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

MEMORANDUM IN SUPPORT OF PHILIP MORRIS'
MOTION FOR JUDGMENT AS A MATTER OF LAW OF NO INVALIDITY

TABLE OF CONTENTS

Page

I. INTRODUCTION 1

II. LEGAL STANDARD.....1

III. ARGUMENT 2

IV. CONCLUSION.....4

I. INTRODUCTION

Philip Morris respectfully moves for judgment as a matter of law that the asserted claims of the '911 Patent are not invalid. Reynolds' sole invalidity defense is that the claims would have been obvious over the Han patent combined with other alleged prior art. But Reynolds' technical expert, Mr. Kodama, offered nothing more than conclusory assertions, rooted in impermissible hindsight, that Han ***could*** be modified to achieve the claimed invention—with no explanation (beyond a conclusion not rooted in evidence) of why a person of skill in the art ***would*** have been motivated to do so. This is insufficient as a matter of law.

II. LEGAL STANDARD

Judgment as matter of law is appropriate "[i]f a party has been fully heard on an issue during a jury trial and the court finds that a reasonable jury would not have a legally sufficient evidentiary basis to find for the party on that issue." FED. R. CIV. P. 50(a)(1). Rule 50(a) "allows the trial court to remove ... issues from jury's consideration when the facts are sufficiently clear that the law requires a particular result." *Weisgram v. Marley*, 528 U.S. 440, 448 (2000). While the Court must view the evidence in the light most favorable to the non-moving party, a "mere scintilla of evidence is insufficient" to create a jury question, and inferences to support a jury's verdict, "must be reasonably probable." *Charleston Area Med. Ctr., Inc. v. Blue Cross & Blue Shield Mut. of Ohio, Inc.*, 6 F.3d 243, 248 (4th Cir. 1993).[1]

Under Federal Circuit law, "[a] party seeking to invalidate a patent on obviousness grounds must demonstrate by clear and convincing evidence that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and … would have had a reasonable expectation of success in doing so." *InTouch Techs., Inc. v.*

[1] All emphasis added and internal quotation marks omitted unless otherwise noted.

VGO Commc'ns, Inc., 751 F.3d 1327, 1347 (Fed. Cir. 2014). "Identifying a motivation to combine the prior art is important because inventions in most, if not all, instances rely on building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *TQ Delta, LLC v. Cisco Sys., Inc.*, 942 F.3d 1352, 1357 (Fed. Cir. 2019) (quoting *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418-19 (2007)). "[A]llowing the challenger to use the challenged patent as a roadmap to reconstruct the claimed invention using disparate elements from the prior art [is] the impermissible *ex post* reasoning and hindsight bias that *KSR* warned against." *Id.*

For this reason, generalized or conclusory expert testimony that "bears no relation to any specific combination of prior art elements" and "fails to explain why a person of ordinary skill in the art would have combined elements from specific references in the way the claimed invention does" is "insufficient for a reasonable jury to support a determination of obviousness." *ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.*, 694 F.3d 1312, 1328 (Fed. Cir. 2012) (affirming Rule 50(a) pre-verdict judgment as a matter of law).

III. ARGUMENT

Philip Morris is entitled to judgment as a matter of law of no invalidity regarding the '911 Patent because no reasonable jury could find that the asserted claims of the '911 Patent are obvious based on Mr. Kodama's vague and conclusory expert testimony. FED. R. CIV. P. 50(a).

Each asserted claim (2, 11, 12, and 13) of the '911 patent requires a blind hole cavity with a "largest cross-sectional dimension x taken along a cross-section of the cavity in a direction perpendicular to the longitudinal direction of the cavity, where x is 0.5 mm, or 1 mm, or between 0.5 mm and 1 mm." There is no dispute that Han (Reynolds' only primary reference) does not disclose this limitation. *See* Ex. A (Trial Tr. 6/10/22 pm) at 116:14-19.

In an attempt to overcome this foundational deficiency, Mr. Kodama asserted that it would have been obvious to modify Han's device based on the Shizumu reference's disclosure of a device with an overall diameter of 7 millimeters. Based on this overall ***device*** dimension, Mr. Kodama concluded that it would have been obvious to modify the "cavity" of Han to have the claimed cavity dimensions of "0.5 mm, or 1 mm, or between 0.5 mm and 1 mm." But the sum total of his testimony about why this would have been obvious is the single sentence below:

> [I]f we take that as a starting point, the outer diameter being, let's say, 7 millimeters, and then we have to add in all these walls, right, the outer walls, two outer walls, the two inner walls that form the mouth hole, the actual mouth hole, it would be obvious to end up with a dimensional range for the cavity or the blind hole of 0.5 to 1 millimeter.

Id. at 64:18-65:1. This "evidence" is legally deficient.

TQ Delta is instructive. There, the Federal Circuit found that the proffered evidence of a motivation to combine was legally insufficient where the expert testified that "somebody ***could*** look at a telepresence robot" or that "***a person of ordinary skill can do that***." *TQ Delta, LLC v. CISCO Sys., Inc.*, 942 F.3d 1352, 1359 (Fed. Cir. 2019) (emphasis original). Mere evidence of what a person of ordinary skill in the art ***could*** have done "is inadequate to support a finding that there would have been a motivation to combine." *In re Van Os*, 844 F.3d 1359, 1361 (Fed. Cir. 2017); *see also, e.g.*, *Polaris Indus., Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1068 (Fed. Cir. 2018) (finding that Board erred by "focus[ing] on what a skilled artisan would have been ***able*** to do, rather than what a skilled artisan would have been ***motivated*** to do at the time of the invention") (emphasis original); *InTouch*, 751 F.3d at 1353 (finding that the "district court erred in denying JMOL" on validity where "testimony primarily consisted of conclusory references to [the expert's] belief that one of ordinary skill in the art could combine these references, not that they would have been motivated to do so."); *Metalcraft of Mayville, Inc. v. The Toro Co.*, 848 F.3d 1358, 1367

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.