IN THE UNITED STATES DISTRICT COURT FOR THE
EASTERN DISTRICT OF VIRGINIA

Alexandria Division

RAI STRATEGIC HOLDINGS, etal	)	
	)	
Plaintiff,	)	
	)	
v.	)	CIVIL ACTION 1:20cv393
	)	
ALTRIA CLIENT SERVICES, LLC, etal	)	
	)	
Defendant.	)	

ORDER

RAI moves for summary judgment that the '374 patent is invalid under 35 U.S.C. § 102(a)(1) because the claimed invention was publicly available before its filing date. In support thereof, RAI states that the original written description of the 949 PCT patent application, (949 PCT) which became the '374 patent, did not disclose embodiments that provide support for the later claims. RAI states that the continuation-in-part of the '374 patent expanded and transformed the claimed invention of the 949 PCT, and therefore the '374 patent is not entitled to the 949 PCT filing date. Without the benefit of the 949 PCT filing date, the '374 patent filing date is July 7, 2015. As a result, RAI states that one of the PMP's own products, the VUSE Solo, is prior art that renders the '374 patent invalid.

RAI more specifically claims that the '374 patent changed the conductive material in the claims from rigid or semi-rigid (949 PCT) to flexible ('374 patent) and from metallic sheet to soft plastic, thereby abandoning the novelty of the earlier conductive material in the 949 PCT application.

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PMP responds that whether or not a priority document (949 PCT) contains sufficient disclosure to comply with the written description in the '374 patent is a question of fact for the jury. PMP asserts that its technical expert, Mr. McAlexander, has opined that a person of skill in the art (POSITA) would find that it does. RAI responds that the Court should outright reject the position that rigid or semi rigid connotes flexible and that metallic sheet connotes soft plastic. Therefore, RAI states that Mr. McAlexander's opinion should be entirely discounted.

The Court has reviewed the underlying materials and finds that there is a triable issue of fact as to whether the '374 patent is entitled to the earlier June 29, 2010 filing date of the 949 PCT. The Court also finds that whether or not the VUSE Solo product is prior art to the '374 patent, if it does not get the June 29, 2010 filing date, is a question of fact for the jury. Therefore, summary judgment on whether the '374 patent is invalid under 35 U.S.C. § 102(a)(1) is **DENIED.**

RAI has moved for summary judgment of no infringement of its VUSE Solo, Vibe, and Ciro by the PMP's 911 patent, literally or under the Doctrine of Equivalents (DOE). PMP agrees that no literal infringement exists but asserts that its expert, Dr. Abraham, has opined that the three products do infringe under DOE.

RAI states that PMP cannot prove infringement under the DOE because of prosecution history estoppel and also vitiation. After a review of the underlying materials, and using the Court's previous definitions of the terms in the 911 patent, the Court finds that whether or not the three products infringe the 911 patent under the DOE is an issue of fact for the jury. Summary judgment is therefore DENIED.

RAI moves for summary judgment of no willful infringement of the 545, 911 and 265 patents under the standard set out in the well-known *Halo Electronics* case, arguing that the

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facts in support of PMP's claims fall short as a matter of law. PMP responds that RAI's pre-suit knowledge and "tie down" of the accused products, its statements to the FDA, its failure to attempt to design around the patents, as well as its expert's opinion of RAI's knowledge of the patents, create issues of fact to be decided by the jury.

Finding that PMP has sufficiently alleged facts under the *Halo Electronics* totality of the circumstances test that may rise to a level where a jury may consider willfulness, the Court denies RAI's motion for summary judgment. Whether the Court ultimately allows willful infringement to be considered by the jury will be decided after the close of the evidence.

Liam O'Grady
United States District Judge

Alexandria Virginia
August 5, 2021

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