

**CONTAINS CONFIDENTIAL BUSINESS INFORMATION
SUBJECT TO PROTECTIVE ORDER**

**UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C.**

**Before the Honorable Clark S. Cheney
Administrative Law Judge**

In the Matter of

**CERTAIN TOBACCO HEATING
ARTICLES AND COMPONENTS
THEREOF**

Investigation No. 337-TA-1199

**RESPONDENTS' JOINT DISCLOSURE OF FINAL CONTENTIONS IN RESPONSE
TO INDIVIDUAL INTERROGATORY NO. 12**

I. INTRODUCTION

Respondents Altria Client Services LLC, Altria Group, Inc., Philip Morris USA Inc., Philip Morris International Inc., and Philip Morris Products S.A. (collectively, "Respondents") provide the following final contentions in response to Individual Interrogatory No. 12.

Complainants assert claims from U.S. Patent No. 9,839,238 ("the '238 patent"); U.S. Patent No. 9,930,915 ("the '915 patent"); and U.S. Patent No. 9,901,123 ("the '123 patent") (collectively, "the Asserted Patents"). In particular, Complainants allege that Respondents infringe claim 19 of the '238 patent; claims 1, 2, 3, and 5 of the '915 patent; and claims 27-30 of the '123 patent (collectively, "the Asserted Claims"). Complainants also contend that their Domestic Industry Products practice claims 1-3, 5-11, 13, 15-16, 18-21 of the '238 patent; claims 1-4 of the '915 patent; and claims 1-7, 9, 11-19, 21, 23-26 of the '123 patent (collectively, "the Domestic Industry Claims"). Respondents' final contentions address the Asserted Claims and the Domestic Industry Claims of the Asserted Patents.

**RAI Strategic Holdings, Inc.
Exhibit 2005
Philip Morris Products, S.A. v. RAI Strategic Holdings, Inc.
IPR2020-01602**

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contend that the VUSE Vibe practices the Domestic Industry Claims of the '123 patent. Consequently, under Complainants' own contention, the VUSE Vibe anticipates those claims.

4. 35 U.S.C. §§ 102, 103 (pre-AIA and AIA)

a. Anticipation & Obviousness

Prior art references and systems that anticipate and/or render obvious the Asserted and Domestic Industry Claims of the '123 patent are identified above and in accompanying exhibits, which, as noted, are incorporated by reference as if fully set forth herein. The exhibits provided identify how the prior art discloses and/or renders obvious each and every element of the Asserted and/or Domestic Industry Claims of the '123 patent, and discloses and/or renders obvious those claims as a whole. To the extent an element or claim is not anticipated, the claim is rendered obvious by combination with one or more other prior art references identified, including as mapped in the accompanying exhibits.

Furthermore, to the extent a finder of fact determines that a limitation of any of the Asserted and/or Domestic Industry Claims of the '123 patent is not disclosed by one of the references, products, and/or systems identified above, the claims are nevertheless unpatentable as obvious because they contain nothing that constitutes patentable innovation. No asserted claim goes beyond combining familiar elements according to known methods to achieve predictable results, or does more than choose between clear alternatives known to those of ordinary skill in the art.

The Asserted and/or Domestic Industry Claims would have been obvious to a POSA over at least the following combinations:

- The Accord in combination with the Bullet Heater, Hajaligol, Adams, Morgan, and/or Park
- Ruyan e-Cigar alone or in combination with Hon '043, Whittemore, Tiffany, Susa, Mays, Gori, Ray, Hon '955, Takeuchi, Tamaoki, Sensabaugh, and/or Jakob
- Ruyan e-Cigarette alone or in combination with Hon '957, Hon '043, Whittemore, Tiffany, Susa, Mays, Gori, Ray, Hon '955, Takeuchi, Tamaoki, Sensabaugh, and/or

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Jakob

- Hajaligol alone or in combination with the Bullet Heater, Adams, and/or Brooks
- Morgan alone or in combination with the Bullet Heater
- Hon '043 alone or in combination with Whittemore, Tiffany, Susa, Mays, Gori, Ray, Hon '955, Takeuchi, Tamaoki, Sensabaugh, and/or Jakob
- Yang alone or in combination with Hon '043, Whittemore, Tiffany, Susa, Mays, Gori, Ray, Hon '955, Takeuchi, Tamaoki, Sensabaugh, and/or Jakob
- Hon '957 alone or in combination with Hon '043, Whittemore, Tiffany, Susa, Mays, Gori, Ray, Hon '955, Takeuchi, Tamaoki, Sensabaugh, and/or Jakob

Reasons a person of ordinary skill in the art would have known and been motivated to make these and other combinations are discussed more immediately below, in Section IV.C.4.b.

With respect to claim 27, Complainants appear to contend that the prior art does not disclose “the elongated portion of the resistance heating element positioned proximal to the center of the outer housing.” Instead, Complainants allege the prior art heating elements are “away” from the center, not “at or near” the center as they interpret the claim limitation to require. However, Complainants provide no criteria for drawing this distinction, and provide no explanation for how they interpret the scope of this claim. The '123 patent also provides no guidance whatsoever to determine whether the elongated portion of the heater is “proximal” to the center of the outer housing. As named co-inventor Billy Conner testified, Complainants appear to simply “eyeball[] it.” Conner Dep. Tr. at 110:1-117:1. To the extent Complainants’ criteria provides reasonable certainty as to the scope of this claim, Respondents’ prior art meets this limitation.

With respect to claims 1 and 15, Complainants appear to contend that the “carrier device is operatively positioned such that ... the mixture ... can be wicked into contact with the electrical resistance heater” requires direct contact between the tobacco extract and aerosol-forming material mixture and the electrical resistance heater. However, claims 14, 24, and 25 recite that the wicking material may be *in proximity to* the heater or *in contact with* the heater. Because claims 14, 24,

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and 25 depend from claims 1 and 15 (respectively), a person of ordinary skill reading the claims would understand that the fibrous/wicking material in claims 1 and 15 may be positioned “in proximity to” the heater or it may be “in contact with” the heater. Claims 1 and 15 also require the fibrous/wicking material to “wick[]” the mixture “into contact with the heater.” This is true even if the fibrous/wicking material itself is “in proximity to,” and thus not “in contact with,” the heater. Thus, a POSA reading the claims would understand that “wick[ing]” the mixture “into contact with the heater” may be performed even if the wick does not contact the heater, but is merely “in proximity to” the heater.

b. Teaching, Suggestion, or Motivation to Combine References

Respondents contend that no specific motivation to combine the references identified above is necessary for references identified in these contentions to render the Asserted and Domestic Industry Claims invalid. Nevertheless, Respondents identify exemplary (and not exhaustive) motivations and reasons to combine the cited art.

First, a person of ordinary skill in the art would have been motivated to combine one or more of the references identified above because they all relate to common objectives and subject matter. The references share commonalities in terms of their general subject matter, as well as the types of equipment, products, and/or approaches they describe. Moreover, a person of ordinary skill would have been motivated to combine the references based on the nature of the problem to be solved, the teachings of the prior art, and their own knowledge. The identified prior art addresses the same or similar technical issues and suggests the same or similar solutions to those issues. To the extent Complainants challenge a combination of prior art with respect to a particular element, Respondents may supplement these contentions to further specify a motivation to combine. In doing so, Respondents may rely on cited or uncited portions of the prior art, other

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- “the elongated portion of the resistance heating element positioned proximal to the center of the outer housing”

'123 patent, cl. 27. A person of ordinary skill would not understand with reasonable certainty the scope of this claim limitation, in particular when an elongated portion of a resistance heating element is, or is not, positioned “proximal” to the center of the smoking device’s outer housing. For example, '123 patent co-inventor Billy Conner, Reynolds’ Director of Carbon Tipped Heated Products, confirmed that in order to determine if an elongated portion of a resistance heating element is position at, near, or away from the center of the outer housing he would “eyeball[] it.” Conner Dep. Tr., Exs. 10-11 (and surrounding testimony). Thus, the criteria for choosing whether the elongated portion of the resistance heating element is “proximal” to the center of the outer housing is “highly subjective.” *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1371 (Fed. Cir. 2014). Therefore, the term “might mean several different things and ‘no informed and confident choice is available among the contending definitions.” *Id.* (quoting *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 911, 134 S. Ct. 2120, 2130 (2014).)

Respondents reserve the right to supplement their final contentions through expert discovery.

Dated: September 18, 2020

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