

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.

Cases IPR2016-01268
Patent 8,365,742 B2

Before BRIAN J. McNAMARA, JEREMY M. PLENZLER, and
JO-ANNE M. KOKOSKI, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

DECISION
Petitioner's Motion to Submit Supplemental Information
37 C.F.R. § 42.123(a)

On February 13, 2017, with Board authorization, Petitioner filed a Motion to Submit Supplemental Information. Paper 18 (“Mot.”). Patent Owner filed a Response stating that it does not oppose Petitioner’s Motion. Paper 19, 1. Petitioner seeks to submit the Supplemental Declaration of Dr. Robert H. Sturges (“Sturges Supplemental Declaration”) and the Declaration of Huo Gejun (“Huo Declaration”). Mot. 1.

Under 37 C.F.R. § 42.123(a), a party may file a motion to submit supplemental information if the following requirements are met: (1) a request for authorization to file the motion was made within one month of the date the trial was instituted; and (2) the supplemental information is relevant to a claim for which trial was instituted. Here, Petitioner sought authorization to file its motion via an email to the Board dated February 3, 2017, which is within one month of the January 3, 2017 institution date in this proceeding. Mot. 1, Ex. 1; *see* Paper 10.

Trial was instituted to determine whether claims 2 and 3 are unpatentable under 35 U.S.C. § 103 as obvious over the combined teachings of Hon ’043 and Whittemore. Paper 10, 15. Petitioner states that the Sturges Supplemental Declaration “provides corroborating evidence” for opinions expressed by Dr. Sturges in Exhibit 1015, which is the declaration Dr. Sturges submitted in support of the Petition. Mot. 1–2. In particular, Petitioner states that “the Sturges Supplemental Declaration provides additional, corroborating facts and data establishing that his opinions regarding ‘friction fit,’ ‘bonding material,’ ‘shear forces,’ ‘axial displacement,’ and air flow in ¶¶ 44–50 and the annotations on pages 32–33

of [Exhibit 1015] are the product of reliable principles and methods.” *Id.* at 5.

With respect to the Huo Declaration, Petitioner states that it confirms “that Exhibit 1018 is what Petitioner represented it is—a true and accurate translation of the PCT equivalent of Hon ’043 (Ex. 1017).” Mot. 2.

Petitioner further states that the Huo Declaration “is an updated translator certificate that includes the statement that the translator has been ‘warned that willful false statements and the like are punishable by fine or imprisonment, or both,’ which was not included in the original translator certificate included with the English translation in Ex. 1018.” *Id.* at 5.

Based on Petitioner’s representations, we are persuaded that the Sturges Supplemental Declaration and the Huo Declaration are relevant to a claim for which trial was instituted. We are also persuaded that Petitioner’s supplemental information does not change the ground of unpatentability authorized in this proceeding, nor does it change the evidence initially presented in the Petition to support that ground. For these reasons, and because the Motion is unopposed, Petitioner’s Motion to Submit Supplemental Information is granted.

Accordingly, it is

ORDERED that Petitioner’s Motion to Submit Supplemental Information (Paper 18) is *granted*; and

FURTHER ORDERED that, within five business days of this Decision, Petitioner shall file the Sturges Supplemental Declaration (attached as Exhibit 2 to Paper 18) and the Huo Declaration (attached as

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Exhibit 3 to Paper 18) as two separately numbered exhibits in the record of this proceeding.

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