

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

U.S. Patent No.: 8,365,742

Issue Date: Feb. 5, 2013

Title: Aerosol Electronic Cigarette

Inter Partes Review No. IPR2016-01268

**DECLARATION OF DR. ROBERT H. STURGES
REGARDING U.S. PATENT NO. 8,365,742**

R.J. Reynolds Vapor

IPR2016-01268

R.J. Reynolds Vapor v. Fontem

Exhibit 1015-00001

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applied fluid “resistors” that rely on porous media to provide resistance to flow. I have also applied heat transfer fundamentals to design and build variations of commercial steam engines used in my undergraduate labs at Carnegie Mellon University and my graduate course in Sustainability at Virginia Tech. In addition, I have taught undergraduate courses focused on fundamental mechanics and the conservation of energy, including basic principles of fluid flow and heat transfer.

4. Based on my background, experience, education and professional activities, I consider myself an expert in the fields of mechanical design, mechatronics, and manufacturing, including systems that employ heat, mass and fluid transfer.

5. My Curriculum Vitae, including my publications and patents, is submitted herewith in Appendix A.

C. Compensation and Prior Testimony

6. I am being compensated at a rate of \$400 per hour for my study and time in this matter. I am also being reimbursed for reasonable and customary expenses associated with my work and time in this investigation. My compensation is not contingent on the outcome of this matter or the specifics of my testimony.

7. The list attached at Appendix B identifies my past expert engagements.

D. Information Considered

8. My opinions are based on my years of education, research, and experience, as well as my investigation and study of relevant materials. In forming my opinions, I have considered, among other things, the '742 patent and its prosecution history, as well as the record of the two prior IPRs involving the '742 patent (IPR2015-00859 and IPR2015-01587), in addition to the prior art and other materials referred to herein.

9. I may rely upon these materials and/or additional materials to rebut arguments raised by the patent owner.

10. I reserve the right to supplement this Declaration in response to additional evidence that may come to light.

II. LEGAL STANDARDS FOR PATENTABILITY

11. In expressing my opinions and considering the subject matter of the claims of the '742 patent, I am relying upon certain basic legal principles that counsel has explained to me.

12. It is my understanding that, to anticipate a claim under 35 U.S.C. § 102, a prior art reference must teach every limitation of the claim.

13. It is also my understanding that a claimed invention is unpatentable under 35 U.S.C. § 103 as being obvious if the differences between the invention and the prior art are such that the subject matter as a whole would have been

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