

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.

IPR2023-00160

Patent 11,497,864 B2

Title: Electronic Vaporizer

Filing Date: June 25, 2019

Issue Date: November 15, 2022

**PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT NO. 11,497,864 B2**

**NJOY Exhibit 1046.001
NJOY v. Juul
IPR2024-00231**

TABLE OF CONTENTS

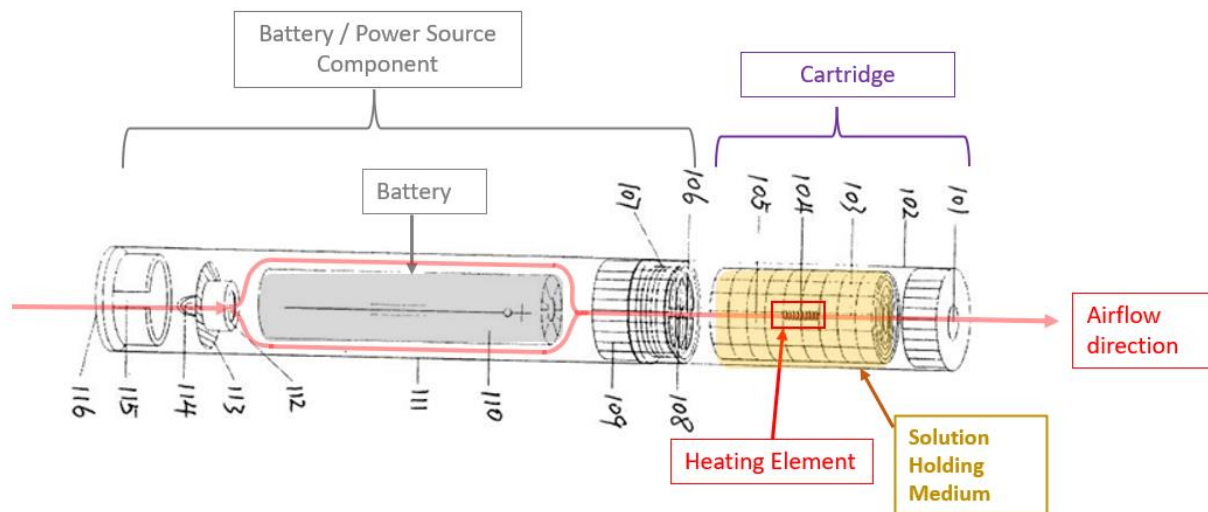
I.	INTRODUCTION	1
II.	MANDATORY NOTICES UNDER 37 C.F.R. § 42.8.....	4
A.	REAL PARTIES-IN-INTEREST.....	4
B.	RELATED MATTERS	4
C.	LEAD AND BACK-UP COUNSEL	5
D.	SERVICE INFORMATION	6
III.	PAYMENT OF FEES	6
IV.	STANDING	6
V.	CHALLENGE AND STATEMENT OF RELIEF REQUESTED.....	7
VI.	THE '864 PATENT	7
A.	SUMMARY OF THE '864 PATENT	7
B.	PROSECUTION HISTORY OF THE '864 PATENT	10
VII.	PRIOR LITIGATION.....	11
A.	LEVEL OF ORDINARY SKILL	11
B.	PRIOR CONSTRUCTIONS.....	12
C.	SUMMARY JUDGMENT OF INFRINGEMENT	13
VIII.	PRIOR ART	17
A.	XIA	18
B.	WANG	23
C.	FANG	26
IX.	MOTIVATION TO COMBINE AND REASONABLE EXPECTATION OF SUCCESS.....	28
X.	THE '864 PATENT IS INVALID IN VIEW OF THE PRIOR ART	30
A.	GROUND 1: XIA ALONE AND IN VIEW OF WANG AND/OR FANG AND THE KNOWLEDGE OF A POSITA RENDERS OBVIOUS THE CHALLENGED CLAIMS	30

B.	GROUND 2: WANG ALONE OR IN COMBINATION WITH FANG RENDERS OBVIOUS CLAIMS 1-48	91
XI.	SECONDARY CONSIDERATIONS CANNOT OVERCOME THE STRONG EVIDENCE OF OBVIOUSNESS	121
A.	NON-INSTITUTION UNDER 35 U.S.C. §325 WOULD BE IMPROPER.....	122
XII.	CONCLUSION	123

2. Claim 2:

a. Battery

Xia discloses “battery 2...arranged inside the controller.” Ex. 1004, 7;
see Fig. 1:



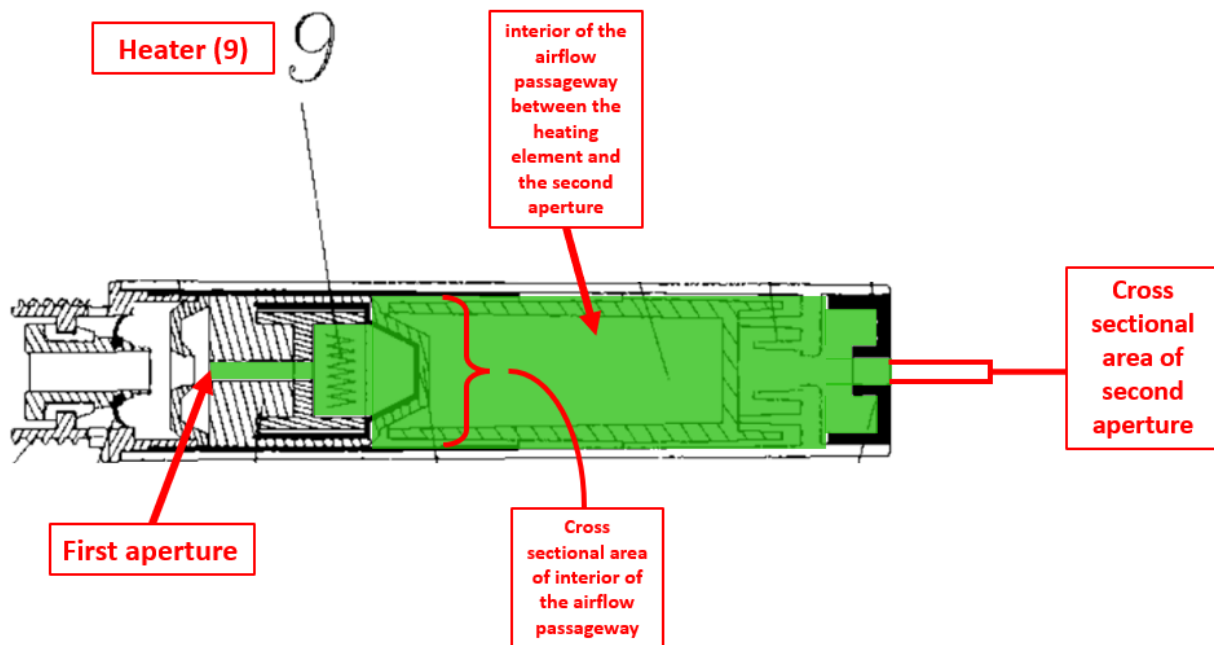
Ex. 1004, Fig. 1. See also 1[p], 1[a3].

3. Claim 3:

a. Airflow passageway having cross sectional area not smaller than second aperture

i. Xia

The interior of Xia’s airflow passageway has a cross sectional area larger than the second aperture perpendicular to the central and longitudinal axis of the device, between the heating element and second aperture. Ex. 1007, ¶164-165.



Ex. 1004, Fig. 2 (partial, annotated).

ii. Xia combined with Wang and/or Fang

The modifications with Wang and/or Fang relate to the location of the first aperture and the location of the airflow passageway, but do not impact the fact that the second aperture in Xia is smaller than the cross section of the passageway. Ex. 1007, ¶166.

4. Claim 4:

a. Airflow passageway having substantially uniform cross-sectional area cross a continuous majority of the length of the housing

See Claim 3 (regarding passageway size versus second aperture); Ex. 1007, ¶167.

As to the substantial uniformity of the cross-sectional area, Xia discloses this as shown in claim 3. The modifications would maintain the uniformity of the airflow passageway, but to move it centrally within the solution medium. A POSITA would recognize the obvious benefits of a simple uniform cross section in the airflow passageway, which also exists in Wang and Fang, because it would create a more consistent airflow, would be simpler to manufacture and repair, and maximizes the storage space for liquid around the passageway. Ex. 1007 ¶ 168-172.

5. Claim 5:

a. 5[p]

See element 1[p].

b. 5[a]

See element 1[a1] – [a4].

c. 5[b]

See element 1[b1]-[b2].

d. 5[c]

See element 1[c].

e. 5[d]: Airflow passageway extends in a straight path from first to second aperture with only heating element obstructing a portion of the airflow

The passageway of Xia and the combinations proposed above extend in a straight path from the first aperture to the second aperture, as explained above in 1[c] and claim 4. Ex. 1007, ¶177.

pertinent art. *Oticon Med. AB v. Cochlear Ltd.*, IPR2019-00975, Paper 15 at 19–20 (PTAB Oct. 16, 2019) (precedential) (granting institution). Additionally, the prosecution history is silent as to the disclosures in Wang, Fang, and Xia, which, as described in detail above, render the claims of the '864 Patent obvious. See § VIII.A - B; see also *Advanced Bionics*, IPR2019-01469, Paper 6, at 10.

Factor (f) is inapplicable because none of the asserted combinations were substantively considered by the Examiner. The Board has consistently declined exercising its discretion under Section 325(d) when the only fact a Patent Owner can point to is that a reference was disclosed to the Examiner during the prosecution. See, e.g., *Digital Check Corp. d/b/a ST Imaging v. E-Imagedata Corp.*, IPR2017-00178, slip op. at 12–13 (PTAB Apr. 25, 2017) (Paper 6) (acknowledging that a prior art reference was cited in an IDS, but granting institution because there was no indication that the claims were rejected based on those references or that the Examiner substantively discussed those references during prosecution). Weighing the factors together, non-institution under §325 would be improper.

XII. CONCLUSION

For the foregoing reasons, the PTAB should institute *inter partes* review against claims 1-48 of the '864 patent and ultimately cancel each of these claims.

U.S. Patent No. 11,497,864 B2
Petition for *Inter Partes* Review

Dated: November 8, 2023

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), Patent Owner hereby certifies, in reliance on the word count of the word-processing system (Microsoft Office Word 2010) used to prepare this petition, that the number of words in this paper is 13,994. This word count excludes the tables of contents, tables of authorities, mandatory notices under 37 C.F.R. § 42.8, certificate of word count, certificate of service, or appendix of exhibits or claim listing. Petitioner certifies that this Petition for *Inter Partes* Review does not exceed the applicable type-volume limit of 37 C.F.R. § 42.24(a).

Dated: November 8, 2023

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CERTIFICATE OF SERVICE

I certify that copies of the foregoing Petition for *Inter Partes* Review, all referenced exhibits, and the Petitioner's Power of Attorney were served on November 8, 2023, via overnight courier upon the following counsel of record for Patent Owner:

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