

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

TABLE OF EXHIBITS

Exhibit Number	Description
2001	Docket Sheet: 1:22-cv-00332-GBW Ddrops Company et al v. MOM Enterprises, LLC, Gregory B. Williams, presiding, Date filed: 03/16/2022, Date of last filing: 06/22/2023. Accessed through PACER, June 23, 2023.
2002	CIVIL DOCKET FOR CASE #: 0:15-cv-03981-WMW-SER, U.S. District Court, U.S. District of Minnesota (DMN), Accessed through PACER, June 23, 2023.
2003	CIVIL DOCKET FOR CASE #: 0:16-cv-04278-JNE-TNL, U.S. District Court, U.S. District of Minnesota (DMN), Accessed through PACER, June 23, 2023.
2004	Declaration of Chris Temovsky
2005	Claim Construction Order, Case 1:22-cv-00332-GBW, Ddrops Company et al v. MOM Enterprises, LLC, Gregory B. Williams, presiding, D.I. 72, Filed 06/02/23
2006	MARC STANDARDS, Library of Congress Network Development and MARC Standards Office, MARC 21 Format for Bibliographic Data, https://www.loc.gov/marc/ last accessed June 23, 2023
2007	U.S. Bureau of Labor Statistics, Occupational Outlook Handbook, Interpreters and Translators, https://www.bls.gov/ooh/media-and-communication/interpreters-and-translators.htm , last accessed June 23, 2023.
2008	Declaration of Reinhold Vieth
2009	Declaration of Warren D. Woessner
2010	Transcript of Markman Hearing, June 1, 2023, Case No. 1:22-cv-00332-GBW Ddrops Company et al v. MOM Enterprises, LLC, Gregory B. Williams, presiding
2011	Oxford English Reference Dictionary, 2 nd Edition, the Oxford University Press, 1996 (Definitions of adhere and viscosity)
2012	DECLARATION IN SUPPORT OF PATENT OWNERS' MOTION FOR PRO HAC VICE ADMISSION OF ALAN M. ANDERSON

2013	DECLARATION IN SUPPORT OF PATENT OWNERS' MOTION FOR PRO HAC VICE ADMISSION OF L. REAGAN FLORENCE
2014	DECLARATION IN SUPPORT OF PATENT OWNERS' MOTION FOR PRO HAC VICE ADMISSION OF MATTEW PALEN
2015	Transcript of 27 Oct. 2023 Board Conference Call
2016	Protective Order, Case 1:22-cv-00332-GBW, Ddrops Company et al v. MOM Enterprises, LLC, Gregory B. Williams, presiding, D.I. 25, Entered August 25, 2022.
2017	Anderson Declaration In Support of Patent Owners' Motion for Additional Discovery

This Memorandum is submitted on behalf of Patent Owners in opposition to Petitioner's Motion to Compel Routine Discovery, or in the Alternative, Additional Discovery of Documents. Petitioner asks the Board to compel Patent Owners to produce documents responsive to four broad categories: "(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." Paper 27 at 7. According to Petitioner, "These materials relate to the knowledge Dr. Vieth and others skilled in the art had regarding the composition and method of administering Vigantol Oil before the September 2006 priority date for the '958 Patent." *Id.* at 1-2. Petitioner claims that it is entitled to such documents as routine discovery pursuant to 37 C.F.R. §42.51(b)(1)(iii), or in the alternative as additional discovery pursuant to 37 C.F.R. §42.51(b)(2). *Id.* at 2.

The Board should deny Petitioner's motion in its entirety. The requested documents are not routine discovery, and alternatively, do not satisfy the framework established by *Garmin Int'l, Inc. v. Couzzo Speed Technologies LLC*, IPR2012-00001, Paper 26 at 6-7 (PTAB Mar. 5, 2013). Moreover, Petitioner's requests are premature. It has no need for any of the requested documents at this time, before Patent Owners have filed their formal response to the petition.

The requested documents are not routine discovery because they are not inconsistent with any position advanced by Patent Owners. Petitioner asserts that the requested documents would be inconsistent with paragraph 8 of Dr. Vieth's declaration. Paper 27 at 3. But Petitioner conveniently omits a critical part of Dr. Vieth's statement. He declared, "One cannot readily obtain a sample, and its actual composition *is not readily available or listed on the product packaging.*" Ex. 2008, ¶8 (emphasis added). Petitioner did not include the italicized portion of Dr. Vieth's sentence in its memorandum. The overly-broad document requests will not disclose documents that contradict Dr. Vieth's statement. And whether or not "others were well aware" of the composition of Vigantol Oil and the use of medium-chain triglycerides (Paper 27 at 3), even if true, would not be inconsistent with any statement by Dr. Vieth. And at this stage of the proceeding is premature and not useful.

Petitioner also claims its overly-broad document requests will provide documents inconsistent with Dr. Vieth's statements in paragraphs 9 and 10 of his declaration. *Id.* But again, the documents requested are not inconsistent with Dr. Vieth's view that he "never *seriously* studied or worked with" Vigantol Oil or that he never used it "*in connection with his research or preparation of the inventions claimed in the '958 Patent.*" See Ex. 2008, ¶s9, 10 (emphasis added). Emails with third parties or representatives of Merck, prior art publications, a laboratory

notebook, and a bottle of Vigantol Oil (a product not available in the United States) – as Petitioner requests – will not show inconsistencies with Dr. Vieth’s statements. Whether “[t]he documents sought show that other researchers in the field also worked with and studied Vigantol Oil” (Paper 27 at 3) could not possibly be inconsistent with Dr. Vieth’s statements. Petitioner’s requests are a speculative fishing expedition that it could develop through its own investigation. Finally, Dr. Vieth’s knowledge is entirely irrelevant in assessing obviousness. “Patentability shall not be negated by the manner in which the invention was made.” 35 USC §103.

Patent Owners are well aware of their obligation under 37 C.F.R. §42.51(b)(1)(iii). They have, and will continue to, comply with that obligation and will produce any documents that are in fact inconsistent with a position advanced in this proceeding. At this time, they have nothing further to produce.

Alternatively, Petitioner’s broad document requests do not satisfy the framework established by *Garmin*, Paper 26 at 6-7. None of those factors supports Petitioner’s overly-broad document requests.

Factor 1. “[T]he requester of information should already be in possession of a threshold amount of evidence or reasoning tending to show beyond speculation that something useful will be uncovered.” *Id.* at 7. Here, Petitioner has not identified any basis for asserting that the requested documents will be useful. Petitioner claims that its broad requests will show what a person of ordinary skill in the art would have

known as of the priority date of the ‘958 Patent. Paper 27 at 4-5. But Petitioner simply speculates what otherwise publicly-available papers authored by other researchers may (or may not) show. How could emails with representatives of Merck be useful? Petitioner has no valid reason for expecting Patent Owners to undertake a comprehensive prior art search for “prior art publications mentioning the administration of oral vitamin D preparations.” It simply speculates how “emails with other researchers and with representatives of Merck mentioning Vigantol Oil” will be useful. Petitioner makes no showing how a “a bottle of Vigantol Oil” – a product not available in the U.S. – will be useful. It also does not show how “a laboratory notebook mentioning Vigantol Oil” will be useful. Petitioner is simply embarking on a fishing expedition, particularly before Patent Owners have filed their formal response to the petition.

Factor 2. Petitioner claims its broad requests “do not seek Patent Owners’ litigation positions or the underlying basis for those positions.” Paper 27 at 5. But that is exactly the reasons presented for Petitioner’s requests. The Petitioner contends throughout its motion that the documents requested will allegedly undermine or contradict statements made in Patent Owners’ preliminary response. *See, e.g., id.* at 4-5. However, as the Board stated in *Garmin*, “the Board has established rules for the presentation of arguments and evidence ... a party may not attempt to alter the Board’s trial procedures under the pretext of discovery.” *Garmin*,

Paper 26 at 13. *See also id.* (“If and when Garmin presents affidavit or declaration testimony to support any position it maintains, Cuozzo has an opportunity to cross-examine the affiant or declarant with regard to the basis of the testimony.”). Petitioner is simply attempting to engage in discovery.

Factor 3. Petitioner’s argument relating to this factor fails when its actual requests are considered. Petitioner is asking Patent Owners to undertake a massive search for any prior art that simply “mention[s] the administration of oral vitamin D preparations.” *Id.* at 7. Petitioner could just as easily undertake such a search. Petitioner could also just as easily attempt to obtain a bottle of Vigantol Oil. *See id.* Petitioner contends it needs the documents sought by its request nos. 1 and 3 to show what “a person of ordinary skill in the art would already have known” regarding the composition of Vigantol Oil.” *Id.* at 5. But Petitioner could undertake its own prior art research and analysis – or identify suitable researchers to provide affidavits – to establish this point. *See also Bloomberg Inc. v. Markets-Alert Pty Ltd.*, CBM2013-00005, Paper 32 at 8 (PTAB May 29, 2013). Petitioner has already established its position on level of ordinary skill in the art and does not allege that any of the requested documents support its position. Petitioner may not supplement its asserted grounds at this stage of the proceeding.

Factor 4. While Petitioner’s requests may appear facially clear, they are breathtaking in scope and contain multiple ambiguities. For example, what

constitutes “mentioning”? Do the words “Vigantol Oil” have to appear in a document or on a page to constitute “mentioning”? What does “oral vitamin D preparations” include? What method of “administration” is covered? Tablet? Liquid? Petitioner’s requests have no instructions that clarify these questions, among others.

Factor 5. Petitioner’s requests are overly burdensome on their face. Petitioner’s requests are not limited to specifically identified documents previously produced in the underlying litigation. (Note 1 of Petitioner’s motion merely identifies some allegedly responsive documents, not all. *See* Paper 27 at 1 n.1.) The open-ended nature of the requests increases the burden on Patent Owners. Each request would require Patent Owners to conduct a complete search of their files to attempt to identify responsive documents. Petitioner’s request no. 2 would require a prior art search and review of monumental proportions, seeking any prior art publication that merely mentions “the administration of oral vitamin D preparations.” The request for a “bottle of Vigantol Oil” is one that Petitioner could and should undertake itself. No reason exists to require Patent Owners to attempt to obtain a product that may not be lawfully sold or distributed in this country.

The interests of justice require that the Board deny the Petitioner’s overly broad and unreasonable document requests. The requests do not satisfy the *Garmin* factors either in whole or in part.

For the foregoing reasons, the Board should deny Petitioner's motion in its entirety.

Dated: November 20, 2023.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. § 42.6(e) that on November 20, 2023,
**PATENT OWNERS' OPPOSITION TO PETITIONER'S MOTION TO
COMPEL ROUTINE DISCOVERY, OR IN THE ALTERNATIVE,
ADDITIONAL DISCOVERY OF DOCUMENTS** is being served, by filing this
document through the Patent Trial and Appeal Case Tracking System (P-TACTS)
and by electronic mail as directed by Petitioner upon the following counsel of
record for Petitioners:

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