

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

PATENT OWNER'S MOTION TO SUBSTITUTE

I. INTRODUCTION

Patent Owner files this Motion to Substitute to address clerical errors in the Patent Owner's Opposition to Petitioner's Motion for Sanctions filed on January 7, 2025. In particular, on Thursday, January 9th Counsel for Patent Owner was informed by Petitioner's counsel that the document margins had been improperly formatted in the Opposition to Petitioner's Motion for Sanctions as initially filed. (Paper 73). This was inadvertent. Patent Owner conferred with Petitioner regarding this clerical error and Petitioner has indicated that it will not oppose the present motion to replace the Opposition (Paper 73) as filed on January 7, 2025 with an Opposition correcting these clerical errors.

II. REQUESTED RELIEF

By this motion, Patent Owner requests that the attached corrected Opposition to Petitioner's Motion for Sanctions be entered into the record without affecting the response date. Further, Patent Owner requests that the previously filed Opposition containing clerical errors (Paper 73) be removed from the record. Alternatively, Patent Owner seeks a waiver of the document margins requirement under 37 C.F.R. § 42.6(a)(2)(iv).

III. STATEMENT OF MATERIAL FACTS

On January 7, 2025, Patent Owner filed its Opposition to Petitioner's Motion for Sanctions. (Paper 73). Patent Owner inadvertently set the document margins for the Opposition to 0.75 inches (the "Moderate" setting in Microsoft

Word), not the prescribed 1-inch document margins under 37 C.F.R. § 42.6(a)(2)(iv). Patent Owners inadvertently formatted Opposition met the prescribed 15-page limit but was approximately 16.5 pages when formatted with the proper margins. Patent Owner has attached a marked up (redlined) amended Opposition (Exhibit A) that simply removes content from the Opposition filed on January 7, 2025.

Patent Owner has conferred with Petitioner regarding the present motion and Petitioner has indicated that it does not oppose it.

IV. ARGUMENT

The Board should allow Patent Owner to submit an amended Opposition to Petitioner's Motion for Sanctions because Paper 73 contained inadvertent clerical errors that were not noticed until after the Opposition was filed. Further, the submission of an amended Opposition does not prejudice Petitioner in any way.

Allowing for the submission of the amended Opposition to be filed and removing Paper 73 does not prejudice Petitioner because the errors do not substantively change the Opposition. Patent Owner is adding any content or argument to the Opposition. Further, Petitioner has not received the Board's authorization to file a Reply and does not face a response deadline. As such Petitioner is not prejudiced by the submission of the amended Opposition.

As the relief requested does not prejudice Petitioner, the error was clerical and typographical in nature, and Patent Owner filed the instant motion upon

receiving permission from the Board to do so, the instant Motion should be granted.

V. CONCLUSION

For the foregoing reasons, Patent Owner requests that the Board enter the attached amended Opposition to Petitioner's Motion for Sanctions into the record and removed Paper 73 from the record. In the alternative, Patent Owner requests a waiver of the document margin requirement under 37 C.F.R. § 42.6(a)(2)(iv).

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing PATENT OWNER'S MOTION TO SUBSTITUTE, was served by filing this document on the date indicated below through the Patent Trial and Appeal Case Tracking System (P-TACTS) and via e-mail to the following attorneys of record for the Patent Owner listed below:

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Dated: January 13, 2025

Respectfully submitted,

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EXHIBIT A

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

**PATENT OWNER'S CORRECTED OPPOSITION TO PETITIONER'S MOTION
FOR SANCTIONS**

I. Introduction

Petitioner's Motion is hyperbolic and devoid of evidence ~~of any misconduct,~~ intending to mislead this Board ~~into buying into its~~ with a false narrative ~~that Patent Owner ("PO") submitted false testimony.~~ Petitioner's false narrative is premised on Petitioner's: (i) mischaracterization and mis-construing PO's testimony regarding a specific tearing problem caused by a chemical interaction, as testimony regarding a generic "adhesion" problem; (ii) heavy reliance on a marked up document by PO's former employee, which is not evidence and not presented as a signed affidavit (required by 28 USC §1746), and mis-construing "could not confirm" in that document as somehow meaning "false;" and (iii) mis-construing the definition in the '882 patent of the Constab ingredient as being "made with" EBS as meaning the Constab ingredient somehow contains 100% EBS.

Petitioner's false narrative was borne out of an ill-fated meeting with Dr. Stark around June 24, 2024, ~~between Petitioner and Dr. Stark,~~ shortly after Petitioner agreed to compensate him for his testimony (EX2034). Petitioner then veered ~~off course~~ from the merits of this proceeding with a fabricated narrative, using Dr. Stark's lack of credibility as a shield to avoid sanctions for directly violating the District Court Order (EX2018; Paper 55, pg. 8-10), but relying ~~almost exclusively on~~ on Dr. Stark's markings as a sword, contending that ~~Dr.~~

~~Stark's~~his markings in EX1072 regarding statements he “could not confirm” as meaning “false.” Black’s Law Dictionary defines “confirm” as “to verify or corroborate.” *Confirm*, BLACK'S LAW DICTIONARY (12th ed. 2024). Based ~~upon~~on the definition of “confirm,” Dr. Stark cannot verify or corroborate the marked statements in the draft—and it is a clear overreach for Petitioner to suggest that it means “false.” Even if this Board were to agree with Petitioner that Dr. Stark meant the statements in *HIS* draft declaration were false for *HIM* to sign, Petitioner failed to provide any evidence that Dr. Boutrid and Mr. Schleicher submitted false testimony regarding matters of their own *personal* knowledge.

In response to this motion, PO searched its records for documents authored by Dr. Stark and/or Dr. Boutrid that would ~~shed light on~~show what actually transpired in the ~~Spring~~spring and ~~Summer~~summer of 2012. ~~PO presents this~~This evidence ~~proving~~proves not only was Dr. Stark unaware of complaints of tearing prior to June 2012, but that Dr. Stark also knew that Dr. Boutrid was unaware of such complaints. (EXs 2036-2039).

Petitioner seeks sanctions not for actual misconduct or knowing misrepresentation ~~of fact~~, but rather because PO disagrees with Petitioner’s mischaracterization of its inventors’ testimony, and Petitioner’s counsel’s inaccurate contention that an additive used in the examples, Constab® PE-SA 270 (“PE-SA 270”) is made of 100% ethylene bis stearamide (EBS). Glaringly absent

from Petitioner's Motion is any evidence directly refuting the inventor's testimony,¹ or any evidence that a POSITA would read and understand the '882 patent in the manner its counsel reads it. Petitioner's counsel knows that statements it made in its Motion, and throughout this proceeding (most recently before this panel in the oral argument) are false, as shown by Petitioner's counsel's own admissions, in documents presented ~~here~~ that Petitioner has concealed from this Board.

II. Legal Authority

~~In general, a~~A motion for sanctions should address: (i) whether a party has performed conduct that warrants sanctions; (ii) whether the moving party has suffered harm from the conduct; and (iii) whether the sanctions requested are proportionate to the harm suffered ~~by the moving party~~. *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 102 at 26 (PTAB Oct. 4, 2022).

Petitioner's motion fails to establish any sanctionable misconduct₂ that it has suffered harm, or that the extraordinary relief requested is proportionate. Further, Petitioner's delay in seeking sanctions and its concealment of its primary document for nearly four months warrant denial of its motion. *MG Freesites Ltd, v. Scorpcast, LLC*, IPR2021-00510, Paper 27, pg. 4 (PTAB March 25, 2022);

¹ Petitioner chose not to depose either witness so that it could fabricate this false narrative, which would have been refuted during their depositions.

Unified Patents Inc., v. Custom Media Technologies LLC, IPR2015-00516, Paper 12, pg. 3 (PTAB Jul. 9, 2015) (“We determine that Patent Owner’s request is untimely because Patent Owner waited until this late stage in the proceeding, . . . to request relief”). In *MG Freesites*, the Board held:

Petitioner’s failure to raise the issue of potential misconduct by phone with the Board . . . and Petitioner’s unexplained delay in raising the issue with the Board in a timely fashion . . . weighs heavily against granting Petitioner’s request to file a Motion for Sanctions. This failure is particularly problematic given the facts that the parties have already filed the Petitioner Reply and Patent Owner Sur-Reply . . . , and that our statutory deadline for issuing a Final Written Decision in this matter is fast approaching. Essentially, Petitioner requests a do-over at this late date.

Paper 27, pg. 4. Here, Petitioner concealed EX1070-1072 from PO and the Board for 4 months, withheld it from its August 23, 2024 letter to PO and any other of its correspondence at that time, concealed it from the Board during the September 17, ~~2024~~ conference call, and waited for almost 6 months before filing its motion—3 months after PO expressed its disagreement with Petitioner and affirmed there was nothing in its filing requiring correction. As in *MG Freesites*, and *Unified Patents*, this panel should deny Petitioner’s motion as untimely ~~and as essentially requesting a do-over.~~

Petitioner has failed to tie any of PO's actions to an actual violation of the ~~multiple~~ rules it cites. PO is unaware of a tribunal sanctioning counsel for disagreeing with one another over what the evidence shows, or for directly quoting an issued patent, yet this is what Petitioner requests. Petitioner's motion seeks to twist PO's evidence into untruths, and then shoehorn them into the *Longhorn* decision, a decision far afield from the facts ~~in this matter~~here. *Spectrum Solutions LLC v. Longhorn Vaccines & Diagnostics, LLC*, IPR2021-00847, Paper No. 142 (PTAB July 11, 2024) ("*Longhorn*"). Unlike *Longhorn*, PO has not withheld any inconsistent results, nor has there been a finding that anything PO stated is inaccurate or inconsistent. Remarkably, Petitioner's counsel admitted to this Board that the *Longhorn* decision ***did not apply*** because the issue ~~in this case~~here was merely a disagreement amongst counsel. (EX1057, 34:14-24, 35:1-4 ("[PO Counsel] stated that these documents are not false, they're - - so therefore that rule [referencing *Longhorn*] is not triggered.")). Nothing of substance has changed since ~~then other than Petitioner now relies on an irrelevant complaint (EX1060-1062), and documents (EXs 1070-1072) it concealed from this Board for 4 months, so it is curious that~~ that September 17, 2024 call to now apply *Longhorn*, so Petitioner's position that the parties' continued disagreement over what the evidence shows is somehow even worse than the facts in *Longhorn*.- is peculiar.

As such, the Board should deny Petitioner's motion.

~~Petitioner's counsel pleaded with this Board during that call that it was "trying to do the right thing here," (EX1057, 33:9-12) yet was knowingly and purposefully concealing from PO and this Board the main document it now relies upon in its motion (EX1072). If Petitioner was trying to do the right thing, why did it conceal the document from PO and the Board for over 4 months? As such, the Board should deny Petitioner's motion.~~

Petitioner's distortion of the inventor's testimony, misreading of the '882 patent, and exaggeration and reliance on Dr. Stark's marked-up document are not evidence—they are simply attorney arguments and hearsay. The fact that PO disagrees with Petitioner's counsel's arguments is not sanctionable as ~~Petitioner's counsel~~Petitioner admitted (EX1057, 34:14-24, 35:1-4), and as PO informed Petitioner on 9-10-2024 (EX2035).

III. Petitioner's Mischaracterization of ~~PO's~~ Inventor

Testimony

Petitioner conflates fact with fiction, relying on unrelated third-party documents about generic adhesion issues, rather than direct evidence ~~from PO's inventors~~, to discredit ~~them~~PO's inventors. These documents have no connection to the very specific problem the inventors identified in 2012. PO informed

Petitioner's counsel months ago on September 10, ~~2024,~~ (EX2035) and in the [September 5](#) meet and confer ~~dated September 5, 2024,~~ (EX1074) that the specific problem was that the inner film tore while being withdrawn from the pipe. Petitioner finally uses the term "tearing" in its Motion but relies on documents that never mention tearing of the inner film as supposed "proof" of an inconsistent statement. Adhesion, even strong adhesion, is not direct or even implied evidence of tearing of the film as it is withdrawn from the cured liner, as PO's counsel informed Petitioner months ago (EX2035 at 4).

Petitioner omits the most important paragraphs of Dr. Boutrid's declaration in its Motion (Paper 71 cites ¶¶12, 14, 18, and 19 of EX2004, glossing over ¶¶15-17). Paragraph 15 of EX2004 explains that Dr. Boutrid first learned that its customer "had begun using UV-curable resin that included maleic anhydride (MAH)," and ~~that~~ he "believed that the maleic anhydride in the UV-curable resin was probably sticking to the polyamide of the outer polyamide layer adjacent to the UV-curable resin." (EX2004, ¶15). This led to a specific type of tearing that was destroying the film, and not some generic type of adhesion, which is necessary for the inner liner to function, and unrelated to other types of tearing due to "longitudinal stresses caused by pulling the entire length of the film by just one location on the film," as Mr. Schleicher explained, (EX2003, ¶23) and as first reported to Dr. Boutrid in June 2012 by a customer (EX2043, ¶8, 9; EX2038 –

lists a customer complaint of tearing in years prior to 2012, but Dr. Boutrid never heard of those complaints prior to June 2012, or the nature of the problem. EX2043, ¶8).

As Dr. Boutrid details in his attached declaration (EX2043), he was aware of issues with adhesion prior to the '882 patent, and that adhesion is ~~a-~~ ~~requirement~~required for proper installation and function of the insertion tube for use in trenchless sewage pipe renovation. In fact, without adhesion, the inner film could collapse and destroy the film, possibly causing a fire. (EX2043, ¶¶9-11; EX2001, ¶63; Paper 13 at 54-55; Paper 47 at 12; EX2039, pg. 3, emphasis added: ***“The film must not separate too well because it could fall onto the very hot UV lamp after the compressed air is released and catch fire”***). Dr. Boutrid also explains the issues mentioned in the 2009 Saertex email (EX1060) and 2006 Quality Agreement (EX1058), none of which could be solved by the patented coating or covering, ~~or~~ nor is related to the specific problem he discovered involving a new UV curable resin containing MAH. (EX2004, ¶¶15-17; EX2043, ¶¶8, 13-25).

The 2009 Saertex email concerned a “winter problem” resulting from improperly installing the film in cold temperatures, and the 2006 Quality Agreement does not disclose ~~an actual~~a problem that ever occurred, but rather a

hypothetical issue ~~that might result~~arising if the outer layer was made from a polymer with a melting point outside the specifications listed in ~~that agreement~~ (§2.4). (EX2043, ¶¶22-25). Petitioner's counsel was informed of this latter point many months ago, (EX2035), but continues ~~inaccurately to state~~to misstate that the Quality Agreement "identified" strong adhesion as ~~an actual~~a real problem with PO's inner film. (Paper 71 at 5). It did not, and Dr. Boutrid states he was not aware of this potential problem occurring. (EX2043, ¶22).

PO has produced hundreds of pages of complaints to Petitioner, but Petitioner has ~~yet to produce~~not produced a single document that ~~directly~~ refutes the inventors' testimony (not Petitioner's distortion). PO did not submit false testimony, proved by internal PO documents from June ~~of 2012~~prove this, and PO cannot be sanctioned for statements it never made. ~~Prior testimony and~~The evidence presented ~~here shows~~shows that the problem PO first learned of was not a generic adhesion problem, or ~~even~~ a generic tearing problem (which can occur when the film bursts upon inflation, or the liner is pulled out at just one location—EX2003, ¶23), but was tearing because the inner film stuck to the new UV-curable resin due to the presence of MAH in the new resin the customer ~~had~~ ~~just~~ started using. Dr. Stark was not aware prior to June, 2012 of complaints involving tearing after curing (EX2036, pg. 1 ~~“He speaks of incidents in the form of tears. Do we have~~2, Dr. Stark asks if Buergofol had received any complaints?”

[of tearing](#)), and Dr. Stark knew that Dr. Boutrid was not aware of complaints involving tearing (EX2037, pg. 1, “Then you don’t know this (see below) yet?”). (See, EX2043, ¶9). The solution to this very specific problem would not have solved any of the prior reported generic adhesion or tearing problems. (EX2043, ¶¶14, 17, 25). Rather than proving the inventors made false statements, the evidence before the Board confirms that the inventors were the first to identify the problem of film tearing during withdrawal from the pipe due to the polyamide layer adhering to MAH in the UV-curable resin. (See, e.g., EX2033, ¶ 22).

IV. Petitioner’s Counsel’s Misreading of the ‘882 Patent

Since at least August 23, 2024, Petitioner has known the approximate amount of EBS wax in PE-SA 270, how to confirm that amount via a short call with the supplier, and that PO is aware of that amount. (EX2040). Despite this knowledge, Petitioner persists in ~~its blatant~~ misreading of the ’882 patent, suggesting PE-SA 270 contains 100% wax and misunderstanding the ’882 patent’s express definition: “release (wax) Constab PE-SA 270 **MADE WITH ETHYLENE BIS STEARAMIDE (EBS)**.” (EX2001 at col. 15:14-17, emphasis added; EX2043, ¶¶ 26-31). Petitioner presents no evidence that a POSITA would have understood the ’882 patent as Petitioner ~~appears to read~~[misreads](#) it, or ~~that a skilled artisan~~ would not have understood the composition of PE-SA 270 in the examples of the ’882 patent, or that the later references in the ’882 patent to

“release wax” or “wax” include parentheticals referring to the composition disclosed in the examples.

The Motion quotes Dr. Boutrid’s declaration as, “the addition of 6% wax (example B6) increases elasticity.” (Paper 71, page 7, emphasis added). As PO’s counsel made it clear to Petitioner in a letter dated September 10, 2024, the inventor, PO, and its expert were quoting directly from the ’882 patent. The parenthetical in the above quote “(example B6)” directs the reader to example B6, where it is clear that it contains 6% PE-SA 270. *Id.* The ’882 patent also expressly defines the release wax: “[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.” (EX1001~~at~~2, col. 15, ll. 14-17, emphasis added; EX2043, ¶30; EX2035 pg. 6).

On August 23, 2024, Petitioner’s Counsel admitted reviewing Dr. Boutrid’s *ex parte* deposition where he testified that he knew Constab PE-SA 270 did not have over 20% EBS wax. (EX2040, pg. 6). Despite this admission, Petitioner ~~continues to feign~~maintains ignorance, ~~going so far as~~ stating neither PO nor its expert knew what was in PE-SA 270, (Paper 24 pg. 11) and stating at oral argument it did not know and has been trying to find out for a very long time. Petitioner could not be looking that hard since Dr. Brant told them how to find out ~~no less than~~ 3 times~~;~~2 (EX1052, pg. 25~~;~~11~~;~~8-17), and Dr. Boutrid told them how

much is present and how to find out (EX2040, pg. 6). Petitioner knows and could independently easily verify the amount in a matter of just a few minutes.

Petitioner ~~has provided~~provides no legal authority in which a Patent Owner has been sanctioned for directly quoting and relying on data from an issued patent. ~~The amount of~~EBS wax ~~present~~content in PE-SA 270 is an inherent feature of the material, and therefore is inherently disclosed by the '882 patent, and readily ascertainable by anyone skilled in the art. *Yeda Research and Dev. Co. v. Abbott GMBH & Co.*, 837 F.3d 1341, 1345 (Fed. Cir. 2016). Moreover, the '882 patent makes it clear that PE-SA 270 is not 100% EBS, ~~first~~ by stating it is made “with” EBS wax, and ~~second~~ by referencing the amount of lipophilic compound in the outer layer as “preferably at least 0.1% by weight, more preferably at least 0.5% by weight and even more preferably at least 1% by weight.” (EX1001, col. 6, ll. 16-19; EX2043, ¶¶ 30-31). Prior to that paragraph, the '882 patent discloses several specific migrating, lipophilic compounds including waxes (EX1001, col. 5, l. 39 to col. 6, l. 9), although the examples define the migrating lipophilic compound differently as PE-SA 270. (EX1001, col. 15, ll. 14-17). The examples use 1%, 4%, and 6% of PE-SA 270, ~~respectively,~~ which would inform a POSITA that PE-SA 270 cannot be 100% EBS, but likely contains ~~on the order of~~ 10%-20%. (1% PE-SA 270 ~~used~~ in Example B4 would result in the outer layer containing 0.1% by weight EBS if PE-SA 270 contained

10% EBS, ~~and~~ 6% PE-SA 270 ~~used~~ in Example B6 would result in the outer layer containing 1% or more EBS if PE-SA 270 contained more than 16.7% EBS.

EX2043, ¶31).

The '882 patent is clear that PE-SA 270 does not contain 100% EBS, but ~~rather~~ contains ~~precisely~~ the amount Dr. Boutrid stated, and the amount Petitioner's counsel has known it contains for over 4 months. (EX2040). Notably, Petitioner easily understood that PE-SA 270 was not made from 100% EBS when citing the Schumann reference in ~~Ground III of~~ the Petition, which included nearly identical language to the '882 patent to describe the release wax ("Constab PE-SA 270 (based on ethylene-bis-stearylamine (EBS))" – EX1007, 23:5).

Petitioner's Motion ~~for Sanctions~~ reaches a new low by referencing PO's counsel specifically by his full name (Paper 71, pg. 9). Making matters worse, ~~Petitioner quoted a fraction of counsel's statement, and~~ Petitioner's fractional quotation intentionally omitted ~~the most important part~~ vital context. PO's counsel ~~was merely stating~~ stated the irrefutable fact that both sides in any ~~adversarial~~ proceeding may unknowingly make false statements—that humans ~~are fallible and~~ make mistakes. (EX2042, ¶7). For example, if this Board finds that Hummel does not anticipate any ~~of the~~ Challenged Claims, then Petitioner's statements that Hummel anticipates those claims will be false. That does not make them sanctionable. That is simple advocacy. What Petitioner omitted from its dishonest

quotations is the last sentence following the statements beginning with “I’m sure:”
“And I can assure you that I have never submitted once in my life, and never will, a knowingly false statement.” (EX1074, 20:4-13; EX2042, ¶7). PO’s counsel explicitly stated that no knowingly false statements were made, yet Petitioner deceptively ~~presents select excerpts to suggest~~suggests PO admitted to making a knowingly false statement. ~~Quoting specific~~Directly quoting examples ~~directly~~ from the ’882 patent when referencing “release wax” or “wax” is not sanctionable simply because Petitioner’s counsel ~~misunderstands and~~ misreads the patent (EX2042, ¶¶5,8,9).

V. Disclosure of Inconsistent Documents

The Motion references allegedly “inconsistent” documents, but Petitioner fails to show any specific inconsistent statement or argument made by PO. Attorney argument that certain documents broadly contradict PO’s core arguments regarding POSITA knowledge and unexpected results, is not evidence of inconsistent statements. In addition, ~~recently obtained~~ internal Buergofol documents clearly show that, prior to ~~June~~the spring of 2012, neither Dr. Stark nor Dr. Boutrid were aware of customer complaints of tearing of the inner film while being withdrawn from the renovated pipe, nor tearing due to the presence of MAH in a new UV-curable resin that interacted (or reacted) with the outer polyamide layer of the inner film. (EX2043, ¶¶ 8, 32; EX2036; EX2037).

VI. PO's Alleged "Scheme"

Petitioner seeks to concoct an alleged "scheme" by PO and ~~to create alleged false statements out of an unsigned document with "unconfirmed" markings.~~ ~~Petitioner again~~ attempts to mislead the Board, stating that PO's motion for a protective order was denied. (Paper 71, pg. 12). In truth, PO's request for a protective order was denied *in part* but was ultimately granted with safeguards in place. (EX2018). PO was ~~rightfully~~ concerned Dr. Stark would communicate confidential information ~~to Petitioner if unencumbered~~. PO sent the draft declaration only *after securing* assurances from the District Court (EX2018) pursuant to PO's arguments regarding Dr. Stark's unreliability ~~(which Petitioner relies upon to support its work product waiver argument statements PO made before the Order)~~. PO had, ~~as would any party,~~ a reasonable expectation that upon sending the draft ~~declaration~~ to Dr. Stark through German counsel, with a reminder of his obligations ~~of secrecy and to assist PO (see Motion to Strike,~~ Paper 33, pg. 2; EX2023; EX2041, ¶7), Dr. Stark, his German counsel, and Petitioner's counsel would comply with the District Court Order.

Petitioner repeatedly contends that Dr. Stark exposes "numerous false statements ~~mirroring those in PO's submitted declarations,~~" but Dr. Stark *does not* indicate that anything ~~in the draft declaration sent to him~~ he marked was *false*. At best, Dr. ~~Stark indicates by underlining that~~ Stark's markings indicate he *cannot*

personally confirm certain facts, ~~but only pertaining to him personally~~. Finally, ~~PO has recently discovered~~ PO's internal ~~PO~~-correspondence from Dr. Stark ~~proving~~ proves that in June of 2012, ~~not only was~~ Dr. Stark unaware of prior complaints of the inner film tearing (EX2036), ~~but he also~~ and knew that Dr. Boutrid was unaware of any such complaints (EX2037), directly refuting any “falsehoods” Petitioner ~~attributes to his markings~~ claims.

PO informing Dr. Stark of his legal obligations and the consequences for violating those obligations is neither extreme, improper, nor sanctionable ~~conduct~~. Dr. Stark is a German citizen subject to obligations under his August 27, 2011, employment contract with Buergofol under German law (EX2041, ¶6), as well as the Assignment Agreement that he signed ~~relative to~~ for the ‘882 patent (EX2023). Clause 9.2 of the employment contract refers to obligations of confidentiality that continue past his employment, and violations of those obligations can result in civil and criminal penalties under German law. The Assignment Agreement at EX2023 includes an obligation to “generally do everything possible to vest title in ASSIGNEE and to aid ASSIGNEE to obtain and enforce proper protection for said invention in all countries.” (EX2023). The German lawyer who forwarded the draft declaration (EX1070), was referring to these aspects previously pointed out to Dr. Stark when referencing that “[W]e had already pointed out that Mr. Stark, as co-inventor and former employee, is obliged to provide support and

cooperation.” (EX2041, ¶¶5-6).

Sections III(A)(4)(c)-(g) of the Motion lack ~~supporting~~ evidence, do not contend that ~~any of~~ the specific conduct alleged is sanctionable, and fail to explain the relevance of district court issues to those present before this Board. Petitioner presents no evidence that PO “silenced” a witness ~~after Petitioner’s Reply~~ (Paper 71, pg. 12), or how PO’s truthful statement in a district court filing, is sanctionable. (Paper 71 pg. 13). Petitioner asserts in Section III(A)(4)(e) that PO sought to “improperly introduce new ‘evidence’ ~~outside the rules,~~” and that ~~“PO’s inaction forced Petitioner to address its false statements in the reply brief.”~~ Petitioner sent PO a threat (EX2040) contending that PO’s inventors submitted false testimony and made false statements in the patent regarding PE-SA 270, demanding PO disclaim the patent and withdraw the declarations or else they would file a motion for sanctions. PO requested the Board’s authorization to submit those documents, and Petitioner opposed, ~~knowingly and~~ falsely stating ~~to the PTAB~~ that it was only requesting that PO redact the ~~inventor~~ declarations (EX1057, 26:18-19), when EX2040 only includes a demand to withdraw the entire declaration. ~~Petitioner’s counsel obtained the relief it sought in that conference call by admitting that Longhorn did not apply to this case. (EX1057, 33:23-24, 34:1-4). Nothing of substance has changed since that September 17, 2024 call to now apply Longhorn.~~ In sum, Petitioner fails to tie its allegations in

Section III(A)(4) to authority justifying sanctions, but appears to be deliberately attempting to paint PO as a bad actor, ~~without evidence~~.

Section III(B) fails to show any real harm to Petitioner beyond expenses any adversary would naturally incur. ~~Even assuming Petitioner expended “significant resources” in filing its motion, those resources were not the result of any action by PO.~~

For the foregoing reasons, Petitioner’s Motion for Sanctions should be denied.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing PATENT OWNER'S CORRECTED OPPOSITION TO PETITIONER'S MOTION FOR SANCTIONS, was served by filing this document on the date indicated below through the Patent Trial and Appeal Case Tracking System (P-TACTS) and via e-mail to the following attorneys of record for the Patent Owner listed below:

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Dated: January ~~7~~13, 2025.

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Summary report: Litera Compare for Word 11.9.1.1 Document comparison done on 1/13/2025 6:27:39 PM	
Style name: Default Style	
Intelligent Table Comparison: Active	
Original DMS: nd://4898-6432-7435/7/DRAFT PO Opposition to Motion for Sanctions.docx	
Modified DMS: nd://4910-0742-5550/3/Corrected DRAFT PO Opposition to Motion for Sanctions.docx	
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~~Delete~~	121
~~Move From~~	0
<u>Move To</u>	0
<u>Table Insert</u>	0
~~Table Delete~~	0
<u>Table moves to</u>	0
~~Table moves from~~	0
Embedded Graphics (Visio, ChemDraw, Images etc.)	0
Embedded Excel	0
Format changes	0
Total Changes:	185