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Via Electronic Mail

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Re: Response to Letters Regarding Alleged False or Inconsistent Statements

Dear Michael:

Further to our meet and confer on Thursday, September 5, 2024, we wish to reiterate that we are only representing the patent owner in the IPR, and not the corresponding litigation matter. Thus, to the extent your letter(s) discuss non-IPR related matters, we intend on redacting that information prior to submitting the letters to the PTAB.

A. What Buergofol Sells

Before addressing the concerns raised in your letters (August 23, 2024; August 27, 2024; and September 3, 2024 – I believe that is all of them, but please correct me if I am mistaken), we point out the following:

1. Buergofol sells the inner tubular films and the outer films that are used in making insertion tubes for use in trenchless sewage pipe restoration. Buergofol does not make or sell insertion tubes;
2. Buergofol does not provide the carrier material or the reactive plastic resin; and
3. Buergofol's customers then fabricate the insertion tubes by combining the inner film, the carrier material, the resin and the outer film. The fabricated insertion tube (referred to as a "liner") is then installed at a job site by an installer company.

B. Buergofol Did Not Make Inconsistent Statements Regarding the Problem of its Inner Film Tearing While Being Withdrawn From a Cured Liner

The problem stated in Dr. Boutrid's declaration and consistently throughout Patent Owner's filings (as well as on column 2, ll. 30-43 of the '882 patent) relates to tearing of the inner film when being pulled out of a cured liner, which would occur when an installer company installs the liner, cures the resin, and removes the inner film (relevant to the third point above). The customer complaints referenced in your various letters that you allege are inconsistent with Dr. Boutrid's testimony are relevant to the inner tubular film that Buergofol sells to customers before the film is incorporated into a liner, or the first point above. The complaints are not related to tearing of the inner tubular film when withdrawn from the cured liner, as Dr. Boutrid and Mr. Schleicher testified.

I have now had the opportunity to review some of the complaints that you contend are inconsistent with Dr. Boutrid's and Mr. Schleicher's testimony. Buergofol takes the position that complaints related to inner tubular films received by customers, (first point above), prior to their fabrication into an insertion tube for use in trenchless sewage pipe renovation, or a quality agreement that discloses a procedure for dealing with certain hypothetical future complaints about the film (again, not fabricated into the claimed insertion tube) that may or may not ever arise, are not inconsistent with Dr. Boutrid's, Gregor Schleicher's, Dr. Brant's, the '882 patent itself, or Patent Owner's statements that the problem that the inventors first realized was tearing of the inner film as it was being withdrawn from cured liner after installation and curing was completed (after bullet point three above).

Your letters contend that "Saertex's complaints regarding Buergofol's inner film are inconsistent with Buergofol's IPR response brief and the declarants' statements to the PTAB, which claimed that prior to 'the spring of 2012' there were no issues with Buergofol's inner film." Aug. 27, 2024, letter, page 2, section D. Your letter cites the Boutrid Declaration at paragraphs 12, 14, 18, and 19, and the Schleicher Declaration at paragraphs 21-24. We reproduce these paragraphs in their entirety below for your convenience:

Boutrid Declaration, paragraphs 12, 14, 18, and 19, emphasis added

12. In the spring of 2012, I became aware of a problem encountered ***when Buergofol customers withdrew Buergofol's inner film from the renovated pipe after the UV-curable resin cured.***

14. Kurt Stark and I visited two customers during the spring of 2012, who informed us that ***Buergofol's inner tubular film had torn and broken off as it was being withdrawn from the renovated pipe. That was the first time that I had heard of this problem.*** Fragments of the inner film had torn off as the inner film was pulled out of the cured liner. The film fragments left behind inside the pipe would block the pipe. This occurred despite Buergofol's inner film being strong because it contained a polyethylene with a relatively high VICAT softening point. Polyethylene with a higher VICAT softening point tends to be stronger and stiffer.

18. ***Before my visit to the two customers during the spring of 2012, I was not aware of any customer experiencing a problem with inner film tearing when it was pulled out of the cured liner. Consequently, I was also not aware that any customer experienced a problem with inner film tearing when it was pulled out of the cured liner because the inner film stuck to the cured resin.***

19. Since I began working at Buergofol in 1998, I have been responsible for quality control, and customer complaints are directed to me. Before the two customers during the spring of 2012, ***no customer complaints were directed to me regarding a problem with inner film tearing when it was pulled out of the cured liner.***

Dr. Boutrid's statements are clear and consistent. They state that prior to the spring of 2012, Dr. Boutrid was not aware of any customer complaints regarding a problem with Buergofol's inner film tearing when it was pulled out of, or withdrawn from, the cured liner. Your characterization of Dr. Boutrid's statements is not accurate – Dr. Boutrid did NOT testify that prior to "the spring of 2012" ***there were no issues*** with Buergofol's inner film. Buergofol contends that Omega could not reasonably have formed a good faith belief that Dr. Boutrid testified in the manner you have alleged in your letters.

Schleicher Declaration, paragraphs 21-24, emphasis added

21. Statements in the specification of WO2011/157356 ("Hummel") [EX1006], which were drafted before June 15, 2010, do not describe any tearing problem with any actual UV-CIPP inner film made of polyethylene (PE) and polyamide (PA) and having at least one outer PE layer and another outer PA layer (as disclosed in Hummel) because, to my knowledge, prior to June 15, 2010, Buergofol was the only company in the world to make such UV-CIPP inner film, ***and prior to 2012 there were no problems with Buergofol's UV-CIPP inner film tearing while being withdrawn from renovated pipe.***

22. In the spring of 2012, ***I became aware of a problem encountered when Buergofol customers withdrew Buergofol's inner film from the renovated pipe after the UV-curable resin cured.*** In response to customer complaints, I visited at least two customers during the spring of 2012, who informed me that ***Buergofol's inner tubular film had torn and broken off as it was being withdrawn*** from the renovated pipe. That was the first time that I had heard of this problem. Fragments of the inner film had torn off as the inner film was pulled out of the cured liner. The film fragments left behind inside the pipe had partially blocked the pipe.

23. When I visited Buergofol's customers in the spring of 2012, I learned that Buergofol's inner film was sticking to the cured UV-curable resin. ***That was the first time that I recognized that the inner film was tearing because***

portions of the inner film were sticking to the cured resin and not just because of the longitudinal stresses caused by pulling the entire length of the film by just one location on the film.

24. Although since 2007, as Managing Director of Buergofol, I have been responsible for knowing about all significant customer complaints about Buergofol's UV-CIPP inner film, ***I was not aware prior to visiting Buergofol's customers in the spring of 2012 that there ever was a problem with inner film tearing when it was pulled out of the cured liner because the inner film stuck to the cured resin.***

Like Dr. Boutrid's statements, Mr. Schleicher's statements are clear and consistent. They state that prior to the spring of 2012, Mr. Schleicher was not aware of any customer complaints regarding a problem with Buergofol's inner film tearing when it was pulled out of, or withdrawn from the cured liner. Your characterization of Mr. Schleicher's clear statements is not accurate and again, Buergofol contends that Omega could not reasonably have formed a good faith belief that Mr. Schleicher testified in the manner you have alleged in your letters.

None of the Saertex complaints that I reviewed, and/or that you reference in your letters relate to a problem of Buergofol's inner film tearing while being withdrawn from the cured liner. For example, the "Quality Agreement" dated Feb. 27, 2006, discloses procedures to take if the customer has complaints with the inner film that is being provided by Buergofol. As part of that Agreement, there were a set of possible issues that may arise, along with a reference to what that problem likely would be attributable to. Your August 23, 2024, letter states that "[s]trong adhesion of the film to the laminate after curing" [was] one of the top four complaints to be addressed."

This is not an accurate assessment of that document. The four problems were developed during a brainstorming session as possibilities that might arise, and how to address those issues, not actual complaints to be addressed. With respect to adhesion to the "Laminat," which we understand to be a specific term referencing the type of carrier material used by Saertex (not sold by Buergofol), the Quality Agreement references Section 2.4 of that agreement as the likely or possible cause of such a problem, were it ever to arise. Section 2.4 concerns the melting points of the respective polymers used in fabricating the inner tubular film. Moreover, strong adhesion is not evidence of, nor does it imply tearing of the inner tubular film as it is withdrawn from the cured liner. Thus, this Quality Agreement does not provide any evidence that there was in fact a customer complaint of such a problem, or that the problem was the inner film tearing while being withdrawn from the cured liner.

A second document referenced in your August 23, 2024, letter is a document entitled 'Meeting Minutes' dated April 13, 2010. Your letter contends that "Buergofol was supplying Saertex with a 'new film with the additive Wax 40' to address prior issues with Buergofol's inner film." The reference to Wax 40 is a reference attributed to the film by the customer (Saertex), which is an internal reference by the customer to identify the film. Buergofol does not reference and did not reference this film as containing wax, nor did it contain any

wax added to the polymers used to make the film, or coated on the external surface thereof. The German word for wax is Wachs, although Google Translate likely translates the German term in that document, which is “Wax,” to English as “Wax” because there is no German word Wax.

Buergofol referenced this film as T780-20/5, and it contains no wax added to any of the polymers forming the layers of the inner tubular film, or coated on the external surface thereof. The customer identified the film by the customer’s internal reference BFWAX40, and referenced other Buergofol inner films by the customer’s internal reference BFSTAND. Buergofol has no control over how its customers identify the Buergofol inner tubular films it sells to them, and the mere fact that one customer internally designated a Buergofol test film as “BFWAX40” has no bearing on the actual film properties or its components. Simply put, there was no wax added to any of the polymers forming the layers of the film designated by Buergofol as T780-20/5, or coated on the external surface thereof. These meeting minutes also refer to Buergofol’s inner tubular films bursting when inflated during installation (item 4). Again, this issue is not relevant to the problem first made known to Dr. Boutrid and Mr. Schleicher in the spring of 2012, which was tearing of the film as it was being withdrawn from the cured liner.

These documents, as well as others we have reviewed, do not support your contention that Buergofol, and specifically Dr. Boutrid and Mr. Schleicher were aware of the specific tearing problem they first heard of in the spring of 2012. These individuals were certainly aware of other problems and customer complaints regarding the Buergofol inner tubular films, as would any manufacturer who has sold hundreds of thousands of materials over decades.

Perhaps the most troubling aspect of this issue you have raised is that all of the information provided above in this letter, which explains the inaccuracies in your assumptions, could have easily been resolved in a matter of minutes during the scheduled cross-examination of either Dr. Boutrid or Mr. Schleicher. But Omega chose not to cross examine either one of them, for no legitimate reason that Buergofol can ascertain other than to create ambiguity and fabricate an issue that simply does not exist. If Omega were concerned or otherwise believed there was inconsistent testimony, it should have cross-examined Dr. Boutrid and Mr. Schleicher and readily discovered that there were no inconsistent statements.

In summary, Omega has mis-characterized Dr. Boutrid’s testimony, and you have improperly quoted only the “spring of 2012” portion of Dr. Boutrid’s (and Mr. Schleicher’s testimony), when you allege in your letters that Dr. Boutrid “falsely claims that he was unaware of **any issues** with the inner film used in cured-in-place-pipe liners (‘CIPP liners’) until the ‘spring of 2012.’” Aug. 23, 2024 letter at page 9, emphasis added. As I stated on multiple occasions during our meet and confer, Dr. Boutrid did not testify in the manner you have alleged and improperly quoted. When I asked you later in our meet and confer if you still stand by these mis-characterizations of Dr. Boutrid’s testimony, you did not answer, so I assume that you still hold fast in your position that Dr. Boutrid testified in the manner you allege.

You mentioned during our meet and confer whether I would be surprised if you brought “in a declaration from a customer that says that they told Buergofol about tearing problems,”

and I asked you whether that would have been prior to 2012, but you did not answer. I also mis-understood your statement about such a hypothetical declaration and now see that you only mentioned “tearing problems,” which if related to the inner tubular films that Buergofol sells to customers might not be surprising. I would be surprised, however, if you have a declaration from a customer that states, with evidence to prove it, that they told Buergofol, and that Dr. Boutrid or Mr. Schleicher were aware prior to the Spring of 2012, that the customer was having problems with tearing of the film while being withdrawn from the pipe. If Omega does indeed have such a declaration in its possession, then it is only fair to Buergofol that you produce that affidavit prior to our submission of the letters to the PTAB, under seal. Please provide Buergofol with a copy of such an affidavit by 5:00 pm tomorrow, September 11, 2024.

C. The ‘882 Patent and Buergofol’s Filings do Not Convey to a Person Having Ordinary Skill in the Art That Examples B4-B6 Contain 1%, 4%, and 6% EBS Wax, Respectively – The Patent States that Examples B4-B6 Contain 1%, 4%, and 6% of Constab PE-SA 270

I pointed out in our meet and confer on September 5, 2024, that your select quotations from the ‘882 patent regarding the Constab product that was used in the inventive examples B4-B6 was inappropriate, did not consider the patent as a whole, and was not relevant in the absence of any evidence that a person having ordinary skill in the art would construe the ‘882 patent in the manner you allege. In the absence of any retraction on your part, I again must assume that you continue to stand by the statement in your Aug. 23, 2024 letter (pg. 1) that the ‘882 patent “makes a number of unequivocal statements regarding the amount of EBS wax present in examples B4, B5, and B6, claiming that 1%, 4%, and 6% EBS wax, respectively, were used....”

While the ‘882 patent, in discussing the results from the examples, does refer to 4% or 6% wax, the ‘882 patent clearly states in the section containing definitions of the components used in the examples that “[t]he (release) wax Constab PE-SA 270 **made with** ethylene bis stearamide (EBS) wax made by CONSTAB Polyolefin Additives GmbH was used as migrating lipophilic compound.” ‘882 patent at col. 15, ll. 14-17, emphasis added. The ‘882 patentee therefore defined the term “wax” as it is used in the examples and referred to in the results sections of the patent, as the Constab PE-SA 270 product that is made with EBS wax. Thus, in each occurrence in the examples, when the patentee referenced “wax,” the patentee was referring to Constab PE-SA 270, which was made with EBS wax. In the select portions of the ‘882 patent quoted in your letter(s), you will see that, if the patentee described improved results with respect a certain amount of “wax,” such as “4% by weight of wax” or “wax proportion to 6%,” the patentee also included a reference to the example number (such as example B5 or example B6), each of which leaves no doubt that the 4% and 6% by weight terminology was referencing the amount of Constab PE-SA 270, not the amount of EBS wax.

Moreover, Constab PE-SA 270 inherently contains the materials from which it is made, regardless of how a patentee characterizes or references the product. Its properties, and its

chemical constituents, are inherent in the material that is purchased from CONSTAB Polyolefin Additives GmbH. As mentioned on the call, a person skilled in the art would not have understood Constab PE-SA 270 to be made of 100% wax, and as Dr. Brant testified on multiple occasions during his cross-examination, a person skilled in the art would call the supplier of the product (in this case CONSTAB Polyolefin Additives GmbH) to determine what additives were used and how much were included before ever using such a material to make a film.

Finally, the '882 patent does not state that comparative example V1 does not contain any wax. Rather, the '882 patent states that the comparative film "is a 200- μ m thick tubular film without releasing coating (i.e. release finishing) and without wax **additivation** used as inner tube film in trenchless sewage pipe renovation." '882 patent at col. 15, ll. 19-22, emphasis added. The film of comparative example V1 therefore did not have wax added in addition to whatever wax may have been included in one or more polymers used to form the inner tubular film.

D. Path Forward

Given that we are at an apparent impasse, and if you cannot provide to us by 5:00 pm ET tomorrow (September 11, 2024) with the affidavit you referenced during our call, please let me know of your availability for a conference call with the PTAB sometime this week. As I stated during our meet and confer on September 5, 2024, we must submit the letters to comply with the PTAB rules, as well as this letter, and we intend on seeking the PTAB's authorization to submit them. We also intend on submitting the customer complaints that have been produced during the corresponding litigation matter, seeking the PTAB's authorization to submit all of these materials under seal pursuant to the Protective Order. We also intend on seeking authorization from the PTAB to submit a reply to the statements in your letters and the customer complaints. Please let us know if you still intend on seeking authorization from the PTAB to file a motion for sanctions.

We look forward to hearing from you soon.

Sincerely yours,

PILLSBURY WINTHROP SHAW PITTMAN LLP



Patrick A. Doody

CC: Darien Wallace
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