

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VMR PRODUCTS LLC

Petitioner,

v.

FONTEM HOLDINGS 1 B.V.

Patent Owner.

Case 2015-000859

Patent No. 8,365,742

**PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR
INTER PARTES REVIEW OF U.S. PATENT NO. 8,365,742**

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LIST OF EXHIBITS RELIED UPON HEREIN

| Petitioner's Exhibits | |
|-----------------------|---|
| Exhibit | Description |
| Ex. 1001 | U.S. Patent No. 8,365,742 (“the ‘742 patent”) |
| Ex. 1006 | WO 2005/099494, which is the PCT application equivalent of Hon (CN2719043) (“Hon ‘494”) |
| Ex. 1007 | Certified English translation of WO 2005/099494 |
| Ex. 1010 | European Patent No. EP0845220 B1 (“Susa”) |
| Ex. 1011 | U.S. Patent No. 5,144,962 (“Counts”) |
| Ex. 1012 | WO 03/034847 (“Abhulimen”) |
| Ex. 1013 | U.S. Patent No. 2,057,353 (“Whittemore”) |
| Ex. 1014 | Litigation Proceedings in CV 14-1645-Rulings on Claims Construction |
| Ex. 1017 | Prosecution History, Non-final Office Action |

| Ex. 1020 | '742 Prosecution History, Examiner Interview Summary |
|--------------------------------|--|
| Patent Owner's Exhibits | |
| Exhibit | Description |
| 2001 | Electronic Cigarette: a possible substitute for cigarette dependence by P. Caponnetto et al. 2013; 79:1, 12-19 |
| 2002 | Safety evaluation and risk assessment of electronic cigarettes as tobacco cigarette substitutes: a systematic review Ther Adv Drug Saf 2014, Vol 5(2) 67-86 |
| 2003 | e-cigarette definition Dictionary.reference.com |
| 2004 | Dkt 93 - 0Joint Claim Construction and Prehearing Statement; Case No. CV14-1645 GW (MRWx) |
| 2005 | The New Oxford American Dictionary 2001 |
| 2006 | Dkt 133 Civil Minutes dated May 7, 2015, Case No. CV 14-1645-GW (MRWx) |
| 2007 | US Patent 4,981,522 Nichols et al. |
| 2008 | Dkt 34 - Revised Joint Claim Construction and Prehearing Statement, Case No. CV 14-1645-GW (MRWx) and related cases |

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