

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 DAVID CLAYBERG

I, David Clayberg, declare:

1. I am certified by the American Translators Association (ATA) for translation from German to English.
2. I have been translating patents since 1991 and patent litigation documents since 2010.
3. I have translated hundreds of IP litigation briefs and dozens of rulings issued by German and European civil courts, patent courts, and patent office Boards of Appeal. International law firms whose German attorneys have successfully argued cases before German courts have then used my translations in corresponding litigation before American and British courts.
4. I have reviewed two passages of the International Publication WO2011/157356, which appears at pages 37-67 of 71 of EX1005 of the Petitioner Omega Liner Company, Inc. (“Omega”) in the Inter Partes Review IPR2023-01372 of U.S. Patent No. 9,547,882 (“the ‘882 patent”). International Publication WO2011/157356 (“the ‘356 Publication”) is a publication of the International Patent Application PCT/EP2011/002685, which is in the German language.
5. I have also reviewed the corresponding passages of Petitioner’s

English translation of the ‘356 Publication, which appears at pages 2-32 of 71 of EX1005.

6. I have also reviewed the corresponding passages of the English translation of the International Patent Application PCT/EP2011/002685 that was filed on November 30, 2012, into the United States Patent and Trademark Office (“USPTO”) as a continuation under 35 U.S.C. §111(a) of the international application. The continuation application was assigned the serial no. 13/690,076 and issued as U.S. Patent No. 8,794,269 (“the ’269 patent”). Thus, I reviewed the corresponding passages of the ‘269 patent.

7. The first passage of the ‘356 Publication that I reviewed is the long sentence below that appears on page 4 of the ‘356 Publication (p. 42 of 71 of EX1005):

Es wurde ferner überraschend festgestellt, dass sich die erfindungsgemäße Mehrschichtfolie, insbesondere in Form einer mehrschichtigen Schlauchfolie, aber auch als eine zu einem Schlauch gesiegelte Mehrschichtfolie, durch sehr gute mechanische Eigenschaften, insbesondere durch eine sehr gute Dehnbarkeit, auszeichnet, so dass sie den bei der Sanierung von unterirdischen Rohren auftretenden Belastungen, insbesondere beim Aufblasen im Rohrsystem, bei dem vorangegangenen Transport, der vorangegangenen Lagerung und dem Einzug in das zu sanierende Rohr standhält, und sich ferner nach der Aushärtung des Harzes ohne ein Ab-, Ein- oder Zerreißen davon abziehen lässt.

The translation of this passage in Petitioner’s English translation of the ‘356

Publication is different than the corresponding English text in the '269 patent.

8. The first passage of the '356 Publication is translated as follows in Petitioner's English translation, which appears at page 4 of the English translation (p. 7 of 71 of EX1005):

It was also surprisingly found that the multilayer film according to the invention, in particular in the form of a multilayer tubular film, but also as a multilayer film sealed to form a tube, is characterized by very good mechanical properties, in particular by very good elasticity, so that it withstands the stresses occurring during the repair of underground pipes, in particular during inflation in the pipe system, during the preceding transport, the preceding storage and the insertion into the pipe to be repaired, and furthermore, after the resin has cured, can be peeled off from it without being torn, torn in or torn off.

9. The first passage of the '356 Publication is translated as follows in the '269 patent, which appears at column 2, lines 52-64:

It has moreover been established, surprisingly, that the multilayer film of the invention, in particular in the form of a multilayer tubular film, or else in the form of a multilayer film sealed to give a tube, features very good mechanical properties, in particular very good extensibility, in such a way that it withstands the loads that arise during the renovation of subterranean pipes, in particular during inflation within the pipe system, during the preceding transport, the preceding storage, and the entry into the pipe requiring renovation, and moreover, after the hardening of the resin, can be withdrawn therefrom without any break-off, splitting or tearing.

10. In my professional opinion, the first passage of the '356 Publication is more accurately translated in the '269 patent than in the Petitioner's translation because the first passage in German does not convey the idea of peeling the

multilayer film off of the hardened resin. The original German does not convey the notion that anything is “peeled off”. Instead, the first passage discloses that, during the renovation of subterranean pipes, in particular during inflation within the pipe system and entry into the pipe requiring renovation, the multilayer film can be withdrawn from the pipe without any break-off, splitting or tearing. In the context of the first passage, the German verb “abziehen” is better translated as “withdraw from” or “remove from” than as “peel off from”.

11. The second passage of the ‘356 Publication that I reviewed is the sentence below that appears on page 20 of the ‘356 Publication (p. 58 of 71 of EX1005):

Nach der Aushärtung, wenn das gefestigte, sanierte Kanalrohr aus dem ausgehärteten Trägermaterial vorliegt, kann die erfindungsgemäße Mehrschichtfolie, vorzugsweise in Form einer Schlauchfolie, als innenliegender Schlauch vorzugsweise ohne Ab- oder Zerreißen bzw. Festsitzen davon abgezogen werden.

The translation of this second passage in Petitioner’s English translation of the ‘356 Publication is different than the corresponding English text in the ‘269 patent.

12. The second passage of the ‘356 Publication is translated as follows in Petitioner’s English translation, which appears at page 20 of the English translation (p. 23 of 71 of EX1005):

After curing, when the consolidated, repaired sewer pipe made of the

cured carrier material is present, the multilayer film according to the invention, preferably in the form of a tubular film, can be peeled off as an inner tube, preferably without tearing or seizing therefrom.

13. The first passage of the ‘356 Publication is translated as follows in the ‘269 patent, which appears at column 12, lines 1-6:

After the hardening process, once the strengthened, renovated drainage pipe made of the hardened support material is in place, the multilayer film of the invention, preferably in the form of a tubular film, as internally situated tube, can preferably be withdrawn therefrom without break-off or tearing, and/or hindrance to movement.

14. In my professional opinion, second passage of the ‘356 Publication is more accurately translated in the ‘269 patent than in the Petitioner’s translation because the second passage in German does not convey the idea of peeling off the multilayer film. The original German does not convey the notion that anything is “peeled off”. Instead, the second passage discloses that, once the renovated drainage pipe is in place, the multilayer film can be withdrawn from the pipe without break-off, tearing, or hindrance to movement. In the context of the second passage, the German word “abgezogen” (the past participle of the verb “abziehen”) is better translated as “withdrawn from” or “removed from” than as “peeled off”.

15. I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I understand that willful false

statements and the like are punishable by fine or imprisonment, or both, under
Section 1001 of Title 18 of the United States Code.

A handwritten signature in black ink, appearing to read "David Clayberg", is written over a horizontal line.

David Clayberg

Dated: June 1, 2024 in Santa Monica, California

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing Declaration of David Clayberg was served electronically via e-mail on June 27, 2024, in its entirety on the following:

Michael S. Neustel (Reg. No. 41,221)
NEUSTEL LAW OFFICES, LTD
2534 South University Drive, Suite #4
Fargo, ND 58103
Tel: (701) 281-8822
michael@neustel.com

Monte M. Bond (*Pro Hac Vice*)
NEUSTEL LAW OFFICES, LTD
2534 South University Drive, Suite #4
Fargo, ND 58103
Tel: (701) 281-8822
monte@neustel.com

Scott A. McKeown (Reg. No. 42,866)
WOLF, GREENFIELD & SACKS, P.C.
601 Massachusetts Avenue, NW
Washington, DC 20001
Tel: (202) 389-6025
Scott.McKeown@WolfGreenfield.com

By: /Patrick A. Doody/

Patrick A. Doody, Reg. No. 35,022
Pillsbury Winthrop Shaw Pittman LLP
1650 Tysons Blvd, Suite 1400
McLean, VA 22102
(703)770-7900
patrick.doody@pillsburylaw.com