

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NJOY, LLC and NJOY HOLDINGS, INC.,
Petitioners,

v.

JUUL LABS, INC.,
Patent Owner

Case No. IPR2024-00231
U.S. Patent No. 10,130,123

**PETITIONERS' OPPOSITION TO
PATENT OWNER'S MOTION TO SUBMIT
SUPPLEMENTAL INFORMATION**

Section V.B of the International Trade Commission’s Opinion in 337-TA-1368 (“Commission Opinion”) is already record evidence and sets forth the Commission’s construction of the “pressure sensor” limitation in the challenged 123 Patent claims. Ex. 1052. Patent Owner’s request to also submit Section V.C.2 because it purportedly “clarifies” the Commission’s construction is a thinly veiled attempt to supplement the record with evidence and argument regarding the doctrine of equivalents (DOE) that Patent Owner failed to present in its Patent Owner Response and Patent Owner Sur-Reply. The Board should deny Patent Owner’s motion because it does not satisfy the requirements of 37 C.F.R. § 42.123.

I. PATENT OWNER CHOSE NOT TO SUBMIT ARGUMENT AND EVIDENCE REGARDING DOE IN THIS PROCEEDING

Patent Owner has not demonstrated that the proposed “supplemental information reasonably could not have been submitted earlier.” 37 C.F.R. § 42.123(b). The vast majority of Section V.C.2 that Patent Owner seeks to submit comprises the parties’ arguments and evidence submitted in May 2024 for the hearing in Inv. No. 337-TA-1368, which occurred months before Patent Owner submitted its Response in this IPR. Motion, App. A at 48-55 (summarizing the parties’ ITC arguments); Paper 21 (POR filed September 2024). For example, several pages of Section V.C.2 are block quotes of testimony from the May 2024 ITC hearing. Motion, App. A at 57-60, 65-66. Indeed, Appendix A includes 65 citations to the trial transcript and dozens of citations to heavily redacted trial

exhibits that were available no later than May 2024, which Patent Owner chose not to submit with its Patent Owner Response months later.

Patent Owner clearly elected not to submit a function-way-result DOE argument for the JUUL System in its Patent Owner Response or Sur-Reply. Instead, Patent Owner included only a single conclusory sentence regarding DOE in each paper, and did so only for the JUUL System (not JAGWAR or JUUL2):

[T]he JUUL System would embody an equivalent to the pressure sensor. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002) (“The scope of a patent is not limited to its literal terms but instead embraces all equivalents to the claims described.”).

Paper 21 at 23; *see also* Paper 35 at 29. Patent Owner also failed to submit expert testimony to support a DOE argument, as required by Federal Circuit law. *VLSI Tech. LLC v. Intel Corp.*, 87 F.4th 1332, 1343-44 (Fed. Cir. 2023). The Board should reject Patent Owner’s attempt to submit a function-way-result argument via the Commission Opinion. *Yamaha Golf Car Co. v. Club Car, LLC*, IPR2017-02141, Paper 33 at 6 (denying request to submit supplemental information that constituted a “substantial change in its original showing on these issues”).

II. ADMISSION OF BELATED ARGUMENTS AND EVIDENCE WOULD NOT BE IN THE INTERESTS OF JUSTICE

Patent Owner’s request should also be denied because it is not in the interests of justice as required by 37 C.F.R. § 42.123(b). First, Patent Owner is clearly attempting to submit Section V.C.2 to backdoor a function-way-result DOE

argument it failed to present in its Patent Owner Response and Patent Owner Sur-Reply, and therefore waived. *See PNC Bank N.A. v. United Services Automobile Assoc.*, IPR2021-01077, Paper 73, at 83–84 (denying motion to submit supplemental information filed after hearing because it was a “thinly-veiled attempt to supplement [Patent Owner’s] briefing”).

Second, Patent Owner’s request is an attempt to incorporate by reference over 30 pages of argument, which violates 37 C.F.R. § 42.6(a)(3) (“Arguments must not be incorporated by reference from one document into another”), and would allow Patent Owner to circumvent the word limits in 37 C.F.R. § 42.24.

Third, Section V.C.2 is replete with inadmissible hearsay that Petitioner has had no opportunity to move to exclude. For example, the proposed exhibit includes over thirty citations to the testimony of Patent Owner’s expert from the ITC Investigation (Mr. Alarcon), who did not submit a declaration in this IPR and was not subject to cross examination herein. Motion, App. A at 59-60, 65-66.

III. SECTION V.C.2 IS IRRELEVANT TO ANY TIMELY CLAIM

Patent Owner’s motion should be denied because Section V.C.2 of the Commission Opinion is not relevant to any claim that the parties raised in their papers as required by 37 C.F.R. § 42.123(a)(2). Section V.C.2 consists of two subsections. Pages 38-48 include the Commission’s determination that the JAGWAR and JUUL2 products do not literally practice the “pressure sensor,” while Pages

48-72 include the Commission’s determination that **only** JUUL2 practices the “pressure sensor” under the DOE. Motion, App. A. Notably, Patent Owner’s assertion that the Commission determined that JAGWAR practices under the DOE (Motion at 1) is false. *See* Motion, App. A at 55, fn. 29 (“The Commission **takes no position** on whether the JAGWAR iteration of the JUUL system also practices claims 27 and 32 under the DOE.”).

Patent Owner contends that Section V.C.2 is relevant because it provides “clarification” of the Commission’s construction of “pressure sensor.” Motion at 3. But Patent Owner has failed to explain how the Commission’s purported clarifications are relevant to any issues raised in this proceeding. As explained above, Section V.C.2 includes the Commission’s analysis that JAGWAR and JUUL2 do not literally practice the “pressure sensor” limitation (pages 44-48), and that JUUL2 practices under the DOE (pages 55-72), but Patent Owner did not rely on either of those products in this proceeding. Patent Owner’s Response and Sur-Reply never reference “JAGWAR” or “JUUL2.” Paper 21; Paper 35. Moreover, Patent Owner’s motion concedes that the products analyzed in the Commission Opinion are not the same as the JUUL System that Patent Owner relied on in this proceeding. Motion at 1 (asserting that JAGWAR and JUUL2 have “a pressure sensor **similar** to that of the JUUL System”). Thus, any “clarification” the Commission provided concerning JAGWAR and JUUL2 is irrelevant to this IPR.

Patent Owner also contends that Section V.C.2 is relevant because the Commission’s “determination regarding the equivalent function, way, and result...provides clarification regarding the scope of its construction.” Motion at 4. As noted above, however, Patent Owner did not present any argument or evidence regarding the equivalent function, way or result in this IPR. Thus, any clarification the Commission provided in the context of its function-way-result analysis for JUUL2 is irrelevant to this IPR.

Finally, even if the few isolated “clarifications” Patent Owner identified are relevant to this IPR (*see* Motion at 3-4), Patent Owner has failed to justify submitting over **30 pages** of the Commission’s Opinion that includes substantial additional content that does not “clarify” the Commission’s construction. For example, Appendix A includes pages of content summarizing the parties’ ITC arguments as well as testimony from a witness who was not a declarant in this IPR, which clearly does not clarify the Commission’s construction. Motion, App. A at 39-44, 48-55, 59-60, 65-66. Patent Owner’s motion neglects to address how this testimony or other extraneous information clarifies the Commission’s construction or otherwise meets the requirements of 37 C.F.R. § 42.123.

IV. CONCLUSION

For at least the above reasons, Patent Owner’s request does not satisfy the requirements of 37 C.F.R. § 42.123 and should be denied.

Date: April 4, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on April 4, 2025, the foregoing
**PETITIONERS' OPPOSITION TO PATENT OWNER'S MOTION TO
SUBMIT SUPPLEMENTAL INFORMATION** was served via electronic
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