

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 BRIEF REGARDING TESTIMONY FROM DR.
ROBERT H. STURGES IN IPR2016-01692**

Pursuant to the Board's September 14, 2017 Order expunging Patent Owner's observations (Paper 38) and authorizing supplemental briefing, Patent Owner Fontem Holdings 1 B.V. respectfully submits the following brief regarding the testimony of Petitioner R.J. Reynolds Vapor Company's declarant, Dr. Robert H. Sturges, taken in co-pending IPR2016-01692 on May 10, 2017 (Ex. 2029).

I. It Is Proper for the Board to Consider Patent Owner's Comments on Dr. Sturges' Testimony from IPR2016-01692

Exhibit 2029 is properly part of the record in this proceeding because Dr. Sturges authenticated the exhibit and testified about it in this proceeding on July 18, 2017. Ex. 2030 at 50:18–51:22. The Board should also consider Patent Owner's comments on the testimony. First, the testimony was taken on May 10, 2017, after Patent Owner had filed its last substantive paper, and was therefore unavailable when Patent Owner filed its Opposition. Paper 24 (filed April 4, 2017); 77 Fed. Reg. at 48,767 (Aug. 14, 2012). Second, the testimony is relevant—it addresses the same prior art that is at issue in this IPR, as well as a related patent. Ex. 2030 at 51:12–22; *see* Ex. 2029. Third, Patent Owner was diligent in calling relevant testimony to the Board's attention. Paper 11 at 5–7; Paper 38.

II. Dr. Sturges' Testimony in Exhibit 2029 Is Relevant to His Testimony in This Proceeding

Dr. Sturges's testimony in Exhibit 2029 contradicts his Reply Declaration regarding Hon '043's ejection hole. In IPR2016-01692, Dr. Sturges testified that prior to Hon '043, “dispersion of ejected liquid in atomizers were well known” and that a person of ordinary skill could modify a “plain atomizer opening” to modify the spray pattern. Ex. 2029, 87:6–95:1. Specifically, Dr. Sturges testified that “prior to Hon '043, one skilled in the art was fully capable of changing the spray formation and dispersion of an ejected liquid in an atomizer” by “changing the atomizer opening.” Ex. 2029, 90:16-24. This testimony is relevant to the Opposition at 45-50, the Reply at 22-25, Exhibit 1027 ¶¶ 57-60, Exhibit 2015 ¶¶ 37 and 98, and Exhibit 2016 at 68:3-6.

The testimony relates to the credibility and reliability of Dr. Sturges's opinions regarding whether a person of ordinary skill would have understood Hon '043's ejection hole is a plain-orifice atomizer. In Exhibit 2029, Dr. Sturges testified about a reference he cited to support his opinion that Hon '043's ejection holes emit “a cone-shaped spray.” Ex. 2029, 88:7-24; *see also* Ex. 1027 ¶ 57 (“the spray from the ejections [in Hon '043] is conical”). He testified that one could “change the cone shape to a different shape” by changing a “plain atomizer opening to something of a different form.” Ex. 2029, 89:17-24. But during that

deposition, he “realized that [that reference] also discloses fan-shaped sprays.” *Id.*, 92:10-94:7. Disclosure of a fan-shaped spray supports Patent Owner’s position. Paper 24 at 49; Ex. 2015 ¶ 98. So in his Reply Declaration, Dr. Sturges changed his view. Now he argues “Hon 043 is not a plain orifice atomizer.” Ex. 1027 ¶ 60.

Dr. Sturges’s testimony in Exhibit 2029 shows that his opinions on fluid flow in this proceeding are not reliable. Dr. Sturges testified in IPR2016-01692 that a person of ordinary skill would “certainly” have the knowledge of the Sabersky book. Ex. 2029, 112:12-17. He also testified that one would need to know “a great deal more than is discussed” in that book to model a diffusing wake. Ex. 2029, 113:25–115:4. This testimony is relevant to Exhibit 1027 ¶¶ 56-60, Exhibit 1032, Exhibit 2016 at 92:20-93:20, and Exhibit 2033 at 170-171.

The testimony relates to the credibility and reliability of Dr. Sturges’s opinions on fluid flow. Specifically, Dr. Sturges relies on page 171 of the Sabersky book to model an eddying wake from a cylinder without being familiar with page 170, which at Figure 6-1b illustrates “[f]low past a slender body without separation” forming a diffusing wake. Ex. 2033 at 170. And while Dr. Sturges believes Hon ’043’s heating wire is a slender body because it is “small in diameter,” Ex. 1027 ¶ 56, he instead cites Figure 6-1d on page 171, which illustrates “[s]eparation behind a cylinder.” Ex. 2033 at 171. But Dr. Sturges

describes Hon '043's heating element as a "coil," which is not a cylinder. Ex. 2030, 65:18-24, 69:21-70:4; Ex. 2016, 70:23-71:7.

Dr. Sturges' testimony from IPR2016-01692 undermines his opinions regarding whether Hon '043's porous body is "supported by" the cavity wall. In Exhibit 2029, Dr. Sturges testified that the term "set on" does not require "supported by." Ex. 2029, 82:5-18. This testimony is relevant to Exhibit 1027 ¶ 22 because it demonstrates that Dr. Sturges' reasoning is contradictory. Specifically, while Dr. Sturges testified in Exhibit 2029 that "set on" does not require "supported by," in Exhibit 1027 he argues that "set on" necessarily requires "supported by" as follows: "the porous component in the 742 patent is set on the frame; as such, the frame *necessarily* supports the weight of the porous body." Ex. 1027 ¶ 22 (emphasis added). Petitioner will argue in response that Dr. Sturges was referring to Patent Owner's expert's opinion, not his own. But Dr. Sturges testifies that this was his own opinion: "Meyst's testimony supports *my opinion* that the cavity wall in Hon 043 provides weight-bearing support to the porous body." Ex. 1027 ¶ 22 (emphasis added).

Dr. Sturges's testimony from IPR2016-01692 undermines his opinion about whether Hon '043 discloses a "friction fit" or "bonding material." In Exhibit 2029, Dr. Sturges testified that the phrase "set on a frame" means "to cause to sit on a

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