

Petition (Paper 2 at 23-25) versus Wensley Decl. (Ex1003 ¶¶ 67-71)

67. Specifically, I find that Sebastian discloses ~~each part of this~~ limitation, ~~both separately and taken in combination—i.e., it discloses~~ nicotine, the combination of nicotine with organic acid, and the necessary formation of a nicotine salt.

68. *First*, Sebastian expressly ~~discloses~~describes the inclusion of nicotine. EX1004 [0057]; ~~EX1003, ¶ 68.~~ For ~~example~~instance, Sebastian ~~teaches~~states that “liquid nicotine can be used” and ~~further instructs~~additionally discloses that nicotine “can be included in the aerosol precursor or vapor precursor composition.” EX1004, [0057]; *see also* ~~id.~~EX1004, [0056] [0061] (“[a]s a non-limiting example, an aerosol precursor according to the invention can comprise...nicotine[.]”); ~~EX1003, ¶ 68.~~

69. *Second*, Sebastian ~~also~~ expressly ~~discloses~~describes the combination of organic acids and nicotine. ~~Specifically, I note that~~ Sebastian explains that “[o]rganic acids particularly can be incorporated *into the aerosol precursor* to affect the flavor, sensation, or organoleptic properties of medicaments, *such as nicotine*, that can be *combined with the aerosol precursor.*” EX1004, [0059]; ~~EX1003, ¶ 69.~~ see also EX1004, [0059] (identifying organic acids as flavoring agents that can be combined with the aerosol-generating material if desired.).

70. Indeed, one of Sebastian's goals was to improve the "organoleptic properties" to "provide a smoking article that can provide the sensations of cigarette, cigar, or pipe smoking.. .without combusting tobacco," similar to the '533 patent's goal of achieving "satisfaction" that is "more comparable to the satisfaction in an individual smoking a traditional cigarette." EX1004, [0008], [0059]; EX1001, 8:1-5; *see also id.* EX1001, 22:42-67; ~~EX1003, ¶ 70.~~

71. ~~Third, Sebastian discloses the creation of a "salt of nicotine and an organic acid"~~ through its disclosure of a combination of nicotine and organic acid. ~~See §III.A.2, supra. As, it is my opinion that Sebastian discloses the creation of a salt of nicotine and an organic acid. I note that~~ the '533 patent itself discloses, "[n]icotine salts are formed by the addition of a suitable acid, including organic or inorganic acids." EX1001, 12:44-45; *see also id.* EX1001, 13:3-7 ("Nicotine salt formulations may be formed by adding a suitable acid to nicotine"[.]), 13:18-20 ("Nicotine salt formulations may be prepared by combining nicotine and a suitable acid in a carrier mixture, such as a mixture of propylene glycol and glycerin";); ~~EX1003, ¶ 71. Notably, as these disclosures demonstrate. In my view,~~ the '533 patent does not ~~disclose~~ describe any specific or novel method of generating a nicotine salt; ~~rather, it implicitly recognizes that. Instead, I note that there is an implicit recognition in the '533 patent that the~~ mere addition of organic acid to

nicotine in solution leads to salt formation. EX1001, 12:44-45, 13:3-20;~~EX1003,~~

~~71.~~