

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

SECOND DECLARATION OF ABDEL-KADER BOUTRID

I, Dr. Abdel-Kadel Boutrid, do hereby declare:

1. I am a named co-inventor of U.S. Patent No. 9,657,882 (“the ’882 patent”).
2. The statements in this declaration are based on my personal knowledge.
3. At no time have I had any intent to deceive the U.S. Patent Office of anything, ever.
4. At no time have I ever intentionally violated any duty of candor, or any other duty for that matter, that I owe to the U.S. Patent Office.
5. From September 1998 to the present I have been employed by Patent Owner (PO), Buergofol GmbH. After April 2024, my employment status changed from employee to senior consultant in compliance with German labor and retirement laws. My current job title is “Head of Research and Development”. My job responsibilities include overseeing both the manufacture of and quality control for Buergofol’s blown extrusion ultraviolet cured-in-place pipe (“UV-CIPP”) films.
6. PO submitted my declaration (EX2004) dated June 24, 2024 in IPR2023-01372. Petitioner in a Reply document (Paper No. 24) has attacked my credibility (the credibility of certain of my statements made in my declaration) with documents that Petitioner had in hand prior to my scheduled deposition.
7. In the paragraphs below, I provide declaration testimony to address each

of these credibility attacks.

A. Credibility Attack#1: So-Called “False Statements” About Knowledge of Adhesion Problems [Paper No. 24, 15:15-16:11] Based on EX1058-EX1063.

8. In the Reply paper, Petitioner makes the following attack on my credibility:

The two inventor declarations falsely claim there were never any adhesion and tearing issues with PO’s inner film before the “spring of 2012” (EX2003, ¶¶22-24; EX2004, ¶¶14-19) However, there were in fact, “massive” problems.

After making this statement, Petitioner cites a customer complaint dated February 26, 2009 (EX1060- EX1063) from Saertex, a former PO customer, that uses the word “massive,” inviting the reader to conclude that the statement in the Saertex complaint pertained to the tearing problem referred in my declaration. Petitioner goes on to confuse issues by stating that a Quality Management Agreement (EX1058) that I signed in 2006 acknowledging “[s]trong adhesion of the film to the laminate after curing” demonstrates PO’s awareness of “adhesion issues” long before the “spring of 2012.”

9. Contrary to the false statement by Petitioner that my and Gregor Schleicher’s declarations “falsely claim” that there never were any “adhesion and tearing issues” with PO’s inner film, the paragraphs of 14-19 of my declaration are entirely correct. Section 2 of my declaration is titled “Recognition of the Problem.” The problem I refer to in Section 2, which is the problem that led

to conception of the invention of the '882 Patent, involved tearing because of sticking. The Saertex complaint (EX1060- EX1063) does not mention tearing. The Saertex complaint dated February 26, 2009, does not relate to the particular tearing problem that we Buergofol inventors recognized in 2012. The Saertex issue, which did not involve tearing, was a “strong adhesion” problem due to Saertex’s improper installation of liners at cold temperatures. I will explain the two different problems below.

10. **Difficult-To-Remove Problem:** The problem of the 2009 Saertex complaint, which did not involve tearing, was due to Saertex’s customers making ill-advised installations of liners in colder winter temperatures. Note that the complaint was made on February 26 regarding recent installation projects. At low temperatures, the polyamide of the inner film becomes increasingly stiff and brittle. In addition, a proper moisture (water) level must be maintained in the polyamide to reduce its stiffness, and at cold temperatures that moisture may freeze. By a combined mechanical effect that to my knowledge is not entirely understood, a mechanical adhesion is observed between the inner film containing polyamide and the resin at low temperatures, even low temperatures above freezing. This mechanical adhesion is not chemical bonding. As a result of the mechanical adhesion, the inner film becomes difficult to remove from the liner after the resin has

cured. That the inner film described in the 2009 Saertex complaint may have been difficult to remove does not mean that there was tearing. This is the “adhesion problem” Saertex customers were having, and it was their own fault for attempting to install liners at low temperatures.

11. In my opinion, in 2009 the Saertex personnel (including Mr. Fuechtjohann) did not understand the mechanical adhesion problem caused by cold temperatures. There was nothing wrong with the Buergofol film. Saertex through Mr. Fuechtjohann made an attempted warranty claim for the two orders listed in the 2009 Saertex complaint for film that was “extremely difficult to remove” from installed liners. But I, as the Buergofol person in charge of quality, declined to recognize the warranty claim and did not provide replacement film to Saertex for these two orders because there was nothing wrong with PO’s inner film.

12. Saertex used the word “massive” in several complaints, including the February 26, 2009 Saertex complaint, in an attempt to obtain warranty rebates and price reductions. But describing the customer complaints as being “massive” was an attempt to mask the fault of the customers for attempting to install liners in cold winter temperatures. PO supplied dozens of other orders of inner film to Saertex in the months prior to the 2009 Saertex complaint that were all made in the same manner with the same few

recipes. Yet only two of the film orders led to the purported customer complaints “on a massive scale.” It is evident that from the dozens of orders, only the film from the two particular orders listed in the 2009 Saertex complaint was “extremely difficult to remove” because the liners that happened to contain film from those two orders were installed on cold days. I do not recall that Saertex ever complained about film being difficult to remove from liners during warm summer months.

13. The customer complaint from Saertex (EX1060-EX1063) was an email dated February 26, 2009 from Nils Fuechtjohann of Saertex to PO’s salesman Tobias Abfall. Although I and five other people were cc’d on the email, I do not recall reading the email at that time. I later learned that the email states that Mr. Fuechtjohann sent PO’s salesman a sample of the inner film that was purportedly difficult to remove from a liner and asked the salesman for comments on the film sample. I do not believe that the salesman ever responded to the email from Mr. Fuechtjohann. I believe that after a couple of weeks, Mr. Fuechtjohann sent a reminder email to the salesman and to me, but neither one of us responded to that email either. By that time the weather was probably getting warmer, and the purported “massive scale” of complaints from Saertex’s customers about the difficulty of removing film from the liner went away on their own.

14. Saertex frequently exaggerated its concerns by using the word “massive” to describe its complaints. I recall receiving another complaint from Saertex in the winter of 2010 unrelated to removing film from liners in which the technical director of Saertex complained of “massive problems” with film bursting when it was inflated in the pipe to be renovated. I rejected those warranty claims as well because there was nothing wrong with PO’s film. The film was bursting when placed under pressure at the installation sites because it was stiff and brittle in the cold weather. I also recall that in 2010 Saertex described aesthetically unwanted spots and creases in PO’s film as being “massive” problems in an attempt to negotiate a lower price and to obtain warranty rebates. I rejected the warranty claims for nearly all of these “massive” problems because there was nothing wrong with PO’s film.
15. Tearing Problem: The tearing problem that my co-inventors and I recognized and that led to the invention of the ‘882 Patent was not the Saertex problem, but rather involved actual tearing of Buergofol inner film. To my knowledge, Saertex customers did not experience any tearing, and certainly did not experience the particular problem of inner film tearing as it was being pulled out of a cured liner due to the inner film becoming stuck to the cured UV-curable resin.
16. As I explained in my declaration (EX2004, ¶15), Kurt Stark and I learned in

2012 that two Buergofol customers had started using UV-curable resin that included maleic anhydride (MAH). I believed that the maleic anhydride in the new UV-curable resin was probably chemically bonding to the polyamide of the outer film layer adjacent to the UV-curable resin. This bonding is not mere mechanical adhesion. As my declaration states, Kurt Stark and I believed that the maleic anhydride in the resin could be prevented from adhering to the outer polyamide layer of the inner film by creating a coating or covering over the outer facing side of the polyamide in order to separate (i.e., as a sort of barrier) the resin from the polyamide.

17. In Petitioner's Reply (Paper No. 24), Petitioner makes the following attack on my credibility:

Further demonstrating PO's awareness of adhesion issues long before the "spring of 2012," Dr. Boutrid, as PO's "QM/Quality Officer," signed a 2006 Quality Management Agreement with Saertex acknowledging problems with "[s]trong adhesion of the film to the laminate after curing." (EX1058, p. 2 at §1, p. 6 at §7; EX1059, p. 1, §1.)

(Paper No. 24, 16:7-11) Petitioner falsely states that the phrase in the Quality Agreement (EX1058) stating "[s]trong adhesion of the film to the laminate after curing" demonstrates that in 2006 I was aware of and acknowledged the problem of PO's film strongly adhering "to the laminate" after curing.

18. The four possible grounds for complaints listed at §7 of EX1058 (EX1059 English translation), including the adhesion of film to the laminate, were not

actual complaints made by Saertex at the time the agreement was entered into in 2006. The four issues listed in §7 were not any acknowledgment of any problems that existed, but rather were simply proposals for how to deal with certain quality issues, if they were to arise. The four grounds for complaints were developed during a brainstorming session as possible quality deficiencies that PO would recognize if the film did not fall within the allowed tolerances of the listed tests for the particular grounds for the complaint. The testing tolerances for the quality deficiency of strong adhesion of film to the laminate are for the melting point of the polyethylene and polyamide in the film as indicated in Section 2.4 of the agreement. (See EX1058, Page 6 of 7) The hypothetical quality deficiency that we envisaged as “strong adhesion of the film to the laminate after curing” was not the problem of inner film tearing as it was being pulled out of a cured liner due to the film becoming stuck to the cured resin. The melting point of the polyethylene and polyamide in the film is not a measure of the adhesion of the film to the laminate. Moreover, the tearing of the film was not a consideration in our hypothetical quality deficiency in film that strongly adheres to the laminate.

19. The Section 7 of the Quality Agreement (EX1058, Page 6 of 7) does not recognize the problem of inner film tearing as it is being pulled out of a

cured liner due to the inner film becoming stuck to the cured resin.

B. Credibility Attack#2: So-Called “False Statements” About EBS Wax in Examples B4-B6 [Paper No. 24, 16:15-16:11] Based On EX1050-EX1051.

20. In the Reply paper, Petitioner attacks the credibility of the “supporting declarations” (Paper No. 24, 16:13) using documents EX1050-EX1051 that Petitioner had in hand before my scheduled deposition on August 8, 2024. After citing to my declaration stating that Constab PE-SA 270 was made with ethylene bis stearamide (EBS) as a migrating compound, Petitioner asserts that PE-SA 270 is not EBS wax and that my statement that PE-SA 270 is made with EBS wax is false:

However, Constab® PE-SA 270 is not a “release wax,” “EBS wax,” or a “migrating lipophilic compound.” Based on available information, it is an “Antiblock-Slip Masterbatch” comprised mainly of *polyethylene* as a carrier with *calcium carbonate* as an antiblock and an unknown “slow migration antiblock additive.”

(Paper No. 24, 17:7-11) (emphasis in original) Petitioner relies on a Constab PE-SA 270 “Product Information” sheet (EX1051) that does not mention ethylene bis stearamide (EBS), implying that Constab PE-SA 270 may not have included any EBS wax, and that my declaration statements about Constab PE-SA 270 being “made with” or “containing” the migrating compound EBS in the examples of the ‘882 Patent were false. (See EX2004, ¶36)

21. As of August 23, 2024, Petitioner's counsel knew of my deposition and had a transcript, as indicated by a letter dated August 23, 2024, from Petitioner's counsel, an excerpt of which appears below:

During the improper *ex parte* deposition on August 8, 2024, Dr. Boutrid stated the following regarding Constab PE-SA 270 used in Examples B4, B5 and B6 of the '882 Patent:

- In 2012, prior to filing for the '882 Patent, he knew that Constab PE-SA 270 was not 100% EBS wax and in fact did not even have over 20% EBS wax. (Boutrid Dep. Tr., pp. 30-31.)
- In 2023, prior to submitting his declaration in the IPR proceeding, he verbally confirmed again that Constab PE-SA 270 was not 100% EBS wax and in fact did not even have over 20% EBS wax. (Boutrid Dep. Tr., pp. 31-32.)
- On August 8, 2024, Dr. Boutrid again verbally confirmed that Constab PE-SA 270 was not 100% EBS wax and that it did not have over 20% EBS wax. (Boutrid Dep. Tr., pp. 32-33.)

(Letter from Petitioner's counsel to PO's counsel Michael Neustel dated August 23, 2024). I am informed that this letter was discussed with the Patent Office PTAB panel during a conference call on September 17, 2024.

22. At the time Petitioner wrote the Reply referring to the "unknown slow migration antiblock additive," with Petitioner underlining the word "unknown," Petitioner was aware of the transcript of my August 8, 2024 deposition. In my deposition I testified, under penalty of perjury, before a certified court reporter. I testified that in the year 2012 (before the filing date of the '882 Patent) I had confirmed with a Mr. Hoenig of Constab that the Constab PE-SA 270 product contained 20 percent EBS wax. I further testified that I reconfirmed this in 2023. I further testified that on the very morning of my deposition (August 8, 2024) I reconfirmed the matter again.

I testified:

Q. Was there any other time when you reconfirmed, when was that?

A: Today I - - over the phone, I called Constab, and they did confirm that the information I received of the 20 percent back in 2023 is correct.

23. The information about Constab PE-SA 270 that I provided in my deposition, which is inconsistent with Petitioner's argument that Constab PE-SA 270 might not include any EBS wax, was not provided by Petitioner to the PTAB in Petitioner's Reply.

C. Materials That I Reviewed.

24. Prior to signing this declaration, I reviewed the following materials: Petitioner's Reply (Paper No. 24), Declaration of Abdel-Kader Boutrid (EX2004), the transcript of my deposition on August 8, 2024, the exhibits EX1050-EX1051 and EX1058-EX1063, and the letter dated August 23, 2024 from Petitioner's counsel Michael Neustel. I reviewed German translations and I discussed the documents with counsel to make sure I understood them adequately.

I declare that all statements made herein on my own knowledge are true and that all statements made on information and belief are believed to be true, and further, that these statements were made with the knowledge that willful false

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

Date: November 28, 2024 in Casablanca, Morocco

By: 
Abdel-Kader Boutrid