UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUUL LABS, INC.,

Petitioner,

v.

NJOY, LLC,

Patent Owner.

Inter Partes Review No.
IPR2024-00161
Patent 10,334,881 B1
Title: Electronic Vaporizer
Filing Date: December 13, 2016
Issue Date: July 2, 2019

PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE PURSUANT TO 37 C.F.R. § 42.108(C)
U.S. PATENT NO. 10,334,881 B1

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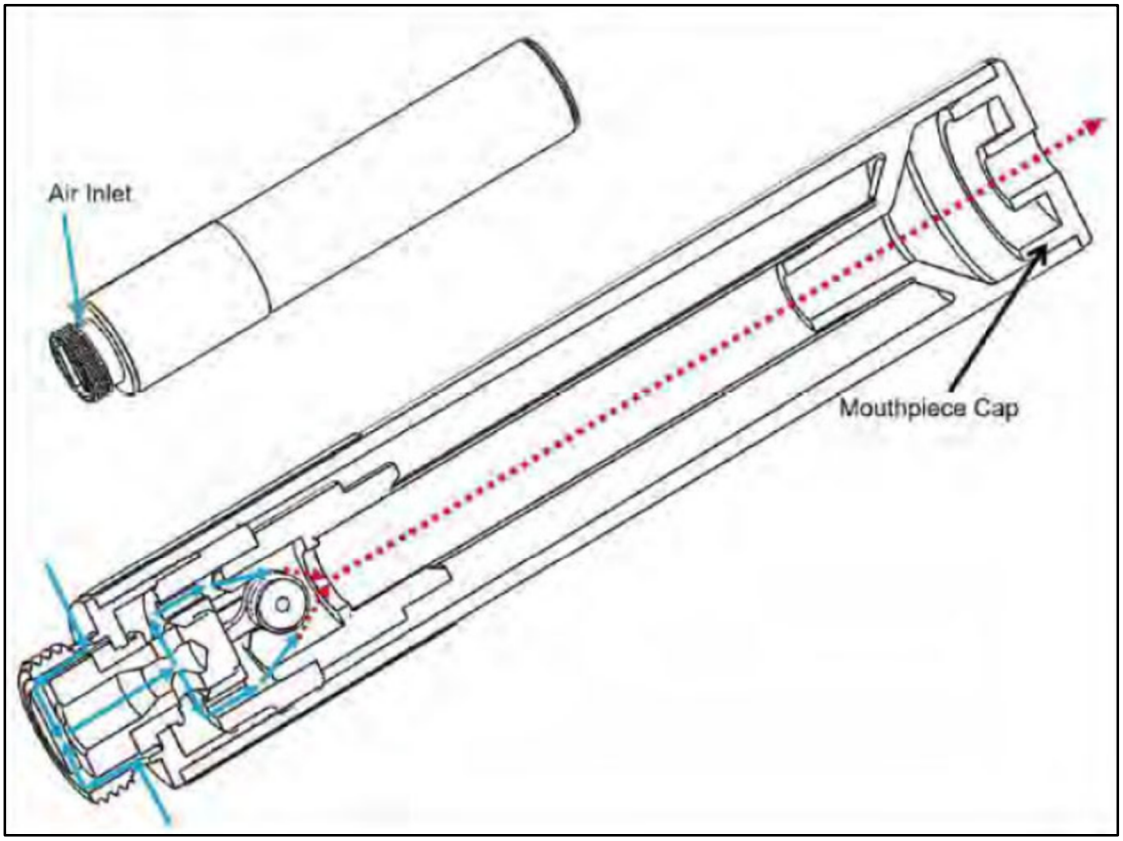
1034	March 14, 2024 E-mail from Board

Patent Owner NJOY's Preliminary Response argues: (1) "the 'first apertures' identified by [JLI]…are not apertures in the housing…but are instead apertures in structures interior to the housing," (POPR at 2) and (2) shorthand description of claim limitations in a claim listing should be counted against the word-count limit, which contradicts the rules and Board precedent. The Board authorized this reply. Ex. 1034.

I. FIRST AND SECOND APERTURE ARGUMENTS

Patent Owner argues the first apertures identified in Xia (Ground 1) and Wang (Ground 2) are internal to the devices and thus are not apertures in the housing. POPR at 24-46. That argument contradicts Patent Owner's ITC positions, where Patent Owner repeatedly argues, in its domestic industry allegations regarding six distinct devices, that such an aperture meets the claim limitations. Among the evidence of record here, Patent Owner points to an aperture within a threaded connector, not the housing, in the Vuse Ciro device. Ex. 1032 at 3 (identifying item "E" as the first aperture), 6 (identifying item E as being within the electrically-conductive threaded connector); POPR at 28. Even if that aperture was in the housing, Patent Owner points to a different "first aperture" for the requirement that the first aperture "allow an airflow through the cartridge" — one that is purely internal to the device. '881 patent, claim 1. Patent Owner's allegations (for example in its diagram below), which mirror both what the Vuse Ciro device manufacturer

stated in litigation and what the Middle District of North Carolina judge held, are that the air flows into the cartridge from the side, and collects at a point ***inside*** the connector, that collection point being the first aperture. Air does not flow in through what is labeled "E" in Ex. 1032 that the POPR alleges is an aperture in the housing:



Ex. 1032 at 10; *see also* Ex. 1014 at 14, 37; Ex. 1015 at 16-17 (Judge finding first aperture met because "the air converges and passes through a single opening at the base of the positive pin"). Thus, under Patent Owner's theories regarding the Vuse Ciro, the first and second apertures in Xia and Wang meet the claim requirements for a first and second aperture.

Even if the above is incorrect, Patent Owner ignores and/or mischaracterizes the Petition's obviousness allegations, which modify Xia and Wang such that the apertures are at the very extreme ends of the housing. Regarding Xia (Ground 1), the Petition argues the air intake could be moved to the battery side "to have air enter centrally on the end of the cartridge" and Xia alone or with Wang and/or Fang renders obvious "extension of the passageway to the very edge of the housing, with a central aperture," which would thus be in the housing even under Patent Owner's narrow interpretation here, even without its broadening read in the ITC. Pet. at 35-36. And Patent Owner's criticisms ignore expert testimony. For example, Patent Owner argues "Petitioner eliminated Xia's liquid-blocking plate 8" and "smokers are more likely to choke on inhaled liquid," but the Petition does no such thing. *See, e.g.*, Ex. 1007 at 122 ("[A] POSITA would move the portion of the liquid blocking plate 8 that stops the backflow of liquid . . . The liquid blocking plate 8 in Xia also keeps its function, that is, blocking backflow of chemical liquid by having a one-way valve in the path of airflow."). As to Wang (Ground 2), Patent Owner acknowledges the movement of the first aperture to the extreme end of the cartridge but alleges that the Petition does not make clear enough that the aperture is in the housing in the modification. There is no reasonable interpretation in which that is not the case, as Petitioner alleged a modification "so that the solution-holding medium and passageway reached the air inlet 106 and the air outlet 101." Pet. at 92.

The unmodified alleged first aperture thus becomes air inlet 106, as it "reache[s]" it, and the same for the second aperture and air outlet 101. And the same would happen in the combination with Fang's passageway extending the length of the device.

II. SHORTHAND NOTATION IN CLAIM LISTING

The regulations governing IPR permit a petitioner to put lengthy claim language in a claim listing that does not count against the 14,000-word limit of a petition. 37 CFR § 42.24. The Board has also repeatedly found that shorthand annotation is permissible, *e.g.*, by referencing claim element numbers corresponding to the claim listing. *Attends Healthcare Prods., Inc. v. Hartmann*, IPR2020-01480, Paper. Nos. 6 at 5-22, 13 at 36. The Petition's use of shorthand notation is no different. It is merely a way to connect the dots to the lengthy claim language, which would have comprised 1,867 words if put in the body of the brief. The shorthand notation adds no argument—the Petition argues the claim language is met, not the shorthand notation, and merely uses shorthand in subheadings to help navigate the many lengthy, highly repetitive claims. And the Board has held words in excess of the limit should not warrant dismissal where the text allegedly over the word-count limit is not "improper or excessive" and otherwise "likely to properly aid" the Board's review, which is the case here. *Tesla, Inc. v. Unicorn Energy GMBH*, IPR2022-00110, Paper 19 (Feb. 17, 2022); *Graco, Inc. v. Daniel Dumitru Dorneanu*, IPR2022-00942, Paper 6 (Oct. 21, 2022) at 9; Practice Guide at 40 ("Except in cases

of obvious abuse, the Board will generally accept a party's certification of compliance with word count limits.").

Dated: March 22, 2024

/s/ William A. Meunier

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CERTIFICATE OF SERVICE

I certify that a copy of Petitioner's Reply to Patent Owner's Preliminary Response Pursuant to 37 C.F.R. § 42.108(C) U.S. Patent No. 10,334,881 B1 is being served by electronic mail on the following counsel of record:

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