

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUUL LABS, INC.,

Petitioner,

v.

NJOY, LLC,

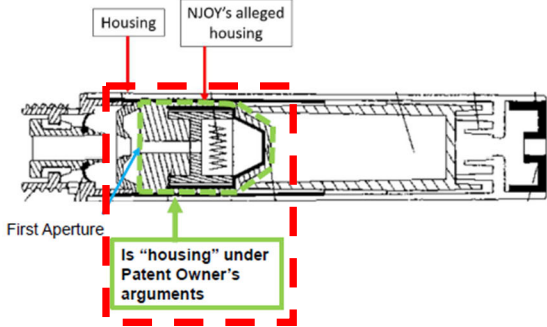
Patent Owner.

IPR2024-00161
U.S. Patent No. 10,334,881

**PATENT OWNER'S OBJECTIONS TO
PETITIONER'S DEMONSTRATIVE EXHIBITS
FOR ORAL ARGUMENT**

I. Objections to Patent Owner's Demonstratives

Pursuant to the Board's January 23, 2025 Order (IPR2024-00161 Paper 27), Patent Owner NJOY, LLC. ("Patent Owner" or "NJOY") submits the following objections to Petitioner's demonstratives for use at the oral argument scheduled for February 25, 2025. In the table below, Patent Owner has placed a red dashed box over the objectionable material in each slide.

Slide No.	Objection
30	<p>Patent Owner objects to the annotated figure as suggesting that Xia's heater 9, secondary liquid storage 10, and liquid guiding mechanism 11 constitutes a "housing" under Patent Owner's arguments," which misrepresents Patent Owner's position, is highly prejudicial, and is a new argument not made in any paper of record.</p> <div><p>Alternatively, Per Patent Owner, Internal Structure Is Housing If It Houses Internals</p><p>Patent Owner's Expert</p><p>Patent Owner Argues Generator's Internal Black Lines Are The Heating Element's Housing</p><p>Reply at 11-12; Ex. 1004, Fig. 2 (annotated); Ex. 1035, 60:2-85:1</p><p>DEMONSTRATIVE EXHIBIT - NOT EVIDENCE - © 2024 MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND PC</p><p>17 Q And you've used the term "outside structure," 18 so your definition is the housing is the outside 19 structure containing the device internals. That's what a 20 housing is, right? 21 A Yes.</p><p>21 A Whatever the external structure holding that 22 within its internals, that would be the housing of the 23 heating element. And you could put it deep inside of a 24 product, and it would still be recognized as the housing 25 of that internals. Again, we -- we often see nested 1 housings.</p><p>16 Q So the -- you can have a structure that's a 17 housing even if it's not the outermost structure then? 18 For example, in figure 2, generator? 19 MR. ANSLEY: Objection. Vague. 20 THE WITNESS: Yeah, certainly I'm aware of a 21 lot of products that have nested housings, like there's a 22 housing for one component, and then a housing is then 23 within some other housing. But I think a person of</p><p>30</p></div>
31	<p>Patent Owner objects to the citation to the ITC Final Initial Determination at 38-40 and EX1033 at 1-2 as improper new evidence and new argument because Petitioner did not address the cited material in any paper of record.</p>

Patent Owner objects to the citation of the prosecution history of the challenged patents and the Han reference as introducing improper new argument because Petitioner did not address the cited material when contending that Patent Owner's construction was not supported in any paper of record.

	<div data-bbox="354 205 1227 285" data-label="Section-Header"> <h2>Patent Owner's Construction Has No Basis In The Prosecution History</h2> </div> <div data-bbox="1352 197 1395 243" data-label="Image"> </div> <div data-bbox="505 300 1006 327" data-label="Section-Header"> <h3>'864 Patent Prosecution History Re Han Reference</h3> </div> <div data-bbox="483 348 1032 506" data-label="Image"> </div> <div data-bbox="737 531 786 552" data-label="Caption"> <p>FIG. 1</p> </div> <div data-bbox="431 560 1131 741" data-label="Text"> <p>first aperture and (b1) as the second aperture. However, the structure of Han cannot meet the limitations of dependent claims 49, 63, and 75 for two reasons. First, Han's shell (b) does not include a central airflow passageway and instead places the perforated component for liquid storage (9) in the middle of shell (b), thereby forcing the airflow around the peripheral surface of perforated component for liquid storage (9) as described in paragraph [0070] of Han and shown in FIG. 3. Second, the first aperture</p> </div> <div data-bbox="1166 543 1385 644" data-label="Text"> <p>Conflicts with NJOY's later ITC infringement and domestic industry assertions</p> </div> <div data-bbox="1166 667 1385 720" data-label="Text"> <p>Does not support "big" vs. "small" construction</p> </div> <div data-bbox="943 743 1359 766" data-label="Text"> <p>Reply at 15-17, 20-21; Pet. at 49-54; Ex. 1002 at 273-74</p> </div> <div data-bbox="321 764 1120 785" data-label="Text"> <p>DEMONSTRATIVE EXHIBIT - NOT EVIDENCE - © 2024 MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. // Confidential Property</p> </div>
<p>53</p>	<div data-bbox="315 791 1422 875" data-label="Text"> <p>Patent Owner objects to the annotated figure as introducing improper new argument that was not disclosed in any paper of record.</p> </div> <div data-bbox="1369 926 1411 974" data-label="Image"> </div> <div data-bbox="347 949 1068 999" data-label="Section-Header"> <h2>Xia As Modified With Wang Or Fang</h2> </div> <div data-bbox="620 1037 1034 1064" data-label="Section-Header"> <h3>Extend Central Passageway Throughout</h3> </div> <div data-bbox="321 1096 1385 1442" data-label="Image"> </div> <div data-bbox="885 1470 1346 1497" data-label="Text"> <p>Pet. at 38-39, 54-62; Reply at 22-25; Ex. 1007 at ¶90</p> </div> <div data-bbox="321 1499 1135 1520" data-label="Text"> <p>DEMONSTRATIVE EXHIBIT - NOT EVIDENCE - © 2024 MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. // Confidential Property</p> </div>
<p>62</p>	<p>Patent Owner objects the annotated portion of the figure as introducing improper new argument that was not addressed in any paper of record.</p>

Lack Of Reabsorption Of Hypothetical Free Droplets Is Not A Significant Technological Drawback

'864 And '881 Patents Embodiments Without Wick Spray Liquid Onto Heating Element

Patent Owner Agrees No Direct Contact Between Liquid Storage And Heating Element In Figure 2

Contrary to JLI's assertion that the claims do not reduce burnt taste (Reply, 37), Fuma's device and invention eliminate burnt taste by separating the heating element and liquid storage. EX2022, ¶¶412-413. The uninsulated lead wires do not

Sur-Reply at 26

Reply at 24; Ex. 1001, Fig. 2 (annotated)

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Patent Owner objects to the citation to EX1035 at 167:6-168:5 as introducing new evidence that was not addressed in any paper of record.

Even If Patent Owner Is Correct, Cheaper Devices With Drawbacks Are Within The Scope Of Obviousness

Testimony Of Patent Owner's Expert

23 Do customers sometimes opt to purchase cheaper, worse
24 performing products?

1 THE WITNESS: Yes, I think they do.

2 Q BY MR. DOKHANCHY: And are you aware of the
3 proliferation of cheap, disposable e-cigarettes in the
4 marketplace today?

5 A I'm generally aware that there's that option.

Reply at 21-22; Ex. 1035 at 167:6-168:5

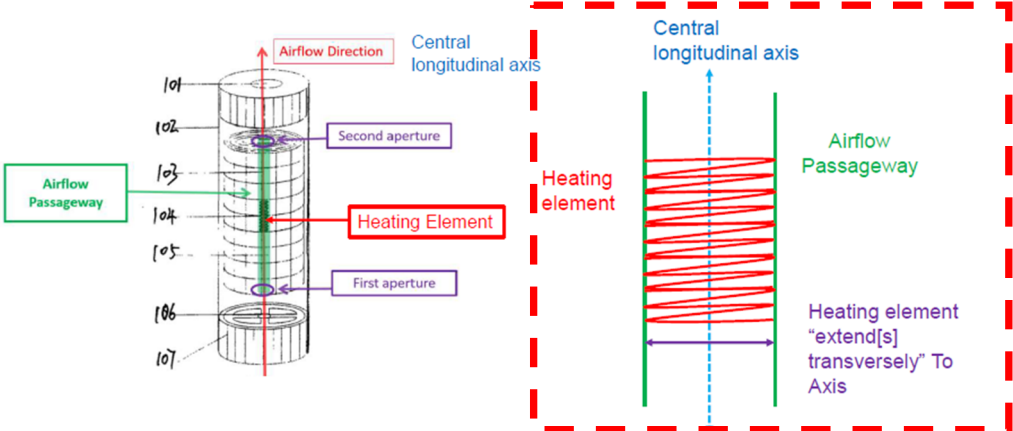
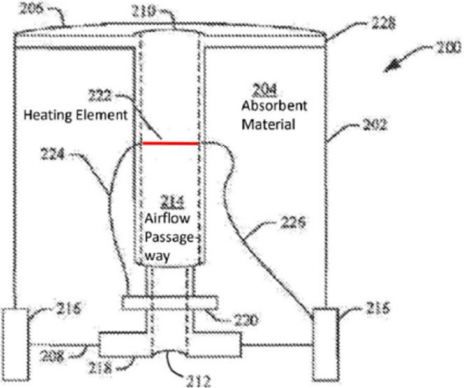
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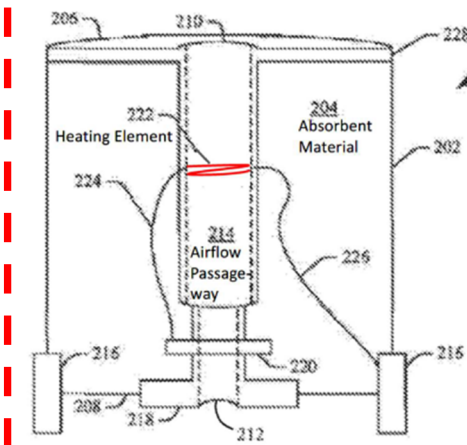
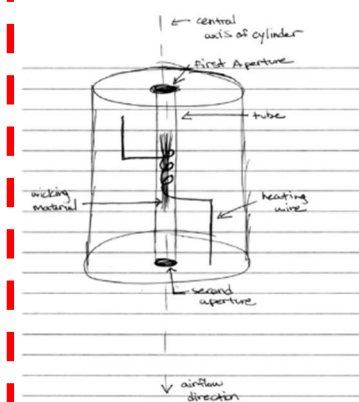
63

82

Patent Owner objects to Slide 82 as introducing new evidence and improper new argument, because Petitioner did not argue that Patent Owner has treated passageway and chamber the same in any paper of record, nor did it cite to EX1033 at 42-43 to make any such argument.

	<div data-bbox="349 218 1326 289" data-label="Text"> <p>“an airflow chamber having a length extending intermediate of the heating element and the second aperture, the length of the chamber having a substantially uniform cross-sectional area along a continuous majority of the length” (Claims 19, 37, 44)</p> </div> <div data-bbox="1360 201 1406 252" data-label="Image"> </div> <div data-bbox="420 300 1300 327" data-label="Section-Header"> <p>Patent Owner's ITC Infringement Arguments Treat Passageway And Chamber The Same</p> </div> <div data-bbox="428 338 495 357" data-label="Section-Header"> <p>Claim 19</p> </div> <div data-bbox="428 367 503 386" data-label="Section-Header"> <p>Claim 19</p> </div> <div data-bbox="428 386 634 548" data-label="Text"> <p>19. The cartridge of claim 9, wherein the housing further comprises an airflow chamber having a length extending intermediate of the heating element and the second aperture, the length of the chamber having a substantially uniform cross-sectional area</p> </div> <div data-bbox="428 546 634 760" data-label="Text"> <p>along a continuous majority of the length, the substantially uniform cross-sectional area being measured perpendicular to the central longitudinal axis of the housing, no portion of the chamber from immediately adjacent the heating element to the second aperture having a cross-sectional area smaller than a cross-sectional area of the second aperture.</p> </div> <div data-bbox="641 386 1245 514" data-label="Text"> <p>The JUUL system comprises the cartridge of claim 9, wherein the housing further comprises an airflow chamber having a length extending intermediate of the heating element and the second aperture, the length of the chamber having a substantially uniform cross-sectional area along a continuous majority of the length, the substantially uniform cross-sectional area being measured perpendicular to the central longitudinal axis of the housing, no portion of the chamber from immediately adjacent the heating element to the second aperture having a cross-sectional area smaller than a cross-sectional area of the second aperture.</p> </div> <div data-bbox="641 525 769 548" data-label="Text"> <p><u>See supra Claim 4.</u></p> </div> <div data-bbox="641 560 1214 602" data-label="Text"> <p><u>The airflow chamber comprises the portion of the airflow passageway between the heating element and the second aperture.</u></p> </div> <div data-bbox="323 774 1308 798" data-label="Text"> <p>DEMONSTRATIVE EXHIBIT - NOT EVIDENCE - © 2024 MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. // Confidential Property Ex. 1033 at 42-43 82</p> </div>
<p>84</p>	<div data-bbox="316 806 1424 930" data-label="Text"> <p>Patent Owner objects to Slide 84 as introducing new evidence and improper new argument, because Petitioner did not cite EX1001 (864 Patent) at 6:53-56, 8:1-3, or Fig. 2 with respect to an airflow chamber.</p> </div> <div data-bbox="344 993 1313 1062" data-label="Text"> <p>“an airflow chamber having a length extending intermediate of the heating element and the second aperture, the length of the chamber having a substantially uniform cross-sectional area along a continuous majority of the length” (Claims 19, 37, 44)</p> </div> <div data-bbox="1346 976 1391 1024" data-label="Image"> </div> <div data-bbox="470 1092 724 1121" data-label="Section-Header"> <p>'864 Patent Specification</p> </div> <div data-bbox="365 1152 816 1260" data-label="Text"> <p>coupled to a positive terminal of the power source. When a user draws a breath by way of the <u>airflow passageway 214</u>, a circuit is closed, thereby providing current to the heating element 222. The heating element 222 acts to vaporize the liquid solution in the absorbent material 204, and the result-</p> </div> <div data-bbox="574 1285 618 1302" data-label="Text"> <p>***</p> </div> <div data-bbox="365 1329 821 1394" data-label="Text"> <p>In another exemplary embodiment, a heating element 302 may be helical in nature and may wrap around the exterior of the <u>airflow chamber 214</u>. The heating element in this case</p> </div> <div data-bbox="964 1089 1179 1117" data-label="Section-Header"> <p>'864 Patent, Figure 2</p> </div> <div data-bbox="904 1140 1297 1470" data-label="Image"> <p>Figure 2 is a cross-sectional view of a device 200. It shows a housing 202 with a top cap 206 and a bottom cap 212. Inside the housing, there is a heating element 222 and a liquid reservoir 204. An airflow passageway 214 is shown, which is a vertical channel through the center of the device. The passageway is defined by a wall 215 and has a bottom opening 216. A heating element 222 is positioned around the passageway. A liquid reservoir 204 is located below the heating element. A wick 224 is shown, which is a vertical channel that draws liquid from the reservoir up to the heating element. A second aperture 228 is located at the top of the device. A first aperture 218 is located at the bottom of the device. A power source 230 is connected to the heating element 222. A circuit 232 is shown, which includes the power source 230 and the heating element 222. A user 208 is shown drawing a breath through the first aperture 218.</p> </div> <div data-bbox="1071 1520 1338 1545" data-label="Text"> <p>Ex. 1001 at 6:53-56, 8:1-3, Fig. 2</p> </div> <div data-bbox="316 1541 1391 1562" data-label="Text"> <p>DEMONSTRATIVE EXHIBIT - NOT EVIDENCE - © 2024 MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. // Confidential Property 84</p> </div>
<p>104</p>	<p>Patent Owner objects to the annotated figure as introducing new evidence and improper new argument that did not appear, or was not otherwise addressed, in any paper of record.</p>

	<p>1[b1] a heating element located in the interior of the housing, <u>the heating element extending transversely to a central longitudinal axis of the housing and being at least partially exposed to the airflow</u></p>  <p>Pet. at 96-97; Reply at 30-34; Ex. 1005, Fig. 3 (annotated).</p> <p>DEMONSTRATIVE EXHIBIT - NOT EVIDENCE - © 2024 MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. // Confidential Property</p>
<p>109</p>	<p>Patent Owner objects to Slide 109 as presenting improper evidence subject to Patent Owner's Motion to Exclude (Paper 29).</p> <p>1[b1] a heating element located in the interior of the housing, the heating element extending transversely to a central longitudinal axis of the housing and being at least partially exposed to the airflow</p> <p>Deposition Testimony of Inventor Daniel Hillenbrandt</p>  <p>20 Q. And you agree it does go transversely 21 across the passageway, right? 22 MR. SIEGER: Same objections. 23 A. That your hypothetical does look 24 transverse.</p> <p>Reply at 33-36; Ex. 1040, 2; Ex. 1038, 88:16-89:24.</p> <p>DEMONSTRATIVE EXHIBIT - NOT EVIDENCE - © 2024 MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. // Confidential Property</p>
<p>110</p>	<p>Patent Owner objects to Slide 110 as presenting improper evidence subject to Patent Owner's Motion to Exclude (Paper 29).</p>

	<p>1[b1] a heating element located in the interior of the housing, the heating element extending transversely to a central longitudinal axis of the housing and being at least partially exposed to the airflow</p> <p>Deposition Testimony of Inventor Daniel Hillenbrandt</p>  <p>15 All this wire does is go across the 16 passageway three times. So my question is, if 17 the heating element, instead of going across 18 once, goes across three times, does it still 19 extend transversely to the airflow passageway? 23 A. As you're describing it, and the way you 24 drew it horizontally, would speculate that it 1 does -- 2 Q. Okay. 3 A. -- is what you're trying to achieve as 4 far as going across.</p> <p>Reply at 33-36; Ex. 1040, 2; Ex. 1038, 90:1-92:1</p> <p>MONSTRATIVE EXHIBIT - NOT EVIDENCE - © 2024 MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. // Confidential Property</p>
111	<p>Patent Owner objects to Slide 111 as presenting improper evidence subject to Patent Owner's Motion to Exclude (Paper 29).</p> <p>1[b1] a heating element located in the interior of the housing, the heating element extending transversely to a central longitudinal axis of the housing and being at least partially exposed to the airflow</p> <p>Deposition Testimony of Inventor Daniel Hillenbrandt</p>  <p>"[I]t does extend transversely across the passageway; correct? 13 MR. PEPE: Objection to form, calls 14 for opinion testimony. 15 A. I can see it can be interpreted like that.</p> <p>Reply at 33-36; Ex. 1041, 240:12-242:15, Ex. 1042.</p> <p>DEMONSTRATIVE EXHIBIT - NOT EVIDENCE - © 2024 MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. // Confidential Property</p>
115	<p>Patent Owner objects to Slide 115 as presenting improper evidence subject to Patent Owner's Motion to Exclude (Paper 29).</p>

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Patent Owner's Theory



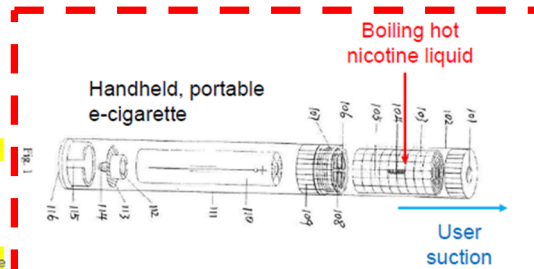
Deposition Of Patent Owner's Expert

2 Q Okay. So how does the vapor pass through a
3 fiber soaked in liquid?
4 A Well, it's kind of like drinking a Sprite or a
5 Coke, right? It's all liquid, but there's bubbles that
6 form and flow through the liquid to get to the outside.
7 So essentially it's a boiling operation, and gas can go
8 through liquid as it's boiling outwards.

24 Q Does Wang describe its operation as boiling the
25 liquid that's within the fiber?
1 A No, it does not use that terminology.

Ex. 1035 at 25:2-26:1

Patent Owner's Theory



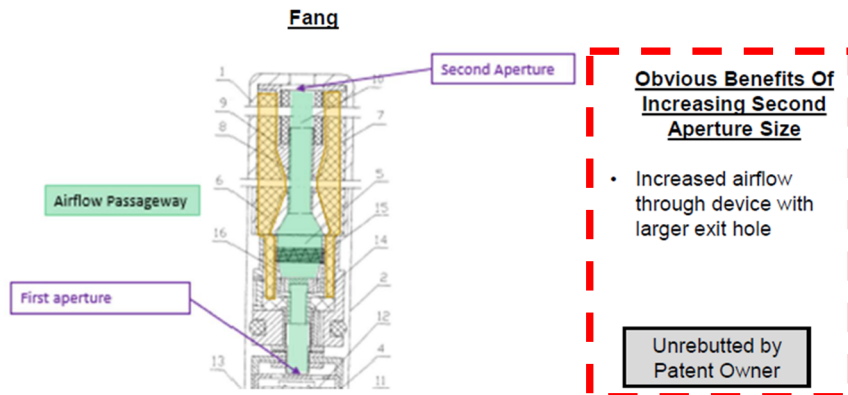
POR, 80-82

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137 Patent Owner objects to Slide 137 as introducing new argument that was not addressed in any paper of record.

"the first aperture proximate the first end is smaller than the second aperture proximate the second end"
(Claims 13, 32)



Reply at 36; Pet. at 113-114; Ex. 1006, Fig. 1 (partial, annotated); Ex. 1007, ¶360-361

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Date: February 25, 2025

By: /Anish R. Desai/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on February 25th, 2025, the foregoing
**PATENT OWNER'S OBJECTIONS TO PETITIONER'S
DEMONSTRATIVE EXHIBITS FOR ORAL ARGUMENT** was served via
electronic mail, upon the following:

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