

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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OMEGA LINER COMPANY, INC.,

Petitioner

v.

BUERGOFOL GmbH,

Patent Owner.

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

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**PATENT OWNER'S MOTION TO SEAL AND REQUEST TO ENTER  
PROTECTIVE ORDER PURSUANT TO 37 C.F.R. §§ 42.14 AND 42.54**

## I. INTRODUCTION

Patent Owner (“PO”) submits this motion to request that the Board seal Exhibits 1060-1063 submitted with Petitioner’s Reply on October 7, 2024. In light of the PTO Rules allowing a party filing a motion to seal confidential information to file a request for entry of a protective order, 37 C.F.R. §§42.54, PO also requests entry of the attached protective order (EX 2017). The attached protective order is the result of negotiations, minor modifications, and final agreement amongst counsel for Patent Owner and Petitioner, culminating in an email dated July 30, 2024, from Mr. Neustel, counsel for Petitioner to Mr. Doody, counsel for Patent Owner stating: “Omega agrees with your proposed changes to the standard protective order.”

The PTAB set out the requirements for a motion to seal in the Informative Order in *Argentum Pharmaceutical LLC v. Alcon Research, Ltd.*, IPR2017-01053, paper 27 (Jan. 19, 2018):

A party moving to seal must show “good cause” for the relief requested. 37 C.F.R. § 42.54(a). We direct the parties to prior Board decisions for guidance on how to establish “good cause” to seal a document or thing in an *inter partes* review. *See Garmin Int’l v. Cuozzo Speed Techs., LLC*, Case IPR2012-00001 (PTAB Mar. 14, 2013) (Paper 34) (“IPR001”) and *Corning Optical Communications RF, LLC, v. PPC Broadband, Inc.*, Case IPR2014-00440 (PTAB April 6, 14, and 17, 2015) (Papers 46, 47, 49) (“IPR440”).

*Argentum*, paper 27, pp. 2-3. The *Corning* case referenced in *Argentum* set forth a three-prong test to satisfy good cause. *Corning*, paper 47, pp. 2-3. The

definition of confidential information is found in 37 C.F.R. §42.2 as “trade secret or other confidential research, development, or commercial information.” The standard for granting a motion to seal is “for good cause.” 37 C.F.R. § 42.54. PO, as the moving party, has the burden of proof in showing entitlement to the requested relief. 37 C.F.R. §42.20(c). For the following reasons, Patent Owner submits that has shown good cause as to why Exhibits 1060-1063 should be sealed.

## **II. PETITIONER SHOWS GOOD CAUSE AND SATISFIES THE ANALYSIS FOR GOOD CAUSE SET OUT IN *ARGENTUM***

The *Corning* case referenced in *Argentum* set forth a three-pong test to satisfy good cause, and *Argentum* established the framework for establishing good cause. The PTAB held in *Argentum*:

“Good cause” for sealing is established by a “sufficient explanation as to why” the “information sought to be sealed is confidential information” (IPR001, Paper 34, 3), a demonstration that the information is not “excessively redacted” (IPR440, Paper 46, 2), and a showing that, on balance, the strong “public[] interest in maintaining a complete and understandable record” is outweighed by “the harm to a party, by disclosure of information” and “the need of either party to rely specifically on the information at issue.” IPR440, Paper 47, 3 (footnote omitted).

Consequently, a movant to seal must demonstrate adequately that (1) the information sought to be sealed is truly confidential, (2) a concrete harm would result upon public disclosure, (3) there exists a genuine need to rely in the trial on the specific information sought to be sealed, and (4), on balance, an interest in maintaining

confidentiality outweighs the strong public interest in having an open record. 37 C.F.R. § 42.54(a); IPR440, Paper 47, 2–3; IPR440, Paper 49, 2.

*Argentum*, IPR2017-01053, Paper 27, 3-4. PO presents the following information to show good cause for sealing Exhibits 1060-1063 below.

**A. Identification of the Exhibits PO Seeks to Seal and Brief Description of the Subject Matter of the Exhibits**

The identity of the documents Patent Owner seeks to seal by this motion are as follows:

- Exhibit 1060 is an English language translation of an email from a customer of PO to PO discussing an issue with two films that were sold by PO to that customer;
- Exhibit 1061 purports to be an original of that email in German;
- Exhibit 1062 is a German language affidavit by an individual that appears to have attached the German language email of Exhibit 1061; and
- Exhibit 1063 is a translation of Exhibit 1062, along with a translation of the email, which was provided as Exhibit 1060.

PO refers to Exhibits 1060-1063 collectively by reference to Exhibit 1063. Page 4 of Exhibit 1063 provides the substance of the email. In this email, PO's customer who purchased inner tubular films from PO, (referenced in the email as "inner foil"), explains an issue unknown un-identified end-use customer(s) allegedly had with a final product (liner) that contained PO's inner tubular film. The final product (liner) is typically prepared by PO's customer by, as best understood, combining PO's inner tubular film with unknown

additional films, curable resins, etc. That final liner product then typically is used to repair underground pipes, but the actual use of the unknown and unidentified customer(s) is not described in the email. The email contends, without support, that the difficulty the unknown customer(s) experienced was due to PO's inner tubular film, and it references the films by their order numbers.

**B. The Subject Matter of the Exhibits is Confidential**

PO does not publish or otherwise make publicly available private communications it has with its customers, suppliers, service providers, and the like. The information contained in these exhibits references specific films sold commercially by PO, and discloses highly sensitive business information that is specifically related to PO's commercial products. In addition, PO has designated communications similar to EX1063 as highly confidential - attorneys eyes only in the corresponding litigation matter. The information contained in these exhibits falls squarely within the definition of "confidential information" as both confidential development, and commercial information. *Cuozzo*, paper 34, pg. 2; 37 C.F.R. §42.2. Petitioner has provided "sufficient explanation as to why" the "information sought to be sealed is confidential information" (IPR001, Paper 34, 3; *Argentum*, IPR2017-01053, Paper 27, 3.

Petitioner has not redacted, and PO does not propose any redactions to Exhibits 1060-1063.

**C. The Public Interest is Outweighed by the Potential Harm to PO  
and the Lack of Need to Rely on Exhibits 1060-1063**

PO respects the public's interest in maintaining a complete and understandable record. In the present case, however, the public interest is outweighed by the potential harm to PO, and the lack of Petitioner's ability to reasonably rely on these exhibits.

1. Exhibits 1060-1063 are harmful to PO

The adverse harm to PO is evident – customer complaints made public damage PO's image in the eyes of existing and potential customers. As is evident from EX1060-EX1063, this was a complaint that referenced a follow up, and failing to provide that follow up evidence harms PO even more severely. PO very well could have completely resolved the issue favorably, but by only presenting the initial document, PO's reputation is damaged. In fact, PO never responded to this email, or a follow up email, and the matter was not discussed further amongst PO and the customer. There is no reason why Petitioner must specifically rely on this document.

Petitioner failed to provide PO with a copy of the document prior to sand-bagging PO with it in its reply,<sup>1</sup> despite apparently having it for three

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<sup>1</sup> EX1060-EX1063 appear to concern the document that Petitioner's counsel mentioned it had just received in the telephone conference with the Board held on September 17, 2024, (EX1057, pg. 25, ll. 12-13), but yet it only provided it

weeks. Moreover, Petitioner was aware that Exhibits 1060-1063 contained the very types of highly sensitive commercial information that PO has designated confidential and attorneys eyes only in the corresponding litigation matter. In fact, Petitioner's counsel admitted it was purposefully side-stepping the protective order in the litigation by directly contacting PO's customers to obtain documents similar to those that PO had designated confidential and attorneys eyes only in the litigation, and thus could not be filed in these proceedings. *See* EX1057, pg. 25, l. 20 to pg. 26, l. 1. Exhibits 1060-1063 are precisely the types of documents PO has designated highly confidential, attorneys eyes only in the corresponding litigation. In sum, the adverse consequences to PO are real and present, and Petitioner has failed to present any legitimate basis upon which it "must rely" on Exhibits 1060-1063.

2. Petitioner cannot rely on Exhibits 1060-1063 for what Petitioner contends they purport to show, and they are not relevant to any merits issue in this proceeding

Petitioner has no legitimate need to rely on the information, and it is not germane to in the merits of this proceeding. In fact, Petitioner cannot rely on this email to show what Petitioner contends it shows because Petitioner has not presented any evidence that the unknown third-party end-users actually did

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to PO via e-mail at 2 am, Sunday morning, October 6 (nearly 3 weeks later), and then made it public 25 hours later when it filed its reply at 2:45 am, Monday morning, October 7

experience that problem, or that the problem was in fact due to PO's inner tubular film. There are multiple layers of hearsay Petitioner must overcome, which it cannot, to prove that what is stated in the email is indeed factual. First, Petitioner presents no evidence that there actually was any issue the unknown, un-identified third-party actually experienced. Second, there is no evidence that whatever the ultimate issue was, if it even existed, was actually due to some feature of PO's film, and not due to the modifications made to the film when PO's customer combined it with other materials, and then the unknown third-party end-users likely improperly inserted the liner product into a sewage pipe. Indeed, it is quite likely that the individual sending the email to Petitioner over-exaggerated the alleged problem in an attempt to obtain a discount, which this particular customer of PO did numerous times.

Petitioner has failed to present any evidence that either of the inventors who submitted declarations in these proceedings ever actually read the email, or were even aware of whatever unknown problem is mentioned therein. Note that the German version of the email appearing at EX1062, p. 3 of 4, as well as the English translation of the email appearing at EX1063, p. 4 of 5, erroneously omit the "Cc:" contained in the original German email of EX1061 in order to make it appear that the email was sent directly to the inventor Abdel Boutrid. In fact, the sender of this email never received a reply from PO, he sent a subsequent follow up and did not receive a reply, and the issue was not discussed any further. There is no evidence that the inventor Abdel Boutrid

ever read the email, considered its contents, or was otherwise made aware of the unknown problem vaguely referenced in EX1063. Mr. Schleicher's name appears nowhere on the email.

Petitioner's need to rely on these exhibits is further suspect because the testimony Petitioner is attempting to discredit by using the exhibits is testimony that was NEVER made by PO's witnesses. Petitioner grossly mischaracterizes PO's witnesses' testimony, without directly quoting that testimony, and contends that the "two inventor declarations falsely claim there were never any adhesion and tearing issues with PO's inner film before the 'Spring of 2012,'" citing EX2003, ¶¶22-24; EX2004, ¶¶14-19). Petitioner's Reply at 15. The inventors did NOT broadly claim there were no "adhesion" problems before the Spring of 2012, as Petitioner alleges. Rather, Dr. Boutrid disclosed in paragraphs 14-19 of his declaration that he first became aware of the inner film **TEARING** while being withdrawn due to a *new material used* in the customer's UV curable resin that strongly adhered to the polyamide. This is clearly not a generic problem of "adhesion," but a very specific and unique problem that Petitioner conveniently glosses over. And Dr. Boutrid made it clear that it was not simply adhering to the polyamide in a manner that made it difficult to remove, but rather it adhered so strongly that the *film tore, large pieces broke off and blocked the pipe*. EX2004, ¶14, emphasis added.

Mr. Schleicher provides similar testimony in his declaration, where he describes the inner tubular film being "*torn off* and broken as it was being

withdrawn from the renovated pipe.” EX2003, ¶22, emphasis added. Mr. Schleicher further explains that that was the first time he 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.” *Id* at ¶23.

The inventors therefore presented very clear testimony that the problem that they first observed in the Spring of 2012 was the inner tubular film **TEARING** as it was being withdrawn, and that at that time the inventors believed that the reason for this was because of a new material, maleic anhydride, used in the UV-curable resin of the customer, was strongly adhering to the polyamide film.

Exhibit 1063 does not even use the word “adhesion” or “adhere” and actually discloses no tearing at all. The email specifically states that the unknown, third-party, end-user customers were able to remove the film without tearing. All that is mentioned is that it was difficult. Exhibit 1063 provides no explanation as to why it was difficult or what caused the difficulty, yet Petitioner unfairly, and without any factual basis, attributes the difficulty to some generic “adhesion” problem. Exhibit 1063 NEVER mentions tearing, or any issues with any material in the UV curable resin. Petitioner cannot reasonably contend that Exhibit 1063 rises to the level of “inconsistent evidence,” when it is silent with respect to any of the testimony referenced in the two inventors’ declarations, and when Petitioner has failed to establish that

the inventors were even aware of this email. The Exhibits do not advance any of the issues related to patentability, and their probative value in discrediting the inventor's testimony is zero. PO therefore has established that there is no need for Petitioner to rely on Exhibits 1060-1063.

3. PO's harm is far outweighed by the public's interest in having an open record

Exhibits 1060-1063 have no public value at all with respect to whether the Challenged Claims of the '882 patent are patentable. Indeed, maintaining these exhibits in the public record would create more confusion than maintaining a complete and understandable record. There can be no debate that publicly disclosing commercially sensitive business information of PO causes reputational harm to PO, as well as making it more difficult for PO to carry on its business by engaging in candid conversations with customers, vendors, and suppliers because those customers, vendors, and suppliers may be reluctant to do business with PO if there is a concern that their private, business conversations are made public. Finally, for the reasons stated above, there is no need for Petitioner to rely on any information in Exhibits 1060-1063, and their evidentiary value is zero.

In view of the foregoing, PO has carried its burden in showing good cause to seal Exhibits 1060-1063, and respectfully requests that these exhibits be sealed.

Dated: October 28, 2024

Respectfully submitted,

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## CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing PATENT OWNER'S MOTION TO SEAL AND REQUEST TO ENTER PROTECTIVE ORDER PURSUANT TO 37 C.F.R. §§ 42.14 AND 42.54, was served by filing this document on the date indicated below through the Patent Trial and Appeal Case Tracking System (P-TACTS) and via e-mail to the following attorneys of record for the Patent Owner listed below:

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