

Ferdinand von Stumm

From: Ferdinand von Stumm
Sent: To: Monday, 30 January 2023
Subject: 15:24
Kurt.Stark@Buergofol.de
Buergofol / Omega - Secrecy and participation in patent infringement proceedings (138-22)

Dear Dr. Stark,

As you know, I advise and represent the company Buergofol GmbH.

As you may know, Buergofol GmbH is in dispute with Omega Liner Company, Inc., USA, for patent infringement on patents US 9,657,882 B2 and US 8,794,269 B2.

The case is currently pending var the U.S. District Court, South Dakota, Southern Division under docket no: No. 4:22-cv-04112-KES. U.S. Attorney Michael Neustel, who represents Omega together with Attorney Michelle Breit, has indicated that he will contact you by telephone, either personally or through a third party, to ask you questions about the dispute. It should not be discussed here whether such an approach is permissible under U.S. civil procedure law, nor whether whatever information could be obtained could then be used in the main proceedings. That is governed by U.S. procedural law.

At

<https://www.courtlistener.com/docket/64894110/buergofol-gmbh-v-omega-liner-company-inc/> you

can view the status of the procedure and the various documents.

The Omega lawyer's agreement to question you on the phone gives me urgent cause to draw your attention to Clause 9 - Confidentiality - of the employment contract between you and my client dated August 27, 2011, and in particular to the fact that the confidentiality obligation imposed on you pursuant to Clause 9.2. of the contract will continue to apply beyond the end of the employment contract.

In addition, with regard to patent US 9,657,882 B2, you, as co-inventor, are bound to special secrecy, because my client has claimed the invention under the Employee Invention Act and you are therefore bound to secrecy as long as the invention has not become free, as stipulated in Sec. 24 (2) Employee Invention Act. At the same time, in connection with the parallel DE patent application of Buergofol, internally referred to as BF 4 a, you, as co-inventor and employee of Buergofol, are obliged to absolute secrecy, because you have worked long and intensively on the patent application and developed solutions in cooperation with my client's patent attorney, Dr. Schlieff. You are therefore also a confidential party in this respect. The violation of the secrecy obligations can result in high claims for damages against you in the specific case and also trigger criminal consequences under Section 23 of the German Act on the Protection of Business Secrets (GeschGehG). Sanctions are (already in case of attempt) : Fine or imprisonment up to 3 years.

We therefore strongly recommend that if such an attempt is made, you invoke your "claim of privilege to avoid the risk of a breach of contract on confidentiality and liability for damages" to avoid civil and criminal liability. You should also make it clear to Attorney Neustel or his aide that, if he were to require you to provide information, he himself would be liable to prosecution for instigation of breach of confidentiality.

In addition, I would like to point out that you are under no obligation to give any information to the lawyer Neustel or any other third party, no matter what the questioners may argue in order to possibly trap you.

I ask for confirmation of receipt of this e-mail.

In connection with this topic, may I also ask you the question:

Since the issue before the court in South Dakota is not only injunctive relief and information, but also claims for damages, to which you will be entitled on a pro rata basis if the case is won and Omega has made the payments after being convicted, I would like to ask you whether you would like to participate as a further plaintiff alongside Buergofol in the proceedings before the court in South Dakota relating to the U.S. use patent for the use of "yellow foil".

I look forward to your reply. With kind regards

Ferdinand von Stumm | Attorney at Law

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