

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OMEGA LINER COMPANY, INC.,

Petitioner

v.

BUERGOFOL GmbH

Patent Owner.

CASE NO.: IPR2023-01372
U.S. PATENT NO. 9,657,882

DECLARATION OF GREGOR SCHLEICHER

I, Gregor Schleicher, do hereby declare:

1. I am making this declaration at the request of Buergofol GmbH (“Buergofol”) to provide the details of the invention disclosed and claimed in U.S. Patent No. 9,657,882 (“the ‘882 patent”), of which I am a named co-inventor. Buergofol is the owner of the ‘882 patent.
2. The statements in this declaration are based on my personal knowledge.
3. I am a German citizen and reside in Germany.
4. I am an owner of Buergofol together with my father Dr. Franz Schleicher. I began working at Buergofol in 2004, and since 2007 I have been the Managing Director of Buergofol.
5. Since 2007, as part of my responsibilities as Managing Director of Buergofol, I have overseen the operations of Buergofol’s facility in Siegenburg, Germany, at which blown extrusion film is manufactured.
6. From 1999 through 2004, I studied mechanical engineering (Maschinenbau) at the Hochschule Konstanz Technik, Wirtschaft und Gestaltung (HTWG) in Konstanz, Germany. My studies in Maschinenbau included, among other things, plastic extrusion equipment. I received the degree Dipl. Ing. (FH).
7. Since 2007, my job responsibilities have also included ensuring that customers are satisfied with the blown extrusion films manufactured by Buergofol, the majority of which are for food packaging but also include inner film usable for

making ultraviolet cured-in-place pipe (“UV-CIPP”) liners for use in trenchless pipe renovation.

8. Since 2007, as part of my job responsibilities of ensuring that customers are satisfied with Buergofol’s inner film for UV-CIPP liners, I have been aware of all significant customer complaints about Buergofol’s UV-CIPP inner film.
9. Since 2007, as part of my responsibilities as Managing Director of Buergofol, I am responsible, together with Buergofol’s sales team, for knowing about all competing products, including products that compete with Buergofol’s UV-CIPP inner film.
10. Before the filing date of the German priority application DE102013102394 on March 11, 2013, I was not aware of any UV-CIPP inner tubular film product made by Buergofol or any other entity that did not have its external outer layer (as opposed to the external layer on the inside of the tube) made of polyamide.
11. The external outer layer of UV-CIPP inner tubular film is almost always made of polyamide (as opposed to other polymers, such as polyethylene, polyurethane or polypropylene) because polyamide better blocks the styrene that is released from the UV-curable resin, and polyamide has a higher melting point than the temperature generated by the exothermic curing reaction of the UV-curable resin. An external outer layer of polyethylene in inner tubular film would likely melt if it were next to the hot, curing UV-curable resin, which reaches a higher temperature than the melting point of polyethylenes used in

inner film. A UV-CIPP inner tubular film with an external outer layer made of polyethylene that melted could not function for its intended purpose.

12. I was informed and aware of the cancellation proceeding that Buergofol filed on April 19, 2012, in the German Patent Office against German Utility Model Patent No. DE202010016048U1, which is related to German application no. DE10201023764.7 to which International Publication No. WO2011/157356 (“Hummel”) [EX1006] claims priority. German Application No. DE10201023764.7, German Patent No. DE202010016048U1 and Publication No. WO2011/157356 (“Hummel”) all have the same specification. The earliest priority filing date for Hummel is June 15, 2010, the date on which German Machinima Application No. DE10201023764.7 was filed, which means that all of the disclosures in the specification of WO2011/157356 (“Hummel”) [EX1006] are from before that date.
13. At least as early as 2012, I was informed and aware that Patent No. DE202010016048U1 was owned by Huhtamaki Deutschland GmbH & Co. KG (“Huhtamaki”).
14. At least as early as 2012, I was informed and aware that Patent No. DE202010016048U1 claimed an inner film having an inner layer with polyethylene having a VICAT softening point of 100°C or above, wherein the inner film had the layers PE/AP/PA/AP/PA, where “PE” denotes polyethylene, “AP” denotes adhesion promoter, and “PA” denotes polyamide.

15. Although since 2007, as Managing Director of Buergofol, I was responsible for knowing about all products that compete with Buergofol's UV-CIPP inner film, I was not aware and do not believe that Huhtamaki was, at least prior to the filing date of the German priority application DE102013102394 to the '882 patent on March 11, 2013, ever able to make and sell the inner film as disclosed in the Patent No. DE202010016048U1 (Hummel) commercially.
16. Although since 2007, as Managing Director of Buergofol, I was responsible for knowing about all products that compete with Buergofol's UV CIPP inner film, I was not aware and do not believe that Huhtamaki was, at least prior to March 11, 2013, ever able to make and sell any UV-CIPP inner film commercially.
17. At least prior to March 11, 2013, no customer of Huhtamaki could have ever used the inner film disclosed and claimed in Patent No. DE202010016048U1 (Hummel) to make UV-CIPP liners and have experienced any problem with the inner film while installing the UV-CIPP liners because the inner film was never, at least prior to March 11, 2013, commercially sold and made into UV-CIPP liners.
18. At least prior to March 11, 2013, no customer of Huhtamaki could have ever used UV-CIPP film made by Huhtamaki to make UV-CIPP liners and have experienced any problem with UV CIPP film made by Huhtamaki while installing UV-CIPP liners because, at least prior to March 11, 2013, Huhtamaki never commercially sold any UV-CIPP inner film.

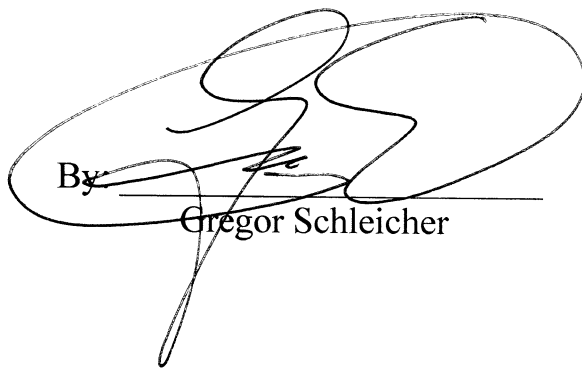
19. Although since 2007, as Managing Director of Buergofol, I have been responsible for knowing about all products that compete with Buergofol's UV-CIPP inner film, I never became aware that there was any problem with the inner film as disclosed and claimed in the Patent No. DE202010016048U1 (Hummel) because I was not aware that any such inner film had ever been used in a UV-CIPP liner.
20. Although since 2007, as Managing Director of Buergofol, I have been responsible for knowing about all products that compete with Buergofol's UV-CIPP inner film, I never became aware that, at least prior to March 11, 2013, there was any problem with any UV-CIPP inner film from Huhtamaki because, at least prior to March 11, 2013, Huhtamaki never commercially sold any UV-CIPP inner film.
21. Statements in the specification of WO2011/157356 ("Hummel") [EX1006], which were drafted before June 15, 2010, do not describe any tearing problem with any actual UV-CIPP inner film made of polyethylene (PE) and polyamide (PA) and having at least one outer PE layer and another outer PA layer (as disclosed in Hummel) because, to my knowledge, prior to June 15, 2010, Buergofol was the only company in the world to make such UV-CIPP inner film, and prior to 2012 there were no problems with Buergofol's UV-CIPP inner film tearing while being withdrawn from renovated pipe.
22. In the spring of 2012, I became aware of a problem encountered when

Buergofol customers withdrew Buergofol's inner film from the renovated pipe after the UV-curable resin cured. In response to customer complaints, I visited at least two customers during the spring of 2012, who informed me that Buergofol's inner tubular film had torn and broken off as it was being withdrawn from the renovated pipe. That was the first time that I had heard of this problem. Fragments of the inner film had torn off as the inner film was pulled out of the cured liner. The film fragments left behind inside the pipe had partially blocked the pipe.

23. When I visited Buergofol's customers in the spring of 2012, I learned that Buergofol's inner film was sticking to the cured UV-curable resin. That was the first time that I recognized that the inner film was tearing because portions of the inner film were sticking to the cured resin and not just because of the longitudinal stresses caused by pulling the entire length of the film by just one location on the film.
24. Although since 2007, as Managing Director of Buergofol, I have been responsible for knowing about all significant customer complaints about Buergofol's UV-CIPP inner film, I was not aware prior to visiting Buergofol's customers in the spring of 2012 that there ever was a problem with inner film tearing when it was pulled out of the cured liner because the inner film stuck to the cured resin.

I declare that all statements made herein on my own knowledge are true and that all statements made on information and belief are believed to be true, and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Date: June 21, 2024 in Munich, Germany

By 
Gregor Schleicher