

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
SEAL EXHIBITS 1070, 1071 & 1072 (PAPER 55)**

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I. INTRODUCTION

Patent Owner's ("PO") motion to seal Exhibits 1070-1072 fails to meaningfully address the *Argentum* factors. PO identifies no confidential information within the exhibits and instead relies on baseless work product claims, which are belied by the record and legal authority. PO's vague allegations of "reputational harm" lack any substantiation, particularly considering Exhibits 1070-1072 only contain information that PO has already made public.

Petitioner has a legitimate need to rely on Exhibits 1070-1072 to refute PO's false claims that no adhesion problems existed prior to the "spring of 2012" and to demonstrate the lack of credibility of PO's interested witnesses. PO fails to demonstrate any confidentiality interest that could outweigh the public's strong interest in maintaining an open record.

The Board has made clear to PO that this proceeding is "not like district court where you can just mark something confidential." (EX1080, Tr., 80:17-19.) Despite this, PO disregards its burden to substantiate its claims of confidentiality, avoiding meaningfully addressing the *Argentum* factors. Instead, PO resorts to rehashing meritless arguments from its past frivolous motions.

For these reasons, PO's motion to seal should be denied.

II. ARGUMENT

A. Exhibits 1070-1072 Contain No Confidential Information.

1. PO Fails to Identify Any Information as Confidential.

PO's motion fails to identify any information in Exhibits 1070-1072 that qualifies as "truly confidential" as required. *Argentum Pharm. LLC v. Alcon Research, Ltd.*, Case IPR2017-01053, Paper 27 at 4 (PTAB Jan. 19, 2018). PO vaguely asserts, without evidence, that its German counsel's email was "confidentially forwarding" the draft declaration to Dr. Stark's German counsel. (Paper 55, 3:5-7.) However, PO does not establish any confidentiality obligations owed to PO or its German counsel by Dr. Stark or his counsel.

In Petitioner's opposition to PO's motion to strike (Paper 38), Petitioner has established that all information in the Stark declaration (EX1072) was already publicly disclosed by PO in this proceeding. Despite having weeks to review Petitioner's non-confidentiality position, PO is unable to identify any information in Exhibits 1070-1072 that was not previously publicly disclosed or is confidential.

The table below,¹ provided in Petitioner's earlier opposition (Paper 38, p. 2), demonstrates that all the information in Dr. Stark's declaration is publicly available:

Stark Declaration (EX1072)	Public IPR Filings
¶¶1, 3-6, 20-21 (Stark's Background)	EX1040; Paper 13, p. 32.
¶¶2, 35-36, 39-41, 43-44, 53 (the '882 Patent)	EX1001; EX1002; EX2004, ¶¶6, 13, 21, 23; Paper 13, pp. 5-23.
¶¶22 (Work with Dr. Boutrid)	EX2004, ¶13; Paper 13, p. 32.
¶¶7-19, 23-24, 32, 35 (Huhtamaki and Hummel)	EX1005; EX1011; EX1040; EX2003, ¶¶12-21; EX2004, ¶¶9-11, 13; Paper 13, pp. 2, 5, 7-8, 12, 23-57.
¶¶25-34 (Knowledge of Adhesion/Tearing Problems)	EX2003, ¶¶ 19-24; EX2004, ¶¶11-19; Paper 13, pp. 11-12, 32-33.
¶¶42-43, 49-51 (Comparative Example V1)	EX2004, ¶¶ 33, 37, 38; Paper 13, pp. 20-21, 62-63, 68.
¶¶44-48 (Durethan B40FAM and 38F)	EX2004, ¶¶33, 37; Paper 13, pp. 21.
¶¶37-43, 49-54 (Alleged Invention and Unexpected Results)	EX2004, ¶¶ 16-59; Paper 13, pp. 33.

PO does not dispute the accuracy of this table, nor does it identify any paragraph of the declaration that contains confidential information. Furthermore, PO does not contest that the declaration (EX1071) was intended for public filing with the Board or that Dr. Stark's mark-ups on his declaration (EX1072) were independently created by him without any confidentiality obligation and were not shared with PO. PO seeks only to hide evidence of its attempted fraud.

¹ The table only identifies the common subject matter between the declaration sent to Dr. Stark and some of the filings by PO in this proceeding. PO has publicly filed the same information in other documents in this and other legal proceedings.

PO claims that it “does not publish or otherwise make publicly available private communications it has with its attorneys, associated international counsel, potential witnesses, and the like.” (Paper 55, 3:24-4:2.) Not only does this assertion have nothing to do with the first *Argentum* factor, but the exhibits also originated from a third party, not PO. (See Section II.A.3 *infra*.)

There is no confidential information in Exhibits 1070-1072. PO’s failure to identify any confidential information makes its motion to seal frivolous.

2. PO Fails to Identify Any Information as Work Product.

PO wastes most of its motion on fanciful work product theories, primarily on the unsupported assertion that “[o]n its face the draft declaration is attorney work product.” (Paper 55, 4:4-5.) PO cites *Twitter* for support, but that case involved a draft expert declaration and applied Fed. R. Civ. P. 26(b)(4)(B), which is limited to draft declarations prepared for expert witnesses. *Twitter, Inc. v. Palo Alto Research Center Inc.*, IPR2021-01398, Paper 33 at pp. 6-8 (PTAB Nov. 18, 2022). Dr. Stark, however, is not an expert witness, making the *Twitter* decision and Rule 26(b)(4)(B) inapplicable. PO has a separate expert witness, Dr. Patrick Brant. (EX2001.)

In addition, “[t]he party asserting the work product privilege to resist disclosure bears the burden of providing **a factual basis** for asserting the privilege.” *Murphy v. Kmart Corp.*, 259 F.R.D. 421, 428 (D.S.D. 2009) (emphasis added). “Merely stating that the documents are an exchange of draft affidavits and

communications relating thereto is insufficient to meet that burden.” *ARA Inc. v. City of Glendale*, 2018 WL 2688773, at *2 (D. Ariz. June 5, 2018).

A majority of courts, including the District of South Dakota (where the underlying lawsuit is located), hold that a declaration is not protected as work product. *Murphy*, 259 F.R.D. at 431 (“affidavits should not contain the mental impressions or legal theories of the attorney who drafted them, and the majority view is premised on that presumption”); *see also, Infosystems, Inc. v. Ceridian Corp.*, 197 F.R.D. 303, 306 (E.D. Mich. 2000) (“An affidavit, after all, purports to be a statement of facts within the personal knowledge of the witness, and not an expression of the opinion of counsel.”)

PO claims the declaration is a “draft” and therefore protected by work product based solely on its purported draft status.² However, PO offers no legal authority to support its assumption that merely identifying a document as a “draft” declaration for a *fact witness* eliminates its burden to provide a “factual basis for asserting” that it qualifies for work product protection. *Murphy*, 259 F.R.D. at 428.

² PO mentions “privilege” without explanation, but no attorney-client privilege exists because Dr. Stark had independent counsel, the communications were non-confidential, and aimed to coerce, not render legal advice.

In *Jamal & Kamal, Inc.*, extensively cited by the South Dakota Court in *Murphy*, the Court found that an unsigned draft affidavit was not protected by the work product privilege because it did not detail the attorney's theory of the case. *E.E.O.C. v. Jamal & Kamal, Inc.*, 2006 WL 2690226 at *3 (E.D. La. Sept.18, 2006). The court ordered the E.E.O.C. to produce the document, finding persuasive the fact that "work product protection only applies to memoranda ... which 'sets forth the attorney's theory of the case and [their] litigation strategy.'" *Id.* (quoting *Nat'l Labor Relations Bd. v. Sears, Roebuck & Co.*, 421 U.S. 132, 154 (1975)).

Importantly here, the burden is on the party claiming work product immunity to establish that a declaration discloses an attorney's theories or separate mental impression of a case. As one Court aptly explained:

There must be something more than a mere categorical assertion that draft affidavits are work-product. "Although changes in draft affidavits might reveal the drafting lawyer's mental impressions and strategy, they may reveal nothing more than that an attorney phrased factual statements for a witness to adopt." *ARA Inc.*, 2018 WL 2688773, at *2. "It is the burden of the lawyer claiming the immunity to establish that an exchange of draft affidavits disclosed an attorney's theories or separate mental impressions of a case." *Id.* (citing *Hernandez*, 604 F.3d at 1102). Merely stating that the documents are an exchange of draft affidavits and communications relating thereto is insufficient to meet that burden.

Altschuler v. Chubb Nat'l Ins. Co., 2023 WL 4010581, at *3 (D. Ariz. Feb. 27, 2023) (emphasis added).

Here, PO's counsel presented the declaration to Dr. Stark—with threats of litigation and “damages”—as a statement of facts within Dr. Stark's personal knowledge, demanding it be signed within three business days. (EX1068-EX1071.) PO did not describe the declaration as a “draft” nor did it invite Dr. Stark to make any changes. (EX1070.) Exhibits 1070-1072 do not contain the mental impressions or legal theories of the attorney who drafted them, and PO has failed to identify any specific portion of the documents that allegedly include such content.

Finally, PO never conducted an interview with Dr. Stark before sending him the detailed 54-paragraph, 16-page declaration. By now arguing that the declaration reflects the drafting attorney's opinions and theories of the case rather than factual statements, PO effectively admits that the document was drafted to put words in Dr. Stark's mouth. As one court has observed, “if [plaintiff] now suggests that it may interpose the work product doctrine because it then put words in the mouths of those third-party affiants as part of its litigation strategy, it misperceives the nature of the doctrine.” *Milwaukee Concrete Studios, Ltd v. Greely Ornamental Concrete Products, Inc.*, 140 F.R.D. 373, 379 (E.D. WI. 1991); *see also Altschuler*, 2023 WL 5010581, at *3 (stating, “this Court concludes that draft affidavits are not protected by the work-product doctrine to the extent that they reveal that the attorney has put words describing facts in the witness's mouth.”). Further, an attorney may not “counsel or assist a witness to testify falsely” then later avoid the requirements of

the rules of professional conduct mandating disclosure by claiming privilege. *See e.g., U.S. v. Rhynes*, 218 F.3d 310, 318 (4th Cir. 2000).

The disputed exhibits contain no work product, and PO has not identified a single sentence within them as alleged work product.

3. PO Waived Any Work Product Sending to Adverse Party.

PO acknowledges that “**Dr. Stark is adverse to Buergofol** considering that there have been **over a dozen lawsuits** between Buergofol and Dr. Stark over the past few years; **many of them are still ongoing.**” (Paper 25, 17:14-16, emphasis added; *see also Buergofol v. Omega*, 22-cv-04112-KES, Dkt. 20, 10:14-16, 13:8-9; Dkt. 21, ¶9; Dkt. 34, 9:11-12; Dkt. 349, 9:19). In the underlying lawsuit, PO has also repeatedly stated that Dr. Stark “**cannot be trusted**” and “**is likely to divulge Buergofol’s privileged information.**” *Buergofol v. Omega*, 22-cv-04112-KES, Dkt. 20, 10:8; Dkt. 21, ¶9; Dkt. 22, ¶12; Dkt. 23, ¶4; Dkt. 34, 9:16-17.

Despite acknowledging that Dr. Stark is adverse to PO and asserting he is untrustworthy and “likely to divulge Buergofol’s privileged information,” PO still sent the declaration to him without obtaining any assurances of confidentiality or other protection for the purported “work product.” PO failed to even designate the declaration or its related communications as confidential, privileged, or subject to work product immunity. These actions make clear that PO never believed the declaration or communications were protected by work product immunity.

It is well-established that work product immunity is waived when a document is disclosed to a third party that “substantially increased the opportunities for potential adversaries to obtain the information.” 8 Wright & Miller, *Federal Practice & Procedure* § 2024 (3d ed.); *see also*, *McKenzie L. Firm, P.A. v. Ruby Receptionists, Inc.*, 333 F.R.D. 638, 648 (D. Or. 2019) (finding waiver of any work product protection for emails and draft declarations with former employee); *see also*, *Altschuler*, 2023 WL 4010581, at *3 (finding waiver of any work product protection for emails and draft declaration sent to a disinterested third party). One court recently held that sharing a draft declaration with even a “*disinterested* third party” waived any claim to work-product doctrine protection to the draft declaration and corresponding emails. *Altschuler*, No. 2023 WL 4010581, at *3 (holding, “[t]he Court finds that Defendant's sharing of the draft declaration and emails with the Foundation substantially increased the opportunities for Plaintiff to obtain this information, i.e., directly from the disinterested third party, the Foundation.”)

By disclosing the declaration and communications to Dr. Stark—whom PO states is both “adverse” and “untrustworthy”—PO unequivocally waived any claim of work product immunity it might have had because it “substantially increased the opportunities for potential adversaries to obtain the information.”

4. PO Waived Work Product in Subject Matter Disclosed.

In addition, PO submitted two co-inventor declarations containing the very same false statements as in EX1070-EX1072 to support alleged “unexpected results” and POSITA knowledge, even improperly attributing to Dr. Stark knowledge of adhesion issues and testing. (EX2003, ¶¶17-18; EX2004, ¶¶16-17, 20, 23, 32-36.) By submitting the declarations, PO put “in issue” the statements within them, including Dr. Stark’s alleged knowledge, problems with PO’s film and customer communications, and related subjects. PO, thereby, waived any claim to work product protection for that subject matter. *Bd. of Trustees of Leland Stanford Junior Univ. v. Roche Molecular Sys., Inc.*, 237 F.R.D. 618, 623–28 (N.D. Cal. 2006) (holding the disclosure of inventor declarations relating to inventorship waived any claim of work product in documents concerning the subject of inventorship).

Furthermore, PO cannot rely on the two submitted inventor declarations that affirm PO’s positions and then claim that the marked-up declaration from Dr. Stark is somehow “work product.” As is well-known, “a litigant cannot use the work product doctrine as both a sword and shield by selectively using the privileged documents to prove a point but then invok[e] the privilege to prevent an opponent from challenging the assertion.” *Seneca Ins. Co. v. W. Claims, Inc.*, 774 F.3d 1272, 1278 (10th Cir. 2014); *see also Spectrum Solutions LLC v. Longhorn Vaccines & Diagnostics, LLC*, IPR2021-00847, Paper 142 at 27-28 (PTAB July 11, 2024).

5. Crime-Fraud Exception Prevents Work Product Protection.

The record establishes that PO committed fraud on the PTAB by submitting false declarations. (*See*, Paper 24, pp. 15-21.) PO's attempts to coerce false testimony from Dr. Stark in violation of 18 U.S. Code § 1512(b) was made in furtherance of the fraudulent activity before the PTAB, therefore the crime-fraud exception bars any work product protection of the disputed exhibits.

B. PO Fails to Demonstrate Any Concrete Harm.

1. No Concrete Harm Identified.

PO fails to identify any specific, concrete harm and instead resorts to baseless allegations of misconduct, which are addressed in Sections II.B.2 and II.B.3 *infra*.

PO vaguely claims that its “image in the eyes of existing and potential customers” would be harmed but provides no explanation or supporting evidence for this assertion. As discussed in Section II.A.1 *supra*, PO has already publicly disclosed the same information in its filings with the PTAB, including the two inventor declarations (EX2003, EX2004). PO offers no rationale for how the disclosure of information already in the public record could damage its reputation.

Similarly, PO claims that “its *counsel's* image” would be harmed, but this is irrelevant under *Argentum*, which considers harm to the party—not its counsel. Any harm to PO's counsel stems from their own conduct, including attempts to coerce a false declaration from Dr. Stark and commit fraud on the agency.

Such vague and unsupported assertions do not demonstrate any “concrete harm,” especially given PO’s repeated public disclosure of the same information.

2. PO’s Baseless Allegation Petitioner Violated Court Order.

PO continues to baselessly claim that “Petitioner obtained this information in a violation of the district court order (EX2018).” (Paper 55, 4:18-20.) PO falsely claims Petitioner’s non-compliance by mischaracterizing a Court Order, which applies only to *oral interviews*, not independently provided documents, which Petitioner did not violate. (EX2018; *see also*, EX2026, 2:31-34). PO’s response does not dispute the Court Order only applies to information exchanged during an oral interview and only asserts that oral information was exchanged in violation of the order. (Paper 55, 4:20-5:3.) PO therefore admits that the receipt of the documents themselves does not violate any Court Order.

3. PO’s Baseless Allegation Petitioner Violated PTO Rules.

PO’s claim that Petitioner violated 37 C.F.R. §11.404(b) is nonsensical and irrelevant to its motion to seal. (Paper 55, pp. 6–7.) PO did not send anything inadvertently. The exhibits did not come from PO—but from Dr. Stark, a third party. Dr. Stark purposefully provided the materials to Petitioner’s counsel to avoid potential fraud, negating any applicability of 37 C.F.R. §11.404(b). This is consistent with ABA Formal Opinion 06-440, which states:

[I]f the providing of the materials is not the result of the sender’s inadvertence, Rule 4.4(b) does not apply to the factual situation

addressed in Formal Opinion 94-382. A lawyer receiving materials under such circumstances is therefore not required to notify another party or that party's lawyer of receipt as a matter of compliance with the Model Rules.

Absurdly, PO attempts to distinguish 37 C.F.R. §11.404(b) from the ABA rules and applicable South Dakota rules, stating “[u]nlike the ABA rules and rules of some states, there is no requirement in the PTO’s ethical rule that the document be privileged, confidential, or work-product protected.” (Paper 55, p. 7:1–3.) This claim is yet another falsehood. A redline comparison of 37 C.F.R. §11.404(b), ABA Model Rule 4.4(b), and South Dakota Rule 4.4(b) shows they are substantially identical:

37 C.F.R. §11.404(b)	ABA Model Rule 4.4(b)	S.D. Rule 4.4(b)
(b) A practitioner who receives a document or electronically stored information relating to the representation of the practitioner's client and knows or reasonably should know that the document or electronically stored information was inadvertently sent shall promptly notify the sender.	(b) A ~~practitioner~~ <u>lawyer</u> who receives a document or electronically stored information relating to the representation of the ~~practitioner~~ <u>lawyer's</u> client and knows or reasonably should know that the document or electronically stored information was inadvertently sent shall promptly notify the sender.	(b) A ~~practitioner~~ <u>lawyer</u> who receives a document or electronically stored information relating to the representation of the ~~practitioner~~ <u>lawyer's</u> client and knows or reasonably should know that the document or electronically stored information was inadvertently sent shall promptly notify the sender, <u>and or sender's lawyer if sender is represented.</u>

Because the documents in question were not inadvertently sent, 37 C.F.R. §11.404(b) simply does not apply here—just as ABA Model Rule 4.4(b) and South Dakota Rule 4.4(b) do not. PO’s argument is meritless, unrelated to its motion to seal, and cannot be taken seriously.

C. Petitioner Has a Genuine Need to Rely on Exhibits 1070-1072.

PO’s latest claim that Petitioner’s reply references Exhibits 1070-1072 in only “two sentences” (Paper 55, 7:17–18) starkly contradicts its prior representations to the Board. On October 21, 2024, PO insisted to the Board that the reply should be stricken “in its entirety” because “[t]he PTAB and Patent Owner should not have to weed through Petitioner’s Reply” (EX3002), a position PO reiterated during the October 24, 2024 hearing (EX1080). In its November 8, 2024 motion to strike, PO narrowed its request to strike pages 1, 15, and 21 (Paper 33, 3:17–18)—still significantly more than “two sentences.”

Moreover, PO disregards the fact that Exhibits 1070-1072 directly refute PO’s false statements about adhesion problems and its secondary indicia arguments. In particular, Dr. Stark’s email with the marked-up declaration (EX1072) identifies numerous false statements that were incorporated into the two inventor declarations filed with the Board. These exhibits expose the falsity of PO’s representations to the Board, reveal the lack of credibility of PO’s witnesses, and highlight PO’s attempt

to coerce false testimony in violation of its Duty of Candor. (Paper 24, pp. 15–21.) Exhibits 1070-1072 are therefore *highly relevant* to the contested trial grounds.

On December 3, 2024, Petitioner requested a conference with the Board to seek authorization to file a motion for sanctions, relying in part on Exhibits 1070-1072 to show PO’s false statements to the Board. If authorized, Exhibits 1070-1072 will be highly relevant to Petitioner’s motion.

D. No Confidentiality Interest Outweighs Public Interest.

There is no public interest in concealing fraudulent statements submitted to the USPTO, which violate the Duty of Candor. *Spectrum Solutions*, Paper 142 at 21-32. PO vaguely asserts that Exhibits 1070-1072 would “confuse the issues” but provides no explanation of how or what confusion would result. Similarly, PO’s claim of “reputational harm” is unsupported and the exhibits only contain information that PO has already publicly disclosed.

PO has failed to establish any legitimate confidentiality interest in the exhibits, much less one that outweighs “the strong public interest in having an open record.” Moreover, while PO references the *Corning* decisions requirement to show that the information is not “excessively redacted” (Paper 55, p. 2), tellingly it chose not to provide a redacted version of the exhibits.

III. CONCLUSION

PO’s motion to seal (Paper 55) should be denied.

Dated: December 3, 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 SEAL EXHIBITS 1070, 1071 & 1072 (PAPER 55)*, 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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