

**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 No. IPR2016-01268

Patent No.: 8,365,742

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**PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO  
EXCLUDE PURSUANT TO 37 C.F.R. §§42.62 AND 42.64**

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## I. INTRODUCTION

Even though P.O. only identifies 18 paragraphs as containing purportedly “new” opinions, P.O. moves to exclude the entire 76-paragraph Reply Declaration of Dr. Robert Sturges (Ex. 1027). This alone warrants denial of P.O.’s motion. *See Liberty Mut. Ins. Co. v. Progressive Cas. Ins. Co.*, CBM2012-00003, Paper 78 at 68 (PTAB Feb. 11, 2014) (“[W]hile [Patent Owner’s] motion specifically discusses only selected paragraphs of the reply declarations . . . , it seeks to exclude the entirety of the reply declarations. That, in itself, is sufficient basis to deny the relief requested.”).

P.O.’s motion also warrants denial as to the 18 paragraphs specifically addressed. P.O.’s argument that these 18 paragraphs introduce “new” evidence is meaningless. But the opinions set forth in Sturges’ Reply Declaration are within the scope of proper reply because they respond to arguments and opinions raised by P.O. and P.O.’s expert. And, with one exception, these opinions are not new in any event. To the contrary, they trace their roots to Sturges’ Petition Declaration and/or P.O. elicited these opinions during cross-examination of Dr. Sturges back in March 2017, *before* P.O. even filed its Opposition papers. P.O. has had multiple opportunities to respond to Dr. Sturges’ opinions. Indeed, if P.O. believed otherwise, it could have requested leave to file a sur-reply or sought other relief,

but it did not do so. Both the record and P.O.'s own inaction belies its cries of unfair prejudice.

P.O. also moves to exclude Sturges' Reply Declaration pursuant to FRE 702 and 703. As the moving party, it was P.O.'s burden to show that the Sturges Reply Declaration, as supplemented by his Supplemental Evidence Declaration (Ex. 1034), should be excluded under FRE 702 and 703. But P.O. did not even try to meet its burden. P.O. provides no analysis whatsoever explaining how Sturges' Reply Declaration allegedly falls short under FRE 702/703.

P.O. also moves to exclude exhibits 1028-1032, because they are only cited in the purportedly improper Sturges Reply Declaration. But Dr. Sturges' Reply Declaration is entirely proper, so P.O.'s sole predicate for excluding exhibits 1028-1032 necessarily fails. In any event, exhibits 1028-1032 are not relied upon in the specific paragraphs addressed by P.O.'s motion, and are proper reply evidence. Exhibits 1028-1031 are offered in reply to the opinion of P.O.'s expert that aerosol allegedly cannot pass through Hon 043's porous body 27. Ex. 1027 at ¶ 42. Ex. 1032 supports Sturges' reply opinion addressing slipstream. *Id.* at ¶ 57.

Finally, P.O. moves to exclude exhibit 1005-1008 and 1022 pursuant to FRE 401-403, but that motion is similarly without merit. Exhibits 1005-1008 are excerpts from the prosecution history of the 742 patent, which is the patent at issue in this proceeding. These exhibits are cited in the Petition for relevant context.

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