

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Li Han Examiner: Terrence R. Till
Reexamination No.: 95/002,235 Art Unit: 3991
Filed: September 13, 2012 Conf. No: 3893
Title: AEROSOL ELECTRONIC CIGARETTE

* * * * *

February 27, 2013

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Third Party Response to Amendment

In response to the Amendment submitted by Ruyan Investments (Holdings) Limited (“Patent Owner”) dated January 28, 2013 (“Patent Owner’s Response”), kindly enter the following response on behalf of Fin Branding Group, LLC (“Third Party Requester”) in the above-referenced reexamination as follows:

Status of Claims begins on page 2 of this paper.

Response begins on page 2 of this paper.

- I. *Claims 1 and 10 are Anticipated by Hon ‘494* - Discussion begins on page 2.
- II. *Claims 1 and 10 are Obvious over Hon ‘494 in View of Hon ‘955 and Over New Prior Art Oljaca ‘776 (newly found)* - Discussion begins on page 5.
- III. *Discussion of the Claims Patent Owner Concedes* begins on page 12.
- IV. *New Claims 42-44 are Obvious over Hon ‘494 in View Hon ‘955 and Over New Prior Art Oljaca ‘776 (newly found)* - Discussion begins on page 22.
- V. *Alternative Limitations Suggested by Third Party Requester* - Discussion begins on page 27.
- VI. *Response to Patent Owner’s Supplemental Amendment* - Discussion begins on page 29.

It is understood that no fees are due, but if this understanding is incorrect, please contact the undersigned at the number indicated below for approval and payment.

STATUS OF CLAIMS

Claims 1-6, 8-12, 15-26, 33-36 and 38 are rejected. Claims 7, 27 and 37 are cancelled. Claims 13-14, 28-32 and 39-41 are pending and Claims 42-44 have been newly proposed by Applicant.

RESPONSE

Third Party Requester appreciates the Examiner's careful attention to this matter in the November 27, 2012, Office Action issued by the Examiner ("First Office Action") and requests: (I) final rejection of claims 1 and 10 as anticipated; (II) final rejection of claims 1 and 10 as obvious; (III) final rejection by the Examiner for each point to which the Patent Owner did not respond in the Patent Owner's Response; (IV) rejection of the new claims proposed in the Patent Owner's Response as anticipated and/or obvious; and (V) in the alternative, if the Examiner allows the proposed new claims, a requirement for clarifying amendments to the claimed invention to include (1) Patent Owner's admitted limitations on the run-through chamber, i.e., "run-through" means "only air runs through" and "open and unrestricted" and (2) limitations in view of the prior art on the heating rod, i.e., "the heating rod is electrified by the heating element." Additional support for these requests is set forth more fully below.

I. Claims 1 and 10 are Anticipated by Hon '494.

In the First Office Action, the Examiner rejected claims 1-4, 8-12, 15-26, 33, 34, 36 and 38 as anticipated by Hon '494. *See* First Office Action, page 5, para. 10. Patent Owner did not respond to any of these rejections, except to call out and rely on two elements of claims 1 and 10. As discussed below in Section III, Patent Owner concedes that every single element of claims 1 and 10 is anticipated by Hon '494, except (i) a run-through atomizer (the "Run-Through Atomizer") and (ii) an electric heating rod located in the atomizing chamber (the "Rod In Chamber"). *See* Section I, paras. (11) and (17). The Examiner cited and provided a machine translation of Hon '494 ("Machine Translation of '494") and Patent Owner relied on the translation found in U.S. Publication 2007/0267031 ("Patent Owner Translation of '494").

A. Hon '494 Teaches A Run-Through Atomizer.

In the First Office Action, the Examiner stated: "Hon '494 teaches . . . a run-through atomizing chamber (open area 10)." See Office Action, para. 11. In the Patent Owner's Response, the Patent Owner argues that the atomizing chamber in Hon '494 is not a "run-through" atomizing chamber because it is not "open and unrestricted." See Patent Owner's Response, page 14, first paragraph. Additionally, Patent Owner argues that "run-through" means that air runs through the chamber and not liquid or vapor. *Id.*, page 20, lines 4-6.

Hon '494 teaches a "run-through" atomizing chamber as shown in figure 6 shown below.

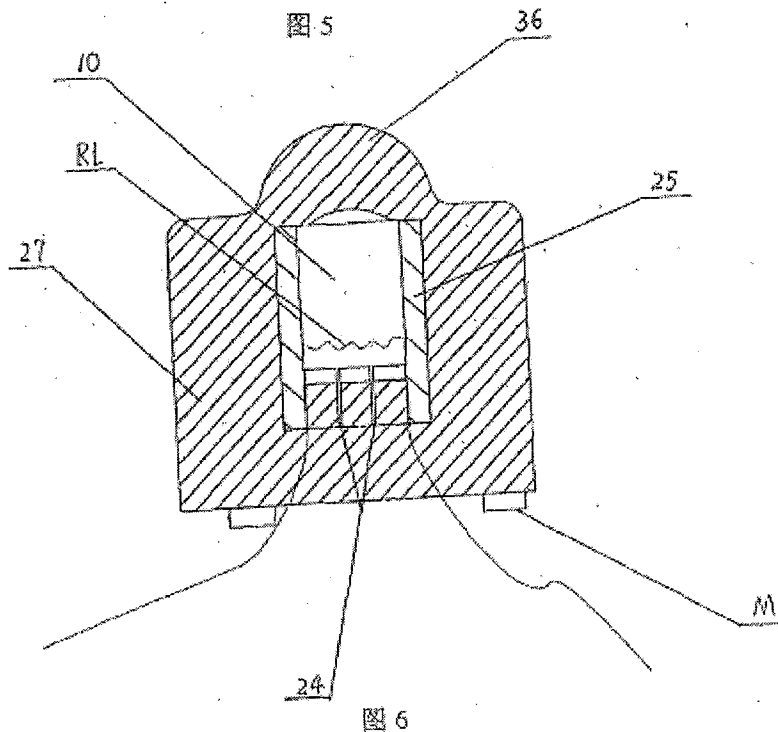


Figure 6 above of Hon '494 clearly shows an atomization cavity 10 with an atomization

cavity wall 25 in the shape of a tube. The tube is wrapped entirely by porous material 36, including some porous material that appears to be stuffed into one end of the tube. Hon '494, Figure 6; *see also* Patent Owner Translation of '494, para [0009], lines 18-19. Among the porous materials taught are “foam nickel” and “stainless steel fiber felt”, which would each allow liquid, steam or air to pass through them. Hon '494, para. [0009], lines 23-24.

Additionally, Hon '494 teaches:

an air inlet provided in the external wall of the shell; an electronic circuit board, a normal pressure cavity, a sensor, a vapor-liquid separator, an atomizer, a liquid-supplying bottle *arranged sequentially* within the shell; a stream [sic] passage provided on one side of the sensor; a negative pressure cavity provided in the sensor; and atomization cavity arranged in the atomizer [sic]; . . . and an aerosol passage provided on the other side of the liquid-supplying bottle, . . . the liquid supplying bottle is in contact with the atomizer; and the air inlet, normal pressure cavity, vapor-liquid separator, atomizer, aerosol passage, gas vent and mouthpiece *are sequentially interconnected*.

Patent Owner Translation of '494, para [0008], lines 2-17 (emphasis added). Hon '494 also teaches:

The air enters the normal pressure cavity 5 through the air inlet 4, passes through the air passage 18 of the sensor and then the through hole in the vapor-liquid separator 7, and flows into the atomization cavity 10 in the atomizer 9. . . . After atomization . . . the droplets with small diameter float in stream and forms aerosols, which are sucked out via the aerosol passage 12, gas vent 17 and mouthpiece 15.

Id., para. [0028], lines 18-21 and 30-32 (omitting the sentences believed by Third Party Requester to pertain to the optional piezoelectric features of the device).

A plain reading of the paragraphs above clearly describes an interconnected path from the air inlet to the mouthpiece. If the air entering the air inlet is to pick up the nicotine in the liquid supply bottle and the atomizer before traveling to the mouthpiece where the nicotine is inhaled by the smoker, the air must necessarily pass through the atomizing chamber along the way.

B. Hon '494 Teaches the Rod In Chamber.

In the First Office Action, the Examiner rejected the Rod In Chamber element of claims 1 and 10 because “Hon ‘494 teaches . . . the electric heating rod comprises a cylinder 25 and a heating element 26 provided at the wall of the cylinder, the electric heating rod is in the said atomizing chamber (see figure 6)” *See* Office Action, para. 11. In the Patent Owner’s Response, the Patent Owner does not dispute that the cylinder of Hon ‘494 is a heating rod, but only the location of it. Specifically, Patent Owner argues that the heating rod of Hon ‘494 is the wall of the chamber, so it cannot be in the chamber. *See* Patent Owner’s Response, page 16, first paragraph. Third Party Requester disagrees with Patent Owner’s analysis because the wall of the chamber in Hon ‘494 defines the chamber so if that heating rod is the wall of the chamber, the rod’s interior surface is necessarily in the chamber.

Hon ‘494 teaches having a “heating element provided within the atomization chamber.” Patent Owner Translation of ‘494, para [0009], lines 16-17. In the Machine Translation of ‘494, the publication also teaches: (1) the “[a]tomizing chamber is equipped with the heating member.” Machine Translation of ‘494, page 4, line 8; and (2) the “atomizing chamber wall 25 in atomizing chamber 10 is gone up to open has spout hole 29, and the intracavity is equipped with heating member 26” Machine Translation of ‘494, page 5, lines 12-13. Either way, Hon ‘494 teaches to heat the liquid from inside the atomization chamber using either a “heating member” or a “heating element.” *Id.*

For the reasons described above, the Examiner should finalize rejection of claims 1 and 10 as anticipated by Hon ‘494.

II. Claims 1 and 10 Are Obvious over Hon ‘494 In View of Hon ‘955 and Over New Prior Art Oljaca ‘776 (necessitated by Patent Owner’s Response).

In the First Office Action, the Examiner rejected claims 1, 2, 5-6, 8-12, 15-17, 24, 26, 33-36 and 38 as being obvious over Hon ‘494 in combination with Hon ‘955. *See* First Office Action, page 10, para. 41. Patent Owner did not respond to any of these rejections, except to call out and rely on two elements of claims 1 and 10. As discussed below in Section III, Patent

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.