

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

Denying Petitioner's Motion to Compel Routine Discovery,
or in the Alternative, for Additional Discovery
37 C.F.R. § 42.51

Petitioner MOM Enterprises, LLC filed an authorized motion to compel Patent Owner Elaine and Reinhold W. Vieth to produce certain categories of documents as routine discovery pursuant to 37 C.F.R. § 42.51(b)(1)(iii). Paper 27 (“Mot.”). Petitioner alternatively moves for additional discovery under 37 C.F.R. § 42.51(b)(2). *See id.* Patent Owner opposes. *See generally* Paper 36 (“Opp.”). For the reasons discussed below, we *deny* Petitioner’s motion.

ANALYSIS

Background and the Requested Discovery

Petitioner’s obviousness arguments are based in part on Harder and Wolf, two references that Petitioner argues teach the administration of a commercial vitamin D product called Vigantol Oil.¹ *See, e.g.*, Pet. 11–15. Petitioner seeks an order compelling Patent Owner to produce the following categories of documents and things relating to Vigantol Oil and vitamin D preparations:

- (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.

Mot. 1. Petitioner argues that the requested information “is inconsistent with Patent Owners’ positions in their Preliminary Response, i.e., the statements

¹ Harder and Wolf are German-language documents. *See* Exs. 1006, 1008. Here we refer to English-language translations filed as Exhibits 1007 (Harder translation) and 1009 (Wolf translation).

Dr. Reinhold Vieth made in his declaration [Ex. 2008],” and should be produced as routine or additional discovery. *Id.* at 2.

Petitioner states that Patent Owner previously produced the requested information under protective order in the parallel District Court Litigation.² Mot. 1. Despite this representation, Petitioner identifies only eight specific previously-produced items that allegedly fall within its requests.³ *Id.* at 1 n.1. Petitioner also requests production of “all” documents responsive to its requests, “should [Patent Owner’s] production [in the District Court Litigation] be incomplete.” *Id.*

Routine Discovery

In an *inter partes* review, a party must serve as “routine discovery” “relevant information that is inconsistent with a position advanced by the party during the proceeding concurrent with the filing of the documents or things that contains the inconsistency.” 37 C.F.R. § 42.51(b)(1)(iii). Petitioner contends that the requested materials are inconsistent with the following three statements from Dr. Vieth’s Declaration:

8. . . . [The] actual composition [of Vigantol Oil] is not readily available

9. . . . I never seriously studied or worked with “Vigantol” oil.
. . .

² *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.).

³ Petitioner identifies these eight items only by Bates number, and does not indicate the subject matter of any of the items, or to which category of requested materials the items belong. Mot. 1 n.1.

10. I never used “Vigantol” oil in connection with the research or preparation of the inventions claimed in the ’958 Patent.

Ex. 2008 ¶¶ 8–10; Mot. 3. Petitioner contends that the documents and things it requests will show information allegedly inconsistent with these statements, namely, that (1) “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;” (2) “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;” and (3) “other researchers in the field also worked with and studied Vigantol Oil.” Mot. 3.

As an initial matter, although most of Petitioner’s motion focuses on alleged inconsistencies between the requested information and Dr. Vieth’s statements, for completeness we begin by addressing Petitioner’s argument that “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.” Mot. 3. In support of this argument, Petitioner cites pages 33–34 of Patent Owner Preliminary Response (Paper 6), where Patent Owner states: “the composition of Vigantol oil is not described in Harder.” Paper 6, 33–34. We do not view this statement as invoking the “actual” composition of Harder, but rather as alleging a deficiency in Harder’s disclosure *vis-à-vis* the requirements of the challenged claims. Accordingly, we find that this statement does not entitle Petitioner to the requested discovery, because “[a]rguments pointing to a deficiency in petitioner’s case do not impose an obligation” on a patent owner under the routine discovery rule. *Hughes Network Sys., LLC v. Cal. Inst. of Tech.*, IPR2015-00059,

Paper 34 at 7 (PTAB Dec. 30, 2015). To hold otherwise would “lead[] to an unreasonably broad scope of routine discovery.” *NVIDIA Corp. v. Samsung Elecs. Co.*, IPR2015-01316, Paper 9, at 3 (PTAB Oct. 28, 2015).

Turning to Dr. Vieth’s Declaration, we find that the broad scope of information Petitioner seeks is incongruous with the narrowness of the cited statements. In paragraph 8, Dr. Vieth expresses his view that the “actual composition” of Vigantol Oil “is not readily available.” Ex. 2008 ¶ 8.

Based on this statement, Petitioner seeks information it says will show that Dr. Vieth and others knew the actual composition of Vigantol Oil before the priority date of the challenged claims. Mot. 3. But in paragraph 8, Dr. Vieth does not claim that he and others did not know the actual composition.

Instead he says that it “is not readily available.” Ex. 2008 ¶ 8. Petitioner appears to be seeking broad discovery intended to demonstrate that Dr. Vieth’s view was wrong, i.e., that the actual composition of Vigantol Oil was allegedly “readily available” to ordinarily skilled artisan, as opposed to seeking information showing that Dr. Vieth held a view inconsistent with his statement, i.e., that he believed the actual composition of Vigantol Oil was in fact readily available.

Turning to Dr. Vieth’s statements in paragraphs 9 and 10, these statements generally relate to Dr. Vieth’s own research with or use of Vigantol Oil. Petitioner again seeks broad discovery based on these much narrower statements. First, the requested information about *others’* research with Vigantol Oil bears no relationship to Dr. Vieth’s characterizations of his own work with this product. Second, in the cited statements, Dr. Vieth does not deny *any* work with Vigantol Oil, but rather says he “never seriously studied or worked with ‘Vigantol’ oil,” or used it “in connection

with the research or preparation of the inventions claimed in the '958 Patent.” Ex. 2008 ¶¶ 8, 9. Petitioner does not explain how the broad categories of documents and things it seeks contain information inconsistent with Dr. Vieth’s statements. Nor do we independently ascertain the connection.

For example, Petitioner’s request (1) covers all “emails with other researchers concerning Vigantol Oil and with representatives of Merck, the manufacturer of Vigantol Oil.” Mot. 1. Petitioner does not specify whose emails this request covers (Dr. Vieth’s?). But even assuming Petitioner is seeking Dr. Vieth’s emails with researchers and Merck regarding Vigantol Oil, Petitioner has not clearly asserted that these emails contain information inconsistent with Dr. Vieth’s statements that he “never seriously studied or worked with ‘Vigantol’ oil” or used it specifically “in connection with the research or preparation of the inventions claimed in the '958 Patent.” Ex. 2008 ¶¶ 8, 9.

Nor has Petitioner persuaded us that “a laboratory notebook *mentioning* Vigantol Oil” (request (3)) is inconsistent with Dr. Vieth’s statements. A mere mention of a product in a laboratory notebook does not suggest that the notebook’s author (Dr. Vieth?) necessarily “seriously studied or worked with ‘Vigantol’ oil” or used it “in connection with the research or preparation of the inventions claimed in the '958 Patent.” Ex. 2008 ¶¶ 8, 9. Additionally, Petitioner does not explain, and we do not independently ascertain, how the documents and things in request (2) (“prior art publications describing the administration of oral vitamin D preparations”) and request (4) (“a bottle of Vigantol Oil”) are allegedly

inconsistent with Dr. Vieth's characterizations of the extent of his work with Vigantol Oil.

Accordingly, on the basis of Dr. Vieth's statements in paragraphs 8–10 of his declaration, we do not compel Patent Owner to produce routine discovery pursuant to Petitioner's requests. Nevertheless, we remind Patent Owner that to the extent it has documents or things showing that Dr. Vieth held a view that the actual composition of Vigantol Oil was in fact readily available to those of ordinary skill in the art before the priority date, or that he did "seriously stud[y] or work[] with 'Vigantol' oil" or used it "in connection with the research or preparation of the inventions claimed in the '958 Patent," it must produce such documents or things under 37 C.F.R. § 42.51(b)(1)(iii).⁴ Patent Owner states that it is "well aware of [its] obligation under 37 C.F.R. § 42.51(b)(1)(iii)," and currently has "nothing further to produce." Opp. 3. To the extent Petitioner disagrees, the parties should meet and confer regarding which specific documents Petitioner identifies as inconsistent with Dr. Vieth's statements (consistent with our analysis of those statements herein). If the parties cannot reach agreement

⁴ "Routine discovery" encompasses "relevant information." 37 C.F.R. § 42.51(b)(1)(iii). Patent Owner argues that "Dr. Vieth's knowledge is entirely irrelevant in assessing obviousness," given the recitation in 35 U.S.C. § 103 that "[p]atentability shall not be negated by the manner in which the invention was made." Opp. 3. Even assuming, *arguendo*, that Patent Owner is correct, we find that information inconsistent with Dr. Vieth's statements (to the extent such information exists), is relevant to at least his credibility and the weight his testimony should be given in this proceeding.

on which specific documents (if any) qualify as routine discovery, they may reach out to the Board for assistance.

For the above reasons, we deny Petitioner's request to compel routine discovery according to its requests (1)–(4), but remind Patent Owner that it must produce as routine discovery any relevant information that is inconsistent with Dr. Vieth's statements as discussed above.

Additional Discovery

As an alternative to its request to compel routine discovery, Petitioner seeks additional discovery of the documents and things specified in its requests (1)–(4). Mot. 4. “The test for a party seeking additional discovery in an *inter partes* review is a strict one.” *Symantec Corp. v. Finjan, Inc.*, IPR2015-01545, Paper 9 at 4 (PTAB Dec. 11, 2015). “The moving party must show that such additional discovery is in the interests of justice.” 37 C.F.R. § 42.51(b)(2)(i).

We consider the following factors in determining whether the requested discovery is necessary for good cause: (1) whether the movant has provided a specific factual reason for reasonably expecting that the discovery will be “useful,” i.e., “favorable in substantive value to a contention”; (2) whether the requests seek the other party's litigation positions and the underlying basis for those positions; (3) the movant's ability to generate equivalent information by other means; (4) whether the requests have easily understandable instructions; and (5) whether the requests are overly burdensome to answer. See *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6–7 (PTAB Mar. 5, 2013) (precedential). We address each factor below.

1. Specific Factual Reason for Reasonably Expecting the Discovery Will be Useful

According to Petitioner, “Patent Owners argue in their Preliminary Response that Petitioner’s primary references, Harder and Wolf, do not disclose the composition of Vigantol Oil.” Mot. 4–5 (citing Patent Owner Preliminary Response (Paper 6), 14, 33, 44). Petitioner asserts that “[t]he 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.” *Id.* at 5. Patent Owner responds that “Petitioner is simply embarking on a fishing expedition, particularly before Patent Owners have filed their formal response to the petition.” Opp. 4.

Petitioner does not persuade us that its requested discovery will lead to information that is “favorable in substantive value to” its obviousness contentions. *Garmin*, Paper 26 at 7. Petitioner’s obviousness theories are based, in relevant part, on Harder and Wolf, both of which Petitioner alleges are prior-art printed publications that teach the use of Vigantol Oil. *See, e.g.*, Pet. 11–15. Petitioner does not (and could not, in this IPR), assert obviousness based on the Vigantol Oil product itself. *See* 35 U.S.C. § 311(b) (“A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent . . . *only on the basis of prior art consisting of patents or printed publications.*”) (emphasis added).

Petitioner argues that its requested discovery will be useful in showing that Dr. Vieth and persons of ordinary skill in the art would have been familiar with the composition and administration of Vigantol Oil as of the priority date. Mot. 5. First, request (2) is not even limited to Vigantol Oil,

but instead much more broadly seeks all “prior art publications describing the administration of oral vitamin D preparations.” *See id.* at 1. Second, Petitioner fails to adequately explain how a skilled artisan’s knowledge of Vigantol Oil (the product) is relevant to its obviousness arguments based on what a person of ordinary skill in the art would have understood based on the asserted prior-art printed publications Harder and Wolf. In this regard, Petitioner did not cite the “actual composition” of Vigantol Oil in the Petition.

More specifically, in arguing that the prior art teaches or suggests the claim limitation reciting “a composition consisting of . . . vitamin D in a liquid triglyceride of 6 to 12 carbon chain length,” the Petition nowhere discusses the “actual composition” of Vigantol Oil, separate from what Harder teaches about the composition. *See, e.g.,* Pet. 22–24, 28; *see also* Ex. 1004 (Williams Decl.) ¶¶ 48, 78, 99, 104. Petitioner cannot vary or supplement its arguments in the Petition to now invoke the “actual composition” of the Vigantol Oil commercial product as bearing on what Harder teaches to a person of ordinary skill in the art.

Finally, and as discussed further under factor 3 below, even if it were relevant that persons of ordinary skill in the art allegedly knew the “actual composition” of Vigantol Oil as of the priority date, this would be publicly available information that is as equally accessible to Petitioner as it is to Patent Owner—not a topic for which Petitioner has demonstrated a need for additional discovery from Patent Owner’s internal files.

For the above reasons, Petitioner does not persuade us that this factor favors granting the requested discovery.

2. *Whether the Requests Seek Patent Owner's Litigation Positions*

The parties dispute whether Petitioner's requests seek Patent Owner's litigation positions. Mot. 5; Opp. 4–5. In this regard, *Garmin* states: “[T]he Board has established rules for the presentation of arguments and evidence and . . . there is a proper time and place for each party to make its presentation, and . . . a party may not attempt to alter the Board's trial procedures under the pretext of discovery.” *Garmin*, Paper 26 at 13.

Petitioner requests discovery based on Patent Owner's alleged arguments in the Preliminary Response. *See, e.g.*, Mot. 4–5. Given that Patent Owner has not yet filed its Patent Owner Response and may not repeat the cited arguments in the Patent Owner Response, under *Garmin*, Petitioner's requests prematurely seek Patent Owner's litigation positions.

3. *Ability to Generate Equivalent Information by Other Means*

Petitioner asserts that the requested 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.” Mot. 5.

Petitioner does not adequately demonstrate that the materials referenced in its requests (2) and (4) are not publicly accessible. Prior art publications (request (2)) are by definition publicly accessible. *See, e.g., GoPro, Inc. v. Contour IP Holding LLC*, 908 F.3d 690, 693 (Fed. Cir. 2018). Vigantol Oil (request (4)) is a commercial product, albeit one that may be available only outside the U.S., and with a prescription. *See* Ex. 1007, 6; Opp. 4. We agree with Patent Owner that Petitioner could just as easily as

Patent Owner undertake a prior art search or attempt to obtain a bottle of Vigantol Oil.⁵ Opp. 5.

While the documents in requests (1) and (3) (emails and a laboratory notebook) appear to be non-public, Petitioner alleges that the utility of these documents is “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.” Mot. 5. Petitioner fails to explain why it needs private documents to demonstrate what was allegedly known to a person of ordinary skill in the art. We again agree with Patent Owner that Petitioner can undertake its own prior art research and analysis to obtain equivalent information. Opp. 5.

For the above reasons, on this record Petitioner has not persuaded us that it is unable to generate equivalent information without the requested discovery.

⁵ Incidentally, on this record Petitioner does not explain why prior art and a commercially available product—materials that appear to be publicly-available—would have been “produced under protective order” in the District Court Litigation, as Petitioner contends. See Mot. 1, 4. If publicly-available materials were designated confidential in the District Court Litigation, other means of generating equivalent information under *Garmin* factor 3 could include seeking authorization from the District Court for Petitioner to use public information in this case, or asking Patent Owner to revise its protective order designations. See, e.g., *Polygroup Ltd. (MCO) v. Willis Elec. Co.*, IPR2016-01610, Paper 54, at 6–8 (PTAB May 16, 2017).

4. *Whether the Requests Have Easily Understandable Instructions*

Petitioner contends that its requests are “easily understandable” because it is “only requesting four specific categories for production.” Mot. 6. We disagree.

As Patent Owner points out, “[w]hile Petitioner’s requests may appear facially clear, they are breathtaking in scope and contain multiple ambiguities.” Opp. 5. For example, request (1) covers *all* emails “concerning” Vigantol Oil. Mot. 1. Later, the Motion restates this request as covering all emails “mentioning” Vigantol Oil. *Id.* at 6. The request fails to specify whose emails are requested, what the terms “concerning” and “mentioning” mean or encompass, or any relevant time period. Opp. 6.

Request (2) fares no better. It is ambiguous in seeking *all* prior art publications “describing the administration of oral vitamin D preparations.” Mot. 1; *see also id.* at 6 (restating the request as all “prior art publications *mentioning* the administration of oral vitamin D preparations”) (emphasis added). What does “describing” or “mentioning” mean? What does “oral vitamin D preparations” include—all tablets, capsules, suspensions, and other oral dosage forms? *See* Opp. 6. Any oral product that includes vitamin D, even in combination with other active ingredients?

Petitioner’s requests have no clarifying instructions. *Id.*

5. *Whether the Requests Are Overly Burdensome to Answer*

Petitioner contends that its requests are not overly burdensome, because “Petitioner has only one request, and it is narrowly tailored and specifically described.” Mot. 6. We disagree. Petitioner posits four requests. Mot. 1. While requests (3) and (4) (a laboratory notebook and a

bottle of Vigantol Oil) appear to be narrowly described, requests (1) and (2) (emails concerning or mentioning Vigantol Oil; prior art publications) each cover a potentially vast amount of information. Petitioner contends that the requested “documents appear to have already been produced by the Vieths with specific bates numbers, and amount to a small number of Plaintiffs’ overall production.” Mot. 6. But as noted above, Petitioner identifies only eight specific documents by Bates number, and further requests “all” documents responsive to its requests—not just select materials that have already been produced in the District Court Litigation. *See id.* at 1 n.1; *see also* Opp. 6. We agree with Patent Owner that “[t]he open-ended nature of the requests increases the burden” on Patent Owner, who would need to “undertake a comprehensive prior art search” and “conduct a complete search of [its] files to attempt to identify responsive documents.” Opp. 4, 6.

Conclusion

Weighing all of the *Garmin* factors together and for reasons discussed above, we conclude that Petitioner has not demonstrated that the requested discovery is necessary in the interest of justice.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s Motion is *denied*.

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