

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 IPR 2023-00726
Patent 9,066,958

PATENT OWNERS' MOTION TO STRIKE UNDER 37 C.F.R. § 42.23(b)

This Motion and Memorandum is submitted by Patent Owners in support of their Motion to Strike portions of Petitioner’s Reply and of Exhibit 1040 (“Raj Decl.”). Recognizing its inability to establish invalidity on the grounds asserted and on which this matter has proceeded, Petitioners added a new argument in its Reply, supported by the Raj Decl. Petitioner now argues that the Harder reference anticipates claims 1, 4 and 5 or is a single-reference for obviousness. Paper 74 at 3-4; 24, n.8. Patent Owners ask the Board to strike those portions of the Reply directed toward the new anticipation and single-reference obviousness argument, viz., Reply Section II.A. (page 3 to page 7, 2nd paragraph); page 9 (last paragraph (arguing “teaching away” is irrelevant based on anticipation); page 12 (first full paragraph referencing Raj Decl.); page 13, last paragraph (arguing anticipation); page 14 (last paragraph referencing Raj Decl.); Section IV (first paragraph, pages 24-25); and those portions of the Raj Decl. presented in support of the new arguments (Raj Decl. paragraphs 15-23).

In its Petition, Petitioner “request[ed] an IPR of the Challenged Claims on the grounds noted below.” Paper 2, p. 2. Each ground asserted 3 or 4 references in combination under §103. Section 5(A) of the Petition addressed the “Legal Standard for Obviousness.” *Id.*, pp. 21-21 The word “obvious” appears 29 times in the Petition, while the word “anticipate” never appears. *See generally* Paper 2. Neither Petitioner nor any of its previously disclosed experts ever argued anticipation or that

Harder was a single-reference for obviousness. *See* Ex. 1004, p. 9, ¶17; Ex. 2025, 20:20 – 21:3. In response to the Patent Owners’ Motion for Additional Discovery of evidence relating to secondary indicia, Petitioner never argued secondary indicia were not relevant, because the Petition asserted that the invalidity grounds were obviousness, rather than the anticipation grounds now asserted in the Reply. *See* Paper 52. As the Board has already stated, “the Petition presented only obviousness grounds. ... We instituted trial based on obviousness grounds ..., and these are the grounds upon which we will adjudicate in any final written decision entered in this case.” Paper 79, at 2.

In its Reply, Petitioner suddenly argues, “Harder Anticipates the Claims.” It makes new arguments and cites new evidence from a previously undisclosed expert to support its new anticipation/single-reference obviousness theory. *See generally* Paper 74.

In an IPR, the petitioner’s petition “define[s] the scope of the litigation all the way from institution through to conclusion.” *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 367 (2018). A petition must identify “with particularity ... the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. §312(a)(3). “[T]he expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to

institute.” *Intelligent Bio-Systems, Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016).

A petitioner “may not submit new evidence or argument in reply that it could have presented earlier....” Consolidated Trial Practice Guide at 73 (Nov. 2019); *accord* 37 C.F.R. §42.23(b). If petitioner’s “reply clearly relies on a new theory not included in prior briefing, and where addressing this new theory ... would prejudice the opposing party, striking the portion of the brief containing that theory may be appropriate.” *Id.* at 81. These rules help ensure that the patent owner receives notice of and a fair opportunity to meet alleged grounds of invalidity. *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1080 (Fed. Cir. 2015). “The Board *will not attempt to sort proper from improper portions of the reply*. Examples of indications that a new issue has been raised in a reply include new evidence necessary to make out a *prima facie* case for ... unpatentability ..., and new evidence that could have been presented in a prior filing.” USPTO, Consolidated Trial Practice Guide at 74 (Nov. 2019) (emphasis added). Considering new grounds of unpatentability constitutes reversible error. *See, e.g., M&K Holdings, Inc. v. Samsung Elecs. Co.*, 985 F.3d 1376, 1385 (Fed. Cir. 2021).

To determine whether Petitioner’s Reply asserts a new legal theory, the Board is required to consider “whether the petitioner’s reply brief is responsive to arguments originally raised in its petition; or whether the reply arguments are

responsive to arguments raised in the patent owner’s response brief.” *Apple Inc. v. Andrea Elecs. Corp.*, 949 F.3d 697, 705-06 (Fed. Cir. 2020). The record here clearly demonstrates that Petitioner impermissibly asserts anticipation/single-reference obviousness as a new theory.

Petitioner argues that its anticipation-by-ambush tactic is permitted by *Realtime Data, LLC v. Iancu*, 912 F.3d 1368 (Fed. Cir. 2019). In *Realtime*, the Federal Circuit did not create an exception to 35 U.S.C. §312(a)(3) or other notice requirements for §102. Rather, the court merely affirmed the Board’s obviousness finding based on a single reference because the petition clearly asserted that all of the elements were disclosed in a single reference. *Id.* at 1373; *see also Polygroup Ltd. MCO v. Willis Elec. Co.*, 759 F. App’x 934, 942 (Fed. Cir. 2019) (relying on *Realtime* to support determination that the Board must consider obviousness based on a single reference when the petition “explicitly argued that [one refence] alone teaches every element of the challenged claims.”). Unlike the petitions filed in *Realtime* and *Polygroup*, Petitioner’s Petition does not argue anticipation or obviousness based on any single reference. Rather Petitioner’s original obviousness grounds relied solely on combinations of three or four references. Petitioner’s reliance on *Realtime* is misplaced.

Petitioner’s reply page 3 to page 7, line 12 should be stricken as an impermissible new argument. Petitioner cannot whitewash its new legal theory by

citing to obviousness arguments in the Petition. Petitioner is improperly attempting to reframe its original obviousness argument into an anticipation or single-reference obviousness argument. The fact both the anticipation argument and single-reference obviousness argument rely on Harder to show a single drop does not identify with particularity that the Petition is asserting invalidity based on anticipation or single-reference obviousness. Similarly, arguing that Harder teaches the element of a single drop does not open the door to Petitioner arguing in its reply that Harder alone discloses all of the limitations. Petitioner's anticipation and single-reference obviousness arguments are new and should be stricken.

Reply page 9, last paragraph, arguing that a reference that "teaches away" from the invention is inapplicable to anticipation, must also be stricken. That argument has no place in a Petition where the sole ground for institution was combinations of multiple references to allegedly establish obviousness.

Reply page 12, line 12 to page 13, line 1, and page 14, lines 16-19 should be stricken as they improperly rely on the Raj Decl. to argue that Harder alone inherently discloses the express claim limitation that its oil adheres to the surface of an object. Pages 29-31 of the Petition relied on a combination of Harder and Wolf, as interpreted by its expert, to contend that the "adheres" limitation is inherent in the prior art. *See* Ex. 1004, ¶s50, 52. Moreover, because Petitioner only references the

Raj Decl. to support its improper anticipation and single-reference obviousness argument, those references on pages 12, 13 and 14 should be stricken.

The first full paragraph of Section IV, on pages 24-25 of the Reply must be stricken. Petitioner's new argument that secondary indicia are not relevant to anticipation must not be allowed. The petition is solely about multiple reference combinations to allegedly establish obviousness.

Petitioner's Reply is supported by the Raj Decl. Paragraphs 15-23 of the declaration describe testing conducted to support its new anticipation and single-reference obviousness arguments. *See* Ex. 1040, ¶s14-25. Petitioner only cites the Raj Decl. in connection with those new arguments. *See* Paper 79 at 12, 14. The testing, however, is not responsive to, and does not contradict any of the tests performed by Dr. Reid. Rather, the testing is new evidence that Petitioner did not include in its Petition. The new tests disclosed in the Raj Decl. allegedly show that Harder meets the "adheres" and "lick" elements of Claim 1 of the '958 Patent. *See* Paper 79 at 12-14. However, this is a new argument, not presented in the Petition. This untimely new experiment and the new opinions should be stricken for the reasons set forth above.

For the foregoing reasons, the Board should grant Patent Owners' motion and strike those portions of the Reply and Raj Decl. as identified specifically above.

Dated: April 30, 2024.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. § 42.6(e) that on April 30, 2024, **PATENT OWNER'S MOTION TO STRIKE** is being served, by filing this document through the Patent Trial and Appeal Case Tracking System (P-TACTS) and by electronic mail as directed by Petitioner upon the following counsel of record for Petitioners:

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