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

ORAL ARGUMENT REQUESTED

[redacted]

PMI/ALTRIA'S OPPOSITION TO RJR'S MOTION *IN LIMINE* NO. 6

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RJR'S MIL #6: PMI/Altria Should Be Allowed To Reference The Lack Of An Opinion Of Counsel And Legal Advice If RJR Opens The Door At Trial

RJR seeks to preclude references to opinions of counsel under 35 U.S.C. § 298. But "[t]he protection granted by 35 U.S.C. § 298 dissolves in the event [RJR] open[s] the door by attempting to … imply[] that they relied on the advice of counsel."[1] *Hologic, Inc. v. Minerva Surgical, Inc.*, No. 15-cv-1031, 2018 WL 3348998, at *2 (D. Del. July 9, 2018); *Ultratec, Inc. v. Sorenson Commc'ns, Inc.*, No. 13-cv-346, 2014 WL 4976596, at *2 (W.D. Wis. Oct. 3, 2014) (same). Here, PMI/Altria does not intend to support its inducement or willfulness claims by relying on the lack of advice of counsel, so long as RJR does not suggest at trial that it relied on legal advice, sought or obtained an opinion of counsel, or otherwise had some good faith belief of non-infringement.

PMI/Altria explained its position to RJR, who refused to provide such confirmation and seeks to have its fact witnesses provide testimony [redacted].[2] *See* Ex. A. If RJR's lawyers or witnesses make such a suggestion, PMI/Altria should be permitted to raise RJR's failure to obtain a ***competent legal*** opinion and to otherwise challenge the good-faith basis and competency of any non-infringement opinions, lay or otherwise. For example, should an RJR fact witness offer testimony that RJR had a good faith belief of non-infringement, PMI/Altria should be able to challenge the competency of such opinion, including through cross-examination that such witness is not a lawyer, is not competent to analyze infringement, and that RJR never obtained any competent opinion from counsel, thus negating the purported "good faith" of any such belief.

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

[2] RJR represents that "[t]he parties were unable to reach a resolution on these issues," Dkt. 839 at 2, but fails to inform the Court that RJR never proposed a stipulation or even followed up after PMI/Altria confirmed it would not rely on the lack of an opinion to prove inducement or willfulness at trial so long as RJR does not make arguments implying otherwise to the jury.

RJR apparently intends to have its employees testify about [redacted], [redacted]. Dkt. 895-18 (6/24/21 Figlar Dep.) at 10:1-22, 11:1-13; Ex. B (6/24/21 Figlar Dep.) at 83:19-84:5 [redacted] While these improper lay opinions should be excluded for the reasons in PMI/Altria's MIL #7, Dkt. 895 at 10-11, RJR should not be permitted to "dress up" lay legal opinions of non-infringement as non-lawyer fact testimony and leave PMI/Altria unable to rebut the competence or "good faith" of such lay opinions. Allowing such implications, without allowing PMI/Altria to (i) explain to the jury that RJR never sought or produced a competent legal opinion of counsel or (ii) test the *bona fides* of RJR's purported "good faith," would present a serious risk that the jury would erroneously presume that RJR had a competent "opinion" that it did not infringe. It would also hamstring PMI/Altria's ability to challenge RJR's purported lay opinion by demonstrating that, if it truly had the courage of those convictions, RJR would have obtained a legal opinion and waived privilege. Such a result would be "manifestly unfair" to PMI/Altria. *See Broadcom Corp. v. Qualcomm Inc.*, 543 F.3d 683, 699 (Fed. Cir. 2008) ("It would be manifestly unfair to allow opinion-of-counsel evidence to serve an exculpatory function ... and yet not permit patentees to identify failures to procure such advice as circumstantial evidence of intent to infringe."). That is why courts allow patentees to explore and expose the absence of a competent opinion of counsel in situations like this. *See, e.g.*, *Dentsply Sirona Inc. v. Edge Endo, LLC*, No. 17-cv-1041, 2020 WL 6392764, at *5 (D.N.M. Nov. 2, 2020) (denying MIL and allowing plaintiff to argue that defendant had "an obligation to obtain an opinion from counsel prior to launching the [accused product]," finding Section 298 did "not apply" because "defendants have opened the door"); *Pac. Biosciences of Cal., Inc. v. Oxford Nanopore Techs., Inc.*, No. 17-cv-275, 2020 WL 954938, at *1 (D. Del. Feb. 27, 2020)

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