

**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 THEIR MOTION TO FURTHER AMEND THEIR
IDENTIFICATION OF CLAIMS FOR TRIAL**

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Counterclaim Plaintiffs Altria Client Services, LLC, Philip Morris USA Inc., and Philip Morris Products S.A. (collectively, “PMP/Altria”) respectfully request that the Court allow PMP/Altria to further amend their identification of claims for trial (Dkt. 1197).

I. BACKGROUND

On March 21, 2022, the Court issued an Order directing Counterclaim Plaintiffs to choose a “reasonable” number of claims to be presented at trial from the five asserted patents. Dkt. 1157 at 1. The Order further directed Reynolds to identify a “reasonable” number of prior art references and specific prior art combinations for trial. *Id.* The parties jointly submitted their identifications on April 20, 2022. *See* Dkt. 1197. PMP/Altria identified a total of nineteen claims (a reduction from forty-five asserted claims), including claims 2, 11, and 12 from the ’911 Patent (a reduction from seven). *See* Dkt. 1153 at 2; 1197 at 2.

Consistent with the Court’s March 21 Order (Dkt. 1157), PMP/Altria seeks to amend their identification to: (i) add claim 13 of U.S. Patent No. 10,104,911 (“the ’911 patent”), which has been asserted throughout the case, and (ii) remove claim 4 of U.S. Patent No. 10,420,374 (“the ’374 patent”) (ensuring the total number of claims for trial does not increase).¹ PMP/Altria asked Reynolds whether it will agree to this amendment. Reynolds refused. *See* Dkt. 1213, Ex. 2.

II. ARGUMENT

There is no surprise or prejudice to Reynolds. Claim 13 of the ’911 Patent has been at issue since the inception of the case. Indeed, the parties’ identification of claims and prior art, which did not identify claim 13, was filed only two weeks ago on April 20, 2022. Before that date, the parties exchanged contentions and expert reports, and took depositions, about that claim.

¹ PMP/Altria filed a motion related to reducing Reynolds’ unreasonably large identification of prior art combinations for claim 2 of the ’911 patent. Dkt. 1211. PMP/Altria’s present motion does not relate to that claim or impact their request.

Moreover, claim 13 is a dependent claim that adds only the requirement that “the at least one cavity” has a “toroidal shape.” Indeed, the prior art references and combinations disclosed by Reynolds’ expert for claim 13 are *identical* to claim 11, which is already on PMP/Altria’s list of asserted claims for trial. *See* Ex. 1 (Excerpts From Expert Report of K. Kodama Dated February 24, 2021). Moreover, PMP/Altria has offered to remove claim 4 of the ’374 patent from their asserted claims at trial, such that this amendment will not increase the total number of claims for trial.

III. CONCLUSION

For these reasons, the Court should grant this Motion to (i) add claim 13 of the ’911 patent, which has been asserted throughout the case, and (ii) remove claim 4 of the ’374 patent (ensuring the total number of claims for trial does not increase).

Dated: May 6, 2022

Respectfully submitted,

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