

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OMEGA LINER COMPANY, INC.,
Petitioner,

v.

BUERGOFOL GmbH,
Patent Owner.

IPR2023-01372
Patent 9,657,882 B2

Before GRACE KARAFFA OBERMANN, KIMBERLY McGRAW, and
JAMES J. MAYBERRY, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* OBERMANN.

Opinion Dissenting filed by *Administrative Patent Judge* McGRAW.

OBERMANN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. §§ 42.5, 42.20(c), 42.23(b)

I. INTRODUCTION AND BACKGROUND

Patent Owner requests authorization to file two new declarations with its Sur-reply to counter arguments presented in Petitioner's Reply. Paper 35 ("Motion" or "Mot."). Petitioner opposes the request. Paper 41 ("Opp."). We authorized Patent Owner to include the proposed new declarations with the Motion. Paper 30, 4; *see* Exs. 2028, 2029 (proposed new declarations).

The declarants, Dr. Boutrid and Mr. Schleicher, are named inventors of the challenged patent. Ex. 1001, code (72). Both previously provided declarations in support of Patent Owner's Response. *See* Ex. 2003, 2004 (original declarations).

Patent Owner argues that the proposed new declarations are necessary to counter assertions, raised in Petitioner's Reply, that these witnesses are not credible and made false statements in their original declarations. Mot. 3.

For reasons that follow, we *deny* the Motion.

II. DISCUSSION

Absent extraordinary circumstances, "[a] sur-reply may only respond to arguments raised in the corresponding reply and may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness." 37 C.F.R. § 42.23(b).¹

As the moving party, Patent Owner bears the burden of proving entitlement to the requested relief. 37 C.F.R. §§ 42.20(c). To meet that

¹ The Patent Trial and Appeal Board Consolidated Trial Practice Guide (84 Fed. Reg. 64,280 (Nov. 21, 2019))¹ ("CTPG") provides that "[t]he sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness. Sur-replies should only respond to arguments made in reply briefs, comment on reply declaration testimony, or point to cross-examination testimony." *See* CTPG 73–74.

burden, Patent Owner must explain with specificity why extraordinary circumstances warrant waiving the rule barring new declaration evidence with a sur-reply. 37 C.F.R. § 42.23(b).

Importantly, Patent Owner does not “acknowledge, let alone address, its burden to establish ‘extraordinary circumstances’ that could warrant waiving the rule barring new” declaration evidence with a sur-reply. Opp. 1–2; *see generally* Mot. For reasons that follow, we are disinclined to waive the rule prohibiting new declaration evidence with a sur-reply, where Patent Owner does not identify with specificity the reasons supporting the relief requested. 37 C.F.R. §§ 42.20(c), 42.23(b).

The circumstances presented are not extraordinary on their face and, thus, do not support a finding that Patent Owner implicitly meets its burden here. In conclusory fashion, Patent Owner argues, “The only way to raise facts to the Board’s attention is by submission of declaration testimony.” Mot. 3. But Patent Owner does not address, much less explain with specificity, why the introduction of the proposed new declarations is the only available vehicle at its disposal for fairly responding in the Sur-reply to arguments in the Reply about the credibility of the original declaration testimony.

The proposed new declarations consist of attempts to (1) explain documents already in the record; and (2) introduce new facts not presently in the record. *See* Ex. 2028 ¶¶ 8–24; Ex. 2029 ¶¶ 5–15. Patent Owner indicates the Reply is “based on a lack of understanding, or a misrepresentation, of the relevant facts,” but does not explain with sufficient clarity why the current record is insufficient to support Patent Owner’s view of those relevant facts. *Id.* at 2–3.

The record includes a datasheet (Ex. 1051) that addresses the composition of a material called “Constab PE-SA 270.” Ex. 1051. The composition of Constab PE-SA 270 appears to be central to the parties’ dispute about whether Dr. Boutrid or Mr. Schleicher misrepresented facts in their original declarations. *Compare* Mot. 2–5, *with* Opp. 3 (disputing whether Dr. Boutrid or Mr. Schleicher misrepresented facts relating to the composition of Constab PE-SA 270). The datasheet indicates that Constab PE-SA 270 is composed of “CaCO₃ and a slow migration antiblock additive in PE” (polyethylene). Ex. 1051. On this record, Patent Owner does not explain with specificity why the existing record is insufficient to adequately address the composition of Constab PE-SA 270 in the Sur-reply.

Patent Owner is free to explain in its Sur-reply why and how the Reply misquotes or misconstrues documents in the record, without reliance on the proposed new declarations. But Patent Owner identifies no genuine need to introduce testimony that explains existing documents or advances new factual assertions. In other words, the circumstances presented do not justify the extraordinary relief requested. Mot. 4–5.

Patent Owner states that Dr. Boutrid and Mr. Schleicher “must be able to explain, with facts, how and why Petitioner’s allegations” about “adhesion and tearing” problems are “based on misconstruing and failing fully to quote the inventors’ declarations,” or misconstruing other “documents” of record. *Id.* at 3–4. That reasoning is not adequate to support a deviation from our rule barring introduction of new declarations with a sur-reply. Here again, Patent Owner does not explain adequately why those “documents already in the record” are insufficient to address any factual inaccuracies about those documents described in the Reply. Opp. 2.

Petitioner argues that allowing Patent Owner to introduce new facts into the record with the Sur-reply would shift to Petitioner the onus of rebutting those facts with documentary evidence, with less than one month remaining before the final hearing. Opp. 5; *see* Paper 32 (setting due date of Sur-reply as November 19, 2024); Paper 37 (setting final hearing for December 17, 2024). Petitioner’s assertion that it would face “significant prejudice” as a result is not without merit. Opp. 5 (heading) (capitalization removed). On that point, Petitioner avers that information necessary to effectively impeach Dr. Boutrid and Mr. Schleicher, during depositions based on their new declarations, is in the possession of a foreign-national third party who is “being hesitant to cooperate” with Petitioner. *Id.* at 1, 5.

In other words, waiving our rule to permit filing of the proposed new declarations in support of Patent Owner’s Sur-reply may implicate compelled discovery from an uncooperative third party, located outside the United States, with less than a month remaining before the final trial hearing. Petitioner persuasively argues that this would impose “a significant burden” on Petitioner “during final oral argument preparations.” *Id.* at 1.

On this record, we agree with Petitioner that Patent Owner should be limited to contesting the factual issues surrounding the veracity of the witnesses’ first declarations by referring in the Sur-reply to documents already in the record. Opp. 2–4. Patent Owner identifies no extraordinary circumstances that warrant a deviation from our rules. Mot. 1–5.

Accordingly, we *deny* the motion and prohibit Patent Owner from filing, citing, or referring to Exhibit 2028 or Exhibit 2029 in connection with its Sur-reply. To preserve the record for appeal, we will not expunge those exhibits.

III. CONCLUSION

We *deny* the Motion. Patent Owner shall not file, cite, or refer to Exhibit 2028 or Exhibit 2029 in connection with its Sur-reply.

IV. ORDER

It is

ORDERED that Patent Owner's Motion to File New Evidence in the Form of Declarations from Dr. Boutrid and Mr. Schleicher (Paper 35) is *denied*; and

FURTHER ORDERED that Patent Owner shall not file, cite, or refer to Exhibit 2028 or Exhibit 2029 in connection with its Sur-reply.

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JAMES J. MAYBERRY, *Administrative Patent Judges*.

McGRAW, *Administrative Patent Judge, dissenting*.

I dissent respectfully from the panel majority's decision to deny Patent Owner's Motion to File New Evidence in the Form of Declarations from Dr. Boutrid and Mr. Schleicher (Paper 35, "Mot."). Under the particular facts presented, I would permit deviation from our rule barring introduction of new declarations with a sur-reply and would permit Patent Owner to submit the declarations (Exhibits 2028, 2029, "Rebuttal Declarations") with its sur-reply.

In its Reply (Paper 24), Petitioner asserts that the inventor declarations (Exs. 2003, 2004, "Original Declarations") that were submitted with Patent Owner Response (Paper 13) contain misrepresentations and false statements. First, Petitioner asserts that both inventors misrepresented their knowledge about adhesion and tearing issues with Patent Owner's inner film prior to a particular date. Reply 15 (citing Ex. 2003 ¶¶ 22–24; Ex. 2004 ¶¶ 14–19). To support this contention, Petitioner points to a customer complaint reporting that "the inner foil you supplied was extremely difficult to remove from the liner after installation" and to other documents signed by Dr. Boutrid, in which Dr. Boutrid acknowledges "problems with '[s]trong adhesion of the film to the laminate after curing.'" *See* Reply 15 (citing Ex. 1060, 2; Ex. 1061–1063; Ex. 1058, 2 at § 1, 6 at § 7; Ex. 1059, 1 at § 1)).

Second, Petitioner further alleges that the Original Declarations contain false statements about EBS wax in examples B4-B6. Reply 16–19. Petitioner asserts that that the Original Declarations state that certain layers in examples B4-B6 contain 1%, 4%, and 6% by weight of EBS wax as the migrating compound. Reply 16. Petitioner asserts that, contrary to Patent Owner's assertions, Constab PE-SA 270 used in examples B4–B6 does not

contain EBS wax, and that one of the inventors even admitted that he did not know what was in Constab PE-SA 270 or the percentages of EBS wax, if any, in examples B4–B6. Reply 17–18 (citing, *inter alia*, Ex. 2001 ¶ 72; Ex. 2004 ¶ 58; Ex. 1052, 166:12–167–7, 177:9–178:211, 179:16–180:2, 180:20–181:4, Ex. 1051, 150, 14).

Third, Petitioner alleges that Patent Owner makes false statements about the EBS wax in Example V1. Reply 19–20 (citing Ex. 2001 ¶ 16; Ex. 2004 ¶ 37; Ex. 1049, 1:3; (EX1052, 112:3-7, 113:5-13, 114:8-115:2, 116:17-118:5, 138:1-3, 151:2-152-1, 162:11-163:4.).

Patent Owner further asserts that Petitioner’s counsel sent PO’s counsel a letter making allegations of inequitable conduct and breach of the duty of candor and good faith against the two inventors. Mot. 2.

Patent Owner seeks to submit the Rebuttal Declarations to rebut Petitioner’s first and second allegations of misrepresentation and false statements. *Id.* at 3–5. Patent Owner states that the Rebuttal Declarations, referring to additional facts not now in the record, are necessary to rebut these allegations. *Id.*

Because Petitioner’s Reply alleges that Patent Owner’s Original Declarations contain false statements and misrepresentations, under the particular facts and circumstances presented here, I would permit Patent Owner to submit, with its sur-reply, declarations and evidence to rebut these allegations. Otherwise, Patent Owner and the declarants would have no opportunity to rebut Petitioner’s allegations of false statements and misrepresentations.

Having reviewed the Rebuttal Declarations, I do not believe that further depositions of the declarants regarding their Rebuttal Declarations is

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necessary. The Rebuttal Declarations and the evidence of record appear to contain sufficient information to allow the panel to evaluate the veracity of statements made in the inventors' Original Declarations without further discovery or cross examination.

Thus, based on the particular circumstances presented, I would permit Patent Owner to submit the Rebuttal Declarations with its sur-reply and would not permit any further discovery or briefing.

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