

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

R.J. REYNOLDS VAPOR COMPANY,
Petitioners

v.

FONTEM HOLDINGS 1 B.V.,
Patent Owner

Case **IPR2016-01268**
Patent No. **8,365,742**

**PATENT OWNER'S CORRECTED OBSERVATIONS ON
CROSS-EXAMINATION OF DR. ROBERT H. STURGES**

Pursuant to the Board's Order dated September 14, 2017 (Paper 45), Patent Owner Fontem Holdings 1 B.V. respectfully submits the following corrected observations regarding the cross-examination testimony of Petitioner R.J. Reynolds Vapor Company's Reply declarant, Dr. Robert H. Sturges.

Patent Owner cross-examined Dr. Sturges on July 18, 2017 regarding his reply declaration. Ex. 1027; Ex. 2030.

I. Airflow in Hon '043

1. In Exhibit 2030, on page 20, lines 11-14, when asked if a droplet could "enter the porous body and not be reabsorbed," Dr. Sturges testified that that is "not suggested" nor "expected given the teachings of [Hon] '043." This testimony is relevant to the Petition at 15-16, 24-26, and 34-35, the Opposition at 31-40 and 43-45, the Reply at 15-20, Exhibit 1015 ¶¶ 47-49 and pp. 32-35, Exhibit 1027 ¶¶ 33-43 and 54, and Exhibit 2015 ¶¶ 42-46, 76-79, and 91-94. The testimony is relevant because it shows that a skilled person would have understood: (1) that Hon '043's atomizer has an exit hole to allow atomized droplets to exit without being reabsorbed by the porous body; and (2) that Hon '043 teaches away from placing a portion of the porous body "in the path of air" or substantially aligned with the run-through hole due to the risk that droplets ejected from the ejection holes would be reabsorbed instead of "further atomized."

2. In Exhibit 2030, on page 47, lines 1-14, Dr. Sturges testified that he did not know the purpose of the “arch space under the [bulge] section” that is shown on pages 13 and 14 of Exhibit 1027, which reproduce Figure 6 of Hon ’043. This testimony is relevant to the Petition at 15-16, the Opposition at 31-42, the Reply at 15-20, Exhibit 1015 ¶¶ 47-49 and pages 32-33, Exhibit 1020 ¶¶ 12-13, Exhibit 1027 ¶¶ 34-45, and Exhibit 2015 ¶¶ 42-46 and 76-88. The testimony is relevant because it goes to the credibility and reliability of Dr. Sturges’s testimony about the exit hole in Hon ’043’s atomizer.

3. In Exhibit 2030, on page 78, line 15 through page 79, line 18, Dr. Sturges testified that Hon ’043 does not show any deformation of bulge 36 when it is inserted into the liquid supply. This testimony is relevant to the Petition at 15-16, the Opposition at 20-42, the Reply at 11-20, Exhibit 1015 ¶¶ 44-49 and pages 32-33, Exhibit 1020 ¶¶ 12-13, Exhibit 1027 ¶¶ 23-45, and Exhibit 2015 ¶¶ 42-46, 66-88, and 98-100. The testimony is relevant because it goes to the credibility and reliability of Dr. Sturges’s opinions on the precision of Hon ’043’s drawings regarding deformation of the porous body and the presence of an exit hole in the atomizer. Specifically, it demonstrates that Dr. Sturges understands Hon ’043’s figures do not precisely depict every element that a person of ordinary skill would understand to be present in an actual device.

4. In Exhibit 2030, on page 75, line 9 through page 76, line 20, Dr. Sturges testified that a person of ordinary skill would have understood that Hon '043's piezoelectric element 35 would have atomized more efficiently if ejected liquid droplets made direct contact with it. This testimony is relevant to the Petition at 18-19, the Opposition at 13-14 and 48-49, Exhibit 1027 ¶¶ 62-64, and Exhibit 2015 ¶¶ 98-100. The testimony is relevant because it shows a skilled person would have understood Hon '043 teaches focusing the ejection holes at the center of piezoelectric element 35 "to achieve the effect of strong ultrasonic atomization." Ex. 1003 at 11.

5. (RESERVED)

6. In Exhibit 2030, on page 31, line 17 through page 33, line 8, Dr. Sturges testified that he did not know why Hon '043 discusses both short and long stream ejection holes or why one skilled in the art would choose one or the other. This testimony is relevant to the Opposition at 45-50, the Reply at 22-25, Exhibit 1027 ¶¶ 57-60, and Exhibit 2015 ¶¶ 37 and 98. The testimony is relevant because it goes to the credibility and reliability of Dr. Sturges's opinions regarding fluid flow.

7. (RESERVED)

8. In Exhibit 2030, on page 68, lines 1-6, Dr. Sturges testified that the air flowing into Whittemore is not entrained with liquid droplets. This testimony is relevant to the Opposition at 45, the Reply at 21, Exhibit 1027 ¶ 67, and Exhibit 2015 ¶¶ 92 and 104. The testimony is relevant because it explains why Whittemore does not express concern about placing porous material in the path of airflow and is consistent with Mr. Meyst's explanation that Hon '043 (not Whittemore) teaches away from placing porous material in the path of airflow.

9. In Exhibit 2030, on page 65, line 6 through page 66, line 11, Dr. Sturges testified that his proposed combination retains all the elements of Hon '043 and that a slipstream would form around the proposed wire/wick heating element. This testimony is relevant to the Opposition at 50-51, the Reply at 25, Exhibit 1027 ¶¶ 57-58 and 67, Exhibit 2015 ¶ 104. The testimony is relevant because it shows that Dr. Sturges's proposed combination does not solve the problem he says motivates the combination: a "slipstream" preventing liquid droplets ejected from the ejection holes from contacting the heating element.

II. Whether Hon '043's Porous Body Is "Supported By" the Cavity Wall

10. In Exhibit 2030, on page 61, lines 16-24, Dr. Sturges testified that his interpretation of the term "supported by" is broader than the interpretation applied by the Board in IPR2015-00859 (Exhibit 1011). This testimony is relevant to the

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