

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Omega Liner Company, Inc.,

Petitioner

v.

Buergofol GmbH,

Patent Owner

Case IPR2023-01372

U.S. Patent 9,657,882

**PATENT OWNER'S MOTION TO FILE NEW EVIDENCE IN THE FORM
OF DECLARATIONS FROM DR. BOUTRID AND MR. SCHLEICHER**

In the section of the Order (Paper 30) titled “Patent Owner’s Request for Authorization to File Motion to Strike New Issues Not Relevant to the Merits or to File New Evidence,” the Board denied the request of Patent Owner (PO) to file a motion to strike Petitioner’s entire Reply but granted PO’s request to file a motion to file new evidence. Specifically, the Board stated:

“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.” (Paper 30, 4:22-26)

Accordingly, PO moves for authorization to file declaration testimony in the form of the “Second Declaration of Abdel-Kader Boutrid” (provisional EX2028) and the “Second Declaration of Gregor Schleicher” (provisional EX2029). See the declarations themselves for an understanding of their contents. Dr. Boutrid and Mr. Schleicher will be made available for cross-examination, either in person or preferably through electronic means, if the declaration testimony is admitted.

The co-inventors Dr. Boutrid and Mr. Schleicher have already submitted declarations in this IPR proceeding. Petitioner then noticed the cross-examination depositions of Dr. Boutrid and Mr. Schleicher for August 8 and 9, 2024, respectively, in Washington D.C. Dr. Boutrid and Mr. Schleicher flew from Germany to the United States in order to attend their depositions. After they were both already present in the United States and ready to have their depositions taken,

Petitioner the evening before Dr. Boutrid's deposition announced that Petitioner would not take the depositions. This was very surprising because Petitioner has been trying for nearly two years to depose Dr. Boutrid, and Petitioner's counsel told PO's counsel after Dr. Brant's deposition was completed that it had not decided on who would take Dr. Boutrid's deposition the following morning. These facts support PO's contention that Petitioner never intended on taking the two scheduled depositions. Dr. Boutrid appeared at the noticed time the following morning on August 8, 2024 and gave testimony under penalty of perjury, before a certified court reporter. Petitioner's counsel did not attend, having canceled Dr. Boutrid's and Mr. Schleicher's deposition the night before. Petitioner's counsel received a copy of the transcript of Dr. Boutrid's testimony.

On August 23, 2024, Petitioner's counsel sent PO's counsel a letter making allegations of "inequitable conduct" and breach of the "duty of candor and good faith" against Dr. Boutrid and Mr. Schleicher. Petitioner's letter of August 23, 2024 was discussed during a conference call with the Board on September 17, 2024. Petitioner's allegations are based on a lack of understanding, or a misrepresentation, of the relevant facts. Petitioner's lack of understanding of the facts could have been resolved had Petitioner taken the depositions that it noticed. Petitioner's counsel deliberately did not ask questions about two notable issues:

- 1) certain warranty complaints and communications with PO's former customer Saertex that Petitioner now claims show that Buergofol's inventors made false

statements in their declarations, and 2) facts relating to the chemical constituents of Constab® PE-SA 270 that Petitioner claims show that the inventors made false statements in their declarations. Petitioner knew prior to filing its Reply that Dr. Boutrid in fact knew the chemical constituents of Constab® PE-SA 270 (August 23, 2024, letter includes ten cites to passages to the transcript of the testimony Dr. Boutrid gave on August 8, 2024), but yet falsely stated in its Reply that PO did not know it (Paper 24, pp. 11, 13).

On October 7, 2024, Petitioner filed Petitioner's Reply (Paper 24). The section titled "PO's Declarations Lack Credibility" alleges that the two inventor declarations contain "False Statements About Knowledge of Adhesion Problems." The Reply alleges there to be "False Statements About EBS Wax in Examples B4-B6" in the inventor declarations. The inventors, to be able to defend themselves against Petitioner's unfounded allegations, must be able to bring additional facts to the Board's attention because those facts rebut the false allegations. The only way to raise facts to the Board's attention is by submission of declaration testimony.

With respect to Petitioner's allegation that the inventors' declarations "falsely claim" that there never was any adhesion and tearing problem with PO's inner film before the spring of 2012, Petitioner's Reply introduces hearsay documents from and relating to PO's former customer Saertex. Petitioner argues that those documents prove knowledge by Buergofol's inventors before 2012 of the problem that the inventors declare in their declarations to have first recognized in 2012. To

defend themselves from these allegations, the inventors must be able to explain, with facts, how and why Petitioner's allegations based on misconstruing and failing fully to quote the inventors' declarations, and misconstruing the Saertex documents are false. The inventors can only do this effectively with reference to additional facts not now in the record. PO did not know to put those facts into the record prior to the present time because PO did not know that Petitioner would make the specious allegations based largely on new documents that were not, prior to the time of the Reply, in the record. In the new declarations, the inventors establish facts showing that the "adhesion problems" mentioned in the Saertex documents were different than the problem of film tearing while being pulled out of a cured liner due to becoming bonded to the cured resin containing a new material that interacted with the outer polyamide layer of the inner tubular film, which was the problem that the inventors solved with the invention. The use of a coating or covering would not have solved the issue discussed in EX1060-EX1063. The inventors also declare from personal knowledge that Saertex exaggerated the adhesion issues as being "massive" in an unsuccessful attempt to obtain warranty rebates on PO's film.

With respect to Petitioner's allegation that the inventors' declarations contain "false statements about EBS wax in the examples B4-B6," Petitioner's Reply argues that "Constab PE-SA 270 is not a 'release wax,' 'EBS wax,' or a 'migrating lipophilic compound.'" (Paper 24, 17:7-8) Petitioner's Reply goes so far as to insinuate that PE-SA 270 may not include any EBS wax, that the

inventors knew this, and that the inventors' declarations therefore contain "false statements." But yet Petitioner knew this statement was false when it acknowledged that Dr. Boutrid knew the presence of and amount of EBS wax in PE-SA 270 in its August 23, 2024, letter to Petitioner. The Reply faults the inventors for not "coming clean" about what PE-SA 270 comprises. But it is Petitioner that is not "coming clean." The inventors need to be able to explain, with facts, why Petitioner's allegations are false. The fact is that the masterbatch supplier Constab had repeatedly confirmed to Dr. Boutrid that PE-SA 270 contains ethylene bis stearamide (EBS). The inventors' declarations and the '882 Patent are correct in that regard. Petitioner's counsel knew of this confirmation by Constab, and was aware of facts pertaining to this confirmation, but yet Petitioner chose to conceal those facts from the Board when it filed its Reply because those facts were inconsistent with the arguments in its Reply. PO and the inventors must be able to submit factual evidence into the record about the EBS content of PE-SA 270 in order to defend themselves from Petitioner's false allegations. Petitioner is trying to conceal these facts from the Board, and that is why Petitioner did not take the deposition of Dr. Boutrid, and why the Reply does not disclose the fact that PE-SA 270 has been repeatedly confirmed to contain 20% EBS.

Mere lawyer argument, without reference to additional facts, is inadequate to defend the inventors from Petitioner's false allegations and new credibility attacks. PO therefore requests authorization to file the declaration testimony.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S MOTION TO FILE NEW EVIDENCE IN THE FORM OF DECLARATIONS FROM DR. BOUTRID AND MR. SCHLEICHER** was served on the date indicated below by filing with the Patent Trial and Appeal Case Tracking System (P-TACTS) and electronically via e-mail to the following attorneys of record for the Petitioner listed below:

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