

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
Conduct of the Proceeding
37 C.F.R. § 42.5

On April 25, 2024, at Patent Owner's request, the panel conducted a conference call with counsel for the parties (Mr. Anderson and Mr. Ungerman for Patent Owner, and Mr. Conrad and Ms. Patel for Petitioner). No court reporter was present.

During the call, Patent Owner requested authorization to file a Motion to Strike: (1) Petitioner's Reply, to the extent it raises anticipation arguments; and (2) portions of Dr. Raj's declaration and related exhibits that concern an experiment conducted by Dr. Raj. Petitioner opposed. During the call we authorized Patent Owner to file a motion to strike, and Petitioner to file an opposition as set forth below. To provide the parties guidance in their briefing, we address each of issues (1) and (2) in more detail below.

As to issue (1), Patent Owner argued that the Petition's grounds of unpatentability are based on obviousness, whereas the Reply changes the theory of unpatentability to anticipation. Petitioner responded that its Reply does not change theories, but is instead consistent with Petitioner's arguments in the Petition, which allegedly asserted that Harder essentially anticipates the claims, and used the secondary references merely to explain Harder. Petitioner also asserted that Patent Owner's arguments are based on "semantics," given that anticipation is the epitome of obviousness.

During the conference call, the panel observed that the Petition presents only obviousness grounds. Although "anticipation is the epitome of obviousness" (*see* Reply 3, citing cases), the reverse is not true. We instituted trial based on obviousness grounds (*see* Paper 10, 6, 48), and these are the grounds upon which we will adjudicate in any final written decision entered in this case. *See, e.g., M&K Holdings, Inc. v. Samsung Elecs. Co.,*

985 F.3d 1376, 1385 (Fed. Cir. 2021) (holding that Board erred in finding claims unpatentable as anticipated where petition argued obviousness).

That said, as noted in our Trial Practice Guide, “striking the entirety or a portion of a party’s brief is an exceptional remedy that the Board expects will be granted rarely.” Trial Practice Guide¹ 80. “In most cases, the Board is capable of identifying new issues or belatedly presented evidence when weighing the evidence at the close of trial, and disregarding any new issues or belatedly presented evidence that exceeds the proper scope of reply or sur-reply.” *Id.* However, “where a reply clearly relies on a new theory not included in prior briefing, and where addressing this new theory during oral hearing would prejudice the opposing party, striking the portion of the brief containing that theory may be appropriate.” *Id.* at 81.

To assist the panel in evaluating the motion to strike, we suggest that, in its motion, Patent Owner very specifically identify discrete portions of Petitioner’s Reply that allegedly address a new legal theory (anticipation). For example, although Patent Owner asserted during the conference call that the first nineteen pages of the Reply articulate a new legal theory, we observe that in attempting to support its assertions that “By disclosing Vigantol oil, Harder discloses the claimed concentration and carrier” and that “Harder also describes the delivery and method of administration (licking off a spoon),” Petitioner at page 3 of the Reply exclusively cites the Petition for support, suggesting that these assertions may not be new. As another example, page 4 of the Reply addresses Dr. Vieth’s research and

¹ Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), *available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

development process in the context of obviousness (not anticipation). As another example, Section B of the Reply (which starts on page 7) addresses whether Harder is analogous art, while Section C (which starts on page 10) addresses the meaning of “zum Ablecken” in Harder and Dr. Reid’s experiment. On their face, these sections, which fall within the first nineteen pages of the Reply cited by Patent Owner during the conference call, do not appear to be arguing anticipation. In short, we encourage Patent Owner to clearly point out specific, discrete passages of the Reply it contends should be stricken for allegedly presenting a new anticipation theory.

As to (2), Patent Owner argued that Dr. Raj conducted an experiment that does not constitute proper reply, and which should have been presented earlier, so that Patent Owner would have an adequate chance to respond, including potentially with responsive expert testimony. Petitioner responded that Dr. Raj’s experiment is responsive to the arguments and experiment presented by Patent Owner’s declarants.

In briefing this issue, we remind the parties that “‘there is no blanket prohibition against the introduction of new evidence during an IPR,’ provided it is an ‘expan[sion] on and . . . fair extension of . . . [a] previously raised . . . argument’ and has a ‘nexus’ (and is therefore responsive) to an argument made by the patent owner or the Board.” *Corephotonics, Ltd. v. Apple Inc.*, 84 F.4th 990, 1009 (Fed. Cir. 2023) (quoting *Rembrandt Diagnostics, LP v. Alere, Inc.*, 76 F.4th 1376, 1384–85 (Fed. Cir. 2023)) (alterations in original). The parties should consider focusing their arguments on whether the material related to Dr. Raj is impermissibly “part of a *new* theory of unpatentability,” and whether it is “*responsive* to [Patent Owner’s] contentions or the Board’s institution decision.” *Id.* at 1008.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner may file a motion to strike, where the motion shall be no more than 7 pages and shall be filed no later than April 30, 2024;

FURTHER ORDERED that Petitioner may file an opposition to Patent Owner's motion to strike, where the opposition shall be no more than 7 pages and shall be filed no later than May 7, 2024;

FURTHER ORDERED that neither party is authorized to file any additional evidence with its motion or opposition; and

FURTHER ORDERED that no other briefing is authorized at this time.

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For PETITIONER:

David Conrad
Lance Wyatt
FISH & RICHARDSON P.C.
conrad@fr.com
wyatt@fr.com

For PATENT OWNER:

Mark Ungerman
UNGERMAN IP PLLC
mungerman@ungermanip.com

Peter Davis
WHITEFORD, TAYLOR & PRESTON LLP
pdavis@wtplaw.com

Alan Anderson
Laura Florence
ALAN ANDERSON LAW FIRM LLC
aanderson@anderson-lawfirm.com
rflorence@anderson-lawfirm.com