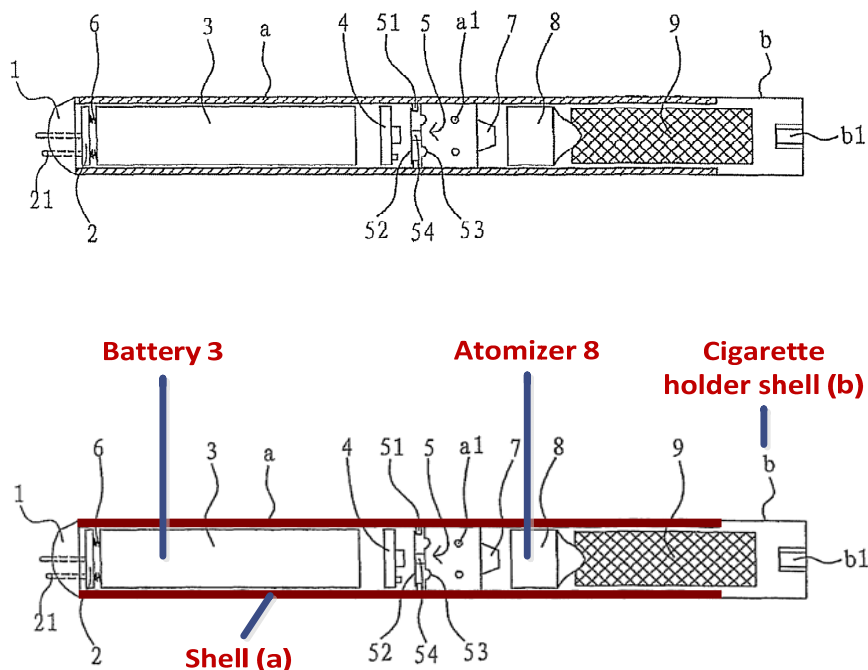


Fig. 1

With respect to Figure 1, the electronic cigarette includes a “shell or housing (a), which is hollow and integrally formed. The battery assembly (which may include battery 3, operating indicator 1, electronic circuit board 4, and airflow sensor 5, which are connected to the battery) connects with the atomizer assembly

8, and both are located in the shell.” Ex. 1001 at 2:30-42. “[T]he cigarette bottle assembly includes a hollow cigarette holder shell (b), and a perforated component for liquid storage (9) inside the shell (b).” *Id.* at 3:49-51. “One end of the cigarette hold shell (b) plugs into the shell (a).” *Id.* at 3:57-58. When shell (b) is plugged into shell (a), the cigarette bottle assembly is located in one end of shell (a), and is detachable from shell (a). *Id.* at 2:35-36. The atomizer assembly 8 has a porous component that contacts the liquid storage 9 in the cigarette bottle assembly to achieve capillary transport of liquid from the cigarette bottle assembly to the atomizer assembly 8. *Id.* at 4:37-40. The liquid from the cigarette bottle assembly is heated and atomized in the atomizer assembly 8. *Id.* at 4:9-25.

C. Person Having Ordinary Skill in the Art (“PHOSITA”)

The PHOSITA is a hypothetical person who is presumed to know the relevant prior art. Factors that guide the determination of level of ordinary skill in the art may include: the education level of those working in the field, the sophistication of the technology, the types of problems encountered in the art, the prior art solutions to those problems, and the speed at which innovations are made may help establish the level of skill in the art.

The PHOSITA for the ‘742 patent at the time of the alleged invention would have had at least the equivalent of a Bachelor’s degree in electrical engineering, mechanical engineering, or biomedical engineering or related fields, along with at

least 5 years of experience designing electromechanical devices, including those involving circuits, fluid mechanics, and heat transfer. Ex. 1012 at ¶¶ 15-16.

D. Claim Construction

Pursuant to 37 C.F.R. § 42.100(b), a claim in an unexpired patent is given its broadest reasonable construction in light of the specification in which it appears.

In re Cuozzo Speed Techs., LLC, 793 F.3d 1268, 1278-79 (Fed. Cir. 2015), *aff'd* *Cuozzo Speed Techs. v. Lee*, 579 U.S. ____ (2016).

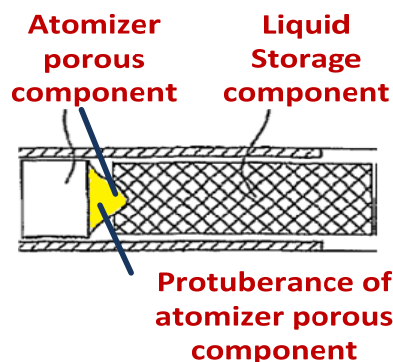
“frame”: In IPR2015-00859 the Board construed the claim term “frame” under the applicable BRI standard to mean “rigid structure.” Ex. 1013, Paper 9 at pp. 7-8. Petitioner applies the Board’s construction for purposes of this Petition.

“porous component”: In IPR2015-00859, the Board construed the claim term “porous component” under the applicable BRI standard to mean “a component of the atomizer assembly in the electronic cigarette that includes pores and is permeable to liquid, such as cigarette solution from the cigarette solution storage area.” *Id.* at 10. Petitioner applies the Board’s construction for purposes of this Petition.

“a battery assembly and an atomizer assembly within a housing”: The limitation “a battery assembly and an atomizer assembly within a housing” (*i.e.*, “the housing limitation”) appears in both challenged claims. In a prior wave of litigations, the Patent Owner asserted that “housing” required no construction, or

alternatively, means “a casing.” The Defendants contended that “housing” means “a one-piece shell.” The district court ruled that “housing” “need not be construed, other than to specify that it need not be a ‘one-piece shell.’” *Fontem Ventures B.V. et al. v. NJOY, Inc. et al.*, No. 2:14-cv-01645 (C.D. Cal., filed March 5, 2014). Ex. 1014, Rulings on Claims Construction (DI-65) at 8-10. For purposes of this Petition, and under the BRI claim construction standard applicable here, Petitioner construes “housing” consistent with the district court’s ruling that the term “housing” is not limited to “a one-piece shell.”

“the porous component substantially surrounded by the liquid storage component”: The specification of the ‘742 patent does not expressly define this limitation, it having been added during prosecution. Ex. 1011 at 4. However, Fig. 1 of the ‘742 patent (annotated below) illustrates that the protuberance/bulge 812 in the atomizer assembly’s porous component is in physical contact with liquid storage 9 for liquid transfer from the liquid storage to the porous component. Ex. 1001 at Fig. 1; 3:16-19.



For purposes of this Petition, Petitioner construes “porous component substantially surrounded by the liquid storage component” under the BRI standard applicable here to encompass the above-illustrated preferred structure described in Fig. 1 the ‘742 patent.

E. U.S. 2009/0095311 ANTICIPATES CLAIMS 2-3 OF THE ‘742 PATENT

Claims 2-3 of the ‘742 patent are anticipated by U.S. 2009/0095311 (Ex. 1002; “the ‘311 publication”). The ‘311 publication was published on April 16, 2009, which is more than one year prior to the filing date of the ‘742 patent. As shown in the claim chart below, and as further explained in the accompanying Declaration of Dr. Sturges, the ‘311 publication discloses each and every limitation of claims 2-3. *See* Ex. 1012 at ¶¶ 21-39.

The preamble of claim 2 recites “[a]n electronic cigarette.” To the extent that the preamble is considered a claim limitation, the ‘311 publication discloses an electronic cigarette.

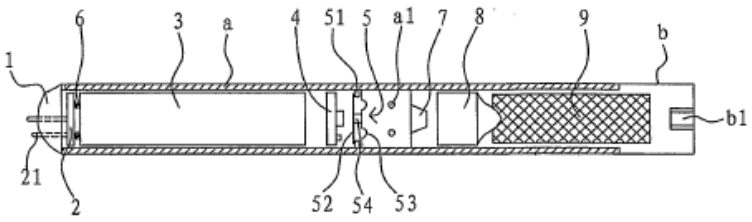
Claim 2	The ‘311 publication
An electronic cigarette, comprising:	“The present invention relates to an electronic cigarette, in particular, an aerosol electronic cigarette that doesn't contain tar but nicotine.” Ex. 1002 at para. [0001], ll. 1-3. “FIG. 1 is the side section view of the electronic cigarette of this invention.” Ex. 1002 at para. [0038], ll. 1-2.

Claim 2 recites “a battery assembly and an atomizer assembly within a housing with the battery assembly electrically connected to the atomizer assembly.” The ‘311 publication discloses a battery assembly (“the battery, and the operating indicator (1), electronic circuit board (4), and airflow sensor (5), which are connected with the battery”) and an atomizer assembly (“an atomizer (8), which includes a porous component (81) and a heating rod (82)”) within a housing (“shell (a)”). Ex. 1002 at para. [0064], ll. 1-4; [0066], ll. 1-3. As shown in Figs. 20 and 21, the battery assembly is electrically connected to the atomizer assembly. Ex. 1002 at para. [0071], ll. 15-19; Figs. 20 and 21.

Claim 2	The ‘311 publication
a battery assembly and an atomizer assembly within a housing with the battery assembly electrically connected to the atomizer assembly;	<div data-bbox="623 1003 1370 1213" data-label="Image"> </div> <p data-bbox="548 1222 824 1264">Ex. 1002 at Fig. 1.</p> <div data-bbox="623 1318 1370 1738" data-label="Diagram"> </div> <p data-bbox="548 1793 750 1835"><i>Id.</i> at Fig. 20.</p>

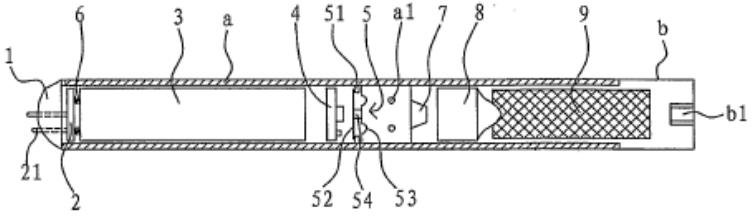
	<p>“The purpose of this invention is fulfilled with the following technical solution: an aerosol electronic cigarette includes a battery assembly, an atomizer assembly ..., and also includes a shell.... The said battery assembly connects with the said atomizer assembly ...” <i>Id.</i> at para. [0008], ll. 1-7; Figs. 1-2, 20-21.</p> <p>“As shown in FIG. 1-10, this utility model provides an aerosol electronic cigarette, which includes a battery assembly, an atomizer assembly and a cigarette bottle assembly, and also includes a shell (a) ...” <i>Id.</i> at para. [0063], ll. 1-5.</p> <p>“In this specific embodiment, the battery assembly includes the battery, and the operating indicator (1), electronic circuit board (4), and airflow sensor (5), which are connected with the battery.” <i>Id.</i> at para. [0064], ll. 1-4.</p> <p>“As shown in FIG. 5-8, the atomizer assembly is an atomizer (8), which includes a porous component (81) and a heating rod (82).” <i>Id.</i> at para. [0066], ll. 1-3.</p> <p>“Thus, the rechargeable battery (3) starts to electrify the electric heating rod (82) inside the atomizer (8).” <i>Id.</i> at para. [0071], ll. 15-19.</p>
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Claim 2 recites “a liquid storage component in the housing.” The ‘311 publication discloses a liquid storage component (“a perforated component for liquid storage (9)”) in the housing (“shell (a)”). Ex. 1002 at para. [0070], ll. 1-3; Figs. 1, 3-4.

Claim 2	The '311 publication
a liquid storage component in the housing;	 <p>Ex. 1002 at Fig. 1.</p> <p>“As shown in 3 and 4, the cigarette bottle assembly includes a hollow cigarette holder shell (b), and a perforated component for liquid storage (9) inside the shell (b).” <i>Id.</i> at para. [0070], ll. 1-3; Figs. 1, 3-4.</p>

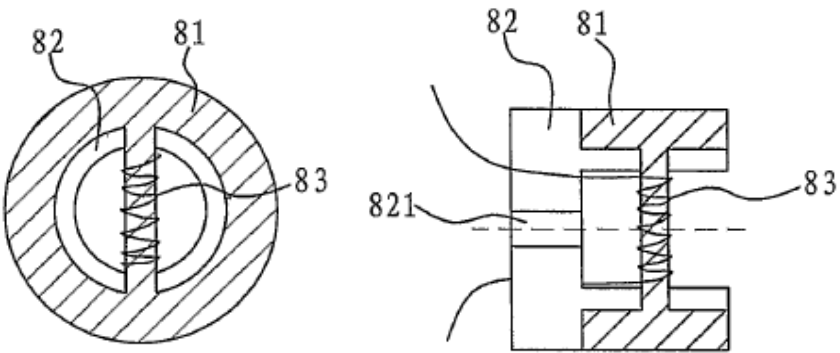
Claim 2 recites “with the housing having one or more through-air-inlets.”

The ‘311 publication discloses the housing (“shell (a)”) having one or more through-air-inlets (“through-air-inlets (a1)”). Ex. 1002 at para. [0063], l. 9; Figs. 1-2, 19.

Claim 2	The '311 publication
with the housing having one or more through-air-inlets;	 <p>Ex. 1002 at Fig. 1.</p> <p>“The shell has through-air-inlets (a1).” <i>Id.</i> at para. [0063], l. 9; Figs. 1-2, 19.</p>

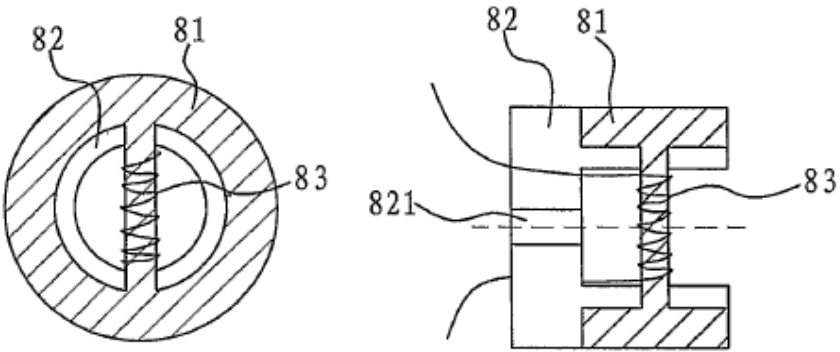
Claim 2 recites “the atomizer assembly including a porous component supported by a frame having a run-through hole.” The ‘311 publication discloses

the atomizer assembly including a porous component (“the porous component (81)”) supported by a frame (“a frame (82)”) having a run-through hole (“a run-through hole (821)” extending through the frame). Ex. 1002 at para. [0078], ll. 1-6; Figs. 17-18.

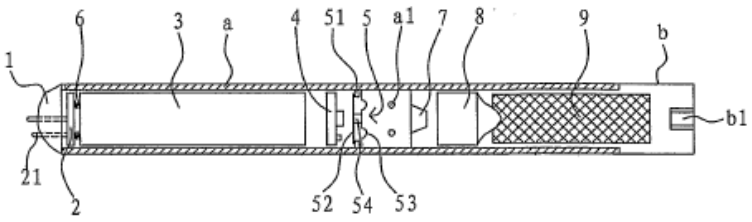
Claim 2	The ‘311 publication
the atomizer assembly including a porous component supported by a frame having a run-through hole;	 <p>Ex. 1002 at Figs. 17-18.</p> <p>“In the fifth preferred embodiment of this utility model, as shown in FIGS. 17 and 18, the atomizer assembly is an atomizer (8), which includes a frame (82), the porous component (81) set on the frame (82), and the heating wire (83) wound on the porous component (81). The frame (82) has a run-through hole (821) on it.” <i>Id.</i> at para. [0078], ll. 1-6.</p>

Claim 2 recites “a heating wire wound on a part of the porous component in the path of air flowing through the run-through hole.” The ‘311 publication discloses a heating wire (“heating wire (83)”) wound on a part of the porous component (“the porous component (81)”) in the path of air flowing through the

run-through hole (“a run-through hole (821)”). Ex. 1002 at para. [0078], ll. 6-8; Figs. 17-18.

Claim 2	The ‘311 publication
a heating wire wound on a part of the porous component in the path of air flowing through the run-through hole; and	 <p>Ex. 1002 at Figs. 17-18.</p> <p>“The porous component (81) is wound with heating wire (83) in the part that is on the side in the axial direction of the run-through hole (821).” <i>Id.</i> at para. [0078], ll. 6-8; Figs. 17-18.</p>

Claim 2 recites “the porous component substantially surrounded by the liquid storage component.” The ‘311 publication discloses the porous component (“the porous component (81)”) substantially surrounded by the liquid storage component (“a perforated component for liquid storage (9)”). Ex. 1002 at para. [0071], ll. 1-4; [0078], ll. 8-10; Figs. 1-2, 17-19.

Claim 2	The ‘311 publication
the porous component substantially surrounded by the liquid storage component.	 <p>Ex. 1002 at Fig. 1.</p> <p>“As shown in FIG. 1-9, one end of the porous component (81) lies against one end surface of the said perforated component for liquid storage (9), and contacts the perforated component for liquid storage (9).” <i>Id.</i> at para. [0071], ll. 1-4; Figs. 1-2, 17-19.</p> <p>“One end of the porous component (81) fits with the cigarette bottle assembly.” <i>Id.</i> at para. [0078], ll. 8-10.</p>

The preamble of claim 3 recites “[a]n electronic cigarette.” To the extent that the preamble is considered a claim limitation, the ‘311 publication discloses an electronic cigarette.

Claim 3	The ‘311 publication
An electronic cigarette, comprising:	<p>“The present invention relates to an electronic cigarette, in particular, an aerosol electronic cigarette that doesn't contain tar but nicotine.” Ex. 1002 at para. [0001], ll. 1-3.</p> <p>“FIG. 1 is the side section view of the electronic cigarette of this invention.” Ex. 1002 at para. [0038], ll. 1-2.</p>

Claim 3 recites “a battery assembly and an atomizer assembly within a housing with the battery assembly electrically connected to the atomizer assembly.” The ‘311 publication discloses a battery assembly (“the battery, and

the operating indicator (1), electronic circuit board (4), and airflow sensor (5), which are connected with the battery”) and an atomizer assembly (“an atomizer (8), which includes a porous component (81) and a heating rod (82)”) within a housing (“shell (a)”). *Id.* at para. [0064], ll. 1-4; [0066], ll. 1-3. As shown in Figs. 20 and 21, the battery assembly is electrically connected to the atomizer assembly. *Id.* at para. [0071], ll. 15-19; Figs. 20 and 21.

Claim 3	The ‘311 publication
<p>a battery assembly and an atomizer assembly within a housing with the battery assembly electrically connected to the atomizer assembly;</p>	<div data-bbox="625 745 1372 955" data-label="Image"> </div> <p>Ex. 1002 at Fig. 1.</p> <div data-bbox="625 1060 1372 1480" data-label="Diagram"> </div> <p><i>Id.</i> at Fig. 20.</p> <p>“The purpose of this invention is fulfilled with the following technical solution: an aerosol electronic cigarette includes a battery assembly, an atomizer assembly ..., and also includes a shell.... The said battery assembly connects with the said atomizer assembly ...” <i>Id.</i> at para. [0008], ll. 1-7; Figs. 1-2, 20-21.</p>

	<p>“As shown in FIG. 1-10, this utility model provides an aerosol electronic cigarette, which includes a battery assembly, an atomizer assembly and a cigarette bottle assembly, and also includes a shell (a) ...” <i>Id.</i> at para. [0063], ll. 1-5.</p> <p>“In this specific embodiment, the battery assembly includes the battery, and the operating indicator (1), electronic circuit board (4), and airflow sensor (5), which are connected with the battery.” <i>Id.</i> at para. [0064], ll. 1-4.</p> <p>“As shown in FIG. 5-8, the atomizer assembly is an atomizer (8), which includes a porous component (81) and a heating rod (82).” <i>Id.</i> at para. [0066], ll. 1-3.</p> <p>“Thus, the rechargeable battery (3) starts to electrify the electric heating rod (82) inside the atomizer (8).” <i>Id.</i> at para. [0071], ll. 15-19.</p>
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Claim 3 recites “with the housing having one or more through-air-inlets and an outlet.” The ‘311 publication discloses the housing (“shell (a)”) having one or more through-air-inlets (“through-air-inlets (a1)”) and an outlet (“an air channel (b1)”). Ex. 1002 at para. [0063], l. 9; para. [0070], ll. 12-14; Figs. 1-2, 19. The air flows into through-air-inlets (a1) through the electronic cigarette and out air channel (b1). Ex. 1002 at para. [0071], ll. 19-36.

Claim 3	The ‘311 publication
with the housing having one or more through-air-inlets and an outlet;	

	<p>Ex. 1002 at Fig. 1.</p> <p>“The shell has through-air-inlets (a1).” <i>Id.</i> at para. [0063], l. 9; Figs. 1-2, 19.</p> <p>“On one end surface of the cigarette holder shell (b), there is an air channel (b1) extending inward. The air channel (b1) is located in the center on the surface of one end of shell (b).” <i>Id.</i> at para. [0070], ll. 12-14; Figs. 1-2, 19.</p> <p>“The air enters the normal pressure cavity through the air inlet (a1), passes the check valve (7) via the airflow passage in the airflow sensor (5), and flows to the negative pressure cavity (83) in the atomizer (8). Since the negative pressure cavity (83) provides the negative pressure compared with the outside, the air flow sprays into it, bringing the cigarette liquid from the porous component (81) to spray into the negative pressure cavity (83) in the form of fine drips. In the meantime, the electric heating rod (82) is electrified by the rechargeable battery (3) under the control of electronic circuit board (4), to heat the fine drips for atomization. After atomization, the big-diameter fine drips are re-absorbed by the porous component (81) under the action of vortex, while the small-diameter fine drips are suspended in the airflow to form gasoloid, which is discharged through the negative pressure cavity (83) and run-through hole (813), flows into the cigarette holder shell (b) of the cigarette bottle assembly, and is absorbed by the air channel (b1).” <i>Id.</i> at para. [0071], ll. 19-36</p>
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Claim 3 recites “the atomizer assembly includes a frame having a run through hole, and a porous component between the frame and the outlet.” The ‘311 publication discloses the atomizer assembly includes a frame (“a frame (82)”) having a run through hole (“a run-through hole (821)”), and a porous component

(“the porous component (81)”) between the frame (“a frame (82)”) and the outlet (“an air channel (b1)”). Ex. 1002 at para. [0078], ll. 1-6; Figs. 17-18.

Claim 3	The ‘311 publication
<p>the atomizer assembly includes a frame having a run through hole, and a porous component between the frame and the outlet;</p>	<div data-bbox="574 415 1409 760"> </div> <p>Ex. 1002 at Figs. 17-18.</p> <p>“In the fifth preferred embodiment of this utility model, as shown in FIGS. 17 and 18, the atomizer assembly is an atomizer (8), which includes a frame (82), the porous component (81) set on the frame (82), and the heating wire (83) wound on the porous component (81). The frame (82) has a run-through hole (821) on it.” <i>Id.</i> at para. [0078], ll. 1-6.</p>

Claim 3 recites “a heating wire wound on a part of the porous component which is substantially aligned with the run-through hole.” The ‘311 publication discloses a heating wire (“heating wire (83)”) wound on a part of the porous component (“the porous component (81)”) which is substantially aligned with the run-through hole (“a run-through hole (821)”). Ex. 1002 at para. [0078], ll. 6-8; Figs. 17-18.

Claim 3	The '311 publication
<p>a heating wire wound on a part of the porous component which is substantially aligned with the run-through hole; and</p>	<div data-bbox="574 241 1409 590"> </div> <p>Ex. 1002 at Figs. 17-18.</p> <p>“The porous component (81) is wound with heating wire (83) in the part that is on the side in the axial direction of the run-through hole (821).” <i>Id.</i> at para. [0078], ll. 6-8; Figs. 17-18.</p>

Claim 3 recites “with the porous component in contact with a liquid supply in the housing.” The ‘311 publication discloses the porous component (“the porous component (81)”) in contact with a liquid supply (“a perforated component for liquid storage (9)”) in the housing (“shell (a)”). Ex. 1002 at para. [0071], ll. 1-4; [0078], ll. 8-10; Figs. 1-2, 17-19.

Claim 3	The '311 publication
<p>with the porous component in contact with a liquid supply in the housing.</p>	<p>“As shown in FIG. 1-9, one end of the porous component (81) lies against one end surface of the said perforated component for liquid storage (9), and contacts the perforated component for liquid storage (9).” Ex. 1002 at para. [0071], ll. 1-4; Figs. 1-2, 17-19.</p> <p>“One end of the porous component (81) fits with the cigarette bottle assembly.” <i>Id.</i> at para. [0078], ll. 8-10.</p>

F. PRIORITY DATE OF CLAIMS 2 AND 3 OF THE ‘742 PATENT

As shown above, the ‘311 publication discloses each and every limitation of claims 2-3 of the ‘742 patent, and was published on April 16, 2009, which is more than one year before the filing date of the ‘742 patent (April 5, 2011). Thus, to avoid anticipation by the ‘311 publication under § 102(b), the Patent Owner has the burden of demonstrating that claims 2-3 are entitled to a priority date earlier than April 17, 2010. *See Research Corp. Techs., Inc.*, 627 F.3d at 870 (“The challenger has the burden of going forward with invalidating prior art The patentee then has the burden of going forward with evidence to the contrary, *i.e.*, the patentee must show that the prior art does not actually invalidate the patent or that it is not prior art because the asserted claim is entitled to the benefit of an earlier filing date.”) (citations omitted); *see also Core Survival, Inc. v. S & S Precision, LLC*, PGR2015-00022, Paper 8 (Feb. 19, 2016) at 8. As explained below, the Patent Owner cannot meet this burden because the only sufficiently early parent application of the ‘742 patent, namely, the parent ‘818 application (which was filed on October 29, 2008) does not provide written description support for the broad housing limitation of claims 2 and 3 of the ‘742 patent.

1. The Board May Rule on Priority Issues

It is within the Board’s statutory authority to rule on priority issues relating to whether an earlier application supports the issued claims of a later application.

See, e.g., Samsung Electronics Co., Ltd., et al. v. Affinity Labs. Of Texas, LLC, IPR2014-01181, Paper 36 (Final Written Decision, Jan. 28, 2016) at 49-54 (rejecting Patent Owner’s argument that the Board cannot determine whether the involved patent is entitled to the benefit of an earlier filing date and finding that challenged claims were not entitled to the parent application’s filing date); *Munchkin, Inc., et al. v. Luv N’ Care, Ltd.*, IPR2013-00072, Paper 28 (Final Written Decision, Apr. 21, 2014), *aff’d*, 599 Fed. Appx. 958 (Fed. Cir. 2015) (affirming PTAB decision that challenged claims were not entitled to earlier priority date of parent application).

2. Legal Standards

“[A] patent’s claims are not entitled to an earlier priority date merely because the patentee claims priority.” *In re NTP, Inc.*, 654 F.3d 1268, 1276-77 (Fed. Cir. 2011). “It is elementary patent law that a patent application is entitled to the benefit of the filing date of an earlier filed application only if the disclosure of the earlier application provides support for the claims of the later application, as required by 35 U.S.C. § 112.” *PowerOasis, Inc.*, 522 F.3d at 1306 (citations omitted). “To satisfy the written description requirement the disclosure of the prior application must convey with reasonably clarity to those skilled in the art that, as of the filing date sought, [the inventor] was in possession of the invention.” *Id.* at 1306 (citations omitted).

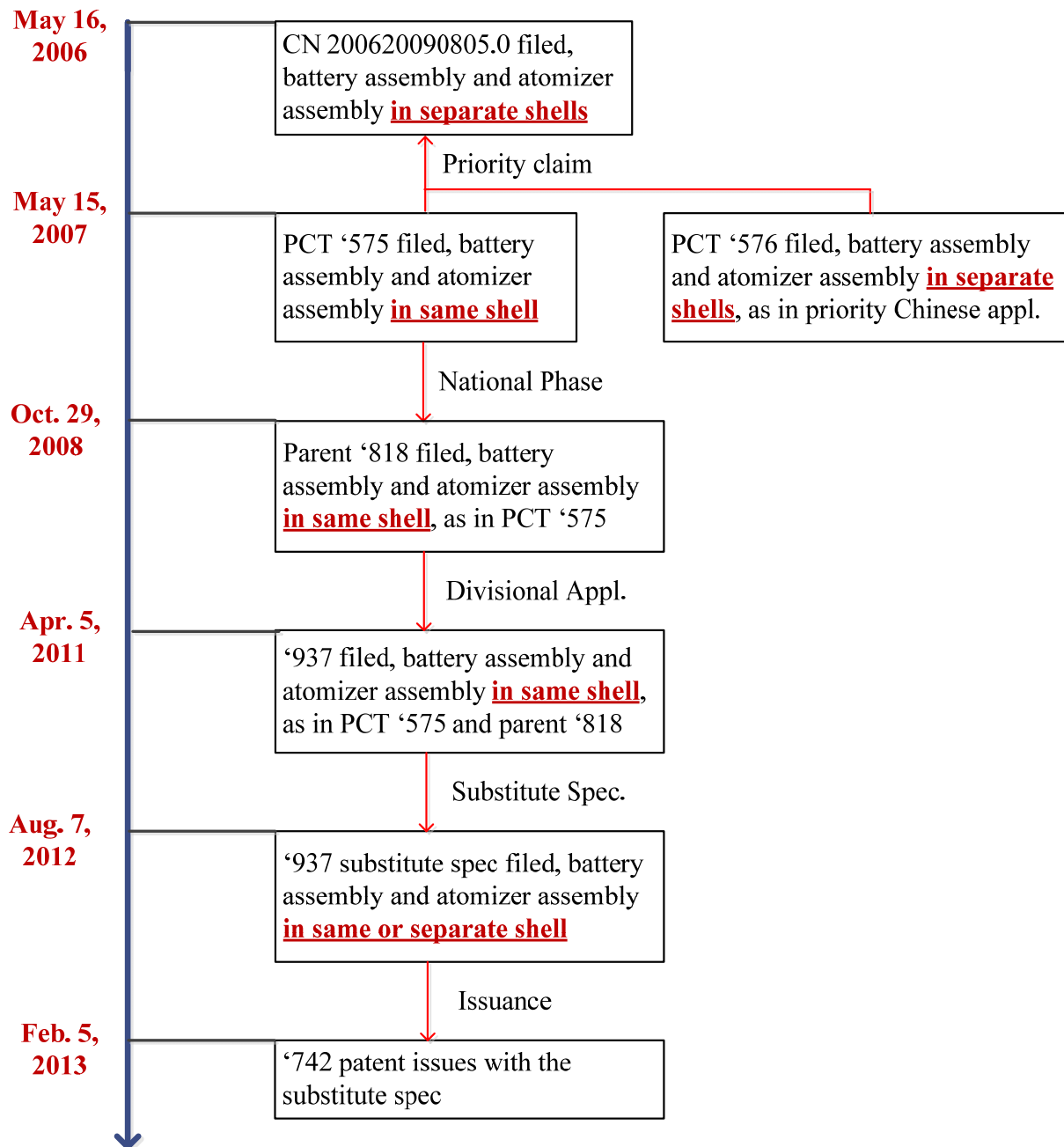
“It is not sufficient for purposes of the written description requirement of § 112 that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modification that the inventor might have envisioned, but failed to disclose.” *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). “The purpose of the written description requirement is to ensure that the scope of the right to exclude, as set forth in the claims, does not overreach the scope of the inventor’s contribution to the field of art as described in the patent specification.” *ICU Med., Inc. v. Alaris Med. Sys., Inc.*, 558 F.3d 1368, 1376 (Fed. Cir. 2009) (citations omitted). Thus, “[e]ntitlement to a filing date does to extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed.” *PowerOasis, Inc.*, 522 F.3d at 1306.

As the Federal Circuit has repeatedly confirmed, a narrow disclosure will not support later-filed broad claims. *See, e.g., Research Corps. Techs.*, 627 F.3d at 871-872 (later filed claims that were not limited to a “blue noise mask” not entitled to priority date of parent application which was “limited to a blue noise mask.”); *ICU Med.*, 558 F.3d at 1377-78 (“spikeless” claims “added years later during prosecution” were not supported by the specification which “describe[d] only medical valves with spikes.”); *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158-60 (Fed. Cir. 1998) (the claimed generically shaped cups not entitled to filing date of the parent application that “disclosed only a trapezoidal cup and nothing more.”).

The written description requirement is implicated when the applicant attempts during prosecution to broaden a later-in-time child disclosure in order to cover subject matter that is not described in the parent application. *See, e.g., PowerOasis, Inc.*, 522 F.3d at 1307-10 (“The 2000 CIP Application added language describing a vending machine with a user interface located remotely from the vending machine, such as on a user’s laptop. . . . Because none of this support was present in the [parent] Application and because the [parent] Application did not disclose a customer interface apart from the vending machine, the asserted claims are only entitled to the 2000 CIP Application filing date of June 15, 2000.”). Broadening can also occur when the applicant removes limiting language from the specification. *See, e.g., Anascape*, 601 F.3d at 1338-1341 (“A description can be broadened by removing limitations. The limitation to a single input member capable of movement in six degrees of freedom was removed, in filing the ‘700 application, and new claims were provided of commensurately broad scope. This is classical new matter. . . . [T]he district court erred in its ruling that, as construed, the broadened scope of the ‘700 claims is entitled to the filing date of the [parent] ‘525 patent.”).

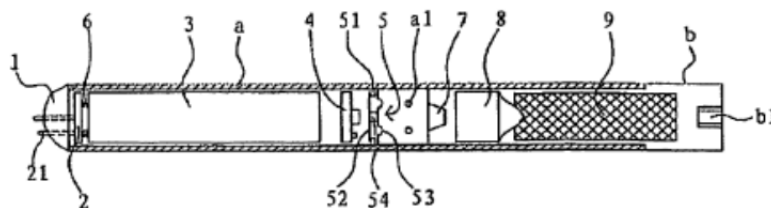
3. Statement of Facts

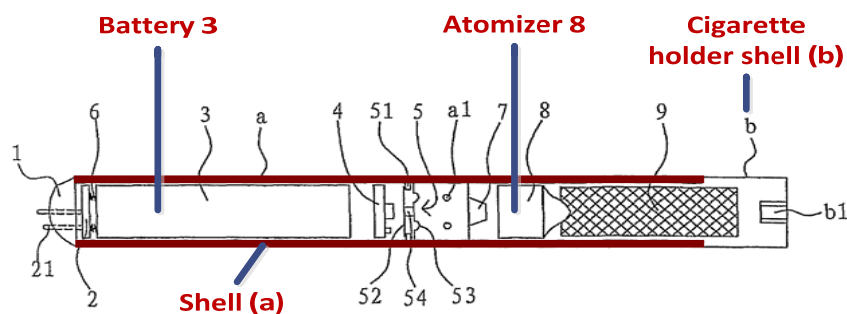
The '742 patent was filed on April 5, 2011, and claims priority to a Chinese patent application filed on May 16, 2006 through a chain of applications as illustrated in the figure below.



Claims 2 and 3 of the ‘742 patent require “a battery assembly and an atomizer assembly within a housing.” Ex. 1001 at 6:27-29, 6:40-41. In the complaint filed on April 4, 2016 in the Central District of California (Ex. 1016), the Patent Owner has alleged that an electronic cigarette having a battery assembly and an atomizer assembly located in separate shells falls within the scope of the “a battery assembly and an atomizer assembly within a housing” limitation of claims 2 and 3 of the ‘742 patent. Ex 1016, ¶¶ 26, 34. However, claims having a scope that encompasses an electronic cigarette with a battery assembly and the atomizer assembly located in separate shells lack written description support in, and thus are not entitled to the filing date of, the parent ‘818 application.

The Parent ‘818 Application: The ‘742 patent claims priority to serial no. 12/226,818 (Ex. 1009), which was filed on October 29, 2008, and published as the ‘311 publication on April 16, 2009 (Ex. 1002). The parent ‘818 application (and the corresponding ‘311 publication) describe, illustrate, and claim an “invention” where the battery assembly and the atomizer assembly are located together in the same, one-piece shell (a). Ex. 1012, ¶¶ 42-55.





Starting with the Abstract, the invention is described as “[a]n aerosol electronic cigarette includes ... a shell (a) which is hollow and integrally formed. Said battery assembly connects with said atomizer assembly and both are located in said shell (a). Said cigarette bottle assembly is located in one end of the shell (a), which is detachable.” Ex. 1009 at 12. The cigarette bottle assembly is detachably located in shell (a) via “the cigarette holder shell (b) [that] plugs into shell (a).” *Id.* at 20, 4th paragraph, l. 6.

The parent ‘818 application distinguishes the “simple structure” of the “invention” from the prior art, three-section electronic cigarettes that are “complicated in structure.” *Id.* at 13, last paragraph.

The parent ‘818 application repeatedly describes the “invention” as one in which the battery assembly and the atomizer assembly are located together in the same, one-piece shell.

Contents of the Invention (Ex 1009; parent ‘818 application)

“The purpose of **this invention** is fulfilled with the following technical solution: an aerosol electronic cigarette includes a battery

assembly, an atomizer assembly and a cigarette bottle assembly, and also **includes a shell, which is hollow and integrally formed. The said battery assembly connects with the said atomizer assembly and both are located in the said shell.**”⁴

Id. at 14, 2nd paragraph.

The parent ‘818 application also touts that a benefit of “this invention” is an electronic cigarette with a “very simple structure” that has “just one connection between two parts,” namely, between the shell (a) and cigarette holder shell (b).

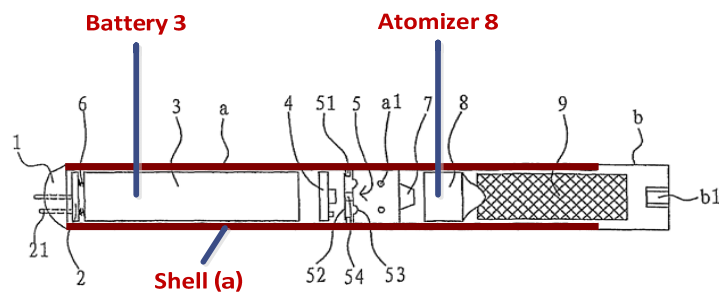
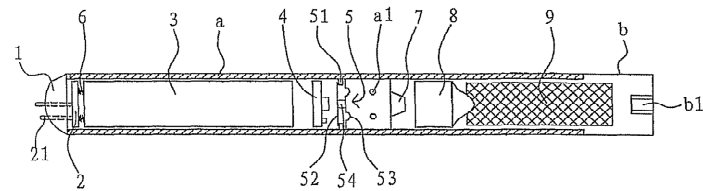
“**This invention** will bring the following benefits: . . . (2) **For this invention**, the battery assembly and atomizer assembly are directly installed inside **the shell**, and **then connected with the cigarette bottle assembly**. That is, **there is just one connection between two parts, resulting in a very simple structure**. For use or change, you just need to plug the cigarette holder into **the shell**, providing great convenience.”

Id. at 16, last paragraph.

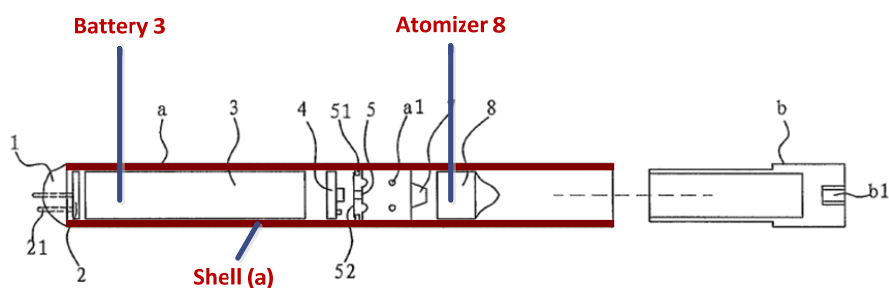
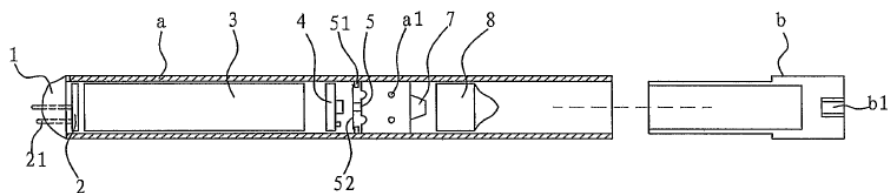
The Description of the Drawings refers to Figures 1-2 as schematics of the “electronic cigarette of **this invention**,” and both Figures 1 and 2 illustrate the “invention” as an electronic cigarette with a one-piece shell (a) in which both the

⁴ Emphasis added herein unless otherwise noted.

battery assembly and the atomizer assembly are located. *Id.* at 17; 27 (Figs. 1-2);
Ex. 1012, ¶¶ 46-47.



Ex. 1009 at 17, 27 (Fig. 1)



Ex. 1009 at 17, 27 (Fig. 2)

Every embodiment of the “invention” described in the Specific Mode for
Carrying Out The Invention of the parent ‘818 application contemplates a shell (a)

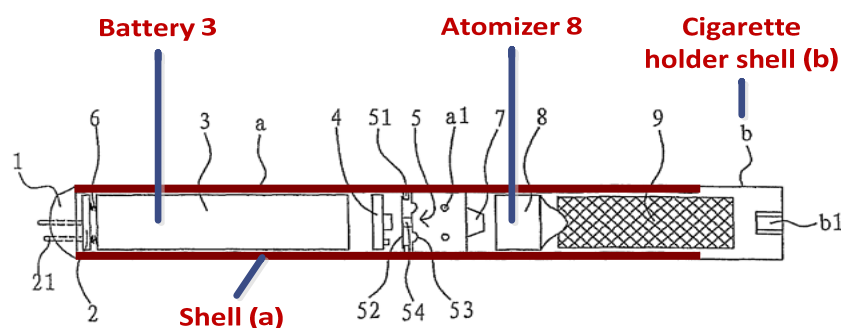
in which both the battery assembly and the atomizer assembly reside. Ex. 1009 at 18-22; Ex. 1012, ¶ 48.

Finally, the sole independent claim (and all of the dependent claims by virtue of their dependency from claim 1) requires “a shell (a) that is hollow and integrally formed; the said battery assembly connects with the said atomizer assembly and both are located in the said shell (a). . . .” Ex. 1009 at 23-26; Ex. 1012, ¶ 49.

There is no disclosure in the parent ‘818 application of an electronic cigarette having a structure other than a one-piece shell (*i.e.*, shell (a)) in which the battery assembly and the atomizer assembly reside. As Dr. Sturges opines, the parent ‘818 application does not convey to the PHOSITA that the inventor was in possession, at the time of the parent ‘818 application, of an electronic cigarette having a housing in which the battery assembly and the atomizer assembly are located in separate shells. Ex. 1012, ¶¶ 51-53.

In an effort to muster written description support in the parent ‘818 application for claims 2 and 3, Patent Owner may argue that the integrally formed shell (a) need not be a one-piece shell but could also be “integrally formed” from two separate yet connected pieces or shells, and thus the battery assembly may be located in one piece and the atomizer assembly located in the other. But any such argument is belied by the written description of the “invention” set forth in the

parent ‘818 application. The only disclosed shell for the battery assembly and atomizer assembly is a one-piece shell. As illustrated in Figures 1 and 2, the shell (a) of the “invention” is made from one piece, *i.e.*, it is a one-piece shell and not a shell formed from two separate yet connected pieces. Ex. 1012, ¶ 54. Moreover, shell (a) must necessarily be a one-piece shell in order to achieve the “benefit” of “this invention.” As the parent ‘818 application notes, the “invention” is an electronic cigarette in which “the battery assembly and atomizer assembly are directly installed inside the shell, and then connected with the cigarette bottle assembly.” Ex. 1009 at 16, last paragraph, ll. 5-6; Ex. 1012, ¶¶ 52-53. A “benefit” of the electronic cigarette of the “invention” having this structure is that there is “just one connection between two parts, resulting in a very simple structure.” The “just one connection” is between the shell (a) and the cigarette holder shell (b). Ex. 1009 at 16, last paragraph, l. 7; Ex. 1012, ¶¶ 52-53.



Ex. 1009 at 17, 27 (Fig. 1)

In order for the electronic cigarette of the “invention” to enjoy this “benefit,” the shell in which both the battery assembly and the atomizer assembly reside is

necessarily a one-piece shell. As the PHOSITA would have readily understood, if that shell (*i.e.*, shell (a)) were formed from two separate yet connected pieces, the resulting electronic cigarette would have two connections, and not “just one” between parts according to the “invention.” The first connection would be between separate pieces of shell (a), and then a second connection would be required between the shell (a) and the cigarette holder shell (b). Ex. 1012, ¶¶ 52-53. Indeed, such a configuration would result in an electronic cigarette with three sections, which the parent ‘818 application disparages as “complicated” with respect to the prior art electronic cigarettes. Ex. 1009 at 13, last paragraph.

4. Application Serial No. 13/079,937

The ‘937 application is a divisional of the parent ‘818 application, was filed on April 5, 2011, and issued as the ‘742 patent. Ex. 1010; Ex. 1001 at 1. The ‘937 application was accompanied by a preliminary amendment that, among other things, attempted to incorporate by reference new matter consisting of the applicant’s Chinese priority application. Ex. 1010 at 6.

On August 7, 2012, the Applicant submitted a substitute specification with substantial revisions, including numerous deletions that were aimed at broadening the disclosure to encompass an electronic cigarette in which the battery assembly and the atomizer assembly are located in separate shells. Ex. 1011 at 7-37 (substitute specification). In the Background Art, although continuing to disparage

the prior art electronic cigarettes as “complicated in structure,” the substitute specification deleted the one example of this complicated structure, namely, electronic cigarettes having bodies “divided into three sections, which have to be connected through via plugging or thread coupling before use.” *Id.* at 8, para. [0006].

The substitute specification also deleted from what became the Summary of Invention the reference to the “benefit” of the “invention” as an electronic cigarette having “just one connection between two parts,” (*i.e.*, between shell (a) and the cigarette holder shell (b)), which “result[s] in a very simple structure.” *Id.* at 14-15, para. [0037]. The Summary of Invention was also revised by deleting the reference to the battery assembly and the atomizer assembly residing together in the “same” integrally formed shell, and instead merely requires that the battery assembly and atomizer assembly are located in a “housing.” *Id.* at 9, para. [0008]. The substitute specification also revised the Description of Drawings, deleting every occurrence of the phrase “of this invention,” including by deleting “the electronic cigarette of this invention” with respect to Figures 1 and 2 which illustrate the electronic cigarette with a one-piece shell (a) in which both the battery assembly and the atomizer assembly are located. *Id.* at 15-18.

The Applicant also submitted a new set of claims, including application claims 31 and 32 (which matured as claims 2 and 3, respectively, of the ‘742

patent). *Id.* at 4; Ex. 1001 at 6:27-52. Attempting to take advantage of the broadened disclosure of the substitute specification, claims 31 and 32 eliminated the requirement found in the claims of the parent ‘818 application that the battery assembly and atomizer assembly are located together in “said” integrally formed shell (a), and instead merely required “a battery assembly and an atomizer assembly within a housing.” Ex. 1011 at 4.

In remarks accompanying the substitute specification, the Applicant stated that the substitute specification merely “corrects various grammatical and punctuation errors . . . and deletes extraneous and redundant content” *Id.* at 2. The Applicant’s revisions, however, were neither grammatical corrections nor the deletion of extraneous and redundant content. To the contrary, the substitute specification removed written description describing the “invention” as an electronic cigarette with a one-piece shell in which both the battery assembly and the atomizer assembly are located.⁵

⁵ It is not clear from the prosecution history whether the Examiner simply accepted the Applicant’s representations or, in the alternative, substantively considered the “substitute specification” for issues involving new matter and/or whether the new claims found written description support in the parent ‘818 application. *In re NPT, Inc.*, 654 F.3d at 1278-79 (“Whether an examiner considered an issue must

5. The Parent ‘818 Application Does Not Support the Broad “Housing” Limitation in Clams 2 and 3 of the ‘742 Patent

For the reasons stated in VI.F.3 *supra*, the written description of the parent ‘818 application is limited to an electronic cigarette that includes a one-piece shell in which both the battery assembly and the atomizer assembly are located. Ex. 1009; *see also* Ex. 1012, ¶¶ 42-54. The parent ‘818 application does not contemplate any other structure for the electronic cigarette of the “invention.” Ex. 1012, ¶¶ –50-54.

In an effort to obscure, the Patent Owner may argue that the parent ‘818 application does not limit the shell in which both the battery assembly and atomizer assembly are located to a *one-piece* shell. In other words, the Patent Owner may contend that the battery assembly and atomizer assembly may be located in separate pieces that are connected to form the “integrally formed” shell in which the battery assembly and atomizer assembly are located. However, as noted above, any such argument is belied by the parent ‘818 application’s description of the “invention.” The “integrally formed” shell must be a one-piece

be content-specific, and here, there is no evidence that the examiner actually considered whether the claims of the ‘592 Patent satisfy the requirements of § 112.”)

shell in order to achieve a “benefit” of the “invention,” namely, an electronic cigarette with “just one connection between two parts.”

The Patent Owner may also argue that the claimed “housing” can be two pieces, referring to shell (a) and cigarette holder shell (b) for support. But whether the housing can be formed from separate pieces is not the relevant issue. The relevant issue is that the parent ‘818 application describes the “invention” as an electronic cigarette including a one-piece shell (a) in which both the battery assembly and the atomizer assembly are located. Thus, although shells (a) and (b) may, together, comprise a “housing,” the “invention” described in the parent ‘818 application is limited to an electronic cigarette in which the battery assembly and the atomizer assembly are located in a one-piece shell (a) of a housing.

Finally, the Patent Owner may direct the Board to the district court’s ruling in the previous wave of litigations that the phrase “integrally formed” as used in claim 1 of the ‘742 patent means “formed by parts that make up a whole” (Ex . 1014 at 10). Thus, Patent Owner may contend that this necessarily means that “integrally formed” shell (a) described in the parent ‘818 application can be “integrally formed” from two separate yet connected pieces with the battery assembly in one piece and the atomizer assembly in the other. However, the Patent Owner’s reliance on the district court’s construction of “integrally formed” would

be misplaced because it is based upon the broadened disclosure of the ‘742 patent, and not the narrow disclosure of the ‘818 application.

The district court’s evaluation of “integrally formed” was based upon the disclosure of the ‘742 patent, which is broader than the disclosure of the parent ‘818 application. Indeed, this highlights a fundamental problem with the substitute specification. As noted above, the ‘742 patent is based upon the substitute specification, which substantially broadened the disclosure of the ‘818 parent application’s description of the invention. The substitute specification deleted disclosure that linked the “invention” to an electronic cigarette including a one-piece shell in which both the battery assembly and the atomizer assembly are located. Thus, the district court did not evaluate the meaning of “integrally formed” constrained by the limiting disclosure of the parent ‘818 application, but instead evaluated this phrase in the context of the broader disclosure found in the ‘742 patent. The district court’s interpretation of “integrally formed” in the context of the ‘742 patent is not particularly relevant to the meaning of this phrase in the context of the much narrower disclosure of the parent ‘818 application, other than to illustrate that the disclosure of the ‘742 patent is broader than that of the ‘818 application. As Dr. Sturges opines, in the context of the limiting written description of the parent ‘818 application, the PHOSITA would have understood

the shell in which both the battery assembly and atomizer assembly are located is a one-piece shell. Ex. 1012, ¶¶ 42-54.

The conclusion that claims 2 and 3 of the '742 patent lack written description support in the parent '818 application is further bolstered by three Federal Circuit decisions, which are discussed below. The facts in each of these cases are similar to those with respect to claims 2 and 3 of the '742 patent, and in each case, the Federal Circuit determined that later-filed broad claims lacked written description support in an earlier-filed, narrower disclosure.

In *ICU Medical*, the specification “describe[d] only medical valves with spikes” and the original claims were likewise limited to medical valves with spikes. 558 F.3d at 1378. During prosecution the patentee added claims encompassing valves that did not require spikes. *Id.* at 1377. The patentee argued that the claims that are silent regarding whether the valve included a spike were supported by the written description of the specification, which only disclosed valves with spikes. *Id.* The Federal Circuit rejected the patentee’s argument noting that “a person of skill in the art would not understand the inventor . . . to have invented a spikeless medical valve.” *Id.* at 1378. The Federal Circuit further noted that “[i]t is not enough that it would have been obvious to a person of ordinary skill that [the valve] could be used without a spike.” *Id.* at 1379.

Here, the specification, figures, and original claims of the parent ‘818 application are limited to an electronic cigarette having a one-piece shell in which both the battery assembly and the atomizer assembly are located. Yet, in a later divisional application, the Applicant submitted new claims that did not require the battery assembly and atomizer assembly to be located together in the same one-piece shell. Just as in *ICU Medical*, where the narrow disclosure of a medical valve with spikes could not support broad claims that omitted the requirement for spikes, the parent ‘818 application’s narrow description of the “invention” as the battery assembly and atomizer assembly located together in the same one-piece shell cannot support the broad claims 2-3 of the ‘742 patent that omit this requirement.

In *Research Corp. Techs.*, the Federal Circuit held that claims of the later-filed child application that did not require a “blue noise mask” were not entitled to the filing date of the parent application. 627 F.3d at 871-872. In reaching that conclusion, the Federal Circuit noted that the parent application “repeatedly refer[s] to a blue noise mask as ‘the present invention,’” the figures all disclosed a blue noise mask, and all of the approved claims of the parent application recited a blue noise mask. *Id.*

Similarly, the parent ‘818 application repeatedly describes and illustrates the electronic cigarette of the “invention” as having a one-piece shell in which both the

battery assembly and atomizer assembly are located. Ex. 1009. Just as in *Research Corp.*, claims 2 and 3 of the ‘742 patent, which do not require the battery assembly and the atomizer assembly to be located together in the same one-piece shell, are not entitled to the filing date of the parent ‘818 application.

In *Anascape, Ltd.*, the Federal Circuit held that the claims of the child application were not entitled to the priority date of the parent application. 601 F.3d at 1334, 1340. The Court found that the specification and drawings of the parent were limited to a *single* input member, and the description of the invention in the child application was broadened by removing narrowing language found in the parent application. *Id.* at 1338-39. Specifically, the Court noted that “[i]n the ‘Background of the Invention’ and ‘Summary of the Invention’ sections, every occurrence of ‘hand operable single input member’ in the [child patent] was replaced with ‘hand operable input member(s)’ . . . or ‘at least one hand operable input member.’” *Id.* at 1338.

The situation with respect to claims 2 and 3 of the ‘742 patent is strikingly similar. The description and original claims of the parent ‘818 application repeatedly limit the electronic cigarette of the “invention” to a one-piece shell in which both the battery assembly and atomizer assembly are located. Several years after filing the ‘818 application, the Applicant filed a substitute specification in a later-filed divisional application (which ultimately matured into the ‘742 patent)

that eliminated the narrowing disclosure from the parent ‘818 application and submitted correspondingly broadened claims that were intended to exploit the broadening disclosure of the substitute specification.

As was the case in *Anascape*, it would be “untenable” for Patent Owner to contend that these substantive changes, which removed the requirement that the battery assembly and the atomizer assembly are located together in the same one-piece shell, did not add broadening new matter. *See* 601 F.3d at 1338 (Patentee “states that these changes to the [child] specification and claims are not ‘new matter.’ That position is untenable, for the changes are extensive and substantive. A description can be broadened by removing limitations. The limitation to a single input member...was removed, in filing the [child] application, and new claims were provided of commensurately broadened scope. This is classical new matter.”). Although the Applicant characterized the changes as grammatical corrections, the changes were in fact substantive and intended to cure the lack of written description support in the parent ‘818 application (and indeed in the originally filed ‘937 application) for claims 2 and 3 of the ‘742 patent.

In summary, the Federal Circuit decisions in *ICU Medical, Research Corp. Techs.*, and *Anascape* further demonstrate that claims 2 and 3 of the ‘742 patent are not entitled to the filing date of the parent ‘818 application, which has a disclosure that limits the “invention” to an electronic cigarette where the battery assembly and

atomizer assembly are located together in the same one-piece shell. As a result, claims 2-3 of the '742 patent are anticipated by the '311 publication.

VII. CONCLUSION

Petitioner has demonstrated that claims 2-3 of the '742 patent are not entitled to a priority date any earlier than April 5, 2011. As such, the '311 publication is anticipatory prior art under 35 U.S.C. § 102(b). Petitioner therefore requests that the Board grant *inter partes* review for each of those claims.

Dated: August 5, 2016

Respectfully submitted,

/s/ Ralph J. Gabric

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CERTIFICATE OF COMPLIANCE

The undersigned certifies that this brief complies with the type-volume limitations of 37 CFR § 42.24(a)(1)(i). This brief contains 11,627 words as calculated by the “Word Count” feature of Microsoft Word 2010, the word processing program used to create it.

The undersigned further certifies that this brief complies with the typeface requirements of 37 CFR § 42.6(a)(2)(ii) and typestyle requirements of 37 CFR § 42.6(a)(2)(iii). This brief has been prepared in a proportionally spaced typeface using Microsoft Word 2010 in Times New Roman 14 point font.

DATED: August 5, 2016

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4)(i) *et seq.* and 42.105(b), the undersigned certifies that on August 5, 2016, a complete and entire copy of this Petition for *Inter Partes* Review, and all supporting exhibits, were served by EXPRESS MAIL® to the Patent Owner by serving the correspondent of record, as indicated below:

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