

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 **IPR2018-00634**
Patent No. **9,456,632**

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. 9,456,632 (“the ’632 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. Fontem Holdings 1 B.V. is a Netherlands company, located at Radarweg 60, 1043 NT Amsterdam, The Netherlands. Fontem Holdings 1 B.V. is an affiliate of Fontem Ventures B.V. and an indirect wholly owned subsidiary of Imperial Brands PLC, an English corporation having a registered office at 121 Winterstoke Road, Bristol, UK BS3 2LL. Fontem Ventures B.V. is a Netherlands company, located at Radarweg 60, 1043 NT Amsterdam, The Netherlands. Fontem Ventures B.V. is an affiliate of Fontem Holdings 1 B.V. and an indirect wholly owned subsidiary of Imperial Brands PLC, 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 ’632 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 '632 patent, U.S. Patent Nos. 8,156,944 and 8,365,742, which are priority cases to the '632 patent, and U.S. Patent No. 9,326,548, which claims priority to the '632 patent):

a. *Fontem Ventures B.V. and Fontem Holdings I B.V. v. R.J. Reynolds Vapor Company*, Civil Action No. 16-CV-1255 and consolidated cases, U.S. District Court for the Middle District of North Carolina (prior Civil Action No. 16-CV-2286 GW (MRW), U.S. District Court for the Central District of California);

b. *Fontem Ventures B.V. and Fontem Holdings I B.V. v. R.J. Reynolds Vapor Company*, Civil Action No. 16-CV-1257, U.S. District Court for the Middle District of North Carolina (prior Civil Action No. 16-CV-3049 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-1261 and consolidated cases, U.S. District Court for the Middle District of North Carolina (prior Civil Action No. 16-CV-2291 GW (MRW), U.S. District Court for the Central District of California);

d. *Fontem Ventures B.V. and Fontem Holdings 1 B.V. v. Nu Mark LLC*, Civil Action No. 16-CV-1259, U.S. District Court for the Middle District of North Carolina (prior Civil Action No. 16-CV-4537, U.S. District Court for the Central District of California);

e. *Fontem Ventures B.V. and Fontem Holdings 1 B.V. v. NJOY, Inc.*, Civil Action No. 14-CV-1645 GW (MRW) and consolidated cases, U.S. District Court for the Central District of California;

f. *Fontem Ventures B.V. and Fontem Holdings 1 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;

g. *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-1649 GW (MRW), U.S. District Court for the Central District of California;

h. *Fontem Ventures B.V. and Fontem Holdings 1 B.V. v. Vapor Corp.*, Civil Action No. 14-CV-1650 GW (MRW), U.S. District Court for the Central District of California;

i. *Fontem Ventures B.V. and Fontem Holdings 1 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;

j. *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;

k. *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;

l. *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;

m. *Fontem Ventures B.V. and Fontem Holdings I 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;

n. *Ruyan Investment (Holdings) Limited v. Sottera, Inc.*, Civil Action No. 12-CV-5454 GAF(FFM), U.S. District Court for the Central District of California;

o. *Ruyan Investment (Holdings) Limited v. LOEC, Inc.*, Civil Action No. 12-CV-5455 GAF(FFM), U.S. District Court for the Central District of California;

p. *Ruyan Investment (Holdings) Limited v. CB Distributors, Inc. et al*, Civil Action No. 12-CV-5456 GAF(FFM), U.S. District Court for the Central District of California;

q. *Ruyan Investment (Holdings) Limited v. The Safe Cig LLC*, Civil Action No. 12-CV-5462 GAF(FFM), U.S. District Court for the Central District of California;

r. *Ruyan Investment (Holdings) Limited v. Vapor Corp.*, Civil Action No. 12-CV-5466 GAF(FFM), U.S. District Court for the Central District of California;

s. *Ruyan Investment (Holdings) Limited v. Finiti Branding Group LLC*, Civil Action No. 12-CV-5468 GAF(FFM), U.S. District Court for the Central District of California;

t. *Ruyan Investment (Holdings) Limited v. Barjan LLC et al*, Civil Action No. 12-CV-5470 GAF(FFM), U.S. District Court for the Central District of California;

u. *Ruyan Investment (Holdings) Limited v. Spark Industries LLC*, Civil Action No. 12-CV-5472 GAF(FFM), U.S. District Court for the Central District of California;

v. *Ruyan Investment (Holdings) Limited v. Nicotek LLC*, Civil Action No. 12-CV-5477 GAF(FFM), U.S. District Court for the Central District of California;

w. *Ruyan Investment (Holdings) Limited v. Logic Technology Development LLC*, Civil Action No. 12-CV-5482 GAF(FFM), U.S. District Court for the Central District of California;

x. *In Re: Fontem Holdings I B.V.*, Appeal No. 15-1511, U.S. Court of Appeals for the Federal Circuit, Appeal from the U.S. Patent and Trademark Office, Patent Trial and Appeal Board IPR2013-00387; and

y. *R.J. Reynolds Vapor Company v. Fontem Holdings I B.V.*, Appeal No. 18-1591, U.S. Court of Appeals for the Federal Circuit, Appeal from the U.S. Patent and Trademark Office, Patent Trial and Appeal Board, IPR2016-01268.

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

z. U.S. Patent No. 8,156,944, issued April 17, 2012 to Lik Hon, filed October 29, 2008 as U.S. Patent Application No. 12/226,818, which is a priority case to the '632 patent;

aa. U.S. Patent No.8,365,742, issued February 5, 2013 to Lik Hon, filed April 5, 2011 as U.S. Patent Application No. 13/079,937, which is a priority case to the'632 patent;

bb. U.S. Patent No. 9,326,548, issued May 3, 2016 to Lik Hon, filed April 3, 2014 as U.S. Patent Application No. 14/244,376, which claims priority to the '632 patent;

cc. U.S. Patent No. 9,808,034, issued November 7, 2017 to Lik Hon, filed May 27, 2016 as U.S. Patent Application No. 15/167,659, which claims priority to the '632 patent;

dd. U.S. Patent Application Publication No. 2016-0270449, by Lik Hon, filed May 27, 2016 as U.S. Patent Application No. 15/167,690, which claims priority to the '632 patent;

ee. U.S. Patent Application No. 15/904,217 by Lik Hon, filed February 23, 2018 and not yet published, which claims priority to the '632 patent;

ff. *Inter partes* reexamination of U.S. Patent No. 8,156,944 (item **z.** above), U.S. Patent Office control number 95/002,235, filed September 13, 2012 by Fin Branding Group, LLC;

gg. Petition for *Inter Partes* Review of U.S. Patent No. 8,156,944 (item **z.** above), Case No. IPR2013-00387, before the Patent Trial and Appeal Board at the U.S. Patent Office, filed June 27, 2013 by Petitioners CB Distributors, Inc. and DR Distributors, LLC;

hh. Petition for *Inter Partes* Review of U.S. Patent No. 8,365,742 (item **aa.** above), Case No. IPR2015-00859, before the Patent Trial and Appeal

Board at the U.S. Patent Office, filed March 10, 2015 by Petitioner VMR Products, LLC;

ii. Petition for *Inter Partes* Review of U.S. Patent No. 8,365,742 (item **aa.** above), Case No. IPR2015-01587, before the Patent Trial and Appeal Board at the U.S. Patent Office, filed July 14, 2015 by Petitioner JT International S.A.;

jj. Petition for *Inter Partes* Review of U.S. Patent No. 8,365,742 (item **aa.** above), Case No. IPR2016-01303, before the Patent Trial and Appeal Board at the U.S. Patent Office, filed June 28, 2016 by Petitioner Nu Mark LLC;

kk. Petition for *Inter Partes* Review of U.S. Patent No. 8,365,742 (item **aa.** above), Case No. IPR2016-01268, before the Patent Trial and Appeal Board at the U.S. Patent Office, filed July 2, 2016 by Petitioner R.J. Reynolds Vapor Company;

ll. Petition for *Inter Partes* Review of U.S. Patent No. 8,365,742 (item **aa.** above), Case No. IPR2016-01532, before the Patent Trial and Appeal Board at the U.S. Patent Office, filed August 5, 2016 by Petitioner R.J. Reynolds Vapor Company;

mm. Petition for *Inter Partes* Review of U.S. Patent No. 9,326,548 (item **bb.** above), Case No. IPR2016-01641, before the Patent Trial and Appeal Board at the U.S. Patent Office, filed August 18, 2016 by Petitioner Nu Mark LLC;

nn. Petition for *Inter Partes* Review of U.S. Patent No. 9,326,548 (item **bb.** above), Case No. IPR2016-01691, before the Patent Trial and Appeal Board at the U.S. Patent Office, filed August 30, 2016 by Petitioner R.J. Reynolds Vapor Company;

oo. Petition for *Inter Partes* Review of U.S. Patent No. 9,326,548 (item **bb.** above), Case No. IPR2016-01692, before the Patent Trial and Appeal Board at the U.S. Patent Office, filed August 30, 2016 by Petitioner R.J. Reynolds Vapor Company; and

pp. Petition for *Inter Partes* Review of U.S. Patent No. 9,326,548 (item **bb.** above), Case No. IPR2017-00204, before the Patent Trial and Appeal Board at the U.S. Patent Office, filed November 4, 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:

<p>Michael J. Wise Lead Counsel USPTO Reg. No. 34,047</p> <p>PERKINS COIE LLP 1888 Century Park East, Suite 1700 Los Angeles, CA 90067 Phone: 310-788-3210 Facsimile: 310-788-3399 Email: MWise@perkinscoie.com</p>	<p>Joseph P. Hamilton Back-up Counsel USPTO Reg. No. 51,770</p> <p>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</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: March 22, 2018

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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: March 22, 2018

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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