

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOM ENTERPRISES, LLC,
Petitioner,

v.

ELAINE AND REINHOLD W. VIETH,
Petitioners.

Case IPR2023-00726
Patent 9,066,958

**PETITIONER'S OPPOSITION TO PATENT OWNERS' MOTION FOR
ADDITIONAL DISCOVERY**

Patent Owners' Motion for Additional Discovery requesting to take the depositions of Petitioner's CEO Yasmin Kaderali, Senior Director of Research and Development Stephanie Medina, and third-party Tisha Winters is not in the interest of justice and is contrary to Congressional intent limiting discovery. Patent Owners have not demonstrated a threshold amount of evidence tending to show that the testimony sought will be useful. Further, Patent Owners fail to explain why this testimony cannot be obtained by other and less burdensome means. Accordingly, Patent Owners' Motion should be denied.

I. THE REQUESTED DEPOSITIONS ARE NOT IN THE INTEREST OF JUSTICE

A. *Garmin* Factor 1

Patent Owners fail to show, beyond speculation, that something more useful than their documentary evidence will be uncovered. *See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001 at 6 (PTAB Mar. 5, 2013) (Paper 26) (precedential). Patent Owners request "testimony . . . to 'shed further light' on certain documents, which **will further establish** secondary considerations of copying, commercial success, and long-felt but unmet need," but fail to adequately explain how this testimony will add to the evidence they already have, or will provide useful information that is not apparent from the documents Petitioner already produced. Paper 49 at 2-3 (emphasis added); *see also Garmin*, Paper 26 at 7 ("'Useful' [] does

not mean merely ‘relevant’ . . . ‘useful’ means favorable in substantive value to a contention of the party moving for discovery.”). Instead of showing why something favorable would be uncovered, Patent Owners merely rely on their counsel’s conclusory statement that “the requested testimony will be favorable and substantively valuable” and speculate that “Kaderali and Medina will provide testimony regarding Petitioner’s sales, marketing plans, and related documents that show the commercial success of Petitioner’s [] product has been due to the inventive features claimed” and nothing else. Paper 49 at 4-5.

The documents Patent Owners highlight suggest only healthy competition. Patent Owners have not indicated how they will result in any specific testimony showing a relevant nexus between Petitioner’s product change and its commercial success. *See Axonic Modulation Technologies, Inc. v. Medtronics, Inc.*, IPR 2020-00679, Paper 24 at 7 (PTAB December 10, 2020) (denying motion for discovery where “Patent Owner merely alleges [] some evidence suggestive of a similar product, but does not offer sufficient evidence or reasoning that the requested [] testimony provide(s) anything more.”); *Red Diamond, Inc. v. Southern Visions, LLP*, 2019-01671, Paper 35 at 36 (PTAB Mar. 31, 2021) (patent owner did not establish commercial success merely by providing sales data and contending that its market share was “high”).

The documents Patent Owners cite in the Motion also do not suggest a

connection with the method or composition recited in the challenged claims. Instead, they discuss [REDACTED]. For example, the attachment discussed in MOM_0002566-0002569 lists “[REDACTED]” as the first objective, with no mention of the product’s administration or composition. *See* MOM_0002569. The same is true of MOM_0002371-2418 (“[REDACTED]”). Other documents cited in Petitioner’s deposition notices tell the same story. *See, e.g.*, MOM_0001463-1488 (highlighting [REDACTED]); [REDACTED]; MOM_0000601-000620 (“[REDACTED]”). Patent Owners cannot show the Board they possess a single threshold document suggesting there could be a nexus between Petitioner’s change in its product composition and commercial success. Rather, the documents tell the story that [REDACTED], clearly recited in the documents. Patent Owners provide only speculative attorney argument that the witnesses “will provide testimony” that commercial success “has been due to the inventive features claimed in the ’958 Patent.” Paper 49 at 4-5.

Patent Owners also fail to show why these named individuals would provide particularized, useful testimony to support Patent Owners’ position of a nexus to the

claimed method and composition. *See* Paper 49 at 4-5. Ms. Kaderali is a CEO. Patent Owners' citations only indicate that Ms. Kaderali is "leadership" actively "involved in the creative direction of marketing & innovation plans." *Id.* Nor have Patent Owners provided anything to support Ms. Medina's testimony other than the conclusory statement that "she played a key role in redesigning Petitioner's product." The internal documents and emails that Patent Owners intend to question the witnesses on make it clear that others were involved in the product change. These documents also explain the reasons for the product change in detail. So why question Ms. Kaderali and Ms. Medina, specifically? Finally, Patent Owners do not even address what testimony Ms. Winters will provide that would be useful to their contentions other than she happened to be "Brand Manager" at the time. It is evident that Patent Owners seek deposition testimony from multiple witnesses because the documents do not support their contentions and they must keep fishing for evidence elsewhere.

Patent Owners' reliance on *Kashiv Pharma* is misplaced. There, the Board allowed depositions to inquire into the extent to which the third party should have been named as a real party in interest ("RPI"). *See Kashiv Pharma LLC v. Purdue Pharma L.P.*, IPR 2018-00625, IPR 2018-00717, Paper 20 (PTAB July 31, 2018). The Board found the existing record showed inconsistencies in the petitioner's current IPR petition (where the third party was not named an RPI) and the

petitioner's prior IPR petitions (where the third party was named an RPI). *Id.* at 5. Such inconsistencies and statutory issues are not present here. Here, the documents Petitioner produced are straightforward, answer Patent Owners' questions, and do not suggest a threshold nexus to secondary considerations of non-obviousness. Because the depositions will not yield something useful to Patent Owners' contentions, this factor weighs in favor of denying Patent Owners' Motion.

B. *Garmin* Factor 3

Patent Owners fail to establish why equivalent information cannot be generated by other means. *See Garmin*, Paper 26 at 6. "Information a party can reasonably figure out or assemble without a discovery request would not be in the interest of justice to have produced by the other party." *Id.*

In prior briefing seeking discovery, Patent Owners argued the documents Petitioner has produced are "uniquely useful to defeating [Petitioner's] obviousness assertion." Paper 28 at 4. They argued these documents "show that the commercial success was because of the inventive features, and not some other reason." *Id.* Patent Owners now have those documents. Thus, the type of information Patent Owners are now seeking through testimony is already present in the documents Petitioner produced. Further, Patent Owners fail to explain why it is necessary to depose all of three of these individuals on exactly the same documents. *See* Paper 49 at 12, 13, 18, 19, and 24. Moreover, Patent Owners fail to explain why they need testimony

from Ms. Winters, a third party who only worked for Petitioner less than a year, instead of any other representative of MOM. Because it is not necessary to conduct all three of the requested depositions to get information already laid out in the documents, this factor weighs in favor of denying Patent Owners' Motion.

C. *Garmin* Factor 5

The depositions requested are grossly overbroad and unduly burdensome. Many of the documents upon which Patent Owners seek testimony are not limited to Petitioner's product at issue in this IPR, and instead, cover the entire portfolio of Petitioner's product offerings.

For Ms. Kaderali and Ms. Medina, Patent Owners appear to recognize that a full day deposition of the CEO and Senior Director of a company is problematic and would limit the deposition time. But there is no justification in the Motion for why these depositions would last so long if each were supposedly a "focused" deposition. Patent Owners do not even provide an hour restriction for Ms. Medina's or third-party Ms. Winters's depositions, other than assurance that neither would not carry over a second day. These offers may save a little bit of time on the day of the deposition, but would not reduce the other burdens associated with deposing witnesses. Ms. Kaderali and Ms. Medina would still have to engage in the time-consuming review of documents in order to prepare for their depositions. And regardless of whether these depositions are one hour or seven, preparation time

would be the same for such broad topics, especially since Ms. Kaderali and Ms. Medina are not the most knowledgeable individuals on all the generic topics Patent Owners seek. The intrusion into high-level employees' schedules as well as the schedules of persons with actual knowledge helping to prepare these individuals to be able to adequately testify about the documents identified would be no less than if each deposition proceeded for a full day.

Finally, Ms. Winters, is a third party. She is on maternity leave and has not worked for Petitioner for over two years. It would be unduly burdensome to have her review and testify about communications she had years ago with current employees of Petitioner, especially when she did not generate the documents about which Patent Owners seek to question her.

Reducing the time for these depositions by a couple of hours offers little benefit, especially considering Patent Owners' speculation about the nature of the testimony they may receive from these three individuals. As the Board noted during the parties' December 21, 2023 conference call, it would be less burdensome for Petitioner to respond to interrogatories or to designate the appropriate witness(es) for targeted 30(b)(6) topics, which Patent Owners are not seeking.

II. CONCLUSION

Patent Owners' requests for deposition testimony are not in the interest of justice. Therefore, Patent Owners' Motion should be denied.

Respectfully submitted,

Date: January 4, 2024

David Conrad, Reg. No. 60,788
Sarika Patel, *Pro Hac Vice*
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 to 37 CFR § 42.6(e)(4), the undersigned certifies that on January 4, 2024, a complete and entire copy of this Petitioner's Opposition to Patent Owners' Motion for Additional Discovery were provided via email, to the Patent Owners by serving the email correspondence addresses of record as follows:

Mark E. Ungerman, Reg. No. 32,070
UNGERMAN IP PLLC
mungerman@ungermanip.com

Peter J. Davis, Reg. No. 36,119
WHITEFORD, TAYLOR & PRESTON LLP
pdavis@whitefordlaw.com

Alan M. Anderson, *Pro Hac Vice*
L. Regan Florence, *Pro Hac Vice*
Matthew Palen, *Pro Hac Vice*
ALAN ANDERSON LAW FIRM LLC
aanderson@anderson-lawfirm.com
rflorence@anderson-lawfirm.com
mpalen@comcast.net

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