

EXHIBIT 1

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

RAI STRATEGIC HOLDINGS, INC. AND R.J.
REYNOLDS VAPOR COMPANY

Plaintiffs and
Counterclaim Defendants,

v.

ALTRIA CLIENT SERVICES LLC; PHILIP
MORRIS USA INC.; and PHILIP MORRIS
PRODUCTS S.A.

Defendants and
Counterclaim Plaintiffs.

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

DRAFT JOINT NOTICE OF AGREED MOTIONS *IN LIMINE*

All parties in this case stipulate to the following motions *in limine*. All parties agree that they, their counsel, representatives, and all witnesses called by them (whether live or by deposition) will not mention, refer to, interrogate about, or attempt to convey to the jury in any manner, either directly or indirectly, any of the matters set forth below without obtaining a favorable ruling from this Court outside the presence of the jury.

- ~~1. **Non-comparable Agreements.** No party will refer to non-comparable agreements or licenses at trial for the purpose of suggesting the amount of a reasonable royalty. For clarity, this agreement does not preclude any party from presenting argument, evidence, or testimony at trial related to the U.S. Settlement and License Agreement between Nu Mark LLC and Fontem (and any settlement agreements/licenses referenced in that agreement), U.S. Settlement and License Agreement between R.J. Reynolds Vapor Company and Fontem, and the ACS/Smart Chip IP Purchase Agreement, subject to any other evidentiary objections regarding those agreements.~~
- ~~2. **Withdrawn Claims or Defenses.** No party will refer to any claims or defenses raised by any party in this case that have been withdrawn, resolved, or that the jury will not be asked to decide at trial.~~
- ~~3. **Unelected or Undisclosed Prior Art.** Reynolds will not argue that any of the following references are invalidating prior art to the applicable patents under 35 U.S.C. §§ 102 and/or 103.~~
 - ~~A. **U.S. Patent No. 10,104,911**~~
 - ~~• Any reference other than Xia (CA 2641869), Cho (KR 20 2009 0003871), Choi (KR 10 0933516), Han (U.S. Patent No. 8,156,944), Yang (CN 201123395Y), Shizumu (WO 01/39619 A1), Murphy (WO 2009/135729), and Egilmex (U.S. Patent No. 4,945,929)~~
 - ~~B. **U.S. Patent No. 6,803,545**~~
 - ~~• Any reference that was raised or could have been reasonably raised in IPR2021-00725, including all references cited in Reynolds' response to Interrogatory No. 2.~~
 - ~~C. **U.S. Patent No. 10,555,556**~~
 - ~~• Any reference that was raised or could have been reasonably raised in IPR2021-00585, including all references cited in Reynolds' response to Interrogatory No. 2.~~

~~D. U.S. Patent No. 10,420,374~~

- ~~• Any reference other than Pan (U.S. Patent No. 8,205,622), McLaughlin (U.S. Patent No. 8,661,910), Gourlay (U.S. Patent App. Pub. No. 2005/0081639 A1), Liu 238 (CN201514238 U), and Liu 667 (CN 201482667 U).~~

- 41. Indefiniteness.** Reynolds will not present argument, evidence, or testimony that any claim term recited in the asserted patents is indefinite under 35 U.S.C. § 112(b). Reynolds, however, reserves the right to introduce evidence consistent with the Court’s claim-construction rulings, including without limitation the plain and ordinary meaning of claim terms. Reynolds also preserves its right to challenge the Court’s claim-construction rulings after trial and on appeal to the extent those rulings rejected Reynolds’s proposed claim constructions.
- 52. IPR Proceedings.** No party will reference the *inter partes* review (“IPR”) proceedings involving the Asserted Patents. ~~Reynolds will not pursue any ground that Reynolds raised or could have reasonably raised in IPR proceedings involving the ’545 and ’556 Patents, including any reference to prior art based invalidity as to those patents.~~
- 63. Disparaging the Patent Office.** No party will present argument, evidence, or testimony disparaging the United States Patent and Trademark Office (“Patent Office”) or its examiners. This agreement does not preclude Reynolds from referencing the fact that certain prior art references may not have been considered by the Patent Office during prosecution of the asserted patents.
- 74. Jury Studies and Shadow Juries.** No argument, evidence, or testimony regarding: (1) any jury study or focus study groups that the parties have conducted ~~and~~, (2) the use by any party of a shadow jury during trial, and (3) the use by any party of jury consultants.
- 85. Sidebar Comments at Depositions.** No references to objections or sidebar comments by counsel during depositions.
- 96. Testimony on Invalidity Defenses.** Dr. Blalock will not provide testimony at trial regarding alleged lack of written description, enablement, or inequitable conduct.
- 7. Motions in limine and Excluding Evidence.** No evidence or argument relating to motions in *limine*, that the Court has made a ruling in response to motions in *limine*, suggesting or inferring that the parties have moved to prohibit proof, or that the Court has excluded proof on any particular matters.
- 8. Objections.** No reference to any objections made by the parties in answers to interrogatories, responses to requests for production, hearings, depositions, or at trial.

Dated: January 11, 2022

Respectfully submitted,

/s/

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