

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 (EX2004)

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I. Introduction.

The declaration of Dr. Abdel-Kader Boutrid (EX2004), submitted by Patent Owner (PO), is riddled with inadmissible evidence, including hearsay, double hearsay, and testimony lacking personal knowledge. Much of the declaration relies on out-of-court statements from unidentified customers and unidentified UV-curable resin manufacturers, none of whom are identified or made available for examination. These statements lack any applicable hearsay exception and should be excluded under FRE 802.

The declaration further includes paraphrased, altered, and supplemented excerpts from the '882 Patent that are not attributed to the patent itself, creating a misleading impression that the testimony reflects the witness's personal knowledge. This issue is exacerbated by the fact that the declaration was submitted in English, a language the witness does not speak or understand, raising serious questions about whether the testimony truly represents the witness's knowledge or merely reflects statements crafted by PO's counsel.

The pervasive inadmissible hearsay, lack of personal knowledge, and improper attempts to rewrite the specification require that the testimony in EX2004 be excluded to preserve the integrity of the record. Petitioner respectfully moves to exclude paragraphs 6–59 of EX2004 in their entirety.

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(c). 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.

III. Patent Owner's Inadmissible Evidence Should Be Excluded.

A. EX2004, ¶¶ 6-11 (Hearsay and Improper Legal Conclusions).

Paragraphs 9-11 of Exhibit 2004 should be excluded under FRE 801/802 because they include and rely on inadmissible hearsay as previously objected to by Petitioner (Paper 14). The testimony identifies a cancellation proceeding in the German Patent Office regarding the Hummel Reference (EX1006) and that the witness was only “informed” of another patent to Hummel (DE202010016048U1) and states what they contain. (EX2004, ¶¶9-10.) Then claims, without basis, what the second Hummel reference shows. (EX2004, ¶11.) Since the witness utterly failed to establish personal knowledge of these out-of-court events as required under FRE 602 or establishing what occurred during the proceedings or the results or submitting

the documents from the proceedings, the testimony regarding the proceedings in Germany and the second Hummel reference are inadmissible hearsay.

The same is true for the unsupported conclusions in EX2004, ¶¶ 6-9, which rely on inadmissible hearsay. The self-serving statements regarding the witness's knowledge of the "state of the art of inner tubular film" (EX2004, ¶8) without establishing personal knowledge required under FRE 602. It is undisputed that Buergofol merely makes film for use in CIPP liners. It does not assemble or install the liners. Obviously, the witness is relying on information from others for the statements in EX2004, ¶¶6-11. This inadmissible hearsay and any testimony based on it should be excluded. *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."); *Flores v. Pennsylvania State Police*, No. CV 18-0137, 2019 WL 251948, at *2 (E.D. Pa. Jan. 17, 2019) ("These documents are comprised of inadmissible hearsay and any conclusions contained within them are inadmissible based on their reliance on such hearsay."); *United States v. Brown*, No. 4:19-CR-00263-01-DGK, 2023 WL 3132011, at *2 (W.D. Mo. Apr. 27, 2023) ("Even assuming it were admissible under [Rules 401-403], the Court would still exclude it to the extent that any testimony was based on hearsay statements to the witnesses.")

EX2004, ¶¶9-11 should be excluded for the additional reason they include legal conclusions regarding priority, and what is disclosed in the references beyond his perception or limited involvement identified. FRE 701, 702; 37 C.F.R. §42.65.

B. EX2004, ¶¶ 12-23; 31-36 (Hearsay).

Paragraphs 12-23 of EX2004 should be excluded under FRE 801 and 802 because they include and rely on inadmissible hearsay (double hearsay in some situations) without any applicable exception as previously objected to by Petitioner (Paper 14). This testimony is based on the out-of-court statements of unidentified customers allegedly obtained during alleged “two customer meetings.” (EX2004, ¶¶12, 14, 15, 16). PO’s opposition and sur-reply cite to this inadmissible hearsay. (Paper 13, pp. 7-8, 32-33, 51; Paper 47, pp. 2-3, 24.) PO’s expert also cites to this inadmissible hearsay. (EX2001, ¶¶32, 57.) This evidence should be excluded.

Dr. Boutrid claims that unidentified customers he visited in the spring of 2012 “had begun using UV-curable resin that included maleic anhydride (MAH)” (EX2004, ¶15). This statement, made out of court, is offered to prove the truth of the matter asserted—that these unidentified customers had, for the first time in the spring of 2012, made and used UV-CIPP liners with an unidentified UV-curable resin containing maleic anhydride (MAH) supplied by an unidentified UV-curable resin manufacturer. This assertion constitutes textbook inadmissible hearsay, compounded by hearsay within hearsay (double hearsay), with no applicable

exception. (EX2004, ¶15.) Further any testimony based on this hearsay is also hearsay and should be excluded. FRE 802. *See e.g., U.S.*, 356 F.3d at 119; *Flores*, 2019 WL 251948, at *2; *United States*, 2023 WL 3132011 at *2.

It is undisputed that PO does not manufacture UV-CIPP liners or UV-curable resin.¹ Instead, PO manufactures and supplies only inner and outer films to CIPP liner manufacturers. These liner manufacturers combine PO's films with UV-curable resin to produce the UV-CIPP liners. The UV-curable resin is sourced from separate resin vendors, not PO. Consequently, neither PO nor its customers have firsthand knowledge of whether maleic anhydride (MAH) is present in the UV-curable resin used by PO's customers. Only the UV-curable resin manufacturer(s) would possess that information.

Any statement by PO asserting that the UV-curable resin used by its customers contained or "had begun using" maleic anhydride (MAH) constitutes classic double hearsay and is inadmissible. *See Zaben v. Air Prods. Chems., 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

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.")

told them presents a classic ‘double hearsay’ problem.”). This inadmissible hearsay and double hearsay from PO’s customers should be excluded. Any testimony based on this hearsay is also hearsay and should also be excluded. FRE 802. *See e.g., U.S.*, 356 F.3d at 119; *Flores*, 2019 WL 251948, at *2; *United States*, 2023 WL 3132011 at *2.

Further, PO has failed to identify the two customers or provide testimony from them. Even if such testimony had been offered, it would also be inadmissible hearsay, as only the UV-curable resin manufacturer would have knowledge of whether maleic anhydride (MAH) was included in the UV-curable resin used by the two customers for the first time in the spring of 2012. Additionally, PO has not provided testimony from any UV-curable resin manufacturer(s) confirming the inclusion of maleic anhydride (MAH) in the UV-curable resin allegedly used by PO’s customers.

Furthermore, the declaration sent to the lead inventor includes a number of paragraphs about the “customer complaints” but makes no mention of the customers starting to use “UV-curable resin that included maleic anhydride.” (EX1072, ¶¶25-34.) Also, the ’882 Patent makes no mention of “UV-curable resin that included maleic anhydride” as being the cause of excessive adhesion between the film and the cured resin. (EX1001.) Especially problematic is that neither of the customers is identified--preventing the Petitioner from examining them in this proceeding.

Therefore, the alleged customer statements and all the testimony based on them in EX2004, ¶¶ 12-23 should be excluded as hearsay. *See e.g., U.S.*, 356 F.3d at 119; *Flores*, 2019 WL 251948, at *2; *United States*, 2023 WL 3132011 at *2.

Additionally, EX2004, ¶¶ 13-16 are based on inadmissible hearsay in the form of statements allegedly made by another inventor Dr. Kurt Stark. *See* EX2004, ¶ 13 (“From discussions with Kurt Stark, . . .”). And speculation regarding what Dr. Stark knew or understood—his state of mind. *See* EX2004, ¶15 (“At the two customer meetings that Kurt Stark and I attended, we learned . . .”); EX2004, ¶16 (“Kurt Stark and I believed . . .”). The hearsay and testimony based on it is inadmissible and should be excluded. *See e.g., Buckmaster v. Wyman*, No. 05-C-0166, 2006 WL 1785845, at *3 (E.D. Wis. June 23, 2006) (“The opinions and conclusions of plaintiff concerning another party's state of mind are not admissible, since one person is not competent to testify what another person is thinking.”)

EX2004, ¶¶31-36 should also be excluded under FRE 801/802 because it is testimony regarding testing that the lead inventor—Dr. Stark—is alleged to have supervised, (EX2004, ¶32) not the witness. It is fundamental that a witness can only testify based on his personal knowledge. FRE 602. The witness does not claim he took part in the testing or even identify who did. (EX2004, ¶32.) The testimony in EX2004, ¶¶31-36 is admittedly based on the out-of-court events and statements regarding testing performed and supervised by others which is hearsay and should

be excluded. FRE 801 and 802. *Maxwell v. York*, No. 217CV00142JMSDLP, 2019 WL 3323147, at *4 (S.D. Ind. July 23, 2019) (“Maxwell's affidavit does not indicate how he knew it was Nurse Riggs on the phone with the guard. If based on hearsay, such evidence would not be admissible at trial.”)

Further, while much of the information in EX2004, ¶¶32-36 appears to come from the '882 Patent, it is not cited. Leaving the misimpression the testimony is based on the knowledge of the witness under FRE 602. But the witness does not speak or read English and has no ability to write in English. Petitioner's Reply, Paper 24, p. 20. German is his native language, and he required an interpreter for his deposition and to understand what is in his declaration. *Id.* PO failed to meet its burden to produce evidence demonstrating he understood what he was signing.

When, as here, a party relies on an English-language declaration of a person whose native language is not English, that party must also submit documents sufficient to establish that [the declarant] understood what he was signing.

Mendez v. MCSS Rest. Corp., 564 F. Supp. 3d 195, 210 (E.D.N.Y. 2021). That did not occur here. Thus, it is entirely unclear who is testifying. The witness or PO's attorneys? Regardless of whether the statements came from the attorney(s) who drafted the patent application or the PO's attorney(s) in this case, the statements in the declaration in English not understood by the witness are based on hearsay and should be excluded. Making matters worse, and further demonstrating the statements in the declaration did not come from the witness, the declaration was not properly

attested to under 28 U.S.C. §1746 and cannot be relied on as information known to the witness. Petitioner’s Reply, Paper 24, pp. 20-21. It should be excluded as inadmissible hearsay particularly as an “unsworn statement.” *Mendez*, 564 F. Supp. 3d at 210. Especially here where PO failed to resubmit a compliant declaration. (*Id.*) Or otherwise, demonstrate the knowledge required under FRE 602 further demonstrating the testimony can only be based on hearsay. This hearsay and any testimony based on it should be excluded. *See e.g., U.S.*, 356 F.3d at 119; *Flores*, 2019 WL 251948, at *2; *United States*, 2023 WL 3132011 at *2.

Moreover, while much of the language in these paragraphs comes from the patent specification, the language has been changed in an improper attempt to rewrite the specification to mislead the reader. For instance, PO changed the information in the ’882 Patent regarding Constab® PE-SA 270 as follows:

The ’882 Patent (EX1001, Col. 15:15-16)	Dr. Boutrid’s Declaration (EX2004, ¶36)
The (release) wax Constab PE-SA 270 made with ethylene bis stearamide (EBS) made by CONSTAB Polyolefin Additives GmbH was used as migrating lipophilic compound.	The (release) wax Constab PE-SA 270 made with ethylene bis stearamide (EBS) <u>wax available from</u> ~~made by~~ CONSTAB Polyolefin Additives GmbH was used as <u>a</u> migrating lipophilic compound.

The witness’s improper efforts to re-write the specification create the misimpression that Constab® PE-SA 270 is merely a “wax,” “available [for purchase] from” Constab instead of what it actually is—a masterbatch comprised of

multiple materials made by Constab. Petitioner’s Reply, Paper 24, Section III.D.2. at pp. 16-19. Thus, not only are the witness’ claims regarding the components of Constab® PE-SA 270 hearsay, they are also false. *Id. See also* EX2004, ¶¶34-35 where the witness identifies the additives alleged to have been actually used in the testing rather than the “types” as set forth in the specification. *See e.g.*, EX1001, Col. 15:1-5 and 7-12.

For all these reasons the testimony in EX2004, ¶¶31-36 should be excluded as inadmissible hearsay. Any testimony based on this hearsay is also hearsay and should also be excluded. FRE 802. *See e.g.*, *U.S.*, 356 F.3d at 119; *Flores*, 2019 WL 251948, at *2; *United States*, 2023 WL 3132011 at *2. Further, neither Petitioner nor the Board should be put to the task of separating the actual disclosure in the specification from PO’s improper changes.

Petitioner respectfully suggests the actual disclosure in the specification should be relied on rather than PO’s improper, factually incorrect, rewrite of the specification. *See* EX1001, Col. 14:29-15:17. At a minimum, any changes to the specification should be excluded as inadmissible hearsay.

C. EX2004, ¶¶ 24-30 and 37-59 (Hearsay).

Petitioner has objected to paragraphs 24-30 and 37-59 of EX2004. (Paper 14.) Paragraphs 24-30 of EX2004 are another example of the witness taking large portions of the specification and changing or paraphrasing them. *E.g.*, compare ¶24

with Col. 13:13-21. Again, the patent is not cited leaving the misimpression that the statements are based on the personal knowledge of the witness who did not take part in the testing, failed to properly attest to the truthfulness of the statements in EX2004, ¶¶24-30 and whose native language is German. All demonstrating these statements are hearsay. Further, there is no reason for copying large sections of the specification into a declaration except for the improper purpose of changing the language to mislead the reader.

The same is true for EX2004, ¶¶37-59. Additionally, it is here that PO and the witness attempt to include new disclosure in the specification regarding the materials in Durethan C38F and Durethan B40 FAM without any support whatsoever. (*See* ¶37 at p.14:19 - p.15:8.) The witness fails to establish personal knowledge under FRE 602. Therefore, as with Constab PE-SA 270, the information regarding the composition of Durethan C38F and Durethan B40 FAM could have only come from outside sources which are never identified and is therefore inadmissible hearsay as is the testimony based on it.

Additionally, language was added that is not in the specification. *See e.g.*, EX2004, ¶40; ¶44 at p. 19:5-8. Leaving the misimpression these statements were included in the specification. Other portions of the specification were not included in those portions repeated in the declaration. *See e.g.*, EX2004, ¶¶48-49 and removed disclosure at Col. 18:10-23. Leaving the misimpression that information is not in the

specification. Further, changes were made to the language in the specification. *E.g.*, compare EX2004, ¶39 to Col. 15:65-67; EX2004, ¶41 to Col. 16:4-7; EX2004, ¶42 to Col. 16:25-28; EX2004, ¶43 to Col. 16:46-49. All of which is hearsay from the witness or PO's attorneys.

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. For example:

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.) Dr. Boutrid's declaration also 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 additivation 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 additivation was insufficient to migrate to the surface and to form a covering.

(EX2004, ¶37; *see also*, EX1001, 15:20-22).

In sum, all the changes to the specification in EX2004, ¶¶ 24-30 and 37-59, should be excluded as inadmissible hearsay. The changes to the specification are improper and made for improper purposes. Instead, the actual disclosure in the specification at Col. 17:14:29-20:13 should be relied on rather than PO's factually incorrect rewrite of the specification. At a minimum, any changes to the specification in EX2004, ¶¶ 24-30 and 37-59, should be excluded as inadmissible hearsay.

IV. Conclusion.

For all the reasons set forth above, EX2004, ¶¶ 6-59 be excluded as containing inadmissible hearsay and testimony based on hearsay. Further, the actual disclosure in the specification at Col. 17:14:29-20:13 should be relied on rather than PO's rewrite of the specification. Any changes to the specification in EX2004 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 (EX2004)*, 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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