

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

JUUL LABS, INC.,
Patent Owner

Case No. IPR2024-00268
U.S. PATENT NO. 11,606,981

**PETITIONER'S MOTION TO WITHDRAW PETITION
THROUGH DISMISSAL WITHOUT PREJUDICE**

PETITIONERS' UPDATED EXHIBIT LIST

No.	Exhibit
1001	U.S. Patent No. 11,606,981 (“981 Patent”)
1002	U.S. Patent No. 8,794,231 (“Thorens231”)
1003	U.S. Patent No. 9,427,022 (“Levin”)
1004	WO2011160788A1 (“Thorens788”)
1005	Expert Declaration of Jason Janet
1006	Curriculum Vitae of Jason Janet
1007	U.S. Patent No. 11,606,981 File History
1008	U.S. Patent No. 9,155,336
1009	U.S. Patent No. 7,717,756
1010	U.S. Patent Publication No. 2014/0150783 A1 (“Liu783”)
1011	Universal Serial Bus Micro-USB Cable and Connections Specification – April 4, 2007
1012	U.S. Patent No. 9,420,831
1013	U.S. Patent Publication No. 2013/0319438 A1
1014	U.S. Patent No. 5,505,214
1015	U.S. Patent No. 8,550,068
1016	<i>Intentionally left blank</i>
1017	<i>Intentionally left blank</i>
1018	<i>Intentionally left blank</i>

No.	Exhibit
1019	<i>Intentionally left blank</i>
1020	U.S. Patent No. 2,057,353
1021	U.S. Patent No. 8,863,752
1022	U.S. Patent Publication No. 2010/0031968 A1
1023	<i>Intentionally left blank</i>
1024	U.S. Patent No. 8,205,622 (“Pan”)
1025	U.S. Patent Publication No. 2014/0190502 A1
1026	U.S. Patent No. 11,229,239
1027	U.S. Patent No. 8,156,944
1028	U.S. Patent No. 9,386,805
1029	U.S. Patent No. 9,408,416
1030	U.S. Patent No. 9,861,138
1031	U.S. Patent No. 8,528,569
1032	Insight: No Smoke, Plenty of Fire Fuels E-Cigarettes – Reuters
1033	U.S. Patent Publication No. 2013/0081642 A1
1034	U.S. Patent Publication No. 2013/0192623 A1
1035	U.S. Patent Publication No. 2014/0261495 A1
1036	U.S. Patent No. 10,143,242
1037	<i>Intentionally left blank</i>
1038	U.S. Patent No. 9,901,120

No.	Exhibit
1039	<i>Intentionally left blank</i>
1040	U.S. Patent No. 9,301,548
1041	U.S. Patent No. 9,820,509
1042	U.S. Patent No. 9,675,114
1043	U.S. Patent No. 9,609,893
1044	CN202697716U
1045	CN202919037U
1046	KR200453424Y1
1047	<i>Intentionally left blank</i>
1048	<i>Intentionally left blank</i>
1049	Joint Claim Construction Chart (2023-11-07)
1050	U.S. Patent No. 9,060,548 (“Zheng”)
1051	<i>Intentionally left blank</i>
1052	U.S. Patent No. 6,155,268
1053	U.S. Patent No. 6,340,320
1054	U.S. Patent No. 7,201,613
1055	Jonny Stevenson, <i>Guide to Avoid a Dry Hit When Vaping</i> , Vapour Depot, July 18, 2023, available at https://vapourdepot.com/blog/dry-hit-vape-guide-avoid-dry-hits-vaping
1056	CN2002819631U
1057	Redlined Versions of Petitions for IPR2024-00268 and Proposed IPR2024-00536

No.	Exhibit
1058	Redlined Versions of Expert Declaration in IPR2024-00268 and Proposed IPR2024-00536

Pursuant to the Board's email authorization dated January 31, 2024, Petitioners hereby files this motion to withdraw the Petition in this proceeding through dismissal without prejudice. Patent Owner has indicated that it does not oppose dismissal of the Petition without prejudice.

The Board has broad discretion to dismiss petitions. 37 C.F.R. § 42.71(a) ("The Board may take up petitions or motions for decisions in any order, may grant, deny, or dismiss any petition or motion, and may enter any appropriate order.").

Petitioners filed the above-captioned Petition on December 5, 2023, challenging the patentability of claims 1, 5, 8-11, and 13-18 of U.S. Patent No. 11,606,981 (the '981 patent), which are all asserted against Petitioners in ITC Investigation No. 337-TA-1368, filed on June 30, 2023. Petitioners inadvertently omitted dependent claim 2 of the '981 Patent, which is also an asserted claim in the ITC Investigation, from Grounds 1 and 4 in the Petition. Petitioners have concurrently with this motion filed a new Petition (IPR2024-00536) that corrects this omission by including claim 2 in Grounds 1 and 4 in the Petition.

Attached as Exhibit 1057 is a redline showing all changes between the new Petition (IPR2024-00536) and the Petition in this proceeding. Aside from the addition of claim 2 in Grounds 1 and 4, the Grounds and arguments in the new Petition are identical to the Grounds and arguments in the Petition in this proceeding. The only change to the exhibits in the new Petition is the addition of six paragraphs

(¶¶ 590-595) that address claim 2 in the supporting expert declaration (EX1005). Exhibit 1058 to this motion is a redline showing the changes to the expert declaration is attached

Patent Owner has not filed its Preliminary Response and the Board has not issued an Institution Decision. Furthermore, Petitioner's one-year time bar under 35 U.S.C. § 315(b) is still six months away. Thus, Petitioners could have filed a new Petition that solely addressed dependent claim 2, while maintaining the current Petition addressing the other challenged claims. Petitioner, however, has opted for the procedure of dismissing the current Petition, and filing the new Petition challenging all asserted claims, which allows the parties and the Board to address all of the challenged claims in a single IPR proceeding. Dismissal of the Petition in this proceeding without prejudice at this juncture will therefore promote efficiency and minimize costs.

Furthermore, there is no prejudice to Patent Owner in allowing Petitioner to proceed with the new Petition while dismissing the Petition in this proceeding without prejudice. The deadline for Patent Owner's preliminary response will be reset based on the notice according a filing date for the new Petition. Petitioner has not added any new prior art in the Petition, has not changed the prior art in the Grounds, and has not made any adjustments to the arguments in the Grounds other

than adding claim 2 to Grounds 1 and 4. Accordingly, Petitioner has not used the new Petition to gain any strategic advantage.

The parties do not have a settlement agreement or other agreements made in connection with or in contemplation of the requested withdrawal of the Petition.

Petitioners respectfully request withdrawal of the Petition through dismissal of the Petition without prejudice.

Respectfully submitted,

Dated: February 5, 2024

By: /Anish R. Desai/
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CERTIFICATE OF SERVICE

I hereby certify that on February 5, 2024, the foregoing **PETITIONER’S**
MOTION TO WITHDRAW PETITION THROUGH DISMISSAL
WITHOUT PREJUDICE and EXHIBITS 1057 – 1058, were served via
electronic mail, upon the following:

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