

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 RESPONSE TO PATENT OWNER’S OPPOSITION TO
THE 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 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."

When faced with Petitioner's Motion to Exclude, Patent Owner takes the position that the Herb Declaration is not expert testimony, and therefore the cited case law in Petitioner's Motion is inapplicable. To the extent the Board finds the Herb Declaration to be lay testimony according to the Patent Owner, the Declaration should be accorded little weight. If the Board finds the technical and scientific aspects of the Herb Declaration to constitute expert testimony, such testimony should be excluded as hearsay.

II. Argument

Patent Owner spends much of its Opposition to Petitioner's Motion to Exclude discussing why the document upon which it relies is important to its case and how it is material to the proceeding. *See* Paper 44, 2-5. However, at no point

has Patent Owner provided a single citation to any case law authority to support its position. At best, Patent Owner tries to distinguish the cases cited by Petitioner yet fails to provide any countervailing opinions or orders from any tribunal, PTAB or otherwise.

The admissibility of expert reports and similar opinions is met with mixed results, often turning on fact-specific issues relevant to the case before the court tasked with determining admissibility of the evidence. The use of a §1.132 Declaration from an inventor of a patent assigned to a petitioner that is not at issue in a post-grant proceeding is unusual. Unlike Patent Owner's position of citing no relevant case law to support its position, Petitioner believes that the cited cases in its original Motion to Exclude, and further case law cited herein, are instructional to the Board and provide context for circumstances in which the Board should exclude evidence of the kind at issue here.

The Herb Declaration is one of a technical nature providing comparative results of experiments performed under laboratory conditions. EX2019, ¶¶10-11. When assessing a § 1.132 declaration, an examiner is required to assess "the probative value of an expert opinion" and "must consider the nature of the matter sought to be established, the strength of any opposing evidence, the interest of the expert in the outcome of the case, and the presence or absence of factual support for the expert's opinion." See MPEP 716.01(c). Patent Owner argues, on the one

hand, that “EX2019 not an expert report” to support their position for the inapplicability of the relevant case law cited by Petitioner, while on the other hand, asking the Board to take the statements of Dr. Herb as factually correct and give them the full weight and consideration of an expert in the field. If Patent Owner seeks to enter the Herb Declaration as merely lay opinion, (see Paper 44, pg. 10 “Additionally, Patent Owner does not submit the Herb Declaration in this proceeding as an expert opinion.”) then it is entitled to little or no weight.

Petitioner appreciates that inventors are, in some instances, allowed to present lay opinions about the patents they invented based on their personal knowledge, but those circumstances do not appear to be at issue here. *See, e.g., Verizon Servs. Corp. v. Cox Fibernet Va., Inc.*, 602 F.3d 1325, 1339-40 (Fed. Cir. 2010) (allowing witness testimony about the patents they invented based on their personal knowledge). Here, the Herb Declaration provides experimental results and conclusions as evidence to show that unexpected results of greater adhesion were achieved based on the use of one polyethylene compared to another. While Patent Owner states that the Herb Declaration is not expert opinion, the contents of the Declaration, including that of scientific and technical knowledge, have the hallmarks of expert opinion.

Should the Board find that the Herb Declaration is expert opinion, then the case law cited by Petitioner is applicable to the current proceeding. While Dr. Herb

states that she is employed by Petitioner, mere employment is not enough to render statements as not hearsay. *See* FRE 801(D)(2); EX2019, ¶1. It is Petitioner's position that Dr. Herb was providing the §1.132 Declaration in her capacity as an inventor and skilled artisan, not as an employee authorized to speak on behalf of the Petitioner. Dr. Herb was providing her opinions as a skilled artisan with respect to the comparison of an LDPE-containing film versus that of a m-LLDPE-containing film, and the relative adhesion strength according to testing method DIN55543-5. To be of probative value to the Patent Office, the evidence presented in a §1.132 Declaration should be objective and factually supported. *See* MPEP 716.01(c) (citing *In re De Blauwe*, 736 F.2d 699, 705, (Fed. Cir. 1984)). As an inventor, submitting her § 1.132 Declaration regarding objective experimental data, Dr. Herb was neither an employee nor agent acting by control or direction of the Petitioner. *See N5 Techs. LLC v. Cap. One N.A.*, 56 F. Supp. 3d 755, 765 (E.D. Va. 2014).

In comparison to *N5 Techs. LLC*, other case law has found that an expert's testimony is admissible, such as in *Medtronic, Inc. v. W.L. Gore & Associates, Inc.*, again turning on specific factual circumstances. 2008 WL 5191846 (N.D. Cal. Dec. 9, 2008). In *Medtronic*, the district court found that the expert retained by Medtronic was considered an employee under Minnesota law based on the consulting agreement that was signed by the expert and Medtronic. *Id.* at *4. The

district court looked to Minnesota law with respect to independent contractors and agency relationships and assessed five factors for determining the status of an employee. *Id.* Patent Owner relies solely on the statement that Dr. Herb is employed by Huhtamaki without providing any analysis as to whether the § 1.132 Declaration was made in Dr. Herb's capacity as an employee, and whether it was a matter within the scope of her employment.

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 the statements made by Manuella Herb in a 37 CFR § 1.132 Declaration made during prosecution of a patent application assigned to Petitioner. Dr. Herb is not a witness or expert in this proceeding and the patent application in which the statements were made is not a subject of this proceeding. The Herb Declaration is hearsay and should be excluded.

III. Conclusion

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

Respectfully submitted,

Dated: April 8, 2024

/s/ Ryan Levy
Ryan D. Levy, Reg. No. 58,618
Tel.: (202) 371-2600
rdl@iplawgroup.com
Counsel for Petitioner

CERTIFICATION OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above-captioned **PETITIONER'S RESPONSE TO PATENT OWNER'S OPPOSITION TO THE 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 April 8, 2024, upon the following parties:

Steven A. Avena (Lead Counsel)
Timothy P. Getzoff (Back-up Counsel)
Jeffrey R. Roeser (Back-up Counsel)
HOLLAND & HART, LLP
saavena@hollandhart.com
tgetzoff@hollandhart.com
jroeser@hollandhart.com

Dated: April 8, 2024

By: /s/ Ryan Levy
Ryan D. Levy, Reg. No. 58,618

Counsel for Petitioner

Patterson Intellectual Property Law, P.C.
1600 Division Street, Suite 500
Nashville, TN 37203
rdl@iplawgroup.com
Tel.: (615) 242-2400
Fax: (615) 242-2221