

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

Granting-in-Part Patent Owner's Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)

With our authorization (Paper 46), Patent Owner Elaine and Reinhold W. Vieth filed a motion for additional discovery, namely, three depositions relating to the alleged objective indicia of non-obviousness of commercial success, copying, and long-felt need. Paper 49 (“Mot.”).¹ Petitioner MOM Enterprises, LLC filed an opposition. Paper 52 (“Opp.”).² For the reasons discussed below, we grant Patent Owner’s motion as to two of the requested depositions, but deny it as to Patent Owner’s request for authorization to obtain a subpoena for the deposition of a third party.

BACKGROUND AND THE REQUESTED DISCOVERY

Petitioner raises obviousness arguments against the challenged claims. *See* Paper 2 (Petition), 1. Patent Owner responds that the challenged claims are not unpatentable as obvious, including because of certain objective indicia of non-obviousness, i.e., commercial success, copying, and long-felt need. *See, e.g.*, Mot. 1. In particular, Patent Owner alleges that Petitioner “changed the chemical composition” of its product “to address flaws” and “to match Patent Owner’s product as claimed in the ‘958 Patent,” which led to “subsequent commercial success.” *Id.* at 1–2.

The Board previously granted a discovery motion from Patent Owner, ordering Petitioner to produce as additional discovery certain documents that Patent Owner alleged are pertinent to its commercial success and copying arguments. *See* Paper 45. Patent Owner now states that “[a]fter reviewing the documents,” it requests “limited, targeted testimony from 3 individuals to ‘shed further light’ on certain documents, which will further establish

¹ Patent Owner filed its Motion (Paper 49) under seal. A redacted version of the motion appears in the record as an Appendix to Patent Owner’s Motion to Seal (Paper 48).

² Petitioner filed its Opposition (Paper 52) under seal. A redacted version of the opposition appears in the record at Paper 51.

secondary considerations of copying, commercial success, and long-felt but unmet need.” Mot. 2–3 (quoting *Kashiv Pharma, LLC v. Purdue Pharma L.P.*, IPR2018-00625, Paper 20 at 3, 5 (PTAB July 31, 2018)). Specifically, Patent Owner seeks the depositions “Yasmin Kaderali, CEO of Petitioner; Stephanie Medina, Senior Director of Research & Development and Quality of Petitioner; and Tisha Winters, who formerly was Brand Manager for the product in issue.”³ *Id.* at 1.

ANALYSIS

The party seeking additional discovery in an *inter partes* review “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 in the interests of justice: (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 request seeks 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 request has easily understandable instructions; and (5) whether the request is 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.

³ Because Ms. Winters is a former employee of Petitioner, Patent Owner seeks authorization to apply for a subpoena for Ms. Winters’s deposition. *See* Mot. 1.

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

Pursuant to *Garmin* factor 1, we consider whether Patent Owner is already in possession of a threshold amount of evidence or reasoning tending to show beyond speculation that something useful will be uncovered via the requested discovery. *See Garmin*, IPR2012-00001, Paper 26, at 7. “Useful” in this context does not mean merely “relevant” and/or “admissible.” *Id.* Rather, it means favorable in substantive value to a contention of the party moving for discovery. *Id.*

Kaderali and Medina Depositions

As to the deposition of Ms. Kaderali, Patent Owner argues that she is “actively involved in the creative direction of marketing & innovation plans” and is familiar “with the packaging and labeling on Petitioner’s product.” Mot. 1 (quoting <https://mommysbliss.com/blogs/mom/runonthepowerofmomasyasmin>; citing *Ddrops Co. v. MOM Enterprises, LLC*, No. 1:22-cv-00332-GBW (D. Del.), Docs. 110-1, ¶ 2; 130, ¶ 4). Patent Owner argues that she will “provide testimony regarding Petitioner’s sales, marketing plans and related documents that show the commercial success of Petitioner’s” product. Mot. 4. Patent Owner also argues that given her long tenure at Petitioner and her involvement in Petitioner’s “decision to introduce” the redesigned product, Ms. Kaderali “will also shed light on the long-felt but unmet need for the invention disclosed in the ’958 Patent” and on copying. *Id.* at 5, 1.

As to the deposition of Ms. Medina, Patent Owner argues that she “played a key role in redesigning Petitioner’s product to address flaws in its predecessor product and its subsequent commercial success.” Mot. 1–2. As

such, Patent Owner contends that “[s]he has knowledge relevant to copying, commercial success, and long-felt but unmet need.” *Id.* at 2.

Petitioner responds that Patent Owner “fail[s] to show, beyond speculation, that something more useful than their documentary evidence will be uncovered.” Opp. 1. Petitioner argues that “[t]he documents Patent Owner[] highlight[s] suggest only healthy competition,” and “do not suggest a connection with the method or composition recited in the challenged claims.” *Id.* at 2–3. Petitioner offers alternative views on what the produced documents show regarding the reasons for success of its redesigned product. *Id.* at 3. Petitioner also argues that Patent Owner “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.” *Id.*

After considering the parties’ arguments and evidence of record, we find that Patent Owner has the better argument. There appears to be no present dispute that Petitioner changed its product composition, and that its product enjoys commercial success. *See, e.g.*, Opp. 3 (referencing, but not disputing, “Petitioner’s change in its product composition and commercial success”). Instead, the parties dispute whether Petitioner’s documents evidence copying or merely “healthy competition,” and whether the commercial success was “due to the inventive features claimed in the ’958 Patent” or other reasons. *See, e.g., id.* at 2–3.

We previously found that Patent Owner had sufficiently shown that certain of Petitioner’s documents would uncover something useful to its copying and commercial success claims. *See* Paper 45 at 5, 6. Given the parties’ competing interpretations of the documents, we find that deposition testimony could help shed further light on these documents and Patent Owner’s objective indicia arguments. As for the requested depositions of

Ms. Kaderali and Ms. Medina in particular, Patent Owner contends, and Petitioner does not appear to dispute, that they are knowledgeable regarding Petitioner's marketing plans, product labeling, and product redesign (and the produced documents relating to the same)—issues that appear to undergird Patent Owner's objective indicia arguments. Mot. 1–2, 4–5.

Petitioner argues that Patent Owner has no threshold evidence of a nexus between “Petitioner's change in its product composition and commercial success.” Opp. 2. We find that this argument is not dispositive at this juncture. Patent Owner alleges that Petitioner changed its product to “match Patent Owners' product as claimed in the '958 Patent,” which allegedly led to “subsequent commercial success.” Mot. 1–2, 4. Patent Owner further argues that Petitioner's product has “no other features . . . which potentially could be responsible for commercial success.” *Id.* at 4. On this record, we find Patent Owner's arguments sufficient to warrant the requested depositions.

For the above reasons, we find that *Garmin* factor 1 favors authorizing the depositions of Ms. Kaderali and Ms. Medina.

Winters Deposition

As to the deposition of Ms. Winters, a former employee of Petitioner, Patent Owner asserts that she “was Brand Manager for Petitioner . . . when Petitioner redesigned its baby vitamin D product and changed the chemical composition to match Patent Owners' product as claimed in the '958 Patent.” Mot. 2. Patent Owner contends that she “has knowledge relevant to copying and commercial success following introduction of the knock-off product in February 2021,” but Patent Owner does not elaborate more specifically on the nature of this alleged knowledge. *Id.*

We find that Patent Owner has not sufficiently articulated a specific factual reason for reasonably expecting that the deposition of Ms. Winters will

be useful. Patent Owner argues only that she was “Brand Manager” at the time of introduction of the redesigned product, but does not specifically articulate what knowledge Ms. Winters is expected to have that would be useful to Patent Owner’s copying and commercial success arguments. *See* Mot. 2; Opp. 4. Nor does Patent Owner allege that Ms. Winters would be knowledgeable about specific documents produced by Petitioner that undergird Patent Owner’s objective indicia arguments.

For these reasons, we find that *Garmin* factor 1 does not favor authorizing Patent Owner to seek a subpoena for Ms. Winters’s deposition.

*2. Whether the Requested Depositions Seek Petitioner’s
Litigation Positions*

Patent Owner argues, and we agree, that the requested depositions do not seek information regarding Petitioner’s litigation positions. Mot. 5. Petitioner does not dispute this. *See generally* Opp. We therefore find that *Garmin* factor 2 favors authorization.

3. Ability to Generate Equivalent Information by Other Means

Patent Owner argues that it has no other means available to generate equivalent information regarding Petitioner’s product. Mot. 6. Petitioner responds that “the documents Petitioner produced are straightforward,” and “the type of information Patent Owner[is]now seeking through testimony is already present in the documents.” Opp. 5.

After considering the parties’ arguments and evidence of record, we find that Patent Owner has the better argument. Patent Owner seeks what appears to be non-public information regarding Petitioner’s product development, market share, and sales data, including testimony regarding Petitioner’s internal, non-public documents. This does not appear to be “[i]nformation a party can reasonably figure out or assemble without a discovery request.”

Garmin, Paper 26 at 6. Additionally, the parties' briefing undercuts Petitioner's contention that the documents themselves are "straightforward, [and] answer Patent Owners' questions." Opp. 5. For example, the parties dispute whether the documents show copying or "healthy competition." *Id.* at 2. Accordingly, deposition testimony may be useful in assisting the Board in evaluating Patent Owner's objective indicia arguments.

For the above reasons, this factor favors granting Patent Owner's Motion.

4. Whether the Requests Have Easily Understandable Instructions

Patent Owner argues, and we agree, that the requested deposition notices are easily understandable, and include a list of specific documents on which Patent Owner seeks to depose the witnesses. Mot. 6. Petitioner does not dispute this. *See generally* Opp. We therefore find that this factor favors authorization.

5. Whether the Requests Are Overly Burdensome to Answer

The parties dispute whether the requested depositions will be overly burdensome. *See* Mot. 6–7; Opp. 6–7. The relevant burdens include "financial burden, burden on human resources, and burden on meeting the time schedule of this review." *Garmin*, Paper 26, at 14.

Neither party raises any issues concerning financial burden or burden on meeting the time schedule of this review. Instead, the parties focus on burden on human resources. After considering the arguments and evidence of record, we agree with Patent Owner that the requested depositions are not overly burdensome, including because they will be taken virtually, each deposition is expected to last less than one day, and Patent Owner has identified the

documents on which it seeks testimony, thereby aiding the witnesses' preparation. *See, e.g.*, Mot. 6.

Petitioner's complaint that "[m]any of the documents upon which Patent Owner[] seek[s] testimony are not limited to Petitioner's product at issue in this IPR, and instead, cover the entire portfolio of Petitioner's product offerings" (Opp. 6) is unavailing. The deposition notices specify that the subject of examination is Petitioner's Mommy's Bliss Baby Vitamin D Organic Drops product, not Petitioner's other products. *See* Mot. 12–13, 18–19, 24.

Petitioner also argues that despite Patent Owner identifying specific documents to be introduced at the deposition and limiting the length of the depositions, Ms. Kaderali and Ms. Medina are "high-level" employees who would still have to engage in the time-consuming review of documents to prepare for their depositions, no matter how long the requested depositions last. Opp. 6–7. We acknowledge Ms. Kaderali's and Ms. Medina's positions within the company, but on this record we are not persuaded that the time commitment to prepare and sit for the depositions is "overly burdensome" on human resources. The depositions will last less than one day each, and Patent Owner has identified "the exhibits to be relied upon during the deposition and a general description of the scope and nature of the testimony to be elicited." Mot. 10, 16.

As to Ms. Medina, we agree with Petitioner that Patent Owner has not established that the deposition of Ms. Winters is not overly burdensome. Ms. Winters is a third party who has not worked for Petitioner for over two years. Opp. 7. She is "on maternity leave" and "did not generate the documents about which Patent Owner[] seek[s] to question her." *Id.* These factors, combined with the fact that Patent Owner has not adequately

articulated any specific or unique knowledge Ms. Winters is expected to have that would be useful to Patent Owner's copying and commercial success arguments, convince us that the requested deposition of Ms. Winters would be overly burdensome.

CONCLUSION

Weighing all of the *Garmin* factors together and for reasons discussed above, we conclude that Patent Owner has demonstrated good cause for the requested depositions of Ms. Kaderali and Ms. Medina, but has not demonstrated good cause for us to authorize Patent Owner to seek a subpoena for the deposition of Ms. Winters.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's Motion is *granted* as to the requested depositions of Ms. Kaderali and Ms. Medina, but *denied* as to the request for authorization to seek a subpoena for the deposition of Ms. Winters;

FURTHER ORDERED that no later than one business day after entry of this Order, Patent Owner shall serve upon Petitioner the deposition notices for Ms. Kaderali and Ms. Medina that are attached as Appendix 1 to the Motion; and

FURTHER ORDERED that the parties shall work together in good faith to timely complete the Kaderali and Medina depositions, cognizant of the remaining deadlines in the Scheduling Order as modified by the parties (Papers 11, 43).

IPR2023-00726
Patent 9,066,958 B2

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