21-1371 and 21-1372

United States Court of Appeals for the Federal Circuit

WESTERN PLASTICS, INC.,

Plaintiff-Cross-Appellant,

– v. –

DUBOSE STRAPPING, INC.,

Defendant-Appellee.

On Appeal from the United States District Court for the Eastern District of North Carolina in No. 5:15-CV-00294, Honorable James C. Dever, Judge

PLAINTIFF-CROSS-APPELLANT'S RESPONSE TO DEFENDANT-APPELLEE'S PETITION FOR REHEARING *EN BANC*

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FEBRUARY 15, 2022

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

CERTIFICATE OF INTEREST

Case Number 21-1371; 21-1372

Short Case Caption Western Plastics, Inc. v. DuBose Strapping, Inc.

Filing Party/Entity WESTERN PLASTICS, INC.

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TABLE OF CONTENTS

Certificate Of Interest i

Summary of Argument 1

Argument 2

I. Standard for Rehearing *En Banc* and Panel Rehearing 2

II. DuBose's Request for Rehearing *En Banc* or by a New Panel Due to Alleged Violation of 28 U.S.C. § 455(b)(5)(iv) Is Meritless 3

A. Judge Stoll Was Not Required to Recuse Herself Under 28 U.S.C. § 455(b)(5)(iv) 3

B. Neither a Rehearing Nor a Rehearing *En banc* Would Be Appropriate, Even Had There Been a Violation of 28 U.S.C. § 455(b)(5)(iv) 7

III. DuBose's Request for a Rehearing or Rehearing *En banc* on Invalidity, Lost Profits and Inequitable Conduct Is Meritless 9

A. Federal Circuit Rule 36 Does Not Violate Due Process 9

B. The District Court Identified the Bases for Its Opinions 10

C. The Court's Rule 36 Affirmance Is Supported 11

IV. Request for Sanctions 14

Conclusion 16

Certificate of Compliance 17

TABLE OF AUTHORITIES

Page(s)

Cases

Hodosh v. Block Drug Co., Inc.,
790 F.2d 880 (Fed. Cir. 1986) 8, 9, 15

Innovation Sciences, LLC v. Amazon.com, Inc.,
842 Fed.Appx. 555 (Fed. Cir. 2021).....10, 15

Kolon Industries Inc. v. E.I. DuPont de Nemours & Co.,
748 F.3d 160 (4th Cir. 2014) 8

Liljeberg v. Health Services Acquisition Corp.,
486 U.S. 847 (1988).....7, 15

Maier v. Orr,
758 F.2d 1578 (Fed. Cir. 1985) 8, 9, 15

Pentex Corp. v. Robinson,
135 F.3d 760 (Fed. Cir. 1998) 3

Phil-Insul Corp. v. Airlite Plastics Co.,
854 F.3d 1344 (Fed. Cir. 2017) 10, 15

Taylor v. McKeithen,
407 U.S. 191 (1972).....9, 15

Statutes

28 U.S.C. 455.....7

28 U.S.C. § 455.....8, 15

28 U.S.C. § 455(b)(5)(iv).....*passim*

Other Authorities

Fed. R. App. P. 40(a)(2).....1, 2, 3

Fed. R. Civ. P. 36(a).....11

Federal Rule of Appellate Procedure 35(a) 2, 3, 7, 14

Parties' *Daubert* 5

Rule 26 .....4, 6

Rule 32(g)(1), I 17

Rule 35(a)(2) 1, 2, 14

Rule 36 .....*passim*

Rule 36(a)(2) 12

Rule 36(a)(3) 13

Rule 50 10

U.S. Patent and Trademark Office. Appx120, Dkt. 126 5

SUMMARY OF ARGUMENT

The Court should deny DuBose's motion for rehearing *en banc* because DuBose has not demonstrated that consideration of any of the issues raised in the motion are "necessary to secure or maintain uniformity of the court's decisions" or "involve[] a question of exceptional importance," as required by Federal Circuit Rule 35(a)(2) and Fed. R. App. P. 35(a)(2). To the extent Dubose's motion also seeks a panel rehearing, Dubose has not an issue of fact or law that the Court "overlooked or misapprehended," as required by Fed. R. App. P. 40(a)(2).

DuBose's challenge to Judge Stoll under 28 U.S.C. § 455(b)(5)(iv) is premised on a blatant falsehood. Robert Stoll was not a "likely material witness in the proceeding" at any time when this case was before Judge Stoll. Western Plastics ("WP") hired Mr. Stoll in 2016 to offer rebuttal opinions on the narrow issue of materiality in response to the opinions offered by DuBose's expert on inequitable conduct. Mr. Stoll submitted an expert report on materiality and DuBose deposed him. Mr. Stoll did not submit any declarations or affidavits to the Court. He did not testify at trial. His name did not appear in either Party's pre-trial dispositive motions, pre-trial witness lists, post-trial motions, or appellate briefs. The reason for that is simple. The district court dismissed DuBose's inequitable conduct defense and counterclaim at the summary judgment stage on the sole ground that DuBose presented insufficient evidence of deceptive intent by the patent owner. That

decision, which was based on the prong of inequitable conduct that Stoll's opinions did not address, rendered Stoll's opinions on materiality going forward superfluous. Robert Stoll therefore had nothing to do with any issue considered by this Court, and he certainly was not a "material witness in the proceeding," as required by § 455(b)(5)(iv).

The rest of DuBose's motion is nothing more than a re-hash of the same arguments on the merits concerning validity, lost profits and inequitable conduct that it already presented to the jury, the District Court and this Court on appeal. DuBose has made no effort to justify its request for a rehearing *en banc* against the Rule 35(a)(2) or Rule 40(a)(2) criteria. In short, the jury came out against DuBose based on substantial evidence presented at trial, and DuBose has ever since tried to nullify the jury verdict by ignoring it and the evidence supporting it. DuBose took that approach on post-trial motions, its appellate briefing, and now in this motion. A rehearing *en banc* is not a vehicle for starting from scratch and arguing a case afresh, as DuBose seeks to do.

ARGUMENT

I. Standard for Rehearing *En Banc* and Panel Rehearing

Federal Circuit Rule 35(a)(2) states that "[a] petition for hearing or rehearing *en banc* that does not meet the standards of Federal Rule of Appellate Procedure

35(a) may be deemed frivolous and sanctions may be imposed." In turn, Federal Rule of Appellate Procedure 35(a) states:

> [a]n *en banc* hearing or rehearing is not favored and ordinarily will not be ordered unless:
>
> (1) *en banc* consideration is necessary to secure or maintain uniformity of the court's decisions; or
>
> (2) the proceeding involves a question of exceptional importance.

As for a panel rehearing, Fed. R. App. P. 40(a)(2) requires the petitioner to "state with particularity the points of law or fact which in the opinion of the petitioner the court has overlooked or misapprehended." *Pentex Corp. v. Robinson*, 135 F.3d 760, 762 (Fed. Cir. 1998), citing Fed. R. App. P. 40(a).

DuBose has not satisfied either set of criteria.

II. DuBose's Request for Rehearing *En Banc* or by a New Panel Due to Alleged Violation of 28 U.S.C. § 455(b)(5)(iv) Is Meritless

A. Judge Stoll Was Not Required to Recuse Herself Under 28 U.S.C. § 455(b)(5)(iv)

28 U.S.C. § 455(b)(5)(iv) states that a judge shall disqualify herself where "[S]he or [her] spouse, or a person within the third degree of relationship to either of them, or the spouse of such a person…is to the judge's knowledge likely to be a material witness in the proceeding." *Id.* (emphasis added). Here, Robert Stoll was not a "likely material witness in the proceeding" at any time when this case was before Judge Stoll.

1. Robert Stoll Was Not a "Material Witness in the Proceeding"

Mr. Stoll was not a "material witness," either in the district court proceedings or the proceedings before this Court. In fact, the prospect of Mr. Stoll being a witness evaporated when the district court dismissed DuBose's inequitable conduct charges on grounds unrelated to his opinions. Mr. Stoll's sole involvement was as a *potential* rebuttal expert witness who issued a Rule 26 expert report on the materiality prong of DuBose's inequitable conduct defense. Mr. Stoll did not opine on the intent prong. Dubose deposed him on his report. But Mr. Stoll neither testified at trial nor offered any declarations or affidavits in pre-trial pleadings, including the Parties' summary judgment pleadings. None of his deposition testimony was filed with the District Court. Mr. Stoll's name does not appear in either Party's appellate briefs.

DuBose's assertion that Mr. Stoll was a "material witness" is disingenuous. DuBose's claims that Mr. Stoll "did testify on an issue appealed to this Court" (Petition for Rehearing En Banc, DN44, Pg.13) and that Mr. Stoll "opined in favor of the Appellee on an issue before the panel" (*Id.*, Pg. 8) are blatant falsehoods. DuBose has not identified any such testimony because there is none. Instead, DuBose falsely implies Mr. Stoll testified by stating "Mr. Stoll was identified in the trial court's summary judgment opinion and in numerous docket entries. [Appx84, Appx113-114; Appx116; Appx119-120; Appx128.]" *Id.* That statement is

technically true, but shamelessly misleading. Mr. Stoll's name appears once in the District Court's omnibus Order dispensing with multiple cross-motions for summary judgment and *Daubert* motions, where the District Court merely acknowledged the fact that DuBose had filed a *Daubert* motion against Mr. Stoll: "DuBose also filed two motions in limine and supporting memoranda to exclude and limit testimony from Robert Stoll and Christopher Schulte." Appx84 (citations omitted). The District Court did not actually decide the motion against Mr. Stoll, though, because it was resolved two years earlier by stipulation of the Parties.[1] Appx120, Dkt. 126. The purported "numerous docket entries" in which Mr. Stoll's name appears all relate to either: (i) the Parties' *Daubert* pleadings (See Appx113-114, Dkt. 55, 56, 65, 71; Appx116, Dkt. 89; Appx119-120, Dkt. 116, 125), or (ii) WP's post-trial motion for bill of costs (See Appx128, Dkt. 237), none of which make Mr. Stoll a "material witness in the proceeding."

[1] The stipulation, which included the resolution of multiple expert evidentiary issues, provided that any testimony offered by DuBose's expert, Art MacCord, and Mr. Stoll (as a potential rebuttal witness at the time of the stipulation) would be limited to a factual description of the prosecution history of the patent-in-suit and general policy, practice, and procedure before the U.S. Patent and Trademark Office. Appx120, Dkt. 126.

Judge Stoll was not required to recuse herself under 28 U.S.C. § 455(b)(5)(iv) because Robert Stoll was not a testifying witness, let alone a "material witness in the proceeding."[2]

2. DuBose Does Not Allege That Judge Stoll Had "Knowledge" That Robert Stoll Was a "Material Witness"

Further, 28 U.S.C. § 455(b)(5)(iv) would apply here only if Judge Stoll had actual "knowledge" that Robert Stoll was a "material witness." DuBose has not alleged that she did. To the contrary, there is no reason to believe Judge Stoll even knew that Robert Stoll had at one time been a *potential* expert witness in the case. Indeed, DuBose chose not to raise this issue until after the Court issued its decision. And even if Judge Stoll had known that Robert Stoll had been a potential expert witness at some point, §455(b)(5)(iv) still does not apply because Mr. Stoll's role in this case ended with the dismissal of DuBose's inequitable conduct allegations. As a result, Robert Stoll did not end up being a "material witness in this proceeding." Dubose has not offered any evidence to the contrary.

[2] DuBose also unabashedly misleads this Court as to the *content* of Mr. Stoll's Rule 26 expert report. DuBose states that Mr. Stoll "was WP's expert witness on the issue of inequitable conduct, an issue DuBose asked this Court to review." Petition for Rehearing En Banc, DN44, Pg.13 (emphasis added). In fact, Mr. Stoll's expert report was directed *only* to the "materiality" prong of DuBose's inequitable conduct defense. Mr. Stoll did not opine on the "specific intent" prong, which was the basis on which the District Court dismissed DuBose's inequitable conduct defense. Appx79. Therefore, contrary to DuBose's claim, Mr. Stoll never offered an opinion on the "issue DuBose asked this Court to review."

B. Neither a Rehearing Nor a Rehearing *En banc* Would Be Appropriate, Even Had There Been a Violation of 28 U.S.C. § 455(b)(5)(iv)

Even if Judge Stoll had been required to recuse herself under 28 U.S.C. § 455(b)(5)(iv) (which she was not), DuBose's request for a rehearing or rehearing *en banc* is meritless. First, DuBose neither asserts nor makes any attempt to explain *why* an *en banc* review is "necessary to secure or maintain uniformity of the court's decisions" or that the proceeding "involves a question of exceptional importance" under Fed. R. App. P. 35(a). In fact, neither basis for a rehearing *en banc* is met.

Second, a violation of 28 U.S.C. 455 does not necessitate vacating the judgement and granting a rehearing. *Liljeberg v. Health Services Acquisition Corp.*, 486 U.S. 847 (1988). Instead, the Court must consider three factors in assessing whether vacating a judgment is the appropriate remedy:

> Although § 455 defines the circumstances that mandate disqualification of federal judges, it neither prescribes nor prohibits any particular remedy for a violation of that duty. Congress has wisely delegated to the judiciary the task of fashioning the remedies that will best serve the purpose of the legislation…We conclude that in determining whether a judgment should be vacated for a violation of § 455, **it is appropriate to consider the risk of injustice to the parties in the particular case, the risk that denial of relief will produce injustice in other cases, and the risk of undermining the public's confidence in the judicial process.**

Id. at 864 (emphasis added). Here, DuBose has made no showing concerning the risks (i) of injustice to the parties, (ii) that denial of relief will produce injustice in

other cases, or (iii) of undermining the public's confidence in the judicial process. In fact, there is no risk to future cases or to the public's confidence in the judicial process. The only risk here would be the injustice to WP if this Court's Judgement were vacated. Such a result would reward DuBose's strategic tactic of waiting until *after* the Court issued its judgment, instead of immediately after the hearing, to raise the issue, effectively using it as a "backup strategy." *See Kolon Industries Inc. v. E.I. DuPont de Nemours & Co.*, 748 F.3d 160, 170 (4th Cir. 2014) ("[W]e should not ignore the harm that would ensue if litigants were permitted to treat motions for recusal as little more than a stratagem.").

Third, DuBose ignores the clear holdings of this Court that a rehearing is not an appropriate remedy where, as it would be here, a violation of 28 U.S.C. § 455 is discovered after a unanimous judgment has been issued:

> That part of the motion requesting a rehearing is equally devoid of merit…If recusal had been appropriate here (and it was not), that fact would not form a basis for attack on the decision."

Maier v. Orr, 758 F.2d 1578, 1583 (Fed. Cir. 1985); *see also Hodosh v. Block Drug Co., Inc.*, 790 F.2d 880, 881 (Fed. Cir. 1986) ("Moreover, if there had been a basis for Judge rich's disqualification (and there was none), that fact would not warrant the vacating of the decision."), citing Advisory Opinion 71, Advisory Committee on Codes of Conduct, Judicial Conference of the United States (December 14, 1981). As pointed out in *Maier*, "If recusal had occurred, the two Circuit Judges who served

on the original panel would have been at liberty to decide the appeal. If rehearing were now granted, those judges would decide the appeal the same way and would approve the opinion as issued." *Id.* at 1583; *see also Hodosh*, 790 F.2d at 881-882 ("Block makes no reference to *Maier* and cites no authority for its erroneous assumption that a unanimous decision must be vacated when one member of the panel learns of a basis for his disqualification after the decision has been handed down.").

Therefore, even if Judge Stoll's recusal were required, which it was not, this Court's Judgement would remain unchanged because it was unanimous, and the decisions of Judge Newman and Judge Hughes would stand. Consequently, a rehearing would not be justified.

III. DuBose's Request for a Rehearing or Rehearing *En banc* on Invalidity, Lost Profits and Inequitable Conduct Is Meritless

A. Federal Circuit Rule 36 Does Not Violate Due Process

DuBose's challenge to the constitutionality of Rule 36 affirmances, i.e., "violate due process," is directly contrary to the Supreme Court's opinion almost 50 years ago that summary affirmances are valid and final judgments of the Court. *See Taylor v. McKeithen*, 407 U.S. 191, 194 n.4 (1972) ("We, of course, agree that the courts of appeals should have wide latitude in their decision of whether or how to write opinions. That is especially true with respect to summary affirmances.").

Moreover, this Court has explained on several occasions that "[a]ppeals whose judgments are entered under Rule 36 receive the full consideration of the court, and are no less carefully decided than the cases in which we issue full opinions." *Phil-Insul Corp. v. Airlite Plastics Co.*, 854 F.3d 1344, 1354 (Fed. Cir. 2017); *see also Innovation Sciences, LLC v. Amazon.com, Inc.*, 842 Fed.Appx. 555, 558 (Fed. Cir. 2021) (unpublished). "[A] Rule 36 judgment simply confirms that the trial court entered the correct judgment." *Phil-Insul,* 854 F.3d at 1355.

B. The District Court Identified the Bases for Its Opinions

Aside from the complete lack of legal support for its position, DuBose is also wrong on its premise that neither the District Court nor this Court "has put pen to paper to tell DuBose *why* its invalidity, lost profits and inequitable conduct claims have, or not have, merit." (Petition for Rehearing En Banc, DN44, Pg. 12). To the contrary, the District Court clearly stated that it denied DuBose's Rule 50 motion for judgment as a matter of law on validity and lost profits because the jury's factual determinations were supported by "substantial evidence" and "for the reasons stated in WP's comprehensive response in opposition":

> In this court's extensive summary judgment order, the court analyzed many of the same legal argument that DuBose renews. See [D.E. 140]. The court left several issues for the jury. **In turn, the jury answered these issues based on substantial evidence.** See [D.E. 219] 1-3. Having considered DuBose's motion for judgment as a matter of law and renewed motion for directed verdict under the applicable standard, **the court denies the**

> **motion for the reasons stated in WP's comprehensive response in opposition.** See [D.E.256].

Appx26 (emphasis added). On appeal, this Court reviewed the District Court's decision *de novo*, re-evaluating on its own the jury's verdict against the same evidence identified by WP as supporting the verdict. This Court concluded, just as the District Court had, that the jury's factual determinations were supported by substantial evidence.

As for DuBose's inequitable conduct defense, the District Court explained that its basis for granting summary judgment was that DuBose failed to offer evidence that would support an inference of specific intent to deceive the USPTO:

> Viewing the evidence in the light most favorable to DuBose, DuBose has not shown that WP acted with the specific intent to deceive by clear and convincing evidence. **DuBose has failed to show that the most reasonable inference that may be drawn from WP's conduct is that WP intended to deceive the PTO.** Even if the information that WP misrepresented or omitted was material, without a showing by clear and convincing evidence that WP specifically intended to deceive the PTO, there remains no genuine issue of material fact for trial.

Appx79 (emphases added). This Court concluded the same after a *de novo* review.

C. The Court's Rule 36 Affirmance Is Supported

Fed. R. Civ. P. 36(a) provides:

> The Court may enter a judgment of affirmance without an opinion, citing this rule, when it determines that any of the following conditions exist and an opinion would have no precedential value:

> (1) the judgment, decision, or order of the trial court appealed from is based on findings that are not clearly erroneous;
>
> (2) the evidence supporting the jury's verdict is sufficient;
>
> (3) the record supports summary judgment, directed verdict, or judgment on the pleadings;
>
> (4) the decision of an administrative agency warrants affirmance under the standard of review in the statute authorizing the petition for review; or
>
> (5) a judgment or decision has been entered without an error of law.

Each of the issues of validity, lost profits and inequitable conduct were properly resolved by this Court with a Rule 36 affirmance.

1. Validity and Lost Profits

This Court's summary affirmance of validity and lost profits was proper under Rule 36(a)(2) because "the evidence supporting the jury's verdict is sufficient," as both the District Court and this Court determined.[3] As in its appellate briefs, DuBose has not challenged the sufficiency of WP's evidence on either validity or lost profits, but instead points to purportedly countervailing evidence that it says should have persuaded the jury to find in its favor. But the jury weighed all the evidence, resolved the issues of fact, and gave its verdict. On appeal, and now here in this motion, DuBose has sought to nullify the jury verdict as if it never happened.

[3] WP relies on its appellate briefing for the detailed showing of the evidence that supported the jury's verdict. See, WP Corrected Opening Brief, DN 21, Pgs.23-59.

DuBose simply wants to relitigate the same facts, which is not a basis for a rehearing or rehearing *en banc*.

2. Inequitable Conduct

DuBose's inequitable conduct defense was dismissed on summary judgment because the District Court concluded DuBose failed to offer evidence from which a reasonable jury could infer specific intent to deceive the USPTO. Appx79. This Court reviewed the District Court's decision *de novo* and came to the same conclusion. This Court's summary affirmance was proper under Rule 36(a)(3) because "the record supports summary judgment, directed verdict or judgment on the pleadings."

Without reference to the criteria for granting a rehearing or rehearing *en banc*, DuBose simply repeats the same arguments on the merits it already presented to the District Court and to this Court on appeal. Accordingly, WP relies on its appellate briefing in opposition to such arguments. See, WP Corrected Opening Brief, DN21, Pgs.68-77. In short, DuBose relied on two alleged "misrepresentations" in its summary judgment briefing: (i) Clarke offered his opinion that ITW's 6G prior art product was an "apparent commercial failure" in a declaration submitted to the USPTO, and (ii) Clarke did not disclose Shirrell's May 2, 2006 letter, though he did disclose all possible prior art references identified therein. DuBose failed to offer any evidence that Clarke misrepresented his opinion concerning ITW's 6G product

or that he intended to deceive the USPTO by not submitting Shirrell's actual letter when he disclosed the prior art that was referenced therein.[4] The rest of DuBose's narrative about the prosecution history of WP's patent (Petition for Rehearing En Banc, DN44, Pgs.19-23) is irrelevant because DuBose did not argue any of those points on summary judgment.[5] See, WP Corrected Opening Brief, DN21, Pg.73 (discussing forfeiture).

DuBose simply wants a different result on the facts of this particular case, which does not justify a rehearing *en banc*.

IV. Request for Sanctions

Federal Circuit Rule 35(a)(2) provides that "[a] petition for hearing or rehearing *en banc* that does not meet the standards of Federal Rule of Appellate Procedure 35(a) may be deemed frivolous and sanctions may be imposed." (emphasis added). WP respectfully requests that sanctions be awarded here. The purported bases for a rehearing *en banc* are exceptionally weak, and, in multiple instances, are based on misrepresentations.

[4] Nor did DuBose present evidence that either of Clarke's opinion that ITW's 6G product was an "apparent commercial failure" and Shirrell's opinion commentary about the 5G-Tamanet prototype (determined not to be prior art) were material to patentability.

[5] They are also meritless. See, WP Corrected Opening Brief, DN21, Pgs.74-77.

First, DuBose has made no attempt to apply the criteria set forth in Federal Circuit Rule 35(a) to any of the issues raised in its motion to justify a rehearing *en banc*.

Second, DuBose blatantly misrepresented that Mr. Stoll "did testify on an issue appealed to this Court" (Petition for Rehearing En Banc, DN44, Pg.13) and that Mr. Stoll "opined in favor of the Appellee on an issue before the panel" (*Id.* at Pg. 8) to falsely imply that he was a "material witness in this proceeding" and feign a basis for recusal under 28 U.S.C. § 455.

Third, DuBose ignored the framework of *Liljeberg v. Health Services Acquisition Corp.*, 486 U.S. 847 (1988) to assess whether a rehearing would be an appropriate remedy in the event of a § 455 violation.

Fourth, DuBose ignored controlling precedent of this Court that even if disqualification under § 455 was required, vacating the judgment is not the appropriate remedy after a unanimous decision has already been issued, as it was here. *See*, *Maier*, 758 F.2d at 1583; *Hodosh*, 790 F.2d at 881.

Fifth, DuBose challenged the constitutionality of Federal Circuit Rule 36 (violates due process) without acknowledging that the Supreme Court and this Court have repeatedly upheld the practice of summary affirmances. *See*, *Taylor*, 407 U.S. at 194 n.4 (1972); *Phil-Insul*, 854 F.3d at 1354; *Innovation Sciences*, 842 Fed.Appx. at 558.

Sixth, DuBose premised, in part, its request for rehearing *en banc* on the issues of invalidity and inequitable conduct on the blatantly false representation that the 5G-TamaNet wrap qualifies as prior art: WP's '304 patent "claimed the identical prior art 5G-TamaNet wrap" (DN44, Pg.10); *See also Id.* at Pg.11 ("…the prior art 5G-TamaNet wrap."). In fact, the jury rejected the 5G-TamaNet wrap as qualifying "prior art" (Appx1005), a finding to which DuBose conceded by not appealing it. Yet, DuBose persists here that Clarke intended to deceive the USPTO because, though he disclosed the 5G-TamaNet prototype itself (which the jury determined did not even qualify as prior art), he did not also submit Shirrell's opinion commentary about it. This is a truly frivolous argument.

CONCLUSION

For the reasons set forth above, WP respectfully requests that the Court deny DuBose's motion and award WP its attorneys' fees incurred to respond to this motion under 35(a)(2).

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Dated: February 15, 2022

FORM 19. Certificate of Compliance with Type-Volume Limitations **Form 19**
July 2020

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

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