

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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VIANCE, LLC,  
Petitioner,  
v.

KOPPERS PERFORMANCE CHEMICALS, INC.,  
Patent Owner.

PGR Nos. 2026-00023  
U.S. Patent No. 12,370,716  
Issued: July 29, 2025  
Application No. 19/072,608  
Filed: March 6, 2025

TITLE: WOOD PRESERVATIVE COMPOSITION COMPRISING 4,5-DICHLORO-2-OCTYLISOTHIAZOL-3(2H)-ONE, A METHOD TREATING A WOOD SUBSTRATE THEREWITH, AND A WOOD PRODUCT PRODUCED THEREFROM

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DECLARATION OF **REDACTED** IN SUPPORT OF PETITION FOR  
POST GRANT REVIEW OF U.S. PATENT NO. 12,370,716

I, the undersigned, [REDACTED], having been duly sworn, declare as follows:

**I. Introduction**

1. I am over the age of eighteen (18) and otherwise competent to make this declaration.

2. I have worked for [REDACTED] since June 1, 2010. I currently hold the position of Director of Quality Assurance and Technical Services. I have held this position since December 21, 2020. This position generally entails me being responsible for the quality of wood utility poles and lumber produced in the United States and Western Canada, wood science based technical support for the organization, as well as technical representation if [REDACTED] at the industry association level.

3. All of the testimony provided in this declaration is based on my personal knowledge and recollection from having worked for [REDACTED] since June 1, 2010. I am not being compensated for any of the testimony provided herein, aside from the normal salary that I receive working for [REDACTED]. I understand that my declaration will be submitted to the United States Patent Trial and Appeal Board in support of a petition for post grant review of United States Patent No. 12,370,716.

4. [REDACTED] is a manufacturer and distributor of industrial pressure-treated wood products, including utility poles, railway ties, and residential and industrial lumber products. [REDACTED] pressure-treated wood products are manufactured at a large scale at various plants across North America using wood treatment products from companies such as Viance, LLC (“Viance”).

**II. Evaluation of the Viance UP-50 Product**

5. [REDACTED] evaluated UP-50 obtained from Viance from the dates as of at least December 2020. The purpose of this work was to evaluate UP-50 in connection with equipment

that closely replicated commercial practice (e.g., to assess solution uptake, retention, and solution stability).

6. I was also able to locate **REDACTED** business records Exs1070-1074 concerning evaluation of Viance's UP-50 product from December 2020 through May 2021.

A. Ex1070

7. Ex1070 is true and correct copy of a report of a **REDACTED** evaluation of UP-50, titled "DCOI Treatment Analysis – UP50 Treatment 1, 2, 3, and 4" prepared on or about December 3, 2020.

8. Ex1070 shows that four treatments of UP-50 were evaluated in connection with larger scale equipment and that core samples from each of the four treatments of UP-50 were then prepared and analyzed. Ex1070 further shows that UP-50 met the target uptake and retention metrics. Ex1070 reports that "[a]ll the cores met the required retentions of 0.2 pcf and 0.1 pcf for the outer zones and inner zones respectively." (Ex1070, page 2.)

B. Ex1074

9. Ex1074 is true and correct copy of a report titled "Quick DCOI Summary" created on or about December 23, 2020. Slide 2 of Ex1074 reports that for DCOI UP 50 "No issues with gelling, crystals or penetration." (Ex1074, page 2.)

C. Ex1071

10. Ex1071 is a report titled "DCOI-UP50, **REDACTED**" dated January 7, 2021. Ex1071 states that "[t]he overall objective is to determine the optimal treatment parameters for this preservative to ultimately be used in a full wood treatment facility." (Ex1071, page 3.)

11. Ex1071 reports that solid blocks of UP-50 were evaluated and that these blocks were "composed of 50% DCOI, 25% paraffin waxes and hydrocarbon waxes, and 25%

microcrystalline wax.” (Ex1071, page 3.) Ex1071 further demonstrates that the UP-50 product met target values for retention and solution uptake of the active ingredient, DCOI. For example, Ex1071 states that “DCOI-UP50 would be capable of treating the poles to meet required retentions.” (Ex1071, page 4.) Ex1071 also states that “DCOI-UP50 was capable of treating four Douglas Fir poles without creating a gel, as well as meet the required assay retentions. Based on these observations it appears that DCOI-UP50 would be a suitable wood preservative . . .” (Ex1071, page 39.)

D. Ex1072

12. Ex1072 is a true and correct copy of a report titled “DCOI Summary Report, REDACTED REDACTED” dated April 15, 2021. Ex1072 reports on further evaluation performed by REDACTED in conjunction with REDACTED, which noted that “Pentachlorophenol . . . is in the process of being phased out of service as wood preservative. \*\*\* The solid block was DCOI UP-50 which was composed of 50% DCOI, and 50% wax variants.” (Ex1072, page 8.)

13. Ex1072 states that the UP-50 product was a solid block with a chemical composition of 50% DCOI, 25% paraffin waxes and hydrocarbon waxes, and 25% microcrystalline wax. (Ex1072, page 8.) Ex1072 reports that “In addition DCOI UP-50 is an acceptable solid block solution as it successfully met all required retentions and gel did not form due to solution matrix.” (Ex1072, page 12.)

E. Ex1073

14. Ex1073 is a true and correct copy of a PowerPoint presentation titled “DCOI Treatments Summary” created on approximately May 3, 2021. Ex1073 reports on various evaluations, stating that “NO ISSUES WITH GELLING, CRYSTALS OR PENETRATION. \* \* \* VERY PLEASING APPEARANCE, DOES NEED HEAT TO WORK BUT RAPIDLY GOES TO

LIQUID UNDER MODERATE TEMPERATURES.” (Ex1073, page 2.) Slide 19 of Ex1073 further states, “NO ISSUES AT ALL.”

15. In connection with the foregoing evaluations of UP-50 reflected in Exs1070-1074, REDACTED diluted the UP-50 received from Viance in an organic solvent to form a diluted composition which was used to treat wood products, e.g. utility poles, by contacting the wood for a period of time suitable to inhibit fungal decay in the wood substrate.

### **III. Transition to Viance UP-50 Product and Sales of Utility Poles Treated with the Same**

16. After the foregoing evaluations of UP-50 reflected in Exs1070-1074, I understand that Viance obtained necessary regulatory approvals for the product. Once received REDACTED began transitioning from UP-23 to UP-50 in May through June 2022.

17. Beginning in May 2022, REDACTED began purchasing UP-50 from Viance, as reflected in various purchase orders from REDACTED (and associated invoices from Viance) on the following dates: May 18, 2022; May 20, 2022; and July 26, 2022, as reflected in Exs1032, 1046, 1052, 1059, 1060, and 1061.

#### A. Exs1032 and 1059: May 18, 2022 Purchase Order and May 27, 2022 Invoice

18. Exs1032 and 1059 reflect the purchase of UP-50 from Viance by REDACTED on May 18, 2022. Ex1032 is a purchase order for UP-50 created by REDACTED and sent to Viance on or about May 18, 2022. Ex1059 is an invoice for the purchase of UP-50 reflected in Ex1032 received from Viance by REDACTED on or about May 27, 2022.

19. As of May 18, 2022, REDACTED had purchased more than 16,000 pounds of UP-50 from Viance for treatment of utility poles.

#### B. Exs1046 and 1060: May 20, 2022 Purchase Order and June 24, 2022 Invoice

20. Exs1046 and 1060 reflect the purchase of UP-50 from Viance by REDACTED on May 20, 2022. Ex1046 is a purchase order for UP-50 created by REDACTED and sent to Viance

on or about May 20, 2022. Ex1060 is an invoice for the purchase of UP-50 reflected in Ex1046 received from Viance by REDACTED on or about June 24, 2022.

21. As of May 18, 2022, REDACTED had purchased an additional 16,000 pounds of UP-50 from Viance for treatment of utility poles.

C. Exs1052 and 1061: July 26, 2022 Purchase and August 5, 2022 Invoice

22. Exs1052 and 1061 reflect the purchase of UP-50 from Viance by REDACTED on July 26, 2022. Ex1052 is an email communication from a REDACTED employee for an order of UP-50 on July 26, 2022. Ex1061 is an invoice for the purchase of UP-50 reflected in Ex1061 received from Viance by REDACTED on or about August 5, 2022.

23. As of July 26, 2022, REDACTED had purchased an additional 16,000 pounds of UP-50 from Viance for treatment of utility poles.

24. Once the ordered UP-50 was delivered, preparations were made to transition our treatment facility in REDACTED over to UP-50 DCOI.

D. Exs1082 and 1081: Estimated and Actual Transition Timeline

25. Ex1082 is a copy of an email from REDACTED, the plant manager at the time, outlining the timeline of the transition. While the timeline anticipated the first charge to be treated with UP-50 to occur on June 26<sup>th</sup> 2022, the first charge started treatment on June 19<sup>th</sup>, 2022. This was due to the expected timeline action items being completed faster than originally anticipated.

26. In June and July 2022, I personally travelled to the REDACTED treatment facility multiple times to supervise our transition to UP-50, which involved the removal of any remaining UP-23 solution and the shipment of that solution to the REDACTED facility for storage, and then shipment of UP-23 to REDACTED facility where it was used for the treatment of Southern Yellow Pine, the flushing of the retort number two treatment system in REDACTED

with diesel to remove any trace amount of the previous UP-23 formulation, the loading and mixing of the UP-50 blocks with new raw diesel, and the commercial treatment trials for the UP-50 formulation. The commercial treatment trials involved Quality Control conformance evaluations to ensure preservative penetrations and chemical retentions were being achieved, microscopy and filtering analysis to ensure the wax additive of the UP-50 was not causing unexpected issues. The trial was successful with some modifications of treatment parameters. This trial was focused on cycle management, and all products produced during this time were conforming to customer specifications and available for customer sale. The first charge of material was treated on June 19th 2022, meaning that all the poles **REDACTED** treated throughout the trial period on retort number two, and after June 19, 2022, were treated with UP-50.

27. Ex1081 is a copy of emails I authored on July 15 and July 26, 2022, reporting out our transition to UP-50. In this email, I explained some challenges relating to temperature of the wax formulation and microscopy of the wood cells showing the wax within the cells which is a reference to properties of UP-50. (Ex1081, page 1.)

E. Exs1083-1086: Offers and Sales of Utility Poles Treated With UP-50 Before August 5, 2022

28. Thereafter, beginning on or about June 19, 2022, **REDACTED** used UP-50 purchased from Viance to treat Douglas fir for use as utility poles. In doing so, **REDACTED** diluted the UP-50 in an organic solvent of high flash point no. 2 diesel to form a diluted treating solution and used the diluted UP-50 solution to treat Douglas fir poles, by contacting the wood for a period of time understood to be suitable to inhibit fungal decay. **REDACTED** would not select Viance's other DCOI wood preservative, UP-23, to treat Douglas fir. Based on my review of the records, I understand that the Douglas fir poles treated with UP-50 and an organic solvent were then offered for sale, sold, and delivered to **REDACTED** customers prior to August 5, 2022.

29. There were a total of twenty three charges treated before the August 5<sup>th</sup>, 2022 date, with a total of 1,192 poles produced. Ex1086 reflects a record of the treatment record and tallies of all twenty three charges—with dates ranging from June 19, 2022 to August 4, 2022—treated with UP-50 prior to the August 5<sup>th</sup> date. The treating parameters have been redacted due to the proprietary nature of the information.

30. The treated poles referenced in Ex1086 were thereafter offered for sale to, and in some instances purchased by, a number of utility customers before August 5, 2022, including:

**REDACTED**

**REDACTED** While pole-level traceability is not possible, a number of these customers purchased poles treated with UP-50 before August 5, 2022. However, **REDACTED** invoices after delivery, for **REDACTED** customers and others, the delivery timeframe resulted in invoicing after the August 5<sup>th</sup> date. These invoices, however, merely memorialized sales that were made before August 5, 2022.

31. As shown in Exs1083-1086, **REDACTED** purchased a utility pole treated with UP-50 from **REDACTED** in July 2022. That pole was shipped on July 26, 2022, and delivered on or before July 29, 2022, when the order was invoiced for payment.

32. Ex1083 reflects a record of pressure treatment of Douglas fir with DCOI using UP-50 for **REDACTED**, as well as other customers. (See also Ex1086, page 5.) The treatment fulfilled an order from **REDACTED** and occurred from June 29, 2022 to July 2, 2022. As reflected on page 1 and 2 of Ex1083, approximately 90 Douglas fir poles were treated with UP-50 and made, offered for sale, and one piece sold to **REDACTED** before August 5, 2022. (Ex1083, page 1-2.) This record of one pole was chosen as full record of delivery

and payment terms from [REDACTED] showing that the end user had taken complete ownership prior to the August 5<sup>th</sup> date.

33. Ex1084 reflects a record of shipment of the pole listed in Ex1083 to [REDACTED] [REDACTED] on July 26, 2022. It includes signed bill of ladings documenting delivery on July 29, 2022, before the August 5<sup>th</sup> date. (Ex1084, page 2.)

34. Ex1085 reflects a record of the July 29, 2022, invoice to [REDACTED] for the pole listed in Ex1083 and 1084, showing [REDACTED] had taken complete ownership of the utility pole treated with UP-50 prior to the August 5<sup>th</sup> date.

35. The sales of utility poles treated with UP-50 reflected in Exs1081-1086 were not subject to any confidentiality restrictions.

#### **IV. Business Records**

36. Exs1070-74, 1081-1086, Exs1032, 1046, 1052, and Exs1059-1061 were generated at or near the date of the events identified therein by [REDACTED] employees as part of their normal business duties by—or from information transmitted by—someone with knowledge of the information contained therein. These records were kept in the course of a regularly conducted business activity of [REDACTED] and were made by [REDACTED] as a regular practice of that activity.

#### **V. Closing Remarks**

37. By signing this declaration, I consent to the submission of this declaration to the United States Patent and Trademark Office to support the petition for post grant review of United States Patent No. 12,370,716. I further understand that I may be subject to cross-examination in this case at a location within the United States. I further declare that any statements herein are based on my personal knowledge developed in the ordinary course of business at [REDACTED]

I declare under penalty of perjury that the foregoing is true and correct to the best of my knowledge, information, and belief.

| Date: March 12, 2026

# REDACTED

