

**UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
ALEXANDRIA DIVISION**

RAI STRATEGIC HOLDINGS, INC. and
R.J. REYNOLDS VAPOR COMPANY,

Plaintiffs and Counterclaim
Defendants,

v.

ALTRIA CLIENT SERVICES LLC; PHILIP
MORRIS USA INC.; and PHILIP MORRIS
PRODUCTS S.A.

Defendants and Counterclaim
Plaintiffs.

Civil Action No. 1:20-cv-393-LO-TCB

**JOINT SUBMISSION IDENTIFYING CLAIMS AND PRIOR ART COMBINATIONS
TO BE PRESENTED AT TRIAL**

Pursuant to the Court’s March 21 order (Dkt. 1157), Plaintiffs Altria Client Services LLC, Philip Morris USA Inc., and Philip Morris Products S.A. (collectively, “Plaintiffs”) and Defendants RAI Strategic Holdings, Inc. and R.J. Reynolds Vapor Company (collectively “Reynolds”) submit their identification of claims and prior art combinations to be presented at trial, as follows:

United States Patent Number 6,803,545: Claims 1, 4.

United States Patent Number 10,555,556: Claim 4.

United States Patent Number 9,814,265: Claims 1, 4, 17.

Reynolds may present evidence that claims 1, 4, and 17 are invalid in view of Alarcon and Rabin. Reynolds also may present evidence that claims 1 and 17 are invalid in view of Alarcon and Harwig, and claim 4 is invalid in further view of Rabin.

United States Patent Number 10,104,911: Claims 2, 11, 12.

Reynolds may present evidence that claims 2, 11, and 12 are invalid in view of Xia, Shizumu, and/or the knowledge of a POSITA with Claim 2 invalid in further view of Murphy or Egilmex. Reynolds may also present evidence that claims 2, 11, and 12 are invalid in view of Cho, Shizumu, and/or the knowledge of a POSITA with claim 12 invalid in further view of Xia and claim 2 invalid in further view of Murphy or Egilmex. Reynolds may also present evidence that claims 2, 11, and 12 are invalid in view of Han, Shizumu, and/or the knowledge of a POSITA, with claim 12 invalid in further view of Xia and claim 2 invalid in further view of Murphy or Egilmex.

United States Patent Number 10,420,374: Claims 3, 4, 5, 8, 10, 16, 18, 20, 24, 25.

Reynolds may present evidence that claims 3, 4, 5, 8, 10, 16, 18, 20, 24, and 25 are invalid in view of Reynolds's sale of the accused Solo product prior to the effective filing date of the '374 patent as alleged by Reynolds. Reynolds may also present evidence that claims 3, 4, 5, 8, and 10 are invalid in view of Liao, McLaughlin, and Liu, and claims 16, 18, 20, 24, and 25 are invalid in view of Liao, McLaughlin, and Gourlay. If the Court rules before trial that Reynolds may not present Liao as prior art, Reynolds may instead present evidence that claims 3, 4, 5, 8, and 10 are invalid in view of Pan, McLaughlin, and Liu, and claims 16, 18, 20, 24, and 25 are invalid in view of Pan, McLaughlin, and Gourlay.

Dated: April 20, 2022

Respectfully submitted,

/s/ David M. Maiorana

David M. Maiorana (VA Bar No. 42334)
Ryan B. McCrum
JONES DAY
901 Lakeside Avenue
Cleveland, OH 44114
Telephone: (216) 586-3939
Facsimile: (216) 579-0212
Email: dmaiorana@jonesday.com
Email: rbmccrum@jonesday.com

John J. Normile
JONES DAY
250 Vesey Street
New York, NY 10281
Tel: (212) 326-3939
Fax: (212) 755-7306
Email: jjnormile@jonesday.com

Alexis A. Smith
JONES DAY
555 South Flower Street
Fiftieth Floor
Los Angeles, CA 90071
Telephone: (213) 243-2653
Facsimile: (213) 243-2539
Email: asmith@jonesday.com

Stephanie E. Parker
JONES DAY
1221 Peachtree Street, N.E.
Suite 400
Atlanta, GA 30361
Telephone: (404) 521-3939
Facsimile: (404) 581-8330
Email: separker@jonesday.com

Anthony M. Insigna
JONES DAY
4655 Executive Drive
Suite 1500
San Diego, CA 92121
Telephone: (858) 314-1200

/s/ Maximilian A. Grant

Maximilian A. Grant (VSB No. 91792)
max.grant@lw.com
Matthew J. Moore (*pro hac vice*)
matthew.moore@lw.com
LATHAM & WATKINS LLP
555 Eleventh Street, N.W., Suite 1000
Washington, DC 20004
Telephone: (202) 637-2200
Facsimile: (202) 637-2201

Clement J. Naples (*pro hac vice*)
clement.naples@lw.com
LATHAM & WATKINS LLP
885 Third Avenue
New York, NY 10022-4834
Tel: (212) 906-1200; Fax: (212) 751-4864

Gregory J. Sobolski (*pro hac vice*)
greg.sobolski@lw.com
LATHAM & WATKINS LLP
505 Montgomery Street, Suite 2000
San Francisco, CA 94111
Telephone: (415) 391-0600
Facsimile: (415) 395-8095

Brenda L. Danek (*pro hac vice*)
brenda.danek@lw.com
LATHAM & WATKINS LLP
330 North Wabash Avenue, Suite 2800
Chicago, IL 60611
Tel: (312) 876-7700; Fax: (312) 993-9767

*Counsel for Defendants-Counterclaim Plaintiffs
Altria Client Services LLC, Philip Morris USA
Inc., and Philip Morris Products S.A.*

/s/ Elizabeth Stotland Weiswasser

W. Sutton Ansley (VSB No. 80085)
sutton.ansley@weil.com
Robert T. Vlasis III (*pro hac vice*)
robert.vlasis@weil.com
Stephanie Adamakos (*pro hac vice*)

Facsimile: (844) 345-3178
Email: aminsogna@jonesday.com

William E. Devitt
JONES DAY
77 West Wacker
Suite 3500
Chicago, IL 60601
Telephone: (312) 269-4240
Facsimile: (312) 782-8585
Email: wdevitt@jonesday.com

Sanjiv P. Laud
JONES DAY
90 South Seventh Street
Suite 4950
Minneapolis, MN 55402
Telephone: (612) 217-8800
Facsimile: (844) 345-3178
Email: slaud@jonesday.com

Charles B. Molster
THE LAW OFFICES OF
CHARLES B. MOLSTER, III PLLC
2141 Wisconsin Avenue, N.W. Suite M
Washington, DC 20007
Telephone: (202) 787-1312
Email: cmolster@molsterlaw.com

*Counsel for Plaintiffs RAI Strategic
Holdings, Inc. and R.J. Reynolds Vapor
Company*

stephanie.adamakos@weil.com
WEIL, GOTSHAL & MANGES LLP
2001 M Street, NW, Suite 600
Washington, DC 20036
Tel: (202) 682-7000; Fax: 202-857-0940

Elizabeth Stotland Weiswasser (pro hac vice)
elizabeth.weiswasser@weil.com
Anish R. Desai (pro hac vice)
anish.desai@weil.com
WEIL, GOTSHAL & MANGES LLP
767 5th Avenue
New York, NY 10153
Tel: (212) 310-8000; Fax: 212-310-8007

Adrian C. Percer (pro hac vice)
adrian.percer@weil.com
WEIL, GOTSHAL & MANGES LLP
201 Redwood Shores Parkway
Redwood Shores, CA 94065
Tel: (650) 802-3000; Fax: 850-802-3100

*Counsel for Defendants-Counterclaim Plaintiffs
Altria Client Services LLC and Philip Morris USA
Inc.*

CERTIFICATE OF SERVICE

I hereby certify that on this 20th day of April, 2022, a true and correct copy of the foregoing was served using the Court's CM/ECF system, with electronic notification of such filing to all counsel of record.

/s/ David M. Maiorana

David M. Maiorana (VA Bar No. 42334)

JONES DAY

901 Lakeside Ave.

Cleveland, OH 44114

Telephone: (216) 586-3939

Facsimile: (216) 579-0212

Email: dmaiorana@jonesday.com

*Counsel for RAI Strategic Holdings, Inc. and
R.J. Reynolds Vapor Company*