

**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 PM/ALTRIA'S MOTION TO FURTHER AMEND
THEIR IDENTIFICATION OF CLAIMS FOR TRIAL**

TABLE OF CONTENTS

	Page
INTRODUCTION	1
BACKGROUND	1
ARGUMENT	2
CONCLUSION.....	4

TABLE OF AUTHORITIES

Page

CASES

Certusview Techs., LLC v. S & N Locating Servs., LLC,
No. 2:13-cv-346, 2014 WL 4930803 (E.D. Va. Oct. 1, 2014)2

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INTRODUCTION

PM/Altria's request to add to its list of patent claims for trial does not comply with the Court's March 21 Order, and is prejudicially late. As PM/Altria told the Court on May 5, this case is "on the eve of trial." Dkt. 1220 at 3. Yet, in an about-face the very next day, PM/Altria asked the Court for permission to *add* to the list of asserted claims it will present at trial. Dkt 1221. It is too late for PM/Altria to move the goal posts. The Court's March 21 Order directed PM/Altria to identify the asserted patent claims for trial on April 5. Relying on PM/Altria's Court-ordered identification of claims, Reynolds has been actively engaged in trial preparations for over five weeks now. And, as directed by the Court's March 21 Order, Reynolds already made decisions tailoring its invalidity case to the particular asserted patent claims PM/Altria identified on April 5. *See* Dkt. 1197. There is no good cause for permitting PM/Altria to expand the asserted patent claims at this late date, long after it was ordered to make its claim selection for trial. Reynolds has relied on that identification and will be prejudiced if a new asserted patent claim is added only three weeks (or less) before the start of trial. PM/Altria's Motion should be denied.

BACKGROUND

As recently as two months ago, PM/Altria still was asserting forty-five patent claims across five patents. On March 11, Reynolds moved to limit the number of asserted claims for the June 6 trial, Dkt. 1146, and PM/Altria opposed, Dkt. 1153. Following a hearing, the Court issued an Order on March 21 directing PM/Altria to "choose a reasonable number of claims to be presented at trial" and "to communicate those claims" to Reynolds by April 5. Dkt. 1157. PM/Altria identified nineteen claims across the five asserted patents, including three claims from the '911 patent. *See* Ex. 1. Claim 13 of the '911 patent was not among them. *Id.* Reynolds, in turn, was directed to identify the prior art references and combinations to be presented at trial

based on the particular patent claims selected by PM/Altria, Dkt. 1157, and Reynolds did so on April 20, Dkt. 1197.

As also directed by the Court, the parties then filed a joint submission on April 20 identifying the asserted patent claims and the prior art references and combinations for trial. *Id.* Subsequently, PM/Altria asked the Court to further limit the number of prior art references and combinations Reynolds can assert at trial against the '911 patent "by no later than May 6," arguing that the approaching June 6 trial meant it was "time to choose" and "time to pick" a reduced number of prior art references and combinations. Dkt. 1211; *see also* Dkt. 1220 at 3. Reynolds opposed. Dkt. 1213. That motion remains pending.

While simultaneously urging the Court to further *reduce* Reynolds's invalidity case for trial, PM/Altria now asks the Court for permission to *expand* its infringement case to *add* claim 13 of the '911 patent to its list of claims to present at trial. Dkt. 1221. PM/Altria acknowledges that '911 claim 13 recites additional limitations (including a "toroidal shape" limitation) not found in any of the other '911 claims identified by PM/Altria on April 5, Dkt. 1222 at 2, but offers no justification for its untimely addition.

ARGUMENT

PM/Altria should not be permitted to add claim 13 of the '911 patent more than five weeks after the Court's deadline for PM/Altria to select the asserted patent claims to be presented at trial because it offers no good reason for doing so. *See Certusview Techs., LLC v. S & N Locating Servs., LLC*, No. 2:13-cv-346, 2014 WL 4930803, at *4 (E.D. Va. Oct. 1, 2014) (recognizing good cause required to assert additional, unselected claims). Indeed, PM/Altria does not identify any unique issues of infringement or damages for trial implicated by claim 13. *See id.* (grounding good cause to add claims for trial on a showing by the patentee that the additional claims "present unique issues of liability or damages"). To the contrary, PM/Altria

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