

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NJOY, LLC and NJOY HOLDINGS, INC.,

Petitioners,

v.

JUUL LABS, INC.

Patent Owner.

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

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]

Exh. No.	Description
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)
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”)

Exh. No.	Description
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”)
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

I. Introduction

Patent Owner Juul Labs, Inc. (“JLI”) respectfully requests denial of the instant Petition because each asserted Ground fails to establish the required likelihood of success. Either of the bases outlined below is sufficient to justify denial.

Failure to address claim limitation: Claim limitation 1(b) of the challenged patent requires a “*nicotine salt* liquid formulation” wherein: “*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.” In the two grounds arguing for invalidity of this claim limitation (which is part of the sole challenged independent claim), the Petition does not once mention “nicotine salt,” or even “salt,” nor does the Petition attempt to show whether or why such salt is “present” in any “amount” in the prior art. Petitioner’s cited expert does not do so either. The Petition thus fails to address a core claim limitation, and institution should be denied based on this simple failure of proof.

Contradictory statements in prior proceedings regarding patentability:

The Petition rests on characterizations of two pieces of prior art – “Sebastian” and “Lechuga-Ballesteros” – that are directly contradicted by Petitioner’s past statements and representations made while Petitioner was trying to obtain its own U.S. and EP patents directed to similar subject matter. In these prior proceedings, Petitioner attempted to refute the teachings of these references in order to distinguish

them over Petitioner’s claims directed to nicotine and lactic acid in liquid formulations for electronic cigarettes. Now that the shoe is on the other foot, however, Petitioner seeks to *rely* on the very same disclosures in Sebastian and Lechuga-Ballesteros that it previously sought to distinguish. Petitioner cannot have it both ways: its prior statements made in prior proceedings are fatal to institution over the same art here.

Accordingly, and as articulated further below, institution of the Petition should be denied.

II. Background

A. The Challenged ’533 Patent

The ’533 patent was issued to JLI on December 3, 2024. Titled “Nicotine Salt Formulations for Aerosol Devices and Methods Thereof,” the ’533 patent names Adam Bowen and Chenyue Xing as co-inventors. In general, the specification of the ’533 patent describes nicotine salt liquid formulations of nicotine and organic acids for generating an inhalable aerosol in an electronic cigarette, comprising an amount of nicotine salt that forms certain concentrations of nicotine (*e.g.*, about 0.5% w/w to about 20% w/w nicotine). *See* Ex1001 at Abstract.

The ’533 patent reflects a major advance in the art of electronic cigarettes – and in particular, the liquid formulations (“e-liquids”) used therein – by providing “nicotine salt” liquid formulations of nicotine and organic acids (specifically,

benzoic acid or lactic acid) in a liquid carrier (specifically, propylene glycol and glycerol). These nicotine salts overcame the deficiencies of free-base nicotine when used in liquid formulations for generating an inhalable aerosol by heating in an electronic cigarette.

As of the patent's priority date in 2013, the conventional wisdom was that nicotine "free base" – i.e., *un*protonated nicotine that is *not* in salt form – was critical to providing sufficiently satisfactory nicotine delivery, including from electronic cigarette devices that use heating to vaporize volatile liquids to produce inhalable aerosols. *See* Ex1001 at 7:52-9:16. Patent Owner surprisingly discovered that nicotine *salts* of organic acids (including benzoic acid or lactic acid as claimed in the '533 patent), when used in a liquid carrier to generate an inhalable aerosol upon heating in an electronic cigarette, provided pharmacodynamic (*e.g.*, heart rate) and pharmacokinetic (*e.g.*, T_{\max}) effects comparable to combustion cigarettes – resulting in satisfaction of cravings comparable to combustion cigarettes. *Id.*; *see also id.* at 21:63-28:11 (Examples 2-8).

Altria Group, Inc., Petitioner's parent company and real-party-in-interest ("Altria"), has acknowledged the value of Patent Owner's counterintuitive discovery in proceedings before the U.S. Federal Trade Commission ("FTC"), in which Altria stated:

[T]he use of nicotine salts[] allowed [Patent Owner's] JUUL to crack the code on providing smokers the satisfaction necessary to replicate the nicotine experience provided by cigarettes.... *[T]he “key” to JUUL’s success was “its inclusion of nicotine salts” (the product of nicotine mixed with an organic acid) [N]icotine salts are essential to the delivery of nicotine satisfaction.*

Ex2007 at 14-15 (emphasis added).

Claim 1 of the '533 Patent is the only asserted independent claim, and is reproduced in full below:

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;

(c) the liquid carrier comprises glycerol and propylene glycol;

(d) and the nicotine salt liquid formulation generates an inhalable aerosol upon heating in the electronic cigarette.

Ex1001 at 60:39-51. All of the challenged claims depend from this claim.

B. The Asserted Prior Art

Petitioner asserts two grounds of invalidity: Ground 1 asserts anticipation of claims 1-8 and 10 over Sebastian (Ex1003); and Ground 2 asserts obviousness of

claims 1-10 over Sebastian in view of Lechuga-Ballesteros (Ex1005). *See* Petition at 4.

During prosecution of the '533 patent, the Examiner initially issued rejections over both Sebastian and Lechuga-Ballesteros (including in combination, as in Petitioner's Ground 2), and ultimately found the '533 patent claims patentable over those references and the other prior art. *See, e.g.*, Ex1002 at 283-290, 314, 382-384, 401, 523. For example, contrary to Petitioner's positions here, the Examiner agreed that (1) Lechuga-Ballesteros does *not* teach or suggest a nicotine salt liquid formulation in a liquid carrier comprising glycerol and propylene glycol for generating an inhalable aerosol upon heating in an electronic cigarette; and (2) a POSA "looking to improve the formulation of Sebastian for use in an electronic smoking article would *not* look to the formulation described in Lechuga-Ballesteros et al which has been optimized for delivery via a pressurized metered dosed inhaler." Ex1002 at 314, 401.

III. Argument

A. The Petition should be denied because each asserted Ground fails to address claim limitation 1(b).

All of the challenged claims depend from claim 1 of the '533 patent. After the preamble, this claim has four claim limitations, with the second one, claim 1(b), reiterated below:

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

(a) [...];

(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;

(c) [...];

(d) and [...].

Ex1001 at 60:39-51 (emphasis added). NJOY commits to the plain and ordinary meanings of all claim terms addressed in its Petition. *See* Petition at 5. (“Here, Petitioner identifies no terms requiring construction. Instead, Petitioner applies the ordinary meaning ascribed to the words of the claims in view of the intrinsic evidence.”).

Claim 1(b) requires a “*nicotine salt* liquid formulation” wherein: “*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.” Since NJOY committed itself to plain and ordinary meaning in the Petition, it needs to address the plain and ordinary words

in each claim element when discussing the prior art and asserted Grounds. That includes at least the words “salt” (or “nicotine salt”) and “amount” for claim 1(b).¹

In addressing claim 1(b) for Ground 1 (anticipation over Sebastian), however, the Petition never once mentions the word “nicotine salt,” let alone “salt.” *See* Petition at 38-39. Similarly, the claim 1(b) argument in the Petition is silent in addressing the “amount” in which the “salt” is “present.” *Id.* As for Ground 2 (obviousness over Sebastian in view of Lechuga-Ballesteros), when addressing claim 1(b) NJOY again never once mentions the word “nicotine salt,” let alone “salt,” let alone the “amount” in which the salt is “present” in either piece of prior art. *See id.* at 67-68.

And it is not just the Petition that is deficient with respect to this claim limitation. In the sections addressing claim 1(b), the Petition cites to no expert testimony other than that of Martin Wensley (Ex1003). *See* Petition at 38-39 (Ground 1), 67-68 (Ground 2). Yet other than simply repeating the entire claim limitation, Martin Wensley does not analyze the word “salt” or “nicotine salt” or “amount” in his declaration in support of Grounds 1 or 2 of the Petition, nor does he

¹ A “salt” is a distinct chemical entity, as described by Petitioner’s expert, Dr. Byrn. *See* Ex1009, ¶ 19 (“[W]hen an acid and base react, a compound—specifically, a salt—forms.”).

analyze where any of these words are found in the prior art. *See* Ex1003, ¶¶ 93-95 (Ground 1); *id.* ¶¶ 161-162 (Ground 2). He, too, simply ignores the plain language of the claim limitation.

Because NJOY has not proposed a construction for claim 1(b) that would allow it to read out the plain words of the claim (including the words “nicotine salt” and “salt” – not to mention “salt is *present in an amount*”), NJOY has failed to properly compare the allegedly invalidating disclosures in the prior art to the claim limitation. And because NJOY has failed to address a claim limitation that is required for all of its grounds in the Petition, institution must be denied. *See e.g., Samsung Electronics America, Inc. et al. v. Collision Communications, Inc.*, IPR2024-01248, Paper No. 11, at 27 (PTAB Mar. 21, 2025) (denying institution because the Petition “fails to (1) acknowledge that limitation 1b recites the term “requiring” and (2) identify where or how Baum teaches such a requirement”); *id.* (“Petitioner does not even attempt to explain how Baum meets the “requiring” recitation of limitation 1b. Thus, on the present record, we find the Petition deficient for failing to address the full scope of limitation 1b.”); *see also Supercell Oy v. Gree, Inc.*, IPR2019-00754, Paper No. 12, at 21-22 (PTAB Aug. 12, 2019) (denying institution because “Petitioner ignores claim language requiring that the actions of subtracting and adding/restoring occur ‘sequentially’”); *id.* at 22 (“Neither the Petition, nor the cited portions of the Friedman Declaration, make any effort to

explain how Petitioner’s contentions regarding adding/restoring are consistent with the sequential aspect of this limitation . . .”).

In sum, NJOY’s proofs fail at the most fundamental level because the Petition does not address the plain and ordinary claim language in limitation 1(b) of claim 1. The Petition should be denied for this reason alone.

B. The Petition should be denied because it is fundamentally at odds with Petitioner’s own statements made in prosecuting Petitioner’s own patents in the same technology space.

The Petition rests on characterizations of the alleged prior art – including Sebastian and Lechuga-Ballesteros – that are directly contradicted by Petitioner’s past statements and representations made while Petitioner was advocating to obtain its own U.S. and European (EP) patents purporting to claim liquid formulations of nicotine and lactic acid for generating inhalable aerosols upon heating in electronic cigarettes. *See, e.g.*, U.S. Patent No. 11,202,470 to Rabinowitz *et al.* (“Rabinowitz ’470”) (Ex2034) at claim 1; Rabinowitz EP ’846 (Ex2027) at claims 1, 5. Petitioner cannot rely on one argument when advocating for the patentability of its own nicotine salt patents, but then argue the opposite when challenging the ’533 patent. *See, e.g., Interactive Commc’ns Int’l, Inc. v. Blackhawk Network Inc.*, IPR2024-00465, Paper No. 40 at 3-4 (Dir. Oct. 9, 2025) (de-instituting IPR based on self-contradictory expert testimony).

Petitioner has known of the Sebastian and Lechuga-Ballesteros references for a long time, as shown by Petitioner's prosecution of the Rabinowitz '470 and Rabinowitz EP '846 patents (both of which stem from disclosures filed *after* the '533 patent at issue here). For example, both Sebastian and Lechuga-Ballesteros were cited as early as 2017 during the prosecution of the Rabinowitz '470 patent. Ex2004 at 13 (IDS citing Lechuga-Ballesteros); *id.* at 23 (Office Action issuing § 102 rejection over Sebastian). Further, during the Opposition to Petitioner's EP '846 patent, Petitioner extensively discussed both the Sebastian PCT (Ex2028, "D5") and Lechuga-Ballesteros PCT No. WO 2006/004646 (Ex2031, "D3"). *See* Ex2029 at 40, 57-59, 69-70, 113-115; *see also* Ex2026. When defending its own applications in the USPTO and EPO, Petitioner presented interpretations of Sebastian and Lechuga-Ballesteros that are entirely different from and indeed directly contradict the positions Petitioner takes now in its Petition to challenge the '533 patent.

1. Petitioner contradicts itself with respect to alleged import of the "lactic acid" disclosures in Sebastian.

The Petition contends that Sebastian inherently discloses a "nicotine lactate" salt formed by an "equimolar" (i.e., "1:1" molar ratio) of nicotine and lactic acid. *See* Petition at 2, 26-29, 37, 60, 65. But during the prosecution of its own Rabinowitz '470 patent, Petitioner repeatedly said the opposite – arguing that *Sebastian does not teach an "equimolar" ratio of lactic acid to nicotine.*

For example, as of February 2019, Petitioner’s pending claims recited, *inter alia*, a liquid composition of nicotine, lactic acid, and solvent, in an acid-to-nicotine ratio from “about 2:3 to about 1:1.” Ex2004 at 36 (February 21, 2019 Response to Office Action). To overcome the Examiner’s rejection over Sebastian, Petitioner argued that “Sebastian does **not** teach that the amount of lactic acid **alone** can range . . . up to an equimolar concentration.” *Id.* at 46 (emphasis in original). To further rebut the Examiner’s rejections based on Sebastian, Petitioner presented a sworn expert declaration from Walton Sumner II, M.D., regarding whether a POSA would have agreed with the Examiner’s characterization of Sebastian ¶[0059]. Ex2004 at 65-68 (Sumner Decl. ¶¶ 10-16); *id.* at 98-102 (October 15, 2019 Response to Office Action). Dr. Sumner opined that:

- “Sebastian **would not be understood by the [POSA]** as teaching that lactic acid may be present in a 1:1 molar ratio with nicotine”; and
- “**There is little or no chance** that a [POSA] would understand from Sebastian that any one or more **organic acids in any concentration** would favorably affect nicotine partitioning, deposition, or absorption.”

Id. at 66-68 (Sumner Decl. ¶¶ 11, 15-16) (emphasis added). Petitioner thereafter consistently relied upon Dr. Sumner’s Declaration, up through allowance of the now-issued claims, to argue that *Sebastian did not disclose an equimolar ratio* of

nicotine and lactic acid. *See, e.g., id.* at 123-127 (May 12, 2020 Response to Office Action); *id.* at 149-150 (June 16, 2021 Response to Office Action).

Moreover, in the EPO Opposition to Petitioner's Rabinowitz EP '846 patent (Ex2027), the Opponent argued that Griffith ¶¶[0086]-[0088] (Ex2025, "D8"), and the mirror-image language in Sebastian PCT pp. 27-28 (Ex2028, "D5"), rendered the Rabinowitz EP '846 claims not novel and obvious. *See, e.g.,* Ex2029 at 22, 31-32. In response, Petitioner admitted that Griffith ¶¶[0086]-[0088] (nearly identical to Sebastian ¶¶[0059]-[0061] asserted in the Petition) does not recite *any* liquid compositions with specific concentration ranges of nicotine in combination with lactic acid, propylene glycol, and glycerol:

[P]aragraph [0086] does not disclose that solely lactic acid may be used as an ion paring agent in [Griffith]. Notwithstanding this, *the singling out of lactic acid from paragraph [0086] may not be combined with the specific composition described in paragraph [0088].*

[...]

There is *nothing in [Griffith] that suggests* that one organic acid should be used or that *lactic acid should be the flavour* specified in the specific embodiment in paragraph [0088].

[...]

There is no clear or unmistakable disclosure in [Griffith] of a composition as claimed in the patent. In particular, there is *nothing in [Griffith] to suggest that lactic acid should be singled out* as a

flavouring agent or that this singling out should be *combined with the specific aerosol precursor composition described in paragraph [0088]*. Furthermore, the cited passages of [Griffith] do not even mention a composition with a pH range....

Ex2029 at 58-59 (emphasis added).

Thereafter, the EPO Opposition Division *agreed* with Petitioner that neither Sebastian nor Griffith anticipated the EP '846 claims directed to liquid formulations of nicotine and lactic acid in a liquid carrier. *Id.* at 90. Specifically, the Opposition Division acknowledged that: (1) Griffith and Sebastian “have very similar disclosures,” (2) “lactic acid is *not* directly and unambiguously disclosed in combination with the composition recited in [Sebastian PCT] p.28” (*i.e.*, Sebastian (Ex1004) ¶[0061]; Griffith (Ex2025) ¶[0088]), and (3) Petitioner’s claim reciting compositions of nicotine, lactic acid, and solvent (*e.g.*, glycerol and propylene glycol) is novel over the Sebastian PCT and Griffith. Ex2029 at 90 (emphasis added). Petitioner’s arguments advanced to and accepted by the EPO regarding Sebastian and Griffith are the opposite of what Petitioner now says in attempting to allege inherent anticipation over Sebastian in this proceeding. *Compare* Petition at 15, 24, 26-30, 35, 37-38, 40, 43-46.

In sum, Petitioner directly contradicts its own past positions regarding its own Rabinowitz patents taken before both the USPTO and EPO, and then hides those

inconvenient facts from the PTAB in this proceeding, rather than being forthcoming about them. Accordingly, the Petition should be denied.

2. Petitioner contradicts itself with respect to alleged significance of “metered dose inhaler” art like that in Lechuga-Ballesteros.

Ground 2 of the Petition asserts obviousness over the combination of Sebastian and Lechuga-Ballesteros, even though Lechuga-Ballesteros concerns an entirely different category of device: pressurized “metered dose inhalers” (“MDIs”). MDIs disperse aerosol particles using a propellant, as opposed to electronic cigarettes that generate aerosol by heating and vaporizing an e-liquid. *See, e.g.*, Petition at 3, 40-41, 46, 56, 59. However, when Petitioner was defending its own Rabinowitz EP ’846 patent (Ex2027) during an EPO Opposition proceeding, Petitioner took positions regarding the relevance of Lechuga-Ballesteros and MDI art that are the opposite of the arguments it now advances in this Petition.

Petitioner asserted in the EPO that the Lechuga-Ballesteros PCT (Ex2031, labeled “D3”) is “in a different technical field” than a “non-metered device” that draws vapor by the user’s “negative pressure,” and that “the skilled person would not consider [Lechuga-Ballesteros] to be relevant prior art to vaping.” Ex2029 at 64, 67-68, 73. Petitioner further told the EPO Opposition Division that:

- “There is *nothing in [Lechuga-Ballesteros] to suggest removing the essential propellant or to switch the MDI for a non-metered device*”;
- “The vaporizing devices of [the Rabinowitz EP ’846] patent are *not MDIs* and the compositions of the patent *do not require the use of a propellant* to form an aerosolizable composition”;
- “Thus, [Lechuga-Ballesteros] is in a *different technical field* to [the Rabinowitz EP ’846] patent,” and “is *not related to the same purpose or effect* as the invention claimed in the patent”; and
- “[T]he skilled person *would not consider that [Lechuga-Ballesteros] is a relevant piece of prior art*, let alone a good starting point.”

Id. at 114-115 (emphasis added). Moreover, while specifically arguing against combining Lechuga-Ballesteros with the Sebastian PCT (Ex2028, labeled “D5”), Petitioner told the Opposition Division that (1) “[Lechuga-Ballesteros] refers to compositions for use in [MDIs],” (2) “[Sebastian] is not directed towards MDIs, and does not require the use of a propellant,” and (3) [t]herefore, *the skilled person would not consider combining [Sebastian] with [Lechuga-Ballesteros]*.” *Id.* at 70.

The Petition makes no attempt to explain why Petitioner now directly contradicts its own past positions before the EPO, and moreover, has failed to apprise the Director and PTAB of those arguments made during the Rabinowitz EP

'846 Opposition in which Petitioner previously asserted these contradictory positions. Petitioner's own prior statements necessitate denial of institution.

3. Petitioner contradicts itself with respect to secondary considerations of non-obviousness.

The Petition directly contradicts the past statements of Altria (Petitioner's real party-in-interest) regarding the state of the art, which Altria made before the FTC while defending its 2018 investment of "\$12.8 billion to acquire 35 percent of [Patent Owner], the maker of JUUL, a leading e-vapor product." Ex2007 at 6. For example, Altria told the FTC how it failed for years to appreciate that Patent Owner's innovative nicotine salt liquid formulations, such as those claimed in the '533 patent, were the "key" for e-cigarettes to "provid[e] smokers the satisfaction necessary to replicate the nicotine experience provided by cigarettes." *See, e.g.*, Ex2007 at 7, 14-15. Now, Petitioner argues that "using nicotine salts" in electronic cigarettes was far from new and that their superior properties had been known for decades. *Compare* Petition at 1-2. In other words, the Petition misleadingly ignores important objective evidence – from a real-party-in-interest, no less – pointing towards the nonobviousness of the inventions claimed in the '533 patent. *See, e.g., LEO Pharm. Prods., Ltd. v. Rea*, 726 F.3d 1346, 1358 (Fed. Cir. 2013) ("Objective indicia can be the most probative evidence of nonobviousness in the record, and enables the court to avert the trap of hindsight.").

Once again, Petitioner cannot have it both ways. It cannot say in a prior proceeding that the “nicotine salts” embodied by the ’533 patent were the “key” to a successful e-cigarette product that solved a problem that had vexed the industry for over a decade, and then turn around and say in this proceeding that “nicotine salts” were neither novel nor non-obvious. The Petition should be denied.

IV. Conclusion

The Petition should be denied because each asserted Ground fails to establish the required likelihood of success.

Respectfully submitted,

Dated: March 4, 2026

/s/ Peter J. Cuomo

Peter J. Cuomo (Reg. #58,481)
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CERTIFICATION UNDER 37 CFR § 42.24

Under the provisions of 37 CFR § 42.24(d), the undersigned hereby certifies that the word count for the foregoing Petition for *Inter Partes* Review totals 3,479 words, which is less than the 14,000 allowed under 37 CFR § 42.24.

Dated: March 4, 2026

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