

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OMEGA LINER COMPANY, INC.,

Petitioner

v.

BUERGOFOL GmbH,

Patent Owner.

CASE NO.: IPR2023-01372
U.S. PATENT NO. 9,657,882

PATENT OWNER'S MOTION TO SEAL EXHIBITS 1070, 1071 & 1072

I. INTRODUCTION

As authorized by the Board in an e-mail dated November 22, 2024, EX3005, Patent Owner (“PO”) submits this motion to request that the Board seal Exhibits 1070-1072 submitted with Petitioner’s Reply on October 7, 2024.

The PTAB set out the requirements for a motion to seal in the Informative Order in *Argentum Pharmaceutical LLC v. Alcon Research, Ltd.*, IPR2017-01053, Paper 27 (Jan. 19, 2018):

A party moving to seal must show “good cause” for the relief requested. 37 C.F.R. § 42.54(a). We direct the parties to prior Board decisions for guidance on how to establish “good cause” to seal a document or thing in an inter *partes* review. *See Garmin Int’l v. Cuozzo Speed Techs., LLC*, Case IPR2012-00001 (PTAB Mar. 14, 2013) (Paper 34) (“IPR001”) and *Corning Optical Communications RF, LLC, v. PPC Broadband, Inc.*, Case IPR2014-00440 (PTAB April 6, 14, and 17, 2015) (Papers 46, 47, 49) (“IPR440”).

Argentum, Paper 27, pp. 2-3. The *Corning* case referenced in *Argentum* set forth a three-prong test to satisfy good cause. *Corning*, Paper 47, pp. 2-3. The definition of confidential information is found in 37 C.F.R. §42.2 as “trade secret or other confidential research, development, or commercial information.” The standard for granting a motion to seal is “for good cause.” 37 C.F.R. § 42.54. PO, as the moving party, has the burden of proof in showing entitlement to the requested relief. 37 C.F.R. §42.20(c). For the following reasons, Patent Owner submits that it has shown good cause as to

why Exhibits 1070-1072 should be sealed.

II. PETITIONER SHOWS GOOD CAUSE AND SATISFIES THE ANALYSIS FOR GOOD CAUSE SET OUT IN *ARGENTUM*

The *Corning* case referenced in *Argentum* set forth a three-pong test to satisfy good cause, and *Argentum* established the framework for establishing good cause. The PTAB held in *Argentum*:

“Good cause” for sealing is established by a “sufficient explanation as to why” the “information sought to be sealed is confidential information” (IPR001, Paper 34, 3), a demonstration that the information is not “excessively redacted” (IPR440, Paper 46, 2), and a showing that, on balance, the strong “public[] interest in maintaining a complete and understandable record” is outweighed by “the harm to a party, by disclosure of information” and “the need of either party to rely specifically on the information at issue.” IPR440, Paper 47, 3 (footnote omitted).

Consequently, a movant to seal must demonstrate adequately that (1) the information sought to be sealed is truly confidential, (2) a concrete harm would result upon public disclosure, (3) there exists a genuine need to rely in the trial on the specific information sought to be sealed, and (4), on balance, an interest in maintaining confidentiality outweighs the strong public interest in having an open record. 37 C.F.R. § 42.54(a); IPR440, Paper 47, 2–3; IPR440, Paper 49, 2.

Argentum, IPR2017-01053, Paper 27, 3-4. PO presents the following information to show good cause for sealing Exhibits 1070-1072 below.

A. Identification of the Exhibits PO Seeks to Seal and Brief Description of the Subject Matter of the Exhibits

The identity of the documents Patent Owner seeks to seal by this motion are as follows:

- Exhibit 1070 is an English language translation of an email from Buergofol's German attorney confidentially forwarding a draft declaration to the German attorney of the inventor Dr. Stark;
- Exhibit 1071 purports to be an original of the email of EX1070 in German;
- Exhibit 1072 is an e-mail from Dr. Stark along with a copy of the draft declaration, including markings from Dr. Stark, forwarded to Counsel Neustel in this matter on June 24, 2024.

Page 2 of Exhibit 1070 provides the substance of the confidential email from PO's German attorney to Dr. Stark's German attorney. This email attaches a draft declaration prepared by "the US attorneys" and includes contact information for the drafting attorney, Mr. Darien Wallace. Exhibit 1072 is an e-mail from Dr. Stark to Petitioner's counsel (Mr. Neustel and Mr. Bond) and Dr. Stark's German attorney (Mr. Eismann), and includes a document purporting to include underlinings (solid lines, or dotted lines) made to the ***draft*** declaration by Dr. Stark. Dr. Stark indicates within the email that he had discussed the ***draft*** declaration with Petitioner's counsel during a prior "video conference," and that he had marked up the ***draft*** declaration.

B. The Subject Matter of the Exhibits is Confidential

PO does not publish or otherwise make publicly available private

communications it has with its attorneys, associated international counsel, potential witnesses, and the like. The information contained in these exhibits is at least protected work product, and PO did not waive any privilege or protection accorded to these documents. On its face the draft declaration is attorney work product. *See Twitter, Inc. v. Palo Alto Research Center Inc.*, IPR2021-01398, Paper No. 33, page 5 (holding a draft declaration prepared by counsel is privileged, protected, and not discoverable, citing 37 C.F.R. § 42.51(b)(1)(iii)). The exhibits contain confidential information by the very nature of the fact that it was a ***draft***—a declaration that had not yet been completed, signed, or filed. Logically, the draft declaration may only be properly considered as work product, because it is simply that—an unfinished draft that must be finalized.

Work product protection is waived only when a party ***voluntarily*** discloses work product to an adversary or by selective waiver. *See United States v. Nobles*, 422 U.S. 255, 238 (1975); *In re John Doe Corp.*, 765 F.2d 482, 489 (2d Cir. 1982; and *In re Steinhardt Partners, LP.*, 9 F.3d 230, 236 (2d Cir. 1993). Neither of these situations exists here, as PO did not ***voluntarily*** disclose the exhibits to Petitioner’s counsel. Petitioner obtained this information in a violation of the district court order (EX2018) precluding Petitioner’s counsel from discussing or obtaining EXs1070-1072. Petitioner asserts that its actions do not violate the order as, under Petitioner’s interpretation, the order only applies to oral interviews. Petitioner’s assertion

is belied by the fact that Exhibit 1072 states clearly that Petitioner and Dr. Stark discussed the document and Dr. Stark's annotations thereto in a prior videoconference. (EX1072, 1:2).

PO has not voluntarily waived the confidentiality protections afforded to its work product. PO took remedial action immediately once it became aware of the wrongful publication on October 10, 2024. Even if PO took no remedial action after Petitioner published PO's wrongfully obtained work product, there is no waiver. *In re Dayco Corp. Sec. Litig.*, 102 F.R.D. 468, 469-70 (S.D. Ohio 1984).

C. Exhibits 1070-1072 are Harmful to PO

PO respects the public's interest in maintaining a complete and understandable record. However, in the present case, the public's interest is outweighed by the realized harm to PO, Petitioner's counsel's egregious ethical violations through their procurement, concealment, and eventual use of these exhibits, and the lack of any legitimate need for these exhibits in this proceeding. Any benefit to Petitioner of using the exhibits with PO's work product in this proceeding is a corresponding harm to PO.

The adverse harm to PO is evident—confidential work product made public damages PO and its counsel's image in the eyes of existing and potential customers and clients. The ABA Model Rules require attorneys to maintain the confidentiality of their clients. Allowing the work product *draft* declaration to remain public sullies the reputation of PO's counsel, facilitated by

Petitioner's flagrant unethical actions with the assistance of an obviously disgruntled ex-employee. There can be no debate that publicly disclosing PO's work product drastically harms its reputation, and ability to defend itself, because its employees and attorneys are faced with the threat that their confidential work product can be made publicly available without recourse. Thus, PO has suffered concrete harm that is readily apparent.

Beyond the instant damage to its reputation, PO has been harmed by the wrongful disclosure of Exhibits 1070-1072. Petitioner *intentionally* and *unlawfully* obtained the exhibits. Petitioner then used the unlawfully obtained exhibits to alter its litigation and PTAB strategy and *intentionally concealed* the exhibits from PO and its counsel for *over three months*. Finally, Petitioner *intentionally* made public the wrongfully obtained work product.

There can be no debate that Petitioner was NOT the intended recipient of the draft declaration forwarded to Dr. Stark through their respective attorneys, as reflected in EX1070 and EX1071. The purposeful disclosure by Dr. Stark to Petitioner's counsel was not authorized or sanctioned by Patent Owner, nor could Petitioner's counsel reasonably believe that to be the case. Thus, Petitioner's counsel receipt of Exhibits 1070-1072 constitutes an inadvertent disclosure.

The PTO ethical rules require that a practitioner who receives a document relating to the representation of the practitioner's client and knows or reasonably should know that the document was inadvertently sent shall

promptly notify the sender. 37 C.F.R. §11.404(b). Unlike the ABA rules and rules of some states, there is no requirement in the PTO's ethical rule that requires the document to be privileged, confidential, or work product protected. Petitioner failed to promptly notify the sender, in this case Patent Owner, and instead purposefully concealed it from Patent Owner for over 3 months while it dramatically altered its litigation strategy, as well as its strategy in this proceeding. Petitioner should not be rewarded for this misconduct by permitting Exhibits 1070-1072 to remain in the record, much less remain publicly available.

D. There is No Genuine Need to Rely on the Specific Sealed Information

Petitioner has no genuine need to rely on Exhibits 1070-1072. Indeed, maintaining these exhibits in the public record would create more confusion than maintaining a complete and understandable record.

Petitioner's inclusion of Exhibits 1070-1072 is not germane to any Ground of Unpatentability, and it is not entirely clear why Petitioner submitted them in the first place. Petitioner's Reply only mentions the documents in the following two sentences:

On June 21, 2024, PO's counsel then emailed Dr. Stark a declaration to sign without prior discussion. (EX1070-1071.) On June 26, 2024, Dr. Stark emailed Omega a marked-up version of the declaration, noting that 'some statements are completely silly from a scientific point of view.' (EX1072.)

Reply, Paper 24 at 20. The reader is left to guess why Petitioner submitted documents that, on their face, are work-product protected, and were never intended to be in Petitioner's possession. Petitioner has not set forth any legitimate need for these exhibits, nor has Petitioner relied upon them to advance any argument Petitioner makes in its Reply.

Aside from being work product, the *draft* declaration of Dr. Stark is not germane to the merits of the proceeding. Exhibit 1072 clearly states that the markups to the draft declarations relate to Dr. Stark's ability to **confirm** information in the draft. *See* (EX1072, pg. 1). Accordingly, there is no legitimate or merits-based need for Petitioner to rely on Exhibits 1070-1072.

E. The Harm to PO Far Outweighs the Public's Interest in an Open Record

Exhibits 1070-1072 have no public value at all with respect to whether the Challenged Claims of the '882 patent are patentable. Allowing these exhibits to remain public would further confuse the issues. Publicly disclosing the confidential *draft* declarations and work product of PO causes prejudicial reputational harm to PO.

While the public has an interest in an open record, Petitioner should not be rewarded for its intentional misconduct, especially when there is no apparent need to rely on these exhibits. Given the fact that there is no need for the exhibits, and consequently, no need for the public to have access to these exhibits, and the real and present harm to PO by permitting Exhibits 1070-1072

to become part of the public record, the harm to PO far outweighs the public interest in an open record.

In view of the foregoing, PO has carried its burden in showing good cause to seal Exhibits 1070-1072, and respectfully requests that these exhibits be sealed.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing PATENT OWNER'S MOTION TO SEAL EXHIBITS 1070, 1071 & 1072, 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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Dated: November 27, 2024

Respectfully submitted,

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