

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 MOTION TO EXCLUDE EVIDENCE (EX2001)

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I. INTRODUCTION

Petitioner moves to exclude the testimony of Patent Owner's expert, Dr. Patrick Brant, contained in EX2001. The declaration is replete with inadmissible hearsay, improper legal conclusions, and testimony unsupported by reliable methods or personal knowledge as required under the Federal Rules of Evidence (FRE) and 37 C.F.R. § 42.65. Dr. Brant's statements rely heavily on out-of-court information from unidentified sources, speculative assumptions, and self-contradictory conclusions that lack foundation. Furthermore, much of the testimony improperly seeks to construe legal terms and patent claims, tasks reserved exclusively for the Board.

The declaration also incorporates information that constitutes hearsay or double hearsay, including assertions about UV-curable resin composition and customer practices, without any admissible basis. Dr. Brant further relies on mistranslations of references and selectively quotes from the '882 Patent, ignoring its full context, resulting in misleading and legally unsound conclusions. Such testimony fails to meet the reliability standards outlined in FRE 702 and 703, *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 509 U.S. 579 (1993), and related case law.

For these reasons, Petitioner respectfully requests that the Board exclude the identified portions of EX2001 that rely on inadmissible hearsay, improper legal

conclusions, and unreliable methods. The exclusion of this testimony is necessary to preserve the integrity of the record and ensure a fair determination in this proceeding.

II. LEGAL STANDARD

The admissibility of exhibits submitted in a PTAB proceeding is governed by the Federal Rules of Evidence. 37 C.F.R. § 42.61; Office Patent Trial Practice Guide, 77 Fed. Reg. 48,758 (Aug. 14, 2012). The Federal Rules of Evidence apply in an *Inter Partes* Review. 37 C.F.R. 42.62(a).

A statement is hearsay if it was made out of court and is offered to prove the truth of the matter asserted. FRE 801. FRE 802 provides that hearsay is not admissible unless a federal statute, the Federal Rules of Evidence, or other rules prescribed by the Supreme Court provide otherwise. FRE 802.

FRE 702, 703 all require that an expert's opinion be based on "reliable principles and methods." *See Daubert v. Merrell Dow Pharm., Inc.*, 509 U.S. 579, 588 (1993). This places a "special obligation upon a trial judge to 'ensure that any and all scientific testimony ... is not only relevant, but reliable.'" *Kumho Tire Co., Ltd. v. Carmichael*, 526 U.S. 137, 147 (1999). 37 C.F.R. §42.65 addresses expert testimony, tests and data.

III. ARGUMENT

A. EX2001, ¶¶13-25 (Hearsay and Improper Legal Conclusions).

EX2001, ¶¶13-25 should be excluded for improper legal conclusions and hearsay. Petitioners Objections to Evidence Under 37 C.F.R. §42.64(B)(1) – Declaration of Patrick Brant (EX2001), Paper No. 15.

First, the unsupported and self-contradictory statements in EX2001, ¶¶ 13-19 should be excluded. *Tijerina v. Isidro Guerra & Molano, Inc.*, No. 7:19-CV-00285, 2020 WL 7632259, at *7 (S.D. Tex. Dec. 22, 2020) (“Expert opinions that are unsupported, self-contradicted, or assumptive are to be excluded.”) In EX2001, ¶13, the witness claims a “small amount” of material on the external surface of the inner film would not perform the “purpose and function” of the claimed invention and would not be a “coating or covering” in the context of the ’882 Patent. In the very next sentence, he claims just the opposite.

The term coating and the expression “coating or covering” also would include a significant amount of material on the external surface of the inner tubular film, even if it did not perform the purpose and function.

EX2001, ¶14. Thus, according to the witness, a significant amount of material on the outer surface of the inner film would form a “coating or covering” in the context of the ’882 Patent even if it did not perform the purpose and function of the claimed invention. (*Id.*) Similar statements to these two irreconcilable statements regarding the meaning of “coating and covering” are also found in EX2001, ¶¶15-20. All of

these contradictory statements unsupported by any underlying facts should be excluded or at least given no weight. 37 C.F.R. §42.65(a); *Tijerina*, 2020 WL 7632259, at *7.

Second, the witness's statements in EX2001, ¶¶20-25 attempting to construe the term "coating or covering" as a matter of law are improper. *Diebold Nixdorf, Inc. v. Int'l Trade Comm'n*, 899 F.3d 1291, 1299 (Fed. Cir. 2018) ("... [e]xperts may be examined to explain terms of art, and the state of the art, at any given time, but they cannot be used to prove the proper or legal construction of any instrument of writing.")(citations and internal quotes omitted). The meaning of terms in the context of claim construction is a "legal analysis." *Id.*

Moreover, the witness applies an improper legal standard which unsurprisingly results in incorrect legal conclusions. The witness points only to certain portions of the specification and failed to conduct the required analysis and consider the entire specification as a whole.

It is beyond debate that the entire specification must be consulted in construing the claims. *Pfizer, Inc. v. Teva Pharms. USA, Inc.*, 429 F.3d 1364, 1373 (Fed. Cir. 2005) ("It is necessary to consider the specification as a whole, and to read all portions of the written description, if possible, in a manner that renders the patent internally consistent.")

Sinorgchem v. Int'l. Trade Com'n, 511 F.3d 1132, 1145 (Fed. Cir. 2007). Here it is self-apparent that the witness failed to review or consider the entire specification and only considered "snippets" that supported his conclusions which is improper. *Id.*,

(“When the entire specification including the specific examples is consulted, rather than selected snippets, the correct claim scope is apparent from the specifications.”) The witness ignores the plain teachings of the ’882 Patent that a “coating” includes those amounts of material that migrate to the outer surface of the inner film as follows:

In the coating alternative with a migrating compound, the latter is incorporated in that outermost layer of the one or multilayered film to whose external side the migrating compound should migrate. This migration to the surface of the outer (or only) layer is time-dependent, of course. The exposed coating of the corresponding external side with the aforesaid migrating compound is caused by this migrating movement.

(EX1001, Col. 5:23-30; *see also*, Col. 18:64-67.) The specification is unambiguous that a coating includes the embodiment of material on the surface of the film from migration. (*Id.*) Thus, the witness’s claims in EX2001, ¶¶21-25 that “coating and covering” are used differently in the specification and have different meanings, i.e., a “coating” is applied over the outer surface of the inner film while a “covering” is formed through migration of the migrating compound to the surface of the inner film are incorrect and cannot be reconciled with the teachings of the specification. *Texas Digital Systems, Inc. v. Telegenix*, 308 F.3d 1193, 1213 (Fed. Cir. 2002) (“Where the patent documents are unambiguous, expert testimony regarding the meaning of a claim is entitled to no weight.”) The witness’s failure to consider the entire specification while ignoring key provisions that contradict his conclusions is fatal to

his testimony in EX2001, ¶¶21-25 which should be excluded or given no weight. *Tijerina*, 2020 WL 7632259, at *7,

Third, the witness's claims regarding the composition of Durethan B40 FAM are based on hearsay and should be excluded. EX2001, ¶16. The witness is clear that he has no personal knowledge in this regard but was "informed" of the EBS wax content of Durethan B40 FAM. *Id.* When cross examined about the source of this information, he could not say for sure but believed it came from PO's attorneys. (EX1052, pp. 151:11-152:5; 203:4-204:12.) This testimony is classic "double hearsay." *Zaben v. Air Products Chemicals, Inc.*, 129 F.3d 1453, 1456 (11th Cir. 1997) ("Moreover, as the district court suggested, Lewis' testimony concerning what Carter and Dunning said to him about what others in the company told them presents a classic "double hearsay" problem.") PO's attorneys are not the manufacturers of Durethan B40 FAM and have no personal knowledge of its contents so any information regarding it must have been obtained from other unidentified sources who may or may not have personal knowledge of the composition of Durethan B40 FAM. The inadmissible hearsay and double hearsay from the attorneys and other unidentified sources, if any, should be excluded. (*Id.*) (citations omitted).

Further, the only other reference to the composition of Durethan B40 FAM is found in the declaration of Dr. Boutrid. (*See e.g.*, EX2004, ¶33.) But as with Dr. Boutrid's declaration, there is no support in this declaration for this claim and no

source of the information is identified. Thus, it is inadmissible hearsay. *See e.g., U.S. v. Casas*, 356 F.3d 104, 119 (1st Cir. 2004) (“And, evidence which is based on inadmissible hearsay is itself inadmissible.”). And depending on the source, if any, it could be inadmissible double hearsay. *Zaben*, 129 F.3d at 1456.

Moreover, the witness cannot render this hearsay admissible by repeating it in his declaration. *Marvel Characters, Inc. v. Kirby*, 726 F.3d 119, 136 (2d Cir. 2013) (“[A] party cannot call an expert simply as a conduit for introducing hearsay under the guise that the testifying expert used the hearsay as the basis of his testimony.”); *United States v. Harvey*, 405 F. Supp. 3d 667, 672 (S.D. Miss. 2019) (“Thus, an expert ‘cannot be used as a means to introduce inadmissible evidence by merely summarizing or repeating the information in court.’” citing Weissenberger's Federal Evidence § 703.5.) Therefore, the testimony in EX2001, ¶16 should be excluded as inadmissible hearsay and double hearsay.

Finally, the witness makes several conclusory and unsupported legal conclusions regarding the prosecution of a patent in Germany. EX2001, ¶¶23-25. But the witness fails to establish any competency to testify or opine regarding what the legal ramification of what occurred in Germany, the results of those proceedings and the meanings of the submissions under German patent law. This is not scientific testimony and there is no indication he reviewed the entire prosecution file rather than just the snippets revealed to him by PO's counsel. There is no indication this

testimony is relevant or reliable and should be excluded. *See, e.g., Kumho Tire Co., Ltd. v. Carmichael*, 526 U.S. 137, 147 (1999).

For all these reasons EX2001, ¶¶13-25 should be excluded for improper legal conclusions and hearsay.

B. EX2001, ¶¶29-35 (Hearsay and Improper Legal Conclusions).

EX2001, ¶¶29-35 should be excluded as inadmissible hearsay and double hearsay. This testimony hinges on the testimony of the inventors which is based on the information allegedly obtained from two customers. (*Id.* at ¶¶29-30.) But the information from the customers stated in the declarations of Dr. Boutrid and Mr. Schleicher is itself hearsay and double hearsay. (EX2003, ¶¶22-23; EX2004, ¶¶12, 14, 15, 16, 18.) As explained, PO does not manufacture CIPP liners or UV-curable resin but instead manufactures and supplies only inner and outer films to CIPP liner manufacturers.¹ These CIPP liner manufacturers source UV-curable resin from separate resin vendors, not PO. As such, neither PO nor its customers would have firsthand knowledge of whether maleic anhydride (MAH) is present in the UV-curable resin used by PO's customers. Only the resin manufacturer(s) would have

¹ EX2003, ¶¶7-9; EX2004, ¶3; *See also, Buergofol GmbH v. Omega Liner Company, Inc.*, 22-cv-04112-KES, Dkt. 49 at 14:22-23 (D.S.D.) (“Buergofol makes film; it does not make liner.”)

that information. Any statement by PO that the UV-curable resin used by PO's customers had maleic anhydride (MAH) (or "had begun using") is classic double hearsay and is therefore inadmissible. *Zaben*, 129 F.3d at 1456. The inadmissible hearsay and double hearsay from PO's customers should be excluded. (*Id.*) (citations omitted). Further, testimony based on inadmissible hearsay is itself inadmissible. *U.S. v. Casas*, 356 F.3d at 119.

Further, the witness cannot render this hearsay admissible by repeating it in his declaration and merely claiming in EX2001, ¶¶31-35 that he agrees with the witness's conclusions and repeating them. *Marvel Characters*, 726 F.3d at 136. *United States*, 405 F. Supp. 3d at 672. Therefore, the testimony in EX2001, ¶¶29-35 should be excluded as inadmissible hearsay and double hearsay.

C. EX2001, ¶¶36-40 (Hearsay and Improper Legal Conclusions).

EX2001, ¶¶36-40 should be excluded as inadmissible hearsay. This testimony hinges on the witness's acceptance of the translation of the Hummel reference when he has no expertise in the German language. And the Petitioner demonstrated the translation relied on is unsupported and incorrect. Petitioners Reply at p. 2 n.1 and EX1005. This testimony stands un rebutted by PO. Further, the witness cannot render the incorrect translation reliable by repeating it in his declaration and testifying based on it as if were true when it is not. *Marvel Characters*, 726 F.3d at 136. *United*

States, 405 F. Supp. 3d at 672. Therefore, the testimony based on the incorrect translation in EX2001, ¶¶36-40 should be excluded as inadmissible hearsay.

D. EX2001, ¶¶42-43 (Hearsay).

EX2001, ¶¶42-43 should be excluded as inadmissible hearsay. This testimony hinges on what the witness was “informed of” regarding the testimony of Dr. MacLean rather than review of it and without citing any portion of the testimony or identifying the person who told him. Any testimony or opinions of the witness relating to the testimony of Dr. MacLean should be based on review of his actual testimony. Not on hearsay summarizing the testimony and other unknown information provided to the witness by some unknown source. Those paraphrased statements are hearsay, and the witness cannot render this hearsay admissible by repeating it in his declaration. *Marvel Characters*, 726 F.3d at 136. *United States*, 405 F. Supp. 3d at 672. Therefore, inadmissible hearsay and testimony based on it in EX2001, ¶¶42-43 should be excluded as inadmissible hearsay.

E. EX2001, ¶¶48-49 (Incorrect Legal Standard).

EX2001, ¶¶48-49 contain misstatements of the law and these and the testimony based on them should be excluded. First, the witness’s statement and understanding of anticipation by inherency is incorrect or incomplete. EX2001, ¶48. The correct definition is as follows:

Inherency can be established when prior art necessarily functions in accordance with, or includes, the claimed limitations, but may not be established by probabilities or possibilities.

Amgen Inc. v. Sandoz Inc., 66 F.4th 952, 966 (Fed. Cir. 2023) (quoting *Bettcher Indus., Inc. v. Bunzl USA, Inc.*, 661 F.3d 629, 639 (Fed. Cir. 2011) (internal quotations omitted).

The witness also misstates the law of obviousness incorrectly claiming that if a reference does not anticipate claim 1 by not disclosing all the of the elements in claim 1, then it cannot render obvious the dependent claims. EX2001, ¶49. But the law and the relevant inquiry in this tribunal is as follows:

Although the prior art that can be considered in inter partes reviews is limited to patents and printed publications, it does not follow that we ignore the skilled artisan's knowledge when determining whether it would have been obvious to modify the prior art. Indeed, under 35 U.S.C. § 103, the obviousness inquiry turns not only on the prior art, but whether "the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious ... to a person having ordinary skill in the art to which the claimed invention pertains." 35 U.S.C. § 103. Regardless of the tribunal, the inquiry into whether any "differences" between the invention and the prior art would have rendered the invention obvious to a skilled artisan necessarily depends on such artisan's knowledge.

Koninklijke Philips N.V. v. Google LLC, 948 F.3d 1330, 1337 (Fed. Cir. 2020).

Based on the incorrect statements of the law, the witness then provides legal conclusions which is improper. As succinctly explained by one Court:

Because an expert's job is to help the *fact* finder understand and determine the *facts*, courts routinely exclude expert opinions that merely provide legal analysis because, after all, legal analysis is the

court's job. Indeed, as the Advisory Committee note to Fed. R. Evid. 704 provides, courts “stand ready to exclude opinions phrased in terms of inadequately explored legal criteria.” Consequently, the Court of Appeals for the Tenth Circuit has stated that “an expert may not state his or her opinion as to legal standards nor may he or she state legal conclusions drawn by applying the law to the facts.”

Vox Mktg. Grp. v. Prodigy Promos L.C., 521 F. Supp. 3d 1135, 1148-49 (D. Utah 2021). For these reasons, the testimony regarding legal standards and legal conclusions in EX2001, ¶¶48-49 should be excluded.

F. EX2001, ¶¶56-59 (Hearsay and Improper Legal Conclusions).

The witness repeats the claims based on the hearsay and double hearsay allegedly provided by PO’s customers. For the same reasons already set forth above in Section III.B., this hearsay and double hearsay and the testimony based on it in EX2001, ¶¶56-59 should be excluded.

G. EX2001, ¶¶60-61 (Legal Conclusions).

The testimony and conclusions in EX2001, ¶¶60-61 are based on the same incorrect statements of the law of inherency and obviousness already discussed above. In Section III.E. For the same reasons, the statements in EX2001, ¶¶60-61 based on the same incorrect statements of law and legal conclusion should be excluded.

H. EX2001, ¶¶66-75 (Hearsay and Legal Conclusions).

EX2001, ¶¶66-75 should be excluded as inadmissible hearsay. In these paragraphs, the witness attempts to bolster the testimony of Dr. Boutrid that Constab

PE-SA 270 is 100% EBS wax. *See e.g.*, EX2001, ¶¶72 citing only EX2004 at ¶¶40-43. Petitioner has objected to and filed a motion to exclude these cited portions of EX2004 and similar testimony for multiple reasons. Petitioners Objections to Evidence Under 37 C.F.R. §42.64(B)(1) – Declaration of Abdel Boutrid (EX2004), Paper No. 15. For these same reasons, the testimony in EX2001, ¶¶66-73 should be excluded.

Further, while much of the information in EX2001, ¶¶66-75 appears to come from the '882 Patent, it is not cited. Instead, the witness cites the testimony of Dr. Boutrid where he made changes to the specification. *See e.g.*, EX2001, ¶¶67 and 72. Or cites to nothing at all leaving the misimpression the testimony is based on the knowledge of the witness under FRE 602. *See e.g.*, EX2001, ¶¶68 – 71.

The witness also cites to EX2004 ¶¶37-43. EX2001, ¶67. This contains the same hearsay and double hearsay regarding the contents of Durethan B40 FAM already objected to above in Section III. A above. For the same reasons, this hearsay and double hearsay in EX2001, ¶67, and ¶¶73-75 should be excluded.

Further, the witness cannot render this hearsay admissible by repeating it in his declaration. *Marvel Characters*, 726 F.3d at 136. *United States*, 405 F. Supp. 3d at 672. This testimony should be excluded as inadmissible hearsay.

IV. CONCLUSION

For all these reasons, the statements of the witness in paragraphs 13-40, 42-43, 48-49, 56-61, and 66-75 of EX2001 as set forth above should be excluded.

Dated: November 26, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing *PETITIONER'S MOTION TO EXCLUDE EVIDENCE (EX2001)*, 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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