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

U.S. Patent 8,365,742
Issue Date: Feb. 5, 2013
Title: Aerosol Electronic Cigarette

Inter Partes Review No. 2016-01532

PETITIONER'S REQUEST FOR REHEARING PURSUANT TO 37 C.F.R. § 42.71(d)

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I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.71(d), R.J. Reynolds Vapor Company ("Reynolds" or "Petitioner") requests rehearing of the Board's Decision denying institution of *Inter Partes* Review entered February 7, 2017 (Paper 9, hereinafter "Decision").

II. BASIS FOR REHEARING

A. Legal Standard

Pursuant to 37 C.F.R. § 42.71(c)-(d) a party may request rehearing of a decision by the Board on whether to institute trial without prior authorization from the Board. "The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each such matter was previously addressed in a motion, an opposition, or a reply." *Id.* The Board will review the previous decision for an abuse of discretion. 37 C.F.R. § 42.71(c). "An abuse of discretion may be indicated if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors." IPR 2013-00369, Paper 39 at 2-3 (citing *Star Fruits S.N.C. v. United States,* 393 F.3d 1277, 1281 (Fed. Cir. 2005).

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B. The Board's Priority Decision Is Not Supported By Substantial Evidence

Petitioner's sole ground asserts that claims 2 and 3 of U.S. Patent No. 8,365,742 ("742 patent," Ex. 1001) are anticipated by U.S. Patent Application Publication No. 2009/0095311 A1, published on April 16, 2009 ("311 publication", Ex. 1002). The 311 publication is the publication of U.S. Application Serial No. 12/226,818 ("818 application" or "parent 811 publication," Ex. 1009). In support of the ground for anticipation, Petitioner contends that the parent 818 application does not provide written description support for claims 2 and 3 of the 742 patent. As such, claims 2 and 3 are not entitled to the filing date of the parent 818 application, and thus the intervening publication of the 818 application (*i.e.,* the 311 publication) anticipates claims 2 and 3. Petition at 1-10, 15, 33, 37-54; Ex. 1012 at ¶¶ 21-39, 42-54.

As set forth in the Petition, the 818 application repeatedly and narrowly describes the "invention" (and not merely an embodiment of the invention) as an electronic cigarette with the battery assembly and atomizer assembly located in the ***same shell***. This limiting disclosure was removed via an intervening "substitute specification." In contrast to the 818 application, which describes the invention as the battery and atomizer assembly in the ***same shell***, claims 2 and 3 of the 742 patent are not so limited, permitting the battery assembly and atomizer assembly to be located in either the same or ***separate shells*** of a housing. Petition at 2, 5-10,

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37-54; Ex. 1012 at ¶¶ 42-54; Ex. 1009 at 12-31; Ex. 1001 at 14. Notwithstanding the difference between the scope of claims 2 and 3 of the 742 patent and the narrow description set forth in the 818 application, the Board nonetheless found that the 818 application provides written description support for broad claims 2 and 3. Decision at 14. Petitioner respectfully submits that the Board's finding is not supported by substantial evidence.

1. The Written Description Requirement

Compliance with the written description requirement is a question of fact. *ScriptPro LLC v. Innovation Assocs.,* 833 F.3d 1336, 1340 (Fed. Cir. 2016). As the Board correctly noted, to satisfy the written description requirement, the disclosure of the priority application must convey with reasonably clarity to those skilled in the art that, as of the filing date sought, the inventor was in possession of the claimed invention. *See* Decision at 10-11.

2. The Board Misapprehended The Disclosure of The 818 Application

The specification, drawings, and original claims of the 818 application narrowly describe the "invention" as a battery assembly and atomizer assembly located in the ***same shell***, *i.e.,* shell (a). Petition at 5-8, 38-44; Ex. 1012 at ¶¶ 42-54; Ex. 1009 at 12-14, 16-27. Figure 2 (annotated) from the 818 application is representative:

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