

Exhibit C1

U.S. Patent No. 5,249,586 (“Morgan”), alone or in combination with other prior art, anticipates and/or renders obvious to one of ordinary skill in the art 103 the asserted claims (27-30) of U.S. Patent No. 9,901,123 (the “123 patent”)

Respondents apply the prior art in light of Complainant’s improper assertions of infringement and improper application of the claims, do not agree with Complainant’s application of the claims, or that the claims satisfy 35 U.S.C. § 112. Respondents’ disclosures should in no way be seen as, admissions or adoptions as to any particular claim scope or construction, or as any admission that the prior art is met in any particular way. Respondents’ initial patent disclosures are made in a variety of alternatives and do not represent an agreement or view as to the meaning, definiteness, written description support for, or enablement of any claim contained in the prior art below are exemplary and identify exemplary instances where the prior art discloses a given limitation expressly or inherently.

Where Respondents cite to a particular figure in Morgan or in other art, the citation should be understood to encompass the figure itself, the caption and description of the figure, and any text relating to the figure. Similarly, where a cited portion of text is cited, the citation should be understood to include the figure as well. In addition, citations necessarily include any contextual description of the figure in Morgan.

Cl.	U.S. Patent No. 9,901,123	U.S. Patent No. 5,249,586
27(pre)	An electrically-powered, aerosol-generating smoking article comprising:	To the extent the preamble is limiting, Morgan discloses and/or anticipates the limitation. <i>See, e.g.,</i> “An article is provided in which a replaceable tobacco flavor substance is heated by a set of permanent reusable heaters to evolve inhalable components in vapor or aerosol form.” Morgan at Abstract. “An electrical smoking article according to the present invention, for example, to simulate a cigarette.” <i>Id.</i> at 3:9-11. “The parameters of the heaters are chosen to allow delivery of a tobacco flavor substance-e.g., an aerosol containing tobacco flavor substance under standard conditions of use.” <i>Id.</i> at 3:58-61.

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		<p>To the extent Complainants contend Morgan does not disclose this limitation, this limitation was well known and/or it would have been obvious to those skilled in the art at the time of Morgan's invention based on the methods and systems of Morgan and/or to combine Morgan with the prior art herein.</p>
27(a)	<p>an electrical power source in the form of a battery within a tubular outer housing having a mouth-end and an end distal to the mouth-end;</p>	<p>Morgan discloses and/or renders obvious this limitation.</p> <p><i>See, e.g.,</i></p> <p>Morgan at Fig. 2.</p> <p>“Article 10 includes reusable or "permanent" portion 20 and a heating element or cartridge 21 which is received in a cavity 30 at the mouth-end of the device. Reusable portion 20 includes, at the end remote from the mouth-end, a power source which could include a battery, a capacitor or both. The battery could be rechargeable or both. If the battery is rechargeable, or if power is provided by a power source alone, then article 10 is provided with charging contacts 11 or 12 for electrical connection to an external power supply (not shown) for charging the battery. Power source 22 provides power for heating elements 23, which are controlled by control circuit 24, which is in turn actuated by pushbutton 25 or an actuated sensor (not shown). Indicators 26, which could be light emitting diodes or visual indicators, reflect the status of the various heaters 23. The device also includes power source 22, control circuit 24, pushbutton 25 (or a puff-actuated sensor), and indicators 26 are described in more detail in above-incorporated copending patent application Ser. No. 07/444,746, filed Dec. 1, 1989, now U.S. Pat. No. 5,249,586. Portion 20 is preferably covered by cigarette wrapping paper or a similar material of a conventional cigarette. Perforations 12 may be provided in the side walls of portion 20 to allow outside air to be drawn in during puffing, or outside air may be drawn in through portion 20 via openings (not shown) at its far end 13.” <i>Id.</i> at col. 1, lines 1-10.</p> <p>To the extent Complainants contend Morgan does not disclose this limitation, this limitation was well known and/or it would have been obvious to those skilled in the art at the time of Morgan's invention based on the methods and systems of Morgan and/or to combine Morgan with the prior art herein.</p>

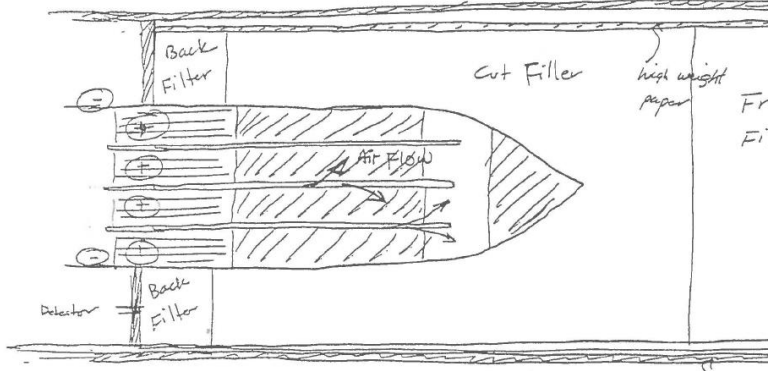
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27(b)	at least one electrical resistance heater powered by said electrical power source,	<p>Morgan discloses and/or renders obvious this limitation.</p> <p><i>See, e.g.,</i></p> <p>“Reusable portion 20 includes, at the end remote from the mouthpiece, a power source which could include a battery, a capacitor or both. The battery is rechargeable or both. If the battery is rechargeable, or if power is provided alone, then article 10 is provided with charging contacts 11 or 12 for electrical connection to an external power supply (not shown) for charging the battery. Power source 22 provides power for heating elements 23, which are under the control of control circuit 24, which is in turn actuated by push button 25 or an actuated sensor (not shown).” Morgan at 4:48-59.</p> <p>“An article is provided in which a replaceable tobacco flavor cartridge is heated by a set of permanent reusable heaters to evolve inhalable tobacco components in vapor or aerosol form.” <i>Id.</i> at Abstract.</p> <p>“More preferably, the heaters should have an active surface area of between about 10 and about 20 mm² and a resistance of between about 1.0 ohm and 1.6 ohms. The area and resistance requirements are interrelated, because heater power consumption is a function of resistance, which in turn is determined by resistivity and size.”</p> <p>“25. The article of claim 1 wherein said electrical heating member has a resistance between about 0.5 ohm and about 3.0 ohms.” <i>Id.</i> at Claim 25.</p> <p>“26. The article of claim 25 wherein said electrical heating member has a resistance between about 1.0 ohm and 1.6 ohms.” <i>Id.</i> at Claim 26. <i>Id.</i> at Figs. 2-8.</p> <p>“Alternatively, the heaters can protrude from the end of the mouthpiece and pierce and extend into the disposable portion.” <i>Id.</i> at 3:33-36.</p> <p>“In another embodiment 70 shown in FIGS. 7 and 8, heating elements 72 are positioned somewhat further from the wall of cavity 30, and each is provided with a power source 74.”</p>

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		<p>sharper “V” tip 72, as well as with fold 73 to increase their rigidity. Heating elements 71 actually pierce and extend into disposable portion 21 to provide intimate thermal contact.” <i>Id.</i> at 6:46-52.</p> <p>“The circuitry is designed so that at least one but less than all heating elements are actuated for any one puff, so that a pre-determined number of heating elements deliver a premeasured amount of tobacco flavor substance, is delivered to the cigarette.” <i>Id.</i> at 1:32-36.</p> <p>“Heating elements 23 are preferably distributed substantially uniformly around the circumference of cavity 30, and should preferably be spaced such that no regions of disposable portion 21 heated by neighboring heating elements overlap, which could lead to reheating and the production of off tastes.” <i>Id.</i> at 5:18-25.</p> <p>To the extent Complainants contend Morgan does not disclose a limitation, this limitation was well known and/or it would have been obvious to one of ordinary skill in the art using the methods and systems of Morgan and/or to combine Morgan with the prior art herein.</p> <p><i>See, e.g.,</i></p> <p>UCSF Declaration of Custodian Records, Attachment 1 at 20 Making a Bullet Shaped Heater: This heater has a shape of a bullet (tip) that upon insertion into a cigarette rod would cut the filter from the sides and position itself [] right at the middle of the cigarette.</p>

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		 <p data-bbox="836 1186 1624 1291"><i>See also UCSF Declaration of Custodian Records, Attachment [redacted] shaped heater . . . [e]liminates smoke condensate inside the article of paper since no paper is burned.”).</i></p>
27(c)	<p>wherein at least a portion of the resistance heating element is elongated and extending downstream toward the mouth-end of the outer housing, the elongated portion of the resistance heating element positioned proximal to the center of the outer housing;</p>	<p>Morgan discloses and/or renders obvious this limitation.</p> <p><i>See, e.g.,</i></p> <p>“Reusable portion 20 includes, at the end remote from the mouth-end of the article, which could include a battery, a capacitor or both. The battery is rechargeable or both. If the battery is rechargeable, or if power is provided alone, then article 10 is provided with charging contacts 11 or 12 in electrical connection to an external power supply (not shown) for charging. Power source 22 provides power for heating elements 23, which are under the control of control circuit 24, which is in turn actuated by push button 25 or an actuated sensor (not shown).” Morgan at 4:48-59.</p> <p>“An article is provided in which a replaceable tobacco flavor is heated by a set of permanent reusable heaters to evolve inhalable tobacco flavor components in vapor or aerosol form.” <i>Id.</i> at Abstract.</p> <p>“More preferably, the heaters should have an active surface area . . .”</p>

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