

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

R.J. REYNOLDS VAPOR COMPANY,
Petitioner,

v.

FONTEM HOLDINGS 1 B.V.,
Patent Owner

Case IPR2017-01120
Patent 8,899,239 B2

Before JOSIAH C. COCKS, RAMA G. ELLURU, and
JO-ANNE M. KOKOSKI *Administrative Patent Judges*.

COCKS, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

R.J. Reynolds Vapor Company (“Petitioner”) filed a Request for Rehearing (Paper 14, “Reh’g Req.”) seeking rehearing of the panel’s decision not to institute *inter partes* review of claims 13–15, 17, and 18 of U.S. Patent No. 8,899,239 B2 (“the ’239 patent”) (Paper 11, “Inst. Dec.”). In particular, Petitioner contends that we misapprehended or overlooked aspects of the disclosure of each of Hongbin¹ and JP ’598² in connection with claims 13–15, 17, and 18 of the ’239 patent.

For the reasons below, Petitioner’s Request for Rehearing is *denied*.

II. DISCUSSION

In determining whether to institute an *inter partes* review, the Board may “deny some or all grounds for unpatentability for some or all of the challenged claims.” 37 C.F.R. § 42.108(b). When rehearing a decision on a petition, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). The party requesting rehearing has the burden of showing the decision should be modified, and “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked.” 37 C.F.R. § 42.71(d). Here, it is Petitioner’s burden to show we misapprehended or overlooked the matters it requests that we review.

A. Claims 13–15

Claim 13 is independent, and claims 14 and 15 ultimately depend therefrom. Claim 13 is drawn to an electronic cigarette that includes, in part,

¹ Chinese patent application publication CN 123436A published November 1999 (“Hongbin,” Ex. 1002, 1003 (English translation)).

² Japanese unexamined patent application publication 2001-291598 published October 2001 (“JP ’598,” Ex. 1004, 1005 (English translation)).

an LED and an airflow sensor. Claim 13 also recites that “the luminance of the LED changes based on an output of the airflow sensor.” In the Decision on Institution, we noted the meaning of “output” offered by Patent Owner as “the current voltage, power, or signal produced by an electrical or electronic device.” Inst. Dec. 26. We also noted that the Petition provided little explanation as to why the operation of Hongbin’s valve plate 5 and spring 3 amounted to providing such an output to an airflow sensor. To that end, we stated the following:

We observe that the ’239 patent generally uses the term “output” in an electrical sense. *See* Ex. 1001, 3:52–53 (“The control circuit board 8 then *outputs two driving voltages . . .*” (emphasis added)). The use of the term “output” in that context is consistent with the meaning of the term proffered by Patent Owner. Although in Hongbin, it is the movement of valve plate 5 that ultimately effects the illumination of indicator 8, Petitioner does not explain adequately how that movement means that it is the “output” of valve plate 5 that causes a change in luminance. In other words, Petitioner does not provide sufficient explanation as to why claim 13 effectively should be read as requiring only that the change in luminance be “based on the airflow sensor” instead of being “based on the *output* of the airflow sensor.”

Id.

With respect to claims 13–15 of the ’239 patent, Petitioner first contends that “The Panel Erred in its Analysis of Claims 13–15 by Overlooking or Misapprehending that Completing a Circuit with Hongbin’s Valve Plate Necessarily Results in Providing an ‘Output’ From the Valve Plate.” Reh’g Req. 2. In attempting to justify that position, Petitioner now states:

[T]he Petition and Dr. Sturges made clear that suction of the electronic cigarette in Hongbin causes the airflow sensor (i.e., valve plate 5) to move to contact the contactor 4 to complete a

circuit between the valve plate 5 and the contactor 4 and thus supplies electricity (i.e. an output) to illuminate the illuminator. Petition, p. 15–16, 29–34, 39–40, and 52–54; Ex. 1008 ¶¶ 40–42, 81, 88 (p. 92–96), 98, 101 (p. 144–148), 112, and 115 (p. 184–188); *accord* Ex. 1008, ¶ 85.

Id. at 3 (emphasis omitted).

Thus, Petitioner asserts the same argument that we found ill-explained in the Petition, i.e., that the movement of valve plate 5 to make contact with contactor 4 means that the valve plate, itself, is producing an “output” or “supplies electricity” to airflow sensor. That Petitioner may disagree with the outcome does not demonstrate that we misapprehended or overlooked any matter in reaching that outcome. Moreover, Petitioner’s new wholesale citation to large and various portions of the record without specificity as to the particular significance of that content does little to show misapprehension on our part.

Petitioner also now alternatively argues that even accepting Patent Owner’s definition of “output,” the pertinent feature is met based on new theories that were not articulated in the Petitioner. *See* Reh’g Req. 4–7. In that regard, Petitioner attempts to use its Request for Rehearing to respond to the Preliminary Response and Institution Decision in order to expand on its proposition of unpatentability of claims 13–15 of the ’239 patent. That we expressed dissatisfaction with the explanation offered in the Petition is not an invitation to provide better explanation in a request for rehearing. A request for rehearing is not an opportunity for a party to attempt to bolster previously under-explained, or under-supported, argument.

We have considered Petitioner’s Request for Rehearing with respect to claims 13–15 (*see* Reh’g Req. 2–7), but we are not persuaded that we

misapprehended or overlooked any matter in concluding that the Petition did not make out an adequate showing of a reasonable likelihood of success that claims 13–15 were unpatentable.

B. Claims 17 and 18

Claims 17 is drawn to a method of using an electronic cigarette that recites the steps of “sensing airflow in a housing of the electronic cigarette via a sensor” and “providing a sensed airflow signal from the sensor to an electronic controller in the housing.”³ As we observed in the Institution Decision, Petitioner also relies on the operation of Hongbin’s valve plate 5 and spring 3 as satisfying those limitations of claim 17. Inst. Dec. 27 (citing “Pet. 57–59 (referencing prior portions of the Petition and citing Ex. 1008 ¶ 85)”).

Petitioner contends that “The Panel Erred in Its Analysis of Claims 17 and 18 by Overlooking or Misapprehending that Completing a Circuit with Hongbin’s Valve Plate Necessarily Results in Providing a ‘Sensed Airflow Signal From The Sensor To An Electronic Controller.’” Reh’g Req. 8. According to Petitioner,

[A]s explained . . . above with respect to claim 13, when the valve plate 5 (i.e., the sensor) engages with the contactor 4 to complete the circuit, electricity (i.e. a signal) is sent from the valve plate 5. See Ex. 1003, p. 3, lines 15–19; Petition, p. 15–16, 29–34, 39–40, and 58; Ex. 1008, ¶¶ 40–42, 85, 88, (p. 108–115); accord Petition, p. 15–16, 29–34, 39–40, and 52–54; Ex. 1008 ¶¶ 40–42, 81, 88 (p. 92–96), 98, 101 (p. 144–148), 112 and 115 (p. 184–188).

Id.

³ Claim 18 depends from claim 17.

In the Institution Decision we took note of Patent Owner's position that "the operation of Hongbin's valve plate to allow the output of the battery to be transmitted to the components of Hongbin's cigarette does not mean that the valve plate, itself, provides any 'sensed airflow signal' to an electronic controller." Inst. Dec. 27 (citing Prelim. Resp. 47–48). We also observed the following:

Claim 17 makes clear that a sensor must provide a "sensed airflow signal" to an "electronic controller." There is little explanation in the Petition as to how Hongbin accounts for those features, simply referring back to prior discussion in the Petition as to claim 1. Claim 1, however, does not recite either a "sensed airflow signal" or an "electronic controller." Dr. Sturges also does not provide adequate explanation in that respect. On the record at hand, it simply is unclear why the movement of Hongbin's valve plate 5 to contact power contactor 4 means that the valve plate is providing a "sensed airflow signal." It also is not apparent why that same valve plate and power contactor interaction means any signal is being provided to "an electronic controller." Petitioner and Dr. Sturges fail to explain suitably that the different terms "control circuit" and "electronic controller" should be regarded as synonymous or what component is being relied upon to constitute the recited "electronic controller."

Id. at 28.

Thus, we were not persuaded that the Petition adequately explained how the operation of valve plate 5 contacting power contactor 4 met the requirements of claim 17 pertaining to the delivery of a "sensed airflow signal" to an "electronic controller." In its Request for Rehearing, Petitioner, generally citing to bulk portions of the Petition and record, contends that contact of valve plate 5 with power contactor 4 "complete[s] a circuit, sending electricity from the valve plate," and "necessarily results in providing a 'sensed airflow signal' from the valve plate." Reh'g Req. 9.

Petitioner's Request for Rehearing does not identify matters that we overlooked or misapprehended in finding unpersuasive the Petition's treatment of the pertinent limitations of claim 17. Petitioner's bulk citation to the record does not remedy the deficiencies noted in the Institution Decision as to the explanation in the Petition as to why the movement of Hongbin's valve plate 5 to contact power contactor 4 means that it is the valve plate, itself, that is providing "a sensed airflow signal" to an electronic controller.

We are not persuaded that we overlooked or misapprehended any matter in declining to institute *inter partes* review with respect to claims 17 and 18 based on the Petition.⁴

III. ORDER

It is ORDERED that Petitioner's Request for Rehearing (Paper 14) is *denied*.

⁴ We are cognizant that Petitioner also contends that we overlooked or misapprehended matters pertaining to the "electronic controller" of claim 17 and its alleged disclosure in Hongbin. See Reh'g Req. 9–11. Because, as noted above, we were, and are, not persuaded that the Petition accounted adequately for other features of claim 17, we need not further address the issues raised by Petitioner pertaining to the "electronic controller" feature.

IPR2017-01120
Patent 8,899,239 B2

For PETITIONER:

Ralph J. Gabric
Robert Mallin
Joshua P. Smith
BRINKS GILSON & LIONE
rgabric@brinksgilson.com
rmallin@brinksgilson.com
jsmith@brinksgilson.com

For PATENT OWNER:

Michael J. Wise
Joseph P. Hamilton
Lara J. Dueppen
Tyler R. Bowen
Nathan R. Kassebaum
PERKINS COIE LLP
MWise@perkinscoie.com
Hamilton@perkinscoie.com
LDueppen@perkinscoie.com
TBowen@perkinscoie.com
NKassebaum@perkinscoie.com