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

PHILIP MORRIS PRODUCTS S.A.

Plaintiff,

v.

R.J. REYNOLDS VAPOR COMPANY

Defendant.

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

PHILIP MORRIS'S MOTION *IN LIMINE TO* EXCLUDE REFERENCE TO REYNOLDS'S PATENTS

Philip Morris respectfully moves the Court *in limine* to preclude Reynolds from introducing, through Dr. Figlar or any other witness, evidence or argument that ***Reynolds's patents*** cover the accused products. Reynolds's counsel previewed during its opening statement that it intends to present evidence that Reynolds does not infringe because it has its "own patents" that cover the accused products:

> The plaintiffs claim that Reynolds took their technology and is using their patent, but Reynolds didn't need to do that. Reynolds had its own technology, ***it had its own patents***, and had done all of this work. The products, the Vuse products of the Reynolds technology is a result of its own work.

Tr. 137:1-5. Not only is there no evidence in the record to support such an assertion, such testimony should be precluded as irrelevant and prejudicial, and further as lacking any foundation or support.

Courts routinely exclude evidence of an alleged infringer's patents because it is legally irrelevant to infringement and is an improper attempt "try to take advantage of a common misconception by the public that a patent grants an affirmative right to make the patented article." *EZ Dock, Inc. v. Schafer Systems, Inc.*, 2003 WL 1610781, *11 (D. Minn. Mar. 8, 2013); s*ee also LifeNet Health v. LifeCell Corp.*, 93 F. Supp. 3d 477, 509 (E.D. Va. 2015), *aff'd*, 837 F.3d 1316 (Fed. Cir. 2016) (excluding evidence of defendant's patents because it would mislead the jury and stating that "the Court [is] on notice that Defendant had such intent ***because it stated in its opening statement that it did not infringe because it had its own patent***."); *Cf. Bio-Technology Gen. Corp. v. Genentech, Inc.*, 80 F.3d 1553, 1559 (Fed. Cir. 1996) (holding that "the existence of one's own patent does not constitute a defense to infringement of someone else's patent"); *see also Fiskars, Inc. v. Hunt Mfg. Co.*, 221 F.3d 1318, 1324 (Fed. Cir. 2000) (affirming district court's exclusion of evidence that defendant's patents covered the accused product because such evidence was not "material to the issue of infringement"); *Conceptus, Inc. v. Hologic, Inc.*, No. C 09-02280 WHA

(N.D. Cal. Sept. 27, 2011), Dkt. No. 433 at 5 (granting plaintiff's motion *in limine* "to exclude evidence, testimony, and argument concerning [defendant's] patents"); *Intellectual Ventures I LLC v. Symantec Corp.*, C.A. No. 10-1067-LPS (D. Del., Jan. 6, 2015), Dkt. No. 615 at 2 (similar).

Reynolds should not be permitted to present evidence or suggest to the jury (again) that it has its own patents that cover the accused products. Such irrelevant evidence will be prejudicial to Philip Morris under FRE 401 and 403 and will only serve to confuse the jury. Moreover, no expert has opined that any of the accused products are covered by any Reynolds patents, and the Court should not allow Dr. Figlar to offer that irrelevant and prejudicial opinion for the first time now.

Dated: June 9, 2022

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 9th day of June, 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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