

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OMEGA LINER COMPANY, INC.,
Petitioner,

v.

BUERGOFOL GmbH,
Patent Owner.

IPR2023-01372
Patent 9,657,882 B2

Before GRACE KARAFFA OBERMANN, KIMBERLY MCGRAW, and
JAMES J. MAYBERRY, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5(A)

On October 24, 2024, a conference call was held between counsel for Petitioner, counsel for Patent Owner, and Judges Obermann, McGraw, and Mayberry. The purpose of the call was to discuss Patent Owner's request for options to address various concerns about Petitioner's Reply and related exhibits, and Petitioner's response to those concerns. The issues in the email (Ex. 3002) were discussed at length. Petitioner filed a transcript of the teleconference, which was prepared by a court reporter present during the call. *See* Ex. 1080 (transcript).

*A. Patent Owner's Request to File Motion to Strike and Expunge –
Work Product*

Patent Owner is authorized to file a combined motion to strike portions of Petitioner's Reply and to expunge Exhibits 1070–1072. Patent Owner should identify which portions of the Reply should be stricken and why. Patent Owner should provide explanations of the law supporting the assertion that the exhibits are attorney work product and, further, explain the facts surrounding Patent Owner's efforts to preserve them as confidential by restricting their public accessibility. For example, Patent Owner should address the reasons for the delay in seeking to preserve them as confidential, from the public filing of the exhibits until the date requesting the conference call, and whether this delay constitutes a waiver of privilege for work product. Documents supporting assertions of the inventor's duty to Patent Owner and concerning waiver may be included as appendices. Patent Owner has four business days from the entry date of this order to file the motion, which is limited to five pages length, plus appendices.

Petitioner has four business days after the date Patent Owner files its motion to file an opposition, limited to five pages.

The parties are directed to guidance in *Argentum Pharm. LLC v. Alcon Research, Ltd.*, Case IPR2017-01053, Paper 27 (PTAB, Jan. 19, 2018) (informative), which provides information on the showing required of a party asserting confidentiality of documents.

B. Patent Owner's Request to File Motion to Strike Allegedly New Issues Relating to Unexpected Results

Patent Owner requests authorization to strike the entirety of Petitioner's Reply, asserting that the Reply "presents a number of arguments regarding Patent Owner's unexpected results," which is based on a declaration that is a "verbatim repeat of examples of the "'882 patent, as required under the PTAB rules." Ex. 3002 § 1(b) (citing Reply 9–15). Patent Owner asserts that the Reply raises new issues that should have been in the Petition as Patent Owner did not submit any new evidence, "other than what could have been readily obtained by Petitioner prior to submitting the Petition" and that Petitioner should not be able to criticize this data in its Reply when it could have provided this critique in the Petition. *Id.*

Patent Owner is authorized to file a separate motion to strike Petitioner's Reply related to Patent Owner's evidence of unexpected results as being new arguments. Patent Owner should include support for the argument that Petitioner, under the particular facts presented, was required to preemptively address secondary considerations in the Petition. Patent Owner should also identify which specific pages and line numbers in the Reply that Patent Owner asserts improperly raise new issues. Patent Owner has four business days from the entry date of this order to file the motion, which is limited to five pages length.

Petitioner has four business days to file an opposition, limited to five pages.

C. Patent Owner's Request for Authorization to File Motion to Strike New Issues Not Relevant to the Merits or to File New Evidence

Patent Owner seeks authorization to file a motion to strike Petitioner's Reply, or portions of Petitioner's Reply, or authorization to file affidavits in response to "Petitioner's new credibility attacks" of co-inventors Dr. Boutrid and Mr. Schleicher. *See* Ex. 3002 § 1(c) (citing Reply 15–21), § 3. Patent Owner asserts that the Reply attempts to discredit Dr. Boutrid and Mr. Schleicher with documents that it had in hand prior to their scheduled depositions, but which were cancelled by Petitioner shortly thereafter. *Id.* § 1(c). Patent Owner requests that if authorization to file a motion to strike is not granted, that it be permitted to address the newly submitted non-merits-based evidence and arguments in its sur-reply by submitting "very brief declaration testimony" from either Dr. Boutrid or Mr. Schleicher or both.

Patent Owner's request to file a motion to strike Petitioner's Reply on this basis is denied. Neither Patent Owner's email, nor Patent Owner's counsel during the teleconference, presents good cause why Petitioner's evidence asserted to discredit the credibility of two co-inventors is improper or should be stricken.

Patent Owner is authorized to file a separate motion for authorization to file declaration testimony. The motion should be accompanied by the declaration testimony that Patent Owner seeks to file, or if finalized declaration testimony is not available, then the motion should address with particularity what specific issues the declaration testimony will address.

Patent Owner should also state whether the declarants will be made available for cross-examination, either in person or through electronic means, if the additional declaration testimony were to be admitted. Patent Owner has four business days from the entry date of this order to file the motion, which is limited to five pages length.

Petitioner has four business days from date of Patent Owner's motion to file an opposition, limited to five pages.

D. Patent Owner's request to refer this matter to Director Vidal

Patent Owner "requests that the Honorable Board refer this matter to Director Vidal for further consideration." Ex. 3002 § 4. Patent Owner's request is denied for the reasons stated during the teleconference.

E. Petitioner's request to waive 21-day period before filing a motion for sanctions

Petitioner requests authorization to file a motion for sanctions, waiving the requirement for a 21-day safe harbor as provided in 37 C.F.R. § 42.11(d)(2). Ex. 3002 at 3.

Petitioner's motion is denied for reasons stated during the teleconference.

F. Provisional sealing of exhibits

Petitioner filed Exhibits 1060, 1061, and 1070–1072 in the public record on October 7, 2024. Patent Owner did not object to the filing of these documents in the public record until October 24, 2024, when Patent Owner reached out to the Board's trial division, in a phone call on the morning of the scheduled teleconference with the panel, to request that these publicly-filed documents be placed and maintained under seal provisionally, in view of the upcoming teleconference set for that same day, which would address

Patent Owner’s request to file a motion to seal Exhibits 1060 and 1061 and to expunge Exhibits 1070–1072.

As stated during the telephone conference, Patent Owner does not require prior authorization to file a motion to seal material asserted to contain confidential information. *See, e.g.*, Patent Trial and Appeal Board’s Consolidated Trial Practice Guide (November 2019) (“CTPG”) § II.A(2).¹ Four days after the call, on October 28, 2024, Patent Owner filed a motion to seal Exhibits 1060–1063² and to request entry of a modified protective order. Paper 28.

During the teleconference held on October 24, 2024, Petitioner requested that we clarify the status of Exhibits 1060, 1061, and 1070–1072. *See* 37 C.F.R. § 42.14. We confirmed that, after Patent Owner called the Board’s trial division on the morning of October 24, 2024, these exhibits were placed under seal provisionally as a “ministerial function” pending submission and resolution of Patent Owner’s motion to seal and that the documents were not sealed based on any consideration of the merits, by the panel or any adjudicating entity, of Patent Owner’s position that these documents contain confidential information owned by Patent Owner. *See* CTPG at 19–20 (stating, *inter alia*, that a document “will be provisionally sealed upon receipt of the remotion and remain so pending the outcome of the decision on motion”).

¹ *Available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

² This motion to seal addresses two exhibits, Exhibits 1062 and 1063, which were not a subject of the teleconference. *Compare* Paper 28, *with* Ex 3002. Contemporaneously with this Order, we *sua sponte* provisionally seal Exhibits 1062 and 1063, which were filed in the public record on October 7, 2024.

ORDER

It is

ORDERED that Patent Owner's request to file a motion to strike portions of Petitioner's Reply related to Exhibits 1070–1072, and to expunge Exhibits 1070–1072, is *granted* pursuant to the terms stated in this Order;

FURTHER ORDERED that Patent Owner's request to file a motion to strike portions of Petitioner's Reply, as to secondary considerations related to unexpected results, as being new arguments, is *granted* pursuant to the terms stated in this Order;

FURTHER ORDERED that Patent Owner's request to file a motion to strike Petitioner's Reply, or portions of Petitioner's Reply, or based on "Petitioner's new credibility attacks" on two co-inventors is *denied*;

FURTHER ORDERED that Patent Owner's request to file a motion to file new declaration testimony with its sur-reply "to address the newly submitted non-merits-based evidence and arguments presented in Petitioner's Reply" is *granted* pursuant to the terms stated in this Order;

FURTHER ORDERED that Patent Owner's request for the Board to refer this "matter" to Director Vidal is *denied*;

FURTHER ORDERED that Petitioner's request to waive the 21-day safe harbor provisions for filing a motion for sanctions in 37 C.F.R. § 42.11(d)(2) is *denied*.

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