

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 OPPOSITION TO PATENT OWNERS' MOTION FOR
ADDITIONAL DISCOVERY**

What remains¹ of Patent Owners' Motion for Additional Discovery should be denied because the substance of the requested information does not further the issues in this IPR and fails to meet the governing *Garmin* test. The requests in Patent Owners' motion are overbroad and unlikely to yield anything useful. Patent Owners, after originally requesting all documents produced by Petitioner in the district court litigation, are now still seeking 294 documents consisting of 2,496 pages as well as a transcript from the third-party deposition of Innovative Labs. *See* Paper 28 at App. 1. But Patent Owners have not made a threshold showing, beyond mere speculation, that explains why the requested documents will be useful. Because Patent Owners have failed to make such showing, the Board should deny what remains of their motion.

I. ARGUMENT

A. *Garmin* Factor 1 Not Met

Factor 1 heavily favors denying Patent Owners' motion because Patent Owners fail to show how the documents they request are useful or will establish any nexus between Petitioner's alleged commercial success and the challenged

¹ The Board issued a *sua sponte* Order on November 17, 2023 expunging EX 2016 and 2017 as well as Appendices 2 and 3, which were improperly attached to Patent Owners' Motion for Additional Discovery. Petitioner's Opposition therefore does not cite to the specific disclosures contained in the struck evidence.

method claims. *See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001 at 6 (PTAB Mar. 5, 2013) (Paper 26) (precedential). Patent Owners generally seek documents relating to “Petitioner’s sales, marketing plans, and documents showing the difference between Petitioner’s past and current products” and argue in conclusory fashion that these documents will “show the commercial success was because of the inventive feature [*i.e.* the composition change], and not for some other reason.” Paper 28 at 4 (“the change of ingredients [] to the composition recited in Claim 1 is the only difference that led to commercial success.”). Instead of explaining why these documents will uncover useful information, here, Patent Owners raise no “more than a possibility” or “mere allegation” that production of the requested documents would return anything of substantive value in this IPR. *Garmin*, Paper 26 at 7.

1. No Copying Showing

There is no dispute that Petitioner updated the formulation of its vitamin D product in recent years. But Patent Owners’ contention that Petitioner created a “knock off” “copy-cat” product is not useful to this IPR because the challenged claims are not directed to a patented product. *See* ’958 Patent at Cls. 1, 3-5. Instead, they claim *a method* of administration. *See id.* Ignoring that the challenged claims are all directed to a method of administration, Patent Owners only request documents relating to a change in composition. *See id.*; *see also* Paper 28 at App.

1. None of Patent Owners’ requests about composition are useful in evaluating the obviousness of the claimed method of administration. Paper 28 at App. 1; *see also Garmin*, Paper 26 at 7 (“useful does not mean merely ‘relevant’ and/or ‘admissible.’” On the contrary, “useful means favorable in substantive value to a contention of the party moving for discovery.”). Patent Owners merely allege that the documents they are requesting will be useful to establish copying without providing any description of these documents or their contents that would support their theory. *See Intex Recreation Corp. v. Team Worldwide Corp.*, IPR2018-00859, Paper 38 at 6 (PTAB Dec. 21, 2018) (finding Factor 1 weighs heavily against request because “Patent Owner fails to explain sufficiently what the requested documents constitute and why they include useful information.”) Notably, the packaging used for Ddrops’s and Petitioner’s products does not support copying because the two products do not list the same ingredients. Further, Patent Owners do not contend that the documents will show that Petitioner knew the composition of Ddrops’s product or were aware of the ’958 Patent’s claims. *Institut Pasteur & Universite Pierre Et Marie Curie v. Focarino*, 738 F.3d 1337, 1347-48 (Fed. Cir. 2013) (“Copying requires duplication of features of the patentee’s work *based on access to that work*, lest all infringement be mistakenly treated as copying.”)(emphasis added).

Instead of establishing why the requested documents would be useful, Patent Owners rely on a conclusory, unsupported statement from their counsel with no more than a “mere allegation” that something useful will be found. *See* Paper 28 at 3 (“counsel is confident the requested documents are useful” and the documents “will contribute to proving secondary considerations of non-obviousness, *viz.* commercial success and copying.”). But it is not enough for Patent Owners’ “counsel [to] review[] the documents,” provide a “general description of the documents,” and offer a “blanket statement that the documents are ‘highly relevant’” to secondary considerations. *Intex*, IPR2018-00859, Paper 38 at 6; *see also Polygroup Ltd. v. Willis Elec. Co., Ltd.*, IPR2016-00800, Paper 28 at 13 (PTAB Jan. 13, 2017) (finding “counsel’s allegation that certain documents are ‘highly probative’” is insufficient). Patent Owners have done no more here, even with the documents in hand today. *See* Paper 28 at 3-4.

Further, none of the documents Patent Owners request will establish that “Petitioner embarked on a strategy to copy the ‘Baby Ddrops® product,’” as Patent Owners allege. Paper 28 at 4. Patent Owners mischaracterize Petitioner’s district court production by suggesting there is no evidence of Petitioner testing compositions “in developing its knock off product” when it “chang[ed] the composition of its product to be identical [to Ddrops products].” In fact, Petitioner produced documents to Patent Owners showing the tests it performed on

Petitioners' products and the reason for switching the composition of Petitioner's product from using sunflower oil to MCT oil. The tests had nothing to do with Ddrops's product or the method in the '958 Patent of placing a drop adhering to a surface. Instead, the change resulted from Petitioner's desire to improve the shelf life of its vitamin D product. Petitioner explained as much in its interrogatory responses and produced documents directly demonstrating this in the district court litigation. Patent Owners intentionally omit these and other relevant facts from their motion. Patent Owners' theory lacks any factual underpinning beyond vague accusations. Its "copying" theory is nothing more than a "competition" theory. Thus, *Garmin* Factor 1 weighs against Patent Owners' requests.

2. No Commercial Success Showing

Patent Owners have also failed to establish how the requested documents will show that it is the claimed *method* of administering Petitioner's vitamin D product that contributed to Petitioner's commercial success (e.g. via increased sales of market share). At most, Patent Owners only speculate "the change of ingredients [] to the composition recited in Claim 1 is the only difference that led to commercial success" and "no other features exist which potentially could be responsible for commercial success." Paper 28 at 3. In doing so, Patent Owners do not make a showing that the alleged commercial success is due to Patent Owners' claimed *method*. See *Garmin* at 8-9 (denying discovery because patent owner "has

not made a sufficient threshold showing that the requested sales and pricing information are for units the sales of which are due to an inventive feature”).

The challenged claims disclose a method of administering a known vitamin D composition. *See* '958 Patent at Cls. 1, 3-5. The claimed method is specific to placing one drop of said vitamin D composition on the external surface of an object so an infant can lick or suck it off. *See id.* Here, the instructions on Petitioner's product contains multiple methods of administering Petitioner's vitamin D product, several of which indisputably are not covered by the claims being challenged in this IPR. Further, Patent Owners omit additional factors they are aware of from the district court litigation that contributed to Petitioner's sales. As just one example, Patent Owners ignore that Petitioner received capital funding from investors, which allowed Petitioner to increase its digital marketing efforts over the past 3 years. Without the required nexus to the claims rather than good business practices, which Patent Owners cannot establish, Patent Owners' requests are not useful to proving its attenuated commercial success allegations. *See Fox Factory, Inc. v. SRAM, LLC*, 994 F.3d 1366, 1378 (Fed. Cir. 2019) (vacating finding of patentability because patentee failed to “prov[e] that the evidence of secondary considerations is attributable to the claimed combination”).

B. *Garmin* Factor 5 Not Met

Patent Owners’ request for 294 documents is grossly overbroad and unduly burdensome, especially because Patent Owners have not justified their request for “each document” “with specificity.” *Intex*, IPR2018-00859, Paper 38 at 6 (denying request for “55 documents [listed] by Litigation Bates number”).

The production of such documents would also be unduly burdensome because it would put Petitioner’s highly-confidential information at greater risk of public disclosure, and in the hands of a competitor, in a final written decision. *See* 77 Fed. Reg. 48756, 48761 (Aug. 14, 2012) (“There is an expectation that [confidential] information will be made public [if] . . . identified in a final written decision[.]”). Many of the requested documents are subject to a protective order that precludes disclosure beyond trial counsel. This is the precise reason why Petitioner originally objected to Patent Owners’ use of these documents in this IPR. Thus, *Garmin* Factor 5 supports denying Patent Owners’ request for the production of voluminous, highly confidential district court documents.

II. CONCLUSION

Patent Owners’ requests are not in the interest of justice and will not advance the issues in this proceeding. Therefore, Patent Owners’ motion should be denied.

Date: Nov. 20, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on November 20, 2023, a complete and entire copy of this Petitioner's Opposition to Patent Owner's Motion for Additional Discovery, were provided via email, to the Patent Owners by serving the email correspondence addresses of record as follows:

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