

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.

Case IPR2023-00726
Patent 9,066,958

**PETITIONER'S UNOPPOSED MOTION TO SUBMIT SUPPLEMENTAL
INFORMATION PURSUANT TO 37 C.F.R. § 42.123(a)(1)**

TABLE OF SUPPLEMENTAL INFORMATION EXHIBITS

Exhibit No.	Description
MOM-1019	Declaration of Amy Tinworth
MOM-1020	Supplemental Declaration of David Sherman
MOM-1021	Declaration of Dr. Stephen Benyunes
MOM-1022	Supplemental Declaration of Simon Liu
MOM-1023	Supplemental Declaration of June Munford

Pursuant to 37 C.F.R. § 42.123(a), and under the authorization granted by the Board on October 30, 2023, Petitioner hereby moves to submit Exhibits MOM 1019-1023 as supplemental information. These Exhibits provide further testimony supporting: (1) the accuracy of the translations for Harder and Wolf, two of the primary references submitted by Petitioner, and (2) the public accessibility of Harder. For at least these reasons, these Exhibits are relevant to a claim for which trial has been instituted. Because both requirements of § 42.123(a) have been met, Petitioner respectfully requests that it be permitted to supplement the information in the record with these Exhibits. This Motion is unopposed.

I. BACKGROUND

Petitioner challenged the claims of U.S. Patent No. 9,066,958 on three grounds. All of the grounds assert obviousness based on Harder and Wolf. Both references were published before the '958 Patent's priority date and are in the German language. In support of its prior art, Petitioner submitted declarations from David Sherman and Simon Liu, attesting to the accuracy of the translations submitted, and from June Munford, supporting public accessibility of its prior art.

In their Preliminary Response, Patent Owners argued that Petitioner's declarations did not adequately attest to the accuracy of the translations. Patent Owners further alleged that Petitioner had not demonstrated the public accessibility

of Harder. *See* Paper 6 at 21, 24-25, 28-29. Specifically Patent Owners argued: (1) “Petitioner has not submitted any declaration from Amy Tinworth attesting to the accuracy of MOM-1007” (*Id.* at 24-25); (2) that the Harder translation is “inaccurate or manipulated” because Sherman added “the critical ‘to be licked off’ phrase,” to Tinworth’s original translation (*Id.* at 21); and (3) “[Liu] does not profess to have knowledge of the German language or [] translations services” (*Id.* at 26). As to the public accessibility of Harder, Patent Owners allege: (1) Munford’s assertion that the MARC record for Harder was created and that Harder was acquired, catalogued, and shelved on January 1, 2003, is questionable; (2) Munford’s declaration fails to attach the entire copy of Harder; (3) because the MARC record cited by Munford was revised on December 3, 2021, such MARC record cannot have existed as of its purported creation date; and (4) Petitioner has not shown that persons interested and ordinarily skilled in the subject matter exercising reasonable diligence could have located Harder at the relevant time. *See id.* at 28-29. The Board subsequently allowed further briefing on these issues, but Petitioner was not permitted to submit additional information prior to institution. *See* Papers 7-9.

On September 15, 2023, the Board instituted trial on all challenged claims based on all three grounds asserted. *See* Paper 10. The Board determined, based on

the current record, Petitioner had established “a reasonable likelihood that Petitioner would prevail in showing at least one of the challenged claims . . . is unpatentable.” The Board, however, noted that (1) Sherman’s declaration was “somewhat unusual in that it references Tinworth’s (missing) translation,” and that (2) Munford’s declaration contains a typographical error. Paper 10 at 27, 31.

Petitioner now seeks to submit supplemental information that will further demonstrate the accuracy of the translations submitted and the public accessibility of Harder. The parties have met and conferred about this request. Patent Owners indicated on an October 12 teleconference that they do not oppose the motion, and Petitioner has produced to Patent Owners the supplemental information it seeks to add to the record. The Board’s order states, “neither party is authorized to file any additional evidence or exhibits in support of its briefs,” so Petitioner has not attached this supplemental information to its motion. Paper 23 at 7.

II. ARGUMENT

A party may seek to submit supplemental information if: (1) “[a] request for the authorization . . . is made within one month of the date the trial is instituted” and (2) “[t]he supplemental information [is] relevant to a claim for which the trial has been instituted.” 37 C.F.R. § 42.123(a). To determine whether the moving party met its burden, the Board considers whether the information would: (1) “change the

grounds of unpatentability authorized in this proceeding” or “the evidence initially presented in the Petition to support those grounds of unpatentability”; (2) interfere with the “just, speedy, and inexpensive” resolution of the proceeding; or (3) otherwise prejudice the nonmoving party. *Palo Alto Networks, Inc v. Juniper Networks, Inc.*, IPR2013-00369, Paper 37 at 3-5 (P.T.A.B. Feb. 5, 2014).

A. Petitioner’s Motion is Timely, and the Supplemental Information is Relevant

Petitioner meets both requirements of § 42.123(a). First, Petitioner’s motion is timely. Petitioner requested authorization to file this Motion within one month of the September 15, institution date. Second, Petitioner’s supplemental information is unquestionably “relevant to a claim [at issue in] the trial” as described below.

1. Supplemental Information Relating to Harder is Relevant

To address any potential issue as to either foundation or accuracy of Petitioner’s translation of the Harder reference, Petitioner produced Tinworth’s declaration (MOM-1019) to Patent Owners. Tinworth’s declaration states her “translation is, to the best of [her] knowledge, a true, full, and accurate translation” of Harder. Given its relevance to the prior translation submitted, Petitioner requests that it be permitted to supplement the record with MOM-1019.

Further, in response to Patent Owners’ allegations relating to the adequacy of Sherman’s declaration, Petitioner requests authorization to supplement the

record with Sherman's supplemental declaration (MOM-1020). MOM-1020 clearly attests to the accuracy of what Sherman reviewed; establishes Sherman's competency as a translator; and provides support for why Sherman made a minor revision to Tinworth's translation.

Finally, to further confirm the accuracy of the translations prepared by Tinworth and Sherman, Petitioner retained another translator, Dr. Stephen Benyunes, to prepare an additional translation of Harder, along with a declaration attesting to its accuracy (MOM-1021). In his declaration, Benyunes: (1) declares that to the best of his knowledge he has prepared "a true, full, and accurate translation of the relevant excerpt from [] Section 15.9" of Harder, and (2) explains his competency to perform translations. Since Benyunes's declaration is relevant to establishing the disputed accuracy of the Harder translation previously submitted, Petitioner asks that it be permitted to supplement the record with MOM-1021.

2. Supplemental Information relating to Wolf is Relevant

Although there is nothing in Rule 42.63 that requires a translator to expressly attest to "hav[ing] knowledge of the German language of proficiency in translation services" as alleged by Patent Owners, Petitioner, in an abundance of caution, produced a supplemental declaration from Liu (MOM-1022) establishing Liu's competency and attaching all exhibits. Because MOM-1022 contains

information relevant to further establishing the accuracy of the Wolf translation that was previously submitted, Petitioner requests that the Board permit it to supplement the record with this Exhibit.

3. Supplemental Information Relating to the Public Accessibility of Harder is Relevant

Although Patent Owners' contentions relating to alleged deficiencies in Munford's declaration lack merit, Petitioner, nevertheless, asked Munford to prepare a supplement declaration (MOM-1023) in light of Patent Owners' concerns. MOM-1023 addresses the issues above that Patent Owners raised. Because MOM-1023 contains information that is relevant in further establishing the public accessibility of Harder, Petitioner requests that the Board permit it to supplement the record with this Exhibit.

B. Petitioner's Supplemental Information Satisfies the Other Factors Considered by the Board

First, the supplemental information does not change "the grounds of unpatentability authorized in this proceeding" or "the evidence initially presented in the Petition to support those grounds of unpatentability." *Palo Alto*, Paper 37 at 3. Rather, all of the information is relevant to a ground or claim already at issue, as it goes to the limited issues identified. Accordingly, there is no risk that the supplemental information would create new issues or be inconsistent with the

evidence already submitted with the Petition.

Second, the proposed supplemental information would not interfere with the “just, speedy, and inexpensive” resolution of the proceeding. *Palo Alto*, Paper 37 at 4. Accepting the Exhibits at this time would permit early and efficient briefing on these issues. In particular, it would allow the parties to brief these issues fully in the principal briefs, rather than having them play out piecemeal in motions to exclude. The current deadline for Patent Owners’ Response is not until December 6, 2023, and Patent Owners have yet to take any depositions; thus, allowing the information into the record would not disrupt the Board’s schedule.

Finally, there is no prejudice to Patent Owners in allowing the supplemental information. Until Patent Owners made their challenges in their Preliminary Response, there was no apparent need for this supplemental information. *See id.* Moreover, the information all speaks to the narrow questions of accuracy and public availability and consists of a small number of pages. Patent Owners have yet to take any deposition and should have no difficulty reviewing and responding to the information in the period allotted for its Response. *See id.* at 5. Petitioners are also amenable to extensions of Due Dates 1–3 to eliminate any potential prejudice.

III. CONCLUSION

Petitioner respectfully requests permission to submit MOM 1019-1023.

Date: Nov. 9, 2023

Respectfully submitted,

/David Conrad/

David Conrad, Reg. No. 60,788

Lance Wyatt, Reg. No. 68,837

Fish & Richardson P.C.

60 South Sixth Street

Minneapolis, MN 55402

T: 202-783-5070

F: 877-769-7945

Counsel for Petitioner

CERTIFICATE OF SERVICE

Pursuant 37 CFR § 42.6(e)(4), the undersigned certifies that on November 9, 2023, a complete and entire copy of this PETITIONER'S UNOPPOSED MOTION TO SUBMIT SUPPLEMENTAL INFORMATION, were provided via email, to the Patent Owner by serving the email correspondence addresses of record as follows:

Mark E. Ungerman, Reg. No. 32,070
UNGERMAN IP PLLC
2305 Calvert Street, N.W.
Washington, DC 20008
Email: mungerman@ungermanip.com

Peter J. Davis, Reg. No. 36119
WHITEFORD, TAYLOR & PRESTON LLP
7 St. Paul St. Baltimore, MD 21202
Email: pdavis@whitefordlaw.com

Alan M. Anderson (pro hac forthcoming)
ALAN ANDERSON LAW FIRM LLC
Crescent Ridge Corporate Center
11100 Wayzata Blvd., Suite 545
Minneapolis, MN 55305
Email: aanderson@anderson-lawfirm.com

/Crena Pacheco/

Crena Pacheco
Fish & Richardson P.C.
60 South Sixth Street
Minneapolis, MN 55402
pacheco@fr.com