

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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R.J. REYNOLDS VAPOR COMPANY,  
Petitioner,

v.

FONTEM HOLDINGS 1 B.V.,  
Patent Owner.

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Case IPR2016-01268  
Patent 8,365,742

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**PETITIONER'S UPDATED MANDATORY NOTICES  
PURSUANT TO 37 C.F.R. § 42.8**

Pursuant to 37 C.F.R. § 42.8(a)(3), R.J. Reynolds Vapor Company (“Reynolds” or “Petitioner”) submits the following updated mandatory notices, which supersede the notice of real party-in-interest and the notice of related matters that Petitioner filed previously.

**I. NOTICE OF REAL PARTY-IN-INTEREST (37 C.F.R. § 42.8(B)(1))**

For purposes of 35 U.S.C. § 312(a)(2) and 37 C.F.R. § 42.8(b)(1) only, Petitioner, R.J. Reynolds Vapor Company, identifies the real parties-in-interest as R.J. Reynolds Vapor Company, RAI Strategic Holdings, Inc., RAI Innovations Company (the direct parent company of R.J. Reynolds Vapor Company and RAI Strategic Holdings, Inc.), R.J. Reynolds Tobacco Company, and RAI Services Company. Each of the foregoing entities is a direct or indirect wholly owned subsidiary of Reynolds American Inc. Although Petitioner does not believe that Reynolds American Inc. is a real party-in-interest (*see* Patent Trial Practice Guide 77 Fed. Reg., Vol. 77, No. 157 (2012) at 48759-60), Reynolds American Inc. and each of its other wholly owned subsidiaries (direct and indirect) nevertheless agree to be bound by any final written decision in these proceedings to the same extent as a real party-in-interest. *See* 35 U.S.C. § 315(e).

**II. NOTICE OF RELATED MATTERS (37 C.F.R. § 42.8(B)(2))**

Petitioner is not aware of any reexamination certificates or pending prosecution concerning the ‘742 patent. Petitioner is a defendant in the following

litigation involving the '742 patent: *Fontem Ventures B.V. et al. v. R.J. Reynolds Vapor Company*, No. 2:16-cv-02286 (C.D. Cal., filed April 4, 2016).<sup>1</sup> Claims 2 and 3 of the '742 patent have been asserted against the Petitioner. Also, Petitioner filed a petition for IPR, IPR2016-01532, challenging claims 2 and 3 of the '742 patent. In addition to the foregoing, the Petitioner is aware of the following additional matters involving the '742 patent and other related matters listed in the tables below.

Pending Litigations and IPRs

Case Name	Filed
<i>Fontem Ventures BV et al v. Nu Mark LLC</i> , 2:16-cv-02291 (C.D. Cal.)	April 4, 2016
<i>Fontem Ventures BV et al v. R.J. Reynolds Vapor Company</i> , 2:16-cv-03049 (C.D. Cal.) (U.S. Patent No. 9,326,548)	May 3, 2016
<i>Fontem Ventures BV et al v. R.J. Reynolds Vapor Company</i> , 2:16-cv-04534 (C.D. Cal.) (U.S. Patent No. 9,370,205)	June 22, 2016
<i>Fontem Ventures BV et al v. Nu Mark LLC</i> , 2:16-cv-04537 (C.D. Cal.) (U.S. Patent Nos. 9,326,548 and 9,326,550)	June 22, 2016
Petition for <i>Inter Partes</i> Review by NU MARK LLC, IPR2016-01303 (PTAB) (challenging claims 2-3 of the '742 patent)	June 28, 2016

<sup>1</sup> The District Court has transferred case nos. 2:16-cv-02286, 2:16-cv-02291, 2:16-cv-03049, 2:16-cv-04534, and 2:16-cv-04537 to the Middle District of North Carolina.

<b>Case Name</b>	<b>Filed</b>
<i>Nu Mark LLC v. Fontem Holdings I B.V.</i> , IPR2016-01307 (PTAB) (U.S. Patent No. 8,375,957)	June 28, 2016
<i>Nu Mark LLC v. Fontem Holdings I B.V.</i> , IPR2016-01309 (PTAB) (U.S. Patent No. 8,863,752)	June 28, 2016

Pending Patent Applications

<b>Serial No.</b>	<b>Filed</b>
U.S. Patent Application No. 13/740,011, which claims priority to the '742 patent	January 11, 2013
U.S. Patent Application No. 15/167,659, which claims priority to the '742 patent	May 27, 2016
U.S. Patent Application No. 15/167,690, which claims priority to the '742 patent	May 27, 2016
U.S. Patent Application No. 15/158,421, which claims priority to the same foreign application as does the '742 patent	May 18, 2016
U.S. Patent Re-Examination No. 95/002,235, which claims priority to the same foreign application as does the '742 patent	September 13, 2012

Terminated Litigations and Previous IPR Petitions

<b>Case Name</b>	<b>Filed</b>
<i>Fontem Ventures BV et al v. NJOY, Inc. et al</i> , 2:14-cv-01645 (C.D. Cal.)	March 5, 2014
<i>Fontem Ventures BV et al v. LOEC, Inc. et al</i> , 2:14-cv-01648 (C.D. Cal.)	March 5, 2014
<i>Fontem Ventures BV et al v. CB Distributors, Inc. et al</i> , 2:14-cv-01649 (C.D. Cal.)	March 5, 2014
<i>Fontem Ventures BV et al v. Vapor Corp. et al</i> , 2:14-cv-01650 (C.D. Cal.)	March 5, 2014

<b>Case Name</b>	<b>Filed</b>
<i>Fontem Ventures BV et al v. FIN Branding Group, LLC et al</i> , 2:14-cv-01651 (C.D. Cal.)	March 5, 2014
<i>Fontem Ventures BV et al v. Ballantyne Brands, LLC et al</i> , 2:14-cv-01652 (C.D. Cal.)	March 5, 2014
<i>Fontem Ventures BV et al v. Spark Industries, LLC et al</i> , 2:14-cv-01653 (C.D. Cal.)	March 5, 2014
<i>Fontem Ventures BV et al v. Logic Technology Development LLC et al</i> , 2:14-cv-01654 (C.D. Cal.)	March 5, 2014
<i>Fontem Ventures BV et al v. VMR Products, LLC et al</i> , 2:14-cv-01655 (C.D. Cal.)	March 5, 2014
<i>Ruyan Investment Holdings Limited v. Sottera, Inc. et al</i> , 2:12-cv-05454 (C.D. Cal.) (U.S. Patent No. 8,156,944)	June 22, 2012
<i>Ruyan Investment Holdings Limited v. LOEC, Inc.</i> , 2:12-cv-05455 (C.D. Cal.) (U.S. Patent No. 8,156,944)	June 22, 2012
<i>Ruyan Investment Holdings Limited v. CB Distributors, Inc., et al</i> , 2:12-cv-05456 (C.D. Cal.) (U.S. Patent No. 8,156,944)	June 22, 2012
<i>Ruyan Investment Holdings Limited v. The Sage Cig, LLC</i> , 2:12-cv-05462 (C.D. Cal.) (U.S. Patent No. 8,156,944)	June 22, 2012
<i>Ruyan Investment Holdings Limited v. Vapor Corp.</i> , 2:12-cv-05466 (C.D. Cal.) (U.S. Patent No. 8,156,944)	June 22, 2012
<i>Ruyan Investment Holdings Limited v. Finiti Branding Group LLC</i> , 2:12-cv-05468 (C.D. Cal.) (U.S. Patent No. 8,156,944)	June 22, 2012
<i>Ruyan Investment Holdings Limited v. Barjan LLC, et al</i> , 2:12-cv-05470 (C.D. Cal.) (U.S. Patent No. 8,156,944)	June 22, 2012
<i>Ruyan Investment Holdings Limited v. Spark Industries LLC</i> , 2:12-cv-05472 (C.D. Cal.) (U.S. Patent No. 8,156,944)	June 22, 2012
<i>Ruyan Investment Holdings Limited v. Nicotek LLC</i> , 2:12-cv-05477 (C.D. Cal.) (U.S. Patent No. 8,156,944)	June 22, 2012

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