

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOM ENTERPRISES, LLC,
Petitioner,

v.

ELAINE AND REINHOLD W. VIETH,
Patent Owner.

IPR2023-00726
Patent 9,066,958 B2

Before JOHN G. NEW, SHERIDAN K. SNEDDEN, and
CYNTHIA M. HARDMAN, *Administrative Patent Judges*.

HARDMAN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

By emails dated October 16, 2023 and October 13, 2023, and pursuant to section A(1) of the Board’s Scheduling Order (Paper 11), Patent Owner and Petitioner respectively submitted requests for an initial conference call with the Board to discuss proposed motions that may be filed in this proceeding that are not authorized by the Scheduling Order or other Board rule or procedure. *See* Ex. 3002 (Patent Owner’s email request), 3003 (Petitioner’s email request). Each party submitted a list of proposed motions to be discussed during the call. *See* Ex. 3004 (Patent Owner’s List of Proposed Motions), Ex. 3005 (Petitioner’s List of Proposed Motions).

On October 27, 2023, the panel conducted a conference call with counsel for the parties, including Mr. Ungerman and Mr. Anderson¹ for Patent Owner, and Mr. Conrad for Petitioner. A court reporter was present, and Patent Owner agreed to file a copy of the transcript of the call as an exhibit in this proceeding upon receipt.

During the call, the panel and the parties discussed each item on the parties’ respective list of proposed motions. We summarize below the outcome of these discussions, and refer to the forthcoming transcript for a more complete discussion of the parties’ arguments and panel’s reasoning for the decisions indicated herein.

Patent Owner’s Proposed Motions

1. Patent Owner sought authorization to file a “Motion to Compel Routine Discovery under 37 C.F.R. § 42.51(b)(1)(iii) (i.e. Motion to Disclose Inconsistent Information), or alternatively, a Motion for Additional

¹ A motion for Mr. Anderson’s admission *pro hac vice* is pending. *See* Paper 12.

Discovery under 37 C.F.R. § 42.51(b)(2)(i)” to compel production of various categories of information, as follows:

a. Translations of Harder (Ex. 1006) and Wolf (Ex. 1008) and related materials: We understand that Petitioner agreed to produce the requested materials, to the extent they are in Petitioner’s possession, custody, or control. *See, e.g.*, Ex. 3002, 2. During the call, Petitioner agreed to produce the materials on a rolling basis, with the production to be completed within two weeks of the conference call (i.e., no later than November 10, 2023). In view of Petitioner’s agreement to produce these materials on a timeline acceptable to Patent Owner, we deny as moot Patent Owner’s request for authorization to file a motion to compel these materials.

b. Complete copies of Harder (Ex. 1006) and European Pharmacopoeia 4th Edition:² After considering the parties’ arguments, we authorized Patent Owner to file a motion to compel complete copies of these two documents. The briefing schedule and briefing limitations are set forth below in the Order.

Although the substance of Patent Owner’s arguments in this motion is left to Patent Owner’s discretion, Patent Owner may wish to consider explaining why, with citation to relevant authority, complete copies of these documents allegedly constitute routine discovery under 37 C.F.R. § 42.51(b)(1)(iii). Further, to the extent Patent Owner argues that the documents constitute additional discovery, Patent Owner may wish to

² Patent Owner’s original request also included a request for a complete copy of the European Pharmacopoeia Supplement 4.3 (Ex. 1010). On the call, Patent Owner’s counsel confirmed that Patent Owner already possesses a complete copy of Supplement 4.3. Accordingly, Patent Owner’s request as it relates to Supplement 4.3 is moot.

particularly explain why there is more than a mere possibility that something useful will be discovered in the complete copies of these documents, why Patent Owner cannot generate equivalent information by other means (e.g., by securing the complete copies itself from a library such as the National Library of Medicine), and why the requests are not overly burdensome to answer, particularly in view of Petitioner's representation that these materials are not presently in Petitioner's possession, custody, or control, and in view of Patent Owner's suggestion that to the extent Petitioner produces a complete copy of Harder, it must also produce an English-language translation of the entire book. *See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6–7 (PTAB Mar. 5, 2013) (precedential).

c. Evidence relating to objective indicia of non-obviousness, including certain sales data and market share information and certain documents relating to alleged copying: After considering the parties' arguments, the panel authorized Patent Owner to file a motion to compel these materials. The briefing schedule and briefing limitations are set forth below in the Order. To maintain clarity of the record, this motion shall be filed separately from the motion to compel authorized in paragraph 1.b above.

2. Motion to Compel Deposition Testimony of three of Petitioner's personnel (Ms. Kaderali, Ms. Medina, and Ms. Lloyd), on issues relating to alleged objective indicia of non-obviousness: We denied authorization to file this motion, without prejudice to renew this request. As discussed during the call, the panel currently views such a motion as premature, given that Patent Owner will be filing a motion to compel

documentation relating to the alleged objective indicia of non-obviousness. To the extent Patent Owner receives such documentation but still believes one or more of the depositions is necessary, Patent Owner may renew this request.

Regarding items 3 through 5 on Patent Owner's List (i.e., (3) "Motion to set schedule for Petitioner to serve Supplement Information under 37 C.F.R. § 42.123, schedule depositions, and comply with discovery requests;" (4) Motion for Protective Order; and (5) Motions for admission *pro hac vice*), Patent Owner agreed that we need not separately address these items at this time.

Petitioner's Proposed Motions

1. "Motion for Supplemental Information under 37 C.F.R. § 42.123(a)(1) to provide information supporting the accuracy of the translations (as applicable) and the public accessibility of the Petitioner's prior art" (Ex. 3005, 1): Patent Owner did not oppose this proposed motion. We authorized the motion. The briefing schedule and briefing limitations are set forth below in the Order.

2. "Motion to Compel Routine Discovery under 37 C.F.R. § 42.51(b)(1)(iii) (i.e. Motion to Disclose Inconsistent Information), or alternatively, a Motion for Additional Discovery under 37 C.F.R. § 42.51(b)(2)(i) to compel production of or permission to use all the documents produced by [D]r. Vieth in the underlying district court litigation, as well as any other documents that Patent Owner is aware of regarding Vigantol oil" (Ex. 3005, 1): After considering the parties' arguments, we authorized this motion. The briefing schedule and briefing limitations are set forth below in the Order. To maintain clarity of the record, this motion

shall be filed separately from the motion for supplemental information authorized in paragraph 1 above.

Although the substance of Petitioner's arguments in this motion is left to Petitioner's discretion, we note that to the extent Petitioner alleges such information constitutes routine discovery because it is inconsistent with a position advanced by Patent Owner (or in Dr. Vieth's declaration (Ex. 2008)) in this proceeding, Petitioner may wish to explain precisely how the specific requested documents are allegedly inconsistent with a specific position advanced in this proceeding.

3. Motion for Protective Order: The parties agreed that the Board need not separately address a proposed protective order at this time.

Regarding items 4 through 7 on Petitioner's list ((4) and (7) are Motions to Compel Live Deposition Testimony of Dr. Vieth and Mr. Temovsky; (5) and (6) are Motions for Additional Discovery and Supplemental Information relating to objective indicia of non-obviousness), Petitioner acknowledged, and we agree, that these motions are premature. We deny the requests for authorization to file the subject motions, without prejudice for Petitioner to renew these requests at the appropriate time if necessary.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner is authorized to file the following two motions: (1) a motion to compel production of complete copies of Harder and European Pharmacopoeia 4th Edition; and (2) a motion to compel production of certain sales data and market share information and certain

documents relating to alleged copying (as specified in Patent Owner's List of Proposed Motions, item 1(c));

FURTHER ORDERED that Petitioner is authorized to file the following two motions: (1) a motion to submit supplemental information under 37 C.F.R. § 42.123(a)(1) relating to the alleged accuracy of certain translations and the alleged public accessibility of Petitioner's asserted prior art; and (2) a motion to compel production of certain documents from the underlying district court litigation and certain documents relating to Vigantol oil (as specified in Petitioner's List of Proposed Motions, item 2);

FURTHER ORDERED that each of the above four motions shall be filed on or before November 9, 2023, and each motion shall not exceed 7 pages (excluding any proposed discovery requests, which shall be placed in an appendix to the motion);

FURTHER ORDERED that the opposing party is authorized to file, on or before November 20, 2023, an opposition to each motion, where each opposition shall not exceed 7 pages;

FURTHER ORDERED that neither party is authorized to file any additional evidence or exhibits in support of their briefs; and

FURTHER ORDERED that no additional briefing is authorized at this time.

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