

**IN THE 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

**REYNOLDS'S OPPOSITION TO MOTION TO LIMIT THE NUMBER OF PRIOR ART
REFERENCES AND PRIOR ART COMBINATIONS FOR THE '911 PATENT**

INTRODUCTION

In its March 21 Order, the Court instructed Altria and Philip Morris to identify a reasonable number of claims to be presented at trial, and Reynolds to thereafter identify a reasonable number of prior art references and combinations to be presented at trial. *See* Dkt. 1157. The parties then filed a joint submission on April 20, 2022, identifying those claims and prior art references and combinations. *See* Dkt. 1197. The Court’s review of that submission remains pending. *See* Dkt. 1157 (stating that, after reviewing the parties’ joint submission, “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”).

PM/Altria’s motion “to limit the number of prior art references and prior art combinations for the ’911 patent”—specifically, the prior art and combinations for claim 2 of the ’911 patent—fails to respect the Court’s Order and process,¹ and offers no justification for the motion. PM/Altria instead offers only its bald assertion that Reynolds’s “6 references and 6 combinations for a single asserted claim is neither realistic nor reasonable.” Mot. Memo. at 1. This is divorced from the relevant facts: the limitations of claim 2, the other claims of the ’911 patent that PM/Altria continues to assert, and the asserted references and combinations—none of which PM/Altria even sets forth in its motion.

Moreover, Reynolds already has limited its prior art references and combinations twice. First, in its expert report on invalidity of the ’911 patent, Reynolds’s expert relied on far fewer

¹ As Exhibit 1 to its Motion, PM/Altria attached an incomplete email chain that improperly suggests that Reynolds was unwilling to meet and confer with PM/Altria. *See* Dkt. 1211-1. The complete record shows, however, that Reynolds did meet and confer with PM/Altria to discuss the requested clarification of Reynolds prior art references and combinations for the ’911 patent. *See* Exhibit 1 to Reynolds’s Opposition. PM/Altria did not thereafter raise any concern about the references and combinations for claim 2 of the ’911 patent until it filed the instant motion on Friday, April 29, 2022. *See* Exhibit 2 to Reynolds’s Opposition.

references and combinations than Reynolds had previously identified in its invalidity contentions. Then, on April 20, Reynolds further reduced the number of prior art references and combinations in response to PM/Altria's court-ordered reduction of claims, eliminating two primary prior art references in their entirety and eliminating all of the obviousness combinations based on those two references. PM/Altria is still asserting three different claims from the '911 patent, each with different limitations. For these three still-asserted '911 patent claims, Reynolds has already narrowed its invalidity case to combinations based on three primary prior art references and three secondary prior art references. Thus, as directed by the Court, Reynolds has already narrowed the prior art to a reasonable number to present at trial, and PM/Altria's motion should be denied.

ARGUMENT

PM/Altria's motion asks the Court to view the prior art references and combinations Reynolds identified on asserted claim 2 of the '911 patent in a vacuum. The Court should decline to do so. While PM/Altria correctly states that Reynolds identified multiple prior art combinations against claim 2 (Mot. Memo. at 1), it ignores that the references and combinations are similar to and overlap with those identified as invalidating claims 11 and 12 of the '911 patent—and PM/Altria does not seek any reduction of references or combinations for claims 11 or 12. Specifically, Reynolds identified four references (Xia, Cho, and Han as primary references in combination with Shizumu) applicable to all three asserted claims of the '911 patent (claims 2, 11, and 12) and added two additional references (Murphy or Egilmex, highlighted below) to show the additional "capillary material" limitation recited in claim 2:

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.

See Dkt. 1197 at 2. After choosing to assert dependent claim 2, which requires a “capillary material” limitation not recited in any of the other asserted claims, PM/Altria should not be surprised Reynolds identified prior art references disclosing that specific limitation. Indeed, PM/Altria’s request to limit Reynolds to three prior art references and two prior art combinations against claim 2 would unfairly restrict Reynolds’s ability to show the “capillary material” limitation recited in claim 2 was known in the prior art and claim 2 is invalid.

PM/Altria also fails to explain how Reynolds’s presentation of Murphy or Egilmex to show the capillary limitation was known in the prior art would multiply proceedings or confuse the jury.² To the contrary, considering the still-asserted claims of the ’911 patent, Reynolds’s reliance on three primary and three secondary prior art references to show three claims in a single patent are invalid fits squarely within the bounds of what courts addressing this issue (including in this district) routinely permit. For instance, in *Certusview*, the court allowed the defendants to maintain up to twenty-five prior art references (without also placing any limits on

² PM/Altria, by contrast, still is asserting nearly twenty claims across five patents, a number that remains unworkable for a jury trial. Mindful of the Court’s March 18 Order, however, Reynolds has not asked the Court to intervene and will await the Court’s guidance. See Dkt. 1157.

obviousness combinations) after the plaintiff limited its asserted claims to fifteen. *Certusview Techs., LLC v. S & N Locating Servs., LLC*, No. 2:13cv346, 2014 WL 4930803, at *7 (E.D. Va. Oct. 1, 2014). Similarly, in *Unwired*, the court found that the number of prior art references the accused infringer could rely on should be a function of the claims asserted by patentee and permitted the defendant to rely on five prior art references per independent claim asserted and eight references per dependent claim for trial. *Unwired Planet LLC v. Google Inc.*, No. 3:12-CV-0504-MMD (VPC), 2013 WL 5592896, at *5 (D. Nev. Oct. 10, 2013); *see also Memory Integrity, LLC v. Intel Corp.*, No. 3:15-cv-00262-SI, 2015 WL 6659674, at *4 (D. Or. Oct. 30, 2015) (requiring the accused infringer to limit its prior art references to thirty-five after plaintiff narrowed its asserted claims to fifteen). Thus, courts regularly find that the reasonable number of prior art references to be presented to a jury should be proportional to the number of claims asserted, not micromanaged on a claim-by-claim basis as PM/Altria would have the Court do here. PM/Altria has offered no reason to adopt that practice now.

CONCLUSION

For the foregoing reasons, Reynolds respectfully requests that PM/Altria's motion be denied.

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