

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

**DECLARATION OF CHRISTINA KOPPE-ZAGOURAS IN
RESPONSE TO PETITIONER'S MOTION FOR SANCTIONS**

I, Christina Koppe-Zagouras, do hereby declare:

1. I am a lawyer at the German law firm of OPPENLÄNDER Attorneys.
2. The statements in this declaration are based on my personal knowledge.
3. I represent Buergofol GmbH in several ongoing litigations against Dr. Kurt Stark in Germany.
4. I forwarded an email with an attached draft declaration for Dr. Stark to Dr. Stark via his attorney Benjamin Eismann on June 21, 2024, which email, English translation and draft declaration have been marked as Exhibits 1070-1071 in this proceeding, and are attached to this declaration as Attachment A.
5. In my communication on June 21, 2024, I wrote “[W]e had already pointed out that Mr. Stark, as a co-inventor and former employee, is obliged to provide support and cooperation.”
6. In a previous letter that I had emailed directly to Dr. Stark on May 22, 2024, I had already reminded Dr. Stark of his duty of care and loyalty as an inventor to his former employer Buergofol, which, according to my legal opinion, exists. The letter of May 22, 2024 and its English translation have been marked as Exhibits 1068-1069 in this proceeding, and are attached to this declaration as

Attachment B.

7. When I forwarded the email and attached draft declaration to Dr. Stark on June 21, 2024 (EX1070-EX1071), I had every expectation that Dr. Stark would keep all information relating to Dr. Stark's employee invention confidential.

I declare that all statements made herein on my own knowledge are true and that all statements made on information and belief are believed to be true, and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Date: January 7, 2025, Stuttgart, Germany

By: 
Christina Koppe-Zagouras

EXHIBIT A

I, Irina Hinrichs, pursuant to 28 U.S.C. § 1746, hereby declare under penalty of perjury that the following is true and correct:

1. I am fluent in both the German and English languages.
2. I am a professional translator of German into English.
3. The attached English translation of “Buergofol .. Stark - Patentstreitigkeit (2069-21)” is, to the best of my knowledge and belief, a true, correct and complete translation of the source document.
4. I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I understand that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. § 1001).



Irina Hinrichs
August 8, 2024

Koppe-Zagouras, Christina

From: Koppe-Zagouras, Christina
Sent: Friday, June 21, 2024, 10:41:50 a.m. +00:00
To: benjamin.eismann@eismann-bayreuth.de
Cc: Koppe-Zagouras, Christina
Subject: Buergofol ./ Stark - Patent dispute (2069-21)
Attachments: Declaration of Stark 240617.pdf, Declaration of Stark 240617.doc

Dear Mr. Eismann,

We refer to our letter dated June 18, 2024.

We had reported that invalidity proceedings are pending in the USA between Buergofol and Omega Liner regarding US Patent No. 9,657,882. Your client was a co-inventor as an employee of our client.

In order to defend themselves, the US patent attorneys involved consider it necessary, among other things, for their client to provide a statement on the patent, in particular on the origin and background of the invention.

We enclose a declaration prepared by the patent attorneys as a pdf and Word document. Your client is also welcome to contact the US attorneys directly. I am enclosing the relevant contact details again.

Darien Wallance
<mailto:darien@imperiumpw.com>
Phone No.: (925) 331-8099

We look forward to receiving the signed declaration by

June 26, 2024

We had already pointed out that Mr. Stark, as a co-inventor and former employee, is obliged to provide support and cooperation.

Please do not hesitate to contact us if you have any questions.

Yours sincerely,

Christina Koppe-Zagouras

Elisabeth Zichler
Apprentice
OPPENLÄNDER Attorneys

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<https://www.oppenlaender.de/datenschutz/>

From: Koppe-Zagouras, Christina <Koppe@oppenlaender.de>
Sent: Friday, June 21, 2024 5:42 AM
To: benjamin.eismann@eismann-bayreuth.de
Cc: Koppe-Zagouras, Christina
Subject: Buergofol ./ Stark - Patentstreitigkeit (2069-21)
Attachments: Declaration of Stark 240617.pdf; Declaration of Stark 240617.doc

Sehr geehrter Herr Eismann,

wir kommen auf unser Schreiben vom 18.06.2024 zurück.

Wir hatten berichtet, dass zwischen Buergofol und Omega Liner betreffend des US-Patents Nr. 9,657,882 in den USA ein Nichtigkeitsverfahren anhängig ist. Ihr Mandant war als Arbeitnehmer unserer Mandantin Miterfinder.

Zur Rechtsverteidigung sehen es die eingeschalteten US-Patentanwälte unter anderem für erforderlich an, dass ihr Mandant eine Erklärung zu dem Patent abgibt, insbesondere zur Entstehung und den Hintergründen der Erfindung.

Eine von den Patentanwälten vorbereitete Erklärung als pdf und Word-Dokument fügen wir anliegend bei. Gerne kann Ihr Mandant auch unmittelbar Kontakt zu den US-Anwälten aufnehmen. Die entsprechenden Kontaktdaten füge ich anliegend nochmals bei.

Darien Wallance
<mailto:darien@imperiumpw.com>
Tel. Nr.: (925) 331-8099

Der Rücksendung der unterzeichneten Erklärung sehen wir bis

26.06.2024

entgegen. Wir hatten bereits darauf hingewiesen, dass Herr Stark als Miterfinder und ehemaliger Arbeitnehmer zu Unterstützungs- und Mitwirkungshandlungen verpflichtet ist.

Für Rückfragen stehen wir gerne zur Verfügung.

Mit freundlichen Grüßen

Christina Koppe-Zagouras

Elisabeth Zichler
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Patent Owner.

CASE NO.: IPR2023-01372
U.S. PATENT NO. 9,657,882

DECLARATION OF DR. KURT STARK

I, Dr. Kurt Stark, do hereby declare:

1. I make this declaration at the request of Buergofol GmbH (“Buergofol”) to provide statements regarding my personal knowledge of facts relating to U.S. Patent No. 9,657,882 (“the ‘882 patent”), and relating to the state of the UV-CIPP art at the time I made my invention (my invention is claimed in the ‘882 patent).
2. I am a named co-inventor on the ‘882 patent.
3. I am a German citizen and currently reside in Neuhaus, Germany.
4. I studied from 1990-1999 as an undergraduate and as a graduate student at the University of Bayreuth, Germany. My undergraduate degree was in chemistry. I received a PhD in Chemistry directed towards surfactant and colloid chemistry.
5. For have approximately twenty years of work experience working in the field of blown extrusion film used to make ultraviolet cured-in-place pipe (“UV-CIPP”) liners. I have also been aware of the state of the art of film used for UV-CIPP liners for almost two decades.
6. I am knowledgeable and I have personal knowledge of the state of the art in the field of making UV-CIPP inner films in the 2011 to 2012 time frame, because I actually worked in the field during that time frame, and at that time I knew others who worked in the field during that time frame.

HUHTAMAKI

7. From approximately March 2005 to September 2011, I was employed by Huhtamaki Deutschland GmbH & Co. KG (“Huhtamaki”) in Germany. My job title was “Head of Research and Development”.
8. In my capacity as “Head of Research and Development” for Huhtamaki, it was my responsibility to oversee Huhtamaki’s R&D efforts into making blown extrusion films for, among other uses, use in UV-CIPP liners.
9. While I worked at Huhtamaki, I worked closely with another employee of Huhtamaki named Henrik Hummel.
10. While I worked at Huhtamaki, I was aware and intimately familiar with an invention of Henrik Hummel that is described and claimed in the German Patent Application No. DE10201023764.7, which is related to the German Utility Model Patent No. DE202010016048U1, the International Publication No. WO2011/157356 (“Hummel Publication”) and the U.S. Patent No. 8,794,269. DE10201023764.7, DE202010016048U1, WO2011/157356 and U.S. 8,794,269 all have the same specification.
11. I worked closely together with Henrik Hummel over a period of years leading up to the time when Henrick Hummel invented the inner film of the Hummel Publication, and then during the subsequent entire time between when Henrik Hummel invented the inner film of the Hummel Publication and when the

International Patent Application PCT/EP2011/002685 (which was published as the Hummel Publication) was filed on May 31, 2011.

12. While I worked at Huhtamaki together with Henrik Hummel, I was informed and was aware that the Hummel Publication claimed an inner film having an inner layer with polyethylene having a VICAT softening point of 100°C or above.
13. While I worked at Huhtamaki together with Henrik Hummel, it was my understanding that the invention of Henrik Hummel claimed in the Hummel Publication had the effect of making the inner film stronger. In my capacity as “Head of Research and Development” it was part of my job function to know this.
14. While I worked at Huhtamaki together with Henrik Hummel, it was my understanding that the invention of Henrik Hummel claimed in the Hummel Publication did not result in a covering of migrating compound being formed over the outer-facing external side of the inner film. In my capacity as “Head of Research and Development” it was part of my job function to know this.
15. While I worked at Huhtamaki together with Henrik Hummel, I never heard Henrik Hummel, or anyone else, state that there was any problem with the inner film as claimed in the Hummel Publication.

16. While I worked at Huhtamaki together with Henrik Hummel, I never heard Henrik Hummel, or anyone else, state that the inner film as claimed in the Hummel Publication had ever stuck in an undesirable way to the cured UV resin in a renovated pipe.
17. I never became aware that there was any sticking or tearing problem with the inner film as claimed in the Hummel Publication. As “Head of Research and Development” for Huhtamaki, it was my responsibility to know if there were any sticking or tearing problems with any Huhtamaki inner film, including the inner film as claimed in the Hummel Publication.
18. To my knowledge, while I worked at Huhtamaki, I was not aware that any film claimed in the Hummel Publication was ever commercially made by Huhtamaki.
19. To my knowledge, while I worked at Huhtamaki, I was not aware that any film claimed in the Hummel Publication was ever sold to any entity in the United States.

BUERGOFOL

20. From October 2011 to August 2022, I was employed by Buergofol GmbH. My job title was “Director of Business Development”. Among other duties, I was responsible for building sales of Buergofol’s blown extrusion film for use in UV-CIPP liners. I was also responsible for developing new film products

for the UV-CIPP liner business and for other fields. I was the person at Buergofol who was responsible for building Buergofol's patent portfolio and for protecting Buergofol's new products with patents.

21. As "Director of Business Development" it was one of my duties and job functions to know as much as I possibly could about the film made by each and every manufacturer of UV-CIPP films, across the entire world.
22. At Buergofol, I worked closely with Dr. Abdel Boutrid, a co-inventor on the '882 patent, regarding how to make new film products for use in UV-CIPP liners, including inner film and outer film.
23. In April 2012, Buergofol filed a cancellation proceeding in the German Patent Office against German Utility Model Patent No. DE202010016048U1, which is related to the Hummel Publication. I advised Buergofol on technical issues in the cancellation proceeding.
24. I was aware of the state of the art of film used for UV-CIPP liners through the end of 2012, including Huhtakamki's offerings in the way of UV-CIPP films. I do not believe that Huhtamaki was ever able, including through the end of 2012, to make and sell the inner film as claimed in the Hummel Publication commercially. This means, to my knowledge, the film claimed in the Hummel Publication was never commercially sold, and therefore was never commercially used.

25. From October 2011 until mid-2012, I was never aware of any significant problem with Buergofol's UV-CIPP inner films that were being made and sold at that time.
26. In the second half of 2012, I first became aware of customer complaints related to removal of Buergofol's UV-CIPP inner film when certain customers withdrew Buergofol's UV-CIPP inner film from renovated pipe after the UV-curable resin of the liner had cured.
27. In the second half of 2012, Dr. Boutrid and I visited two customers who informed us that Buergofol's inner 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 inner film tearing when it was withdrawn from the renovated pipe. Fragments of the inner film had torn off as the inner film was being pulled out of the cured liner. The film fragments left behind inside the pipe had partially blocked the pipe.
28. This problem of Buergofol's UV-CIPP inner film tearing and breaking off as it was being withdrawn from the renovated pipe occurred despite the inner film being strong because it contained a polyethylene with a relatively high VICAT softening point. Polyethylene having a higher VICAT softening point tends to be stronger and stiffer than polyethylene having a lower VICAT softening point.

29. At the time I first learned of the customer complaints, neither I nor anyone else at Buergofol to my knowledge knew why the inner film was tearing, in that the tearing could have been due to numerous reasons including film manufacturing defects, unusual environmental conditions, improper storage conditions, and multiple other reasons that could compromise the strength of the inner film.
30. At the time I first learned of the customer complaints, I knew that some adhesion between the polyamide layer of the inner film and the cured UV-curable resin of the liner was a desirable and beneficial characteristic of a UV-CIPP inner film.
31. At the two customer meetings that Dr. Boutrid and I attended, we recognized that the cured UV-curable resin was probably sticking to the polyamide of the outer polyamide layer of the inner film, and this may have been due to the release force per unit area between the polyamide layer and the cured resin being too high. I believed that a solution to the sticking of the inner film to the cured resin would be related to the outer polyamide layer of the inner film.
32. Before my visit to the two customers during the second half of 2012, I was not aware of any customer experiencing a problem with inner film (inner film made by Huhtamaki, by Buergofol, or by any other manufacturer) 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.
33. To my knowledge, before my visit to the two customers during the second half of 2012, neither I nor anyone I knew of had felt a motivation to change the release force per unit area between the polyamide layer of the inner film and the cured resin in a UV-CIPP liner.
34. Dr. Boutrid and I believed that the UV-curable resin could be prevented from unduly adhering to the outer polyamide layer of the inner film by forming a coating of polysiloxane or a migrating compound or a covering of a migrating compound over the outer facing external side of the polyamide layer in order to separate the UV-curable resin in the carrier material from the polyamide. The coating or covering would create an increased release effect to counteract undue sticking of the inner film to the cured resin.
35. When I signed my inventor declaration for the '882 patent on April 28, 2014, I was aware of the German Utility Model Patent No. DE202010016048U1 (which is related to and has the same specification as the Hummel Publication) against which Buergofol had filed a cancellation proceeding in the German Patent Office in April 2012. I believed that my invention that I was claiming in the '882 patent was not disclosed in the Hummel Publication and that the

Hummel Publication did not recognize that inner film could have a problem sticking to the cured resin inside a renovated pipe.

36. When I signed my inventor declaration for the '882 patent on April 28, 2014, I had a good understanding of the English language and of the scope of the claims as written in English. When I signed my inventor declaration for the '882 patent, I had considerable experience drafting, preparing and reviewing patent applications. I knew and understood that the claimed invention of the '882 patent includes two embodiments. I would have been upset and would have demanded that the claims be amended if I had thought that the scope of the claims as written in English did not include both embodiments, namely (1) applying a coating of polysiloxane or migrating compound over the external side of the inner film facing the carrier material, and (2) adding a migrating compound to the external layer where it migrates to the surface to form a covering.
37. The making of UV-CIPP inner films is, in my personal experience, an unpredictable art. At the time my co-inventors and I made our invention, I had personal knowledge that it was believed in the art and certainly at Buergofol, that using an unnecessarily large amount of slip agent in the making of blown extrusion films to increase throughput was "lazy" and produced lower quality film. It was considered lazy because the operator could increase production

rates by using more slip agent, but the quality and characteristics of such rapidly-made film tended to be poor. I have personal knowledge that it was appreciated at the time my co-inventors and I made our invention that there were good reasons not to use more than the minimum amount of slip agent necessary to facilitate proper blown extrusion equipment operation in the factory. Using more slip agent is not necessarily better.

38. As my co-inventors and I experimented with ways to form coatings and coverings over the outer facing external surface of the polyamide layer in order to separate the UV-curable resin from the polyamide layer so as to increase the release effect against the resin, we were surprised to discover that forming a coating or covering over the polyamide layer, either by applying a coating of polysiloxane or migrating compound over the external surface, or by forming a covering of a migrating compound due to migration to the surface of the external side of the film, not only improved the release effect, but also unexpectedly improved certain mechanical properties of the film.
39. As my co-inventors and I experimented with ways to form coatings and coverings over the outer facing external surface of the polyamide layer in order to separate the UV-curable resin from the polyamide layer so as to increase the release effect against the resin, we unexpectedly discovered that there was a measurable increase in the elasticity of the inner film until film splice and film

break. We included data in the '882 patent in order to provide evidence of these unexpected elasticity properties.

40. Due to these surprising properties, my co-inventors and I submitted our findings to Buergofol to seek patent protection for our discovery. The '882 patent discloses our invention. Our invention includes the formation of either an external coating on the external surface of the outermost layer of the inner film, or a covering that is formed when a migrating compound added to the external layer migrates to the external surface. The coating can either be of polysiloxane or of a migrating compound. The covering, however, is formed only by use of a migrating compound.
41. My co-inventors and I included film examples in the '882 patent to communicate that a wax or other migrating compound present as an additive in a small concentration in the polymer forming the external layer would not form a coating because it is not applied over the surface of the external layer, and would also not form a covering, even if some of that wax migrated to the surface, as it likely would.
42. As my co-inventors and I experimented with ways to form coatings and coverings over the outer-facing external surface of the polyamide layer in order to separate the UV-curable resin from the polyamide layer so as to

increase the release effect against the resin, we worked with a film called “Comparative Example V1.”

43. My co-inventors and I included a description of the “Comparative Example V1” film in the ‘882 patent in order to communicate an example of what our inventive film was not. That is why we used the term “comparative.” The first table (below) in column 15 of the ‘882 patent provides the composition of the inner film of Comparative Example V1:

Layer number	Composition	Proportion in layer in %	Thickness in μm
1	Durethan C38 F	88	40
	Durethan B40 FAM	12	
2	Adhesive promoter: Admer NF 498 E	100	10
3	Lupolen 2420 F	70	65
	Exceed 1327 CA	30	
4	Adhesive promoter: Admer NF 498 E	100	10
5	Lupolen 2420 F	70	75
	Exceed 1327 CA	30	
			Sum: 200 μm

44. The external layer of the inner film facing the carrier material, layer number 1 in the table above from column 15, includes 12% Durethan B40 FAM. The designation “FAM” informs the reader of the ‘882 patent that this material includes a slip agent, which is a migrating compound.

45. At the time my co-inventors and I made our invention, it was known in the prior art that Durethan B40 FAM contained less than 0.1% (1000 ppm, parts per million) by weight of a slip agent.
46. The external layer of the inner film facing the carrier material, layer number 1 in the table above from column 15, includes 88% Durethan C38 F.
47. At the time my co-inventors and I made our invention, it was known in the prior art that Durethan C38 F contained no additives or processing aids.
48. Because Durethan B40 FAM contains less than 0.1% (1000 ppm) by weight of slip agent and because the external layer of the inner film includes 12% Durethan B40 FAM and 88% Durethan C38 F, the amount of slip agent present in the external layer of the inner film facing the carrier material was small, at less than 0.012% (120 ppm) by weight.
49. As my co-inventors and I experimented with ways to form coatings and coverings over the outer facing external surface of the polyamide layer in order to separate the UV-curable resin from the polyamide layer so as to increase the release effect against the resin, we determined that “Comparative Example V1” without wax additivation and with less than 0.012% (120 ppm) by weight of the slip agent, which is a migrating compound, did not have a covering of a migrating compound.

50. My co-inventors and I determined by experimentation that “Comparative Example V1” without wax additivation and with less than 0.012% (120 ppm) by weight of a slip agent, which is a migrating compound, exhibited a higher release force than did the films of the polysiloxane examples B1-B3 and the films of the examples B4-B6 with migrating compounds that formed coverings.
51. My co-inventors and I determined that “Comparative Example V1” without wax additivation and with less than 0.012% (120 ppm) by weight of a slip agent, which is a migrating compound, exhibited a lower elasticity until splice and until break than did the films of the polysiloxane examples B1-B3 and the films of the examples B4-B6 with migrating compounds that formed coverings.
52. My co-inventors and I determined that film without wax additivation and with less than 0.012% (120 ppm) by weight of a migrating compound does not form a covering of the migrating compound, which is shown by our experimental results in the tables in columns 17 and 19.
53. The results of our experiments shown in the tables in columns 17 and 19 of the ‘882 patent indicate that no covering forms over the external layer of the inner film facing the carrier material when only a small concentration of migrating compound is added to the external layer.

54. A UV-CIPP inner film whose resin-facing polyamide layer contains only an incidental amount of a lubricating migrating compound (for example, EBS wax) inadequate to form a coating or covering on the polyamide layer is not my invention.

I declare that all statements made herein on my own knowledge are true and that all statements made on information and belief are believed to be true, and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Date: June ____, 2024 in _____, Germany

By: _____
Dr. Kurt Stark

EXHIBIT B

I, Irina Hinrichs, pursuant to 28 U.S.C. § 1746, hereby declare under penalty of perjury that the following is true and correct:

1. I am fluent in both the German and English languages.
2. I am a professional translator of German into English.
3. The attached English translation of “2024-05-22 Buergofol Letter (Koppe-Zagouras) to Stark” is, to the best of my knowledge and belief, a true, correct and complete translation of the source document.
4. I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I understand that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. § 1001).



Irina Hinrichs
August 8, 2024

OPPENLÄNDER

RECHTSANWÄLTE [Attorneys]

Mr.
Dr. Kurt Stark
Rothenbruck 101
91284 Neuhaus

By e-mail: stark.patents@t-online.de

Dr. Christina Koppe-Zagouras

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001362-22 CK/ez
3742844v3

May 22, 2024

Buergofol ./ Dr. Kurt Stark

Dear Mr. Stark,

As you know, we represent Buergofol GmbH. Our power of attorney is legally insured. We are contacting you in the following matter:

As you are aware, our client is currently litigating in the District Court of South Dakota against Omega Liner Company, Inc. The subject matter of the proceedings is the infringement of our client's US patent No. 9,657,882. The patent on which the legal dispute is based concerns an invention relating to a tubular film and its use. You are one of the inventors. This is an employee invention.

As part of the proceedings, the validity of the patent was now challenged in an action for revocation, namely with regard to the novelty of the invention. The following documents were submitted to our client in this respect:

Prof. Dr. Albrecht Bach
Dr. Thomas Tröltzsch
Prof. Dr. Markus Köhler
Prof. Dr. Christof Lenz
Dr. Timo Kieser
Dr. Rolf Leinekugel
Dr. Matthias Ulshöfer
Dr. Andreas Hahn
Dr. Donata Beck
Dr. Christina Koppe-Zagouras
Dr. Ulrich Klumpp

Dr. Christian Günther
Dr. Matthias Lorenz
Dr. Felix Born
Dr. Torsten Gerhard
Dr. Christoph Wolf
Dr. Florian Schmidt-Volkmar
Dr. Katharina Köbler
Dr. Malte Weitner
Dr. Corina Jürschik-Grau
Dr. Martin Fink
Dr. Thomas Kreuz

Dr. Anne-Kathrin Bichweiler
Dr. Svenja Buckstegge
Dr. Carl Höfer
Dr. Simon Schmauder
Dr. Clemens Birkert
Dr. Natalie Seitz
Dr. Joachim Ott
Dr. Henrike Schulte
Dr. Jens Ritter
Dr. Damian Schmidt
Arthur Eichmann

Dr. Raphael Höll
Sven Luckert
Dr. Christopher Réti
Dr. Maximilian Stützel
Julia Felger
Julia Sauter
Tobias Gawaz
Anja Niederhofer
Dr. Matthias Tratt
Jessica Ferreira Rocha
Simon Gollasch

Pia Koller
Christian Geyer
Vera Dörrfuß
Anton Müller
Dr. Franziska Schaible
Annika Witte Paz
Franziska Münchow

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- WO 2011/054434A1. The applicant is Huhtamaki Forchheim, you are also a co-inventor here.
- WO 2011/157356A1: Huhtamaki is also the applicant here, the inventor is Mr. Henrik Hummel.
- Japanese Patent No. JP2002/1819: The applicant is Kansui Kogyo K.K., Japan.

At least the first two inventions are well known to you.

As a co-inventor and former employee, you are obliged to support our client in her defense and to cooperate in this. This obligation is based on the duty of care and loyalty of the person who has made an employee invention and on the post-contractual requirement of good faith (see Bartenbach/Volz, *Arbeitnehmererfindungsgesetz* [German Employee Invention Act], § 15 para. 8).

We therefore request that you actively notify our client by **Friday, May 24, 2024** at the latest of your willingness to participate in the defense of the aforementioned US patent. Our client already points out that it will enforce the existing obligations to cooperate in court if necessary and naturally reserves the right to claim damages in the event that the US patent is destroyed.

Yours sincerely,

[signature]
Dr. Christina Koppe-Zagouras
Attorney at Law

OPPENLÄNDER

RECHTSANWÄLTE

Herrn
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91284 Neuhaus

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001362-22 CK/ez
3742844v3

22.05.2024

Per E-Mail: stark.patents@t-online.de

Buergofol ./ Dr. Kurt Stark

Sehr geehrter Herr Stark,

wie Sie wissen vertreten wir die Buergofol GmbH. Unsere Vollmacht wird anwaltlich versichert. Wir wenden uns in Folgender Angelegenheit an Sie:

Wie Ihnen bekannt ist, führt unsere Mandantin aktuell vor dem District Court von South Dakota gegen die Omega Liner Company, Inc. Eine gerichtliche Auseinandersetzung. Gegenstand des Verfahrens ist die Verletzung des US-Patentes unserer Mandantin Nr. 9,657,882. Bei dem Rechtsstreit zugrunde liegenden Patent handelt es sich um eine Erfindung betreffend eine Schlauchfolie und deren Verwendung. Erfinder sind unter anderem Sie. Es handelt sich hierbei um eine Arbeitnehmererfindung.

Im Rahmen des Verfahrens wurde nun die Wirksamkeit des Patentes im Rahmen einer Nichtigkeitsklage angegriffen, und zwar im Hinblick auf die Neuheit der Erfindung. Entgegengehalten wurden unserer Mandantin insoweit Folgende Dokumente:

Prof. Dr. Albrecht Bach
Dr. Thomas Tröhlitzsch
Prof. Dr. Markus Köhler
Prof. Dr. Christofer Lenz
Dr. Timo Kieser
Dr. Rolf Leinekugel
Dr. Matthias Ulshöfer
Dr. Andreas Hahn
Dr. Donata Beck
Dr. Christina Koppe-Zagouras
Dr. Ulrich Klumpp

Dr. Christian Gunßer
Dr. Matthias Lorenz
Dr. Felix Born
Dr. Torsten Gerhard
Dr. Christoph Wolf
Dr. Florian Schmidt-Volkmar
Dr. Katharina Köbler
Dr. Malte Weitner
Dr. Corina Jürschik-Grau
Dr. Martin Fink
Dr. Thomas Kreuz

Dr. Anne-Kathrin Bichweiler
Dr. Svenja Buckstegge
Dr. Carl Höfer
Dr. Simon Schmauder
Dr. Clemens Birkert
Dr. Natalie Seitz
Dr. Joachim Ott
Dr. Henrike Schulte
Dr. Jens Ritter
Dr. Damian Schmidt
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Dr. Maximilian Stützel
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Tobias Gawaz
Anja Niederhofer
Dr. Matthias Tratt
Jessica Ferreira Rocha
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OPPENLÄNDER

RECHTSANWÄLTE

- WO 2011/054434A1. Anmelder ist Huhtamaki Forchheim, Sie sind hier ebenfalls Miterfinder.
- WO 2011/157356A1: Auch hier ist Huhtamaki Anmelder, Erfinder ist Herr Henrik Hummel.
- Japanisches Patent Nr. JP2002/1819: Anmelder ist die Kansui Kogyo K.K., Japan.

Zumindest die ersten beiden Erfindungen sind Ihnen bestens bekannt.

Als Miterfinder und ehemaliger Arbeitnehmer sind Sie verpflichtet, unsere Mandantin bei der Verteidigung zu unterstützen und hieran mitzuwirken. Diese Verpflichtung beruht auf den § 25 Arbeitnehmererfindungsgesetz zugrunde liegenden Fürsorge- und Treuepflichten desjenigen, der eine Arbeitnehmererfindung getätigt hat sowie aus dem nachvertraglichen Gebot von Treu und Glauben (vgl. Bartenbach/Volz, Arbeitnehmererfindungsgesetz, § 15 Rn. 8).

Wir fordern Sie daher auf, unserer Mandantin bis spätestens **Freitag, den 24.05.2024** aktiv die Bereitschaft anzuzeigen, an der Verteidigung des genannten US-Patentes mitzuwirken. Schon jetzt weist unsere Mandantin darauf hin, dass sie die bestehenden Mitwirkungspflichten notfalls gerichtlich durchsetzen wird und sich etwaige Schadensersatzansprüche im Falle der Vernichtung des US-Patentes selbstverständlich vorbehält.

Mit freundlichen Grüßen



Dr. Christina Koppe-Zagouras
Rechtsanwältin