

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ECTO WORLD, LLC and SV3, LLC,
Petitioner,

v.

RAI STRATEGIC HOLDINGS, INC.,
Patent Owner.

PGR2024-00049
Patent 11,925,202 B2

Before JO-ANNE M. KOKOSKI, CHRISTOPER M. KAISER, and
BRIAN D. RANGE, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 324

I. INTRODUCTION

Ecto World, LLC and SV3, LLC (collectively, “Petitioner”) filed a Petition (Paper 3, “Pet.”) requesting post-grant review of claims 1–30 of U.S. Patent No. 11,925,202 B2 (Ex. 1001, “the ’202 patent”). RAI Strategic Holdings, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 9 (“Prelim. Resp.”).

Institution of post-grant review is authorized by statute only when “the information presented in the petition . . . demonstrate[s] that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” 35 U.S.C. § 325; *see* 37 C.F.R. § 42.2. The burden is on Petitioner to show that the challenged patent is eligible for post-grant review. *Mylan Pharms. Inc. v. Yeda Research & Dev. Co.*, PGR2016-00010, Paper 9 at 10 (PTAB Aug. 15, 2016) (holding that the ultimate burden of persuasion remains with a petitioner to demonstrate that the challenged patent is eligible for post-grant review).

Upon consideration of the Petition, Preliminary Response, and the cited evidence, we determine that Petitioner has not satisfied its burden to show that the ’202 patent is eligible for post-grant review.

A. *Real Parties in Interest*

Petitioner identifies Ecto World, LLC, d/b/a Demand Vape, and SV3, LLC, d/b/a Mi-One Brands, as the real parties in interest. Pet. 5. Patent Owner identifies RAI Strategic Holdings, Inc., R.J. Reynolds Vapor Company, RAI Innovations Company, and R.J. Reynolds Tobacco Company as the real parties in interest. Paper 7 (Patent Owner’s Updated Mandatory Notice), 1.

B. Related Matters

The parties indicate that the '202 patent is asserted in the U.S. International Trade Commission, Investigation No. 337-TA-1410, *Certain Disposable Vaporizer Devices*, filed on June 11, 2024 (“the ITC proceeding”). Pet. 5; Paper 7, 1. Petitioner also challenges claims 1–30 of the '202 patent in IPR2024-01280. Pet. 6; Paper 7, 1. The parties indicate that the '202 patent is also the subject of IPR2024-01406, filed by Shenzhen Kangvape Technology Co., Ltd. Paper 7, 1; Paper 8 (Petitioner’s Updated Mandatory Notice), 2.

C. The '202 Patent

The '202 patent, titled “Tobacco-Containing Smoking Article,” is directed to “tobacco smoking articles that produce aerosols without experiencing any necessary burning of tobacco or other component materials during periods in which the articles are used.” Ex. 1001, code (54), 4:61–65. Figure 1 is reproduced below.

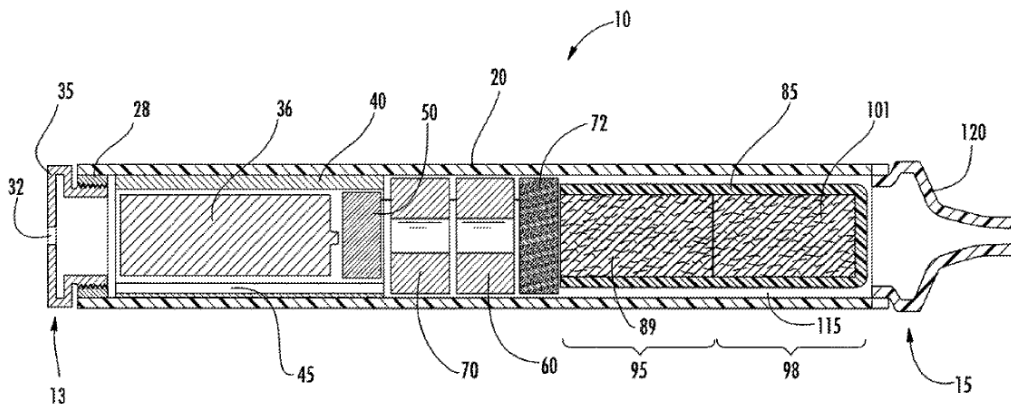


FIG. 1

Figure 1 depicts a longitudinal cross-sectional view of an embodiment of an electrically-powered, tobacco-containing smoking article described in the '202 patent. *Id.* at 8:47–49. Smoking article 10 includes outer housing 20, mouth-end 15, mouth-end piece 120, distal end 13, and end

cover cap 35. *Id.* at 19:58–60, 20:5–11, 24:14–15. Mouth-end 15 comprises an opening adapted for egress of an aerosol generated within smoking article 10, and distal end 13 comprises an opening adapted for intake of air into smoking article 10. *Id.* at 20:5–9. Electric power source 36, electrically powered control components 50, sensing mechanism 60, and at least one electrical resistance heating element 70, 72 are arranged within outer housing 20. *Id.* at 20:24–25, 20:45–46, 20:61–64, 21:28–29. Resistance heating elements 70, 72 can be powered by electric power source 36, can be controlled by electrically powered control components 50, and are configured to allow airflow therethrough. *Id.* at 21:35–40.

Cartridge 85 contains some form of tobacco 89 and aerosol-forming material. Ex. 1001, 22:14–16. Cartridge 85 can include upstream segment 95, composed of tobacco or processed tobacco filler material 89 incorporating aerosol-forming material, and downstream segment 98, composed of substrate 101 carrying flavors or aerosol-forming material. *Id.* at 22:27–32. The '202 patent teaches that “smoking article 10 is assembled such that a certain amount of aerosol-forming material and tobacco components can be wicked or otherwise transferred to heating element 72 or the region in close proximity to the heating element.” *Id.* at 22:32–36. At least one air passageway 115 extends longitudinally between the inner surface of outer housing 20 and the outer surface of cartridge 85. *Id.* at 22:40–43.

During use, mouth-end 15 is placed in the smoker's lips, and air is drawn through openings 32 in cap 35 located at distal end 13 and into outer housing 20. Ex. 1001, 24:30–34. The drawn air passes through air passageway 45 that extends along the length of power source 36 and electronic control components 50, then through an air passageway area

within resistance heating element 70 and sensing mechanism 60, past or through resistance heating element 72, through air passageway 115 and into mouth-end piece 120. *Id.* at 24:34–41. Resistance heating elements 70, 72 heat aerosol-forming materials and tobacco materials in the vicinity of those heating elements. *Id.* at 24:41–44. “Aerosol that is formed by the action of drawn air passing heated tobacco components and aerosol-forming material in the region of” resistance heating element 72 “is drawn through the mouth-end piece 120, and into the mouth of the smoker.” *Id.* at 24:50–54.

D. Illustrative Claim

Petitioner challenges claims 1–30 of the ’202 patent. Claims 1 and 18 are independent; claim 1 is representative of the challenged subject matter, and is reproduced below.

1. An electrically-powered, aerosol-generating smoking article comprising:
 - an outer housing having two ends;
 - a mouthpiece defined at one of the two ends;
 - an electrical power source arranged within the outer housing;
 - an electrical resistance heater positioned within the outer housing, the electrical resistance heater being configured for electrical connection with the electrical power source
 - a storage compartment defined within the outer housing, the storage compartment being configured for storage of a liquid aerosol-forming material and being arranged such that the liquid aerosol-forming material can be wicked into contact with the electrical resistance heater to volatilize the liquid aerosol-forming material;
 - an air passageway through at least a portion of the outer housing, the air passageway being arranged so that

air drawn into the outer housing combines with volatilized liquid aerosol-forming material to produce an aerosol that can be drawn into the mouth of a user of the electrically-powered, aerosol-generating smoking article through the mouthpiece; and

a controller configured to activate current flow through the electrical resistance heater in response to a draw on the electrically-powered, aerosol-generating smoking article.

Ex. 1001, 32:58–33:18

E. Evidence

Petitioner relies on the following patent evidence.

Name	Patent Document	Exhibit
Takeuchi	US 6,155,268, published Dec. 5, 2000	1004
Kim	US 2006/0016453 A1, published Jan. 26, 2006	1007
Susa	EP 0 845 220 A1, published June 3, 1998	1018
Pienemann	WO 00/28843, published May 25, 2000	1006 (with English translation)

F. Asserted Grounds

Petitioner asserts that claims 1–30 would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 3–15, 18–29	103	Takeuchi
6, 7, 14, 15, 18–29	103	Takeuchi, Pienemann
1–30	103	Kim, Pienemann
1–30	103	Kim, Pienemann, Susa
1–30	112	Written Description

Pet. 11. Petitioner relies on the Declaration of Seetharama C. Deevi, Ph. D. (Ex. 1003) in support of its contentions.

II. ANALYSIS

A. *Level of Ordinary Skill in the Art*

Petitioner contends that a person of ordinary skill in the art (“POSA”) would have had “a bachelor’s degree in electrical engineering, mechanical engineering, chemistry, physics, or an equivalent field, as well as at least 3–4 years of industry experience, or a master’s degree in the above fields, and 1–2 years of industry experience.” Pet. 16. Petitioner further contends that “[s]uch a POSA would have been familiar with electrically powered smoking articles and/or the components and underlying technology used therein.” *Id.* at 16–17 (citing Ex. 1003 ¶ 63). Patent Owner states that, for purposes of the Preliminary Response, “Patent Owner maintains that Petitioners’ arguments fail even under Petitioners’ POSA definition.” Prelim. Resp. 6.

On this record, we preliminarily adopt Petitioner’s undisputed proposed definition because it appears to be consistent with the cited prior art and the disclosure of the ’202 patent. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (explaining that specific findings regarding ordinary skill level are not required “where the prior art itself reflects an appropriate level and a need for testimony is not shown” (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985))).

B. *Claim Construction*

We construe each claim “in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b). Under this standard, claim terms are generally given their plain and ordinary meaning as would have been understood by a person of

ordinary skill in the art at the time of the invention and in the context of the entire patent disclosure. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc). Only those terms in controversy need to be construed, and only to the extent necessary to resolve the controversy. *Realtime Data LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019).

Based on the parties' arguments and our review of the current record, we determine that it is necessary to address the preambles of independent claims 1 and 18, and the term "smoking article."

1. Preambles of Claims 1 and 18

In general, a preamble is construed as a limitation "if it recites essential structures or steps, or if it is 'necessary to give life, meaning, and vitality' to the claim." *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2012) (quoting *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999)). When the limitations in the body of the claim "rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention." *Eaton Corp. v. Rockwell Int'l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003); *see also In re Fought*, 941 F.3d 1175, 1178 (Fed. Cir. 2019) ("We have repeatedly held a preamble limiting when it serves as antecedent basis for a term appearing in the body of a claim.").

The preambles of claims 1 and 18 recite "[a]n electrically-powered, aerosol-generating smoking article comprising," and the bodies of claims 1 and 18 include the claim term "the electrically-powered, aerosol-generating smoking article." Ex. 1001, 32:58–59, 33:11–13, 33:16–17, 34:7–8, 34:25–27, 34:30–31. Because the preamble provides antecedent basis for a term appearing in the body of the claim, we determine that the claim term

“smoking article” that appears in the preambles of claims 1 and 18 is entitled to patentable weight.

2. “*smoking article*”

Petitioner contends that, if the Board “finds that the challenged claims have not been impermissibly broadened beyond the scope of the specification,^[1] then the claims necessarily must be limited to a ‘tobacco containing smoking article.’” Pet. 19. Petitioner argues:

Such a construction is commensurate with: (i) the title of the ’202 patent; (ii) the entirety of the specification; (iii) the figures; (iv) the alleged point of novelty; and (v) the scope in at least seven of the parent/grandparent patents to the ’202 patent (which each recite “A **tobacco**-containing . . . smoking article’ in some form or another.”).

Id. (citing *id.* at 125–129 (§ IX.E); Ex. 1032, claim 1; Ex. 1036, claim 1). Therefore, Petitioner argues, “the term ‘*smoking article*,’ as recited in each of the challenged claims, should be construed to mean ‘tobacco containing smoking article.’” *Id.* at 20.

Patent Owner asserts that “[t]he Board should adopt the ITC’s construction of ‘smoking article’ as being ‘limited to devices incorporating tobacco, including tobacco-derived components.’” Prelim. Resp. 6–7 (citing Ex. 2003, 34). Patent Owner argues that, in the ITC proceeding, “smoking article” was tentatively construed “as being ‘limited to devices incorporating tobacco, including tobacco-derived components,’” Patent Owner accepted this construction for purposes of the ITC proceeding, and “[a]dopting this construction [for purposes of this PGR proceeding] ‘promotes consistency in

¹ Petitioner argues that the challenged claims lack written description support in the ’202 patent specification. *See* Pet. 8–9, 125–129. We address those arguments in § II.C.1, *infra*.

claim construction rulings and patentability determinations’ between different forums, the importance of which has been recognized by the Federal Circuit.” *Id.* at 8–9 (citing *Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board*, 83 Fed. Reg. 51,340, 51,347, 51,349–51,350 (Oct. 11, 2018)).

Having reviewed the claim language, the Specification, and the record currently before us, we determine, for purposes of this Decision, that the claim term “smoking article” is limited to devices that contain tobacco. The ’202 patent is titled “Tobacco-Containing Smoking Article” and the Abstract states that “[t]he smoking article possesses at least one form of tobacco.” Ex. 1001, codes (54), (57). The Specification consistently characterizes “the present invention” as being a tobacco-containing “smoking article” or otherwise including tobacco and characterizes “smoking articles” as containing tobacco. *See, e.g., id.* at 1:28–29 (“The present invention relates to tobacco products, such as tobacco-containing smoking articles.”), 4:48–51 (“The present invention relates to smoking articles for providing tobacco enjoyment using such articles, as well as manners and method for providing tobacco enjoyment using such smoking articles.”), 4:51–53 (“[T]he present invention relates to articles that produce aerosols incorporating components derived from, or provided by, tobacco.”), 4:61–662 (“the present invention relates to tobacco smoking articles”), 4:65–67 (“the present invention relates to smoking articles, and in particular, to smoking articles that incorporate[] tobacco in some form”), 5:41–43 (“the present invention relates to a smoking article that is smoked by incorporating that tobacco within an electrically-powered, aerosol-generating device”), 8:66–67 (“A smoking article of the present invention incorporates tobacco.

The type of tobacco can vary.”), 13:59–64 (“The smoking article of the present invention further includes an aerosol-generating material, which can be in intimate contact with the tobacco material . . . or can be carried by a non-tobacco substrate and segregated from the tobacco in the smoking article . . .”). Similarly, the described embodiments all contain tobacco. *See, e.g., id.* at 5:13–18 (“In one embodiment, the present invention relates to a cigarette that is smoked by coupling that cigarette to an electrically powered aerosol generating device that acts as a holder for the cigarette. The cigarette possesses at least one form of tobacco, and that tobacco is wrapped in a paper wrapper.”), 5:62–6:29 (describing “one preferred embodiment” as “a tobacco-containing, electrically-powered smoking article” comprising, *inter alia*, “a tobacco material positioned within the outer housing”), 6:62–7:32 (describing “yet another preferred embodiment” as “a tobacco-containing, electrically-powered smoking article” comprising, *inter alia*, “a cigarette rod . . . comprising a tobacco rod”), 7:42–8:11 (describing “a still further embodiment” as “a tobacco-containing, electrically-powered smoking article” comprising, *inter alia*, “a removable carrier device within the outer housing comprising a tobacco material”), 8:27–29 (“In any of the above embodiments, at least a portion of the tobacco in the tobacco rod can be in the form of tobacco cut filler”), 23:15–17 (“In a further embodiment, tobacco can be incorporated within a cartridge 85 having the ability to act as a type of liquid storage container of the smoking article.”), 23:23–25 (“In another embodiment, pieces of tobacco lamina, stems, or processed tobacco can be incorporated within the liquid storage container 85.”), 23:35–37 (“In another embodiment, the tobacco can be located within the smoking article 10 in a region that is physically separate

from the cartridge 85.”), 26:47–48 (“In a still further embodiment, the cartridge 85 can contain a reconstituted tobacco material”).

Additionally, more than four columns of the Specification (Ex. 1001, 9:5–13:58) are dedicated to describing the different types and forms of tobacco that can be employed in the smoking article, as well as the different manners and methods for incorporating tobacco into the smoking article. *See, e.g., id.* at 9:5–9 (“The tobacco employed can include, or can be derived from, tobaccos such as flue-cured tobacco, burley tobacco, Oriental tobacco, Maryland tobacco, dark tobacco, dark-fired tobacco and *Rustica* tobacco, as well as other rare or specialty tobaccos, or blends thereof.”), 9:28–32 (“The tobacco that is incorporated within the smoking article can be employed in various forms; and combinations of various forms of tobacco can be employed, or different forms of tobacco can be employed at different locations within the smoking article.”), 9:62–63 (“Processed tobaccos that can be incorporated within the smoking article can vary.”), 10:43 (“The tobacco can be used in blended form.”), 11:32–34 (“The tobacco can be treated with tobacco additives of the type that are traditionally used for the manufacture of tobacco products.”), 12:31–33 (“At least a portion of the tobacco incorporated with the smoking article can be provided in the form of a tobacco abstract.”). And, when the Specification teaches that “[o]ther types of flavoring agents” “provided from sources other than tobacco” can be employed in the smoking article, it does so in relation to the total weight of tobacco in the smoking article, and notes that “[t]he flavoring agents *can be added to the tobacco* material or to the aerosol-generating material or both.” *Id.* at 17:28–52 (emphasis added).

We note that the Specification describes smoking articles that contain tobacco substitutes as being disfavored, and highlights the need to provide a product that contains tobacco:

Smoking articles that employ tobacco substitute materials and smoking articles that employ sources of heat other than burning tobacco cut filler to produce tobacco-flavored vapors or tobacco-flavored visible aerosols have not received widespread commercial success. Thus, it would be highly desirable to provide a smoking article that provides a smoker with an ability to enjoy using tobacco without the necessity of burning any significant amount of tobacco. In particular, it would be highly desirable to provide a tobacco-containing smoking article, such as an article having the general appearance of a cigarette, cigar, or pipe, that possesses the ability to provide to a smoker many of the benefits and advantages of conventional tobacco smoking without necessarily delivering considerable quantities of incomplete combustion and pyrolysis products.

Id. at 4:30–44.

Accordingly, the '202 patent consistently and repeatedly characterizes the invention as incorporating tobacco in some form and ties the stated benefits of the invention to the inclusion of tobacco. Moreover, the Specification is directed to smoking articles containing tobacco, all of the embodiments include tobacco, and “the present invention” is described as a smoking article, where the smoking article includes tobacco. Consequently, we determine that “smoking article” as it is used in the challenged claims is limited to devices that include tobacco. *See Mosaic Brands, Inc. v. Ridge Wallet LLC*, 55 F.4th 1354, 1361 (Fed. Cir. 2022) (finding claimed “lip” is limited to “extrudable plastic materials” where specification states that “the device of the present invention is constructed of extrudable plastic materials” and “emphasizes the benefits of using extrudable plastics and describes them as benefits of the invention as a whole”); *Poly-Am., L.P. v.*

API Indus., Inc., 839 F.3d 1131, 1137 (Fed. Cir. 2016) (“Every embodiment described in the specification has inwardly extended short seals and every section of the specification indicates the importance of inwardly extended short seals. These two facts provide together a proper reason to limit the claims in this way.”); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–1317 (Fed. Cir. 2005) (en banc) (“[T]he specification may reveal an intentional disclaimer, or disavowal, of claim scope by the inventor. In that instance as well, the inventor has dictated the correct claim scope, and the inventor’s intention, as expressed in the specification, is regarded as dispositive.”).

C. Post-Grant Review Eligibility

As a threshold issue, we must determine whether the ’202 patent is eligible for post-grant review. There are two requirements that must be met for post-grant review to be available. First, post-grant review is only available if the petition is filed within nine months of the issuance of the challenged patent. 35 U.S.C. § 321(c). Here, the Petition was filed on August 13, 2024, which is within nine months of the ’202 patent’s March 12, 2024 issue date. Ex. 1001, code (45).

Second, a patent is eligible for post-grant review only if it issued from an application that at one point contained at least one claim with an effective filing date of March 16, 2023 or later. AIA² §§ 3(n)(1), 6(f)(2)(A). The “effective filing date” for a claim is either the application’s actual filing date or the filing date of the earliest application that supports the claim. 35 U.S.C. § 100(i).

² Leahy-Smith America Invents Act, Pub. L. No. 112–29, 125 Stat. 284 (2011) (“AIA”).

Petitioner has the burden of establishing eligibility for post-grant review. *See Commonwealth Scientific & Indus. Res. Org. v. BASF Plant Science GmbH*, PGR2020-00033, Paper 11 at 7 (PTAB Sept. 10, 2020); *Mylan Pharms.*, PGR2016-00010, Paper 9 at 10. To show that the '202 patent is eligible for post-grant review, Petitioner bears the burden of proving that the challenged claims lack the benefit of the filing date of the earliest application that supports the claims. In particular, Petitioner must show that at least one of the challenged claims “was not disclosed in compliance with the written description and enablement requirements of § 112(a) in the earlier application for which the benefit of an earlier filing date prior to March 16, 2013 was sought.” *Inguran, LLC v. Premium Genetics (UK) Ltd.*, PGR2015-00017, Paper 8 at 11 (PTAB Dec. 22, 2015); *see also MicroSurgical Tech., Inc. v. The Regents of the University of Colorado*, PGR2021-00026, Paper 12 at 13–16 (PTAB June 16, 2021) (discussing, as a threshold matter, the “more complex” determination whether a “transition application,” that is, an application filed on or after March 16, 2013 that claims the benefit of an earlier filing date is eligible for post-grant review).

The '202 patent claims priority, through a chain of continuation applications, to Application No. 11/550,634, filed on October 18, 2006 (“the '634 application”). Ex. 1001, code (63). Based on this claimed priority date of October 18, 2006, which is before March 16, 2013, the '202 patent is *not* eligible for post-grant review. Petitioner, however, contends that “the claims lack written-description support in the specification of the '202 patent and likewise every patent in the priority chain (all of which have identical specifications).” Pet. 9. In support of this contention, Petitioner argues that “the inventors removed ‘tobacco’ from the originally

filed claims, and as a result, impermissibly broadened the claims beyond what is supported by any specification in the '202 patent family.” *Id.* Petitioner, therefore, argues that “the claims of the '202 patent have an effective filing date of March 31, 2023,” and PGR is available. *Id.*

Patent Owner contends that adopting a construction of the claim term “‘smoking article’ that requires tobacco moots Petitioners’ written description arguments in this PGR.” Prelim. Resp. 10. Patent Owner contends that, because “the '202 patent’s claims require a smoking article that incorporates tobacco, including tobacco-derived components,” the claims “are supported by the specification” and “[t]he '202 patent is entitled to an effective filing date of October 18, 2006.” *Id.* at 13 (citing Ex. 2003, 34).

1. Written Description

For a claim in a later-filed U.S. patent application to be entitled to the filing date of an earlier U.S. patent application, the earlier application must, among other requirements, provide written description support under 35 U.S.C. § 112 for the claimed subject matter in the later-filed U.S. application. *See Anascape, Ltd. v. Nintendo of Am. Inc.*, 601 F.3d 1333, 1335 (Fed. Cir. 2010) (To obtain the benefit of a parent application’s filing date under section 120, “the claims of the later-filed application must be supported by the written description in the parent ‘in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought.’” (quoting *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997))). To satisfy the written description requirement, “the disclosure of the earlier application, the parent, must reasonably convey to one of skill in the art that the inventor possessed the later-claimed subject matter at the time the parent application

was filed.” *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158 (Fed. Cir. 1998). “[A] description that merely renders the invention obvious does not satisfy the requirement.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010) (en banc). In evaluating the adequacy of the disclosure, a court may consider “the existing knowledge in the particular field, the extent and content of the prior art, the maturity of the science or technology, [and] the predictability of the aspect at issue.” *Capon v. Eshhar*, 418 F.3d 1349, 1359 (Fed. Cir. 2005) (cited with approval in *Ariad*, 598 F.3d at 1352).

Petitioner contends that “[n]either the original specification of the ’202 patent nor any parent/grandparent thereto (all of which have identical specifications, and thus are subject to the same written-description analysis below) contains written-description support for a ‘smoking article’ that does not contain tobacco.” Pet. 125 (citing Ex. 1001; Exs. 1032–1039). Specifically, Petitioner asserts that “the applicant prosecuted an entire family of tobacco-related applications, with tobacco-related claims,” but, “[i]n the application for the ’202 patent, the applicant deleted all tobacco limitations from the original claims, without submitting any remarks explaining the impact of that change.” *Id.* at 128 (citing Ex. 1002, 8–10, 55–59).

Petitioner’s argument is dependent on accepting Petitioner’s assertion that the claims include a smoking article that does not contain tobacco, which we have not done. Instead, as set forth above, we construe “smoking article” as being limited to devices that include tobacco. *See* § II.B.2, *supra*. Based on our construction of “smoking article” and the evidence of record in this proceeding, we determine that the challenged claims are supported by the specification of the ’202 patent, which is identical to the specification of all of the continuations in the chain leading back to the October 18, 2006

filing of the '634 application. Ex. 1001, code (63); *see also* Pet. 9 (noting that the specification of the '202 patent and every patent in its priority chain “have identical specifications”); Prelim. Resp. 13 (noting that Petitioner does not identify other limitations in the challenged claims “allegedly lacking support in the '202 patent family’s applications dating back to U.S. App. No. 11/550,634, filed on October 18, 2006”).

Accordingly, we determine that Petitioner does not demonstrate that it is more likely than not that the challenged claims lack written support in the Specification (and the '634 application). That is, on this record, it appears that the challenged claims properly claim priority to the '634 application and, accordingly, have an effective filing date in October 2006.

2. *Conclusion: PGR Eligibility*

For the foregoing reasons, and based on the record before us, we determine that Petitioner has not demonstrated that it is more likely than not that the '202 patent has, or had, at least one claim having an effective filing date on or after March 16, 2013. Accordingly, we determine that the '202 patent is entitled to the filing date of the '634 application (October 18, 2006), and, thus, the '202 patent is not eligible for post-grant review.

III. CONCLUSION

Based on the arguments in the Petition and the Preliminary Response, and the evidence of record, we determine that Petitioner fails to carry its burden to show that at least one of the challenged claims of the '202 patent is not entitled to an effective filing date before March 16, 2013. Consequently, Petitioner fails to establish that the '202 patent is eligible for post-grant review. Our determination that the '202 patent is not eligible for

post grant review precludes our consideration of Petitioner's arguments that the challenged claims are unpatentable under 35 U.S.C. § 103.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is denied, and no trial is instituted.

PGR2024-00049
Patent 11,925,202 B2

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