

United States District Court,
D. Maryland, Southern Division.

STAR SCIENTIFIC, INC,
Plaintiff.

v.

R.J. REYNOLDS TOBACCO COMPANY,
Defendant.

March 31, 2004.

Richard Mcmillan, Jr., Jonathan H. Pittman, Kathryn D. Kirmayer, Mark Michael Supko, Crowell and Moring LLP, Washington, DC, Andrew Jay Graham, Kramon and Graham PA, Baltimore, MD, for Plaintiff.

Barry Jay Rosenthal, Bromberg Rosenthal LLP, Rockville, MD, Dominic P. Zanfardino, Howard S. Michael, Justin B. Rand, Richard A. Kaplan, Robert G. Pluta, Abby L. Lerneck, Cynthia Ann Homan, Danielle Anne Phillip, Harold V. Johnson, Jeffry M. Nichols, Jerold A. Jacover, K. Shannon Mrksich, Patricia Leahu, Ralph Joseph Gabric, Robert Mallin, Brinks Hofer Gilson and Lione, Chicago, IL, August J. Borschke, RJ Reynolds Tobacco Co., Senior Counsel, Winston Salem, NC, David B. Hamilton, Womble Carlyle Sandridge and Rice PLLC, Baltimore, MD, Leonard Samuel Goodman, Venable LLP, Rockville, MD, for Defendant.

ORDER

ALEXANDER WILLIAMS, JR., District Judge.

On February 23, 2004, the Court received a Report and Recommendation from Special Master Philip G. Hampton [Paper No. 428] regarding Defendant R.J. Reynolds Tobacco Company's ("R.J.Reynolds") Motion for Summary Judgment No. 4 (Invalidity Based On The Prior Art) [Paper No. 274]. The Special Master recommended that the Court enter an order denying R.J. Reynolds's motion for summary judgment that the patents-in-suit are invalid under various subsections of 35 U.S.C. s. 102 in light of the prior art presented by R.J. Reynolds.

After *de novo* review of the entire record, including the Special Master's Report and Recommendation, Star Scientific's filed objections [439], R.J. Reynolds's filed objection [443], Star Scientific's response to R.J. Reynolds's filed objection [450], and R.J. Reynolds's response to Star Scientific's filed objections [454], the Court finds that the Special Master fully considered the pleadings and supporting documents and carefully applied the law to the relevant facts. The Court agrees with the Special Master that since R.J. Reynolds did not show that the Burton Letter discloses each and every claim limitation of the asserted claims, R.J. Reynolds did not meet its initial burden by a showing of clear and convincing evidence that the patents-in-suit are anticipated under 35 U.S.C. s. 102(f). The Court further agrees that even if R.J. Reynolds had met its burden, there were genuine issues of material fact as to whether the Burton letter disclosed each and every limitation of the asserted claims. Furthermore, the Court agrees with the Special Master that since R.J.

Reynolds failed to provide clear and convincing evidence that the Brown Method satisfies each and every claim limitation of the asserted claims, the burden did not shift to Star Scientific to present evidence tending to show that there are genuine issues of material fact regarding anticipation under 35 U.S.C. s. 102(b). The Court also agrees with the Special Master that R.J. Reynolds does not present clear and convincing evidence of invalidity to support its motion for summary judgment under 35 U.S.C. s. 102(e), and that Star Scientific provides specific facts showing that genuine issues of fact remain for a trier of fact as to whether the Peele Applications actually describe the limitations of the asserted claims.

Therefore, IT IS this 30th day of March, 2004, by the United States District Court for the District of Maryland, hereby **ORDERED**:

1. That the Report and Recommendation dated February 23, 2004[428] BE, and the same hereby IS, **ADOPTED** *in toto*; AND;

2. Defendant R.J. Reynolds Tobacco Company's ("R.J.Reynolds") Motion for Summary Judgment No. 4 (Invalidity Based On The Prior Art) [Paper No. 274] BE, and the same hereby IS, **DENIED**; AND;

3. That the Clerk of the Court mail copies of this Order to all counsel of record.

D.Md.,2004.

Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.

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