

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUUL LABS, INC.,
Petitioner,

v.

NJOY, LLC,
Patent Owner.

Case No. IPR2024-00160

U.S. Patent No. 11,497,864 B2

Title: Electronic Vaporizer

Filing Date: June 25, 2019

Issue Date: November 15, 2022

PATENT OWNER'S PRELIMINARY SUR-REPLY

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Petitioner's reply is without merit. Petitioner does not contest that its prior art references fail to disclose a housing having a first aperture. Instead, Petitioner argues that, despite the clear language of the claims, the aperture need not be in the housing; or, alternatively, it would have been obvious to include an aperture in the housing. For the former, Petitioner argues that Patent Owner took positions in the ITC investigation concerning the Vuse Ciro device that purportedly confirm that the aperture need not be in the housing. Patent Owner, however, is no longer relying on the Vuse Ciro in the ITC investigation. Regardless, the Vuse Ciro practices this limitation. For the latter, Petitioner argues it would have been obvious to move the existing apertures closer to the housing end. But that only puts the aperture closer to the housing, not in the housing as required.

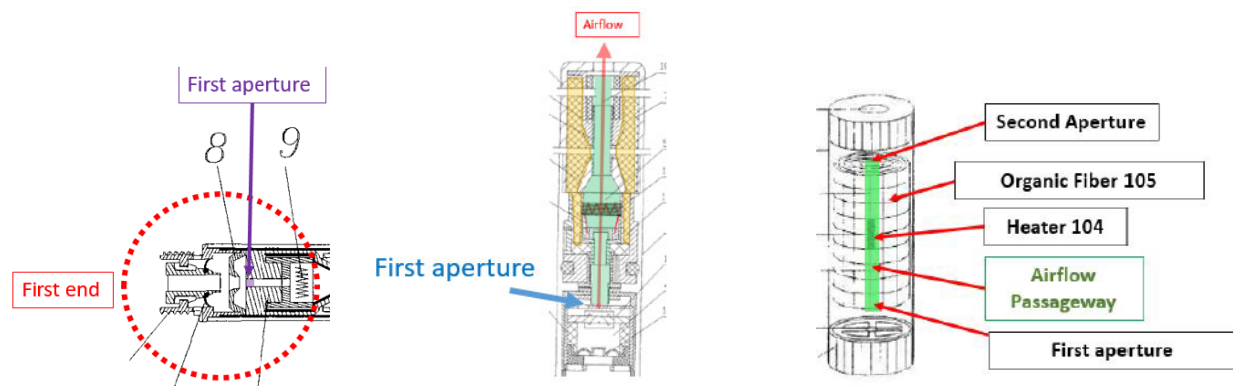
With regards to § 325(d), Petitioner does not dispute that Xia and Han are nearly identical. Nor does Petitioner provide a rebuttal to Patent Owner's arguments concerning Wang and Fang.

Finally, concerning the word count issue, Petitioner does not dispute that the short-hand characterization would take the word count over the statutory limit. Nor do any of the cases relied on by Petitioner have the same fact pattern as here.

I. Petitioner Does Not Dispute That The Prior Art Fails To Disclose A "Housing Having A [First/Second] Aperture"

The claims recite a "housing having a [first/second] aperture." Yet, as seen below, the Petitioner uniformly failed to identify this requirement in any of its prior

art references:



Xia (Pet. at 19)

Fang (Pet. at 27 (annotated))

Wang (Pet. at 25)

Petitioner nonetheless argues that the aperture need not be in the housing because Patent Owner purportedly takes that position in the ITC investigation concerning the Vuse Ciro. Reply at 1-3. Patent Owner, however, dropped its reliance on the Vuse Ciro in the ITC investigation.

Regardless, the Vuse Ciro includes a housing (*i.e.*, the outer structure of the device) having an aperture, which can be clearly seen from outside the device. POPR at 28. Petitioner draws a distinction between the housing and the threaded connector (Reply at 1); but the threaded connector is part of the housing (*i.e.*, the outer structure of the device). And even if the threaded connector was not considered part of the housing, the housing has an aperture to accommodate the threaded connector.

Petitioner also misstates the Middle District of North Carolina judge's holding, which Petitioner suggests permits an internal aperture. Reply at 2. There, the judge determined that, "[a]ir enters through an opening at the base of the positive

pin.” Ex. 1015 at 16. The “opening at the base of the positive pin” is the housing’s hole, which can be seen when viewing the exterior of the cartridge, identified by Patent Owner as the aperture, not some internal gathering point. POPR at 28.

Petitioner’s Reply then resorts to rearguing its obviousness case – suggesting that it would have been obvious to modify Xia and Wang to have this feature. Reply at 3. As to Xia, Petitioner cites for support the Pet. at 38-39. But Pet. at 38-39 recites that Xia’s aperture could be *replaced* by Wang’s apertures. *See* Pet. at 39 (“it was obvious to modify Xia’s cartridge to include the *known airflow passageway of Wang*.” (emphasis added)). As the figures above demonstrate, Wang’s purported apertures are not in the housing, but are instead in the liquid storage medium. Pet. at 38-39 also suggests it would have been obvious to “require *extension of the passageway* to the very edge of the housing, with a central aperture (already present in Wang, and in Fang)” (emphasis added). But *extending the structures having the apertures* to be closer to the housing ends is not the same as moving the aperture from these structures to the housing, which is required under the claims.

As to Wang, Petitioner cites Pet. at 102 to argue that the Petition argues obviousness for an aperture in Wang’s housing. The Pet. at 102, however, recites extending “*the solution-holding medium and passageway [to] reach[] the air inlet 106*” (emphasis added). Again, the Petition does not suggest moving the aperture to the housing, but instead, keeping the aperture in the solution-holding medium and

extending the solution-holding medium so that the aperture is closer to the housing end.

Petitioner also criticizes Patent Owner for mischaracterizing the Petition. Reply at 3. Specifically, that certain elements Patent Owner argued would be removed, would not actually be removed. Tellingly, Petitioner does not, and cannot, point to the Petition to support this contention. The Petition simply has no discussion of this and the only figures provided by the Petitioner omit these features. *See, e.g.*, Pet. at 57. Petitioner's resort to its expert declaration to make this point is endemic of Petitioner's improper incorporation by reference to support its obviousness arguments. POPR at 34.

To be clear, Petitioner failed to identify a first aperture *in the housing* in any of its prior art references. Petitioner seemingly overlooked this limitation. The only apertures identified by the Petitioner are apertures internal to the housing. Petitioner is using its Reply to repurpose its obviousness arguments that were directed to bringing its internal apertures *closer* to the housing end to now include *moving* the aperture to the housing end. This is a *post facto* argument not included in the Petition.

II. Petitioner Does Not Dispute Xia (Ground 1) Is Nearly Identical To Han Or Rebut Arguments Made With Respect To Ground 2

Petitioner makes no argument that Xia is not nearly identical to Han. Nor does Petitioner dispute that the same arguments made to the Examiner are now the same arguments Petitioner makes in its Petition. Instead, Petitioner pursues a strawman.

Petitioner again argues that Patent Owner is being inconsistent in its arguments with respect to the Vuse Ciro (not related to either Han or Xia); but Patent Owner has dropped its reliance on the Vuse Ciro in the ITC Investigation. Petitioner also once again misstates the findings in the M.D.N.C. litigation. The judge there specifically held that small items that “do not alter the direction of the Ciro’s airflow passageway any more than the heating element” are obstructions. Ex. 1015 at 16. Xia’s liquid storage does not fall within this description.

The only remaining issue is Ground 2. Petitioner provides no rebuttal to Patent Owner’s arguments that the Examiner considered Wang and Fang. *See* POPR at 47-48. Petitioner’s only argument is that Wang and Fang are not similar to Han (an argument Patent Owner did not make).

III. Petitioner Exceeded the Word Count

37 CFR § 42.24 permits an “appendix of exhibits or claim listing.” Petitioner provided more than a claim listing, it included a short-hand characterization of each claim limitation. Petitioner relies on *Attends Healthcare Prods., Inc. v. Hartmann*, IPR2020-01480, Paper 6 at 5-22 (Nov. 25, 2020); *id.* Paper 13 at 36 (Feb. 24, 2021); *Tesla, Inc. v. Unicorn Energy GMBH*, IPR2022-00110, Paper 19 (Feb. 17, 2022); and *Graco, Inc. v. Daniel Dumitru Dorneanu*, IPR2022-00942, Paper 6 at 9 (Oct. 21, 2022). None of these cases includes a short-hand description of the claim limitations. And in the case of *Tesla*, the Board required the Petitioner to refile.

U.S. Patent No. 11,497,864 B2

Patent Owner's Sur-reply to Petitioner's Reply to Patent Owner's POPR

Dated: March 29, 2024

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

The undersigned hereby certifies that this brief complies with the type-volume limitations of 37 C.F.R. § 42.24 (c)(1). This brief contains 1,205 words as calculated by the "Word Count" feature of Microsoft Word 2016, the word processing program used to create it.

The undersigned further certifies that this brief complies with the typeface requirements of 37 CFR § 42.6(a)(2)(ii) and typestyle requirements of 37 CFR § 42.6(a)(2)(iii). This brief has been prepared in a proportionally spaced typeface using Microsoft Word 2010 in Times New Roman 14 point font.

Dated: March 29, 2024

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The undersigned hereby certifies that on March 29, 2024, the foregoing
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