

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re *Inter Partes* Review of:            )  
U.S. Patent No. 9,901,123                )  
Issued: February 27, 2018                )  
Application No.: 15/286,087                )  
Filing Date: October 5, 2016             )

For: **Tobacco-Containing Smoking Article**

**FILED VIA E2E**

**PETITION FOR *INTER PARTES* REVIEW  
OF U.S. PATENT NO. 9,901,123**

**TABLE OF CONTENTS**

I. Introduction.....1

II. Identification of Challenges (37 C.F.R. § 42.104(b)) .....3

III. Background.....4

    A. The named inventors disassembled Hon’s prior-art Ruyan device and used it to describe their alleged invention .....4

    B. Prosecution History .....9

    C. The Person of Ordinary Skill In The Art .....9

    D. Claim Construction .....10

IV. Ground 1: Claims 1, 2, 5, 7, 9, 11, 12, 14, 15, 18, 21, and 23-26 are Unpatentable Over Hon, Alone or with Brooks and Whittemore .....10

    A. Overview of Hon (Ex. 1005).....11

    B. Overview of Whittemore (Ex. 1007) .....14

    C. Overview of Brooks (Ex. 1006) .....16

    D. Independent Claims 1 and 15 .....17

        1. Preambles .....17

        2. Element 1/15[a]: electrical power source .....18

        3. Element 1/15[b]: electrical resistance heater .....20

        4. Element 1/15[c]: puff-actuated controller.....22

        5. Element 1/15[d]: a rod-shaped carrier device.....29

            a. Overview of Hon’s rod-shaped carrier device comprising a cartridge .....30

            b. Mixture of tobacco extract and aerosol-forming material .....32

            c. Absorbent fibrous/wicking material .....34

d.	Single unit cartridge/carrier .....	38
e.	[Removably] engaged.....	41
f.	Rod-shaped and generally tubular, with airflow therethrough.....	43
6.	Element 1/15[e]: wicking and aerosol formation .....	45
E.	Dependent Claims .....	53
1.	Claim 2: glycerin or propylene glycol .....	54
2.	Claims 5 and 18: organic acid.....	54
3.	Claim 7: synthetic polymer fibrous material .....	54
4.	Claims 9, 11, 21 and 23: cartridge materials .....	55
a.	Claims 9 and 21: plastic.....	57
b.	Claims 9, 11, 21, and 23: conducts heat/electricity.....	59
5.	Claim 12: carrier is removably engaged.....	60
6.	Claims 14 and 24: absorbent fibrous/wicking material in contact with heater .....	61
7.	Claim 25: wick in proximity to heater .....	61
8.	Claim 26: air passageway along length of cartridge.....	62
V.	Ground 2: Claims 3, 4, 13, 16, and 17 are Unpatentable Over Hon, Whittemore, Brooks, and Susa (Ex. 1008) .....	62
A.	Claims 3, 4, 16, and 17: flavoring agent, menthol.....	63
B.	Claim 13: glycerin, tobacco extract, and a flavoring agent .....	64
VI.	Ground 3: Claims 6 and 19 are Unpatentable Over Hon, Whittemore, Brooks, and Ray (Ex. 1009) .....	66
A.	Claims 6 and 19: mixture includes pure or predominantly nicotine .....	66

VII.	Secondary Considerations .....	69
VIII.	The Board Should Reach the Merits of This Petition .....	69
	A. Section 325(d) is not applicable here .....	69
	B. <i>NHK Spring</i> is not applicable here .....	72
	C. <i>General Plastic</i> is not applicable here .....	73
IX.	Mandatory Notices Under 37 C.F.R. § 42.8.....	75
	A. Real Parties-in-Interest.....	75
	B. Related Matters.....	75
	C. Grounds for Standing .....	77
	D. Lead and Backup Counsel and Service Information.....	77
	E. Fee for <i>Inter Partes</i> Review .....	78
X.	Conclusion .....	79

**TABLE OF AUTHORITIES**

**Page(s)**

**CASES**

*Advanced Bionics, LLC v. Med-El Elektromedizinische Gerate GMBH*,  
IPR2019-01469, Paper 6 (Feb. 13, 2020) .....71

*Apple Inc. v. Fintiv, Inc.*,  
IPR2020-00019, Paper 11 (Mar. 20, 2020) .....72, 73

*In the Matter of Certain Tobacco Heating Articles and Components Thereof*,  
Inv. No. 337-TA-1199, EDIS Doc. ID 707369 (filed Apr. 9, 2020).....76

*Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*,  
807 F.2d 955 (Fed. Cir. 1986) .....34, 58

*Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*,  
IPR2016-01357, Paper 19 (Sept. 9, 2017).....73

*Nitto Denko Corp. v. Hutchinson Tech. Inc.*,  
IPR2018-00955, Paper 7 (Dec. 4, 2018).....72

*R.J. Reynolds Vapor Co. v. Fontem Holdings I B.V.*,  
IPR2016-01268, Paper 63 (Dec. 19, 2017).....*passim*

*RAI Strategic Holdings, Inc. v. Altria Client Services LLC*,  
No. 1:20-cv-393 (E.D. Va. filed Apr. 9, 2020).....75

*RAI Strategic Holdings, Inc. v. Altria Client Servs. LLC*,  
No. 3:20-cv-393 (E.D. Va. July 13, 2020) .....76

*Yeda Research & Dev. Co. v. Mylan Pharms., Inc.*,  
906 F.3d 1031 (Fed. Cir. 2018) .....9, 34, 36, 59

*Zip Top, LLC v. Stasher, Inc.*,  
IPR2018-01216, Paper 14 (Jan. 17, 2019).....70

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.