

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 IPR2023-00726
Patent 9,066,958 B2

**PETITIONER'S OPPOSITION TO PATENT OWNERS'
MOTION TO STRIKE**

Patent Owners' contention that Petitioner's Reply employed an "anticipation-by-ambush tactic" focuses on semantics rather than substance. The Response did not challenge the Petition's reason for combining references: to explain the composition and dosage of Vigantol oil used in Harder. Consequently, Harder discloses the claimed "invention." It does not matter whether this is called anticipation or obviousness, because anticipation is the epitome of obviousness. Further, Patent Owners' arguments as to Dr. Raj's declaration are nonsensical, and any potential prejudice (there is none) was cured through Dr. Raj's deposition and Patent Owners' forthcoming Sur-reply. "[S]triking the entirety or a portion of a party's brief is an exceptional remedy." Trial Practice Guide, 80.¹ Such remedy is particularly unwarranted here, where Patent Owners failed to identify any prejudice whatsoever.

I. Patent Owners' Failure to Rebut the Teachings of the Combination Makes Obviousness Under Section 103 as Strong as Anticipation

Petitioner's Reply asserts the same ground for unpatentability presented in the Petition. The primary obviousness argument set forth in the Petition is that (a) Harder discloses the claimed method with Vigantol oil, and (b) Wolf, the European Pharmacopeia, and Gartner help the POSITA "understand" or "confirm" that Vigantol oil is the claimed composition and dosage in a single drop. First, the

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

Petition identifies every limitation in claims 1, 4, and 5 in Harder with Vigantol oil. Reply, 3 (citing Pet., 25-31). Second, the Petition identifies that the motivation of the combination is to help a POSITA understand the MCT-based Vigantol oil used in Harder's method. *See* Pet., 22 ("A person of ordinary skill would combine these reference[s] to provide a complete composition and dosage of Vigantol oil that Harder teaches delivering by placing one drop on a spoon..."). The Petition argues that European Pharmacopeia explains the "carbon chain length" of MCT oil and that Wolf discloses the claimed dosage of Vitamin D₃ in "1 drop." *Id.*; *see also id.* at 24 ("A POSITA would ... consult European Pharmacopoeia [] to understand the composition of Vigantol oil disclosed in Harder and Wolf...."), 27-28, 32-33, 36-37. Patent Owners' Response concedes this. *See* POR, 33 ("Petitioner relies on Wolf for teaching the composition and dosage of Vigantol® oil").

Patent Owners did not challenge the argument that it was obvious to a POSITA that Harder provided the claimed composition and dosage in one drop of Vigantol oil. They chose to complain only that Wolf teaches a different method than Harder involving "diluting" (and thus teaching away) and that European Pharmacopoeia does not disclose vitamin D in MCT. POR, 19–21. Neither argument rebuts the Petition's reasons for combining the references.

This can be further seen in that Patent Owners' primary response on the merits was not directed at reasons to combine the references, but at the disclosure of Harder

itself. POR, 33. Relying on inventor testimony and experts, it argues that Harder is silent as to whether Vigantol oil “adheres” or can be “suck[ed] or lick[ed]” off a surface by an infant. *Id.* This argument boils down to whether Harder *appreciated* the inherent properties of Vigantol oil or the method’s *efficacy*. Dr. Vieth did, because he did the science. But neither fact matters under Federal Circuit precedent. *See Reply*, 5–7. “[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art’s functioning, does not render the old composition patentably new to the discoverer.” *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999). Put another way, “[w]hile [Dr. Vieth] may have recognized something quite interesting about [Vigantol oil, he] simply has not invented anything new.” *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1350–51 (Fed. Cir. 2002). Moreover, “proof of efficacy is not required for a prior art reference to be enabling for purposes of anticipation.” *Impax Laby’s. Inc. v. Aventis Pharm. Inc.*, 468 F.3d 1366, 1383 (Fed. Cir. 2006).

After considering what Patent Owners chose to rebut and what to concede, this case is no different than evaluating whether Harder disclosed every limitation of Claims 1, 4, and 5 because it disclosed the claimed method using one drop of Vigantol oil. This still invalidates these claims under § 103 whether it is called anticipation or obviousness. First, because “[a]nticipation is the epitome of obviousness.” *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1373 (Fed. Cir. 2019).

Further, because the Board must consider whether a single reference discloses every limitation even if the Petition's ground includes multiple references. *Polygroup Ltd. MCO v. Willis Elec. Co., Ltd*, 759 F. App'x 934, 943, n.3 (Fed. Cir. 2019).

The facts here are directly analogous to *Realtime Data, LLC v. Iancu*, 912 F.3d 1368 (Fed. Cir. 2019). Just as in *Realtime*, the Petition clearly asserted that all of the elements were disclosed in a single reference. And, like *Realtime*, here the "sole purpose" for reliance on secondary references was to show that the **primary reference** disclosed a limitation (namely the composition and dosage of one drop of Vigantol oil). *Realtime*, 912 F.3d at 1373. Patent Owners' response concedes this. *See, e.g.*, POR, 33 ("Petitioner relies on Wolf for teaching the composition and dosage of Vigantol® oil"). It would similarly be reversible error for the Board to disregard Petitioner's argument here. *Polygroup*, 759 F. App'x at 943.

M&K Holdings is distinguishable. 985 F.3d 1376, 1385 (Fed. Cir. 2021). There the Board found anticipation where the Petitioner had "expressly stated" in its Petition that the primary reference **did not disclose** a limitation. *Id.* As such, the Federal Circuit found that M&K had not been put on notice of this theory or given a chance to respond. *Id.* Not so, here. As described above, the Petition identified every claim element in Harder through its disclosure of Vigantol oil. Moreover, Patent Owners have a Sur-reply in which to respond, curing any prejudice (had Patent Owners even identified any).

II. Dr. Raj's Declaration Directly Rebuts Patent Owners' Response

Petitioner's Reply cites to Dr. Raj's declaration exactly twice, and each time in direct response to Patent Owners' evidence. On page 12, Petitioner addresses "Dr. Reid's contrived experiments" performing Harder's method, presented for the first time in Patent Owners' Response, and then explains that Dr. Raj "confirmed Harder's method was feasible." Reply, 12. Therefore, Patent Owners' argument that "[t]he testing ... is not responsive to, and does not contradict any of the tests performed by Dr. Reid," is nonsensical. Mot., 6. Dr. Raj's testing was plainly in direct response to Dr. Reid's testing, and therefore constitutes fair play.

Moreover, on page 14, the Reply addresses Patent Owners' contention that infants are unable to lick spoons. *See, e.g.*, POR, 34–35 ("A POSITA – unlike Harder – also would have known that an infant does not, and is simply unable to, suck a spoon or even lick it"); *id.*, 35 ("A spoon does not facilitate infant sucking"). In direct response to this argument, the Reply states that Dr. Raj "confirms that a baby can 'suck and/or lick the drop off from' a small spoon." Reply, 14 (citing EX1040, ¶17). Dr. Raj's declaration and Petitioner's Reply therefore both "squarely respond[] to [the] Patent Owner Response." *Apple Inc. v. Andrea Elecs. Corp.*, 949 F.3d 697, 706–07 (Fed. Cir. 2020). Once again, Dr. Raj's testimony is fair play, exposing the weaknesses of Patent Owners' arguments in its Response.

Each time Dr. Raj's testing and declaration rebut Patent Owners' arguments regarding Harder's disclosure, which apply regardless of whether anticipation or obviousness is considered. Thus, there is no merit to Patent Owners' allegation that Petitioner only cites to Dr. Raj "in connection with those new arguments." *Id.*

Finally, Patent Owners' Motion alleges no prejudice. Nor could it. Patent Owners had the full opportunity to depose Dr. Raj in timely fashion. *See* Paper No. 78. No basis exists for the Board to strike Dr. Raj's declaration or the portions of Petitioner's Reply that rely on Dr. Raj's declaration.

III. Petitioner's Reply Arguments and Evidence Are Entirely Proper

As the Federal Circuit has regularly held, "the petitioner in an *inter partes* review proceeding may introduce new evidence after the petition stage if the evidence is a legitimate reply to evidence introduced by the patent owner." *Anacor Pharm., Inc. v. Iancu*, 889 F.3d 1372, 1380–81 (Fed. Cir. 2018); *see also* Paper No. 79, 4 ("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.") (quoting *Corephotonics, Ltd. v. Apple Inc.*, 84 F.4th 990, 1009 (Fed. Cir. 2023)). Here, Patent Owners have not identified any evidence or argument that is not directly responsive to either the Patent Owners' Response or Patent Owners' declarants.

Because Patent Owners did not contest that the properties of Vigantol oil are the same as the claimed composition, Petitioner's obviousness challenge simply became much stronger, effectively no different than anticipation.

Like the *Apple* case that Patent Owners cite, (Mot. 3–4), where the Federal Circuit vacated the Board's finding of unpatentability, this is not a case where Petitioner "cite[d] any new evidence or 'unidentified portions'" of the prior art or tried to rely on new prior art. *Apple*, 949 F.3d at 706. Petitioner relies on the same disclosures in Harder that it identified in the Petition for every limitation. And "Parties are not barred from elaborating on their arguments on issues previously raised." *Chamberlain Grp., Inc. v. One World Techs., Inc.*, 944 F.3d 919, 925 (Fed. Cir. 2019). In vacating the decision in *Apple*, the Federal Circuit found the Board "parse[d] the petitioner's arguments on reply with too fine of a filter." *Apple*, 949 F.3d at 706 (citing *Ericsson Inc. v. Intellectual Ventures I LLC*, 901 F.3d 1374, 1380 (Fed. Cir. 2018) (cleaned up)). The Board should not make the same mistake here.

In sum, as the Board noted, "striking the entirety or a portion of a party's brief is an exceptional remedy that the Board expects will be granted rarely." Paper 79, 3. Petitioner's effective anticipation argument and Dr. Raj's declaration are directly responsive to Patent Owners' arguments, and Patent Owners have made no showing of any prejudice. Moreover, Patent Owners will have the last word in their Sur-reply. Petitioner respectfully requests the Board deny Patent Owners' motion to strike.

Date: May 7, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§42.6(e), the undersigned certifies that on May 7, 2024, a complete and entire copy of Petitioner's Opposition to Patent Owners' Motion to Strike was provided via email to the Patent Owners by serving the correspondence email address of record as follows:

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