

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.

PGR2023-00008

Patent 11,260,624

**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO
EXCLUDE**

I. INTRODUCTION

Petitioner seeks to exclude a sworn declaration (EX2019) from one of Petitioner's own employees, which Petitioner previously submitted to the United States Patent and Trademark Office ("Office") during prosecution of one of its patents. Petitioner argues that the declaration is inadmissible hearsay, and also claims that the substance of the declaration is improper expert testimony that fails to include sufficient facts or data under FRE 703.

It is not surprising that Petitioner would want to exclude EX2019 from this proceeding, as it squarely undercuts Petitioner's position that the .65 mil LDPE layer in Riis's Example 5 film is a tie layer (a pillar upon which Petitioner's case rests). In EX2019, Petitioner's employee, Manuella Herb (hereinafter "Herb Declaration"), testified under oath that the bond between an LDPE layer and a COC layer (as disclosed in Riis Example 5) is weak and "more or less easily delaminates," which is the opposite of how a tie layer functions.

What is surprising is the length that Petitioner is going to try and exclude the Herb Declaration. Petitioner's hearsay argument is frivolous, as Petitioner either overlooked Fed. R. Evid. 801(d)(2) or, worse, was aware but chose not to cite it.

But what is more troubling is Petitioner's attempt to discredit the substance of the Herb Declaration. To be clear, when prosecuting its own patent application, Petitioner had no qualms in urging the Office to accept the statements and opinions

in the Herb Declaration as true, accurate, and reliable.¹ As apparent from the prosecution history, the substance of the Herb Declaration was a material basis on which the Office ultimately granted Petitioner's U.S. Pat. No. 11,504,954. *See* EX2017, 64 (April 7, 2022, Office Action) ("Applicant's arguments and affidavit filed on 01/24/2022 are acknowledged and have been fully considered. Any rejection and/or objection not specifically addressed below is herein withdrawn").

Now, however, Petitioner requests that the Board exclude the very same statements and opinions as unreliable, improper expert testimony and based on insufficient facts and data. *See* Paper 42 (Petitioner's Objections to EX2019) (arguing EX2019 includes "statements based on insufficient facts or data" and "fails to provide sufficient facts or data"). Obviously, Petitioner did not believe the Herb Declaration suffered from these flaws when it submitted it in support of its own application or, if it did, it failed to disclose these flaws to the Office.²

At bottom, Petitioner's argument to discredit the Herb Declaration amounts to another example of Petitioner taking contradictory positions based on the

¹ In submitting the Herb Declaration, Petitioner declared that "willful false statements and the like may jeopardize the validity of this document," and that "all statements made [therein are] of his/her own knowledge and are true." EX2019 at 4.

² There is no record in EX2019 that Petitioner cautioned or disclosed to the Office, when submitting the Herb Declaration, that it was "not based on reliable foundation, and/or constitutes conclusory opinions without sufficient support," as it now claims. *See* Paper 42 at 1-2.

exigencies of the moment, even at the expense of its duty of candor towards the Office.

For the reasons below, the Board should deny Petitioner's Motion to Exclude.

II. BACKGROUND

The Herb Declaration exposes Petitioner's statements made to the Office in other proceedings that are inconsistent with, and starkly undercut, Petitioner's position taken in this proceeding. These statements were made by the Petitioner while addressing Osborn (EX2003) as prior art to U.S. Pat. No. 11,504,954. Riis (EX1004), which is heavily relied on by Petitioner in this proceeding, relies on Osborn³ for priority. EX1004 ¶ [0001]. Osborn includes a reproduction of Riis's Example 5. EX2003 ¶ [0100].

As noted by Petitioner on page 2 of its Motion to Exclude, Petitioner represented to the Office in EX2019 that a COC layer "more or less easily delaminates or can be peeled off from the neighboring LDPE layer" and that "the bond between a regular LDPE layer and a [connected] COC layer" in a laminate structure including "aluminum/ ethylene acrylic acid [(EAA)] copolymer/ LDPE/ COC has a strength per length of .5 N per 15mm."

³ U.S. App. No. 14/178,005.

These statements contradict Petitioner's foundational position that the .65 mil LDPE layer in Riis's Example 5 film is a tie layer — under Patent Owner's definition, Riis's definition, and Petitioner's own definition of a tie layer. In fact, Petitioner's expert, Dr. Spontak, recently confirmed his understanding of a tie layer as follows: "the definition of [a] tie layer is to enable adhesion and to mitigate delamination." EX2021, 183:23–189:4. According to Dr. Spontak, the .65 mil LDPE layer is a tie layer since it "is needed for good adhesion to the COC layer, the contact layer." *Id.*, 191:15–20; *see also id.*, 207:12–17 (Dr. Spontak opining that the .65 mil LDPE layer would not easily delaminate or peel off from the COC layer).

These statements undermine essential foundation for Petitioner's allegations in Paper 36 (Petitioner's Opposition to Patent Owner's RMTA) that a person of ordinary skill in the art (POSITA) would modify or combine Riis with Holzmuller, because Petitioner's combination of Riis with Holzmuller hinges on Riis's .65 mil LDPE layer being a tie layer.

Faced with its prior statements in EX2019 that undercut Petitioner's case as well as Petitioner's credibility and that of its expert, Petitioner now blatantly misapplies Rule 801 of the Federal Rules of Evidence.

III. EX2019 IS ADMISSIBLE AND IS NOT HEARSAY UNDER FRE 801(d)

A. FRE 801.

Although Petitioner's Motion cited FRE 801 in passing, it spent the bulk of its arguments on "exceptions" to the hearsay rule set forth in 803, 804, and 807, all while ignoring the express provisions of FRE 801(d)(2):

(d) Statements That Are Not Hearsay. A statement that meets the following conditions is not hearsay:

. . .

(2) An Opposing Party's Statement. The statement is offered against an opposing party and:

(A) was made by the party in an individual or representative capacity;

(B) is one the party manifested that it adopted or believed to be true;

(C) was made by a person whom the party authorized to make a statement on the subject; [or]

(D) was made by the party's agent or employee on a matter within the scope of that relationship and while it existed

. . .

B. EX2019, a Declaration of Petitioner's employee that was submitted by Petitioner to the Office, qualifies as an opposing party's statement and is, therefore, not hearsay.

EX2019 qualifies as an opposing party's statement in multiple ways under FRE 801(d)(2). FRE 801(d)(2) provides that (1) a statement that is offered against

an opposing party and (2) satisfies at least one of FRE 801(d)(2)(A)–(E) is not hearsay.

Offered Against Opposing Party

EX2019 is being offered against Petitioner, the opposing party.

FRE 801(d)(2)(B)–(D)

FRE 801(2)(B). EX2019 was submitted⁴, and relied on, by Petitioner during prosecution of its patent (U.S. Pat. No. 11,504,954⁵) in front of the Office. Thus, Petitioner manifested that it adopted or believed the statements in EX2019 to be true.

FRE 801(2)(C). EX2019 is a declaration of an inventor of Petitioner's patent, which was then submitted by Petitioner to the Office. Thus, the statement was made by a person authorized by Petitioner to make a statement on the subject. *See* EX2019 at 4 ("The undersigned ... declares that s/he is properly authorized to execute this document on behalf of the applicant.").

FRE 801(2)(D). EX2019 is a declaration of an employee of Petitioner that was prepared at the direction of Petitioner's counsel during prosecution of Petitioner's patent. Thus, the statement was made by the party's agent or employee on a matter within the scope of that relationship and while it existed. *Id.*

⁴ By Huhtamaki Flexible Packaging Germany GmbH & Co. KG on 08/12/2021.

⁵ Filed by, and assigned to, Huhtamaki Flexible Packaging Germany GmbH & Co. KG, on 07/19/2019. *See* Reel/frame: 049802/0762.

As such, EX2019 is expressly not hearsay under FRE 801(d)(2)(B) – (D).

Thus, hearsay is not a ground for excluding the Herb Declaration and the exceptions to hearsay need not be considered.

C. Petitioner similarly misapplies the cases being cited in support of its Motion to Exclude.

The cases cited by Petitioner in support of its Motion to Exclude are inapposite.

In *N5 Techs. LLC v. Cap. One N.A.*, 56 F. Supp. 3d 755, 764, 765 (E.D. Va. 2014), the plaintiff sought to offer the defendant's expert's statements in defendant's expert report into evidence "under either Rule 801(d)(2), Fed. R. Evid. (governing the hearsay exception for statements by opposing parties⁶) or under Rule 807, Fed. R. Evid. (providing a residual exception to the general prohibition on hearsay)." In *N5*, "although there is no Federal Circuit authority on this point," the plaintiff was prohibited from submitting the defendant's expert's statements because the plaintiff failed to show that "the expert was acting as the party's agent or employee or was specifically authorized to make a statement on that subject." *Id.* at 765.

⁶ Assuming Petitioner read the *single* page Petitioner cited from this case, Petitioner knew, or should have known, of the "opposing party statement" rule *but failed to* bring this controlling adverse authority to the Board's attention.

As a threshold matter, and as pointed out by Petitioner, Manuella Herb is an employee of Petitioner, not a witness or expert in this proceeding (Motion to Exclude, 2), and EX2019 is not an expert report. Putting aside the merits of the *N5* holding, under the *N5* holding, EX2019 would not qualify as hearsay because EX2019 includes statements made by an employee of Petitioner that was specifically authorized to make the statements in the EX2019.

In *Denso Corp. v. Collision Avoidance Techs. Inc.*, IPR2017-01715, Paper 24 at 24 (PTAB Jan. 22, 2019), the patent owner sought to submit a first exhibit of a deposition transcript of "an expert witness in a different *inter partes* review proceeding . . . filed by a different petitioner than the Petitioner in the case before us" and a second exhibit of a deposition transcript of "an expert witness in two different *inter partes* review proceeding[s] . . . each filed by a different petitioner than the Petitioner in the case before us." (emphasis added).

Thus, *Denso* is not applicable to the present matter since *Denso* is concerned with the submission of an expert witness report by a party other than the petitioner — not the issue of a party's own prior statement.

D. Petitioner's reference to 37 CFR § 42.65 is misplaced.

"A motion to exclude . . . may not be used to challenge the sufficiency of evidence to prove a particular fact." PTAB Consolidated Trial Guide, 79, § II.K

(Nov. 2019). "A motion to exclude is not a vehicle for addressing the weight to be given evidence." *Id.*

37 C.F.R. § 42.65 provides that "[e]xpert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled **to little or no weight**" (emphasis added). Here, Petitioner obviously believed that there were sufficient underlying facts and data regarding the testing that was discussed in the Herb Declaration when it submitted it to the Office. As such, it is disingenuous at best to argue otherwise.

Additionally, Patent Owner does not submit the Herb Declaration in this proceeding as an expert opinion. The definition of expert is derived from FRE702, which relates to "[a] witness who is qualified as an expert by knowledge, skill, experience, training, or education may testify in the form of an opinion or otherwise." Here, the Herb Declaration is not expert testimony under 37 C.F.R. § 42.65 as Manuella Herb is not a witness or expert in this proceeding. Moreover, 37 C.F.R. § 42.65 relates to the weight to be given to expert testimony. Accordingly, discussion of 37 C.F.R. § 42.65 in the context of Petitioner's Motion to Exclude is improper.

IV. CONCLUSION

For all these reasons, Patent Owner respectfully requests that the Board deny
Petitioner's Motion to Exclude.

By: /Steven Avena/
 Steven A. Avena

On: April 2, 2024

For: Patent Owner

Holland & Hart LLP
1800 Broadway, Suite 300
Boulder, CO 80302
Tel: 303.473.2700 • Fax: 303.473.2720
Email: saavena@hollandhart.com

CERTIFICATE OF SERVICE

I, Steven A. Avena, hereby certify that a copy of the foregoing has been served on the attorneys of record of Huhtamaki Flexible Packaging Germany GmbH & Co. KG ("Petitioner") electronically by email¹ as of today, April 2, 2024, at the following electronic addresses:

General Email: litigation@iplawgroup.com

Ryan D. Levy (Lead Counsel): rdl@iplawgroup.com

Mark A. Kilgore (Back-Up Counsel): mak@iplawgroup.com

Seth R. Ogden (Back-Up Counsel): sro@iplawgroup.com

Samuel A. Raque (Back-Up Counsel): sar@iplawgroup.com

By: /Steven Avena/
Steven A. Avena

On: April 2, 2024

For: Patent Owner

Holland & Hart LLP
1800 Broadway, Suite 300
Boulder, CO 80302
Tel: 303.473.2700 • Fax: 303.473.2720
Email: saavena@hollandhart.com

¹ Petitioner has consented to electronic service by email. See Petition, § II.D.