

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

**PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO
STRIKE PORTIONS OF PETITIONER'S REPLY AND TO EXPUNGE
PETITIONER'S REPLY EVIDENCE (PAPER 33)**

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A. Introduction

PO sent Dr. Kurt Stark—an adverse party to Patent Owner **in 12 lawsuits**—an untruthful declaration, giving him three business days to sign it under threat of legal action and “damages.” (EX1068-EX1071.) He correctly declined and alerted Petitioner’s counsel to potential fraud by marking up the declaration to identify its untruthful portions (EX1072), exposing numerous material falsehoods that PO later repackaged as other inventor declarations.

By submitting this declaration to an adverse party, publicly filing other inventor declarations with the same repackaged falsehoods, and foregoing any claim of confidentiality for weeks, PO waived any claim of confidentiality or work product in the disputed exhibits. PO cannot now use a baseless work product claim to conceal the unfavorable marked-up declaration—a previously failed sword and shield tactic. *Spectrum Solutions LLC v. Longhorn Vaccines & Diagnostics, LLC*, IPR2021-00847, Paper 142 at 21-32 (PTAB July 11, 2024).

B. No Confidential Information or Work Product.

1. No Confidential Information—*Argentum* Factors.

PO’s bare attorney argument that Exhibits 1070-1072 qualify as confidential information and/or work product fails to address the four *Argentum* factors. *Argentum Pharm. LLC v. Alcon Research, Ltd.*, Case IPR2017-01053, Paper 27 at 4 (PTAB Jan. 19, 2018). Furthermore, PO did not submit Dr. Stark’s employment agreement, citing nonexistent “District Court use restrictions” (Paper 33, p. 2, fn. 1),

and relies solely on attorney argument and a generic patent assignment agreement that cannot require false statements. As the Board reminded PO's counsel, this is "not like district court where you can just mark something confidential." (EX1080, Tr., 80:17-19.) Yet, PO ignores its burden anyway.

For the first factor, PO fails to identify or prove that any information in the exhibits is confidential. A simple comparison of Dr. Stark's declaration with PO's public filings with the Board shows the information is already publicly available:

Stark Declaration (EX1072)	Public IPR Filings
¶¶1, 3-6, 20-21 (Stark's Background)	EX1040; Paper 13, p. 32.
¶¶2, 35-36, 39-41, 43-44, 53 (the '882 Patent)	EX1001; EX1002; EX2004, ¶¶6, 13, 21, 23; Paper 13, pp. 5-23.
¶¶22 (Work with Dr. Boutrid)	EX2004, ¶13; Paper 13, p. 32.
¶¶7-19, 23-24, 32, 35 (Huhtamaki and Hummel)	EX1005; EX1011; EX1040; EX2003, ¶¶12-21; EX2004, ¶¶9-11, 13; Paper 13, pp. 2, 5, 7-8, 12, 23-57.
¶¶25-34 (Knowledge of Adhesion/Tearing Problems)	EX2003, ¶¶ 19-24; EX2004, ¶¶11-19; Paper 13, pp. 11-12, 32-33.
¶¶42-43, 49-51 (Comparative Example V1)	EX2004, ¶¶ 33, 37, 38; Paper 13, pp. 20-21, 62-63, 68.
¶¶44-48 (Durethan B40FAM and 38F)	EX2004, ¶¶33, 37; Paper 13, pp. 21.
¶¶37-43, 49-54 (Alleged Invention and Unexpected Results)	EX2004, ¶¶ 16-59; Paper 13, pp. 33.

PO does not dispute that the declaration (EX1071) was intended for public filing with the Board, nor does it contest Dr. Stark's mark-ups on his declaration (EX1072) were independently made by him, without any confidentiality obligation and without sharing them with PO.

On the second factor, PO merely asserts that disclosure risks “the potential of losing current and prospective clients” without meaningful explanation (Paper 33, 4:8-10), which does not demonstrate “*concrete* harm”—particularly given that PO has repeatedly disclosed the same information publicly in this proceeding.

For the third factor, PO asserts that Petitioner need not rely on Exhibits 1070-1072 for unpatentability (Paper 33, 4:12-14), ignoring that these exhibits directly address PO’s secondary indicia arguments and expose the lack of credibility of PO’s witnesses, making them *highly relevant* to the contested trial grounds.

Finally, PO fails to address the fourth *Argentum* factor, which balances any confidentiality interest against “the strong public interest in having an open record.” There can be no public interest in concealing fraudulent statements to the USPTO, which clearly violate the Duty of Candor. *Spectrum Solutions*, Paper 142 at 21-32.

2. No Work Product.

PO fails to provide any factual basis for its work product claim, merely asserting, “[t]he Draft Declaration on its face is attorney work product.” (Paper 33, 1:10). However, “[m]erely stating that the documents are an exchange of draft affidavits and communications relating thereto is insufficient to meet that burden.” *ARA Inc. v. City of Glendale*, 2018 WL 2688773, at *2 (D. Ariz. June 5, 2018).

Moreover, a majority of courts, including the District of South Dakota (where the underlying lawsuit is located), hold that a declaration is not protected as work

product. *Murphy v. Kmart Corp.*, 259 F.R.D. 421, 431 (D.S.D. 2009) (“affidavits should not contain the mental impressions or legal theories of the attorney who drafted them, and the majority view is premised on that presumption”); *see also*, *Infosystems, Inc. v. Ceridian Corp.*, 197 F.R.D. 303, 306 (E.D. Mich. 2000) (“An affidavit, after all, purports to be a statement of facts within the personal knowledge of the witness, and not an expression of the opinion of counsel.”)

Additionally, PO acknowledges that “**Dr. Stark is adverse to Buergofol** considering that there have been over a dozen lawsuits between Buergofol and Dr. Stark over the past few years; **many of them are still ongoing.**” (Paper 25, 17:14-16.) By disclosing the declaration to an adverse party without any confidentiality assurance, PO “substantially increased the opportunities for potential adversaries to obtain the information,” thus waiving any work product protection in the declaration and communications. 8 Wright & Miller, *Federal Practice & Procedure* § 2024 (3d ed.); *see also*, *McKenzie L. Firm, P.A. v. Ruby Receptionists, Inc.*, 333 F.R.D. 638, 648 (D. Or. 2019), and *Altschuler v. Chubb Nat’l Ins. Co.*, 2023 WL 4010581, at *3 (D. Ariz. Feb. 27, 2023) (two cases finding waiver of work product for emails and draft declaration sent to a former employee and a “disinterested nonparty”).

Furthermore, PO submitted co-inventor declarations containing the same false statements to support alleged “unexpected results” and POSITA knowledge, improperly attributing to Dr. Stark knowledge of adhesion issues and testing.

(EX2003, ¶¶17-18; EX2004, ¶¶16-17, 20, 23, 32-36.) By submitting the purportedly favorable inventor declarations, PO waived any work product in the unfavorable marked up declaration by Dr. Stark. *Spectrum Solutions*, Paper 142 at 27-28.

Finally, the crime-fraud exception bars any work product protection of the disputed exhibits. 18 U.S. Code § 1512(b); 18 U.S. Code § 1622.

3. PO's Delay to Protect Information.

PO's counsel falsely testified to the Board it waited four business days to review Petitioner's reply. (EX1080, Tr., 9:1-6; Paper 33, 3:13-14, 4:19-20.) In fact, the reply was served on October 7, 2024 at 1:45 am CT, and by 8:33 am CT that same morning, PO's owner had already contacted Saertex questioning its cooperation relative to EX1060. Finally, PO's October 10 letter (EX2026) fails to assert work product or identify any confidential information, with virtually no action until PO's *ex parte* call to the PTAB clerk on October 22—weeks after the reply.

C. PO's Baseless Claim of Petitioner's Non-Compliance with Order.

PO falsely claims Petitioner's non-compliance by mischaracterizing a District Court order, which applies only to *oral interviews*, not independently provided documents, which Petitioner did not violate. (EX2018; *see also*, EX2026, 2:31-34).

D. No Attorney-Client Privilege.

PO mentions “privilege” without explanation, but no attorney-client privilege exists because Dr. Stark had independent counsel, the communications were non-confidential, and aimed to coerce, not render legal advice.

Dated: November 14, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing *PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO STRIKE PORTIONS OF PETITIONER'S REPLY AND TO EXPUNGE PETITIONER'S REPLY EVIDENCE (PAPER 33)*, 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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