

UNITED STATES DISTRICT COURT
DISTRICT OF SOUTH DAKOTA
SOUTHERN DIVISION

BUERGOFOL GMBH, Plaintiff, vs. OMEGA LINER COMPANY, INC., Defendant.	Civil Action No.: 22-cv-04112-KES BUERGOFOL’S RESPONSES TO OMEGA’S INTERROGATORIES TO BUERGOFOL (SET TWO) (Nos. 6-13)
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PROPOUNDING PARTY: OMEGA LINER COMPANY, INC.

RESPONDING PARTY: BUERGOFOL GMBH

SET NUMBER: TWO (2)

To OMEGA and its attorneys of record:

Pursuant to Rule 33 of the Federal Rules of Civil Procedure, Plaintiff

BUERGOFOL GMBH (“Buergofol”) hereby responds to Defendant OMEGA LINER COMPANY, INC.’s (“Omega”) Set One of Interrogatories. The following responses are based on Buergofol’s present state of recollection, knowledge and belief. They are at all times subject to additional or different information that discovery may disclose, and, while based on the present state of recollection, are subject to such refreshing of recollection, and such knowledge or facts, as may result from further investigation by Buergofol or its attorneys. Buergofol’s answers and objections are made without in any way waiving or intending to waive, but on the contrary, intending to preserve and preserving:

1. All questions as to competency, relevancy, materiality, privilege and

admissibility as evidence for any purpose of the responses or subject matter thereof, in any subsequent proceeding in or at the trial of this or any other action;

2. The right to object on any ground to the use of said responses, or the subject matter thereof, in any subsequent proceeding in the trial of this or any other action; and

3. The right to object on any ground at any time to other interrogatories or other discovery procedures involving or relating to the subject matter of these interrogatories.

GENERAL OBJECTIONS

1. Buergofol objects to each and every interrogatory to the extent that it purports to impose any requirement or discovery obligation upon Buergofol other than as set forth in the Federal Rules of Civil Procedure and any applicable local rules of this Court.

2. Buergofol objects to each and every interrogatory to the extent that it seeks information that is not relevant to any party's claim or defense and proportional to the needs of the case.

3. Buergofol objects to each and every interrogatory to the extent that it seeks information protected by the attorney-client privilege, the attorney work product doctrine, or any other applicable restriction upon discovery.

4. Buergofol objects to each and every interrogatory to the extent that it purports to require Buergofol to disclose the content of any part of any agreement between Buergofol and a third party which by its terms may not be disclosed by Buergofol.

5. Buergofol objects to the definitions of "BUERGOFOL", "YOU" and "YOUR" to the extent that these definitions purport to include any company, individual, or entity other than Buergofol GmbH, a German limited liability company. Buergofol will respond only to discovery that seeks discoverable information concerning plaintiff Buergofol GmbH. Otherwise, the definitions are overbroad, burdensome and are inclusive of irrelevant subject matter.

The foregoing general objections shall be deemed continuous throughout the

responses to specific interrogatories which follow, even though not specifically referred to in such responses.

RESPONSES

INTERROGATORY NO. 6:

For each Claim-in-Suit, describe all facts and circumstances, including dates, relating to the conception, development, reduction to practice, and decision to seek patent protection of the claimed subject matter and all acts of diligence from the alleged date of conception to the alleged date of reduction to practice, and identify each person with knowledge of the foregoing and all documents relating to the foregoing.

RESPONSE TO INTERROGATORY NO. 6:

Buergofol objects to ROG No. 6 as being unduly burdensome at this time because it seeks information that is not relevant to any party's current claims or defenses and is therefore not proportional to the needs of the case. ROG No. 6 seeks all facts and circumstances that would support Buergofol's ability to swear behind potential items of prior art that might have dates prior to the filing dates of the foreign priority documents to the Patents-in-Suit. Because Omega has not yet identified any prior art that it contends invalidates any Claim-in-Suit, Omega has raised no invalidity defense to which the information sought in ROG No. 6 could be relevant. Swearing behind prior art by establishing earlier conception, diligence and reduction to practice requires a detailed showing of periodic demonstrations of diligence between conception and reduction to practice. The detailed showing of continued diligence is burdensome to establish, especially for events that occurred more than a decade ago, and for the '269 Patent at a company other than Buergofol. This discovery request is premature before Buergofol is informed of the date of the particular prior art upon which Omega bases its invalidity defense. At the current time, Omega has not yet even answered Buergofol's complaint and has not plead any invalidity defense based on prior art. Hence, this request is overly burdensome, not relevant to Omega's defenses, and not proportional to the needs of the case.

Subject to and without waiving the foregoing objections, Buergofol answers as follows. Buergofol has not completed discovery and is still investigating the facts relating to how the inventions of the Claims-in-Suit were conceived and reduced to practice. This answer is based on current knowledge is subject to additional or different information that discovery may disclose. This answer will be supplemented pursuant to Rule 26(e) after Buergofol has conducted additional investigation to establish conception, diligence and reduction to practice in order to swear behind a specific item of prior art relied upon by Omega for an invalidity defense, if Omega raises such a defense.

All Claims-in-Suit of US 8,794,269. Henrik Hummel conceived of the inventions of the '269 Patent. From the time of conception until the filing of the priority document DE 10 2010 023 764.7 on June 15, 2010, Henrik Hummel was an employee of Huhtamaki Deutschland GmbH & Co. KG. Buergofol has never had control over Huhtamaki or Hummel and has not obtained any information from Huhtamaki or Hummel relating to the facts and circumstances requested in ROG No. 6.

All Claims-in-Suit of US 9,657,882. The inventions of the '882 Patent were conceived of by the three inventors Kurt Stark, Gregor Schleicher and Abdel Kader Boutrid. In addition to the three inventors, Thomas Schlieff also has knowledge of the conception, diligence and reduction to practice of the inventions of DE 10 2013 102 394.0 and DE 10 2013 109 052.4. Thomas Schlieff is the German patent attorney who drafted and filed the German patent applications DE 10 2013 102 394.0 and DE 10 2013 109 052.4. Thomas Schlieff is a partner of the law firm of Canzler & Bergmeier in Ingolstadt, Germany. Thomas Schlieff continues to represent Buergofol. Kurt Stark conceived of the inventions of the '882 Patent at least as early as January 25, 2013 when he disclosed the inventions to Thomas Schlieff in a privileged invention disclosure document. Kurt Stark conceived of the inventions of the '882 Patent before January 25, 2013 in response to complaints from liner customers of Buergofol in Europe that the inner film would sometimes stick to the cured resin and would be rip during

removal from the retrofitted pipe leaving pieces of film inside the pipe.

INTERROGATORY NO. 7:

Identify all opinions, evaluations, analyses, or reverse engineering reports, whether written or oral, that Buergofol has requested, received or is aware of regarding any Patent-in-Suit, including, but not limited to, date, author(s), addressee(s), recipient(s) and whether it relates to infringement or noninfringement, validity or invalidity, enforceability or unenforceability, any other affirmative defense, or a valuation of any Patent-in- Suit.

RESPONSE TO INTERROGATORY NO. 7:

Buergofol objects to ROG No. 7 for being vague and failing clearly to describe what is meant by a “reverse engineering report regarding a patent”. Buergofol has no knowledge of how a patent could be reverse engineered.

Buergofol objects to ROG No. 7 for introducing distinct subparts that are not logically or necessarily related. An evaluation of invalidity is specific to a version of a specific claim as opposed to a patent. Each invalidity argument against a version of a claim by an examiner at a patent office involves a distinct analysis, which is potentially responsive to a distinct subpart of ROG No. 7. An analysis or evaluation of the validity of claims in different patents certainly involves distinct subparts of ROG No. 7. The analysis of infringement is also specific to a claim as opposed to a patent, which is potentially responsive to a distinct subpart of ROG No. 7. Certainly, infringement analyses of claims of different patents involve distinct subparts of ROG No. 7. An opinion of unenforceability also involves an analysis distinct from validity and infringement. An opinion relating to an affirmative defense other than unenforceability would also involve a distinct subpart of ROG No. 7 for each Patent-in-Suit. Each analysis of a monetary valuation of each Patent-in-Suit also involves a distinct subpart of ROG No. 7 which is not

necessarily related to any of the other many subparts of ROG No. 7.

Buergofol objects to answering ROG No. 7 to the extent that responsive opinions, evaluations and analyses of the infringement by Omega's products are covered by the attorney-client privilege or were part of the pre-litigation analysis of Omega's products performed in anticipation of this legal action. Buergofol objects to answering ROG No. 7 to the extent that responsive opinions, evaluations and analyses relating to the validity of either of the Patents-in-Suit are covered by the attorney-client privilege or were part of the pre-litigation analysis performed in anticipation of this legal action.

Subject to and without waiving the foregoing objections, Buergofol responds as follows:

Kurt Stark was of the opinion that Omega's liner made with orange outer film fell completely within the scope of U.S. Patent No. 8,361,580, which Kurt Stark explained to Kenny Moulds in an email dated 9/30/19 8:56AM (BF2407-BF2419). The '580 patents includes claims with some of the same claim elements present in the claims of the '882 and '269 patents. Kurt Stark was of the opinion that Omega's liner made with orange outer film from anyone other than Buergofol infringed the '580 Patent, which Kurt Stark explained to Grant Marquardt and Kenny Moulds in an email dated 9/30/20 4:55AM (BF2626-BF2639). Kurt Stark was of the opinion that UV CIPP liner made with orange outer film was patented by the '580 Patent, which Kurt Stark explained to Grant Marquardt and Kenny Moulds in an email dated 5/15/20 9:00AM (BF2482). Kurt Stark was of the opinion that Omega's liner was infringing the '580 Patent, which Kurt Stark expressed to Franz Schleicher and Tobias Goth in an email dated 5/19/20 9:02AM (BF2494-BF2505). Kurt Stark was of the opinion that Omega's liner made with outer film purchased by Omega from a company going out of business was covered by the '580 Patent, which Kurt Stark explained to Kenny Moulds in an email dated 11/3/20 11:40PM (BF2644).

Franz Schleicher was of the opinion that Omega's sale of liner made with yellow

or orange outer film that absorbs UV infringes the '580 Patent if Omega does not obtain a license from Buergofol, which Franz Schleicher explained to Grant Marquardt in emails dated 8/11/21 08:11AM (BF2717) and 8/17/21 9:09AM (BF2725-BF2726)

Franz Schleicher provided an analysis of why Omega's liner is covered by U.S. Patent No. 9,657,882, which Franz Schleicher explained to Gary Strom, Kenny Moulds and Grant Marquardt in an email dated 8/29/21 9:44PM to which the '882 Patent and '580 Patent were attached (BF2734-BF2777).

Opinions and evaluations of the validity of pending claims of the foreign applications to which the Patents-in-Suit claim priority are contained in the examination history of the foreign applications and any opposition proceedings to the issuance of foreign patents. The foreign applications include claims with some of the same claim elements present in the claims of the '882 and '269 patents, although the foreign applications claim film, whereas the '882 and '269 patents claim liner.

INTERROGATORY NO. 8:

Describe all facts and circumstances relating to any ownership or licensing interests in any Patent-in-Suit or offer to license any Patent-in-Suit, including, but not limited to, the identification of all individuals or organizations who have ever owned, licensed, or been offered a license to any Patent-in-Suit, the identification of any license, settlement, or other agreements, including any draft agreements, relating to the ownership or licensing of any Patent-in-Suit, the dates of any ownership, licensing, or offers, and the amounts of any royalties or other payments exchanged, and identify each person with knowledge of the foregoing and all documents relating to the foregoing..

RESPONSE TO INTERROGATORY NO. 8:

Buergofol objects to answering ROG No. 8 to the extent that the interrogatory calls for identifying all draft arrangements that were part of the pre-litigation preparation

in anticipation of this legal action and to the extent that the draft arrangements were never finalized in a binding agreement. Such draft arrangements were part of the pre-litigation preparation and negotiations undertaken in anticipation of this legal action.

Subject to and without waiving the foregoing objections, Buergofol responds as follows:

On May 6, 2013, Franz Schleicher on behalf of Buergofol and Kurt Stark entered into a license agreement to various patents and patent applications in which Kurt Stark had an ownership interest and/or was an inventor or co-inventor. The scope, term and effectiveness of the license agreement has been in dispute and is the subject of ongoing litigation in Germany, for example in case no. 7O10640/21 before the 7th Civil Chambers of the Landgericht München I and case no. 6U2188/22 before the Civil Department of the Oberlandesgericht München. Whether the license agreement covers the '580 Patent, the '269 Patent and/or the '882 Patent is unclear and has not been finally decided. Whether the license agreement remains valid and in effect has also not been finally decided in the multiple lawsuits. As a license fee, Kurt Stark is to receive 9% of the net proceeds of film covered by any patent included in the license agreement. For calculating the license fee, it is assumed that Kurt Stark is the 100% owner of each patent; if his ownership share is less, then his right to remuneration is reduced in proportion to his actual ownership share. The license agreement provides that Buergofol is to receive all payments for patent infringement damages irrespective of who conducts the lawsuit for patent infringement. Kurt Stark is to be remunerated with 9% of any payment for patent infringement damages received by Buergofol.

The inventors of the '269 Patent and the '882 Patent have quasi-ownership/licensing interests in the '269 Patent and the '882 Patent by virtue of the German Arbeitnehmererfindungsgesetz (ArbnErfG; Employee Invention Law), which entitles each employee to a royalty payment on profits from the patented inventions. The determination of the royalty amount is complex and inversely related to the expectation

of innovation and invention for the employee's position. For example, the Head of Research and Development would receive a lower royalty rate than the cleaning lady for the same invention. For high-level employee positions, the royalty amount is typically a nominal amount. In addition, the royalty amount is reduced by the percentage contribution to the invention by the employee. The percentage contributions of the inventors of the '882 Patent are: Kurt Stark 40%, Gregor Schleicher 30%, Abdel Kader Boutrid 30%. An employee's right to royalty payments can be purchased by the employer. Buergofol believes that Henrik Hummel, the sole inventor of the '269 Patent, has no remaining rights in the patent by virtue of the German Employee Invention Law.

Buergofol acquired the ownership of the '269 Patent from Loparex Germany GmbH & Co., KG through an assignment document executed on August 10, 2022, which is recorded with the U.S. Patent and Trademark Office at reel/frame 060769/0531. The ownership rights in the '269 Patent were acquired in anticipation of this legal action, which was initiated five days following the execution of the assignment document. As part of the negotiations to acquire the '269 Patent, Buergofol and Loparex negotiated the terms of a license that Buergofol would grant back to Loparex. However, no license agreement was ever entered into by Buergofol and Loparex, and Loparex has no license to the '269 Patent.

INTERROGATORY NO. 9:

For each Claim-in-Suit, explain in detail each objective indicia of nonobviousness, if any, that Buergofol contends supports the validity of the claim, including, but not limited to, any alleged commercial success and nexus to the claimed subject matter, any alleged long-felt need in the art for the claimed subject matter, any alleged failure of others to solve the problems addressed by the claimed subject matter, any alleged skepticism or disbelief by any person relating to the claimed subject matter, any alleged positive recognition in the cured-in-place pipe (CIPP) liner industry for the claimed

subject matter, any alleged copying of the claimed subject matter, and any alleged unexpected results produced by the claimed subject matter, and identify each person with knowledge of the foregoing and all documents relating to the foregoing.

RESPONSE TO INTERROGATORY NO. 9:

Buergofol objects to ROG No. 9 as being unduly burdensome at this time because it seeks information that is not relevant to any party's current claims or defenses and is therefore not proportional to the needs of the case. ROG No. 9 seeks a detailed explanation of each objective indicia of nonobviousness "that Buergofol contends supports the validity of the claim [each Claim-in-Suit]" (emphasis added). Buergofol has made no contention that any claim of the Patents-in-Suit is valid because no argument of obviousness has yet been made. All of the claims of the Patent-in-Suit are presumed valid. 35 U.S.C. §282. Objective indicia of nonobviousness do not support a patentee's contention of validity, as ROG No. 9 incorrectly implies. Rather, objective indicia of nonobviousness are one of the four Graham factors that must be considered together with the other three Graham factors in an obviousness analysis. *See Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litig.*, 676 F.3d 1063, 1075 (Fed. Cir. 2012) Because Omega has not yet raised any invalidity defense based on obviousness and has not yet identified any prior art on which the future obviousness argument would be based, Buergofol cannot yet identify objective indicia of nonobviousness that would tend to show that the obviousness combination of the as-yet unknown prior art references was made with hindsight to recreate the recited invention of the particular claim. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007).

At this point in the litigation, developing arguments and evidence to show objective indicia of nonobviousness that can be applied to as-yet unknown obviousness combinations would be unduly burdensome because Buergofol would have to anticipate hypothetical invalidity arguments based on unknown obviousness combinations for all

claims of both Patents-in-Suit. The effort required to answer ROG No. 9 at this point in the litigation is not proportional to the needs of the case. The information requested by ROG No. 9 is not relevant to any current defense of invalidity due to an obviousness combination. ROG No. 9 is therefore premature. At the current time, Omega has not yet even answered Buergofol's complaint and has not pled invalidity as an affirmative defense based on any identified prior art. Hence, ROG No. 9 is overly burdensome, not relevant to Omega's defenses, and not proportional to the needs of the case.

Subject to and without waiving the foregoing objections, Buergofol answers as follows. Buergofol has not completed discovery and is still investigating the facts relating to secondary considerations, such as commercial success, long felt but unresolved need, failure of others, copying of the claimed subject matter, unexpected results, etc. Buergofol is aware that a German manufacturer of food packaging film, Südpack Verpackungen GmbH & Co. KG, has attempted to copy both the inner film and the outer film recited in the claims of the Patents-in-Suit. Buergofol believes that Südpack, or Südpack's subsidiary in Wisconsin Südpack Oak Creek Corporation, copied Buergofol's film and then sold the copied film to Omega. Buergofol believes that Omega and Omega's "new film supplier" are attempting to copy both the inner film and the outer film recited in the claims of the Patents-in-Suit so that Omega can use the copied film to copy the liner recited in the Patents-in-Suit. (See Dkt. 38, 9:19-20). Omega has admitted that all liner film currently being produced potentially falls within the scope of the Patents-in-Suit, including the film being developed by Omega's new film supplier. Omega has admitted that its new film supplier "had no experience in the UV CIPP industry" (Dkt. 38, 12:2). Omega admitted, "If Buergofol obtains and uses the highly confidential information of Omega's current film supplier to develop a patent strategy and Omega loses access to this supplier, Omega would be forced to either 'purchase all of its film from Buergofol,' purchase film from Sudpack which Buergofol claims infringes a German patent, or go out of business." (Dkt. 38, 9-12) Omega is attempting to copy

Buergofol's film and the liner recited in the Patents-in-Suit.

Buergofol is one of the major film suppliers, if not the main film supplier, for the UV CIPP liner industry. (See Dkt. 38, 2:16-17) Buergofol has achieved this commercial success by selling the UV CIPP film required to make the UV CIPP liner patented by the Patents-in-Suit. Omega has stated, "Omega is aware of only three film suppliers in the world that can supply the quality of film needed to manufacture Omega's liners: Buergofol, Sudpack and Omega's current undisclosed film supplier." (Dkt. 38, 11:17-19) Buergofol is clearly the market leader and has achieved commercial success selling the film needed to manufacture the UV CIPP liner patented by the Patents-in-Suit.

INTERROGATORY NO. 10:

For each shipment of film from Buergofol to Omega Liner Company, Inc., identify the product name or identifier, the description of the film, the type of film, the size of film (diameter if tubular film or width if flat film), the shipment date, the delivery number, the order number, the quantity of film shipped in meters, the thickness of the film, the number of layers in the film, the chemical composition of each layer of the film, the layer sequence of the film, the thickness of each layer, any migrating compound within an exterior layer of the film, and any coating on the film.

RESPONSE TO INTERROGATORY NO. 10:

Buergofol objects to ROG No. 10 as including multiple distinct, unrelated subparts:

- 1) product name or identifier;
- 2) description of the film;
- 3) type of film;
- 4) size of film;
- 5) shipment date;
- 6) delivery number;

- 7) order number;
- 8) quantity of film shipped;
- 9) thickness of film shipped;
- 10) number of layers in the film;
- 11) chemical composition of each layer of the film;
- 12) layer sequence of the film;
- 13) thickness of each layer;
- 14) migrating compound within an exterior layer of the film; and
- 15) coating on the film.

At a minimum, ROG No. 10 counts as at least 4 interrogatories if Omega's request to "limit the number of interrogatories to 30, including subparts" is adopted by the Court. (See Dkt. 40, 3:3-4) The chemical composition of an object is not logically related to the name of the object. Whether an object includes a migrating compound is not logically related to the size of the object. The thickness of each layer of an object is not logically related to a date on which the object was shipped. An order number is not logically related to how many layers an object has.

Buergofol's answer to ROG No. 10 includes responsive information provided in the table of Attachment A (which has also been produced as BF2840-BF2842) and in the table of Attachment B (which has also been produced as BF2843). Buergofol in general used only two product names to identify its inner film and outer film products. Ergo.Vac34A0004 is the name of Buergofol's inner film products. BFCR AF Orange 14000 is the name of Buergofol's outer film products. The naming convention was not, however, always followed or consistently used. Sometimes Ergo.Vac34B0004 or Ergo.Vac34C0004 were sometimes used to identify inner film. The indicated "ship date" entries in the tables of Attachment A and Attachment B refer to the dates products were supplied to Omega on an EXW basis. By the term EXW, Buergofol means that Omega provided Buergofol with information as to how to supply the product (for example,

Omega provided shipping containers to Buergofol that Buergofol then loaded with product) and Buergofol supplied the products to Omega in Germany, with possession and title to the goods transferring in Germany from Buergofol to Omega. The term “ship date” is therefore more properly referred to as “pickup date.” The entries in the “Pipe Dia. (inch)” column in the tables of Attachment A and Attachment B are taken from Omega documentation. As indicated in the table of Attachment A, an inner film indicated in the “Layers” column as “5c” has a 5-layer structure “PA/AP/PA/AP/PE”, where the leftmost “PA” refers to the outermost layer and where the rightmost “PE” refers to the innermost layer. As indicated in the table of Attachment A, an inner film indicated in the “Layers” column as “7a” has a 7-layer structure “PA/AP/PA/AP/PE/PE/PE”, where the leftmost “PA” refers to the outermost layer and where the rightmost “PE” refers to the innermost layer. As indicated in the table of Attachment A, an outer film indicated in the “Layers” column as “5c” has a 5-layer structure “PE/AP/PA/AP/PE.” To the best of Buergofol’s knowledge, documentary information is no longer remaining on the thicknesses of individual layers for any of the inner or outer films listed in the tables of Attachment A or Attachment B, but for one 7-layer inner film identified by Buergofol order number 11801841 and line number 3. A photograph (produced as BF2793) of a sample of that 7-layer inner film as delivered to Omega exists and the photograph indicates that the three outermost layers had approximate thicknesses of 36 microns, 15 microns, and 13 microns, respectively, with 36 microns being the thickness of the film’s outermost layer. The three innermost layers had a combined thickness of approximately 77 microns. The innermost layer of each inner film listed in the tables of Attachment A and Attachment B was a PE layer having a VICAT softening point of at least 100 degrees Celsius. The outermost layer of each inner film listed in the tables of Attachment A and Attachment B included an amount of EBS wax as a migrating compound, and an amount of that migrating compound migrated to and onto the external side of the layer so there existed a coating of EBS wax (ethylene bis

stearamide) on the outer side of the outermost layer. The “3b” and “3c” notations in the “Layers” column of the table of Attachment B indicate that the inner film had three constituent layers PA/AP/PE, where the outermost layer was a polyamide (PA) layer. The “5b” notation in the “Layers” column of the table of Attachment B indicates that the inner film had five constituent layers PA/AP/PE/AP/PE, where the outermost layer was a polyamide (PA) layer.

INTERROGATORY NO. 11:

For each shipment of film by Buergofol prior to June 15, 2009, regardless of its intended use, that had five layers or more with one external layer comprised of at least one thermoplastic olefin homo- or copolymer and another external layer comprised of at least one homo- and/or copolyamide, identify the product name or identifier, the Person to whom Buergofol shipped the film, the description of the film, the type of film, the size of film (diameter if tubular film or width if flat film), the shipment date, the delivery number, the order number, the quantity of film shipped in meters, the thickness of the film, the number of layers in the film, the chemical composition of each layer of the film, the layer sequence of the film, and the thickness of each layer.

RESPONSE TO INTERROGATORY NO. 11:

Buergofol objects to ROG No. 11 as including multiple distinct, unrelated subparts:

- 1) product name or identifier;
- 2) person to whom Buergofol shipped the film;
- 3) description of the film;
- 4) type of film;
- 5) size of film;
- 6) shipment date;
- 7) delivery number;

- 8) order number;
- 9) quantity of film shipped;
- 10) thickness of film shipped;
- 11) number of layers in the film;
- 12) chemical composition of each layer of the film;
- 13) layer sequence of the film; and
- 14) thickness of each layer.

At a minimum, ROG No. 11 counts as at least 4 interrogatories if Omega's request to "limit the number of interrogatories to 30, including subparts" is adopted by the Court. (See Dkt. 40, 3:3-4) The chemical composition of an object is not logically related to the name of the object. The person who shipped an object is not logically related to the size of the object. The thickness of each layer of an object is not logically related to a date in time. An order number is not logically related to whether an object has multiple layers, and if so, how many.

Buergofol objects to ROG No. 11 as not being proportional to the needs of the case because it seeks information that is not relevant to any of Omega's claims or defenses. The burden and harm to Buergofol of providing the requested information far outweighs Omega's need for this information. ROG No. 11 requests Buergofol to identify numerous trade secrets regarding each shipment of 5-layer and 7-layer film prior to June 15, 2009 for film in which one external layer is polyethylene (PE) and the other external layer is polyamide (PA). The shipments for which information is sought are not limited to shipments of film to manufacturers of UV CIPP liner, but include shipments to all of Buergofol's customers. Approximately 99 percent of Buergofol's business does not pertain to film for UV CIPP liners, but rather relates to other types of films for packaging of food, cosmetics, semiconductors and automotive applications. Only a very small amount of Buergofol's old documentation regarding the requested information that could possibly indicate the thickness of the film, the number of layers in the film, the

chemical composition of each layer of the film, the layer sequence of the film, or the thickness of each layer, pertains to UV CIPP films and is mixed in with the vastly larger amount of irrelevant documentation pertaining primarily to food packaging films. This old documentation is only on paper and is not organized by date but rather is arranged by Buergofol's production order number.

The requested identity of Buergofol's customers, the film type, size, thickness and quantity shipped, the shipment date, delivery number, order number, the number of film layers, the chemical composition of each layer and the layer sequence and thickness are all Buergofol's trade secrets. Especially for film not used by manufacturers of UV CIPP liner, Omega's lack of need for this information is not proportional to the great harm that the disclosure of these trade secrets would cause Buergofol. Moreover, the film size, thickness and quantity shipped and the thickness of each layer are not relevant to any defense of Omega, including the defense of invalidity.

In addition, even if a document were to be found in a needle-in-the-haystack type search of old paper documentation that identifies a shipment prior to June 15, 2009 of 5-layer or 7-layer film in which one external layer is PE and the other external layer is PA, it is unlikely that the document would be relevant to any as-yet unpled defense of invalidity because the document would not pertain to "prior art" for multiple reasons. First, UV CIPP **film**, even if it had been sold prior to June 15, 2009, would not establish prior-art on-sale activity because the claimed invention in both patents-in-suit is UV CIPP **liner** ("an insertion tube"). The sale of **film** does not constitute barring on-sale activity. Moreover, the sale of UV CIPP liner that included just Buergofol's inner film or outer film (assuming that film met the claim limitations) would also not constitute barring on-sale activity if the liner made with that film did not also include all of the other claim elements, such as the recited outer film or inner film. Second, even the sale of liner by a customer of Buergofol that happened to include all of the claim limitations would still not constitute barring on-sale activity if the sale of the liner did not take place in the United

States. Buergofol is a German company that produces film in Germany. The vast majority of Buergofol's customers are outside the United States, and ROG No. 11 requests disclosure of Buergofol's trade secrets regarding shipments to all customers.

So even if Buergofol were forced to identify its trade secrets regarding each shipment of 5-layer and 7-layer film prior to June 15, 2009 for film with external PE and PA layers, and even if one of such shipments pertained to UV CIPP film that was used in UV CIPP liner, it would nevertheless still be highly unlikely that the trade secrets relating to the shipment would evidence prior art to either patent-in-suit. In other words, in the language of Rule 26(b)(1), there would be no likely benefit to carrying out the onerous discovery, but the harm to Buergofol would be great and irreversible.

Subject to and without waiving the foregoing objections, Buergofol answers as follows. Buergofol has not completed discovery and its investigations are ongoing. After a reasonable investigation, no document or person has been identified that reveals the requested information about shipments prior to June 15, 2009 of 5-layer and 7-layer film with external PE and PA layers. No 14-year-old and older documents regarding the requested shipments could be located. Although Buergofol had equipment capable of producing 5-layer and 7-layer film prior to June 15, 2009, no reliable evidence (documentary or testimonial) as to the specifics called for in ROG No. 11 could be determined.

INTERROGATORY NO. 12:

For each shipment of film by Buergofol prior to March 11, 2012 that included a coating, identify the product name or identifier, the Person to whom Buergofol shipped the film, the description of the film, the "Type of Film" as indicated on the label attached to the film, whether the film was tubular or flat, the size of film (diameter if tubular film or width if flat film), the shipment date, the delivery number, the order number, the quantity of film shipped in meters, the thickness of the film, the number of layers in the

film, the chemical composition of each layer of the film, the layer sequence of the film, the thickness of each layer, whether the coating was incorporated into a layer or applied over part or all of the layer, and which layer the migrating compound was incorporated into or applied over.

RESPONSE TO INTERROGATORY NO. 12:

Buergofol objects to ROG No. 12 as including multiple distinct, unrelated subparts:

- 1) product name or identifier;
- 2) person to whom Buergofol shipped the film;
- 3) description of the film;
- 4) type of film;
- 5) whether the film was tubular or flat;
- 6) size of film;
- 7) shipment date;
- 8) delivery number;
- 9) order number;
- 10) quantity of film shipped;
- 11) thickness of film shipped;
- 12) number of layers in the film;
- 13) chemical composition of each layer of the film;
- 14) layer sequence of the film; and
- 15) thickness of each layer;
- 16) whether a coating was incorporated into a layer or applied the layer; and
- 17) into which layer the migrating compound was incorporated.

At a minimum, ROG No. 12 counts as at least 5 interrogatories if Omega's request to "limit the number of interrogatories to 30, including subparts" is adopted by the Court. (See Dkt. 40, 3:3-4) The sequence of layers of an object is not logically related to a date

on which the object was shipped. The chemical composition of an object is not logically related to the size of the object. Whether a coating is applied over a layer or incorporated into the layer is not logically related to the name of the object that includes the layer. The person who shipped an object is not logically related to the thickness of each layer of the object. An order number is not logically related to whether an object has multiple layers, and if so, how many.

Buergofol objects to ROG No. 12 as not being proportional to the needs of the case because it seeks information that is not relevant to any of Omega's claims or defenses. The burden and harm to Buergofol of providing the requested information far outweighs Omega's need for this information. ROG No. 12 requests Buergofol to identify numerous trade secrets regarding each shipment prior to March 11, 2012 of film that included a coating. The shipments for which information is sought are not limited to shipments of film to manufacturers of UV CIPP liner, but include shipments to all of Buergofol's customers. Approximately 99 percent of Buergofol's business does not pertain to film for UV CIPP liners, but rather relates to other types of films for packaging of food, cosmetics, semiconductors and automotive applications. Films for packaging can also contain migrating compounds that form a coating on external sides of the film. Only a very small amount of Buergofol's old documentation regarding the requested information that could possibly indicate the thickness of the film, the number of layers in the film, the chemical composition of each film layer, the layer sequence of the film, the thickness of each layer, whether a coating was in a layer or over the layer, and the layer into which a migrating compound was incorporated or applied over, pertains to UV CIPP films and is mixed in with the vastly larger amount of irrelevant documentation pertaining primarily to food packaging films. This old documentation is only on paper and is not organized by date but rather is arranged by Buergofol's production order number.

The requested identity of Buergofol's customers, the film type, size, thickness and quantity shipped, the shipment date, delivery number, order number, the number of film

layers, the chemical composition of each layer and the layer sequence and thickness are all Buergofol's trade secrets. Especially for film not used by manufacturers of UV CIPP liner, Omega's lack of need for this information is not proportional to the great harm that the disclosure of these trade secrets would cause Buergofol. Moreover, the film size, thickness and quantity shipped and the thickness of each layer are not relevant to any defense of Omega, including the defense of invalidity.

In addition, even if a document were to be found in a search of old paper documentation that identifies a shipment prior to March 11, 2012 of film that included a coating, it is unlikely that the document would be relevant to any as-yet unpled defense of invalidity because the document would not pertain to "prior art" for multiple reasons. First, UV CIPP **film**, even if it had been sold prior to March 11, 2012, would not establish prior-art on-sale activity because the claimed invention in both patents-in-suit is UV CIPP **liner** ("an insertion tube"). The sale of **film** does not constitute barring on-sale activity. Moreover, the sale of UV CIPP liner that included just Buergofol's inner film or outer film (assuming that film met the claim limitations) would also not constitute barring on-sale activity if the liner made with that film did not also include all of the other claim elements, such as the recited outer film or inner film. Second, even the sale of liner by a customer of Buergofol that happened to include all of the claim limitations would still not constitute barring on-sale activity if the sale of the liner did not take place in the United States. Buergofol is a German company that produces film in Germany. The vast majority of Buergofol's customers are outside the United States, and ROG No. 12 requests disclosure of Buergofol's trade secrets regarding shipments to all customers.

So even if Buergofol were forced to identify its trade secrets regarding each shipment prior to March 11, 2012 of film that included a coating, and even if one of such shipments pertained to UV CIPP film that was used in UV CIPP liner, it would nevertheless still be highly unlikely that the trade secrets relating to the shipment would evidence prior art to either patent-in-suit. In other words, in the language of Rule

26(b)(1), there would be no likely benefit to carrying out the onerous discovery, but the harm to Buergofol would be great and irreversible.

Subject to and without waiving the foregoing objections, Buergofol answers as follows. Buergofol declines to reveal its trade secrets relating to all film with a coating shipped prior to March 11, 2012 considering that (i) 99 percent of such film does not relate to UV CIPP liners and most of the film includes additives, such as migrating compounds that form coatings, (ii) none of the shipments evidence barring on-sale activity relating to the patents-in-suit, and (iii) use of the film by the vast majority of Buergofol's customers would also not constitute barring on-sale activity because those customers are not located in the United States. The harm to Buergofol of revealing its trade secrets by answering ROG No. 12 far outweighs any likely benefit to Omega of receiving the information.

INTERROGATORY NO. 13:

Describe in detail all facts and circumstances, and identify each document, relating to each communication between Buergofol and Omega prior to August 15, 2022 (including, without limitation, the communications referenced in Buergofol's Response to Interrogatory No. 3) relating in any way to either of the Patents-in-Suit or subject matter related to the Patents-in-Suit (such as UV CIPP liners or tubular film), identifying, without limitation, all participants of each communication, which party initiated such communication, the date of such communication, the method of communication (i.e., written (e.g., letter, email, text) or verbal (e.g., phone call, in person)), the content of such communication, and identify each person with knowledge of the communication..

RESPONSE TO INTERROGATORY NO. 13:

Buergofol objects to ROG No. 13 for being vague and failing clearly to describe what is meant by a "subject matter related to the Patents-in-Suit (such as UV CIPP liners or tubular film)." To the extent that Omega intended ROG No. 13 to describe each

communication between Buergofol and Omega relating in any way to the “subject matter related to UV CIPP liners,” Buergofol objects to the interrogatory as being unduly burdensome because it would require Buergofol to describe practically all communications between Buergofol and Omega prior to August 15, 2022. Buergofol interprets ROG No. 13 to request identification of each communication between Buergofol and Omega prior to August 15, 2022 relating in any way to either of the ‘269 Patent or the ‘882 Patent.

Subject to and without waiving the foregoing objections, Buergofol answers as follows. Buergofol has not completed discovery and is still investigating the facts relating to communications between Buergofol and Omega. This answer is based on current knowledge is subject to additional or different information that discovery may disclose, especially regarding verbal communications between Buergofol and Omega.

On March 21, 2018, Kurt Stark and Tobias Goth met with Jason Homrighaus, Dave McConnell and René Quitter during Stark’s and Goth’s visit to Omega’s facility in Canton. Stark informed Homrighaus and McConnell that Buergofol’s outer film, to which a reinforcing mesh of fleece is laminated, was being patented. Stark informed Homrighaus and McConnell that a liner made with the outer film laminated with fleece would be protected by a patent. At least Stark, Goth, Homrighaus and McConnell had knowledge of the communication.

On May 10, 2019, Kurt Stark sent an email addressed to David McConnell, copied to Tobias Goth, with an attached data sheet for Buergofol’s outer film. (See BF2404-BF2405) The parties to the email have knowledge of the communication. Stark informed McConnell that both the outer film and the liner that contains the outer film are patented. Thus, Stark stated to McConnell that the outer film and the liner were separately patented. Stark asked McConnell to be aware of possible patent violators who could offer outer film to Omega. Stark stated that Buergofol wants to destroy all patent violators.

On September 30, 2019, Kurt Stark sent an email addressed to Kenny Moulds

having the subject line: “phone call - important topic - Options for patent.” Attached to the email was U.S. Patent No. 8,361,580. (See BF2407-BF2419) The parties to the email have knowledge of the communication. The email states that Stark and Moulds had a phone conversation on the same day before the email was sent. The email states that in the phone call Stark explained the patent situation to Moulds and stated that René Quitter has nothing to do with the patent situation. In the email, Stark introduced the ‘580 Patent to Moulds and stated that Stark had presented the ‘580 Patent to Jason Homrighaus and Dave McConnell during Stark’s visit to Canton in March 2018. Stark informed Moulds that the ‘580 Patent is a liner patent and that Omega’s liner is completely within the ‘580 Patent. Stark warned Moulds that if a competitor (instead of Buergofol and Stark) were to acquire ownership to the ‘580 Patent, then Omega could be prohibited from producing and selling Omega’s liner regardless of whether Buergofol was still delivering films to Omega. Thus, Stark informed Moulds that purchasing outer and inner films from Buergofol did not confer on Omega the right to make liner and that a license to a separate patent would be required to make liner.

On May 15, 2020, Kurt Stark sent an email addressed to Grant Marquardt and also sent to Tobias Goth and Kenny Moulds having the subject line: “Re-4: General Offer different films Re-3: Topics to discuss with a phone call - new offers from Buergofol.” (See BF2482) The parties to the email have knowledge of the communication. Stark informed Marquardt that the outer film and the liner containing the outer film were separately patented. Stark stated that the outer film used by Omega is patented, and also all the liners containing this film are patented too. Stark told Marquardt, “This is just for your information. Kenny already knows this.”

On August 10, 2021, Franz Schleicher sent an email addressed to Grant Marquardt and Kenny Moulds, copied to Tobias Goth, Gregor Schleicher and Petra Blien, having the subject line: “Buergofol - Omega Liner purchase of patent of yellow film Loparex.” (See BF2713) The parties to the email have knowledge of the communication.

Schleicher informed Marquardt that Buergofol could grant Omega a license to produce liner depending on if Omega sourced its inner as well as outer film from Buergofol, Schleicher stated, “We are in the position to grant a licence to produce and sell your liner depending of the supply of inner as well outer film from Buergofol.”

On August 11, 2021, Franz Schleicher sent an email to Grant Marquardt having the subject line: “Buergofol - Omega Liner purchase of patent of yellow film Loparex.” (See BF2717) The parties to the email have knowledge of the communication.

Schleicher informed Marquardt that without a license from Buergofol, Omega would have to stop selling liner, as it would be patent infringement. Schleicher explained that using a competitor’s outer film in liner would be patent infringement without a license, while using inner film from a competitor would also constitute patent infringement without a separate license. Schleicher also stated, “A couple of years ago we informed and handed over you a copy of the patent but you didn’t took care.”

On August 17, 2021, Franz Schleicher sent an email addressed to Gary Strom, Kenny Moulds and Grant Marquardt, copied to Darien Wallace and Gregor Schleicher having the subject line: “Omega Liner patent case Buergofol.” (See BF2725-BF2726) The parties to the email have knowledge of the communication. Schleicher informed Strom, Moulds and Marquardt that Omega needed a license from Buergofol to sell Omega’s liner. Schleicher stated, “Even we disclosed the situation a coupled of years ago, you didn’t take care.” Schleicher stated that he attached a letter from Wallace that proposed a license. The letter from Wallace was addressed to Strom and was also dated August 17, 2021. The Wallace letter stated that Omega’s liner falls with the scope of the claims of U.S. Patent No. 8,361,580 and proposed granting a license to the ‘580 Patent to Omega in exchange for Omega purchasing both inner and outer film for all of its liners from Buergofol.

On August 26, 2021, Michael Neustel sent an email addressed to Darien Wallace, copied to kmason@vogellaw.com having the subject line: “Buergofol and Omega Liner

Matter - U.S. Patent No. 8,361,580.” (See BF2729-BF2730) The email included an attached letter from Neustel to Wallace also dated August 26, 2021 with the subject line: “Buergofol GmbH and Omega Liner Co., Inc. - U.S. Patent No. 8,361,580.” The Neustel letter referred to the infringement alleged in the Wallace letter dated August 17, 2021 and stated that the Wallace letter did not include a claim chart “as required under U.S. Patent Law.”

On August 29, 2021, Franz Schleicher sent an email addressed to Gary Strom, copied to Kenny Moulds, Grant Marquardt and Gregor Schleicher having the subject line: “purchasing film from Buergofol for Omega's liner.” Attached to the email were copies of U.S. patent documents 8,361,580, 2019/0293224 (11,105,455) and 9,657,882 (See BF2734-BF2777) The parties to the email have knowledge of the communication. Schleicher referred to his email to Strom, Moulds and Marquardt of August 17 regarding Omega obtaining a license from Buergofol. Schleicher explained why Omega's liner is covered by the claims of the three patent documents. Schleicher wrote, “Finally, I would also be willing to give Omega a license to the attached US9,657,882, which covers a liner that includes an inner film with a polysiloxane or migrating compound coating. Again, Suedpack copied Buergofol's inner film and now sells it to you, and Buergofol's inner film includes the claimed coating.”

Dated this 31st day of March, 2023 at Munich,

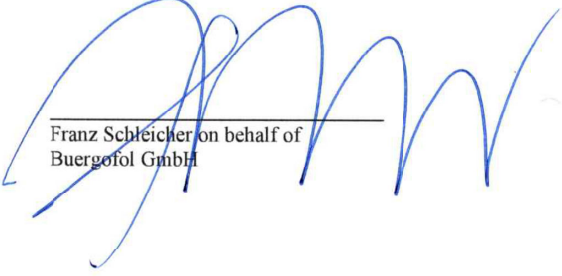
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VERIFICATION

I, Franz Schleicher, have the title of Alleinprokurist (sole officer with general commercial power of representation) of Buergofol GmbH. I declare under penalty of perjury that the facts stated in the foregoing Buergofol's Responses to Omega's Interrogatories to Buergofol (Set Two) (Nos. 6-13) are true and correct to the best of my knowledge, information, and belief.



Franz Schleicher on behalf of
Buergofol GmbH

CERTIFICATE OF SERVICE

The undersigned certifies that, on the date indicated above, a true and correct copy of the foregoing document was served electronically using the CM/ECF system or email:

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- Michelle G. Breit (michelle@neustel.com), *Attorney for Defendant*
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