

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 SHERIDAN K. SNEDDEN and CYNTHIA M. HARDMAN,
Administrative Patent Judges.

HARDMAN, *Administrative Patent Judge.*

ORDER
Granting-in-Part Patent Owner's Motion to Strike
37 C.F.R. § 42.5

Patent Owner filed an authorized Motion to Strike: (1) Petitioner’s Reply, to the extent it raises alleged new arguments, i.e., anticipation by Harder and single-reference obviousness based on Harder; and (2) portions of Dr. Raj’s declaration (Ex. 1040), which Patent Owner argues Petitioner cites solely in support of the new anticipation and single-reference obviousness arguments. *See* Paper 81 (“Mot.”), 1, 6. Petitioner opposed. Paper 88 (“Opp.”).

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.

Below we first address Patent Owner’s arguments that the Reply presents impermissible new anticipation and single-reference obviousness arguments, then turn to the dispute over the Raj Declaration and the related arguments in the Reply.

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

Alleged New Anticipation and Single-Reference Obviousness
Arguments

Patent Owner contends that Petitioner’s Reply improperly presents a new theories of unpatentability based on anticipation by Harder and single-reference obviousness over Harder, whereas the Petition asserted obviousness based on Harder in combination with other references. *See* Mot. 1–2.

Petitioner responds that “the Petition identified every claim element in Harder,” and Patent Owner’s “primary response on the merits was not directed at reasons to combine the references.” Opp. 4, 2. According to Petitioner, “[a]fter 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.” *Id.* at 3; *see also id.* at 7 (“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.”). Petitioner argues that Patent Owner “focuses on semantics rather than substance.” *Id.* at 1.

After considering the parties’ arguments, we find that Patent Owner has the better argument. Patent Owner establishes, and Petitioner does not dispute, that the Petition asserts only obviousness based on combinations of references, and never mentions anticipation. Mot. 1.; *see also* Paper 2 (“Pet.”) at, *e.g.*, 2 (presenting three grounds of obviousness based on various combinations of references), 21 (“This request shows how *various combinations of the above references disclose the limitations of the Challenged Claims*, thereby invalidating Claims 1, 3, 4, and 5 of the ’958

Patent.”) (emphasis added). By changing its theories of unpatentability from obviousness based on multiple references to anticipation or obviousness over Harder alone, Petitioner’s Reply “clearly relies on a new theory not included in prior briefing.” Trial Practice Guide 81.

Petitioner seeks to justify its change to anticipation because, in its view, the Petition asserts that Harder teaches or suggests all claim limitations and Patent Owner “did not challenge the Petition’s reasons for combining the references.” Mot. 1; *see also id.* at 1–2 (“the Petition identifies every limitation in claims 1, 4, and 5 in Harder”). Even assuming that Petitioner is correct regarding the content of the Petition, Petitioner perhaps *could have* argued that Harder anticipates or alone renders the claims obvious, but did not. Instead, Petitioner, who is “the master its complaint,” chose to assert obviousness arguments based on “various combinations of . . . references.” *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018); Pet. 21. Neither we nor Patent Owner is required to deduce the existence of an anticipation argument from within the Petition’s obviousness arguments. *Cf. Microsoft Corp. v. FG SRC, LLC*, 860 F. App’x 708, 713 (Fed. Cir. 2021) (finding no abuse of discretion where Board declined to interpret petition as asserting obviousness where it clearly argued anticipation).

Petitioner is incorrect in suggesting that Patent Owner’s alleged lack of challenge to the Petition’s reasons for combining the references or the properties of Vigantol permits Petitioner to convert its obviousness arguments to anticipation. *See, e.g.,* Opp. 3, 7. In an *inter partes* review, “the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable,” and this burden never shifts to

Patent Owner. *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016); *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015); 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the grounds on which the challenge to each claim is based”). Accordingly, Petitioner cannot use Patent Owner’s arguments to retroactively change the grounds asserted in its Petition.

Petitioner argues that “[i]t does not matter” whether its arguments are captioned as “anticipation or obviousness, because anticipation is the epitome of obviousness.” Mot. 1. We disagree. “[T]hough anticipation is the epitome of obviousness, [they] are separate and distinct concepts” with different legal requirements. *See Cohesive Techs., Inc. v. Waters Corp.*, 543 F.3d 1351, 1363–64 (Fed. Cir. 2008) (quoting *Jones v. Hardy*, 727 F.2d 1524, 1529 (Fed. Cir. 1984)).

Petitioner suggests there is no prejudice to Patent Owner resulting from a change in theory from obviousness to anticipation, but we disagree. *See* Opp. 4. In apparent reliance on the Petition’s framing of its unpatentability arguments, Patent Owner pursued discovery on various objective indicia of nonobviousness, and spent a significant portion of its Response arguing such objective indicia. *See* Paper 61 (“PO Resp.”) 44–64; Papers 28, 49 (Patent Owner’s Motions for Additional Discovery). Patent Owner also raised other arguments that Petitioner itself recognizes are pertinent to obviousness but not anticipation. *See id.* at, e.g., 19 (arguing that “Wolf teaches away from the claimed inventions”). As Petitioner is well aware, Patent Owner’s arguments would have been unnecessary had the Petition been limited to anticipation. *See, e.g.,* Reply 9, 24–25 (arguing that

objective indicia and teaching away are irrelevant to anticipation). Additionally, Patent Owner should not have to allocate space in its forthcoming Sur-reply to address belated and improper anticipation and/or single-reference obviousness theories.

Petitioner asserts that “[t]he facts here are directly analogous to *Realtime Data, LLC v. Iancu*, 912 F.3d 1368 (Fed. Cir. 2019).” We disagree. In *Realtime*, it was undisputed that the petitioner had argued in the petition that O’Brien disclosed all claim elements, and argued “*in the alternative* that Nelson disclosed some of the elements.” *See id.* at 1372–73. In other words, the petition itself presented both a single-reference obviousness argument and an alternative argument based on a combination of that reference with an additional reference. Here, the Petition does not identify a single-reference obviousness argument. It instead expressly presents only obviousness arguments based on “various combinations of . . . references.” Pet. 21.²

For the above reasons, we will strike certain material in Petitioner’s Reply that references anticipation.³ That said, not all of the material Patent

² Petitioner also cites *Polygroup Ltd. MCO v. Willis Elec. Co.*, 759 F. App’x 934, 943, n.3 (Fed. Cir. 2019) for the proposition that “the Board must consider whether a single reference discloses every limitation even if the Petition’s ground includes multiple references.” Opp. 4. We see no such holding in the cited footnote. In any event, *Polygroup* is not binding precedent.

³ Patent Owner does not point us to any material that expressly references a single-reference obviousness argument, nor does Patent Owner adequately explain how any of the cited materials allegedly represent a single-reference obviousness argument. For example, we will not automatically view a

Owner seeks to strike addresses anticipation. Below we individually address the specific portions of the Reply that Patent Owner seeks to strike.⁴

Reply Section II.A (page 3 to page 7, line 12)

Patent Owner argues that Section II.A of Petitioner's Reply should be stricken because Petitioner is "attempting to reframe its original obviousness argument into an anticipation or single-reference obviousness argument." Mot. 4–5.

It is true that Section II.A is captioned, "Harder Anticipates the Claims." Reply 3. A review of the material in this Section, however, presents a more nuanced picture of Petitioner's arguments.

The paragraph spanning pages 3 and 4 references Patent Owner's argument that "the problem addressed by the invention involved 'five inter-related variables: (a) a single drop; (b) the correct concentration; (c) the proper carrier; (d) the delivery means; and (e) the method of administration.'" Reply 3 (citing Paper 61 "PO Resp.") 4–5). Petitioner then argues that Harder discloses each of these five variables. *See id.* To support this argument, Petitioner exclusively cites the Petition. Petitioner then concludes that "Anticipation is the epitome of obviousness." *See id.* at 3 (footnote and citations omitted).

discussion in the Reply of Harder's disclosures as an abandonment of the Petition's arguments regarding other references.

⁴ Notably, Petitioner did not individually address any specific portion of the Reply that Patent Owner requested we strike. Instead, Petitioner's Opposition sought to globally justify its references to anticipation in the Reply. *See generally* Opp.

We acknowledge that Petitioner exclusively cites the Petition to support its arguments here, but the problem is that Petitioner uses the previously-presented arguments to support a new, belated legal theory. Because this paragraph is fairly couched as an anticipation argument, and in the absence of any contrary argument by Petitioner that this paragraph is not directed to anticipation, we grant Patent Owner's request to strike the paragraph spanning pages 3 and 4, as well as the headers A and A.1 on page 3. We do not strike the footnotes on page 3, because they do not appear to allege anticipation.

Pages 4–5 of the Reply, however, largely address Dr. Vieth's research and development efforts that led to the patent, and conclude that "Dr. Vieth's path to the invention has no bearing on patentability." Reply 4–5. We do not perceive, and Patent Owner has failed to adequately explain, how the vast majority of material in this section represents an anticipation or single-reference obviousness argument. (Indeed, page 4 expressly addresses "the inquiry for obviousness.") Instead, we view this section as proper reply to Patent Owner's arguments regarding Dr. Vieth's path to the invention. *See* 37 CFR § 42.23 (stating that a reply may respond to arguments raised in the corresponding patent owner response).

That said, one sentence on page 5 reads: "Harder disclosed the very method of administering Vigantol that Patent Owners claimed in the '958 patent." Reply 5. Arguably this sentence articulates an anticipation argument—a reasonable conclusion given that it appears under a header that reads "Harder Anticipates the Claims." *See* Reply 5, 3. As such, and in the absence of any contrary argument by Petitioner that this sentence is not directed to anticipation, we strike this sentence.

We now turn to Section II.A.2 (“Allegedly Missing Properties are Inherent in Harder”), which starts on page 5 of the Reply. On page 5, Petitioner cites case law indicating that “inherency may supply a missing claim limitation in an *obviousness* analysis.” Reply 5 (emphasis added; citation omitted). Petitioner then discusses why Harder allegedly inherently discloses limitations of the challenged claims. *See id.* at 5–7. With one exception—which we address below—we find that Section II.A.2 reiterates arguments previously made in the Petition. *See, e.g.*, Pet. 29–31 (arguing that Harder inherently discloses the “adheres” limitation). Given that this Section of the Reply expressly references an obviousness analysis and repeats arguments made in the Petition, Patent Owner fails to adequately explain how this Section allegedly represents a new anticipation or single-reference obviousness argument.

That said, there is one statement in Section II.A.2 that expressly articulates an anticipation argument. Specifically, the last sentence on Reply page 6 states: “Additionally, ‘proof of efficacy is not required for a prior art reference to be enabling for purposes of anticipation.’” Reply 6 (citation omitted). As such, we strike this sentence (and the related citation to *Impax*).

Reply page 9, last paragraph

In response to the obviousness arguments raised in the Petition, Patent Owner argues that Harder “teaches away” from the claimed subject matter. *See, e.g.*, PO Resp. 18, 37–38. The first three sentences of the last paragraph on page 9 in Petitioner’s Reply respond to this argument. The remainder of the paragraph, however, reads: “Further, ‘whether a reference “teaches away” from the invention is inapplicable’ to anticipation. *Celeritas Techs. v.*

Rockwell Int’l Corp., 150 F.3d 1354, 1361 (Fed. Cir. 1998). Harder anticipates claim 1, so ‘teaching away’ is irrelevant.” Reply 9. These statements expressly articulate an anticipation argument. As such, we strike the portion of the last paragraph on page 9 beginning with “Further,” and ending with “irrelevant.”

Reply page 13, last paragraph

The subject paragraph reads:

As an initial matter, the claims of the ’958 patent are drafted broadly. Claims 1, 4, and 5 do not require a specific object, but simply require the vitamin D drop be placed on its “exterior surface.” EX1001, cl. 1. A spoon is an object. To prove that a claim covering multiple alternative embodiments is invalid, a challenger need only prove that one of the embodiments is invalid. *See, e.g., In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1281 (Fed. Cir. 2015). Nothing more is required to anticipate these claims.

Reply 13. The majority of this paragraph speaks to claim scope. Patent Owner fails to adequately explain how most of this paragraph allegedly represents a new anticipation or single-reference obviousness argument.

That said, the last sentence (“Nothing more is required to anticipate these claims.”) expressly articulates an anticipation argument. As such, we strike this sentence.

Reply, paragraph spanning pages 24–25

This paragraph (including footnote 8) asserts that Harder anticipates the claims and because “secondary considerations are irrelevant to an anticipation analysis,” “the Board need not consider Patent Owners’ secondary considerations evidence and arguments.” Reply 24–25. This

paragraph clearly presents an express anticipation argument. As such, we strike this paragraph (including footnote 8).

Dr. Raj's Declaration and Related Citations in the Reply

Patent Owner seeks to strike “Reply page 12, line 12 to page 13, line 1, and page 14, lines 16-19,” as well as paragraphs 15–23 of Dr. Raj’s Declaration. Mot. 5, 6. Patent Owner argues that the cited pages of the Reply “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,” whereas “the Petition relied on a combination of Harder and Wolf . . . to contend that the ‘adheres’ limitation is inherent in the prior art.” *Id.* at 5 (citing Pet. 29–31; Ex. 1004 ¶¶ 50, 52). Patent Owner asserts that “Petitioner only references the Raj Decl. to support its improper anticipation and single-reference obviousness argument.” *Id.* at 5–6.

Patent Owner also argues that Dr. Raj’s testing “is not responsive to . . . any of the tests performed by Dr. Reid,” but instead is “untimely” because it is offered to show “that Harder meets the ‘adheres’ and ‘lick’ elements of Claim 1 of the ‘958 Patent.” *Id.* at 6.

Petitioner asserts that Dr. Raj’s declaration responds to Patent Owner’s arguments that Harder’s method is not feasible because infants are allegedly unable to lick spoons, and that “any potential prejudice (there is none) was cured through Dr. Raj’s deposition and Patent Owners’ forthcoming Sur-reply.” Opp. 5, 1.

After considering the arguments and evidence of record, we find that Patent Owner mischaracterizes the record when it argues that “the Petition relied on a combination of Harder and Wolf . . . to contend that the ‘adheres’ limitation is inherent in the prior art,” but the Reply now “improperly rel[ies]

on the Raj Decl. to argue that Harder alone inherently discloses” this limitation. Mot. 5. The Petition alleges that the ’958 patent makes clear that certain oil compositions, like the Vigantol oil disclosed in Wolf, will inherently adhere to a surface. Pet. 29–30. The Petition additionally alleges that Harder “inherently discloses that a drop of Vigantol oil adheres to the surface of the spoon.” *Id.* at 31. In other words, the Petition alleges that both Wolf and Harder separately inherently disclose the “adheres” limitation. Under the circumstances, we see nothing improper about the Reply further expanding on its argument that Harder inherently discloses the “adheres” limitation, without further expanding on its separate inherency argument based on Wolf.

Additionally, Patent Owner does not persuade us that Dr. Raj’s experiment and opinions should have been presented with the Petition. Dr. Raj’s experiment and opinions are offered to rebut Dr. Reid’s experiment, which purportedly shows that a drop of vitamin D oil does not adhere to a spoon, and Patent Owner’s arguments that an infant cannot suck or lick a spoon to remove a vitamin D drop as allegedly taught in Harder. *See, e.g.*, PO Resp. 33–35; Reply 12, 14; Ex. 1040 (Raj Decl.) ¶¶ 17–23. In other words, Dr. Raj’s experiment and opinions squarely respond to Patent Owner’s arguments. *See 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)) (“‘[T]here 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.”) (alterations in original); Opp. 5.

For the above reasons, we deny Patent Owner's request to strike the Reply's references to Dr. Raj's declaration, or paragraphs 15–23 of Dr. Raj's Declaration.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's Motion to Strike is granted in part, namely, the following material in Petitioner's Reply is stricken from the record:

- page 3, main body text starting at “A. Harder Anticipates the Claims,” through page 4, line 4 (excluding the footnotes on page 3);
- page 5, lines 7–8 (i.e., the sentence that reads: “Harder disclosed the very method of administering Vigantol that Patent Owners claimed in the '958 patent.”);
- page 6, last sentence (i.e., “Additionally, ‘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).”);
- page 9, the portion of the last paragraph reading: “Further, ‘whether a reference “teaches away” from the invention is inapplicable’ to anticipation. *Celeritas Techs. v. Rockwell Int'l Corp.*, 150 F.3d 1354, 1361 (Fed. Cir. 1998). Harder anticipates claim 1, so ‘teaching away’ is irrelevant.”);
- page 13, last sentence (“Nothing more is required to anticipate these claims.”);

- page 24, last line on page (starting with “As established above, . . .,” and including footnote 8) through page 25, line 4; and

FURTHER ORDERED that Patent Owner’s Motion to Strike is otherwise denied.

IPR2023-00726
Patent 9,066,958 B2

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