

UNITED STATES DISTRICT COURT
DISTRICT OF SOUTH DAKOTA
SOUTHERN DIVISION

BUERGOFOL GMBH, Plaintiff, vs. OMEGA LINER COMPANY, INC., Defendant.	Civil Action No.: 22-cv-04112-KES BUERGOFOL’S RESPONSES TO OMEGA’S TWELFTH SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS TO BUERGOFOL (SET TWELVE) (Nos. 307-309)
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PROPOUNDING PARTY: OMEGA LINER COMPANY, INC.

RESPONDING PARTY: BUERGOFOL GMBH

SET NUMBER: TWELVE (12)

To OMEGA and its attorneys of record:

Pursuant to Rule 34 of the Federal Rules of Civil Procedure, Plaintiff

BUERGOFOL GMBH (“Buergofol”) hereby responds to Defendant OMEGA LINER COMPANY, INC.’s (“Omega”) “Omega’s Twelfth Set of Request for Production of Documents and Things to Buergofol (307-309)” as follows:

GENERAL OBJECTIONS

Buergofol objects to the requests to the extent that they seek production of privileged or work product (fact work product or opinion work product) information.

Buergofol objects to the requests to the extent that they seek production of Buergofol trade secret information and sensitive commercial information subject to protection under Rule 26(c)(1)(G), such as Buergofol’s trade secret information

pertaining to how Buergofol makes Buergofol film products including Buergofol's inner film and outer film products.

Buergofol objects to the requests to the extent that they seek documents that cannot be located after a reasonable inquiry and search of known document repositories most likely to contain the responsive information.

Buergofol objects to the requests to the extent that they seek documents already within Omega's possession, custody, or control, or to the extent that the documents sought are publicly available, or would require Buergofol to locate and produce documents that could more easily and more efficiently be located and obtained by Omega.

PRODUCTION REQUESTS, OBJECTIONS AND RESPONSES

REQUEST FOR PRODUCTION NO. 307:

All documents relating to inner tubular film referred to by Buergofol as T748, T788, T788Mod, and/or T780. Documents responsive to this request include, but are not limited to, technical data sheets, property data sheets, recipes, formulations, specifications, manufacturing instructions, extrusion sheets, quotes, purchase orders, orders, order confirmations, proforma invoices, packing lists, delivery notes, shipping records, export records, import records, invoices, meeting notes, electronic messages (e.g., emails, WhatsApp messages, text messages), faxes, and letters.

RESPONSE TO REQUEST FOR PRODUCTION NO. 307:

Scope of Request is Vague and Unclear: Buergofol objects to RFP 307 as being vague and lacking in adequate specificity due to the request to produce "all document relating to inner tubular film" referred to as T748, T788, T788Mod and/or T780. Buergofol does not know the scope of "all documents relating to" and whether "relating to" is limited in any way. The request appears to be unlimited in any way to documents containing the character strings "T748, T788, T788Mod and T780" because the long list of

documents, which includes recipes, formulations and specifications, is not limited to even the long list of document types. The extent to which documents might be “relating to” film referred to as “T748, T788, T788Mod and/or T780” is not clear. Accordingly, the request is overbroad depending on how it is understood.

Trade Secrets Are Not Discoverable Without A Showing Of Need: Buergofol objects to RFP 307 to the extent it seeks production of Buergofol trade secret information subject to protection under Rule 26(c)(1)(G), such as Buergofol’s trade secret information pertaining to how Buergofol makes film for use in UV CIPP liners. Trade secrets are not discoverable without a determination that Omega has a true “need” for each identified trade secret in preparing a particular claim or defense. *In re Remington Arms Company, Inc.*, 952 F.2d 1029 (8th Cir. 1991). Omega has not made the required showing of need for the requested documents, including recipes, formulations, specifications and “extrusion sheets,” in order to prepare any claim or defense.

Buergofol objects to RFP 307 to the extent it seeks production of Buergofol’s trade secret information pertaining to how Buergofol makes film for use in UV CIPP liners. Buergofol has no obligation, through discovery in this case, to disclose Buergofol’s proprietary recipes to Omega and thereby to teach Omega how to copy Buergofol’s superior films. Confidential details and knowhow of how Buergofol manufactures Buergofol’s special UV CIPP films are Buergofol’s trade secrets and are not patented. If Omega were to learn of Buergofol’s trade secret information about how Buergofol manufactures Buergofol’s special UV CIPP films, then Omega might be able (potentially along with Vialflex, Sudpack or another film manufacturer) to make UV CIPP film in direct competition with Buergofol. This could result in financial harm to Buergofol. Not only are the recipes for film Buergofol’s trade secrets, but also Omega has no legitimate litigation need to discover the proprietary, trade secret recipes, formulations, specifications and/or “extrusion sheets.” The possible extreme harm to Buergofol due to improper use of trade secret information outweighs what little benefit

the proposed discovery would likely have in resolving issues in this case, so according to Rule 26(b)(1) the discovery is outside the scope of permissible discovery.

Omega has not made any showing that film “referred to as T748, T788, T788Mod and/or T780” is related to film used by Omega and therefore needed for the defense of noninfringement. Omega has not made any showing that film “referred to as T748, T788, T788Mod and/or T780” was used or sold in the United States prior to March 11, 2012 and is therefore needed for the defense of invalidity. RFP 307 is not limited by time or location.

Accordingly, the request is overbroad because it includes trade secret information for which Omega has no need.

No Threshold Showing Of Relevance: In addition to failing to make the heightened showing of “need” for trade secret information, Omega has also failed even to make a showing of relevance. Buergofol objects to RFP 307 because Omega has not made the required “threshold showing of relevance,” and therefore the information sought by RFP 307 is outside the scope of discovery under Rule 26(b)(1). “[I]n order to preclude fishing expeditions in discovery, courts require the party seeking discovery to make a threshold showing of relevance before production is required.” *Cutsforth, Inc. v. Westinghouse Air Brake Techs. Corp.*, No. 12-cv-1200, 2017 WL 11486322, 2017 BL 541123 (D. Minn. Mar. 15, 2017), citing *Hofer v. Mack Trucks, Inc.*, 981 F.2d 377, 380 (8th Cir. 1992) (emphasis added). Omega’s request for all documents containing the character strings “T748, T788, and T788Mod” is a fishing expedition for a massive amount of documents for which Omega has no basis to contend that the documents are in any way relevant to any claim or defense in this case. Documents relating to “T780” have already been requested in Omega’s RFP’s 300-306, so the request for document relating to “T780” in RFP 307 is duplicative. “The party seeking discovery must make a ‘threshold showing of relevance before production of information, which does not reasonably bear on the issues in the case, is required.’” *Murphy v. Kmart Corp.*, 255 F.R.D. 497 (D.S.D. 2009), citing *E.E.O.C. v.*

Woodmen of the World Life Ins. Society, 2007 BL 232729, 2007 WL 1217919 (D.Neb. March 15, 2007), citing *Hofer v. Mack Trucks, Inc.*, 981 F.2d 377, 380 (8th Cir.1993) (emphasis added).

Whether any document sought by RFP 307 is relevant to a party's claim or defense in this patent infringement case depends on whether the document is relevant to infringement or validity. A document that includes the character strings "T748, T788, T788Mod and/or T780" is not relevant to either validity or infringement of the patents-in-suit simply because the document might include one of those character strings. Film referred to as "T748, T788, T788Mod and/or T780" is not necessarily relevant to either validity or infringement. Buergofol has not contended that film made with one of the recipes "T748, T788, T788Mod and/or T780" is relevant to infringement.

With regard to validity, documents are not relevant that relate to "T748, T788, T788Mod and/or T780" to the extent they are dated after March 11, 2012 or relate to film made or sold outside the United States even before March 11, 2012. RFP 307 is overbroad because it is not limited by time or location. The requested documents are not relevant to validity because, even to the extent that some of the requested documents might relate to manufacturing film for UV CIPP liners, they would not constitute prior art under 35 U.S.C. § 102 because they would not show public use or sale in the United States prior to March 11, 2012, of UV CIPP liner containing inner film referred to as "T748, T788, T788Mod and/or T780". Moreover, Omega has made no showing that film referred to as "T748, T788, T788Mod and/or T780" has relevance to any claim element of any patent-in-suit. Omega has made no threshold showing of how such documents relating to film referred to as "T748, T788, T788Mod and/or T780" are relevant to any issue in this case. Because the party seeking discovery must make a "threshold showing of relevance" *before* production is required, and because Omega has not made a threshold showing of relevance with respect to the documents requested by RFP 307, Buergofol is not obligated to undertake the burdensome search at this time for all documents that might include one of the character

strings “T748, T788, T788Mod or T780”.

The Request is Overbroad and Not Proportional To The Needs Of The Case:

Buergofol objects to RFP 307 for being overly broad and therefore not proportional to the needs of the case because the request covers documents relating to film referred to as “T748, T788, T788Mod and/or T780” that (1) are not necessarily related to film for liners sold or used in the United States, and/or (2) are not necessarily related to film for liners sold or used prior to March 11, 2012. Omega has no need for the requested documents and things for its defense of invalidity if both conditions (1) and (2) do not apply.

(1) Documents relating to film referred to as “T748, T788, T788Mod and/or T780” are not relevant to validity to the extent they do not relate to film used or sold in the United States, and only a very small percentage of Buergofol’s film is sold or used in the United States. Therefore, only a very small percentage of Buergofol’s film referred to as “T748, T788, T788Mod and/or T780” could be used in UV CIPP liners in the United States.

(2) Documents relating to film referred to as “T748, T788, T788Mod and/or T780” are not relevant to validity to the extent they do not relate to film used to make a UV CIPP pipe liner that was used or sold in the United States prior to March 11, 2012. RFP 307 is not even limited to documents before March 11, 2012.

Thus, the vast majority of documents responsive to RFP 307 are not relevant to Omega’s claim of invalidity. And even if a small proportion of responsive documents requested by RFP 307 might arguably be relevant, the requested discovery is nonetheless not proportional to the needs of the case considering the factors set forth in Rule 26(b)(1). Nearly any burden on Buergofol in searching for and producing these irrelevant documents in response to the overbroad RFP 307 would be undue and not proportional to the needs of the case. “*Even if relevant*, discovery is not permitted where no need is shown, or compliance would be unduly burdensome, or where *harm* to the person from whom discovery is sought *outweighs the need* of the person seeking discovery of the

information.” *Micro Motion, Inc. v. Kane Steel Co.*, 894 F.2d 1318, 13 U.S.P.Q.2d 1696 (Fed. Cir. 1990) (emphasis in original).

Buergofol stands on the objections to RFP 307 given above with respect to lack of relevance, overbreadth, vagueness, not being proportional to the needs of the case, and being trade secret information subject to protection under Rule 26(c)(1)(G). For trade secret information, if there is no demonstrated need for responsive material, then that material is not discoverable. Buergofol is not obligated to search for documents responsive to objectionable RFP 307.

After conducting a reasonable search, Buergofol found no recipes for film made prior to March 11, 2012, including but not limited to any such recipes, formulations or specifications in binders (i.e., paper), extrusion sheets or film production documents older than March 11, 2012, that could be searched for the character strings “T748, T788, T788Mod or T780”. Buergofol is searching for emails responsive to this request.

Buergofol states pursuant to Rule 34(b)(2)(C), that it is not withholding any materials responsive to RFP 307 on the basis of any of the objections made above.

REQUEST FOR PRODUCTION NO. 308:

All communications between Buergofol and Saertex relating to inner tubular film referred to by Buergofol as T748, T788, T788Mod, and/or T780.

RESPONSE TO REQUEST FOR PRODUCTION NO. 308:

Scope of Request is Vague and Unclear: Buergofol objects to RFP 308 as being vague because it is unclear whether the request covers (1) only those communications between Buergofol and Saertex that contain the character strings “T748, T788, T788Mod and/or T780”, or (2) all communications between Buergofol and Saertex relating to inner tubular film, where the communication does not contain the character strings “T748, T788, T788Mod or T780”, but for which an independent investigation must be performed to determine whether the particular inner tubular film is of a type referred to as “T748, T788,

T788Mod and/or T780”. Buergofol interprets RFP 308 to request only those communications between Buergofol and Saertex that contain the character strings “T748, T788, T788Mod and/or T780”.

Overbroad Request Calls For The Production Of Irrelevant Communications:

Buergofol objects to RFP 308 for being overly broad and for calling for the production of many “communications” that are not relevant to any claim or defense in this case. So-called “communications” between Buergofol and Saertex that occurred after March 11, 2012 are not relevant to invalidity of either of the patents-in-suit, so time and money that would be spent by Buergofol preparing such communication documents for production would be a waste of time and money and would not be proportional to the needs of the case. Moreover, film (of any type) made by Buergofol in Germany is not prior art under 35 U.S.C. §102 to the patents-in-suit, and therefore communications related to that film is irrelevant. Similarly, Buergofol’s sales of film to Saertex in Germany are not prior art to the patents-in-suit under 35 U.S.C. §102, so communications about irrelevant foreign sales of film is irrelevant. Omega has made no showing of relevance of “communications” related to such foreign non-prior art film and sales. Because producing such irrelevant voluminous documents would be very time-consuming and costly for Buergofol, producing all responsive documents would amount to a burden and cost on Buergofol that is not proportional to the needs of the case. Due to the above, Buergofol will not search for and produce communications responsive to RFP 308 that are dated after March 11, 2012.

Communications between Buergofol and Saertex relating to “T780-20/5, T780-20/5 B, and T780-20/5 B-200 have already been requested in Omega’s RFP’s 305, so the request for communications between Buergofol and Saertex relating to “T780” in RFP 308 is duplicative.

Trade Secrets Are Not Discoverable Without A Showing Of Need: Buergofol objects to RFP 308 to the extent it seeks production of Buergofol trade secret information subject to protection under Rule 26(c)(1)(G), such as Buergofol’s trade secret information

pertaining to how Buergofol makes film for use in UV CIPP liners. Trade secrets are not discoverable without a determination that Omega has a true “need” for each identified trade secret in preparing a particular claim or defense. *In re Remington Arms Company, Inc.*, 952 F.2d 1029 (8th Cir. 1991). Buergofol will not produce any document that would disclose one of Buergofol’s trade secrets pertaining to how Buergofol makes film for use in UV-CIPP liners.

Subject to the above objections, even though the manufacture and sale of film in Germany is not prior art pursuant to 35 U.S.C. §102 and is therefore irrelevant to the issues in this case, Buergofol will search for and produce all non-privileged and non-trade secret “communications” dated before March 11, 2012, between Buergofol and Saertex that contain the character strings “T748, T788 and/or T788Mod”.

Buergofol states pursuant to Rule 34(b)(2)(C), that it is not withholding any materials responsive to RFP 308 on the basis of any of the objections made above.

REQUEST FOR PRODUCTION NO. 309:

All documents relating to issues, problems, and/or defects with inner tubular film supplied by Buergofol to Saertex prior to March 11, 2013.

RESPONSE TO REQUEST FOR PRODUCTION NO. 309:

No Threshold Showing Of Relevance: Buergofol objects to RFP 309 for being overly broad and for calling for the production of irrelevant documents. Buergofol objects to RFP 309 because Omega has not made the required “threshold showing of relevance,” and therefore the information sought by RFP 309 is outside the scope of discovery under Rule 26(b)(1). “[I]n order to preclude fishing expeditions in discovery, courts require the party seeking discovery to make a threshold showing of relevance ***before*** production is required.” *Cutsforth, Inc. v. Westinghouse Air Brake Techs. Corp.*, No. 12-cv-1200, 2017 WL 11486322, 2017 BL 541123 (D. Minn. Mar. 15, 2017), citing *Hofer v. Mack Trucks, Inc.*, 981 F.2d 377, 380 (8th Cir. 1992) (emphasis added). Omega’s request for all

documents relating to issues, problems, and/or defects with inner tubular film supplied by Buergofol to Saertex prior to March 11, 2013 is a fishing expedition for a massive amount of documents for which Omega has no basis to contend that the documents are in any way relevant to any claim or defense in this case. “The party seeking discovery must make a ‘threshold showing of relevance before production of information, which does not reasonably bear on the issues in the case, is required.” *Murphy v. Kmart Corp.*, 255 F.R.D. 497 (D.S.D. 2009), citing *E.E.O.C. v. Woodmen of the World Life Ins. Society*, 2007 BL 232729, 2007 WL 1217919 (D.Neb. March 15, 2007), citing *Hofer v. Mack Trucks, Inc.*, 981 F.2d 377, 380 (8th Cir.1993) (emphasis added).

Whether any document sought by RFP 309 is relevant to a party’s claim or defense in this patent infringement case depends on whether the document is relevant to infringement or validity. Film supplied by Buergofol to Saertex is obviously not relevant to infringement in this case. In addition, all of the issues, problems, and/or defects with inner tubular film supplied by Buergofol to Saertex prior to March 11, 2013 are obviously not relevant to validity of the patents-in-suit. Examples of irrelevant issues include: whether the film was the incorrect diameter or length, whether the side of the film roll was damaged, whether the film had white spots or black spots, whether the film had folds or creases, whether the film included a melted area, whether the film achieved the specified mechanical properties, and whether the film contained holes. Omega has not made any threshold showing of relevance as to validity of any “issue, problem, or defect” with inner tubular film supplied by Buergofol to Saertex prior to March 11, 2013. With regard to validity, documents are not relevant to the extent they are dated after March 11, 2012 or relate to film made or sold outside the United States even before March 11, 2012. Because the party seeking discovery must make a “threshold showing of relevance” before production is required, and because Omega has not made a threshold showing of relevance with respect to the documents requested by RFP 309, Buergofol is not obligated to undertake the burdensome search at this time for all documents relating to issues, problems,

and/or defects with inner tubular film supplied by Buergofol to Saertex prior to March 11, 2013.

The Request is Overbroad and Not Proportional To The Needs Of The Case:

Buergofol objects to RFP 309 for being overly broad and therefore not proportional to the needs of the case because the request covers documents relating to issues, problems, and/or defects with film that (1) was not necessarily used in liners sold or used in the United States, and/or (2) was not necessarily used in liners sold or used prior to March 11, 2012. Omega has no need for the requested documents for its defense of invalidity if both conditions (1) and (2) do not apply.

Thus, the vast majority of documents responsive to RFP 309 are not relevant to Omega's claim of invalidity. And even if a small proportion of responsive documents requested by RFP 309 might arguably be relevant, the requested discovery is nonetheless not proportional to the needs of the case considering the factors set forth in Rule 26(b)(1). Nearly any burden on Buergofol in searching for and producing these irrelevant documents in response to the overbroad RFP 309 would be undue and not proportional to the needs of the case. "***Even if relevant***, discovery is not permitted where no need is shown, or compliance would be unduly burdensome, or where ***harm*** to the person from whom discovery is sought ***outweighs the need*** of the person seeking discovery of the information." *Micro Motion, Inc. v. Kane Steel Co.*, 894 F.2d 1318, 13 U.S.P.Q.2d 1696 (Fed. Cir. 1990) (emphasis in original).

Buergofol stands on the objections to RFP 309 given above with respect to lack of relevance, overbreadth, and not being proportional to the needs of the case. Buergofol is not obligated to search for documents responsive to objectionable RFP 309.

Buergofol states pursuant to Rule 34(b)(2)(C), that it is not withholding any materials responsive to RFP 309 on the basis of any of the objections made above.

Dated this 1st day of August, 2024

IMPERIUM PATENT WORKS LLP

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CERTIFICATE OF SERVICE

The undersigned certifies that, on the date indicated above, a true and correct copy of the foregoing document was served electronically using the CM/ECF system or email:

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