

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NJOY, LLC and NJOY HOLDINGS, INC.,
Petitioner,

v.

JUUL LABS, INC.,
Patent Owner.

IPR2024-00268
Patent 11,606,981 B2

Before KRISTINA M. KALAN, KIMBERLY McGRAW, and
AVELYN ROSS, *Administrative Patent Judges*.

McGRAW, *Administrative Patent Judge*.

DECISION
Dismissal Prior to Institution of Trial
35 U.S.C. § 314, 37 C.F.R. § 42.71(a)

I. INTRODUCTION

NJOY, LLC and NJOY Holdings, Inc. (collectively, “Petitioner”) filed, on December 5, 2023, a Petition requesting an *inter partes* review of claims 1, 5, 8–11, and 13–18 of U.S. Patent No. 11,606,981 B2 (“the ’981 patent”). Paper 2 (“Petition”). With the Board’s authorization, Petitioner filed, on February 5, 2024, a Motion to Withdraw Petition Through Dismissal Without Prejudice in this proceeding prior to an institution decision. Paper 6 (“Motion”). In the Motion, Petitioner explains that the Petition was intended to challenge claims of the ’981 patent that have been asserted against Petitioner in an ITC Investigation (ITC Investigation No. 337-TA-1368 (filed June 30, 2023)) but “Petitioner[] 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.” Motion 2. Petitioner has sought to correct the omission by filing, on February 5, 2024, “a new Petition (IPR2024-00536) that corrects this omission by including claim 2 in Grounds 1 and 4 in the [new] Petition” such that “[a]side 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 [IPR2024-00268] proceeding.” *Id.* Petitioner therefore seeks the dismissal of the Petition, as the “filing [of] the new Petition challenging all asserted claims . . . allows the parties and the Board to address all of the challenged claims [of the ’981 patent] in a single IPR proceeding.” *Id.* at 2–3.

JUUL Labs, Inc. (“Patent Owner”) has not yet filed a Preliminary Response to the Petition. Petitioner informs us that “Patent Owner has

indicated that it does not oppose dismissal of the Petition without prejudice.”
Motion 2.

II. ANALYSIS

Having considered Petitioner’s Motion, we determine that it is appropriate to dismiss the Petition as to both Petitioner and Patent Owner without rendering either a decision to institute or a final written decision. *See* 37 C.F.R. §§ 42.5(a); 42.71(a). This proceeding is in a preliminary stage, and no decision on whether to institute an *inter partes* review has been made. As Petitioner notes, “Patent Owner has not filed its Preliminary Response and the Board has not issued an Institution Decision.” Motion 3. Petitioner further submits that “there is no prejudice to Patent Owner in allowing Petitioner to proceed with the new Petition [(i.e., IPR2024-00536)] while dismissing the Petition in this proceeding without prejudice” as “Petitioner has not used the new Petition to gain any strategic advantage.” *Id.* at 3–4. Petitioner also submits that “dismissing the current Petition, and filing the new Petition . . . allows the parties and the Board to address all of the challenged claims in a single IPR proceeding” which will “promote efficiency and minimize costs.” *Id.* at 3. Moreover, Petitioner represents that Patent Owner does not object to withdrawal of the Petition. *Id.* at 2.

Under these circumstances, we determine that it is appropriate to grant Petitioner’s Motion to Withdraw its petition without prejudice and terminate this proceeding.

This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Motion to Withdraw its Petition for *Inter Partes* Review is *granted*; and

FURTHER ORDERED that the Petition is *dismissed* and IPR2024-00268 is *terminated* as to all parties.

IPR2024-00268
Patent 11,606,981 B2

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