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

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| PHILIP MORRIS PRODUCTS S.A.<br><br>Plaintiff,<br><br>v.<br><br>R.J. REYNOLDS VAPOR COMPANY<br><br>Defendant. | Case No. 1:20-cv-00393-LO-TCB |

**MEMORANDUM IN SUPPORT OF PHILIP MORRIS' MOTION *IN LIMINE* TO PRECLUDE REYNOLDS FROM ARGUING THAT THE PATENT OFFICE EXAMINER ERRED**

## I. INTRODUCTION

Philip Morris requests that the Court preclude Reynolds from presenting arguments that the Patent Office Examiner reviewing the '911 application: (1) did not consider the "Xia" reference and (2) "used the wrong wording" or otherwise made a mistake when describing Figures 5 and 6.

## II. ARGUMENT

### A. The Examiner Considered The "Xia" Reference

Based on the testimony from Reynolds' technical expert for the '911 patent, Kelly Kodama, Philip Morris expects Reynolds to incorrectly argue to the jury that the Examiner did ***not*** consider the Xia reference during prosecution of the '911 patent. On cross-examination, Mr. Kodama testified that he "***believes*** that the claim of Xia with the second cavity was perhaps not considered" by the Examiner:

> Q. In fact, Xia is one of those references that the Patent Office examiner already considered before allowing the '911 Patent, right?
>
> A. Yes, it was in the file history of the patent.
>
> ***
>
> Q. But you think the examiner just got it totally wrong, right?
>
> A. Totally wrong with regard to regarding Xia?
>
> Q. With regards to allowing the '911 Patent claims to issue despite considering Xia.
>
> A. I believe that the claim of Xia with the second cavity was perhaps ***not considered***.

Ex. A (Trial Tr. 6/10/22 a.m.) 111:21-24, 112:19-25 (emphasis added). That is factually incorrect and legally improper. Reynolds should not be allowed to present similar improper arguments to the jury for three reasons.

***First***, when overruling Reynolds' counsel's foundation objection[1], the Court "accepted" as a "fact" that Xia "was considered by the Patent Office." *Id.* at 111:25-112:12. The Court was correct: Xia appears on the face of the '911 patent—the Examiner electronically signed the IDS document on which Xia appears, thus expressly acknowledging that he considered it. PX-8 at 509.

***Second***, any argument that the Examiner did not consider Xia should be barred as contrary to law. Where, as here, "prior art is listed on the face of a patent, the examiner is ***presumed*** to have considered it." *BlephEx, LLC v. Myco Indus., Inc.*, 24 F.4th 1391, 1402 (Fed. Cir. 2022) (citation omitted); *see also Applied Materials, Inc. v. Adv. Semiconductor Materials Am., Inc.*, 98 F.3d 1563, 1569 (Fed. Cir. 1996) (same). Moreover, examiners are "entitled to appropriate deference as official agency action, for examiners are deemed to be experienced in the relevant technology as well as the statutory requirements for patentability." *Nature Simulation Sys., Inc. v. Autodesk, Inc.*, 23 F.4th 1334, 1343 (Fed. Cir. 2022). Reynolds' argument that the Examiner did not consider Xia violates this well-established law and should be barred.

***Third***, because it is factually incorrect and contrary to law, any argument that the Examiner did not consider Xia is irrelevant. FED. R. EVID. 401. Moreover, any probative value that this factually incorrect and legally improper argument carries is substantially outweighed by the risks of confusing and misleading the jury, who may be erroneously believe that the Examiner actually did not consider Xia and thus more likely to find that it invalidates the '911 Patent. FED. R. EVID. 403. Such a result would unfairly prejudice Philip Morris.

The Court should bar Reynolds from contradicting this Court's ruling and controlling law by arguing that the Examiner did not consider Xia during prosecution of the '911 patent.

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[1] Reynolds' counsel's baseless objection was: "We don't know if that examiner looked at the specific patent. There's no evidence of that in the record." Ex. A (Trial Tr. 6/10/22 a.m.) at 112:2-9. The factual premise of that objection was false. PX-8 at 509.

**B. The Examiner Did Not Use "The Wrong Wording"**

Based on testimony from Mr. Kodama, Philip Morris' expects Reynolds to argue to the jury that the Examiner used "the wrong wording," or otherwise erred, when reviewing the '911 application. During cross-examination and when asked a question by Reynolds counsel that was intended to elicit improper testimony, Mr. Kodama testified that the Examiners erred during prosecution of the '911 patent:

> Q. Now, that's exactly what Figure 6 of the '911 Patent shows, right, 'the at least one cavity is a blind hole has a toroidal shape,' correct?
>
> A. That's Figure 6, but I would not call that a blind hole. Based upon my experience in the industry, that is not a blind hole. That would be what we call an annular groove.
>
> Q. It's just not what the examiners called it, right?
>
> A. Well, unfortunately, ***I believe the examiners might have used the wrong wording there***. They actually used 'blind cavity' instead of 'blind hole.' In industry, we would not call that area shaded in yellow a blind hole, it would be an annular groove or some other shape.
>
> Q. ***In other words, you think the experts*** **[i.e., the examiners at the Patent Office]** ***got it wrong***.
>
> A. ***I think they might have chosen the wrong wording in their reply, yes***.

Ex. A (Trial Tr. 6/10/22 a.m.) at 96:8-22 (emphasis added). This rank speculation is improper and lacks any factual basis. It should be excluded.

Such argument contradicts the parties' agreed motion *in limine* No. 3, which states "[n]o party will present argument, evidence, or testimony disparaging the United States Patent and Trademark Office … or its examiners." Dkt. 822 at 2. Moreover, examiners are entitled to deference because, as even Mr. Kodama recognizes, they "have expertise in the art of the '911 Patent" and "understand the '911 Patent's claims." Ex. A (Trial Tr. 6/10/22 a.m.) at 91:14-20; *Nature Simulation*, 23 F.4th at 1343 ("Actions by PTO examiners are entitled to appropriate

deference as official agency actions"). It would be improper to allow Reynolds to suggest, without any factual basis, that the Examiner was wrong or otherwise erred. Such suggestions are routinely excluded in jury trials because they only serve to confuse and mislead the jury into finding that Reynolds' asserted prior art somehow invalidates the '911 patent. FED. R. EVID. 403.

The Court should bar Reynolds from improperly suggesting that the Examiner "used the wrong wording" or otherwise erred when reviewing the '911 application.

## III. CONCLUSION

Philip Morris respectfully requests that the Court preclude Reynolds from arguing that the '911 patent Examiner: (1) did not consider the "Xia" reference and (2) "used the wrong wording" or otherwise made a mistake when describing the figures in the specification.

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