

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PROAMPAC HOLDINGS INC.,

Petitioner

v.

SIGMA TECHNOLOGIES INTERNATIONAL, LLC,

Patent Owner

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Case IPR2025-01143  
U.S. Patent No. 11,072,148

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**PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL**

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| 2001               | ProAmpac's <i>First Amended Answer and Counterclaims</i> from Parallel Litigation                                                         |
| 2002               | Declaration of Steven Yializis                                                                                                            |
| 2003               | Docket Entries from Parallel Litigation (As Of Aug. 27, 2025)                                                                             |
| 2004               | Oral Order Entered 08/14/25 in Parallel Litigation Denying (Without Prejudice) ProAmpac's Motion to Stay Pending IPR                      |
| 2005               | Parallel Litigation <i>Scheduling Order</i> entered 03/14/25                                                                              |
| 2006               | Parallel Litigation <i>Joint Stipulation and [Proposed] Order Substituting Parties and Changing Case Caption</i> (filed 06/25/25)         |
| 2007               | <i>Defendant/Counterclaim Plaintiff ProAmpac Holdings Inc.'s Initial Invalidity Contentions</i> (served 08/27/25)                         |
| 2008               | Dennis Crouch, <i>Estoppel Gutted: A Pelican's Guide to Patent Litigation</i> , PatentlyO.com (May 7, 2025).                              |
| 2009               | Andrew Zappia, Bryan Smith, and Nicolas Gallo, <i>How IPR Estoppel Ruling May Clash with PTAB Landscape</i> , Law360.com (Jun. 17, 2025). |

Patent Owner's Request for Discretionary Denial  
U.S. Patent No. 11,072,148

| Exhibit No. | DESCRIPTION                                                                                                                                                                                                                                                                                                                                                                                                                                                                              |
|-------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 2010        | <p>Scott R. Boalick, Chief Administrative Patent Judge, <i>Guidance on USPTO's Recission of 'Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,'</i> (Mar. 24, 2025),<br/> <a href="https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf">https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf</a></p> |
| 2011        | <p>Coke Morgan Stewart, USPTO Acting Director, <i>Interim Processes for PTAB Workload Management</i> (Mar. 26, 2025),<br/> <a href="https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf">https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf</a>.</p>                                                                                                                                      |
| 2012        | <p><i>Apple, Inc. v. Fintiv, Inc.</i>, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential).</p>                                                                                                                                                                                                                                                                                                                                                                                  |
| 2013        | <p><i>Dabico Airport Sol'ns Inc. v. AXA Power APS</i>, IPR2025-00408, Paper 21, 2025 Pat. App. LEXIS 3168 (P.T.A.B. Jun. 18, 2025) (nonprecedential).</p>                                                                                                                                                                                                                                                                                                                                |
| 2014        | <p><i>Ecto World, LLC v. RAI Strategic Holdings, Inc.</i>, IPR2024-01280, Paper 13 (P.T.A.B. May 19, 2025) (precedential).</p>                                                                                                                                                                                                                                                                                                                                                           |
| 2015        | <p><i>Hospira, Inc. v. Genentech, Inc.</i>, IPR2017-00739, Paper 16 (PTAB Jul. 27, 2017) (informative),</p>                                                                                                                                                                                                                                                                                                                                                                              |

Patent Owner's Request for Discretionary Denial  
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| Exhibit No. | DESCRIPTION                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                          |
|-------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 2016        | <i>Motorola Sol'ns, Inc. v. Stellar, LLC</i> , IPR2024-01205, Paper 19 (Stewart Mar. 28, 2025).                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                      |
| 2017        | <i>Samsung Elecs. Co. v. GhengisComm Holdings, LLC</i> , IPR2025-00788, Paper 11 (P.T.A.B. Aug. 25, 2025).                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                           |
| 2018        | <i>Sotera Wireless, Inc. v. Masimo Corp.</i> , IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A)                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                               |
| 2019        | Coke Morgan Stewart, USPTO Acting Director, <i>Enforcement and Non-Waiver of 37 C.F.R. § 42.104(b)(4) and Permissible Uses of General Knowledge in Inter Partes Reviews</i> (Jul. 31, 2025), <a href="https://www.uspto.gov/sites/default/files/documents/aapa_memo_final_signed.pdf?utm_campaign=subscriptioncenter&amp;utm_content=&amp;utm_medium=email&amp;utm_name=&amp;utm_source=govdelivery&amp;utm_term=">https://www.uspto.gov/sites/default/files/documents/aapa_memo_final_signed.pdf?utm_campaign=subscriptioncenter&amp;utm_content=&amp;utm_medium=email&amp;utm_name=&amp;utm_source=govdelivery&amp;utm_term=</a> . |

## I. INTRODUCTION

Sigma Technologies International, LLC (“Sigma”) respectfully requests that the Acting Director exercise her discretion under 35 U.S.C. § 314(a) and/or § 325(d) and deny institution of *inter partes* review (“IPR”) for U.S. Patent No. 11,072,148 (“the ‘148 Patent”).

The *Fintiv* factors weigh heavily against proceeding with the IPR. The related Parallel Litigation (“the Litigation”)<sup>1</sup> has advanced into discovery and exchanges of infringement and invalidity contentions. The District Court has set a firm trial date of January 4, 2027, just days after the Board’s Final Written Decision, due January 2, 2027. As such, the District Court is in the process of resolving all issues that are raised in the IPR, as well as addressing numerous other issues not raised in the IPR including antitrust and inequitable conduct. The existence of the antitrust claims presents the Acting Director with a unique scenario. There simply is no efficiency benefit for the Board to invest its scarce resources into the review of the ‘148 Patent in the context of this unique scenario, and Petitioner has offered none.

Denial is also appropriate because Sigma has settled expectations based on commercial activity going back over six years; the prior art raised in the Petition is

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<sup>1</sup> *Pratt Retail Specialties, LLC v. ProAmpac Holdings Inc.*, C.A. No. 1:24-cv-1073-RGA (D. Del.).

cumulative of that raised during prosecution of the '148 Patent; and Petitioner inappropriately relies on expert testimony to fill the gaping holes in the prior art.

Finally, Petitioner's *Sotera* stipulation is illusory as both overly narrow under a recent Federal Circuit decision, and because Petitioner already violated its stipulation by raising new issues in its District Court invalidity contentions – issues not raised in the Petition.

## II. FACTUAL BACKGROUND

On January 1, 2019, Sigma filed the application that became the '148 Patent, which was published on July 11, 2019 as US 2019/0210321 A1. (Ex. 1002). Following publication, Sigma and Pratt executed an Exclusive Supply Agreement on December 8, 2020 (**Ex. 2002**), reflecting a mutual intent to commercialize the technology. The '148 Patent issued on July 27, 2021. In March 2023, Sigma granted Pratt an exclusive license to the '148 Patent, including the right to enforce it against infringers. (Ex. 1009, ¶ 7). Both Sigma and Pratt have made substantial investments to commercialize products practicing the patented technology. (Ex. 2002 at ¶¶ 7 & 8).

On September 25, 2024, Pratt (as exclusive licensee) filed suit against ProAmpac in the District of Delaware for infringement of the '148 Patent. (Ex. 1009). The case has proceeded into multiple rounds of discovery; and the parties have exchanged infringement and invalidity contentions. The District Court has set

a firm trial date of January 4, 2027, just two days after the statutory date for the Final Written Decision, should the IPR proceed which it should not. A copy of the case schedule is attached as **Ex. 2005**.

### **III. THE *FINTIV* FACTORS FAVOR DISCRETIONARY DENIAL**

“Institution of an inter partes review is discretionary.” *Hospira, Inc. v. Genentech, Inc.*, IPR2017-00739, Paper 16 at 17 (PTAB Jul. 27, 2017) (informative) (**Ex. 2015**). “[T]he . . . *Fintiv* factors . . . are used to assess whether instituting Patent Office review would be an inefficient use of resources given parallel district court proceedings.” *Intel Corp. v. VLSI Tech. LLC*, No. 2021-1614 *et al.*, 2021 U.S. App. LEXIS 37737, at \*4 (Fed. Cir. May 5, 2021) (nonprecedential).

#### **A. *Fintiv* Factor #1: The District of Delaware Already Denied ProAmpac’s Motion to Stay Without Prejudice**

On July 7, 2025, ProAmpac unsuccessfully moved to stay the Litigation pending resolution of any IPR (**Ex. 2003**, Docket Entries, at D.I. 46), so this factor favors discretionary denial. While the motion was denied without prejudice to the stay request being raised again upon institution (**Ex. 2004**, Oral Order), a post-institution stay is not guaranteed, so the weight given to the willingness by the Court to reconsider is diminished in view of the proximity to trial. *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 7 (PTAB Mar. 20, 2020) (precedential) (**Ex. 2012**)

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**B. Fintiv Factor #2: The Close Proximity of the District Court's Trial Date to the Board's Deadline for a Final Written Decision**

If the Board institutes review, the projected statutory deadline for a Final Written Decision ("FWD") would be **January 2, 2027**—just **two days before** the district court trial begins on **January 4, 2027**. *See Ex. 2005, Scheduling Order* at ¶ 15.

Pursuant to the *Notice of Filing Date Accorded to Petition* dated July 2, 2025 (Paper 4), Sigma's Preliminary Response will be due on October 2, 2025. The Director then has three months, until January 2, 2026, to decide whether to institute. 35 U.S.C. § 314(b). If instituted, a FWD would be due one year from that date, i.e., on January 2, 2027. 35 U.S.C. § 316(a)(11).

"If the court's trial date is at or around the same time as the projected statutory deadline, the decision whether to institute will likely implicate other factors discussed herein, such as the resources that have been invested in the parallel proceeding." *Fintiv*, Paper 11 at 9. Consequently, *Fintiv* Factor #2 is neutral, and the Director looks to other *Fintiv* factors to determine whether to exercise its discretion to deny IPR institution. Here, the duplicative effort and investment by the parties is a near-certainty (see *Fintiv* Factor #3, below). This extreme temporal proximity underscores that institution would provide no efficiency benefit and risks duplicative proceedings, inconsistent outcomes, and unnecessary expenditure of Office

resources.

C. **Fintiv Factor #3: Significant Investment by the District Court and the Parties for the Litigation**

Despite the projected FWD date being two days before trial is to begin in the Litigation, the bulk of the pre-trial investment and work will be completed well in advance of the January 2, 2027 FWD deadline. This includes claim construction and resolution of dispositive motions. “[I]f, at the time of the institution decision, the district court has issued substantive orders related to the patent at issue in the petition, this fact favors denial. Likewise, district court claim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.” *Fintiv*, Paper 11 at 9-10.

The Litigation has scheduled several of these explicitly referenced proceedings and decisions to take place a full six to twelve months before the Board's FWD deadline. Specifically, discovery is scheduled to be completed by February 27, 2026, *See* Ex. 2005, *Scheduling Order* at ¶ 3.a. Additionally, a claim construction hearing is scheduled for January 8, 2026 (*Id.* at ¶ 8); and dispositive and *Daubert* motions are due on September 11, 2026 (*Id.* at ¶¶ 9.b. & 10).

Investment by the parties in the Litigation is not speculative or limited to future proceedings but has been accumulating since the initiation of the case on September 25, 2024= (Ex. 2003 at D.I. 1), which spawned rounds of responsive

pleadings (*Id.* at D.I. 16, 25, 52, & 59). The parties also already propounded and responded to substantial written discovery in the Litigation including: initial disclosures by Pratt and ProAmpac (*Id.* at D.I. 26, 27, 38, & 39) ; Pratt's first set of requests for production to ProAmpac (*Id.* at D.I. 28); Pratt's Identification of Accused Products and Asserted Patents (*Id.* at D.I. 29); ProAmpac's objections and responses to Pratt's RPDs and first requests for production to Pratt (*Id.* at D.I. 36); core technical documents and sales figures for the accused products produced by ProAmpac (*Id.* at D.I. 41); first set of interrogatories and requests for production to Pratt by ProAmpac (*Id.* at D.I. 48); Pratt's Initial and Amended Disclosure of Asserted Claims and Infringement Contentions (*Id.* at D.I. 53 & 60); Pratt's first interrogatories and second request for production to ProAmpac (*Id.* at D.I. 56); Pratt's responses to ProAmpac's first set of interrogatories and RPDs (*Id.* at D.I. 61); ProAmpac's second set of interrogatories to Pratt (*Id.* at D.I. 63); ProAmpac's third set of interrogatories and second set of RPDs to Pratt (*Id.* at D.I. 64); ProAmpac's objections and responses to Pratt's first set of interrogatories and second RPD's (*Id.*); and ProAmpac's Invalidity Contentions (Ex. 2007). Additionally, the parties made substantive investments in the Litigation concerning briefing on ProAmpac's stay motion (Ex. 2003 at D.I. 46, 47, 55, & 57), now denied (Ex. 2004, *supra*).

“This investment factor is related to the trial date factor, in that more work completed by the parties and court in the parallel proceeding tends to support the

arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs.” *Fintiv*, Paper 11 at 10. Therefore, the work required in support of the Defendant’s IPR petition would be duplicative of the meaningful investments made in the pre-trial phase of the Litigation, and favor denial of institution.

**D. Fintiv Factor #4: Overlap Between Issues Raised in the Petition and in the Parallel Proceeding**

**1. The Litigation Will Resolve All Issues Raised in ProAmpac’s Petition—and More**

The Litigation encompasses all of the invalidity issues raised in ProAmpac’s petition and numerous additional claims that are beyond the PTAB’s jurisdiction. “[I]f the issues are the same as, or substantially similar to, those already or about to be litigated, or other circumstances weigh against redoing the work of another tribunal, the Board may, nonetheless, exercise the authority to deny institution.” *Fintiv*, Paper 11 at 14.

ProAmpac’s IPR petition confines the present issues to whether the ’148 Patent is invalid under 35 U.S.C. §§ 102 (“anticipated”) and 103 (“obvious”). *See* Paper 1 at 17 (listing six grounds). Those issues are fully subsumed in the Litigation—but they are just the starting point. In addition to §§ 102 and 103 invalidity theories, ProAmpac asserts invalidity theories under § 112 (Ex. 2001 at ¶¶ 2 & 19), as well as 11 affirmative defenses and Sherman Act (antitrust)

counterclaims alleging Pratt's enforcement of the '148 Patent constitutes an attempt to monopolize the market. (Ex. 2001 ¶ 72). These antitrust and inequitable conduct claims are wholly outside the PTAB's authority and will require full adjudication in district court regardless of whether the PTAB institutes review. This, to Sigma's knowledge, is a unique scenario. Thus, instituting the IPR would not simplify the dispute and would instead force the parties and tribunals to litigate in two forums simultaneously over overlapping facts, witnesses, and evidence. Because the Delaware litigation is broader, more advanced, and will necessarily proceed, this factor heavily favors discretionary denial.

## **2. ProAmpac's *Sotera* Stipulation Is Illusory**

ProAmpac's *Sotera* Stipulation states:

If the Board institutes *inter partes* review in this proceeding, IPR2025-01143, Petitioner will not pursue in the related litigation, *Pratt Retail Specialties, LLC v. ProAmpac Holdings Inc.*, No. 1:24-cv-01073-RGA (D. Del.), the specific grounds of invalidity raised in the Petition or any grounds of invalidity that reasonably could have been raised in an *inter partes* review against U.S. Patent No. 11,072,148 under 35 U.S.C. §§102 or 103 ***on the basis of prior art patents or printed publications.***

(Paper 6 at 2) (emphasis added) (citing *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 13-14 (PTAB Dec. 1, 2020) (precedential as to § II.A) (Ex. 2018)). While a *Sotera* stipulation is deemed “highly relevant” to a *Fintiv*

analysis, the stipulation “will not be dispositive by itself.” (**Ex. 2010**) (Boalick Recission Memo). Indeed, here the stipulation should be discounted because it is illusory—both overly narrow and already violated.

In view of a Federal Circuit decision that issued on May 7, ProAmpac's *Sotera* stipulation no longer has sufficient breadth to be accorded meaningful weight. Specifically, the Federal Circuit declared: “IPR estoppel does not preclude a petitioner from relying on the same patents and printed publications as evidence in asserting a ground that could not be raised during the IPR, such as that the claimed invention was known or used by others, on sale, or in public use.” *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1367 (Fed. Cir. 2025). “[A] printed publication from an IPR can be later used in the litigation as part of the same combination of references used in the IPR, so long as the publications are categorized by the patent challenger in the litigation as proving that the invention was known/used/on-sale.” *See* Dennis Crouch article (**Ex. 2008**). “[P]etitioners might . . . consider providing a stipulation that effectively forecloses any challenges in the co-pending district court that rely on the particular prior art references raised in the IPR petition, in order to reduce the risk of discretionary denial.” *See* Zappia et al. article (**Ex. 2009**).

Furthermore, ProAmpac violated its own *Sotera* stipulation. After filing its stipulation in this proceeding, but without submitting the same stipulation to the District Court, ProAmpac recently served invalidity contentions asserting prior art

never raised in its Petition. (**Ex. 2007**, ProAmpac's Initial Invalidity Contentions). This contradiction demonstrates that ProAmpac intends to litigate validity on two parallel tracks with parallel collections of prior art, defeating the very efficiency gains *Sotera* stipulations are meant to achieve. In this case, ProAmpac's conduct demonstrates that instituting this IPR would not simplify the dispute—it would merely duplicate proceedings and waste PTAB resources. *See Motorola Sol'ns, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3–4 (Stewart Mar. 28, 2025) (**Ex. 2016**) (stipulation did not ensure IPR proceedings would be “true alternative” to parallel proceeding).

**E. Fintiv Factor #5: Petitioner and the Defendant in the Litigation are the Same Party**

“If a petitioner is unrelated to a defendant in an earlier court proceeding, the Board has weighed this fact against exercising discretion to deny institution under *NHK*.” *Fintiv*, Paper 11 at 13-14 (footnote omitted). Here, the opposite is true: Petitioner ProAmpac is now the named Defendant in the Litigation. *See Exhibit 2006*, Joint Stipulation; *see also* Ex. 2003 at D.I. 45 (order granting same). Therefore, *Fintiv* Factor #5 weighs against IPR institution.

**F. Fintiv Factor #6: Several Sub-Factors Weigh in Favor of Refusing to Institute an IPR**<sup>2</sup>

“[A]s stated in *Fintiv*, the factors considered in the exercise of discretion are part of a balanced assessment of all the relevant circumstances in the case, including settled expectations and the strength of the merits. Settled expectations are present because of the six-year period of investment into the commercialization of the claimed inventions. Additionally, the prior art presented is cumulative, and Petitioner improperly attempts to fill the gaps in the prior art with expert testimony.

**1. The “Settled Expectations” Factor Goes Beyond Mere Age of the Patent and Brings to Bear Additional Facts, such as Patent Owner’s Six Year Investment into the Technology**

A petitioner’s awareness of the challenged patent prior to filing its petition remains relevant when assessing the “settled expectations” factor. *See iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, -74, -76, -77, & -78, Paper 10 at 3, 2025 Pat. App. LEXIS 3094, at \*2-\*3 (PTAB Jun. 6, 2025) (nonprecedential)

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<sup>2</sup> (a) “[t]he strength of the unpatentability challenge”; and (b) “[s]ettled expectations of the parties, such as the length of time the claims have been in force” (“Interim Processes for PTAB Workload Management” (Mar. 26, 2025) at 2 (**Exhibit 2011**); and (c) whether the petitioner has “provide[d] any persuasive reasoning why an inter partes review is an appropriate use of Office resources.” *Dabico Airport Sol’ns Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 at 3, 2025 Pat. App. LEXIS 3168, at \*2 (P.T.A.B. Jun. 18, 2025) (nonprecedential) (**Ex. 2013**).

(patent owner's "persuasive" argument asserted that petitioner knew of patent as early as 2013, when it cited "the then-pending application" in its own IDS). Further, settled expectations may arise during a period as short as three years – shorter than the facts here. *Samsung Elecs. Co. v. GhengisComm Holdings, LLC*, IPR2025-00788, Paper 11 at 2 (P.T.A.B. Aug. 25, 2025) (**Ex. 2017**).

Moreover, patent applications (after 18 months) and issued patents are almost always publicly available to provide notice to the public, other inventors, competitors, and commercial interests. 35 U.S.C. § 122. . . . As such, actual notice of a patent or of possible infringement is not necessary to create settled expectations.

*Dabico*, Paper 21 at 3, 2025 Pat. App. LEXIS 3168, at \*3. Sigma and Pratt first executed an Exclusive Supply Agreement on December 8, 2020 (Ex. 2002) following the publication of the patent application indicating a longstanding intent to commercialize the current products, enhancing their settled expectations.

Additionally, patent life length "alone does not tip the balance against discretionary denial." *GhengisComm*, Paper 11 at 2 (granting discretionary denial request challenging a three-year-old patent). The '148 Patent is presently over four years old. Not until June 11, 2025, after Pratt sued for infringement, did ProAmpac petition this Board to invalidate the patent.. This four-year delay in conjunction with ProAmpac's two-supplier market allegation strengthens Sigma's "settled expectations," which favors denial of institution.

## **2. Petitioner's References are Cumulative of Art Already Considered**

The Petition brings nothing new. During prosecution, the Examiner thoroughly evaluated metallized films, low-emissivity packaging, cellulose-based structures, and repulpability standards (Tilton, Shimizu, Wadsworth, Gregory).<sup>3</sup> The claims were allowed precisely because none of that art taught maintaining emissivity  $\leq 0.10$ , achieving optical density  $< 0.09$ , or preserving emissivity through intended use while permitting oxidation through repulping.

Every asserted reference merely rehashes what the Office already weighed. The *Voluntary Standard* (Ex. 1007) was incorporated by reference and relied upon during prosecution; its reuse here is inherently cumulative. Gundlach (Ex. 1005) duplicates Tilton/Shimizu's teachings on low-e metallized films and radiant-barrier behavior but fails to fill the Examiner-identified gaps. Yializis (Ex. 1006) discusses thin metallized films already contemplated in the '148 specification and reviewed by the Examiner, yet provides no teaching of the critical emissivity and optical

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<sup>3</sup> “[T]his court presumes that the Patent Office complies with its own rules, a presumption overcome only upon presentation of contrary evidence.” *Genzyme Corp. v. Transkaryotic Therapies, Inc.*, 346 F.3d 1094, 1103 n.3 (Fed. Cir. 2003). Specifically: (1) M.P.E.P. § 2103(I)(C.) (“Examiners should then correlate each claim limitation to all portions of the disclosure that describe the claim limitation.”); and (2) M.P.E.P. § 2129 (“[T]he examiner must determine whether the subject matter identified as ‘prior art’ is the inventor’s own work, or the work of another.”).

density thresholds or preserving emissivity through intended use while permitting oxidation through repulping. Rebouillat (Ex. 1008) addresses condensation control in pallet wraps; at best, its general barrier teachings are background and cumulative of closer art. Because these references neither introduce new teachings nor identify any material examiner error, the Petition recycles the same art and arguments already considered, and discretionary denial under 35 U.S.C. § 325(d)<sup>4</sup> is warranted.

### **3. Improper Use of Expert Testimony**

Petitioner's case hinges almost entirely on a 117-page declaration from its expert, Glenn May, who is used to "fill gaps" that the cited references simply do not disclose. For example—among many instances throughout the Petition—ProAmpac relies on Mr. May's opinions about what was "commonly known" to replace Gundlach's missing repulping process (Petition at p.28; EX1003, ¶ 95); invokes his opinion on "full oxidation" since this concept was not taught by Gundlach (Petition at p. 29; EX1003, ¶¶ 97-98); and substitutes Mr. May's interpretation of industry practice for explicit disclosures on maintaining emissivity and preventing oxidation (Petition at p. 32-33; ¶¶ 103, 105-106). These examples are illustrative only; similar flaws appear throughout Mr. May's declaration and the Petition.

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<sup>4</sup> ProAmpac has not complied with Step 2 of the § 325(d) analysis, nowhere asserting Examiner error. *See Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 5-6 (P.T.A.B. May 19, 2025) (precedential) (**Ex. 2014**).

This approach is improper. The July 31, 2025, USPTO Enforcement Memorandum<sup>5</sup> reaffirms the requirement of 37 C.F.R. § 42.104(b)(4) (Rule 104(b)(4)) that an IPR petition must identify where each challenged claim limitation is expressly found in patents or printed publications and forbids supplying missing elements through “general knowledge” or expert testimony.<sup>6</sup> Here, ProAmpac outsources much of its invalidity theory to Mr. May instead of pointing to where the prior art teaches the disputed limitations.

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<sup>5</sup> Coke Morgan Stewart, USPTO Acting Director, *Enforcement and Non-Waiver of 37 C.F.R. § 42.104(b)(4) and Permissible Uses of General Knowledge in Inter Partes Reviews* (Jul. 31, 2025) (**Ex. 2019**) (“Enforcement Memorandum”).

<sup>6</sup> Although the Enforcement Memorandum technically applies only to petitions filed on or after September 1, 2025, it reflects the USPTO’s longstanding rule in 37 C.F.R. § 42.104(b)(4) that petitioners must identify where each challenged claim element is expressly disclosed in patents or printed publications. That rule has never changed—only its enforcement posture has. The Director’s renewed commitment to enforce this requirement underscores its relevance here: ProAmpac’s petition fails for precisely the reason the rule exists, i.e., it relies on expert opinion and “general knowledge” instead of pointing to actual disclosures. Even if not formally effective, the Enforcement Memorandum clarifies the Office’s consistent policy and should inform the Board’s discretionary assessment in this proceeding.

**4. Petitioner's Failure to Justify Use of PTAB Resources**

ProAmpac offers no explanation why institution here would be an appropriate or efficient use of the Board's constrained resources, or how conflicting decisions with the Litigation would be avoided where the same parties have already committed substantial resources toward resolving a broader array of issues in parallel litigation, subsuming those presented in ProAmpac's IPR petition. Where, as here, "petitioner failed to present persuasive reasons why the Office should review the challenged patent, ... the Office is disinclined to disturb the settled expectations of Patent Owner." *See Dabico*, Paper 21 at 3, 2025 Pat. App. LEXIS 316, at \*2-\*3. Petitioner's silence on this point is telling: where efficiency gains are nonexistent and the Litigation already subsumes all issues, the Board's institutional policy weighs heavily in favor of discretionary denial.

#### IV. CONCLUSION

For the foregoing reasons, Sigma requests that the Acting Director, in her discretion, deny the *Petition for Inter Partes Review* filed by Petitioner.

This 2<sup>nd</sup> day of September, 2025.

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. §§ 42.6(e), the undersigned certifies that the foregoing Patent Owner's Request for Discretionary Denial and supporting materials are being served on counsel of record by filing the document through the Patent Trial and Appeal Case Tracking System (P-TACTS), with a copy served via electronic mail to the following email address,  
  
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