

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JT INTERNATIONAL S.A.,
Petitioner,

v.

FONTEM HOLDINGS 1 B.V.,
Patent Owner.

Case IPR2015-01587

Patent No. 8,365,742

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

TABLE OF CONTENTS

	Page
1. INTRODUCTION	1
1.1 The Prior Petition By VMR	1
1.2 The New Petition By JTI.....	2
2. THE IPR PETITION IS TIME-BARRED BECAUSE PETITIONER JTI AND LOGIC ARE IN PRIVACY FOR PURPOSES OF § 315(b)	3
2.1 35 U.S.C. § 315(b).....	3
2.2 Timeline.....	5
2.3 Petitioner JTI Is In Privity With Logic	7
3. CLAIM CONSTRUCTION	8
3.1 Porous Component	9
3.2 Liquid Supply And Liquid Storage Component	10
3.3 Frame.....	11
3.4 Heating Wire Wound On A Part Of The Porous Component.....	11
3.5 Run-Through Hole	12
3.6 Atomizer	13
The broadest reasonable interpretation of the term “atomizer” is a “component that converts liquid into aerosol or vapor.”	13
Claims 1, 2 and 3 recite an “atomizer” that includes a “frame,” “porous body,” and a “heating wire.”	13
Thus, the broadest reasonable interpretation of the term “atomizer” is a “component that converts liquid into aerosol or vapor.”	14
4. OBVIOUSNESS.....	14
5. THE '742 PATENT FILE HISTORY	15
6. RESPONSE TO GROUND 1: THE PETITION SHOWS NO REASONABLE LIKELIHOOD THAT CLAIMS 1–3 ARE UNPATENTABLE OVER TAKEUCHI	16
6.1 Takeuchi Is Missing Numerous Claim 1 Elements.....	16
6.2 Takeuchi Does Not Meet The Elements Of Claim 2	19

6.3	Takeuchi Does Not Meet The Elements Of Claim 3	20
6.4	Conclusion.....	21
7.	RESPONSE TO GROUND 2: THE PETITION SHOWS NO REASONABLE LIKELIHOOD THAT CLAIMS 1–3 ARE UNPATENTABLE OVER TAKEUCHI IN VIEW OF COX.....	21
7.1	Overview Of Cox	21
7.2	Petitioner’s Takeuchi-Cox Combination Has Multiple Flaws.....	21
7.3	Conclusion.....	29
8.	RESPONSE TO GROUND 3: THE PETITION SHOWS NO REASONABLE LIKELIHOOD THAT CLAIMS 1 AND 3 ARE UNPATENTABLE OVER BROOKS	30
8.1	Brooks Has No Heating Wire Wound On A Porous Component.....	30
8.2	Brooks Has No Detachable Cigarette Bottle Assembly And No Liquid Supply In Contact With The Porous Component.....	33
8.3	The Record Does Not Support Petitioner’s Modification Of Brooks Based On Whittemore.....	35
8.4	Conclusion.....	36
9.	RESPONSE TO GROUND 4: NO REASONABLE LIKELIHOOD THAT CLAIMS 1-3 ARE UNPATENTABLE OVER THE COMBINATION OF BROOKS IN VIEW OF WHITTEMORE	36
9.1	Whittemore And The Prior VMR Decision	36
9.2	No Reasoning With Rational Underpinnings Why One Of Ordinary Skill Would Modify Brooks To Include A Heater Coil Wrapped Porous Component Of Whittemore Based On Petitioner’s Asserted Reasoning That It Would Permit One To “Independently Optimize The Properties” Of The Heater Coil And Porous Component	37
9.3	No Reasoning With Rational Underpinnings Why One Of Ordinary Skill Would Modify Brooks To Include The Liquid Supply Of Whittemore Based On Petitioner’s Asserted Reasoning That It Would Increase The Number Of Available Puffs.....	40
9.4	Petitioner’s Rationale And Proposed Modifications To Brooks Are Fundamentally Flawed	41

9.5	Conclusion.....	42
10.	RESPONSE TO GROUND 5: THE PETITION SHOWS NO REASONABLE LIKELIHOOD THAT CLAIMS 1-3 ARE UNPATENTABLE OVER THE COMBINATION OF LIU IN VIEW OF SUSA.....	43
10.1	The Board Has Previously Determined In IPR2015-00859 That Susa’s “Formed Body 92” Is Not A “Porous Component” Or “A Heating Wire Wound On A Porous Component” Within The Meaning The ‘742 Patent Claims.....	43
10.2	No New Argument Or Evidence That Would Warrant A Different Outcome From The Board’s Decision In IPR2015-00859.....	46
10.3	Conclusion.....	47
11.	RESPONSE TO GROUND 6: THE PETITION SHOWS NO REASONABLE LIKELIHOOD THAT CLAIMS 1-3 ARE UNPATENTABLE AS ANTICIPATED BY SUSA.....	48
12.	RESPONSE TO GROUND 7: THE PETITION SHOWS NO REASONABLE LIKELIHOOD THAT CLAIM 3 IS UNPATENTABLE AS OBVIOUS OVER SUSA.....	49
12.1	The Proposed Modification.....	49
12.2	The Embodiments Of Figures 12 & 13, And “Formed Body 92”.....	50
12.3	Petitioner’s Proposed Modification Is Flawed.....	52
12.1	Conclusion.....	54
13.	RESPONSE TO GROUND 8: THE PETITION SHOWS NO REASONABLE LIKELIHOOD THAT CLAIMS 1-3 ARE UNPATENTABLE OVER THE COMBINATION OF SUSA IN VIEW OF WHITTEMORE.....	55
13.1	Elements Missing From Combination Of Susa And Whittemore.....	55
13.2	Whittemore Is Not Reasonably Combined With Susa.....	56
13.3	Petitioner’s Proposed Combinations Redesign The Device Of Susa Figure 13 And Change Susa’s Basic Operating Principles.....	57
13.4	There Is No Basis In The Evidence Of Record For Petitioner’s Alleged Motivations To Modify Susa.....	58

13.5	Petitioner’s Reconstruction Of Susa Does Not Produce A Combination That Meets All Of The Elements Of The ‘742 Patent Claims 1-3	59
13.6	Conclusion.....	60
14.	CONCLUSION.....	60

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.