

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOM Enterprises, LLC,
Petitioner,

v.

ELAINE AND REINHOLD W. VIETH,
Patent Owners,

Case IPR 2023-00726
Patent 9,066,958

**PATENT OWNERS' SUR-REPLY BRIEF AUTHORIZED BY
THE BOARD UNDER 37 CFR § 42.5**

Petitioner recognized its failure to meet the statutory threshold for institution and sought permission to file five additional declarations. The Board denied Petitioner's request to submit supplemental evidence and ordered that "neither party is authorized to file any additional evidence with its brief." Paper 7 at 3. Despite this clear limitation, Petitioner's reply is replete with unverified and unsupported additional evidence. The Board should reject these unauthorized submissions. Regardless, Petitioner's Reply does not solve the deficiencies in its Petition. The three declarations – MOM-1005 ("Munford"), MOM-1007 ("Sherman"), and MOM-1009 ("Liu") – are insufficient on their face to meet the threshold standard. As established in the POPR, the Board should refuse to institute *inter partes* review.

Petitioner attempts to distinguish *Shenzhen Aurora Tech. Co. Ltd. v. Potco, Inc.*, IPR 2020-00670, Paper 10, (PTAB August 27, 2020) on the grounds that its translations here were prepared by humans. *Shenzhen* does not express a rule limited to machine translations. It stands for the proposition that incomplete translations or translations lacking proper affidavits attesting to their accuracy do not satisfy the standard. *Id.* at 5-6. Whether they were made by humans or machines is irrelevant.

Petitioner impermissibly adds new factual assertions regarding Sherman's alleged qualifications and responsibilities. *See* Reply at 2. Sherman's declaration does NOT state anything regarding his qualifications or supervision of translators. The signature block under his name provides Sherman's title, but not his

qualifications or responsibilities. See MOM-1007. Sherman never affirmed that he is competent to attest to the accuracy of a German translation; he provided no indication of his German language skills or qualifications. See MOM-1007. The Board should not countenance Petitioner's clear violation of its Order.

Petitioner has not complied with 37 C.F.R. §42.63(b). No declaration was submitted by Tinworth, who apparently prepared a different translation. Contrary to Petitioner's argument, Tinworth's translation must not be an "accurate" translation; if it was, there would be no need for Petitioner to submit Sherman to add "*more accurate*" words. MOM-1007, ¶3 (emphasis added). Petitioner cannot escape the fact that Sherman only attests to two words of Harder as being "more accurate." There is no affidavit attesting to the accuracy of any part of Tinworth's translation.

Liu's declaration is also deficient. Petitioner again includes new facts regarding Liu's alleged qualifications in its Reply. See Reply at 2. Liu does not disclose "years working in Germany at a biotechnology company, and since then, work as a translator ..." *Id.* The Board should reject Petitioner's violation of its Order.

Contrary to the position of Petitioner, Liu's declaration does not establish his capacity to attest to the accuracy of the translation. His stated education does not suggest any knowledge of the German language. He merely "worked in Germany following [his] studies." MOM-1009, ¶3. Petitioner's reliance on *Intel Corp. v. VLSI Tech. LLC*, IPR2018-01040, Paper 15 at 36-37 (PTAB Feb. 13, 2019), a non-

precedential decision, is misplaced. In *Intel*, the Board rejected an evidentiary challenge to the translation. In contrast, Patent Owners are making a threshold challenge to Liu because he has NOT established his competency to provide an accurate translation. Petitioner has not met the statutory threshold of a likelihood of success because it has not shown that an essential reference to the asserted grounds is available as prior art. MOM recognizes Liu's lack of foundation, but the Board's Order precludes its attempt to improperly supplement his qualifications. Liu does not satisfy the 37 C.F.R. §42.63(b) threshold burden.

Recognizing the weakness of its position, Petitioner contends Patent Owners should challenge admissibility after institution or it could submit "supplemental information after institution to address any challenges...." Reply at 3. However, it is Petitioner's burden to meet the threshold for each element of the grounds prior to institution; Patent Owners have no burden at this stage. *See* 35 U.S.C. §§ 312, 314. *Hulu v. Soundview Innovations, LLC*, IPR2008-01039, Paper 29 (PTAB December 29, 2019), does not suggest otherwise. A petition may be considered only if it identifies *with particularity* the grounds for institution, proper evidence supporting such grounds, and information required by the regulations. 35 U.S.C. §312. *See Hulu*, Paper 29 at 13. The regulations require "an affidavit attesting to the accuracy of the translation" of a non-English document. 37 C.F.R. §42.63(b). Petitions filed without proper affidavits do not meet the statutory threshold for institution.

Petitioner has not established the Harder reference was publicly available prior to the critical date. Munford is virtually identical to the declaration in *Microsoft Corp. v. Throughputter, Inc.*, IPR2022-01566, Paper 13 (PTAB May 31, 2023). Again, Petitioner ignores the Board’s Order and makes unsupported attorney arguments that Harder has a particular copyright date and is “a textbook of a major publisher.” It points to MOM-1006, pages 1-3, however, Petitioner provided no translation of the cited pages.

Petitioner does not rebut the fact that the MARC Record for Harder did not exist until 2021, well after the critical date. *See* MOM-1005, page 35, field 005. Petitioner also ignores the distinction between public accessibility and technical accessibility. Munford only claims that Harder was made available in 2003. The declaration at most asserts facts to support “technical accessibility,” not public accessibility. Similarly, MOM-1005, page 35, field 005, at best shows technical accessibility in 2021. The facts do not establish technical accessibility by the critical date of Sept. 14, 2005, because the MARC record did not exist prior to 2021.

Petitioner relies on *VidStream LLC v. Twitter, Inc.*, 981 F.3d 1060 (Fed. Cir. 2020), *Samsung Elecs. Co. v. Infobridge Pte. Ltd.*, 929 F.3d 1363 (Fed. Cir. 2019), and *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186 (Fed. Cir. 2008). However, those cases support Patent Owners’ position and recognize that public accessibility is considered on a case-by-case basis; all rely on evidence not contained

in the record here. *VidSteam*, 981 F.3d. at 1064, relied on evidence that the MARC record content was searchable prior to the critical date, archived Amazon catalog pages and Internet Archive information, and a copyright registration (not just a printed copyright date). *Samsung*, 929 F.3d at 1373-4, remanded the matter to the Board to consider if accessibility was established by an email distribution of the reference to a listserv that included 254 “interested individuals.” *SRI Int’l*, 511 F.3d at 1097-98, remanded for a determination of whether a paper posted on an ftp server was publicly accessible. There is no overlap between the present question and *SRI*. Unlike the cases cited by Petitioner, *Microsoft* is on all fours with the facts of this case. The Board should follow the reasoning of *Microsoft*.

The Reply makes the unsupported argument that “postnatal care methods” and “postpartum care” could be used by “an interested researcher” to find Harder. Nothing in MOM-1005 says that those terms were searchable or present before the critical date. MOM-1005 also does not show that a person of ordinary skill could have located Harder at the relevant time through reasonable diligence. In fact, MOM-1005 does not even mention the level of ordinary skill in the art. Petitioner makes no effort to explain how such a person could have technically found Harder or how reasonable diligence could have resulted in discovery even if the over-generalized terms were searchable before the critical date. *See* POPR at 34.

The Board therefore should deny the Petition.

Dated: August 25, 2023,

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that the foregoing Patent Owners' Sur-Reply Brief is being served on August 25, 2023, by filing this document through the Patent Trial and Appeal Case Tracking System (P-TACTS) and by electronic mail as directed by Petition upon the following counsel of record for Petitioners:

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