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EXAMINER

FELTON, MICHAEL J

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1747

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ELECTRONIC

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RAI Strategic Holdings, Inc.
Exhibit 2034
Philip Morris Products, S.A. v. RAI Strategic Holdings, Inc.
IPR2020-00919



1. The present application is being examined under the pre-AIA first to invent provisions.

### DETAILED ACTION

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of pre-AIA 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under pre-AIA 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating

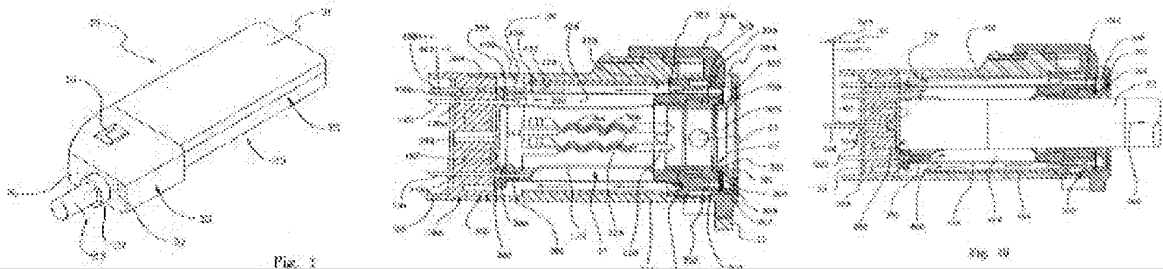
obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under pre-AIA 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

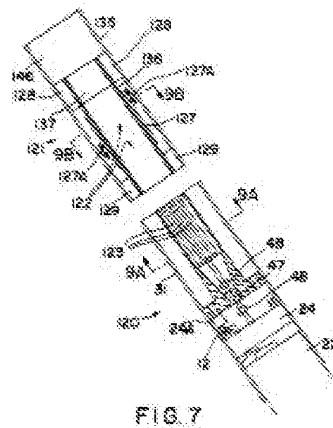
not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of pre-AIA 35 U.S.C. 103(c) and potential pre-AIA 35 U.S.C. 102(e), (f) or (g) prior art under pre-AIA 35 U.S.C. 103(a).

5. Claims **16-29** are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Counts et al. (US 5,954,979) in view of Collins et al. (US 5,505,214).

6. Regarding claims **16, 19, 20, 23, and 28**, Counts et al. disclose an aerosol generating system 21 comprising an aerosol-forming article 23 comprising an aerosol-forming substrate 80 and a mouthpiece portion 94 for allowing a user to draw air through the substrate and an aerosol generating device 25, the device comprising a housing 31 having proximal and distal ends and comprising at least one external surface and one internal surface, the internal surface defining an open ended cavity 27 at the proximal end of the housing in which the aerosol-forming substrate is received (see figure 1), the cavity having a longitudinal extent between its proximal and distal ends (see figure 6), a heater element 37 within the cavity configured to heat an aerosol-forming substrate received in the cavity, and air inlets 324, wherein the system comprises a first air flow channel extending from the air inlets to a distal end of the cavity, wherein the first air flow channel 410 extends between the heater and the external surface of the housing along at least a portion of the longitudinal extent of the cavity (see figure 6), and a second air flow channel 420+466 extending from the distal end of the cavity to the mouthpiece portion (see figure 10).



7. Counts et al. do not disclose the heater element is in the form of a pin or blade that extends into the substrate. However, Collins et al. disclose an analogous aerosol device and disclose that heating element and substrate may be arranged so that the heating element blade/pin enters into the substrate (see Figure 7, below and col. 10, line 65—col. 11, line 17) in addition to the arrangements where the heating elements are outside the substrate as shown in Counts et al. It would have been obvious to one of ordinary skill in the art at the time of invention to use this alternate arrangement of heating element and substrate as disclosed by Collins et al.



8. Regarding claims **17 and 29**, Counts et al. discloses that a frit in the air flow path, "renders a desired resistance to draw ("RTD") at a predetermined flow rate...in the range of approximately 70 to 100 mm of water." (col. 13, 36-49).

9. Regarding claim **18**, because the frit is within the flow channel of Counts et al. and achieves the desired RTD, one of ordinary skill in the art would expect that the flow channel (and frit) would contribute greater than 10% of the entire RTD. In addition, the

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