

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUHTAMAKI FLEXIBLE PACKAGING GERMANY GMBH & CO. KG,
Petitioner,

v.

ADAPA FLEXIBLES DENMARK SLAGELSE A/S,
f/k/a DANAPAK FLEXIBLES A/S
Patent Owner

Case PGR2023-00008
Patent 11,260,624

**PETITIONER’S MOTION TO EXCLUDE PATENT OWNER’S EVIDENCE
PURSUANT TO 37 C.F.R. § 42.64(c)**

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

I. Introduction

On January 16, 2024, Patent Owner, Adapa Flexibles (“Patent Owner”) submitted its Revised Motion to Amend (“RMTA”) (Paper 31), and on March 5, 2024, Petitioner Huhtamaki (“Petitioner”) submitted its Opposition to the RMTA (Paper 36) alleging that all claims at issue are unpatentable as obvious in view of Riis (EX1004), Wypych (EX1005), and further in view of Holzmuller (EX1034) and Rivers (EX1035).¹ On March 26, 2024, Patent Owner filed its Reply to Petitioner’s Opposition to the RMTA (Paper 41) and included EX2019 (“Manuella Herb Declaration”) which is relied upon by Patent Owner and its expert, Dr. Stephen McCarthy. *See* PO’s Reply to Opp. to RMTA, pgs. 3-5, 11, and 12; *see also* EX2022, ¶¶74-78, 100, 119, 120. Patent Owner relies on this exhibit to supports its position that the polyethylene component LDPE “does not serve as a tie layer” because it has “weak” bonding to COC based on the “strength per length of 0.5 N per 15 mm.”

Pursuant to 37 C.F.R. § 42.64 (c) and the Federal Rules of Evidence, Petitioner Huhtamaki (“Petitioner”) moves to exclude Exhibit 2019 (“Manuella Herb Declaration”). Petitioner timely objected to this exhibit on sufficiently particularized grounds. *See* Paper 42.

¹ Petitioner alleges in its Opposition to PO’s RMTA that claims 14, 15, and 20-24 are obvious in view of Riis and Wypych, claims 16-18 are obvious in view of Riis, Wypych, and Holzmuller, and claim 19 is obvious in view of Riis, Wypych, and Rivers.

II. Argument

A. Patent Owner Offers the Manuella Herb Declaration Statements for Their Truth

Under Fed. R. Evid. 801, out-of-court statements offered for the truth of the matter asserted are inadmissible as hearsay. Patent Owner and its expert offers for its truth a statement made by Manuella Herb in a 37 CFR 1.132 Declaration made during prosecution of a patent application assigned to Petitioner. The declarant, Manuella Herb, is not a witness or expert in this proceeding and the patent application the statements were made in are not a subject of this proceeding. The Manuella Herb Declaration is hearsay and should be excluded.

Patent Owner specifically cites to the Manuella Herb Declaration to argue that LDPE is not a “tie layer” but instead serves “primarily” as a bulk layer. PO Reply to Opp. to RMTA, 1, 3.

However, Petitioner's own inventor, Manuella Herb, has submitted that the bond between a regular LDPE layer and a COC layer (as disclosed in Riis) is weak such that the COC layer "*more or less easily delaminates* or can be peeled off from the neighboring LDPE layer." EX2019 ¶ 10. Manuella supported this position with claims that laboratory testing shows that "the bond between a regular LDPE layer and a [connected] COC layer" within a laminate structure including "aluminum/ethylene acrylic acid [(EAA)] copolymer/ LDPE/ COC⁷ has a strength per length of 0.5 N per 15 mm." *Id.*

PO Reply to Opp. to RMTA, 4. According to Patent Owner's argument, this statement purportedly demonstrates its position that "the .65 mil LDPE layer primarily serves as a bulk layer and does not serve as a tie layer." The statements made in the Manuella Herb Declaration are supported by unknown "laboratory testing" to generate a quantification of "strength per length" but fail to provide the underlying data, how the data was generated, how the test is regarded in the art, and other relevant information for determining its accuracy. *See* 37 CFR §42.65. Further, Manuella Herb was not subject to cross-examination on the conclusions of the Declaration. These statements, cited by the Patent Owner's Reply and its Expert are offered for the truth: that LDPE delaminates from COC and has poor binding of 0.5 N per 15 mm. The statements in the Manuella Herb Declaration are hearsay under Rule 801 of the FRE. *See N5 Techs. LLC v. Cap. One N.A.*, 56 F. Supp. 3d 755, 765 (E.D. Va. 2014) ("To begin with, Christensen's expert report is not admissible under an exception to the hearsay rule."); *Denso Corp. v. Collision Avoidance Techs. Inc.*, IPR2017-01715, Paper 27 at 25 (PTAB Jan. 22, 2019) ("It is beyond reasonable dispute that the deposition testimony of [experts in other IPR proceedings] are hearsay in the proceeding before us."); *see also GAF Materials LLC v. Kirsch Research and Dev., LLC*, IPR2021-00192, Paper 45 at 62-65 (PTAB May 24, 2022).

B. No Hearsay Exception Applies

The statements made in the Manuella Herb Declaration in EX2019 are not subject to any hearsay exceptions. For instance, EX2019 does not satisfy any of the conditions that are set forth in FRE Rule 803(1) – (23). Moreover, none of the FRE Rule 804 exceptions apply because they require the witness to be unavailable. Under FRE Rule 804, a witness is deemed unavailable to testify if the witness: (1) is exempted due to court rules or privilege; (2) refuses to testify despite a court order; (3) testifies to not remembering the subject matter; (4) cannot be present due to death or then-existing infirmity, physical illness, or mental illness; (5) is absent and has not been obtainable by process or other reasonable means. None of the circumstances above are applicable to this matter before this Board.

Rule 807 does not apply to the EX2019 because it requires the hearsay statement to: (1) have equivalent circumstantial guarantees of trustworthiness; (2) be offered as evidence of a material fact; (3) be more probative on the point for which it is offered than any other evidence that the proponent can obtain through reasonable efforts; and (4) be in the interests of justice to admit. The exercise of the residual exception rule under FRE Rule 807 is reserved only for those exceptional cases and should not be used as a “broad license” to admit otherwise statements of hearsay not falling within one of the other exceptions. *Neste Oil OYJ v. REG Synthetic Fuels, LLC*, IPR2013-00578 (Paper 52), at 9 (PTAB March 12,

2015) (quoting *Conoco, Inc. v. Dep't of Energy*, 99 F.3d 387, 392 (Fed. Cir. 1996)). There is no indication here of an exception case because the interest of justice would not be served where the Patent Owner has made no effort to procure Manuella Herb's statements for this proceeding and has not shown that the hearsay statements are more probative than other evidence it could have obtained through its own reasonable efforts. *See CaptionCall*, IPR2015-00637 (Paper 98), at 15-17.

Additionally, while “[a]n expert may base an opinion on facts or data in the case that the expert has been made aware of or personally observed” so long as “experts in the field would reasonably rely on those kinds of facts or data in forming an opinion on the subject” under FRE Rule 703, the Manuella Herb Declaration is not such a declaration with facts or data that would meet this Rule. Patent Owner nor its expert have stated or demonstrated that a §1.132 Declaration is a document experts in this field reasonably rely on for the “facts or data in forming an opinion on the subject.” *See* FRE Rule 703.

III. Conclusion

Based on the foregoing, the Board should exclude Exhibit 2019 under 37 C.F.R. § 42.64(c).

Respectfully submitted,

Dated: March 28, 2024

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above-captioned **PETITIONERS' MOTION TO EXCLUDE PATENT OWNER'S EVIDENCE PURSUANT TO 37 C.F.R. § 42.64(C)** was served electronically via e-mail in its entirety on March 28, 2024, upon the following parties:

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