

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.

Case No. IPR2026-00161
U.S. Patent No. 12,156,533

**PATENT OWNER'S SUR-REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

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EXHIBIT LIST

Exh. No.	Description
2001	Declaration of Thomas H. Wintner in Support of Patent Owner’s Notice of Intent to Designate a Provisionally Recognized PTAB Attorney Under 37 C.F.R. § 42.10(c)(2)
2002	Memorandum from Chief Administrative Patent Judge Boalick regarding Guidance on USPTO’s rescission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” dated March 24, 2025
2003	U.S. Patent No. 9,215,895 to Bowen <i>et al.</i>
2004	Excerpts from File History of U.S. Patent Application No. 14/284,194 to Rabinowitz <i>et al.</i>
2005	Wayne <i>et al.</i> , “Brand differences of free-base nicotine delivery in cigarette smoke: the view of the tobacco industry documents,” <i>Tobacco Control</i> (2006) 15:189-198
2006	Shao <i>et al.</i> , “Nicotine Delivery to Rats via Lung Alveolar Region-Targeted Aerosol Technology Produces Blood Pharmacokinetics Resembling Human Smoking,” <i>Nicotine & Tobacco Research</i> (2013) 15:1248-1258 (advanced publication Dec. 13, 2012)
2007	Excerpts from Post-Trial Brief of Respondents Altria Group, Inc. and JUUL Labs, Inc., <i>In the Matter of Altria Group, Inc. and JUUL Labs, Inc.</i> , Docket No. 9393, U.S. Federal Trade Comm’n (dated August 23, 2021)
2008	Complaint, <i>In the Matter of Certain Vaporizer Devices, Cartridges Used Therewith, and Components Thereof</i> , Inv. 337-TA-1460, Int’l Trade Comm’n (Aug. 8, 2025)
2009	Respondents’ Verified Response to JUUL Labs, Inc.’s Complaint, <i>In the Matter of Certain Vaporizer Devices, Cartridges Used Therewith, and Components Thereof</i> , Inv. 337-TA-1460, Int’l Trade Comm’n (Nov. 20, 2025)
2010	Redline Comparison of Sebastian (US 2014/0000638) ¶¶[0059]-[0061] to Potter (US 2014/0261486) ¶¶[0049]-[0051]
2011	Order No. 18: Construing Claim Term, <i>In the Matter of Certain Vaporizer Devices, Cartridges Used Therewith, and Components Thereof</i> , Inv. 337-TA-1460, Int’l Trade Comm’n (Jan. 22, 2026)

Exh. No.	Description
2012	Order No. 19: Amending Procedural Schedule, <i>In the Matter of Certain Vaporizer Devices, Cartridges Used Therewith, and Components Thereof</i> , Inv. 337-TA-1460, , Int’l Trade Comm’n (Jan. 30, 2026)
2013	Excerpts from Transcript for Markman Hearing and Case Management Conference, <i>In the Matter of Certain Vaporizer Devices, Cartridges Used Therewith, and Components Thereof</i> , Inv. 337-TA-1460, Int’l Trade Comm’n (Jan. 8, 2026)
2014	Defendants’ Response Memorandum to Plaintiff’s Motion to Stay (ECF No. 26), <i>JUUL Labs, Inc. v. NJOY, LLC, et al.</i> , Civ. Action No. 2:25-cv-02853-JJT, D. Az. (Oct. 24, 2025)
2015	Order (ECF No. 33), <i>JUUL Labs, Inc. v. NJOY, LLC, et al.</i> , Civ. Action No. 2:25-cv-02853-JJT, D. Az. (Nov. 20, 2025)
2016	Scheduling Order (ECF No. 36), <i>JUUL Labs, Inc. v. NJOY, LLC, et al.</i> , Civ. Action No. 2:25-cv-02853-JJT, D. Az. (Nov. 25, 2025)
2017	Excerpts from Attachment G, Respondents’ Final Invalidity Contentions, <i>In the Matter of Certain Vaporizer Devices, Cartridges Used Therewith, and Components Thereof</i> , Inv. 337-TA-1460, Int’l Trade Comm’n (Jan. 6, 2026)
2018	U.S. Patent Application No. 2014/0261486 A1 to Potter <i>et al.</i> (publication date Sep. 18, 2014) (“Potter”)
2019	U.S. Patent Application No. 2014/0060554 A1 to Collett <i>et al.</i> (publication date Mar. 6, 2014) (“Collett”)
2020	U.S. Patent Application No. 2014/0253144 A1 to Novak <i>et al.</i> (publication date Sep. 11, 2014) (“Novak”)
2021	U.S. Patent Application No. 2014/0209105 A1 to Sears <i>et al.</i> (publication date July 31, 2014) (“Sears ’105”)
2022	U.S. Patent Application No. 2014/0096781 A1 to Sears <i>et al.</i> (publication date Apr. 10, 2014) (“Sears ’781”)
2023	U.S. Patent Application No. 2014/0261487 A1 to Chapman <i>et al.</i> (publication date Sep. 18, 2014) (“Chapman”)
2024	U.S. Patent Application No. 2014/0270727 A1 to Ampolini <i>et al.</i> (publication date Sep. 18, 2014) (“Ampolini”)
2025	U.S. Patent Application No. 2013/0255702 A1 to Griffith <i>et al.</i> (publication date Oct. 3, 2013) (“Griffith”)

Exh. No.	Description
2026	Redline Comparison of Sebastian (US 2014/0000638) ¶¶[0059]-[0061] to Griffith (US 2013/0255702) ¶¶[0086]-[0088]
2027	EP 3073846 B1 to Rabinowitz <i>et al.</i> (“Rabinowitz EP ’846”)
2028	WO 2014/004648 A1 to Sebastian <i>et al.</i> (publication date Jan. 3, 2014) (“Sebastian PCT”)
2029	Excerpts from File History for EPO Opposition to EP 3073846 B1
2030	Court Profile: International Trade Commission, “Motion Success – ITC Motion to Stay Pending IPR,” Docket Navigator (last accessed Feb. 2, 2026)
2031	WO 2006/004646 A1 to Lechuga-Ballesteros <i>et al.</i> (publication date Jan. 12, 2006) (“Lechuga-Ballesteros PCT”)
2032	Memorandum from USPTO Acting Director Stewart regarding “Interim Processes for PTAB Workload Management”, dated March 26, 2025
2033	Redline Comparison of Petition (Paper 2 at 23-25) to Wensley Decl. (Ex1003 ¶¶ 67-71)
2034	U.S. Patent No. 11,202,470 to Rabinowitz <i>et al.</i> (“Rabinowitz ’470”)
2035	International Trade Commission, “Section 337 Statistics: Average Length of Investigations” (Jan. 27, 2026), <i>available at</i> https://www.usitc.gov/intellectual_property/337_statistics_average_length_investigations.htm
2036	Pankow <i>et al.</i> , “Conversion of Nicotine in Tobacco Smoke to its Volatile and Available Free-Base Form through the Action of Gaseous Ammonia,” <i>Environ. Sci. Technol.</i> (1997) 31:2428-2433

As explained in Patent Owner’s Preliminary Response (Paper 12), the Petition fails for a simple reason: it does not address the required words of Claim 1(b) that limit every challenged claim, as emphasized here:

1. An electronic cigarette comprising a cartridge, wherein the cartridge comprises a nicotine salt liquid formulation, wherein:

(a) the nicotine salt liquid formulation comprises ***a salt*** of nicotine and an organic acid in a liquid carrier, wherein the organic acid is benzoic acid or lactic acid;

(b) ***the salt is present in an amount that forms*** a nicotine concentration of 0.5% (w/w) to 20% (w/w) in the nicotine salt liquid formulation;

[...]

Petitioner’s Reply (Paper 14) confirms this. Notably, while the Reply purports to address “plain meaning,” not once does it recite the ***actual words*** of Claim 1(b), or even, *e.g.*, the words “salt is present,” “in an amount,” or “forms.” The Reply, just like the Petition, does not say where this claim limitation was addressed – because it was not. Accordingly, denial of the Petition is warranted.

Petitioner then offers a non-plain meaning “construction” of Claim 1(b), which appears to be:

(b) ~~the salt is present in an amount that forms~~ *a nicotine concentration of 0.5% (w/w) to 20% (w/w) in the nicotine salt liquid formulation;*

See, e.g., Paper 14, 1 (“[Claim 1(b)] defines the % nicotine that must be present.”).

By striking ***nine words*** from this claim limitation, Petitioner flouts the principle that

“meaning should be given to *all* of a claim’s terms.” *Dell Inc. v. Acceleron, LLC*, 818 F.3d 1293, 1300 (Fed. Cir. 2016) (emphasis added) (rejecting construction that “den[ie]d effect” to “require[d]” claim language); *see also Rovi Guides, Inc. v. Vidal*, No. 2020-1994, 2022 WL 1152311 (Fed. Cir. Apr. 19, 2022), at *2 (“A claim construction that gives meaning to all the terms of the claim is preferred over one that does not do so.”) (quoting *Merck & Co. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1372 (Fed. Cir. 2005)).

Petitioner’s Reply cites no intrinsic evidence in support of its counter-textual “construction.” The Petition therefore fails for lack of proof on Claim 1(b), because it addresses neither (1) the “*amount*” of any “salt” of nicotine and benzoic or lactic acid that is “*present*” in the asserted prior art; nor (2) whether such an “amount” of “salt” is “*an amount that forms*” the nicotine concentration of Claim 1(b).

In a last-minute attempt to remedy this, the Reply relies on a single paragraph of an expert declaration, which discusses a “calculation” that is never mentioned or explained in the Petition. *See* Paper 14, 3. But this is a clear example of an impermissible incorporation by reference. 37 C.F.R. § 42.6(a)(3); *see, e.g., Cisco Sys., Inc. v. C-Cation Techs., LLC*, IPR2014-00454, Paper 12, at 7-10 (PTAB Aug. 29, 2014) (Informative); *Skullcandy, Inc. v. Earin AB*, IPR2025-00690, Paper 14, at 18-19 (PTAB Sep. 15, 2025); *3M Co. v. Westech Aerosol Corp.*, IPR2018-00576, Paper 49, at 7-8 (PTAB Feb. 4, 2020), *aff’d*, 860 F. App’x 724 (Fed. Cir. 2021).

Without the claim language, intrinsic evidence, or anything in the Petition on its side, Petitioner resorts to gripes about what has transpired in “Parallel Proceedings.” But the Parallel Proceedings are not *this* proceeding. PTAB rules do not require any pre-Petition “meet-and-confer” regarding claim construction. Rather, as is usually the case, Patent Owner had no notice of the Petition before it was filed and served. What Petitioner said in the Petition – on claim construction or any other matter – was fully within Petitioner’s control. In fact, it was Petitioner’s obligation to address “[h]ow the challenged claim is to be construed” in the Petition. 37 C.F.R. § 42.104(b)(3).

Simply put, Petitioner chose to (1) apply a non-plain meaning construction of Claim 1(b) that strikes nine words from the claims, without explanation in law or intrinsic evidence, and (2) hide the ball from the Director, Board and Patent Owner by purporting to use “ordinary meaning” throughout the Petition (Paper 2, 5). Petitioner cannot blame Patent Owner or any “Parallel Proceedings” for that choice. If anything, Petitioner’s attempt to leverage what it says are overlapping issues in Parallel Proceedings weighs further in favor of denial.

Finally, Petitioner’s contradictory representations to the USPTO and EPO, regarding the same or similar prior art (Paper 14, 3 n.2, citing Paper 12), speak for themselves. Once again, Petitioner is trying to blame Patent Owner for Petitioner’s own choices and actions. The Petition should be denied.

Respectfully submitted,

Dated: March 31, 2026

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CERTIFICATE OF SERVICE

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