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Subject: Omega Liner Co. v. Buergofol GmbH (IPR2023-01372) ('882)- Unauthorized Reply re Motion for Sanctions
Date: Monday, January 27, 2025 9:15:00 AM
Attachments: [image001.png](#)
[image002.png](#)

Counsel:

Taking account of the parties' respective positions set forth in the email below, the Board determines that Petitioner shows good cause for submitting Paper 79. We deny Patent Owner's request for authorization to strike Paper 79. Paper 79 shall remain in the record and be deemed timely filed. The Board will enter a copy of this correspondence as Exhibit 3010.

Regards,

Tina Lee
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Jakopin, David A. <david.jakopin@pillsburylaw.com>
Sent: Friday, January 24, 2025 2:42 PM
To: Trials <Trials@USPTO.GOV>
Cc: Michael Neustel <michael@neustel.com>; Scott.McKeown@WolfGreenfield.com; Monte Bond <monte@neustel.com>; darien@imperiumpw.com; Lester@imperiumpw.com
Subject: Omega Liner Co. v. Buergofol GmbH (IPR2023-01372) ('882)- Unauthorized Reply re Motion for Sanctions

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Dear Honorable Board,

I am counsel for Patent Owner Buergofol GmbH in the above-captioned matter (IPR2023-01372). Patent Owner and Petitioner request a conference call with the Board regarding the submission of Petitioner's Reply in Support of Motion for Sanctions (Paper 79). Patent Owner has conferred with Petitioner regarding the submission of Paper 79, and the following represents the parties' respective positions

Patent Owner's Position

Under this Board's December 12, 2024 order (Paper 70), Petitioner was authorized to file motion for sanctions by December 23, 2024. In addition, Patent Owner was authorized to file an Opposition to Petitioner's Motion on or before January 7, 2025. The Board's order does not authorize any other filings. Petitioner's Reply (Paper 79) was unauthorized and should be expunged from the record pursuant to 37 C.F.R. § 42.7(a). In the alternative, Patent Owner requests authorization to file a motion to strike.

The Board's rules do not automatically grant Petitioner authorization to submit a Reply in support of its Motion. 37 C.F.R. § 42.25(a) (a motion may only be filed according to a schedule set by the Board); 37 C.F.R. § 42.20 (a motion will not be entered without Board authorization).

This Board's December 12, 2024 order (Paper 70) authorized only the filing of Petitioner's Motion and Patent Owner's Opposition. It did not authorize a Reply.

Further, the Board's precedent supports Patent Owner's position. Typically, a Board order that authorizes a Reply will explicitly provide such authorization in its order. *See e.g., Yita LLC v. MacNeil IP LLC*, IPR2023-00172, Paper 54 at 2 (P.T.A.B. Mar. 12, 2024) (authorizing a Motion for Sanctions, an Opposition, and a Reply); *One World Technologies, Inc. v. Chervon (HK) Ltd.*, IPR2020-00884, Paper 27 at 6 (P.T.A.B. Feb. 11, 2021) (same); *Coalition for Affordable Drugs IV LLC v. Pharmacyclics, Inc.*, IPR2015-01076, Paper 15 at 3 (P.T.A.B. July 28, 2015) (same). In comparison, in orders that have not explicitly authorized a Reply in support of a Motion for Sanctions, no Reply can be found in the record. *See e.g., RPX Corp. v. Applications In Internet Time, LLC*, IPR2015-01750, Paper 23 at 5 (P.T.A.B. Dec. 4, 2015) (Authorizing only a Motion for Sanctions and an Opposition); *Apple Inc. v. California Institute of Technology*, IPR2017-00210, Paper 48 at 3 (P.T.A.B. Feb. 10, 2018).

Petitioner's Position

To the extent PO's improper argument and inapposite case citations are even considered as inappropriately presented in this email, Petitioner has already explained to PO that the burden remains with the movant (Rule 42.20(c)), and that like Motions to Amend, Exclude, etc., 5 page replies are contemplated as a matter of due process (Rules 42.23(b), 42.24(c)(2) and 42.25(a)(2)). Given this well-worn practice, and the Board's most recent, and identical handling of sanctions briefing in *Spectrum Solutions LLC v. Longhorn Vaccines & Diagnostics, LLC*, IPR2021-00847 (Paper 84, Reply), Petitioner did not interpret the December 13, 2024 Order (Paper 70) as straying from that authority.

Nevertheless, should a showing of good cause be deemed necessary, Petitioner notes that PO's opposition introduced (a) 42 pages of new inventor declarations (EX2033, EX2043) that address merit-based arguments and that present new and conflicting testimony relative to earlier trial testimony, and (b) a customer Visit Report (EX2038) inconsistent with prior trial testimony and not previously produced as required. Petitioner submits that its 5-page Reply (Paper 79) will aid the Board in addressing these matters in the most efficient manner possible.

Respectfully submitted,

David A. Jakopin | Partner

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