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**UNITED STATES INTERNATIONAL TRADE COMMISSION  
WASHINGTON, D.C.**

**Before the Honorable Clark S. Cheney  
Administrative Law Judge**

**In the Matter of**

**CERTAIN TOBACCO HEATING  
ARTICLES AND COMPONENTS  
THEREOF**

**Investigation No. 337-TA-1199**

**RESPONDENTS' JOINT DISCLOSURE OF FINAL CONTENTIONS IN RESPONSE  
TO INDIVIDUAL INTERROGATORY NO. 12**

**I. INTRODUCTION**

Respondents Altria Client Services LLC, Altria Group, Inc., Philip Morris USA Inc., Philip Morris International Inc., and Philip Morris Products S.A. (collectively, "Respondents") provide the following final contentions in response to Individual Interrogatory No. 12.

Complainants assert claims from U.S. Patent No. 9,839,238 ("the '238 patent"); U.S. Patent No. 9,930,915 ("the '915 patent"); and U.S. Patent No. 9,901,123 ("the '123 patent") (collectively, "the Asserted Patents"). In particular, Complainants allege that Respondents infringe claim 19 of the '238 patent; claims 1, 2, 3, and 5 of the '915 patent; and claims 27-30 of the '123 patent (collectively, "the Asserted Claims"). Complainants also contend that their Domestic Industry Products practice claims 1-3, 5-11, 13, 15-16, 18-21 of the '238 patent; claims 1-4 of the '915 patent; and claims 1-7, 9, 11-19, 21, 23-26 of the '123 patent (collectively, "the Domestic Industry Claims"). Respondents' final contentions address the Asserted Claims and the Domestic Industry Claims of the Asserted Patents.

**Philip Morris Products, S.A.  
Exhibit 1036  
PMP v. RAI  
IPB2020-00010**

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which the patentee claims priority. *See PowerOasis, Inc.*, 522 F.3d at 1304-06; *see also Research Corp. Techs., Inc. v. Microsoft Corp.*, 627 F.3d 859, 870 (Fed. Cir. 2010). As explained below in Sections IV.C.2 and IV.C.3, the validity of the Domestic Industry Claims hinges on the priority date of the Domestic Industry Claims of the '123 Patent in view of at least the Hon '957 prior art reference and VUSE Vibe prior art system. *See* Ex. C6 (Hon '957) and Compl. Ex. 42 (VUSE Vibe). Accordingly, the burden relating to the '123 patent's priority shifts to Complainants, and Complainants must prove that the '123 Patent Domestic Industry Claims are entitled to claim priority to the '634 Application.

Respondents further note that even if the claims of the '123 patent are not subject to the AIA (they are), Complainants bear the burden of proving earlier conception and/or reduction to practice on a claim-by-claim basis. Complainants have not done so. To date, Complainants have merely stated in conclusory fashion that the '123 patent "is entitled to a priority date of at least as early as October 18, 2006." Complainants' Responses to Respondents' First Set of Interrogatories (No. 8) (May 28, 2020). If Complainants can carry their burden of proving that the Asserted and/or Domestic Industry claims are entitled to claim priority to this date, and also argue that any of the Asserted Claims and/or Domestic Industry Claims of the '123 patent have an earlier conception or reduction to practice date, then Respondents reserve the right to respond, including by identifying additional prior art and contentions.

Respondents reserve the right to supplement their final contentions through expert discovery.

## **2. Prior Art Patents, Patent Applications, and Publications**

The patents, patent applications, and publications identified in the table below are prior art to the '123 patent, and they anticipate and/or render obvious the Asserted and/or Domestic Industry Claims of the '123 patent.

<b>Prior Art</b>	<b>Issuing Country</b>	<b>Date</b>	<b>Inventor(s)/Author(s)</b>	<b>Exhibit</b>
U.S. Patent No. 5,249,586 ("Morgan")	U.S.	Oct. 5, 1993	Morgan, Constance H. Nichols, Walter A.	C1
International Patent Application Publication No. WO 95/27412 ("Hajaligol")	WIPO	Oct. 19, 1995	Hajaligol, Mohammad R. Fleischhauer, Grier S., <i>et al</i>	C2
Chinese Patent No. 2719043 ("Hon '043")	China	Aug. 24, 2005	Lik, Hon	C4
Chinese Patent No. 1775123 ("Yang")	China	May, 24, 2006	Yinhai, Yang	C5
U.S. Patent No. 8,375,957 ("Hon '957")	U.S.	May 16, 2006	Lik, Hon	C6
U.S. Patent Application Publication No. 2007/0102013 ("Adams")	U.S.	Sept. 28, 2006	Adams, John M. Crowe, William J., <i>et al.</i>	Addressed as appropriate
U.S. Patent No. 5,144,962 ("Counts-962")	U.S.	Sept. 8, 1992	Counts, Mary E. Hajaligol, Mohammad R., <i>et al.</i>	Addressed as appropriate
U.S. Patent No. 4,947,874 ("Brooks")	U.S.	Aug. 14, 1990	Brooks, Johnny L. Roberts, Donald L. Simmons, Jerry S.	Addressed as appropriate
U.S. Patent No. 5,060,671 ("Counts-671")	U.S.	Oct. 29, 1991	Counts, Mary E. LaRoy, Bernard C., <i>et al</i>	Addressed as appropriate
U.S. Patent No. 5,692,525 ("Counts-525")	U.S.	Dec. 2, 1997	Counts, Mary E. Houck, Willie G., Jr. <i>et al</i>	Addressed as appropriate
U.S. Patent No. 5,095,921 ("Losee")	U.S.	Mar. 17, 1992	Losee, Bruce D. Morgan, Constance H., <i>et al</i>	Addressed as appropriate
U.S. Patent No. 5,591,368 ("the '368 patent")	U.S.	Jan. 7, 1997	Fleischhauer, Grier S. Hayes, Patrick H., <i>et al</i>	Addressed as appropriate
International Patent Application Publication No. WO 96/32854 ("Baggett")	WIPO	Oct. 24, 1996	Baggett, James D., Jr. Clark, David A., <i>et al</i>	Addressed as appropriate

Prior Art	Issuing Country	Date	Inventor(s)/Author(s)	Exhibit
Korean Patent No. 10-0636287 (“Park”)	Korea	Oct. 12, 2006	Park, Dae Geun Lee, Yung Taek Lee, Dong Wook	Addressed as appropriate
U.S. Patent No. 5,498,855 (“Deevi-855”)	U.S.	Mar. 12, 1996	Deevi, Seetharama C. Lilly, A. Clifton, Jr.	Addressed as appropriate
U.S. Patent No. 4,510,950 (“Keritsis”)	U.S.	Apr. 16, 1985	Keritsis, Gus. D. Nichols, Walter A.	Addressed as appropriate
U.S. Patent No. 2,104,266 (“McCormick”)	U.S.	Jan. 4, 1938	McCormick, W.J.	Addressed as appropriate
U.S. Patent No. 5,865,185 (“Collins-185”)	U.S.	Feb. 2, 1999	Collins, Alfred L. Counts, Mary Ellen, <i>et al</i>	Addressed as appropriate
U.S. Patent Application Publication No. 2007/0215167 (“Crooks”)	U.S.	Mar. 16, 2006	Crooks, Evon Llewellyn Conner, Billy Tyrone, <i>et al</i>	Addressed as appropriate
U.S. Provisional Application Serial No. 60/722,036	U.S.	Sept. 30, 2005	Adams, John M. Baggett, James D., Jr. Crowe, William J.	Addressed as appropriate
U.S. Patent No. 5,498,855 (“the ’855 patent”)	U.S.	Mar. 12, 1996	Deevi, Seetharama C. Lilly, A. Clifton, Jr.	Addressed as appropriate
UCSF Declaration of Custodian Records, Attachment 1 (“Bullet Heater”)	U.S.	February 1, 2002	Hajaligol, Mohammad R.	Addressed as appropriate
UCSF Declaration of Custodian Records, Attachment 2 (“Bullet Shape Design”)	U.S.	December 4, 2014	Hajaligol, Mohammad R. Higgins, Charles	Addressed as appropriate

<b>Prior Art</b>	<b>Issuing Country</b>	<b>Date</b>	<b>Inventor(s)/Author(s)</b>	<b>Exhibit</b>
UCSF Declaration of Custodian Records, Attachment 3 (“Cigarette Brainstorming Team Number 2”)	U.S.	February 1, 2002	Jones, Jan Clark, Dave Pham, Xuan Hates, Pat Smith, Cecil Raymond, Wynn Amick, Debbie Watkins, Mike	Addressed as appropriate
UCSF Declaration of Custodian Records, Attachment 4 (“Heater Development”)	U.S.	February 1, 2002	Philip Morris USA	Addressed as appropriate
UCSF Declaration of Custodian Records, Attachment 5 (“An Outline of a Permanent Heater”)	U.S.	July 9, 2002	LaRoy, B. Utsch, F.	Addressed as appropriate
UCSF Declaration of Custodian Records, Attachment 6 (“Philip Morris Unpatented Invention Disclosures”)	U.S.	December 9, 2002	Philip Morris USA	Addressed as appropriate
UCSF Declaration of Custodian Records, Attachment 7 (“Project Beta Core Teams”)	U.S.	December 9, 2002	Philip Morris USA	Addressed as appropriate
UCSF Declaration of Custodian Records, Attachment 8 (“Beta Patent Review Meet Agenda”)	U.S.	June 15, 2004	Philip Morris USA	Addressed as appropriate
The Lady Smokes, www.theladysmokes.com (archived at web.archive.org, 2006-2007)	U.S.	Nov. 7, 2006	The LadySmokes	Addressed as appropriate
European Patent Publication 0 845 220 (“Susa”)	Europe	June 3, 1998	Susa, Masayuki Takeuchi, Manabu, <i>et al</i>	Addressed as appropriate

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