

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: LIK HON
APPLICATION NO.: 13/740,011
FILED: JANUARY 11, 2013
FOR: **ELECTRONIC CIGARETTE**

EXAMINER: DIONNE WALLS
MAYES
ART UNIT: 1747
CONF. NO: 5634

STATEMENT OF RELATED APPLICATIONS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Commissioner:

Applicant advises that the following may be material to the examination of the present Application. The U.S. applications or U.S. patents identified below all claim priority to PCT/CN07/001575 (Family 4A in the attached Table) and include certain elements in common with the claims of the present application.

1. In 12/226,818, now U.S. Patent No. 8,156,944, Examiner Mayes rejected claims over CN 2719043 (Family 3 US 2007/0267031) in view of Hon US 2006/0196518 (Family 2). U.S. Patent No. 8,156,944 is in reexamination in 95/002,235 with claims rejected over CN 03111582.9 (Family 3) alone, and in combination with CN

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I hereby certify that this paper (along with any referred to as being attached or enclosed) is being electronically filed with the U.S. Patent and Trademark Office on the date entered below.

December 22, 2015
Date of Electronic Submission

/Debbie Gilbert/
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111971-8012.US03/129082809.1

200420031182 (Family 2). In the reexamination the requestor also proposed rejections further relying on Kessler U.S. Patent No. 6,095,153, Roberts et al U.S. Patent No. 4,819,665, Gerth U.S. Patent No. 4,735,217, Brooks U.S. Patent No. 4,947,874, Counts U.S. Patent No. 5,388,594; Chester EP 0295122 and Deevi U.S. Patent No 5,224,498, which were not adopted in the reexamination. The requestor has further proposed rejections based on the combination of Hon CN 2719043 (Family 3 US 2007/0267031) and Hon US 2006/0196518 (Family 2) and Oljaca et al U.S. Patent No. 6,601,776.

In IPR2013-00387 a Petition was filed asserting claims in U.S. Patent No. 8,156,944 are invalid over Liu WO2007/078273 alone, and in combination with Susa EP845220B1, Hon WO2005/099494 (Family 3), and Liu with Susa and WO2005/099494 (Family 3). Claims in U.S. Patent No. 8,156,944 have been ruled to be invalid over Liu and Hon WO2005/099494 (Family 3) in a final decision in IPR2013-00387 which is currently on appeal.

2. Application 13/079,937, now U.S. Patent No. 8,365,742, was allowed with no prior art rejections. In an in-person 8/14/2012 interview the following references were discussed: Voges, U.S. Patent No. 6,196,218; Robinson, U.S. Patent No. 1,775,947; Counts, U.S. Patent No. 5,144,962; Brooks, U.S. Patent No. 4,947,875; Susa EP 0845220 B1; Hon Lik WO2004/095955 (Family 2); and Hon Lik WO2005/099494 (Family 3).

In IPR2015-00859 a Petition was filed asserting claims of U.S. Patent No. 8,365,742 are invalid over CN 2719043 (Family 3); Susa EP 0845220; Counts U.S. Patent No. 5,144,962; Abhuliman WO 2003/034847 and Whittemore U.S. Patent No. 2,057,353. In a 9/16/2015 Decision, the Patent Trial and Appeal Board denied this

Petition on the basis that the Petitioner had not established a reasonable likelihood of prevailing with respect to the claims in the patent.

In IPR2015-01587 a Petition was filed asserting claims of U.S. Patent No. 8,365,742 are invalid over Takeuchi U.S. Patent No. 6,155,268; Cox U.S. Patent No. 6,234,167; Brooks U.S. Patent No. 4,947,874; Whittemore U.S. Patent No. 2,057,353; Susa EP 0845220; and Liu WO 2007/078273 A1; and specifically that Claims 1-3 are obvious over Takeuchi; Claims 1-3 are obvious over Takeuchi in view of Cox; Claims 1 and 3 are obvious over on Brooks; Claims 1-3 are obvious over Brooks in view of Whittemore; Claims 1-3 are obvious over Liu in View of Susa; Claims 1-3 are anticipated by Susa; Claim 3 is obvious over Susa; and Claims 1-3 are obvious over Susa in view of Whittemore. This proceeding was dismissed in a 12/14/2015 Order based on settlement.

3. In Application No. 14/244,376 claims were rejected for double patenting over US Patent No. 8,156,944 (referenced above) and over the present application 13/740,011. Claims were also rejected over Susa EP 845220 alone, and in combination with Brooks US Patent No. 4,922,901.

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4. As discussed during the December 1, 2015 Examiner Interview in 14/244,376, this paper refers only to the examination of applications claiming priority to PCT/CN07/001575, and not to the examination of other applications filed by the inventor and directed to electronic cigarettes as listed in the attached IPR Summary Table.

Dated: December 22, 2015

Respectfully submitted,

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IPR Summary

Challenged Patent Family	Case Number Perkins Ref.	Petitioner Opposing Counsel	IPR Filed/ Served	Mandatory Notices (+21 days from service)	Notice of Filing Date Mailed	Preliminary Response (+3 months from date of Notice of Filing Date)	Institution Decision & Scheduling Order
8156944 4A	IPR2013-00387 111971-0010	CBDR	6/27/2013	Due 7/18/2013 Filed 7/17/2013	7/2/2013	Due 10/2/2013 Not filed	12/30/2013
8393331 3	IPR2014-01289 111971-0012	NJOY Ropes & Gray	8/14/2014	Due 9/4/2014 Filed 9/4/2014	8/26/2014	Due 11/20/2014 Filed 11/20/2014	2/19/2015
8490628 3	IPR2014-01500 111971-0013	NJOY Ropes & Gray	8/15/2014	Due 9/5/2014 Filed 9/4/2014	8/26/2014	Due 11/20/2014 Filed 11/20/2014	2/19/2015
8688805 6	IPR2014-01529 111971-0015	CBDR - Morrison Foerster NJOY - Ropes & Gray	9/22/2014	Due 10/13/2014 Filed 10/13/2014	10/8/2014	Due 1/8/2015 Filed 1/8/2015	3/12/2015
8375957 4B	IPR2015-00098 111971-0016	Logic	10/21/2014	Due 11/11/2014 Filed 11/11/2014	11/18/2014	Due 2/18/2015 Filed 2/18/2015	5/11/2015 (NOT INSTITUTED)
8365742 4A	IPR2015-00459 111971-0017	VMR FeidmanGate	3/10/2015	Due 3/31/2015 Filed 3/31/2015	3/26/2015	Due 6/20/2015 Filed 6/22/2015	9/16/2015 (NOT INSTITUTED)

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