

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

Before GRACE KARAFFA OBERMANN, KIMBERLY MCGRAW,
and JAMES J. MAYBERRY, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

ORDER

*Granting Petitioner's Request to File a Motion for Sanctions;
Denying Patent Owner's Request to File a Motion for Sanctions
37 C.F.R. §§ 42.11(a), 42.41(b)(1)(iii)*

I. INTRODUCTION

On December 6, 2024, a conference call was held between counsel for Petitioner, counsel for Patent Owner, and Judges Obermann, McGraw, and Mayberry. The purpose of the call was to discuss each party's request to file a motion for sanctions. Ex. 3007 (email to the Board explaining each party's request). Petitioner filed a partial transcript of the call. Paper 62; Ex. 1085.

II. PETITIONER'S REQUEST

Petitioner requests authorization to file a motion for sanctions based on asserted violations by Patent Owner's counsel of its duty of candor and good faith and withholding inconsistent information. Ex. 3007, 1 (citing 37 C.F.R. §§ 42.11(a), 42.51(b)(1)(iii)).

Petitioner asserts that Patent Owner's counsel knowingly submitted false testimony to the Board from two fact witnesses. *Id.* Sanctionable conduct, in our forum, includes “[m]isrepresent[ing] . . . a fact” to the Board. *OpenSky Inds., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 138, 4 (PTAB June 27, 2023) (Vidal) (quoting 37 C.F.R. § 42.12(a)(2)).

Without resolving whether Petitioner's assertions are meritorious, we find that the assertions, that Patent Owner's counsel violated its duty of candor and good faith by knowingly misrepresenting facts to the Board, are of a character that may warrant sanctions. Ex. 3007, 1. Because briefing is warranted on that issue, we further determine, based on the particular facts and circumstances presented, that allowing Petitioner to brief also whether Patent Owner's counsel improperly withheld inconsistent information is warranted.

Accordingly, we grant Petitioner's request to file a motion for sanctions that addresses all issues raised by Petitioner in Exhibit 3007.

III. PATENT OWNER’S REQUEST

Patent Owner requests authorization to file a motion for sanctions based on asserted “ethical violations” by Petitioner’s counsel in “violating a court order” (Ex. 2018, “District Court Order”) entered “in the underlying litigation.” Ex. 3007, 1. According to Patent Owner, Petitioner violated the District Court Order by soliciting “confidential information from” a former employee of Patent Owner, namely, Dr. Kurt Stark, a co-inventor of the challenged patent. *Id.*; *see* Ex. 1001, code (72). Patent Owner further argues that Petitioner’s counsel violated the District Court Order by failing “to terminate any interview if it appears that Dr. Stark may reveal confidential matters.” Ex. 3007, 1.

We deny Patent Owner’s request because it requires the Board to construe, apply, and enforce the terms of the District Court Order, which are tasks assigned to the District Court. *Id.* Patent Owner cites no authority indicating that these tasks fall within the Board’s jurisdiction. *See generally* Ex. 3007; Ex. 1085 (partial transcript).

Alternatively, we deny Patent Owner’s request because Patent Owner admits that this request depends on a finding that Exhibits 1070–1072 reflect protected attorney work product. Ex. 1085, 11:6–10. Concurrently herewith, we issue an order that finds Exhibits 1070–1072 contain no protected attorney work product or, alternatively, that Patent Owner waived any claim of work product immunity associated with the exhibits. Paper 69.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's request to file a motion for sanctions is *granted*;

FURTHER ORDERED that Petitioner's motion for sanctions shall be filed on or before December 23, 2024;

FURTHER ORDERED that Patent Owner may file an opposition to Petitioner's motion for sanctions on or before January 7, 2025; and

FURTHER ORDERED that Patent Owner's request to file a motion for sanctions is *denied*.

IPR2023-01372
Patent 9,657,882 B2

For PETITIONER:

Michael Neustel
Monte Bond
NEUSTEL LAW OFFICES, LTD
michael@neustel.com
monte@neustel.com

Scott McKeown
WOLF, GREENFIELD & SACKS, P.C.
scott.mckeown@wolfgreenfield.com

For PATENT OWNER:

Patrick Doody
PILLSBURY WINTHROP SHAW PITTMAN LLP
patrick.doody@pillsburylaw.com

T. Lester Wallace
Darien Wallace
IMPERIUM PATENT WORKS, LLP
lester@imperiumpw.com
darien@imperiumpw.com