

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUUL LABS, INC.

Petitioner,

v.

NJOY, LLC,

Patent Owner

IPR2024-00160
U.S. Patent No. 11,497,864

DECLARATION OF DANIEL HILLENBRANDT

1. My name is Daniel Hillenbrandt. The statements contained in this declaration are based on my personal knowledge and the documents cited in this declaration. I am not being separately compensated for the time spent preparing this declaration.

2. I am a co-owner of Fuma International LLC (“Fuma”). I have worked at Fuma since the company was formed in July 2009. I am currently employed as Fuma’s Vice President and am a co-inventor of U.S. Patent No. 11,497,864 (“the 864 Patent”).

3. Exhibit 2029 is a true and accurate copy of a 1.131 Declaration that I helped to prepare and was submitted to the Patent and Trademark Office during the prosecution of the 864 Patent. This Declaration includes pictures of a Fuma Starter Kit and Fuma cartridges. EX2029.0016-0032.

4. Exhibit 2030 is a true and accurate copy of a 1.131 Declaration that I helped to prepare and was submitted to the Patent and Trademark Office during the prosecution of U.S. Patent No. 10,334,881. This Declaration includes the same pictures of a Fuma Starter Kit and Fuma cartridges that are depicted in Exhibit 2029. EX2030.0016-0032; EX2029.0016-0032.

5. Before developing the Fuma e-cigarette and cartridges with Greg Conley, who is a co-owner of Fuma and co-inventor of the 864 Patent, I experienced various issues with cartomizer-type two-piece devices that were on the market. For example, I noticed that these devices were hard to draw on, leaked and created excess liquid

droplets in the airflow, and delivered short-lived flavor before becoming a burnt taste. It appeared that the burnt taste was due to the atomizer burning the absorbent material that held the e-liquid. For example, when Greg Conley took the cap off of a cartomizer-type two-piece device (Smoke Fifty-One Duo) that had a burnt taste, I noticed a scorch mark on the outer inside edge of the batting material, which I believe was caused by the heating element in the batting material.

6. After experiencing issues with commercially available e-cigarettes, Greg Conley and I invented a new type of e-cigarette that eliminated the issues with pre-existing e-cigarettes. Our new e-cigarette had a transverse heating element in a central airflow passageway surrounded by a solution holding medium, which allowed for a clear path for the airflow to decrease the amount of suction required to draw a vapor, separated the airflow from the solution holding medium to reduce liquid droplets in the airflow, and separated the heating element from the solution holding medium to prevent the burnt taste. In addition to eliminating the issues with pre-existing e-cigarettes, this new e-cigarette improved the vaporization of the e-liquid, providing an enhanced experience.

7. In 2009, we (as part of Fuma) commercialized and began selling our invention, which is depicted in Exhibits 2029 and 2030. The commercialized invention includes Fuma starter kits and e-cigarette cartridges, which include a solution comprising nicotine and propylene glycol.

8. We filed for patents to protect our invention, and one of the patents that issued is the 864 Patent. The claims of the 864 Patent recite a cartridge configured to couple to a power source, the cartridge having a housing, an airflow path or airflow passageway between apertures in the housing, a solution holding medium to hold the solution, and a transverse heating element exposed to airflow to vaporize the solution. For the same reasons described above with respect to the design of the Fuma e-cigarette, the claimed features of the 864 Patent eliminated the issues with pre-existing devices and drove Fuma's sales of Fuma's cartridges and starter kits.

9. Exhibit 2026 is a true and accurate copy of an email from June 15, 2010 sent by Dennis Potter, RJRV's VP of Strategic Innovations, to Greg Conley. The email was sent to Greg Conley's work email address, "GC@myfuma.com." I understand that Greg Conley had access to and used this email address in the ordinary course of business.

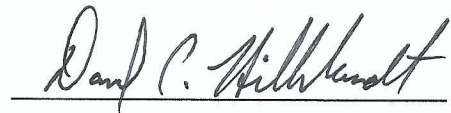
10. Exhibit 2028 is a true and accurate copy of an email from July 19, 2010 sent by Dennis Potter to Greg Conley. This email was sent to "info@myfuma.com." Greg Conley had access to this email address, and the email begins with "Hi Greg." I understand that Greg Conley had access to and used this email address in the ordinary course of business.

11. I declare that all statements made in this declaration based on my own knowledge are true and that all statements made on information and belief are

believed to be true. Further, I declare that all statements made in this declaration were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment or both under Section 1001 of Title 18 of the United States Code.

12. I declare under penalty of perjury that the foregoing is true and correct to the best of my knowledge.

Executed: 8-22-24

A handwritten signature in cursive script, reading "Daniel C. Hillenbrandt", written over a horizontal line.

Mr. Daniel Hillenbrandt