

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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R.J. REYNOLDS VAPOR COMPANY,  
Petitioner,

v.

FONTEM HOLDINGS 1 B.V.,  
Patent Owner.

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Case IPR2016-01692  
Patent 9,326,548 B2

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Before JO-ANNE M. KOKOSKI, KRISTINA M. KALAN, and  
KIMBERLY McGRAW, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5, 37 C.F.R. § 42.123(b)*

On October 19, 2017, the Board received an email from Petitioner’s counsel requesting authorization to submit supplemental information. Petitioner indicated that Patent Owner opposes Petitioner’s request. A teleconference to consider the request was held on October 20, 2017, among Judges Kokoski, Kalan, and McGraw, and counsel for the parties. A court reporter was on the line, and a copy of the transcript will be filed as an exhibit in this proceeding in due course.<sup>1</sup>

Our rules allow a party to submit supplemental information more than one month after the institution of trial where (1) the supplemental information could not reasonably have been obtained earlier and (2) consideration of the supplemental information would be in the interests-of-justice. 37 C.F.R. § 42.123(b).

Petitioner stated during the call that it seeks to submit a copy of Patent Owner’s proposed preliminary claim construction of the term “run-through hole” in a related district court proceeding involving the same patent and the same parties. Petitioner represented that it received this document on October 13, 2017, and that Patent Owner’s proposed claim construction therein contradicts the position Patent Owner takes in the present proceeding. Petitioner argued that consideration of this document would be in the interests of justice, given the recent nature of Patent Owner’s proposed claim construction and the allegedly contrary positions taken by Patent Owner in the district court proceeding and before the Board.

Patent Owner responded that its position in the October 13, 2017 preliminary claim construction document is not inconsistent with its position

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<sup>1</sup> This order summarizes the statements made during the conference call. A more detailed record may be found in the transcript.

in this proceeding. Patent Owner also emphasized that its proposed claim constructions in the district court proceeding are preliminary, noting that, in the district court, opening briefs regarding claim construction are due in December, and responsive briefs are due in January. If the Board were to allow Petitioner to submit the October 13, 2017 document, Patent Owner argued, Patent Owner should be allowed to submit Petitioner's preliminary claim construction documents filed in the same district court proceeding. Petitioner did not object to this proposal.

After consideration of the arguments of counsel for the parties, we determine that the proposed information could not reasonably have been obtained earlier, given the timeline of the claim construction portion of the district court proceeding. We also determine that consideration of the supplemental information would be in the interests-of-justice, because the parties' claim construction positions in the district court proceeding allegedly are either inconsistent with or illuminate their positions in this proceeding, and we are persuaded that the documents discussed during the conference call may be relevant to our analysis of the parties' claim construction and arguments related thereto in this proceeding.

Petitioner is authorized to submit, as supplemental information under 37 C.F.R. § 42.123(b), Patent Owner's preliminary claim construction document, dated October 13, 2017, as identified during the conference call; Patent Owner is authorized to submit Petitioner's preliminary claim construction documents, dated September 18, 2017 and September 25, 2017, as identified during the conference call. No cover sheet, argument, or any other filing is authorized at this time. The parties may, if desired, present

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arguments directed to these submissions at the upcoming Oral Hearing on October 26, 2017.

Accordingly, it is

ORDERED that the parties may file the three documents identified in this Order in the manner set forth in this Order, along with an updated Exhibit List for each party; and

FURTHER ORDERED that no cover sheet, argument, or other filing is authorized at this time.

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