

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

Case IPR2016-01268

Patent 8,365,742

**PETITIONER'S REPLY TO PATENT OWNER'S BRIEF REGARDING
DR. ROBERT H. STURGES' TESTIMONY IN IPR2016-01692 PURSUANT
TO BOARD'S SEPTEMBER 14, 2017 ORDER (PAPER 45)**

I. Dr. Sturges Did Not “Change” His Opinion About Hon 043’s Ejection Holes

Dr. Sturges did not change his opinion about Hon 043’s ejection holes.

Consistent with the teachings of Hon 043, Dr. Sturges opines in his Reply Declaration that the droplets ejected from Hon 043’s ejection holes are not atomized. Ex. 1027, ¶¶59-61; *see also* Ex. 1003-00011 (“To simplify the design, the first piezoelectric element 23 on the atomizer 9 can be omitted, and the atomization of the nicotine solution will be made only by the heating element 26.”).

In contending that Dr. Sturges’ Reply Declaration reflects a “change” in opinion, P.O. points to Dr. Sturges’ previous testimony in the 1692 IPR. But that testimony does not demonstrate any purported “change” in opinion. A review of that testimony reveals that Dr. Sturges was merely responding to questions about atomizers generally, and not whether Hon 043’s ejection holes are atomizers. *See* Ex. 2029, 87:6-95:1.

Indeed, it is Meyst – not Dr. Sturges – who vacillates about Hon 043’s ejection holes. In support of P.O.’s Preliminary Response, Meyst never referred to the droplets ejected from Hon 043’s ejection holes as atomized. *See* Ex. 2001, ¶32. However, in an effort to muster support for a “teaching away” argument (*i.e.*, that Hon 043 modified with Whittemore’s wick would allegedly absorb purportedly atomized droplets ejected from Hon 043’s ejection holes), Meyst

shifted gears and opined for the first time that Hon 043’s ejection holes are “essentially a plain orifice atomizer.” Ex. 2015, ¶137. But when confronted with the express teachings of Hon 043 during cross-examination, Meyst waived, explaining that he needed “more time” to review Hon 043 before he could stand by his opinion that Hon 043’s ejection holes are atomizers. Ex. 1023, 70:4-8; 80:12-82:13.¹

II. Dr. Sturges’ Opinions About Fluid Flow Are Reliable

In an effort to make Fig. 6-1b of Sabersky relevant (and thus a figure with respect to which Dr. Sturges should have been intimately familiar), P.O. incorrectly – and for the first time² – argues that Hon ‘043’s heating wire is a slender body that would cause a diffusing wake akin to the “slender strut” illustrated in Fig. 6-1b instead of the cylinder that causes an eddying wake as illustrated in Fig. 6-1d of Sabersky.³ But the evidence is to the contrary. Hon 043 itself refers to “eddy flow” (not diffusing flow) through the atomization chamber,

¹ Meyst ultimately clung to the opinion that Hon 043’s ejection holes are atomizers. *See id.*, 148:1-158:7.

² P.O. ignores the Board’s instruction that new arguments should not be raised in this supplemental briefing. Paper 45, p. 4.

³ Sabersky is marked as Ex. 2033 in both this IPR and the 1692 IPR.

and P.O.'s expert Meyst acknowledged that Hon 043's heating wire contributes to that eddy flow. Ex. 1003, p. 11; Ex. 1035, 52:7-19; 54:7-21. Thus, and consistent with Dr. Sturges' opinion, the PHOSITA would have understood that the eddying flow caused by Hon 043's heating wire is similar to the eddying flow illustrated in Fig. 6-1d, and not the diffusing flow illustrated in Fig. 6-1b.

Also without merit is P.O.'s argument that Dr. Sturges "believes" that Hon 043's heating wire is a "slender body." But no such testimony exists. Rather, Dr. Sturges' opinion that Hon 043's heating wire has a "small . . . diameter" is entirely consistent with the wire having a cylindrical shape. Moreover, Hon 043's heating wire can have both a cylindrical shape while also being configured into the very loose "coil" illustrated in Fig. 6 of Hon 043.

Finally, and ignored by P.O., Dr. Sturges explained that additional information beyond that provided by Sabersky would be necessary to assure creation of a diffusing wake, but acknowledged that a PHOSITA would have been capable of creating such a system. Ex. 2029, 114:8-115:21.

III. Dr. Sturges' Testimony Does Not "Undermine" His Opinion That Hon 043's Porous Body Is "Supported By" The Cavity Wall

Dr. Sturges has consistently opined in the 1692 IPR that the "set on" limitation of the 548 patent encompasses but does not require that the frame provide weight-bearing support for the porous component. Ex. 2029, 28:25-34:18, 80:13-82:22. Notwithstanding P.O.'s argument to the contrary, that testimony is

not inconsistent with Dr. Sturges' opinion in this IPR that Hon 043's cavity wall provides weight-bearing support for the porous body as articulated in Ex. 1027, ¶22.

In ¶22, Dr. Sturges cites to Meyst's testimony that the frame of the 742 patent provides weight-bearing support for the porous component. Ex. 1023, 34:16-23, 40:4-13. As Dr. Sturges explains, Meyst's reasoning about weight-bearing support applies with equal force to the cavity wall of Hon 043. Ex. 1027, ¶22. Dr. Sturges did not opine, nor did he otherwise adopt as his own Meyst's opinion, that the term "set on" requires weight-bearing support. That is a separate issue, which is not even addressed by Dr. Sturges in ¶22.

IV. Dr. Sturges' Testimony Does Not "Undermine" His Opinion That Hon 043 Discloses a Friction Fit Or Bonding Material

P.O. reads far too much into Dr. Sturges' deposition testimony from the 1692 IPR in an effort to create the misimpression that if Hon 043's porous body is "set on" the cavity wall (as Dr. Sturges opines in the 1692 IPR) then that necessarily means that the porous body cannot be "attached" to the cavity wall by a friction fit or with a bonding material as he testifies in this IPR. P.O.'s argument is without merit.

First, there is no material dispute in this IPR that the PHOSITA would have understood that Hon 043's porous body is attached in some fashion to the cavity wall. *See e.g.* Ex. 1015, ¶ 45; Ex. 1020, ¶¶ 4-8; Ex. 1027, ¶¶ 18-20. Indeed, P.O.'s

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