

Philip Morris Blows Out Another Vaping Patent At The PTAB

By **Andrew Karpan**

Law360 (January 11, 2022, 6:26 PM EST) -- The Patent Trial and Appeal Board has sided with Philip Morris in a ruling that wiped out remaining claims in a vaping cartridge patent owned by R.J. Reynolds' parent company and also asserted in an infringement lawsuit over the IQOS cartridge brand.

The Monday ruling from the PTAB axed all of the claims challenged in a patent owned by RAI Strategic Holdings, following a post-grant review petition from rival Philip Morris Products SA.

RAI accused Altria Group Inc. — the Philip Morris spinoff that's also behind the Marlboro and IQOS brands — of infringing the patent, among others, in a lawsuit the company filed in Virginia federal court in 2020.

Lawyers from Philip Morris were able to convince the patent board that claims in the RAI patent on vaping cartridges, issued by the patent office in 2019, would have been obvious to those in the industry. In part, they successfully argued this was because of an older type of vaping cartridge that RAI's R.J. Reynolds secured a patent in 2010 could be combined with an electrically heated smoking system that Philip Morris secured a patent on in 2011.

Incidentally, RAI has accused Philip Morris of infringing the 2010 patent in the ongoing Virginia lawsuit as well. A jury trial in that case is currently scheduled to take place this April in U.S. District Judge Liam O'Grady's courtroom in Alexandria.

In addition to successfully citing the older patents, Philip Morris had luck arguing that two other claims in the RAI patent were not actually supported by language used elsewhere in the patent. A number of remaining claims were also disclaimed by RAI before last year's patent board hearing went down.

Curiously, no transcript of that hearing exists, the board noted, "due to an error." Nonetheless, the board had concluded that nowhere in the law are they prevented from still handing down an opinion.

"We determine that claims 10 and 27 are unpatentable for lack of written description support," Administrative Patent Judge Jeff Abraham had added. He went on to detail the lack of clarity articulated by the patent's inventors regarding the length of the heaters used by the vaping cartridge.

R.J. Reynolds spokeswoman Kaelan Hollon told Law360 in an email Tuesday that the company "will evaluate our options for appeal." It's not the first patent involved in the Virginia lawsuit that Philip Morris has successfully challenged at the PTAB.

Back in November, a patent board consisting of two of the same judges that handed down Monday's decision wiped out claims in a different RAI patent that covered a charging case for vaping devices.

Hollon, the R.J. Reynolds spokeswoman, however, drew attention to an infringement ruling the company landed at the U.S. International Trade Commission last September, over two different patents RAI asserted against Philip Morris and alleged were used in Morris' IQOS products.

"The PTAB decision has no impact on Reynolds's successful enforcement of two patents in the International Trade Commission against Philip Morris, which resulted in the entry of an exclusion order blocking cigarette giants Philip Morris and Altria from importing IQOS products into the U.S.," Hollon wrote.

Representatives for Philip Morris did not respond to a request for comment on the ruling.

The patent-in-suit is U.S. Patent No. 10,492,542.

Administrative Patent Judges Jeff Abraham, Elizabeth Roesel and Michelle Nerozzi-Ankenbrand sat on the panel.

Philip Morris is represented by Jonathan M. Strang, Matthew J. Moore, Dale Chang and Lawrence J. Gotts of Latham & Watkins LLP.

RAI Strategic Holdings is represented by David M. Maiorana, Anthony M. Insogna, Kenneth S. Luchesi, Geoffrey K. Gavin, Joshua R. Nightingale, George N. Phillips and David Cochran of Jones Day.

The case is Philip Morris Products SA v. RAI Strategic Holdings Inc., case number PGR2020-00071, before the Patent Trial and Appeal Board.

--Additional reporting by Adam Lidgett and Sarah Jarvis. Editing by JoVona Taylor.