

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

**PATENT OWNER'S MOTION TO STRIKE SECTIONS IIIA, IIIB, AND
IIIC OF PETITIONER'S REPLY**

As authorized (Paper 30), Patent Owner Buergofol GmbH (“Patent Owner”) moves to strike portions of Petitioner Omega Liner Company, Inc.’s (“Petitioner”) Reply (Paper 24). Patent Owner seeks to strike the entirety of Petitioner’s new argument regarding secondary evidence of nonobviousness, first raised in its Reply: the entirety of Section III.A, III.B, and III.C.

In its Reply, Petitioner attempts to rewrite the Petition by advancing entirely new arguments about secondary considerations of nonobviousness. By statute, “the initial petition [must] identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim. 35 U.S.C. § 312(a)(3).” *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 775 (Fed. Cir. 2018). Accordingly, a “reply may only respond to arguments raised in the ... patent owner response,” 37 C.F.R. § 42.23(b), and may not “raise[] a new issue or belatedly present[] evidence.” PTAB Consolidated Trial Practice Guide (November 2019) (“CTPG”), p. 74.

Here, Petitioner’s Reply arguments were not raised in the Petition and are not responsive to any new data or new comparison made by Patent Owner. Rather, they represent an attempt to fill gaps in the petition with new arguments, and the Board should strike them from the Reply.

The Reply’s main arguments are premised on secondary consideration of nonobviousness. To the extent the Petition discusses secondary considerations, it is limited to general allegations based on copying and commercial success (Petition, Paper 2, pp. 63-64). The Petition lacks discussion of the closest prior

art, arguments regarding the scope of results being commensurate in scope with the claims, or arguments regarding unexpected results. Petitioner's choice to newly argue these positions in the Reply is improper and untimely.

A. The Board Should Strike Section III.A of Petitioner's Reply

The Reply argues that Patent Owner failed to compare its results to the closest prior art. This is improper. *See Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed Cir. 2016) (Board properly struck new argument on what “an ordinary artisan would have considered [] obvious”). The Petition fails to discuss any comparison of examples B1-B6 with V1. The comparison of examples B1-B6 with V1 is evidence cut-and-pasted from U.S. Patent No. 9,657,882 (“the ’882 patent”). Compare: EX2004, ¶¶ 24-30 of Boutrid Declaration with EX1001, col. 13, l. 12 to col. 14, l. 24; EX2004, ¶ 32, beginning with TEGO® to ¶33 with EX1001, col. 14, l. 29 to col. 59; EX2004, ¶¶ 34-36 with EX1001, col. 15, ll. 1-17; EX2004, ¶ 37, first sentence and Table with EX1001, col. 15, ll. 18-38; EX2004, ¶¶ 38, 39 with EX1001, col. 15, ll. 29-67; EX2004, ¶¶ 40-48 with EX1001, col. 16, l. 3 to col. 18, l. 9; EX2004, 49-59 with EX1001, col. 18, l. 23 to col. 20, l. 13. The tables and data are all identical, and the wording is only slightly different in certain instances.

The only technical details that were added in EX2004 can be found in paragraph 37 where the inventor describes the amount of migrating compound inherent in the polymer used to fabricate Comparative Example V1. All that is

described by the inventor is what Durethan B40 FAM was made from, which is inherent in the '882 Patent, and should have been readily and easily obtainable by Petitioner prior to filing the Petition. Because the data in paragraphs 24-59 of Dr. Boutrid's Declaration (EX2004) are identical to the data in the '882 patent (EX1001), this evidence was already in Petitioner's possession at the time the Petition was filed. Petitioner therefore had every opportunity to, and should have addressed any alleged failure to compare the results disclosed in the '882 patent to the closest prior art, but failed to do so. The Reply does not address any new data or arguments made by Patent Owner in its Response. The Petitioner cannot *now* decide to replace its insufficiently supported Petition with a new argument. *See Acceleration Bay*, 908 F.3d at 775. The Board should strike section III.A from the Reply.

B. The Board Should Strike Section III.B of Petitioner's Reply

In its Petition, Petitioner argues commensurability and nexus *only* with respect to Patent Owner's contentions of copying and commercial success. Petitioner did not provide any supplemental explanation or argument addressing the unexpected results described in the '882 patent. In its Response, Patent Owner identified these deficiencies (PO Response, Paper 13, pg. 60). In Reply, Petitioner newly argues that the testing and results in the '882 patent have no nexus and are not commensurate in scope with the claims. Petitioner does not respond to new data or new arguments made in Patent Owner's Response; Dr. Boutrid's declaration simply repeats the language of the

examples contained within the '882 patent. Petitioner's Reply makes much of PO's expert not knowing how much migrating compound is present in Constab® PE-SA 270, (Reply at pp. 10-11), but Petitioner never deposed inventor Boutrid, who did know. PO's expert Dr. Brant would have no reason to know this, he testified that he relied on Boutrid's testimony, and testified that if he was going to use any material in a film, he would call the supplier to determine what was in it (EX1052, pg. 111, ll. 15-22; pg. 113, l. 19-pg. 114, l. 7). Dr. Boutrid did just that, had Petitioner bothered to ask him, and Petitioner could have done the same (in a matter of minutes) prior to filing the Petition. Petitioner's attempt to rewrite its obviousness theory by offering new alleged motivations and expectations of success is improper. *See Intelligent Bio-Sys., Inc.* 821 F.3d at 1369 (Fed. Cir. 2016); *Coherus Biosciences Inc. v. AbbVie Biotech. Ltd.*, IPR2016-00188, Paper 54 at 33-23 (PTAB Jun. 9, 2017) (disallowing Petitioner's shift to a new motivation argument).

Petitioner made a strategic choice and did not present this argument in the Petition. Petitioner should be held to its strategic choices and the entirety of section III.B should be struck from the Reply.

C. The Board Should Strike Section III.C of Petitioner's Reply

Glaringly absent from the Petition is any discussion regarding the unexpected results described in the '882 patent, but Petitioner now seeks to attack them in the Reply. Petitioner was aware of the very evidence of unexpected results that Patent Owner relies on when it filed its petition, but

failed to analyze such evidence, much less rebut it. *Praxair Distribution, Inc. v. Mallinckrodt Hospital Products*, IPR2016-00777, Paper 10 at 9 (PTAB Sep. 22, 2016) (concluding that the petitioner should have addressed available evidence of secondary considerations in the petition). Any attempt to address surprising or unexpected results in the Reply is untimely and should be ignored.

The specification of the '882 patent uses the terms “surprising” and “unexpected” to describe these results no less than five times. The '822 patent also includes comparative examples of these unexpected results. Patent Owner submitted the *same* data and examples in the '882 patent in its Response. Petitioner belatedly attempts to argue against the unexpected results disclosed in the '882 patent itself. Those are precisely the type of arguments that should have been presented in the Petition but were not. *See Intelligent Bio-Sys.*, F.3d at 1370; ; *Praxair Distribution*, IPR2016-00777, Paper 10.

In short, Petitioner’s attempt to cure the deficiencies of its Petition is a prime example of the tactics that Rule 42.23(b) is designed to guard against. *See* CTPG at 74. As such, the Board should strike the entirety of section III.C from the Reply.

For the foregoing reasons, Patent Owner asks the Board to strike the entirety of sections III.A, III.B, and III.C from Petitioner’s Reply.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing PATENT OWNER'S MOTION TO STRIKE SECTIONS IIIA, IIIB, AND IIIC OF PETITIONER'S REPLY, 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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