

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 REPLY TO PETITIONER'S OPPOSITION TO
PATENT OWNER'S MOTION TO EXCLUDE**

I. Relief Requested

Patent Owner maintains its arguments presented in its Motion to Exclude and provides the following in reply to Petitioner's Opposition.

II. Exhibit 1047 should be excluded

The Board should exclude Exhibit 1047 because Petitioner has failed to establish that it was a printed publication or publicly available prior to the critical date of the '882 patent.

Petitioner presents a lengthy discussion as to Exhibit 1047's status as hearsay. However, the Opposition does not discuss, if not outright concedes that there is nothing to indicate that it was available before the critical date. Petitioner must, and failed to establish that Exhibit 1047 was publicly available or otherwise published *before the critical date* of the '882 patent. *See Stewart-Warner Corp. v. City of Pontiac*, 767 F.2d 1563, 1570 (Fed. Cir. 1985). Accordingly, Exhibit 1047 is irrelevant, and should be excluded. *Id.*

III. Exhibit 1048 should be excluded

The Board should exclude Exhibit 1048. Petitioner's Opposition fails to discuss the relevance of Exhibit 1048. Exhibit 1048 is not cited in Petitioner's Petition or in its Reply. Therefore, Petitioner is not legitimately relying on this exhibit or identifying with any particularity how this exhibit is relevant to this proceeding. *SK Innovation Co., Ltd. v. Celgard, LLC*, IPR2014-00679, Paper 58, p. 49 (P.T.A.B. Sept. 25, 2015). Petitioner's Opposition all but concedes, as it must, that Exhibit 1048 is irrelevant to this proceeding as it is not relied on

in its Petition or its reply and so it should be excluded.

IV. Exhibit 1049 should be excluded

As with Exhibit 1047, Petitioner has failed to establish that Exhibit 1049 was a printed publication or publicly available prior to the critical date of the '882 patent. Petitioner's Opposition lacks any showing that Exhibit 1049 was a printed publication or publicly available prior to the critical date of the '882 patent. As stated in Exhibit 1073, Exhibit 1049 was downloaded on 10/7/2024, more than a dozen years after the critical date of the '882 patent. Absent any indication that it was available prior to this date, Exhibit 1049 is irrelevant to this proceeding. Accordingly, the Board should exclude Exhibit 1049.

V. Exhibit 1051 should be excluded

The Board should exclude Exhibit 1051 because Petitioner failed to establish the reliability of Exhibit 1051.

Petitioner contends that Dr. Brant, in his deposition, adopted the information in Exhibit 1051 as reliable. However, Petitioner misconstrues Dr. Brant's testimony to reach their misleading conclusion. Dr. Brant repeatedly testified that data sheets like Exhibit 1051 are useful as a *starting point*, but that the information within must be ***verified by contacting the manufacturer***. EX1052, pg. 23, 11:8-18; 24, 11:4-21; 27, 11:11-22; and 28, 11:5-11. Even the putative author of Exhibit 1051 states that the information in the datasheets should be verified ("prechecked") before using the product. Dr. Brant, and the putative author of Exhibit 1051, both make it clear that the information within

Exhibit 1051 is only reliable as a starting point. The fact that information within Exhibit 1051 must be verified is a direct question as to the reliability of that information itself. Accordingly, Exhibit 1051 should be excluded.

VI. Exhibits 1058 & 1059 should be excluded

The Board should exclude Exhibits 1058 and 1059 because Petitioner failed to address or establish that they were relevant to this proceeding. The statements in Exhibits 1058 and 1059 are irrelevant to the instituted grounds and do not relate to validity, secondary considerations, or any of the references Hummel, Schuhmann, or Nagai. Petitioner's Opposition fails to submit any contention or discussion as to the relevance of Exhibits 1058 and 1059. Accordingly, Exhibits 1058 and 1059 should be excluded.

VI. Exhibits 1060 & 1061 should be excluded

The Board should exclude Exhibits 1060 and 1061 because Patent Owner did not waive its objection. Petitioner contends that Patent Owner's objection to Exhibits 1060 and 1061 is waived because the emails were included in Mr. Fuechtjohann's declaration. Petitioner's assertion of waiver misrepresents the character and basis of Patent Owner's objection. Patent Owner timely objected to the Exhibits 1060-1061 (the "Email") "and Petitioner's reference to or reliance thereon." Paper 025, pg. 13. This statement includes Exhibits 1062 and 1063, which refer to the exact same Email. Exhibits 1062 and 1063 are simply a declaration by Mr. Feuchtjohann stating that he was the author of the Email. Patent Owner properly objected to

the Email, and that exact same Email attached to another declaration carries with it the same objection. Regardless of the location of the document itself, Patent Owner's objection is not waived with respect to the Email. Accordingly, Exhibits 1060 and 1061 should be excluded.

VII. Exhibits 1070, 1071, & 1072 should be excluded

The Board should exclude Exhibits 1070, 1071, and 1072 because Petitioner fails to establish their admissibility. While Petitioner asserts that these Exhibits are not hearsay/work product, this is not correct.

First, Petitioner asserts that **alleged** fraudulent statements are not hearsay when offered as proof of the fraud, citing *Prudential Ins. Co. of Am. v. Sagers*, 421 F.Supp.3d 1199, 1204 (D. Utah 2019) and *Giove v. Stanko*, 977 F.2d 413, 417 (8th Cir. 1992). However, both of these cases are easily distinguished, as each case is centered around ***civil actions for fraud***. See *Giove v. Stanko*, 977 F.2d 417 (discussing the fraudulent conveyance cause of action). As clearly stated in *Prudential*, the statements are not hearsay only because the existence of the statement is ***an element of the underlying claim***. *Prudential Ins. Co. of Am. v. Sagers*, 421 F.Supp.3d 1199, 1204 (D. Utah 2019) (“The statement is not hearsay, but rather a statement to establish Mr. Sagers’ fraud, **which is an element of Dianne’s unjust enrichment claim**”) (emphasis added). Here, Petitioner is not seeking to establish an element of their claim. Accordingly, they are not afforded the protections of their cited precedent.

Second, Petitioner asserts that FRE 501 and 502 do not establish a basis

to obtain or exclude evidence. Petitioner's assertion is completely untethered from reality. Petitioner cites *Mitre Sports Int'l Ltd.* and *Winfield v. City of N.Y.* in support of their assertion. However, both *Mitre Sports* and *Winfield* are easily distinguished, as they discuss how FRE 501-502 and Rule 26 affect work product reviewed by a Special Master or *in camera* by a judge. See e.g., *Mitre Sports Int'l Ltd. v. Home Box Office, Inc.*, 304 F.R.D. 369, 371-72 (S.D.N.Y. 2015) (discussing the effects of waiver after voluntary disclosure to a Special Master); *Winfield v. City of N.Y.*, 15-cv-05236, at *14 (S.D.N.Y. May 10, 2018) (stating that the work product doctrine is not abrogated by Rule 26 and FRE 502(d)). Here, Petitioner's assertion that FRE 501 and 502 does not establish a basis to obtain or exclude evidence is misleading at best. The work product doctrine is a judicial doctrine adopted by the FRE, and adopted by the PTAB. *Mitre*, 304 F.R.D. at 371; *Twitter, Inc. v. Palo Alto Research Center Inc.*, IPR2021-01398, paper No. 33, page 5. Documents like ***draft*** declarations are the exact type of information that is protected by the work product doctrine. Petitioner's misleading and misstated precedent does not create grounds for the admission of Patent Owner's work product.

Accordingly, Exhibits 1070, 1071, and 1072 should be excluded.

VIII. Conclusion

Based on the foregoing, the Board should exclude Petitioner's Exhibits 1047, 1048, 1049, 1051, 1058, 1059, 1060, 1061, 1070, 1071, and 1072.

Respectfully submitted,

PILLSBURY WINTHROP SHAW
PITTMAN LLP
IMPERIUM PATENT WORKS LLP

By: /Darien K Wallace/
Darien K. Wallace, Reg. No. 53,736
T. Lester Wallace, Reg. No. 34,748
David Jakopin, Reg. No. 32,995

Counsel for Patent Owner

Date: December 10, 2024
315 Ray Street
Pleasanton, CA 94566
(952) 550-5067

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE, 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:

Michael S. Neustel – michael@neustel.com

Monte M. Bond – monte@neustel.com

Scott A. McKeown – scott.mckeown@wolfgreenfield.com

Dated: December 10, 2024

Respectfully submitted,

/Darien K Wallace/
Darien K. Wallace, Reg. No. 53,736
Attorney for Patent Owner Buergofol