

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
FILE NEW EVIDENCE IN THE FORM OF DECLARATIONS FROM DR.
BOUTRID AND MR. SCHLEICHER (PAPER 35)**

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A. Introduction.

PO's counsel assured the Board that it required only a **“short declaration.”** (EX1080, Tr., 59:17-60:7.) Yet, PO now proposes multiple declarations totaling nearly 20 pages of unsupported and misleading hearsay-based testimony necessitating extensive cross-examination. If admitted, this would require Petitioner to secure rebuttal evidence from foreign sources, imposing a significant burden during final oral argument preparations. A responsive submission by Petitioner would be necessary to address the declarations' numerous misrepresentations.

PO has shown no “extraordinary situation” to justify waiver of 37 C.F.R. § 42.23(b), and this trial cannot conclude with unrebutted evidence. 5 U.S.C. § 556(d).

B. The Record is Already Full of PO's Statements.

The Board already has a comprehensive record: PO filed an opposition with three declarations (Paper 13, EX2001, EX2003, EX2004), had two lengthy hearings (EX1057, EX1080), submitted four motions (Papers 28, 33, 34, 35), and will be filing both a sur-reply and a motion to exclude shortly. The record is now filled with PO's false testimony and misleading statements. PO's request should be denied.

C. No “Extraordinary Circumstances” to Warrant Waiver.

PO has failed to acknowledge, let alone address, its burden to establish “extraordinary circumstances” that could warrant waiving the rule barring new evidence with a sur-reply. 37 C.F.R. § 42.23(b). This is yet another attempt by PO

to abuse agency resources to gain an unfair advantage over Petitioner, hindering Petitioner's ability to prepare for oral argument amidst an ever-shifting record.

The truth is that PO has long possessed all the information it now proposes to belatedly introduce, including the documents at issue (EX1051, EX1058, EX1060).

D. New Testimony Unnecessary for PO's Stated Issues.

PO's Exhibits 2028 and 2029¹ are purportedly offered to explain "how and why Petitioner's allegations based on misconstruing and failing fully to quote the inventors' declarations, and misconstruing the Saertex documents are false." (Paper 35, 4:1-4.) However, new testimony is unnecessary for issues involving mere "misconstruing" or "incomplete quotation" of documents already in the record. PO can address these matters in its reply without additional testimony. Indeed, PO has already spent over three pages on these same issues in its motion to seal, arguing the merits of the existing declarations and the disputed email. (Paper 28, pp. 7-11).

E. New Testimony Rewrites Patent, Shifts Positions and Justifies Perjury.

1. Constab® PE-SA 270 Datasheet (EX1051).

Exhibit 2028 is purportedly offered to "submit factual evidence into the record about the EBS content of [Constab®] PE-SA 270" (Paper 35, 5:14) but in reality, it seeks to rewrite the '882 Patent with inadmissible hearsay attempting to explain

¹ These exhibits should be expunged from the record if the motion is denied.

away PO's expert's disastrous cross-examination (EX1052), which exposed numerous material misrepresentations about the wax content in examples B4-B6.

For instance, PO falsely claimed that examples B4, B5, and B6 contained 1%, 4%, and 6% wax, identifying Constab® PE-SA 270 as the “migrating compound.” (Paper 13, pp. 65, 66, 67:1-11; EX2001, ¶¶69–72; EX2004, ¶¶36, 41–43, 48, 58.) In fact, the Constab® PE-SA 270 datasheet reveals it mainly consists of **non-migrating compounds**—polyethylene and calcium carbonate. (EX1051.)

Both PO's lead counsel and Dr. Boutrid have now admitted they always knew Constab® PE-SA 270 was not entirely wax, with PO's lead counsel dismissively stating, “**Why do I care?**” (EX1074, Tr., 18:3-19:23; EX2028, ¶22.) Although Dr. Boutrid claims he was only *verbally* informed that Constab® PE-SA 270 was purportedly only 20% wax, PO provides no explanation for why this information or the Constab® PE-SA 270 datasheet was withheld from the Board.

Furthermore, PO's expert was extensively cross-examined about Constab® PE-SA 270 and conceded that he had never seen the Constab® PE-SA 270 datasheet and does not know what is in Constab® PE-SA 270. (EX1052, Tr., pp. 166-202.) After reviewing the datasheet (EX1051) and the additive handbook listing the Constab® PE-SA family the expert uses (EX1050, p. 14, 1:49-2:12), PO's expert opined that Constab® PE-SA 270 could contain “88 percent polyethylene” as a non-migrating compound (EX1052, Tr., 184:2-18, 199:21-200:17). PO had the

opportunity to redirect its expert to address his false statements, which PO now seeks to “clarify” through new inventor declarations, but PO strategically chose not to. (EX1052, Tr., 219:11-12.)

PO must not be allowed to introduce unsupported, misleading hearsay testimony that fails to clarify or correct the record, especially in the absence of “extraordinary circumstances.”

2. Saertex Quality Agreement (EX1058) and Email (EX1060).

PO misrepresented that it had no knowledge of “sticking or tearing” issues before 2012, while withholding inconsistent documents, specifically the Quality Agreement (EX1058) and a Saertex email (EX1060). PO’s only “surprise” was that its fraud was uncovered through Petitioner’s investigation of third-party sources.

PO also introduces new arguments on “maleic anhydride” and “chemical bonding” (EX2028, ¶16; EX2029, ¶¶8-9), issues not mentioned in the ’882 Patent (EX1001) or Dr. Stark’s declaration (EX1072). However, related testimony was already presented in Dr. Boutrid’s prior declaration (EX2004, ¶¶15-16).

On October 28, 2024, PO told the Board that Dr. Boutrid neither read nor knew of Saertex’s complaint email, that PO never replied, and that **“the issue was not discussed any further.”** (Paper 28, 8:20-9:2). Yet, by November 8, 2024—*only 11 days later*—both inventors suddenly “recalled” that “cold weather” and “mechanical adhesion” caused Saertex’s problems, without providing any support

or specifics. (EX2028, ¶¶9-16; EX2029, ¶¶12-15.) These “cold weather” statements are nonsensical and contradicted by PO’s public filings. CIPP liners are routinely installed in cold weather due to (1) **55°F ground temperatures** for sewer pipes, (2) resin temperatures **exceeding 212°F** during curing, as PO explained in the lawsuit,² and (3) immediate removal of the inner film from the cured resin, as PO explained in the lawsuit.³ PO also admits it supplied “dozens of other orders” to Saertex in the prior *colder* months without any complaints. (EX2028, ¶12; EX2029, ¶15).

F. Significant Prejudice to Petitioner if Testimony Admitted.

Petitioner has no chance to rebut the numerous falsehoods in the two new declarations if allowed. The inventors have repeatedly made false statements throughout the prosecution of the ’882 Patent, in declarations with PO’s opposition, and now in the proposed declarations. Depositions of these individuals, who disregard their Duty of Candor, would therefore be ineffective in uncovering the truth. Finally, PO’s owner contacted Saertex only a few hours after Petitioner’s reply was filed, questioning Saertex’s cooperation regarding EX1060. This interference has led Saertex being hesitant to cooperate with Petitioner, hampering Petitioner’s access to relevant information required to impeach the new testimony.

² *Buergofol v. Omega*, 22-cv-04112-KES, Dkt. 275 at 5:8-12 (D.S.D.).

³ *Id.*, Dkt. 33 at 6:9-10.

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 FILE NEW EVIDENCE IN THE FORM OF DECLARATIONS FROM DR. BOUTRID AND MR. SCHLEICHER (PAPER 35)*, 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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