

# EXHIBIT 1

UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF VIRGINIA

PHILIP MORRIS PRODCUTS S.A., )  
)  
) Civil Action  
Counterclaim Plaintiff, ) No. 1:20-cv-00393-LMB/TCB  
)  
v. ) June 10, 2022  
) 9:13 a.m.  
R.J. REYNOLDS VAPOR COMPANY, )  
)  
)  
Counterclaim Defendant. )  
)  
)

VOLUME 3 - MORNING SESSION  
TRANSCRIPT OF JURY TRIAL PROCEEDINGS  
BEFORE THE HONORABLE LEONIE M. BRINKEMA,  
UNITED STATES DISTRICT COURT JUDGE

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09:33AM **1** So what happened is the patent examiner objected saying

09:34AM **2** that Rose disclosed cavity, and in Philip Morris's argument to

09:34AM **3** the Patent Office they defined what defines "non-blind." In

09:34AM **4** this case they're saying that the spaces are open or on the

09:34AM **5** sides, which means these features are non-blind. So basically

09:34AM **6** they're defining what "blind" means, which means a space that

09:34AM **7** has -- that is not open around the side.

09:34AM **8** Furthermore, they followed saying basically what the

09:34AM **9** patent examiner wrote is the opposite of what is claimed, so, in

09:34AM **10** other words, they defined in their own words during the patent

09:34AM **11** application process what "blind" what "blind hole" represents.

09:34AM **12** Q. Did the patent examiner point to something in the Rose

09:34AM **13** patent that he contended was a cavity?

09:34AM **14** A. He did, yes. If you remember the picture from Rose it's

09:34AM **15** got sort of these fingers that are inside the cavity, and,

09:34AM **16** again, they argued that because it had open sides, it was

09:34AM **17** non-blind.

09:34AM **18** Q. Did Philip Morris make those arguments about spaces with

09:34AM **19** open sides being non-blind more than once to the Patent Office?

09:35AM **20** A. They did, yes, multiple times.

09:35AM **21** Q. How are Philip Morris's arguments to the Patent Office

09:35AM **22** about blind holes relevant to your opinion here?

09:35AM **23** A. Well, again, Claim 1 of the claim language has the term

09:35AM **24** "blind hole," so it limits itself to the geometric features of

09:35AM **25** the patent to a blind hole.

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09:35AM **1** Q. And did the arguments Philip Morris made inform you about

09:35AM **2** what a blind hole means?

09:35AM **3** A. Well, I already know, understand from industry what a

09:35AM **4** blind hole means, but yes, you can look at Philip Morris's words

09:35AM **5** and they, themselves, have defined what they are presenting to

09:35AM **6** the Patent Office what a blind hole means.

09:35AM **7** Q. Are there any figures in the '911 Patent showing what a

09:35AM **8** blind hole is in the product in the '911 Patent?

09:35AM **9** A. Yes. So there are two figures, which I believe you've

09:35AM **10** seen before, Figures 3 and 4, which represent a design for blind

09:35AM **11** holes.

09:35AM **12** Q. Explain to the jury what we're seeing here in this --

09:35AM **13** your annotated of Figures 3 and 4.

09:35AM **14** A. So, again, this is showing Figures 3 and 4 from the

09:36AM **15** patent. On the left-hand side you can see items 305 up at the

09:36AM **16** top and 307 down at the bottom, and those are labeled "blind

09:36AM **17** hole."

09:36AM **18** Thank you.

09:36AM **19** And then on the right-hand side in Figure 4, again, items

09:36AM **20** 305 and 307 showing blind holes.

09:36AM **21** Q. In Figure 3 there's a dotted line with the Roman

09:36AM **22** Numeral IV next to it. Can you explain to the jury what that

09:36AM **23** is?

09:36AM **24** A. Yes. So in the Claim 1 language there's a lot of

09:36AM **1** there's some wording about the largest cross-sectional dimension

09:36AM **2** and so that item 4 with the arrows in the Figure 3, that's got

09:36AM **3** the Roman Numeral IV, that is basically a cut through that

09:36AM **4** device, and then Figure 4 is a view that would result from that

09:36AM **5** cut, so if you imagine you have a sausage, and you sort of cut

09:36AM **6** that sausage in half and then Figure 4 is sort of looking at the

09:36AM **7** end of that sausage. Sorry, that's probably not a great

09:37AM **8** analogy.

09:37AM **9** Q. Did the asserted '911 Patent claims require a blind hole

09:37AM **10** as shown in Figures 3 and 4?

09:37AM **11** A. They do, yes.

09:37AM **12** Q. Did you prepare an animation to help the jury understand

09:37AM **13** what a blind hole claimed in the '911 Patent would look like in

09:37AM **14** three dimensions?

09:37AM **15** A. Yes. I produced some animations to help you sort of

09:37AM **16** visualize what's trying to be represented in Figures 3 and 4 of

09:37AM **17** the patent.

09:37AM **18** Q. How did you create this animation?

09:37AM **19** A. So I took the patent diagram and created three models

09:37AM **20** that represented similar shapes and sizes to the patent figures,

09:37AM **21** and then, in three dimensions, animated these in order to

09:37AM **22** visualize what the holes would look like, the blind holes would

09:37AM **23** look like in three dimensions.

09:37AM **24** Q. Did you do anything to insure that the animations were an

09:37AM **25** accurate representation of the '911 Patent?

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09:37AM **1** A. Yes, I compared them and overlaid the figure on top of

09:37AM **2** the animation so you can see for yourself that I'm not trying to

09:37AM **3** misrepresent what's shown in Figures 3 and Figures 4.

09:37AM **4** Q. Mr. Kodama, do you use animations like this in your

09:37AM **5** day-to-day work?

09:37AM **6** A. Yes, of course. We need to present sort of complex

09:38AM **7** concepts sometimes, also for ourselves, in order to analyze

09:38AM **8** products and devices for assembly purposes and for

09:38AM **9** manufacturability purposes.

09:38AM **10** Q. And what are you going to show the jury in these

09:38AM **11** animations?

09:38AM **12** A. So I'm going to show you, again, sort of the figures

09:38AM **13** overlaid on top of the 3D models, just so you can see how they

09:38AM **14** relate, as well as the different cross-sectional views which

09:38AM **15** means cutting the item in half so you can see inside, and the

09:38AM **16** final animation I'll show you how sort of the condensate is

09:38AM **17** collected inside of the blind holes.

09:38AM **18** Q. Mr. Kodama, let's look at the first clip, please.

09:38AM **19** (Videotape played.)

09:38AM **20** BY MR. MAIORANA:

09:38AM **21** Q. What do we see in that clip, Mr. Kodama?

09:38AM **22** A. So what we saw in that clip was, again, the device cut in

09:38AM **23** half, and then rotated, and then we cut it at the end using

09:38AM **24** section Roman Numeral IV, which corresponds to Figure 4 in the

09:44AM **1 A.** What I'm showing here is on the left-hand side is a

09:44AM **2** photograph of the Vuse Alto. In the middle image is a CAD

09:44AM **3** rendering of the mouthpiece section, the entire mouthpiece

09:44AM **4** section, and on the far right what I've done similar to those

09:44AM **5** original images I showed you is I cut the mouthpiece in half,

09:44AM **6** just so you can see the details inside that we're talking about,

09:44AM **7** which are, in this case, the small rib down at the bottom of the

09:44AM **8** screen that partially surrounds the mouthpiece hole.

09:44AM **9 Q.** Let's look at the next slide. Does this image show the

09:44AM **10** area in the Alto mouthpiece that Dr. Abraham contends is a blind

09:44AM **11** hole?

09:44AM **12 A.** Yes, it does.

09:44AM **13 Q.** Where is that indicated?

09:44AM **14 A.** So that's indicated in the red highlighted area of the

09:44AM **15** surface behind that rib -- in between the rib and the inner wall

09:44AM **16** of the mouthpiece.

09:44AM **17 Q.** Does that space in the Alto mouthpiece form a cavity as

09:44AM **18** required by the '911 Patent claims?

09:44AM **19 A.** No, it does not. It has open sides, so it doesn't form

09:44AM **20** any sort of cavity.

09:44AM **21 Q.** Does that space in the Alto mouthpiece form a blind hole

09:45AM **22** as required by the '911 Patent?

09:45AM **23 A.** No, it does not form a blind hole either.

09:45AM **24 Q.** You were here on Wednesday when Dr. Abraham testified

09:45AM **25** about the doctrine of equivalents, do you remember that?

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09:45AM **1 A.** Yes, I do.

09:45AM **2 Q.** And you heard Dr. Abraham say that the open-sided spaces

09:45AM **3** in the Alto mouthpiece are equivalent to a cavity? Do you

09:45AM **4** remember that?

09:45AM **5 A.** I remember that.

09:45AM **6 Q.** Do you agree with that opinion?

09:45AM **7 A.** No.

09:45AM **8 Q.** Why not?

09:45AM **9 A.** Again, because the sides are open, it does not form a

09:45AM **10** cavity. In addition, there's a whole series of steps that need

09:45AM **11** to be sort of explained for doctrine of equivalents. Basically,

09:45AM **12** the function of the ribs is not to trap condensate. The

09:45AM **13** function is to locate the gasket.

09:45AM **14** In the right-hand view of this image that I'm showing

09:45AM **15** you, again, it's that sort of cut view of the mouthpiece, but,

09:45AM **16** in addition, you can see that purple piece. I believe

09:45AM **17** Dr. Abraham had it shown in orange or some other color, but in

09:45AM **18** this case it's purple. So it's actually a silicone gasket that

09:46AM **19** is positioned inside the mouthpiece. The purpose of those ribs

09:46AM **20** is to properly position that gasket in place, not to retain any

09:46AM **21** sort of condensate.

09:46AM **22** In addition, the condensate is not trapped because the

09:46AM **23** ribs have open sides, right, it doesn't form a cavity. It's

09:46AM **24** just a flat surface with a rib, so the rib performs no function

09:46AM **1** In addition, because of the gasket that's in place there,

09:46AM **2** there's no space to store condensate. This picture and some of

09:46AM **3** Dr. Abraham's images were a little bit deceptive because there's

09:46AM **4** actually another hole component, a plastic component, which I

09:46AM **5** can show you on this cartridge (indicating), that's this sort of

09:46AM **6** clear tank area that's got the liquid in it. That entire

09:46AM **7** component goes inside of the mouthpiece and interfaces with that

09:46AM **8** silicone gasket, seals against that silicone gasket, so there

09:46AM **9** really is no space inside of the air flow channel to store

09:46AM **10** condensate. So as a result, condensate is not collected inside

09:47AM **11** of there, inside of the proposed cavity that's formed by the rib

09:47AM **12** inside the Alto mouthpiece.

09:47AM **13 Q.** Now, you mentioned there was something colored in orange

09:47AM **14** in one of Dr. Abraham's slides the other day.

09:47AM **15** THE COURT REPORTER: (Reporter requests clarification.)

09:47AM **16** THE WITNESS: Orange

09:47AM **17** MR. MAIORANA: Orange.

09:47AM **18** BY MR. MAIORANA:

09:47AM **19 Q.** There was something colored in orange in one of

09:47AM **20** Dr. Abraham's slides Wednesday? You mentioned that?

09:47AM **21 A.** Yes.

09:47AM **22 Q.** And do you recall Her Honor asked a question about what

09:47AM **23** that orange thing is?

09:47AM **24 A.** Right.

09:47AM **25 Q.** So could you please explain that so we're all clear on

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09:47AM **1** what that -- the orange piece in Dr. Abraham's figure was?

09:47AM **2 A.** Yes, so I'll explain that in a little more detail. So,

09:47AM **3** again, on this view, on the image you can see -- I actually have

09:47AM **4** colored it purple, and that's a silicone gasket, so the silicone

09:47AM **5** gasket, again, is intended to seal between this clear piece and

09:47AM **6** the mouthpiece, and that seals the air channel. There's a tube

09:47AM **7** that runs along in the inside of this plastic piece, which the

09:47AM **8** vapor goes out, and that's the intention of that gasket. The

09:47AM **9** intention and the purpose of the ribs is to locate that gasket.

09:48AM **10** Now, that diskette is made out of silicone, which is a

09:48AM **11** noncapillary material, so it kind of is actually used for

09:48AM **12** sealing, right? You use it to seal your bathtub, you use it to

09:48AM **13** seal your windows, and this is a similar material, a different

09:48AM **14** type of silicone, but it's the same purpose. Again, it's trying

09:48AM **15** to be used as a gasket for sealing between two parts, not to try

09:48AM **16** and trap or store condensate.

09:48AM **17 Q.** Now, how do you know that's the purpose of the silicone

09:48AM **18** gasket in the Alto?

09:48AM **19 A.** So the PMTA, the premarket tobacco application, for the

09:48AM **20** Vuse Alto references the gasket, actually references every

09:48AM **21** component and explains to the FDA what the purpose and function

09:48AM **22** of those components are.

09:48AM **23 Q.** What materials is the gasket made of?

09:48AM **24 A.** So the gasket is made of a PDMS silicone, so it's just a

09:48AM **1** very easy to mold, basically an injection mold of a  
 09:48AM **2** manufacturer, and it's quite cheap to manufacture as well.  
 09:48AM **3** It also performs very well as a gasket or as a sealant  
 09:49AM **4** because of the inherent material properties. It's a little bit  
 09:49AM **5** spongy, right, so it gives so you can push the two parts  
 09:49AM **6** together very rightly and create a nice seal between two  
 09:49AM **7** components using that silicone gasket.  
 09:49AM **8** Q. In your work designing e-cigarettes, have you had  
 09:49AM **9** occasion to work with gaskets in these types of products?  
 09:49AM **10** A. Yes. Liquid and, as I said, condensate gets everywhere  
 09:49AM **11** in these devices, so there's always applications needed for  
 09:49AM **12** gasketing and for sealing. Sometimes we use glue, but typically  
 09:49AM **13** we'll try and use silicone seals like this because they're much  
 09:49AM **14** more easy to manufacture and much more easy to produce.  
 09:49AM **15** Q. And did you hear on Wednesday Dr. Abraham called that  
 09:49AM **16** silicone gasket a capillary material?  
 09:49AM **17** A. Yes, I did.  
 09:49AM **18** Q. Do you agree with that?  
 09:49AM **19** A. No.  
 09:49AM **20** Q. Why not?  
 09:49AM **21** A. As I mentioned, silicone is sort of the opposite of a  
 09:49AM **22** capillary material, right, it's actually impermeable, meaning  
 09:49AM **23** liquid does not get stored in it. Its sole purpose is actually  
 09:49AM **24** to resist liquid, and that's the purpose of the silicone gasket  
 09:49AM **25** in this case.

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09:49AM **1** Again, as I mentioned, silicone you use for sealing  
 09:50AM **2** bathtubs, sealing windows. It's designed, based on its  
 09:50AM **3** material, to try and resist moisture, absorbing moisture, or any  
 09:50AM **4** sort of liquid.  
 09:50AM **5** Q. Would a person of skill in the e-cigarette field consider  
 09:50AM **6** the Alto silicone gasket to be a capillary material as described  
 09:50AM **7** in the '911 Patent?  
 09:50AM **8** A. No, they would not.  
 09:50AM **9** Q. Please summarize your opinion regarding the '911 Patent  
 09:50AM **10** blind hole requirement in the Vuse Alto product.  
 09:50AM **11** A. So as I've shown you on the previous slide, the Vuse Alto  
 09:50AM **12** does not represent, does not contain a blind hole or any sort of  
 09:50AM **13** cavity at all.  
 09:50AM **14** Q. Now, the jury has heard a lot about this size requirement  
 09:50AM **15** in the '911 Patent claims; is that right?  
 09:50AM **16** A. Right.  
 09:50AM **17** Q. Can you point out that requirement in the '911 Patent  
 09:50AM **18** Claim 1?  
 09:50AM **19** A. So we'll go back to, again, Claim 1.  
 09:50AM **20** Thank you for zooming in.  
 09:50AM **21** At the bottom you can see I highlighted, again, the  
 09:50AM **22** specific language that's used to measure the blind cavity or the  
 09:51AM **23** blind hole. In this case it's the largest cross-sectional  
 09:51AM **24** dimension. Again, remember I'm talking about the sausage and

09:51AM **1** dimensions, so it needs to be the largest dimension of the  
 09:51AM **2** cavity that's taken there.  
 09:51AM **3** In addition, it has a very specific range, right, it  
 09:51AM **4** needs to be 0.5 or 1 millimeter or between 0.5 and 1 millimeter,  
 09:51AM **5** and that's what the claim language depicts.  
 09:51AM **6** Q. Do you see where the claim refers to the largest  
 09:51AM **7** cross-sectional dimension?  
 09:51AM **8** A. Yes.  
 09:51AM **9** Q. What does the word "largest" mean in the context of the  
 09:51AM **10** '911 Patent, Claim 1?  
 09:51AM **11** A. So when we take a cross-section of any sort of  
 09:51AM **12** complicated device, you'll see there's obviously many  
 09:51AM **13** dimensions, right, but what the claim -- what the patent is  
 09:51AM **14** claiming is you must take the largest dimension. So you can't  
 09:51AM **15** just take any dimension, you have to take the largest dimension  
 09:51AM **16** that represents the cavity.  
 09:51AM **17** Q. Now, the claim says "a largest cross-sectional  
 09:51AM **18** dimension." Do you see that?  
 09:51AM **19** A. I do, yes.  
 09:51AM **20** Q. Can a particular cross-section have two largest  
 09:51AM **21** cross-sectional dimensions?  
 09:51AM **22** A. I don't believe so. "Largest" is basically defining the  
 09:52AM **23** largest, right, so I'm not sure why the wording says "a  
 09:52AM **24** largest," but to a POSA and to a person in industry, "largest"  
 09:52AM **25** would mean the largest dimension that represents the cavity.

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09:52AM **1** Q. Does the '911 Patent discuss the advantages of that  
 09:52AM **2** specific claimed dimensional range?  
 09:52AM **3** A. It does. In the specification for the patent, meaning  
 09:52AM **4** the description of the patent, it talks about how they came up  
 09:52AM **5** with the 0.5 to 1 millimeter dimensions.  
 09:52AM **6** Q. What advantages does the specification talk about?  
 09:52AM **7** A. So the specification mentions that the  
 09:52AM **8** 0.5-to-1 millimeter range for the blind hole is large enough to  
 09:52AM **9** store enough condensate to make it useful, but small enough to  
 09:52AM **10** retain or keep the liquid or condensate from leaking out due to  
 09:52AM **11** capillary forces.  
 09:52AM **12** Q. Now, I'm going to ask you about the prosecution history  
 09:52AM **13** again. Was there any discussion of this dimensional requirement  
 09:52AM **14** during the '911 prosecution?  
 09:52AM **15** A. There was, yes.  
 09:52AM **16** Q. What did Philip Morris say to the Patent Office about the  
 09:52AM **17** dimensional requirement?  
 09:53AM **18** A. So Philip Morris, you can see on the screen here, I've  
 09:53AM **19** shown on the left-hand side, it's a snippet from the patent file  
 09:53AM **20** history, and what they said was originally they had the word  
 09:53AM **21** "preferably," and so it means any dimension but preferably  
 09:53AM **22** between 0.5 and 1 millimeter. And what the Patent Office came  
 09:53AM **23** back with is, they forced Philip Morris to be more specific, so  
 09:53AM **24** they basically removed the word "preferably," meaning the

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