

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. IPR2024-00223
U.S. Patent No. 10,709,173

**PETITIONERS' REPLY TO PATENT OWNER'S
PRELIMINARY RESPONSE**

TABLE OF CONTENTS

	Page
I. JUUL IS NOT CO-EXTENSIVE WITH THE 173 PATENT CLAIMS.....	1
II. THE 173 PATENT DID NOT SATISFY A LONG-FELT NEED.....	2
III. ANY UNEXPECTED RESULTS HAVE NO NEXUS TO THE 173 PATENT CLAIMS.....	3
IV. ANY INDUSTRY PRAISE HAS NO NEXUS TO THE 173 PATENT CLAIMS	4
V. ANY COMMERCIAL SUCCESS HAS NO NEXUS TO THE 173 PATENT	4
VI. JLI'S EVIDENCE OF COPYING HAS NO NEXUS TO THE 173 PATENT	5

PETITIONERS' EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 10,709,173 to Monsees et al. (“the ’173 patent”)
1002	File History for U.S. Patent 10,709,173
1003	Declaration of William Singhose in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent 10,709,173
1004	Curriculum Vitae of William Singhose
1005	U.S. Patent Publication No. 2015/0128971 (“Verleur”)
1006	U.S. Provisional Application No. 61/903,344 (“Verleur-Prov”)
1007	U.S. Patent Publication No. 2009/0272379 (“Thorens379”)
1008	U.S. Patent Publication No. 2016/0021933 (“Thorens 933”)
1009	<i>JUUL Labs, Inc. v. NJOY, LLC</i> , No. 23-cv-01204 (D. Ariz.) Docket (retrieved Nov. 13, 2023)
1010	U.S. Patent No. 8,205,622 (“Pan 622”)
1011	<i>Reserved</i>
1012	U.S. Patent No. 3,200,819 (“Gilbert”)
1013	U.S. Patent Publication No. 2013/0228191 (“Newton 191”)
1014	U.S. Patent No. 5,388,594 (“Counts 594”)
1015	U.S. Patent Publication No. 2012/0199663 (“Qiu 663”)
1016	International Application No. WO 2013/076098A2 (“Plojoux”)
1017	U.S. Patent No. 8,499,766 (“Newton”)
1018	U.S. Patent No. 9,332,787 (“Liu 787”)
1019	KR200457694 (“Youm”)
1020	Certified Translation of KR200457694 (“Youm”)
1021	KR200453424 (“Yeom”)
1022	Certified Translation of KR200453424 (“Yeom”)
1023	U.S. Patent No. 11,606,981 (“Verleur 981”)

Exhibit No.	Description
1024	U.S. Patent No. 11,134,722 (“Verleur 722”)
1025	U.S. Patent Publication No. 2011/0094523 (“Thorens 523”)
1026	U.S.I.T.C. Investigation No. 337-TA-1368, Joint Claim Construction Chart
1027	Aug. 22, 2006 Tariff Classification Ruling M85579, <i>available at</i> https://rulings.cbp.gov/search?term=m85579
1028	U.S. Patent Publication No. 2014/0174458 (“Katz”)
1029	U.S. Patent No. 5,144,962 (“Counts 962”)
1030	U.S. Patent Publication No. 2013/0037041 (“Worm”)
1031	U.S. Patent No. 9,516,899 (“Plojoux 899”)
1032	Transcript from Deposition of James Monsees in Inv. 337-TA-1368
1033	Transcript from Deposition of Adam Bowen in Inv. 337-TA-1368
1034	JLI-NJOY-ITC1368-01326346
1035	JLI-NJOY-ITC1368-01935328
1036	JLI-NJOY-ITC1368-01935331

The Board should assess secondary considerations after institution on a full evidentiary record. *Umicore AG & Co. KG v. BASF Corp.*, IPR2015-01124, Paper 8, p. 22 (P.T.A.B. Nov. 2, 2015). Nonetheless, JLI’s arguments at this stage fail to overcome the compelling case of obviousness set forth in the Petition.

I. JUUL is Not Co-Extensive with the 173 Patent Claims

For nexus to be presumed, JLI must demonstrate that a specific product: (1) embodies the claimed features; and (2) is co-extensive with the claims. *Polaris Indus., Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1072 (Fed. Cir. 2018). Even if JUUL practices the 173 Patent claims, JLI cannot satisfy the co-extensiveness requirement because JUUL comprises numerous material unclaimed features:

- Nicotine salt formulation, flavors, and high nicotine concentration. Ex. 2027.005 (“[T]he high level of nicotine in Juul’s pods [is]...almost double the concentration in some rival e-liquids....”); Ex.2031.002 (“Juulpods...contain a concentrated juice cocktail of salts and organic acids ... [that] more closely resembles the experience of smoking a cigarette....”); Ex. 2036.002 (“The growing popularity of JUUL seems to be driven by flavored offerings....”).
- Thumb drive shape. Ex. 2027.002 (“Juul says its signature brushed-aluminum, thumb-drive-shaped vape is intended to help adult smokers switch....”).
- Temperature control system. Ex. 2003.011 (“[REDACTED]”).

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.