

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUUL LABS, INC.,
Petitioner,

v.

NJOY, LLC,
Patent Owner.

Case No. IPR2024-00161

U.S. Patent No. 10,334,881 B1

Title: Electronic Vaporizer

Filing Date: December 13, 2016

Issue Date: July 2, 2019

PATENT OWNER'S PRELIMINARY SUR-REPLY

TABLE OF CONTENTS

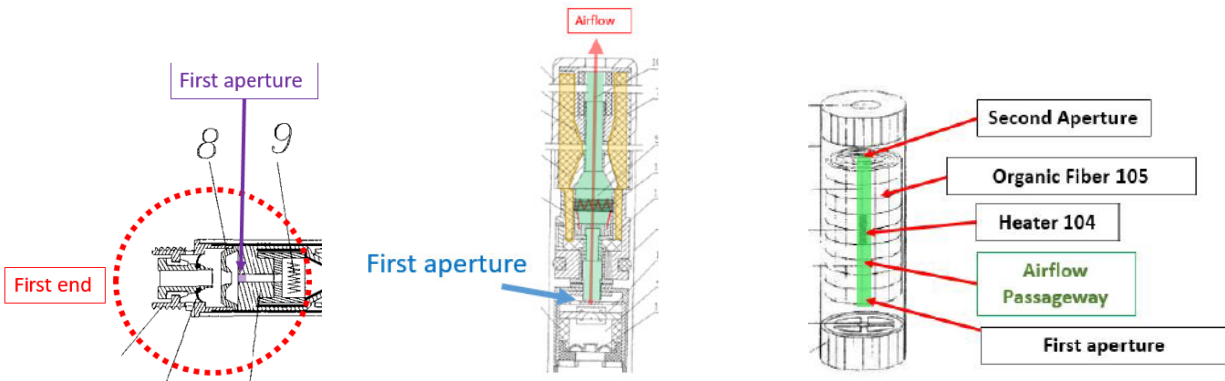
	Page
I. Petitioner Does Not Dispute That The Prior Art Fails To Disclose A “Housing Having A [First/Second] Aperture”	1
II. Petitioner Exceeded the Word Count	4

Petitioner's reply is without merit. Petitioner does not contest that its prior art references fail to disclose a housing having a first aperture. Instead, Petitioner argues that, despite the clear language of the claims, the aperture need not be in the housing; or, alternatively, it would have been obvious to include an aperture in the housing. For the former, Petitioner argues that Patent Owner took positions in the ITC investigation concerning the Vuse Ciro device that purportedly confirm that the aperture need not be in the housing. Patent Owner, however, is no longer relying on the Vuse Ciro in the ITC investigation. Regardless, the Vuse Ciro practices this limitation. For the latter, Petitioner argues it would have been obvious to move the existing apertures closer to the housing end. But that only puts the aperture closer to the housing, not in the housing as required.

Finally, concerning the word count issue, Petitioner does not dispute that the short-hand characterization would take the word count over the statutory limit. Nor do any of the cases relied on by Petitioner have the same fact pattern as here.

I. Petitioner Does Not Dispute That The Prior Art Fails To Disclose A "Housing Having A [First/Second] Aperture"

The claims recite a "housing having a [first/second] aperture." Yet, as seen below, the Petitioner uniformly failed to identify this requirement in any of its prior art references:



Xia (Pet. at 17)

Fang (Pet. at 24 (annotated))

Wang (Pet. at 22)

Petitioner nonetheless argues that the aperture need not be in the housing because Patent Owner purportedly takes that position in the ITC investigation concerning the Vuse Cir. Reply at 1-2. Patent Owner, however, dropped its reliance on the Vuse Cir. in the ITC investigation.

Regardless, the Vuse Cir. includes a housing (*i.e.*, the outer structure of the device) having an aperture, which can be clearly seen from outside the device. POPR at 27. Petitioner draws a distinction between the housing and the threaded connector (Reply at 1); but the threaded connector is part of the housing (*i.e.*, the outer structure of the device). And even if the threaded connector was not considered part of the housing, the housing has an aperture to accommodate the threaded connector.

Petitioner also misstates the Middle District of North Carolina judge's holding, which Petitioner suggests permits an internal aperture. Reply at 1-2. There, the judge determined that, "[a]ir enters through an opening at the base of the positive pin." Ex. 1015 at 16. The "opening at the base of the positive pin" is the housing's

hole, which can be seen when viewing the exterior of the cartridge, identified by Patent Owner as the aperture, not some internal gathering point. POPR at 27.

Petitioner's Reply then resorts to rearguing its obviousness case – suggesting that it would have been obvious to modify Xia and Wang to have this feature. Reply at 3. As to Xia, Petitioner cites for support the Pet. at 35-36. But Pet. at 35-36 recites that Xia's aperture could be *replaced* by Wang's apertures. Pet. at 36 (“it was obvious to modify Xia's cartridge to include a passageway through the center of the solution holding medium *as in Wang.*” (emphasis added). As the figures above demonstrate, Wang's purported apertures are not in the housing but are instead in the liquid storage medium. Pet. at 36 also suggests it would have been obvious to “require *extension of the passageway* to the very edge of the housing, with a central aperture (already present in Wang and Fang)” (emphasis added). But *extending the structures having the apertures* to be closer to the housing ends is not the same as moving the aperture from these structures to the housing, which is required under the claims.

As to Wang, Petitioner cites Pet. at 92 to argue that the Petition argues obviousness for an aperture in Wang's housing. The Pet. at 92, however, recites extending “*the solution holding medium* and the passageway [to] reach[] to air inlet 106” (emphasis added). Again, the Petition does not suggest moving the aperture to the housing, but instead, keeping the aperture in the solution-holding medium and

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