

**PUBLIC VERSION**

**UNITED STATES INTERNATIONAL TRADE COMMISSION  
WASHINGTON, DC**

**Before The Honorable Clark S. Cheney  
Administrative Law Judge**

**In the Matter of**

CERTAIN TOBACCO HEATING  
ARTICLES AND COMPONENTS  
THEREOF

Investigation No. 337-TA-1199

**Public Version of  
Motion Number 1199-002**

**COMPLAINANTS' MOTION FOR LEAVE TO AMEND  
THE COMPLAINT AND NOTICE OF INVESTIGATION  
TO ADD CLAIM 3 OF THE '915 PATENT**

Pursuant to 19 C.F.R. §§ 210.14(b)(1) and 210.15, Complainants move to amend the Complaint and Notice of Investigation to assert infringement of claim 3 of U.S. Patent No. 9,930,915 (“the ’915 patent”). As set forth in detail in the attached Memorandum of Points and Authorities, good cause exists pursuant to 19 C.F.R. § 210.14(b)(1) to make this amendment.

**GROUND RULE 5.1 CERTIFICATION**

Pursuant to Ground Rule 5.1, counsel for Complainants certifies that it provided notice of this motion to Respondents and Commission Investigative Staff (“Staff”) at least two business days prior to filing this motion. The Parties and Staff met and conferred on June 7, 2020 regarding the substance of this motion, as well as in email correspondence thereafter, but were unable to reach a resolution. Complainants understand that Respondents and Staff will state their positions after reviewing the papers filed.

Accordingly, Complainants respectfully request that the Administrative Law Judge issue an Initial Determination granting this Motion.

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Dated: July 13, 2020

Respectfully submitted,

*/s/ David M. Maiorana*

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**MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF  
MOTION FOR LEAVE TO AMEND THE COMPLAINT AND NOTICE OF  
INVESTIGATION TO ADD CLAIM 3 OF THE '915 PATENT**

Pursuant to 19 C.F.R. §§ 210.14(b)(1) and 210.15, Complainants hereby submit this memorandum of points and authorities in support of their motion to amend the Complaint and Notice Investigation to assert claim 3 of U.S. Patent No. 9,930,915 (“the ’915 patent”).

**I. INTRODUCTION**

Good cause exists for allowing Complainants to assert infringement of dependent claim 3 of the ’915 patent in this Investigation. That claim is already at issue in this Investigation as Complainants rely on it for purposes of establishing a domestic industry, and Respondents have served invalidity contentions challenging the validity of claim 3. Furthermore, Complainants already assert infringement of claims 1, 2, and 5 of the ’915 patent against Respondents, and claim 3 would add only a single additional limitation. Moreover, each product Complainants seek to accuse of infringing claim 3 is already accused of infringing claims 1, 2, and 5. Accordingly, adding claim 3 would not require any modification to the scope of discovery, and it is in the public interest to include all of these claims in a single proceeding.

In addition, Complainants have not delayed in seeking leave to assert claim 3. The information giving rise to the assertion of claim 3 could not reasonably have been obtained

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before filing suit. In particular, Complainants conducted a reasonable pre-suit investigation of the IQOS<sup>®</sup> system with respect to claim 1, from which claim 3 depends. That investigation included purchases, tear downs, and analyses of the IQOS<sup>®</sup> system based upon information and materials in the public domain. The necessary information to confirm infringement of claim 3, however, became available only through the course of discovery, in the form of confidential documents produced by Respondents. Respondents did not provide those documents until June 12, 2020, as part of a production that contained nearly two million pages. Complainants began their review of those documents immediately, and have filed this motion as quickly as practicable.

Meanwhile, particularly in light of claim 3's close relationship to the claims already asserted, the requested amendment does not prejudice Respondents. In fact, Complainants have included claim 3 in their initial infringement contentions, and Respondents have already challenged the validity of claim 3 in their initial invalidity contentions, as well in a separate *inter partes* review (IPR) petition, further making clear that permitting Complainants to assert this claim does not prejudice Respondents in any respect and will not present issues requiring any procedural schedule changes.

Accordingly, for all of these reasons, leave to amend the Complaint and Notice of Institution of Investigation to permit assertion of claim 3 of the '915 patent should be granted.

## II. BACKGROUND

The Complaint in this Investigation was filed on April 9, 2020. As to the '915 patent, the Complaint asserts infringement of claims 1, 2, and 5, and it included claim 3 in the domestic industry analysis. *See* Complaint ¶¶ 2, 120 & Ex. 44. The Commission issued the Notice of Investigation on May 11, 2020.

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On June 12, 2020, as part of the discovery in this Investigation, Respondents produced nearly two million pages of documents. Those documents included information—not publicly available—demonstrating Respondents’ infringement of claim 3 of the ’915 patent. Accordingly, on July 2, 2020, in light of their review of those documents, Complainants informed Respondents of their intent to assert infringement of claim 3 in this Investigation. Consistent with that intent, Complainants included claim 3 with the initial infringement contentions they served that same day. Respondents’ initial non-infringement contentions are not due until July 23, 2020, and the parties do not exchange claim terms for construction until July 27, 2020.

Meanwhile, on June 12, 2020—the same day they produced documents revealing their infringement of claim 3—Respondents filed an IPR petition challenging the validity of the ’915 patent, including claim 3. *See Philip Morris Products, S.A. v. RAI Strategic Holdings, Inc.*, No. IPR2020-01094 (petition filed by Respondent Philip Morris Products, S.A. on June 12, 2020, and identifying itself and additional Respondents Philip Morris International, Inc., Altria Client Services LLC, and Philip Morris USA as real parties-in-interest, and further noting that the final Respondent Altria Group, Inc. has agreed to estoppel arising from the IPR). In their petition, Respondents raise various arguments and asserted alleged prior art references challenging the validity of ’915 claim 3. And on July 2, 2020, Respondents served their initial invalidity contentions in this Investigation, which included contentions directed at claim 3 of the ’915 patent.

On July 7, 2020, Complainants, Respondents, and Commission Investigative Staff (“Staff”) conferred regarding Complainants’ intent to seek leave to assert claim 3 in this Investigation. After further email correspondence, the Parties have been unable to reach a

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