

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

**PATENT OWNER'S REPLY IN SUPPORT OF
MOTION TO EXCLUDE**

I. Ex. 1007, Sturges Declaration (FRE 402, 403, 701, 702, and 802)

Petitioner claims that expert testimony cannot be excluded for relying on inadmissible evidence. Pet'r Op. at 3. That is incorrect. *Mylan Pharms., Inc. v. Bausch Health Ireland Ltd.*, IPR2022-00722, Paper 78 at 72 (Sept. 8, 2023) (“[B]ecause the Currie submission is inadmissible hearsay and Petitioner has not met its burden to show that FRE 703 applies, we grant Patent Owner’s motion to exclude”). Petitioner should not be permitted to back-door hearsay through Dr. Sturges.

II. Exs. 1014, 1021, 1025 – Fuma Litigation Briefs (FRE 402, 403, 802)

Petitioner does not dispute that these exhibits relate to statements by non-parties about products and patents not at issue. Petitioner instead introduces a new exhibit (Ex. 1045) to make a new argument that Patent Owner has adopted positions taken by Fuma. Pet'r Op. 6. This argument is untimely, incorrect, and does not address the relevance of Ex. 1014 (Reynolds’s brief).

III. Ex. 1017 – Declaration of Shanhong Wang from Fuma Litigation, (FRE 402, 403, 701, 702, 802, and 37 C.F.R. § 42.63)

Petitioner does not dispute that Exhibit 1017 is hearsay. Petitioner argues that Mr. Wang’s declaration should be admitted under FRE 804(b)(1) as an exception to hearsay and alleges that it “was unable to retain him or secure his availability to testify.” Pet'r Op. 6. But Petitioner offers no evidence showing unavailability for this IPR. In response to Patent Owner’s request for a deposition, Petitioner simply stated that it was not representing Mr. Wang. Ex. 2044. A conclusory statement that

Mr. Wang was not available is insufficient to prove that a hearsay exception exists. *See, e.g., N.L.R.B. v. Augusta Bakery Corp.*, 957 F.2d 1467, 1480 (7th Cir. 1992) (“Augusta’s conclusory offer of proof offered nothing except the plain assertion that Acevedo was unavailable.”); *Dartez v. Fibreboard Corp.*, 765 F.2d 456, 463 (5th Cir. 1985) (“Plaintiff made no attempt to establish that Ames was unavailable. Admission of his former testimony without such a showing was erroneous.”).

Petitioner challenges the applicability of Rule 403 to non-jury trials (Petr’ Op. 2) but fails to address that Mr. Wang’s declaration and deposition testimony were excluded as unreliable in ITC Inv. No. 337-TA-1372—a non-jury trial.

IV. Ex. 1018 – Fuma Claim Construction Brief (FRE 402, 802)

Petitioner argues that Fuma’s claim construction brief “provides context for other exhibits . . . including the claim construction order.” and Pet’r Op. 8. But the order speaks for itself, and Fuma’s positions are not relevant to this proceeding.

V. Ex. 1023 – G. Conley Deposition from Fuma Litigation (FRE 402, 802)

Petitioner does not dispute that Exhibit 1023 is hearsay. Petitioner argues that Mr. Conley’s transcript should be admitted under FRE 804(b)(1) because Mr. Conley was “unavailable . . . because he is Patent Owner’s witness.” Pet’r Op. 9.

Petitioner’s claim is incorrect. Patent Owner’s counsel represented Mr. Conley in the ITC to respond to a subpoena, not as “Patent Owner’s witness.” *Certain Vaporizer Devices*, Inv. No. 337-TA-1372, Motion of Non-Party Gregory

D. Conley for an Extension of Time to Quash or Limit Respondent’s Subpoena Duces Tecum and Ad Testificandum (Oct. 31, 2023) (EDIS Doc ID 807407). There is no indication that Petitioner attempted to contact Mr. Conley for this IPR or sought additional discovery to take his deposition. 37 C.F.R. § 42.51.

Petitioner’s reliance on IPR2022-01291 for the residual hearsay exception is misguided. The testimony at issue was “to a large extent . . . posed by Apple’s own counsel” regarding “Apple’s own R&D documents.” *Apple, Inc. v. Massimo Corp.*, IPR2022-01291, Paper No. 75 at 137 (PTAB Jan. 30, 2024).

Petitioner’s attempt to distinguish *Solomon* as a “pre-*Phillips* case” fails. Pet’r Op. 9. The Federal Circuit re-stated the relevant holding four years after *Phillips*. *Howmedica Osteonics Corp. v. Wright Med. Tech., Inc.*, 540 F.3d 1337, 1347 (Fed. Cir. 2008) (“We hold that inventor testimony as to the inventor’s subjective intent is irrelevant to the issue of claim construction.”); *id.* at 1347 n.5 (noting that inventor testimony “may be pertinent . . . as to understanding the established meaning of particular terms in the relevant art” under *Phillips*). Petitioner is not using Mr. Conley’s testimony to show “the established meaning of particular terms.”

VI. Ex. 1024 –Conley Deposition Exhibit, Fuma Litigation (FRE 402, 802)

Petitioner does not dispute Ex. 1024 is irrelevant if Ex. 1023 is excluded.

VII. Ex. 1036 – Wang Deposition from Fuma Litigation (FRE 402, 403, 802)

Petitioner’s argument that Exhibit 1036 should be admissible under FRE

804(b)(1) should be rejected for the same reasons discussed above in Section III.

VIII. Ex. 1038, Hillenbrandt Deposition Transcript (FRE 402, 403, 701/702)

Regarding excerpts 42:1-44:22, Petitioner states that “[t]estimony that prior art devices had a central airflow passageway . . . is probative of how a POSITA would view Wang.” Pet’r Op. 12. There is no such testimony in excerpts 42:1-44:22. Petitioner further claims that these excerpts “rebut[] Patent Owner’s . . . invention story.” *Id.* Petitioner fails to explain how.

Regarding excerpts 88:16-92:1, Petitioner repeats its argument that *Solomon* is not good law post-*Phillips*, which is incorrect as discussed above in Section V. Moreover, nothing in *Phillips* suggests that inventor testimony applying claim language to *hypothetical* device configurations is not expert testimony.

Regarding excerpts 115:18-133:5, Petitioner claims that “inventor testimony about the novel or non-obvious aspects of an invention shed light on the invalidity analysis” (Pet’r Op. 12) but offers no explanation as to how.

IX. Ex. 1039 – Yardimici Declaration (FRE 402, 403, 701, 702, 802)

Petitioner does not dispute that the Yardimici declaration *testimony* is hearsay but argues that the exhibits *attached* to the declaration contain photos, which are not hearsay. Pet’r Op. 13. But the photos have no meaning without the declaration. Indeed, Petitioner states that it relies on CT scans “Dr. Yardimici testified under oath he directed two other scientists to perform.” *Id.* If the Yardimici declaration is

excluded, the attached photos should be excluded as part and parcel. Moreover, Petitioner's attempt to combine the teachings of a Smoke 51 *device* with the Wang *reference* is an improper end-run around 35 U.S.C. § 311(b).

X. Ex. 1040 – Exhibit 7 to D. Hillenbrandt Deposition (FRE 402)

Petitioner does not dispute Ex. 1040 is irrelevant if the Ex. 1038 excerpts are.

XI. Ex. 1041 –Hillenbrandt Transcript from ITC (FRE 701, 702, 802)

Petitioner argues that Ex. 1041 is not hearsay because it is a party admission and inconsistent with later testimony. Petitioner offers no explanation as to how a third party's deposition under Petitioner's subpoena qualifies as a party admission against Patent Owner. Secondly, there is nothing inconsistent in the two statements, which concern two different configurations. And Petitioner could have asked Mr. Hillenbrandt about this "inconsistency" at his deposition but chose not to.

XII. Ex. 1042 – Exhibit to Hillenbrandt Deposition from ITC (FRE 402)

Petitioner does not dispute Ex. 1042 is irrelevant if Ex. 1040 is excluded.

XIII. Ex. 1044 – Article on E Cigarette Unit Sales (FRE 402)

Petitioner argues that "post-filing evidence may be used to show the state of the art existing at the time of filing of the patent-at-issue." Pet'r Op. 15. Petitioner fails to establish, however, that consumer preference in 2020 has any relevance to consumer preference "at the time of filing of the patent-at-issue" in 2009.

Date: February 14, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on February 14th, 2025, the foregoing
PATENT OWNER'S REPLY IN SUPPORT OF MOTION TO EXCLUDE
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