

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 SECTIONS IIIA, IIIB, AND IIIC OF
PETITIONER'S REPLY (PAPER 34)**

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A. Introduction.

PO submitted direct testimony on alleged secondary indicia with its principal trial brief that did not exist prior to institution. As is its right, Petitioner conducted cross-examination and submitted responsive evidence and argument. 5 U.S.C § 556(d); 37 C.F.R. §42.53(b). PO argues that Petitioner's response to its new testimonial evidence is improper. However, Petitioner could not have anticipated PO's new testimony, especially testimony that attempts to rewrite the intrinsic record to conceal material defects. PO's motion is without merit and frivolous.

B. Petitioner Has the Right to Respond to PO's Response Filings.

1. Declarations Were Created Post-Institution.

No argument or evidence of "unexpected results" was presented during prosecution of the '882 Patent, nor was any identified in the examiner's Reasons for Allowance. (EX1002, p. 460.)¹ PO does not dispute that the new testimony (EX2001, EX2003, EX2004) was unavailable at the time the petition was filed. Nevertheless, PO argues that Petitioner should have preemptively addressed this non-existent testimony in its petition because it allegedly references text of the patent—even though no such secondary consideration argument or testimony was offered in the

¹ It should be noted the Notice of Allowance stated that "WO 98/12465 is the closest prior art," not comparative example V1. (EX1002, p. 460.)

prosecution history, Petitioner was informed in the litigation that such didn't exist, and the testimony —far from parroting the text of the patent—rewrites it.²

PO submitted a new expert declaration which provides new and extensive testimony on “unexpected results” and other matters. (*See e.g.*, EX2001, ¶¶14-19, 26, 28, 30-35, 50, 56-61, 64, 66-75.) PO’s expert declaration also relies heavily on the new inventor declarations (EX2003, EX2004) and additional evidence for the purported “unexpected results.” (*See e.g.*, EX2001, ¶¶8, 30-33, 57-58, 67-72, 74.)

The rules specifically allow Petitioner to respond to and submit additional evidence in the reply in response to PO’s response. 37 CFR § 42.23(b); *Valmont Indus., Inc. v. Lindsay Corp.*, 730 F. App'x 918, 922 (Fed. Cir. 2018); 5 U.S.C. §

² In the two years since the underlying lawsuit began, PO has never asserted “unexpected results.” Only five months before filing the petition, PO responded to Request for Production 63 stating “‘unexpected results’ have not been ‘alleged’ at the present time in this case.” (EX1081, pp. 35-36.) At the same time, PO responded to Interrogatory No. 9 merely stating that PO “is still investigating the facts relating to secondary considerations, such as ... unexpected results” and nothing more. (EX1038, pp. 9-12.) As of this filing, neither response has been amended by PO.

556(d) (*A party is entitled to present his case or defense by oral or documentary evidence, to submit rebuttal evidence, and to conduct such cross-examination as may be required for a full and true disclosure of the facts*).

PO offers no basis to deny due process to Petitioner, nor could it.

2. PO Cites No Authority to Deny Due Process.

PO cites *Praxair* for the position that the petition should have addressed the purported “evidence” in the ’882 Patent; however, *Praxair* involved declarations already in the prosecution record, which is not the case here. *Praxair Distribution, Inc. v. Mallinckrodt Hospital Products*, IPR2016-00777, Exhibit 1005 at 534-665, 909-982 (PTAB March 23, 2016). In PO’s remaining three cases (*Acceleration Bay*, *Intelligent Bio-Sys.*, and *Coherus*), each involved situations where the petitioner introduced new obviousness arguments/grounds—none involved a petitioner responding to new testimonial evidence to rebut unchanged obviousness grounds, as is the case here. These decisions are inapplicable as Petitioner has not introduced a new theory of unpatentability. Petitioner has consistently argued that no secondary indicia exists that will render the claims patentable. (Paper 2, pp. 63-64.)

C. The Declarations Attempt to Rewrite ’882 Specification.

Setting aside PO’s fundamental failure above, the argument that the declarations are identical to the ’882 Patent text is a shocking misrepresentation. PO states that “**paragraphs 24-59** of Dr. Boutrid’s Declaration (EX2004) are **identical**

to the data in the '882 patent (EX1001).” (Paper 34, 3:3-5.) Far from “identical,” the declaration rewrites the '882 specification to conceal its defects.

a) Amount of “Migrating Compound” in Examples B4-B6.

A redline comparison between Dr. Boutrid’s declaration (EX2004) and the '882 specification’s language for examples B4-B6 reveals material changes that are, at best, misleading:

The '882 Patent (EX1001, 16:4-7)	Dr. Boutrid’s Decl. (EX2004, ¶41)
Example B4: Structure of the inner tube film: thickness 200 µm; with 1% release wax Constab PE-SA 270 (migrating additive) made from ethylene bis stearamide (EBS) in the polyamide external layer:	Example B4: Structure of the inner tube film: thickness 200 µm; with 1% ~~release wax~~ Constab PE-SA 270 <u>containing the release wax</u> (migrating additive) ~~made from~~ ethylene bis stearamide (EBS) in the polyamide external layer:

Similar alterations were made with respect to examples B5 and B6. (Compare EX2004, ¶¶42-43 with EX1001, 16:25-28, 16:46-49.)

The changes are direct to the false claims in the '882 Patent that examples B4, B5, and B6 contain 1%, 4%, and 6% “wax” as the “migrating compound,” identifying Constab® PE-SA 270 as the “migrating additive.” (EX1001, 15:15-18, 16:4-50, 18:9-18, 19:58-67). Both PO and Dr. Boutrid have long known that Constab® PE-SA 270 is primarily composed of non-migrating compounds—polyethylene and calcium carbonate. (EX1051; *see also*, EX1050, p. 14, 1:49-2:12.) Rather than disclosing the true composition of Constab® PE-SA 270 or the true

amount of migrating compound in examples B4-B6, Dr. Boutrid perpetuates the false wax content narrative by subtly rewriting the '882 specification.

b) “Migrating Compound” in Comparative Example V1.

The '882 Patent describes comparative example V1 as “without wax additivition”—*i.e.*, no “migrating compound” present. (EX1001, 15:20-22.) However, Dr. Boutrid’s declaration significantly rewrites the '882 specification to assert that comparative example V1 contains 0.012% migrating compound as redlined below:

37. The film of comparative example V1 is a 200-μm thick tubular film without a releasing coating or covering (i.e., release finishing), and without wax additivition used as an inner tubular film in trenchless sewage pipe renovation. Comparative example V1 uses Durethan C38 F (88%) and Durethan B40 FAM (12%) as the external layer. Durethan C38 F is a PA 6.66 polyamide with no additives, while Durethan B40 FAM is a PA 6 polyamide with a slip agent incorporated therein. The amount of slip agent (migrating compound) contained in the Durethan B40 FAM was less than 0.1% (1,000 ppm). Thus, the external layer of comparative example V1 contained less than .012% slip agent (120 ppm). The less than 120 ppm of migrating compound in the external polyamide layer of comparative example V1 without wax additivition was insufficient to migrate to the surface and to form a covering.

(EX2004, ¶37; *see also*, EX1001, 15:20-22). The above changes are significant because PO is attempting to modify the language of the '882 Patent to reflect its arguments to the Board that comparative example V1 has an unknown “slip agent” purportedly in the amount of 0.012% which is allegedly insufficient to migrate to the surface and form a “covering.” (Paper 13, 21:2-22:3.)

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 SECTIONS IIIA, IIIB, AND IIIC OF PETITIONER'S REPLY (PAPER 34)*, 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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