

Paper No. \_\_\_\_  
Filed: July 18, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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**NU MARK LLC,**  
Petitioner,

v.

**FONTEM HOLDINGS 1 B.V.,**  
Patent Owner.

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Case **IPR2016-01303**  
Patent No. **8,365,742**

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**PATENT OWNER'S MANDATORY NOTICES**

Pursuant to 37 C.F.R. § 42.8, Patent Owner, Fontem Holdings 1 B.V. submits the following Mandatory Notices in response to the above-captioned Petition for *Inter Partes* Review of U.S. Patent No. 8,365,742 (“the ‘742 patent” or “the involved patent”).

## **1. Real Party-In-Interest**

In accordance with 37 C.F.R. § 42.8(b)(1), Patent Owner identifies the real party-in interest as Fontem Holdings 1 B.V., a Netherlands corporation, located at 12th Floor, Barbara Strozziilaan 101, 1083 HN Amsterdam, The Netherlands. Fontem Holdings 1 B.V. is a wholly owned subsidiary of Fontem Ventures B.V., also located at 12th Floor, Barbara Strozziilaan 101, 1083 HN Amsterdam, The Netherlands. Fontem Ventures B.V. is an indirect wholly owned subsidiary of Imperial Brands PLC. Imperial Brands PLC is an English corporation having a registered office at 121 Winterstoke Road, Bristol, UK BS3 2LL. Fontem Holdings 1 B.V. has granted Fontem Ventures B.V. an exclusive license to the ’742 patent. Fontem Holdings 1 B.V. became the Patent Owner via an assignment executed December 9, 2013.

## **2. Related Proceedings**

In accordance with 37 C.F.R. § 42.8(b)(2), Patent Owner identifies the following related judicial proceedings (involving, among other patents, the ‘742

patent, U.S. Patent No. 8,156,944, which is a priority case to the '742 patent, and U.S. Patent No. 9,326,548, which shares priority claims with the '742 patent):

**a.** *Fontem Ventures B.V. and Fontem Holdings I B.V. v. R.J. Reynolds Vapor Company*, Civil Action No. 16-CV-2286 GW (MRW), U.S. District Court for the Central District of California;

**b.** *Fontem Ventures B.V. and Fontem Holdings I B.V. v. R.J. Reynolds Vapor Company*, Civil Action No. 16-CV-3049 GW (MRW), U.S. District Court for the Central District of California;

**c.** *Fontem Ventures B.V. and Fontem Holdings I B.V. v. Nu Mark LLC*, Civil Action No. 16-CV-2291 GW (MRW), U.S. District Court for the Central District of California;

**d.** *Fontem Ventures B.V. and Fontem Holdings I B.V. v. Nu Mark LLC*, Civil Action No. 16-CV-4537, U.S. District Court for the Central District of California;

**e.** *Fontem Ventures B.V. and Fontem Holdings I B.V. v. NJOY, Inc.*, Civil Action No. 14-CV-1645 GW (MRW), U.S. District Court for the Central District of California;

**f.** *Fontem Ventures B.V. and Fontem Holdings I B.V. v. LOEC, Inc., dba blue cigs*, Civil Action No. 14-CV-1648 GW (MRW), U.S. District Court for the Central District of California;

**g.** *Fontem Ventures B.V. and Fontem Holdings 1 B.V. v. CB Distributors, Inc. and DR Distributors, LLC, dba 21st Century Smoke, LLC*, Civil Action No. 14-CV-1649 GW (MRW), U.S. District Court for the Central District of California;

**h.** *Fontem Ventures B.V. and Fontem Holdings 1 B.V. v. Vapor Corp.*, Civil Action No. 14-CV-1650 GW (MRW), U.S. District Court for the Central District of California;

**i.** *Fontem Ventures B.V. and Fontem Holdings 1 B.V. v. Fin Branding Group, LLC and Victory Electronic Cigarettes Corporation*, Civil Action No. 14-CV-1651 GW (MRW), U.S. District Court for the Central District of California;

**j.** *Fontem Ventures B.V. and Fontem Holdings 1 B.V. v. Ballantyne Brands, LLC*, Civil Action No. 14-CV-1652 GW (MRW), U.S. District Court for the Central District of California;

**k.** *Fontem Ventures B.V. and Fontem Holdings 1 B.V. v. Spark Industries, LLC*, Civil Action No. 14-CV-1653 GW (MRW), U.S. District Court for the Central District of California;

**l.** *Fontem Ventures B.V. and Fontem Holdings 1 B.V. v. Logic Technology Development LLC*, Civil Action No. 14-CV-1654 GW (MRW), U.S. District Court for the Central District of California;

**m.** *Fontem Ventures B.V. and Fontem Holdings 1 B.V. v. VMR Products, LLC, dba V2CIGS*, Civil Action No. 14-CV-1655 GW (MRW), U.S. District Court for the Central District of California;

**n.** *Ruyan Investment (Holdings) Limited v. Sottera, Inc.*, Civil Action No. 12-CV-5454 GAF(FFM), U.S. District Court for the Central District of California;

**o.** *Ruyan Investment (Holdings) Limited v. LOEC, Inc.*, Civil Action No. 12-CV-5455 GAF(FFM), U.S. District Court for the Central District of California;

**p.** *Ruyan Investment (Holdings) Limited v. CB Distributors, Inc. et al*, Civil Action No. 12-CV-5456 GAF(FFM), U.S. District Court for the Central District of California;

**q.** *Ruyan Investment (Holdings) Limited v. The Safe Cig LLC*, Civil Action No. 12-CV-5462 GAF(FFM), U.S. District Court for the Central District of California;

**r.** *Ruyan Investment (Holdings) Limited v. Vapor Corp.*, Civil Action No. 12-CV-5466 GAF(FFM), U.S. District Court for the Central District of California;

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