

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OMEGA LINER COMPANY, INC.,

Petitioner

v.

BUERGOFOL GmbH,

Patent Owner.

IPR2023-01372

Patent 9,657,882 B2

**PETITIONER’S REPLY TO PATENT OWNER’S OPPOSITION TO
PETITIONER’S MOTION FOR SANCTIONS**

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A. Introduction.

PO knew its film had “massive” adhesion problems before 2012 but represented *the exact opposite* to the PTAB. Caught red-handed, PO seeks to rewrite the record to save itself. PO now insists that it was only unaware of a “very specific” adhesion problem allegedly caused by maleic anhydride (MAH)—despite admitting its claims require no such thing and its specification makes no mention of this “specific” problem.¹ Worse, PO attempts to defy the PTAB again by reintroducing previously denied testimony on this irrelevant point for appeal purposes.²

Having now reimagined the record, PO discloses for the first time evidence it improperly withheld from Petitioner during trial in violation of Rule 42.51(b)(1)(iii). Shockingly, Dr. Boutrid’s new declaration flip-flops now admitting that “*prior to the Spring of 2012, I was made aware of adhesion problems with Buergofol’s inner film* [].” (EX2043, ¶7.) Additionally, PO’s June 5, 2012 customer “Visit Report” reveals numerous adhesion-tearing issues in 2010 (49 problems) and 2011

¹ At the close of PO’s oral argument sur-rebuttal, PO acknowledged this and walked away from the podium. (Transcript unavailable at time of filing.)

² (Paper 44.) Allowing PO to backdoor merit-based evidence without cross-exam violates Petitioner’s due process rights to cross-examination. 5 U.S.C. § 556(d).

(56 problems). (EX2038, p. 2.) These are the very “massive problems” that PO has consistently and vehemently denied existed until being subject to sanctions.

PO’s arguments regarding its slip agent (EBS wax) misrepresentations fare no better. Claiming “humans are fallible” and it was merely “quoting” the patent, PO offers no explanation as to why it is ethical to repeat known falsehoods.

PO’s repeated violations of its Duty of Candor warrant significant sanctions.

B. Newly Revealed Evidence Confirms Inventors Knew of Adhesion Problems Before Spring of 2012.

Gregor Schleicher and Dr. Boutrid now admit in their new declarations that they knew of adhesion problems “prior to the Spring of 2012.” (EX2033, ¶7; EX2043, ¶7.) Also, a newly submitted June 5, 2012 customer “Visit Report” reveals, “*We have already been informed* of ‘general complaints’ about *film tears* when removing the inner tube film after resin curing,” identifying **49 complaints in 2010** and **56 complaints in 2011**. (EX2038, p. 2.) Despite being responsible for customer complaints and quality control, Mr. Schleicher and Dr. Boutrid failed to disclose this inconsistent information to the PTAB. (EX2003, ¶¶7, 8, 24; EX2004, ¶¶8, 19.)

In an attempt to excuse its misrepresentations in the original declarations, PO tries to limit the adhesion problem to “very specific problem” and a “specific type of tearing” allegedly caused by MAH. (Paper 73, pp. 5-8.) First, the ’882 Patent does not mention any curable resin having MAH and merely describes the adhesion problem broadly in terms of lack of “release effect against adhesive resins” with

tearing occurring only in the “worst case scenario.” (EX1001, 2:30-38.) Second, Mr. Schleicher’s declaration does not mention MAH or anything “specific.” (EX2003.) Third, Dr. Boutrid’s testimony of when he first learned of any adhesion problems is not limited to a “specific problem” or a “specific type of tearing” different from that described in the ’882 Patent. (EX2004, ¶¶12, 14, 18, 19; *see also*, Paper 54, pp. 4-7, Petitioner’s motion to exclude MAH testimony as hearsay.) Finally, the absence of curable resin with MAH in the inventor testing is telling. (EX2004, ¶25.)

PO’s claims about Dr. Stark’s knowledge also fail. First, PO’s claims that a June 1, 2012 email shows Dr. Stark was unaware of any problems is irrelevant since he only began working for PO in October 2011 and would have limited historical knowledge at that time. (EX1040, p. 2.) Second, the email thread submitted by PO merely references “problems” without any specifics—and **omits the intervening response emails** between Dr. Stark’s June 1 and June 4, 2012 emails. (EX2036, pp. 1-2.) Third, PO’s argument that Dr. Stark’s markings in EX1072 reflect only that he “could not confirm” them is irrelevant to PO’s duty to disclose inconsistent information. Contradictorily, PO’s counsel admitted during a hearing with the Board that Dr. Stark was “pretty smart” for not expressly stating the statements were “false” to avoid being “sued in Germany.” (EX1085, 3:18-4:1.) Finally, the declarations are based on the personal knowledge of Dr. Boutrid and Mr. Schleicher—not Dr. Stark’s knowledge.

In response to this motion, PO admits it limited its search solely to documents “*authored by* Dr. Stark and/or Dr. Boutrid that would shed light on *what actually transpired in the Spring and Summer of 2012.*” (Paper 73, 2:6-8.) This overly narrow search violates Rule 42.11(c) by excluding (i) documents authored/received by Mr. Schleicher, (ii) customer complaints *received* (e.g. Saertex complaints), and (iii) documents predating 2012. Notably, PO has failed to produce the “Visit Reports” from the “customer meetings” where Dr. Boutrid said he first learned about MAH. (EX2004, ¶15.)

Finally, PO again claims the Saertex email concerned “cold weather” issues, a nonsensical claim contradicted by PO’s own filings. (*See*, Paper 41, pp. 4-5.)

C. PO’s False Wax Statements Not Justified by “Quoting” the Patent.

PO and its counsel cannot evade responsibility for the false statements in its declarations regarding the wax content in Examples B4-B6: “**the addition of 6% wax** (example B6) increases elasticity” (EX2004, ¶58), “**1% release wax,**” “**4% release wax**” and “**6% release wax**” (EX2001, ¶¶69-71), and “using different amounts of **migrating compound** ... other than the use of far less than the **1% used in Example B4**, or far more than the **6% used in Example B6**” (EX2001, ¶72).

Dr. Boutrid’s new declaration admits he knew in 2012 that Constab PE-SA 270 was far from 100% EBS wax. (EX2043, ¶28.) Moreover, PO’s opposition does not deny that its former lead counsel, Patrick Doody, knew the statements were false.

PO attempts to excuse its false statements by claiming they were “quoting directly from the ’882 patent” and accusing Petitioner of “blatant misreading of the ’882 Patent.” (Paper 73, pp. 9-12.) First, quoting the patent does not absolve PO or its counsel of their Duty of Candor when making knowingly false statements. Second, Dr. Boutrid’s declaration rewrote portions of the specification regarding the composition of Constab PE-SA 270 *demonstrating full awareness of its inaccuracy*. (EX2004, ¶¶41-43; *see*, Paper 39, p. 4.) Third, even if PO’s arguments were valid (which they are not), they do not excuse its Duty of Candor about the true composition of Constab PE-SA 270. Finally, PO still fails to disclose its knowledge of the **non-migrating compounds** in Constab PE-SA 270—polyethylene and calcium carbonate—or their effect on the release and elongation test results.

Finally, PO argues “humans are fallible and make mistakes,” yet once its counsel was made aware of these “mistakes,” they had an obligation to (1) “expressly advise the PTO of its existence” and (2) advise the PTO of “what the actual facts are”—a duty PO’s counsel failed to fulfill. *Rohm & Haas Co. v. Crystal Chem. Co.*, 722 F.2d 1556, 1572 (Fed. Cir. 1983). This duty remains unfulfilled.

D. Conclusion.

Petitioner respectfully requests entry of judgment against PO, or an award of its fees incurred in addressing PO’s frivolous motions, with both of PO’s law firms held jointly and severally liable.

Dated: January 21, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing *PETITIONER'S REPLY TO PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION FOR SANCTIONS*, including all exhibits, 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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