

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 IPR2023-00726
Patent 9,066,958

**PETITIONER'S MOTION TO COMPEL ROUTINE DISCOVERY, OR IN
THE ALTERNATIVE, ADDITIONAL DISCOVERY OF DOCUMENTS**

I. INTRODUCTION

Petitioner MOM Enterprises, LLC (“Petitioner” or “MOM”) respectfully moves the Board for an order compelling Patent Owner Reinhold W. Vieth to produce certain categories of documents, which he produced under protective order in *Ddrops Company, Reinhold Vieth, and Elaine Vieth v. MOM Enterprises, LLC, d/b/a Mommy’s Bliss*, C.A. No. 1:22-cv-00332-GBW (D. Del.) (the “District Court Litigation”), and which are highly pertinent to this proceeding and the ultimate invalidity of the ’958 Patent due to obviousness.¹ These documents include: (1) emails with other researchers concerning Vigantol Oil and with representatives of Merck, the manufacturer of Vigantol Oil; (2) prior art publications describing the administration of oral vitamin D preparations; (3) a laboratory notebook mentioning Vigantol Oil; and (4) a bottle of Vigantol Oil. These materials relate to the knowledge Dr. Vieth and others skilled in the art had regarding the composition and

¹ Although these categories should have been produced in the District Court Litigation, MOM’s motion requests all such documents should the production be incomplete. Known produced documents responsive to this motion include:

R.VIETH000-0000020, R.VIETH000-0000166, R.VIETH000-0000330,
R.VIETH000-0000375, R.VIETH000-0000378, R.VIETH000-0000379,
R.VIETH000-0000394, R.VIETH000-0000433.

method of administering Vigantol Oil before the September 2006 priority date for the '958 Patent. Patent Owners should have to produce such documents as routine discovery pursuant to 37 C.F.R. § 42.51(b)(1)(iii) because these documents contain information that is inconsistent with Patent Owners' positions in their Preliminary Response, *i.e.*, the statements Dr. Reinhold Vieth made in his declaration. *See generally* Ex. 2008. In the alternative, the Board should grant Petitioner's request for these documents as additional discovery pursuant to 37 C.F.R. § 42.51(b)(2) because doing so would be in the "interest of justice" under the *Garmin* factors.

II. PETITIONER'S REQUEST CONSTITUTES ROUTINE DISCOVERY

As part of its "routine discovery," Patent Owners "***must*** serve relevant information that is inconsistent with a position" it advanced in this proceeding. 37 C.F.R. § 42.51(b)(1)(iii) (emphasis added).

MOM's Petition is premised on Harder, a publication that instructs the reader on how to administer Vigantol Oil to babies. Harder states that Vigantol Oil contains vitamin D and medium chain triglycerides. *See* MOM-1007 at 4. Thus, at issue in this proceeding is what knowledge a hypothetical person of ordinary skill would already have had about the composition of Vigantol Oil, which may affect what Harder teaches. *Koninklijke Philips NV v. Google LLC*, 948 F. 3d 1330, 1337 ([T]he inquiry into whether any "differences" between the invention and the prior art would

have rendered the invention obvious to a skilled artisan necessarily depends on such artisan's knowledge.”)

Patent Owners argue that Harder does not teach the composition of Claim 1 because it allegedly fails to disclose the *actual* composition of Vigantol Oil. *See* Paper 6 at 33-34. Dr. Vieth's declaration alleges that the “actual composition [of Vigantol Oil] is not readily available[.]” Ex. 2008 at ¶ 8. But the documents Petitioner requests demonstrate that Dr. Vieth and others were well aware of the composition of Vigantol Oil and the use of medium-chain triglycerides years before the priority date of the '958 Patent.

There are additional inconsistencies. For example, Dr. Vieth claims that he “never seriously studied or worked with ‘Vigantol Oil,’” (*Id.*, ¶ 9), and that he “never used ‘Vigantol’ oil in connection with the research or preparation of the invention claimed in the '958 Patent” (*Id.*, ¶ 10). But the documents sought will show that Dr. Vieth worked with and studied with Vigantol Oil, knew the composition of Vigantol Oil, and was using medium-chain triglycerides with Vigantol Oil well before the September 2006 priority date for the '958 Patent. The documents sought show that other researchers in the field also worked with and studied with Vigantol Oil.

These documents are therefore directly inconsistent with Patent Owners' positions in their Preliminary Response, *i.e.*, the foregoing statements identified from Dr. Vieth's declaration. Accordingly, Patent Owners should be compelled as a

matter of routine discovery to produce these materials referencing Vigantol Oil that were produced in the District Court Litigation. *See* 37 C.F.R. § 42.51(b)(1)(iii).

III. IN THE ALTERNATIVE, ADDITIONAL DISCOVERY IS IN THE INTEREST OF JUSTICE

In the alternative, additional discovery should be ordered. The Board may grant additional discovery in an IPR when a party refuses to provide additional discovery if such discovery is “in the interest of justice.” 37 C.F.R. § 42.51(b)(2). In determining when a request for additional discovery is in the “interest of justice,” the Board considers the factors set forth in its precedential decision in *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001 (PTAB Mar. 5, 2013) (Paper 26) (precedential).

Factor 1: There is more than a possibility and mere allegation that the discovery sought by Petitioner exists and will be useful. *See id.* at 6. As discussed above, the specific categories of documents Petitioner requests exist and were already produced in the District Court Litigation, albeit under a protective order.

Further, Patent Owners argue in their Preliminary Response that Petitioner’s primary references, Harder and Wolf, do not disclose the composition of Vigantol Oil. *See* Paper 6 at 14 (“Wolf does not disclose the composition of Vigantol oil except to claim it is a pure vitamin D3 preparation”), 33 (“the composition of Vigantol oil is not described in Harder”), and 44 (“Petitioner has not provided any

reliable evidence of the composition of Vigantol oil”). The documents Petitioner is requesting will be useful in showing that a person of ordinary skill in the art would have already known the composition of Vigantol Oil as of the priority date of the ’958 Patent. Specifically, these documents show that Dr. Vieth and the researchers he worked with were aware of the composition of Vigantol Oil as of at least 2002. They show that the individuals that co-authored papers with Dr. Vieth were aware of the concentration of and use of medium-chain triglycerides with Vigantol Oil in studies. These documents also suggest that a person of ordinary skill in the art would have been familiar with the composition and administration of Vigantol Oil, similar to how they are familiar with the compositions and administration of other medications and supplements they distribute. This information is relevant to the arguments about Harder and Wolf Patent Owners have already made.

Factor 2: Petitioner’s request is narrowly tailored and does not seek Patent Owners’ litigation positions or the underlying basis for those positions. *See id.*

Factor 3: These documents are not publicly accessible, and Petitioner does not have the ability to generate equivalent information about Vieth’s specific awareness that is contained within the requested documents by other means. *See id.* Patent Owners suggest that they conducted years of research to come up with the invention disclosed in the ’958 Patent and dispute that Vigantol Oil has the same

composition as the composition disclosed in Claim 1. But the information in the requested documents shows otherwise.

Factor 4: Petitioner's discovery request is easily understandable. *See id.* at 6-7. Specifically, Petitioner is only requesting four specific categories for production: all (1) emails with other researchers and with representatives of Merck mentioning Vigantol Oil; (2) prior art publications mentioning the administration of oral vitamin D preparations; (3) a laboratory notebook mentioning Vigantol Oil; and (4) a bottle of Vigantol Oil. This request seeks specific documents and things that are clearly in the Vieths' possession, and that relate to the knowledge Dr. Vieth and others skilled in the art had regarding the composition and method of administering Vigantol Oil.

Factor 5: Petitioner's discovery request is not overly burdensome. *See id.* at 7. As stated above, Petitioner has only one request, and it is narrowly tailored and specifically described. Specifically, Petitioner seeks to compel the documents the Vieths produced in the District Court Litigation, which contain Dr. Vieth's lab notebooks, correspondence with third parties, and co-authored articles that reference Vigantol and establish the knowledge of a person of ordinary skill in the art during the relevant time period. Patent Owners can easily respond to this request because these documents appear to have already been produced by the Vieths with specific bates numbers, and amount to a small number of Plaintiffs' overall production. Further, both parties already have access to these documents Petitioner is requesting,

just not the permission to use them in this proceeding, so there would be no additional effort required by Patent Owners to produce these documents. Accordingly, no changes to the current schedule will be necessary to accommodate Petitioner's request.

Granting additional discovery relating to these documents is in the interest of justice because these documents are the direct evidence of the knowledge that persons of ordinary skill in the art had about the composition of Vigantol Oil before the priority date of the '958 Patent. As such, they are relevant in demonstrating obviousness based on the grounds asserted by Petitioner.

IV. CONCLUSION

For the forgoing reasons, Petitioner respectfully moves the Board for an order compelling Patent Owners to produce all: (1) emails with other researchers and with representatives of Merck mentioning Vigantol Oil; (2) prior art publications mentioning the administration of oral vitamin D preparations; (3) a laboratory notebook mentioning Vigantol Oil; and (4) a bottle of Vigantol Oil.

Date: Nov. 9, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on November 9, 2023, a complete and entire copy of this Motion, were provided via email, to the Patent Owners by serving the email correspondence addresses of record as follows:

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