

**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.

Case No. 1:20-cv-00393-LO-TCB

**COUNTERCLAIM PLAINTIFFS' MEMORANDUM IN SUPPORT OF MOTION
TO LIMIT THE NUMBER OF PRIOR ART REFERENCES AND PRIOR ART
COMBINATIONS FOR THE '911 PATENT**

Counterclaim Plaintiffs Altria Client Services, LLC, Philip Morris USA Inc., and Philip Morris Products S.A. (collectively, “PMP/Altria”) respectfully request that the Court order Reynolds to further limit its identification of prior art and combinations for claim 2 of U.S. Patent No. 10,104,911 (“the ’911 Patent”) from the current 6 references and 6 combinations to no more than 3 references and 2 combinations.

On March 21, 2022, the Court issued an Order directing Counterclaim Plaintiffs to choose a “reasonable” number of claims to be presented at trial. Dkt. 1157 at 1. The Order further directed Reynolds to specifically identify a “reasonable” number of prior art references and combinations for trial. *Id.* The parties jointly notified the Court of these identifications on April 20, 2022. *See* Dkt. 1197. Relevant to this motion, Counterclaim Plaintiffs identified 3 asserted claims from the ’911 Patent (a reduction from 7 asserted claims). Reynolds, however, responded by identifying 6 references and 6 combinations for just asserted claim 2 of the ’911 Patent. Counterclaim Plaintiffs requested that Reynolds reduce their identification to a reasonable number. Reynolds refused. *See* Exhibit 1 (Email From J. Michalik to S. Ravula dated April 27, 2022).

The Court’s Order stated that “the Court will decide how to proceed and whether any further limitations to the claims and/or pieces of prior art is necessary before trial.” Dkt. 1157 at 1. Reynolds’ disclosure of 6 references and 6 combinations for a single asserted claim is neither realistic nor reasonable. Accordingly, PMI/Altria respectfully requests that the Court order Reynolds to further limit the number of prior art and prior art combinations to no more than 3 references and 2 combinations for claim 2 of the ’911 Patent by no later than May 6, 2022.

Dated: April 29, 2022

Respectfully submitted,

By: /s/ Maximilian A. Grant

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CERTIFICATE OF SERVICE

I hereby certify that on this 29th 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:

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