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13 *CertainTeed Gypsum, Inc.*

14  
15 UNITED STATES DISTRICT COURT  
16 FOR THE NORTHERN DISTRICT OF CALIFORNIA  
17 SAN JOSE DIVISION JUDICIAL DISTRICT

18 CERTAINTEED GYPSUM, INC.,

19 Plaintiff,

20 v.

21 PACIFIC COAST BUILDING PRODUCTS,  
22 INC. AND PABCO BUILDING  
23 PRODUCTS, LLC,

24 Defendants.

CASE NO. 5:19-cv-00802-LHK

**PLAINTIFF'S FIRST AMENDED  
COMPLAINT FOR DECLARATORY  
JUDGMENT**

1 Plaintiff CertainTeed Gypsum, Inc. (“CertainTeed”) brings this action against Pacific  
2 Coast Building Products, Inc. (“Pacific Coast”) and PABCO Building Products, LLC  
3 (“PABCO”) (collectively, “Defendants”) for a declaratory judgment of patent unenforceability  
4 and noninfringement.

### 5 INTRODUCTION

6 1. The patents-in-suit are U.S. Patent No. 10,125,492 (the “’492 patent”) and U.S.  
7 Patent No. 10,132,076 (the “’076 patent”). Both patents are children of U.S. Patent No.  
8 9,388,568 (the “’568 patent”). The ’492 patent is a continuation of the ’568 patent, and the ’076  
9 patent is a divisional of the ’568 patent.

10 2. The claims of the ’492 and ’076 patents are similar to the claims of the ’568  
11 patent. For example, claim 21 of the ’568 patent, claims 7-8 of the ’492 patent, and claims 7-8  
12 of the ’076 patent all include limitations that explicitly refer to the “scored flexural strength” of a  
13 laminated building structure. By way of further example, claim 21 of the ’568 patent, claims 1-4  
14 of the ’492 patent, and claims 1-4 of the ’076 patent are directed to a laminated structure of two  
15 gypsum boards glued together, in which the entire inner surface of both gypsum boards is  
16 unclad.

17 3. Pacific Coast twice sued CertainTeed in this District for alleged infringement of  
18 the ’568 patent, including specifically claim 21. *See Pac. Coast Bldg. Prods., Inc. v.*  
19 *CertainTeed Corp.*, Nos. 5:17-cv-0116-LHK (N.D. Cal.) (the “2017 N.D. Cal. Action”) and  
20 5:18-cv-00346-LHK (N.D. Cal.) (the “2018 N.D. Cal. Action”). In the 2018 N.D. Cal. Action,  
21 CertainTeed provided Pacific Coast with extensive information demonstrating the invalidity of  
22 claim 21 of the ’568 patent based on, among other things, the indefiniteness of “scored flexural  
23 strength” claim limitations and prior art references such as Unexamined Japanese Patent  
24 Application Publication No. 2004-42557 (A) (“Hirata”). For example, CertainTeed provided a  
25 44-page declaration of Dr. Paul Miller (the “Miller Declaration”), which was supported by  
26 testing and explained multiple reasons why the claim terms are indefinite. This Court  
27 determined that the “scored flexural strength” terms in claim 21 of the ’568 patent are indefinite,  
28 relying significantly on the Miller Declaration. 2018 WL 6268880 (N.D. Cal. Nov. 29, 2018).

1 The U.S. Court of Appeals for the Federal Circuit affirmed, also relying on the Miller  
2 Declaration. 816 F. App'x 454 (Fed. Cir. June 30, 2020).

3 4. Between this Court's indefiniteness ruling and the Federal Circuit's affirmance,  
4 Pacific Coast fled this forum and filed a third lawsuit against CertainTeed Gypsum  
5 Manufacturing, Inc. in the Western District of Arkansas. *See Pac. Coast Bldg. Prods., Inc. v.*  
6 *CertainTeed Gypsum Mfg., Inc.*, No. 4:18-cv-04165-SOH (W.D. Ark.) (the "Arkansas Action").  
7 Pacific Coast's complaint alleged that the same SilentFX QuickCut product now infringes the  
8 '492 and '076 patents. Pacific Coast added PABCO as a co-plaintiff after unsuccessfully trying  
9 to do so in the 2018 N.D. Cal. Action. This Court denied Pacific Coast's prior request, stating  
10 "Two years, the litigation, and you still don't have the right party for your lost profits theory.  
11 Undue delay. It's not coming in." Hr'g Tr. 49:9-52:5, Dkt. No. 105, 2018 N.D. Cal. Action.  
12 Pacific Coast and PABCO have no apparent or alleged connection to the Western District of  
13 Arkansas, whereas both have places of business in California—such as a PABCO gypsum  
14 wallboard manufacturing facility in this District in Newark, California. On August 27, 2019, the  
15 court stayed and administratively terminated the Arkansas Action pending resolution of this case.  
16 Dkt. No. 60, *Arkansas Action* (2019 WL 4046550 (W.D. Ark. Aug. 27, 2019)); *see also* Dkt. No.  
17 49, Ex. A, 5:19cv802-LHK (copy of same filed in current action). In doing so, the court  
18 recognized that Pacific Coast's filing of the Arkansas Action, brought "[l]ess than two weeks  
19 after [this Court's indefiniteness] ruling" in the 2018 N.D. Cal. Action, "suggest[ed] an effort to  
20 avoid adverse rulings in the Northern District of California and remedy past mistakes in a new  
21 forum." *Id.* at 12.

22 5. Pacific Coast prosecuted the '492 and '076 patents concurrently with the 2017  
23 and 2018 N.D. Cal. Actions. The '492 patent issued on November 13, 2018 from an application  
24 filed on March 1, 2013; and the '076 patent issued on November 20, 2018 from an application  
25 filed on March 1, 2013. Pacific Coast initiated the 2017 N.D. Cal. Action by filing a complaint  
26 on March 3, 2017; and received invalidity contentions demonstrating the invalidity of claim 21  
27 of the '568 patent based on Hirata on August 30, 2017. Pacific Coast initiated the 2018 N.D.  
28 Cal. Action by filing a complaint on January 16, 2018; received invalidity contentions

1 demonstrating the invalidity of claim 21 of the '568 patent based on Hirata on June 18, 2018; and  
2 received the Miller Declaration on August 17, 2018.

3 6. The same outside counsel represented Pacific Coast in prosecution of the '492 and  
4 '076 patents and in the 2018 N.D. Cal. Action—i.e., the law firm Sheppard, Mullin, Richter &  
5 Hampton LLP (“Sheppard Mullin”) and specifically attorneys Jason Mueller and Galyn Gafford.

6 7. Pacific Coast’s counsel—including at least Jason Mueller and Galyn Gafford—  
7 had a duty to disclose material information to the Patent Office during and in connection with  
8 prosecution of the '492 and '076 patents.

9 8. In prosecuting these patents before the Patent Office, Pacific Coast (through its  
10 counsel Jason Mueller and Galyn Gafford) withheld information and made misrepresentations  
11 that were material to the patentability of claims in the '492 and '076 patents.

12 9. For example, Pacific Coast failed to disclose to the Patent Office the existence of  
13 the litigation in this District, information that this Court relied on in holding that the “scored  
14 flexural strength” terms are indefinite (such as the Miller Declaration), and CertainTeed’s  
15 invalidity contentions demonstrating invalidity based on the Hirata prior art reference.

16 10. By way of further example, on May 22, 2018, Pacific Coast, and specifically  
17 Galyn Gafford, represented to the Patent Trial and Appeal Board that removal of the paper from  
18 the inner surfaces of the gypsum boards is “what distinguishes [the then-pending claims in the  
19 applications that issued as the '492 and '076 patents] from the prior art and I don’t think, and I  
20 still haven’t seen any prior art that shows these laminated panels made without the interior  
21 paper.” *See* Record of Oral Hr’g at 6, *Ex parte Brandon D. Tinianov*, Appeal Nos. 2016-03810,  
22 2016-03995 (PTAB May 22, 2018). But before this statement to the Patent Office, on April 12,  
23 2018, Galyn Gafford represented in the 2018 N.D. Cal. Action: “Hirata only discloses gluing  
24 two of boards together to increase the strength of the board without face paper because otherwise  
25 the strength would be inadequate to be used in a traditional manner and discloses that the boards  
26 could be glued in other configurations (paper-to-paper or paper-to-exposed) to achieve same  
27 results.”

28

1 11. Pacific Coast’s statement, made by Galyn Gafford, to the Patent Trial and Appeal  
2 Board that it “ha[d]n’t seen any prior art that shows these laminated panels made *without the*  
3 *interior paper*,” directly contradicts its earlier statement in its interrogatory responses, signed by  
4 Galyn Gafford, that “Hirata only discloses gluing two of the boards together ... *without face*  
5 *paper*.” (emphasis added).

6 12. Separately, the SilentFX QuickCut product does not infringe the ’492 and ’076  
7 patents at least for one of the same reasons that it did not infringe claim 21 of the ’568 patent—  
8 as a result of the manufacturing process used to create SilentFX QuickCut products, there is  
9 paper cladding on the inner surface of the gypsum cores.

10 13. Pacific Coast’s inequitable conduct and CertainTeed’s noninfringement  
11 arguments are inextricably intertwined with the 2017 and 2018 N.D. Cal. Actions and renders the  
12 ’492 and ’076 patents unenforceable and not infringed.

13 **NATURE OF THE ACTION**

14 14. This action arises under the patent laws of the United States, 35 U.S.C. § 100 *et*  
15 *seq.*, and the Declaratory Judgment Act, 28 U.S.C. §§ 2201-2202.

16 **THE PARTIES**

17 15. Plaintiff CertainTeed is a corporation organized and existing under the laws of  
18 Delaware with its corporate headquarters at 20 Moores Road, Malvern, PA 19355.

19 16. On information and belief, Defendant Pacific Coast is a corporation organized  
20 under the laws of California with a principal place of business at 10600 White Rock Road,  
21 Building B, Suite 100, Rancho Cordova, CA 95670.

22 17. On information and belief, Defendant PABCO is a limited liability company  
23 organized under the laws of Nevada with a principal place of business at 10600 White Rock  
24 Road, Building A, Suite 150, Rancho Cordova, CA 95670.

25 18. On information and belief, Defendant Pacific Coast is the owner of the ’492  
26 patent (a true and correct copy of which is attached as Exhibit A) and the ’076 patent (a true and  
27 correct copy of which is attached as Exhibit B).

28





1 about how a flexural strength test is to be performed,” quoting the ’568 patent at 2:45-54.  
2 Pacific Coast, and specifically Mr. Mueller, also admitted that if CertainTeed’s SilentFX  
3 QuickCut “product has some paper cladding on the inner surfaces of the gypsum cores[], then the  
4 product may not literally infringe the claim of the ’568 patent.” *See* Dkt. Nos. 121-1 and 121-3  
5 (Ex. B), 2018 N.D. Cal. Action. On August 18, 2017, CertainTeed filed a First Amended  
6 Answer, Defenses, and Counterclaims in the 2017 N.D. Cal. Action. *See* Dkt. No. 56, 2017 N.D.  
7 Cal. Action. CertainTeed again pled that the ’568 patent claims are invalid because the “scored  
8 flexural strength” terms in those claims were indefinite. CertainTeed also pled, on a limitation-  
9 by-limitation basis, that at least claim 21 of the ’568 patent is invalid for anticipation and/or  
10 obviousness based on Hirata. *See id.*

11 36. On August 30, 2017, CertainTeed served invalidity contentions on Pacific Coast,  
12 which again explained that the “scored flexural strength” terms are indefinite. *See* Dkt. Nos.  
13 121-1 and 121-4 (Ex. C), 2018 N.D. Cal. Action. These invalidity contentions also explained, on  
14 a limitation-by-limitation basis, that claim 21 of the ’568 patent is invalid for anticipation and/or  
15 obviousness based on Hirata.

16 37. On September 12, 2017, Pacific Coast and CertainTeed held a meeting with in-  
17 house counsel, outside counsel, and business representatives, during which CertainTeed again  
18 explained why the “scored flexural strength” terms in claim 21 of the ’568 patent are indefinite.  
19 *See* Dkt. Nos. 121-1 and 121-5 (Ex. D), 2018 N.D. Cal. Action. Attendees on behalf of Pacific  
20 Coast at this meeting included Jason Mueller (outside counsel), Daniel Yanagihara (in-house  
21 counsel), and Ryan Lucchetti (business representative).

22 38. CertainTeed’s presentation at the September 12, 2017 meeting compared the  
23 “scored flexural strength” recited in claim 21 of the ’568 patent with Pacific Coast’s argument in  
24 its August 18, 2017 letter (signed by Jason Mueller) that the ’568 patent describes “how a  
25 flexural strength test is to be performed” and stated that the standard recited in the ’568 patent  
26 “does not describe anything about how to test ‘scored flexural strength.’” Dkt. Nos. 121-1 and  
27 121-5 (Ex. D) at 17, 19, 2018 N.D. Cal. Action. CertainTeed’s presentation also explained again  
28 that SilentFX QuickCut products do not literally infringe claim 21 of the ’568 patent because



1 they have paper on the inner surfaces of their gypsum panels. Further, it explained that SilentFX  
2 QuickCut products do not infringe under the doctrine of equivalents because prosecution history  
3 estoppel bars application of the doctrine since Pacific Coast amended its claims to require that  
4 “the entire inner surface of the [first/second] gypsum board is unclad” for a substantial reason  
5 relating to patentability. *Id.* at 21-24.

6 39. Less than one month after this meeting, on October 3, 2017, Pacific Coast  
7 dismissed its claims and CertainTeed, in turn, dismissed its counterclaims without prejudice in  
8 the 2017 N.D. Cal. Action. *See* Dkt. No. 59, 2017 N.D. Cal. Action.

9 **2. 2018 N.D. Cal. Action**

10 40. On January 16, 2018, Pacific Coast refiled its case against CertainTeed in this  
11 Court, again asserting claim 21 of the '568 patent against the same SilentFX QuickCut product  
12 that is at issue in this case. *See* Dkt. No. 1, 2018 N.D. Cal. Action.

13 41. On February 13, 2018, CertainTeed answered this complaint, raising the same  
14 affirmative defenses and counterclaims of invalidity, including that the “scored flexural strength”  
15 terms are indefinite and that claim 21 of the '568 patent is anticipated by and/or would have been  
16 obvious based on the Hirata prior art reference. *See* Dkt. No. 32, 2018 N.D. Cal. Action.

17 42. On March 1, 2018, CertainTeed served two interrogatories directed to Pacific  
18 Coast’s understanding of the “scored flexural strength” terms. *See* Dkt. Nos. 121-1 and 121-6  
19 (Ex. E), 2018 N.D. Cal. Action. Another interrogatory requested the basis for Pacific Coast’s  
20 contentions, if any, that claim 21 of the '568 patent is not invalid in light of the prior art,  
21 including Hirata.

22 43. On April 12, 2018, Pacific Coast responded to the interrogatory regarding  
23 invalidity in light of the prior art stating, in part, that “Hirata only discloses gluing two of boards  
24 together to increase the strength of the board without face paper because otherwise the strength  
25 would be inadequate to be used in a traditional manner and discloses that the boards could be  
26 glued in other configurations (paper-to-paper or paper-to-exposed) to achieve same results.” *See*  
27 Dkt. Nos. 121-1 and 121-10 (Ex. I) at 9, 2018 N.D. Cal. Action (original response unchanged in  
28

1 second supplement). Galyn Gafford signed these interrogatory responses on Pacific Coast's  
2 behalf.

3 44. Because Pacific Coast's responses to the interrogatories on "scored flexural  
4 strength" were deficient, CertainTeed sent Pacific Coast several letters requesting  
5 supplementation. *See* Dkt. Nos. 121-1, 121-7 – 121-9 (Exs. F-H), 2018 N.D. Cal. Action.

6 45. Although Pacific Coast supplemented its responses to these interrogatories on  
7 "scored flexural strength" twice, Pacific Coast failed to address many deficiencies and ultimately  
8 stopped responding to CertainTeed's deficiency letters. *See* Dkt. Nos. 121-1, 121-7 – 121-9  
9 (Exs. F-H), and 121-11 (Ex. J), 2018 N.D. Cal. Action. Pacific Coast took the position that it  
10 "had fully complied with its discovery obligation" regarding Interrogatory No. 17, and Pacific  
11 Coast stood on its objections to Interrogatory No. 18, deferring its response until "expert  
12 opinions" and "the Court's schedule for claim construction." *See* Dkt. Nos. 121-1 and 121-11  
13 (Ex. J), 2018 N.D. Cal. Action.

14 46. On June 18, 2018, CertainTeed served invalidity contentions on Pacific Coast that  
15 again detailed how the "scored flexural strength" terms are indefinite. *See* Exhibit C (the "Hirata  
16 Invalidity Contentions"). The Hirata Invalidity Contentions also explained, on a limitation-by-  
17 limitation basis, that claim 21 of the '568 patent is invalid for anticipation and/or obviousness  
18 based on Hirata.

19 47. On July 23, 2018, pursuant to the Northern District of California Patent L.R. 4-2,  
20 CertainTeed served claim construction disclosures on Pacific Coast, detailing again why the  
21 "scored flexural strength" terms are indefinite. CertainTeed disclosed that its expert, Dr. Miller,  
22 would testify that the '568 patent does not provide guidance on how to determine the claimed  
23 "scored flexural strength." *See* Dkt. Nos. 121-1 and 121-13 (Ex. L), 2018 N.D. Cal. Action.  
24 CertainTeed notified Pacific Coast that Dr. Miller would testify that the '568 patent did not  
25 provide guidance on at least four specific issues regarding testing for "scored flexural strength."  
26 *See id.*

27 48. On August 17, 2018, Pacific Coast and CertainTeed filed a joint claim  
28 construction statement pursuant to N.D. Cal. Patent L.R. 4-3. *See* Dkt. No. 75, 2018 N.D. Cal.

1 *Action*. CertainTeed submitted a 44-page declaration from Dr. Miller detailing why the “scored  
2 flexural strength” terms are indefinite. *See* Dkt. No. 75-2, 2018 N.D. Cal. *Action* (the “Miller  
3 Declaration,” a true and correct copy of which is attached as Exhibit D). Dr. Miller’s declaration  
4 included test results showing that the measured “scored flexural strength” varied depending on  
5 which of several test methods was used. *See id.*

6 49. Pacific Coast submitted a 4-page declaration from its expert, Mr. Matthew  
7 Risinger, with the joint claim construction statement. This declaration contained only four  
8 substantive paragraphs and did not address CertainTeed’s four specific criticisms of the “scored  
9 flexural strength” terms. *See* Dkt. No. 75-1, 2018 N.D. Cal. *Action*.

10 50. Jason Mueller was Pacific Coast’s lead counsel in the 2018 N.D. Cal. *Action*. *See*  
11 Dkt. No. 1, 2018 N.D. Cal. *Action*. As lead counsel, Jason Mueller was responsible for  
12 monitoring the likelihood of success on the matter and considering any related claims.

13 51. Jason Mueller knew of the Miller Declaration at least as early as August 24, 2018.

14 52. Galyn Gafford knew of the Miller Declaration at least as early as August 24,  
15 2018.

16 53. On information and belief, Jason Mueller was Sheppard Mullin’s billing attorney  
17 and responsible for approving all time billed to Pacific Coast by Sheppard Mullin on the 2018  
18 N.D. Cal. *Action* done in August 2018 – October 2018.

19 54. On information and belief, Jason Mueller was substantively involved in  
20 developing Pacific Coast’s arguments regarding the Miller Declaration.

21 55. On information and belief, Jason Mueller provided direction to and worked with  
22 Galyn Gafford regarding the deposition of Dr. Miller prior to that deposition.

23 56. On September 17, 2018, outside counsel for Pacific Coast, specifically Galyn  
24 Gafford, deposed Dr. Miller regarding the Miller Declaration.

25 57. On September 24, 2018, CertainTeed wrote to Pacific Coast, noting, among other  
26 things, the undeniable evidence in Dr. Miller’s declaration that the “scored flexural strength”  
27 terms are indefinite. *See* Dkt. Nos. 121-1 and 121-14 (Ex. M), 2018 N.D. Cal. *Action*.

28

1           58.     On September 28, 2018, Pacific Coast submitted its Opening Claim Construction  
2 Brief, signed by Jason Mueller, in the 2018 N.D. Cal. Action. Galyn Gafford submitted a  
3 declaration in support of this brief. Pacific Coast’s opening claim construction brief argued that  
4 the “scored flexural strength” terms were definite. In this brief, Pacific Coast cited Dr. Miller’s  
5 deposition transcript and the Miller Declaration, and addressed the test results disclosed in the  
6 Miller Declaration. *See* Dkt. No. 80 and 80-1, *2018 N.D. Cal. Action*.

7           59.     Jason Mueller knew of the Miller Declaration at least as early as September 30,  
8 2018.

9           60.     Galyn Gafford knew of the Miller Declaration at least as early as September 30,  
10 2018.

11           61.     On October 12, 2018, Pacific Coast and its outside counsel, including at least  
12 Galyn Gafford and Jason Mueller, received copies of CertainTeed Gypsum, Inc.’s Responsive  
13 Claim Construction Brief and supporting declaration and exhibits that were filed in the 2018  
14 N.D. Cal. Action. CertainTeed Gypsum, Inc.’s brief argued that the “scored flexural strength”  
15 terms were indefinite, citing and quoting from the Miller Declaration. *See* Dkt. Nos. 82 and 82-  
16 1, *2018 N.D. Cal. Action*.

17           62.     On October 19, 2018, Pacific Coast submitted its Reply Claim Construction Brief,  
18 signed by Jason Mueller, in the 2018 N.D. Cal. Action. Pacific Coast’s reply claim construction  
19 brief argued that the “scored flexural strength” terms were definite and again addressed  
20 Dr. Miller’s test results, declaration, and deposition testimony. *See* Dkt. No. 83, *2018 N.D. Cal.*  
21 *Action*.

22           63.     On October 24, 2018, Pacific Coast, in a letter signed by Jason Mueller,  
23 responded to CertainTeed’s September 24, 2018 letter, failing to address or even attempt to rebut  
24 the evidence in the Miller Declaration. *See* Dkt. Nos. 121-1 and 121-15 (Ex. N), *2018 N.D. Cal.*  
25 *Action*.

26           64.     On November 29, 2018, this Court held a claim construction hearing in which it  
27 addressed indefiniteness of the “scored flexural strength” terms in the ’568 patent. *See* Dkt. No.  
28 105 (Hr’g Tr.), *2018 N.D. Cal. Action*. Both Jason Mueller and Galyn Gafford appeared, and

1 Jason Mueller argued, on behalf of Pacific Coast at this hearing. The same day, this Court issued  
2 a claim construction order, holding that the “scored flexural strength” terms in the ’568 patent  
3 were indefinite. *See* Dkt. No. 100, *2018 N.D. Cal. Action*, also available at 2018 WL 6268880  
4 (N.D. Cal. Nov. 29, 2018). This Court concluded that the ’568 patent claims and specification  
5 do not explain how to measure “scored flexural strength,” relying on the Miller Declaration,  
6 which “confirm[ed] that there is no common understanding in the art of how to measure scored  
7 flexural strength.” Dkt. No. 100 at 16, *2018 N.D. Cal. Action*. This Court also rejected Pacific  
8 Coast’s argument from its August 18, 2017 letter, signed by Jason Mueller, that the ’568 patent’s  
9 specification discussion of “flexural strength” was relevant to the indefiniteness of “scored  
10 flexural strength.” *Compare* Dkt. No. 100 at 15-16, *2018 N.D. Cal. Action*, with Dkt. Nos. 121-1  
11 and 121-3 (Ex. B), *2018 N.D. Cal. Action*.

12 65. On January 9, 2019, this Court entered a stipulated judgment holding that claim  
13 21 of the ’568 patent was invalid as indefinite based on the Court’s claim construction order.  
14 Dkt. No. 119, *2018 N.D. Cal. Action*.

15 66. On June 30, 2020, the U.S. Court of Appeals for the Federal Circuit affirmed the  
16 judgment that claim 21 of the ’568 patent was invalid as indefinite. 816 F. App’x 454 (Fed. Cir.  
17 2020). In doing so, the Federal Circuit relied on the Miller Declaration. Like this Court, the  
18 Federal Circuit also rejected Pacific Coast’s argument from its August 18, 2017 letter, signed by  
19 Jason Mueller, that the ’568 patent’s specification discussion of “flexural strength” was relevant  
20 to the indefiniteness of “scored flexural strength.” *Compare* 816 F. App’x 454 at 459, with Dkt.  
21 Nos. 121-1 and 121-3 (Ex. B), *2018 N.D. Cal. Action*.

### 22 3. Prosecution of the ’492 and ’076 Patents

23 67. The ’492 patent issued on November 13, 2018 from a patent application filed on  
24 March 1, 2013. This patent application was Application No. 13/783,165.

25 68. The ’076 patents issued on November 20, 2018 from a patent application filed on  
26 March 1, 2013. This patent application was Application No. 13/783,179.

27 69. Pacific Coast prosecuted the ’492 and ’076 patents concurrently with the 2017  
28 N.D. Cal. Action and the 2018 N.D. Cal. Action.

1           70.     The law firm Sheppard, Mullin, Richter & Hampton LLP represented Pacific  
2 Coast in prosecution of the '492 and '076 patents.

3           71.     Galyn Gafford is registered to practice before the U.S. Patent and Trademark  
4 Office. He has Registration No. 52,929. He registered as a patent agent effective February 28,  
5 2003 and as a patent attorney effective October 18, 2004.

6           72.     Galyn Gafford represented Pacific Coast in prosecution of the '492 and '076  
7 patents.

8           73.     Galyn Gafford was listed as an "Attorney/Agent" authorized to communicate with  
9 the Patent Office on Pacific Coast's behalf regarding prosecution of the '492 and '076 patents.

10          74.     Jason Mueller was the billing partner responsible for the prosecution of the '492  
11 and '076 patents. Jason Mueller was responsible for reviewing any time billed for the  
12 prosecution of the '492 and '076 patents and determining whether it was appropriate to bill to  
13 Pacific Coast. As the lead partner in the 2018 N.D.Cal. Action, Jason Mueller was also  
14 responsible for monitoring any developments in the prosecution of the '492 and '076 patents  
15 because they are related to the '568 patent, the prosecution of the related '492 and '076 patents  
16 could lead to admissible evidence in the 2018 N.D. Cal. Action, and could lead to additional  
17 claims against CertainTeed.

18          75.     Jason Mueller is registered to practice before the U.S. Patent and Trademark  
19 Office. He has Registration No. 64,647. He registered as a patent agent effective June 22, 2009  
20 and as a patent attorney effective August 7, 2009.

21          76.     Jason Mueller represented Pacific Coast in prosecution of the '492 and '076  
22 patents.

23          77.     Jason Mueller was the lead partner at Sheppard, Mullin, Richter & Hampton LLP  
24 responsible for Pacific Coast as a client during prosecution of the '492 and '076 patents.

25          78.     Jason Mueller was listed as an "Attorney/Agent" authorized to communicate with  
26 the Patent Office on Pacific Coast's behalf regarding prosecution of the '492 and '076 patents.

27          79.     On February 17, 2014, Jason Mueller submitted to the U.S. Patent and Trademark  
28 Office an assignment of U.S. Patent Application No. 13/783,165 from PABCO Building

1 Products LLC to Pacific Coast Building Products, Inc. Jason Mueller signed this submission.  
2 The '492 patent would later issue from this patent application. A true and correct copy of this  
3 submission is attached as Exhibit E.

4 80. On February 17, 2014, Jason Mueller submitted to the U.S. Patent and Trademark  
5 Office an assignment of U.S. Patent Application No. 13/783,179 from PABCO Building  
6 Products LLC to Pacific Coast Building Products, Inc. Jason Mueller signed this submission.  
7 The '076 patent would later issue from this patent application. Exhibit E.

8 81. On May 2, 2014, Jason Mueller submitted to the U.S. Patent and Trademark  
9 Office an assignment of U.S. Patent Application No. 13/783,165 from Serious Energy, Inc. to  
10 PABCO Building Products LLC. Jason Mueller signed this submission. The '492 patent would  
11 later issue from this patent application. A true and correct copy of this submission is attached as  
12 Exhibit F.

13 82. On May 2, 2014, Jason Mueller submitted to the U.S. Patent and Trademark  
14 Office an assignment of U.S. Patent Application No. 13/783,179 from Serious Energy, Inc. to  
15 PABCO Building Products LLC. Jason Mueller signed this submission. The '076 patent would  
16 later issue from this patent application. Exhibit F.

17 83. Galyn Gafford signed responses to office actions and other documents in the '492  
18 patent prosecution history at least as early as October 1, 2013.

19 84. Galyn Gafford signed responses to office actions and other documents in the '076  
20 patent prosecution history at least as early as October 2, 2013.

21 85. On May 22, 2018, in a hearing before the Patent Trial and Appeal Board, Galyn  
22 Gafford argued an appeal of the patent examiner's rejection of the then-pending applications for  
23 the '492 and '076 patents. Galyn Gafford did not inform the Board during this hearing of the  
24 2018 N.D. Cal Action, or that the 2018 N.D. Cal. Action involved allegations that the "scored  
25 flexural strength" terms in the '568 patent were indefinite or that Hirata anticipated and/or  
26 rendered obvious claim 21 of the '568 patent. Rather, Galyn Gafford argued in this hearing that  
27 removal of the paper from the inner surfaces of the gypsum boards is "what distinguishes [the  
28 then-pending claims in the application that issued as the '492 and '076 patents] from the prior art

1 and I don't think, and I still haven't seen any prior art that shows these laminated panels made  
2 without the interior paper." *See* Record of Oral Hr'g at 6, *Ex parte Brandon D. Tinianov*, Appeal  
3 Nos. 2016-03810, 2016-03995 (PTAB May 22, 2018).

4 86. On information and belief, Galyn Gafford met with the Sheppard Mullin team  
5 regarding his argument before the Patent Trial and Appeal Board regarding the patent examiner's  
6 rejection of the then-pending applications for the '492 and '076 patents.

7 87. On May 22, 2018, Galyn Gafford and Jason Mueller having signed and/or  
8 submitted filings to the Patent Office and/or been substantively involved in the prosecution and  
9 preparation of the then-pending applications for the '492 and '076 patents, owed a duty to  
10 disclose material information to the Patent Office in connection with prosecution of then-pending  
11 applications for the '492 and '076 patents.

12 88. On information and belief, Jason Mueller was Sheppard Mullin's billing attorney  
13 and was responsible for approving all time billed to Pacific Coast by Sheppard Mullin for work  
14 on the prosecution of the then-pending applications for the '492 and '076 applications done in  
15 May 2018 – October 2018.

16 89. On June 15, 2018, Pacific Coast's outside counsel, specifically Jason Mueller,  
17 met and conferred with CertainTeed's outside counsel regarding Pacific Coast's intention to  
18 move to disqualify Dr. Miller in the 2018 N.D. Cal. Action. On information and belief, on the  
19 same day, Galyn Gafford met internally with the Sheppard Mullin team regarding Patent Trial  
20 and Appeal Board's decision as to the then-pending applications for the '492 and '076 patents.

21 90. On June 21, 2018, Galyn Gafford, on behalf of Pacific Coast, emailed  
22 CertainTeed's counsel a draft joint statement regarding Pacific Coast's motion to disqualify Dr.  
23 Miller as CertainTeed's expert.

24 91. On June 22, 2018, Jason Mueller, on behalf of Pacific Coast, signed and filed the  
25 joint statement on Pacific Coast's motion to disqualify Dr. Miller as CertainTeed's expert. Dkt.  
26 No. 57 at 6, *2018 N.D. Cal. Action*.

27 92. On information and belief, on July 17, 2018, Galyn Gafford reviewed the Patent  
28 Trial and Appeal Board's decision as to the then-pending applications for the '492 and '076



1 patents and drafted Requests for Continued Examination and terminal disclaimers for both  
2 pending applications.

3 93. On July 18, 2018, this Court denied Pacific Coast's motion to disqualify Dr.  
4 Miller as CertainTeed's expert, holding that Pacific Coast's "failure to demonstrate that it  
5 exchanged confidential information relevant to this litigation with Dr. Miller is fatal to its motion  
6 to disqualify." Dkt. No. 67 at 7, *2018 N.D. Cal. Action*. On information and belief, also on July  
7 18, 2018, Galyn Gafford revised the Requests for Continued Examination and terminal  
8 disclaimers for the then-pending applications for the '492 and '076 patents and communicated  
9 internally with the Sheppard Mullin team regarding them.

10 94. On July 19, 2018, Galyn Gafford (on Pacific Coast's behalf) filed Requests for  
11 Continued Examination of then-pending applications for the '492 and '076 patents. The  
12 Requests for Continued Examination referred to the decision from the Patent Trial and Appeal  
13 Board, made after the May 22, 2018 appeal hearing, and requested that claims, including those  
14 reciting "scored flexural strength" limitations, be allowed. The Requests for Continued  
15 Examination did not mention the 2018 N.D. Cal Action, or that the 2018 N.D. Cal. Action  
16 involved allegations that the "scored flexural strength" terms in the '568 patent were indefinite or  
17 that Hirata anticipated and/or rendered obvious claim 21 of the '568 patent.

18 95. On July 19, 2018, Galyn Gafford and Jason Mueller having signed and/or  
19 submitted filings to the Patent Office and/or been substantively involved in the prosecution and  
20 preparation of the then-pending applications for the '492 and '076 patents, owed a duty to  
21 disclose material information to the Patent Office in connection with prosecution of then-pending  
22 applications for the '492 and '076 patents.

23 96. On August 29, 2018, Galyn Gafford (on behalf of Pacific Coast) filed an  
24 Amendment and Response in prosecution of the then-pending application for the '492 patent.  
25 The Amendment and Response provided a complete listing of all pending claims, and requested  
26 that claims, including those reciting "scored flexural strength" limitations, be allowed. The  
27 Amendment and Response did not mention the 2018 N.D. Cal Action, or that the 2018 N.D. Cal.  
28 Action involved allegations that the "scored flexural strength" terms in the '568 patent were

1 indefinite or that Hirata anticipated and/or rendered obvious claim 21 of the '568 patent. On  
2 information and belief, also on August 29, 2018, Galyn Gafford communicated internally with  
3 the Sheppard Mullin team and also with the Patent Office regarding this Amendment and  
4 Response.

5 97. On August 29, 2018, Galyn Gafford and Jason Mueller having signed and/or  
6 submitted filings to the Patent Office and/or been substantively involved in the prosecution and  
7 preparation of the then-pending applications for the '492 and '076 patents, owed a duty to  
8 disclose material information to the Patent Office in connection with prosecution of then-pending  
9 applications for the '492 and '076 patents.

10 98. On information and belief, on August 31, 2018, Galyn Gafford communicated  
11 with the patent examiner regarding the claim listing of the then-pending applications for the '492  
12 and '076 patents and entry of an examiner's amendment.

13 99. On September 12, 2018 the Patent Office issued a notice of allowance for the  
14 '076 patent.

15 100. On September 13, 2018 the Patent Office issued a notice of allowance for the  
16 '492 patent.

17 101. On October 10, 2018, Pacific Coast paid the issue fees for the '492 and '076  
18 patents.

19 102. On October 10, 2018, Galyn Gafford and Jason Mueller having signed and/or  
20 submitted filings to the Patent Office and/or been substantively involved in the prosecution and  
21 preparation of the then-pending applications for the '492 and '076 patents, owed a duty to  
22 disclose material information to the Patent Office in connection with prosecution of then-pending  
23 applications for the '492 and '076 patents.

24 103. On November 12, 2018, before issuance of the '492 patent, Galyn Gafford and  
25 Jason Mueller, having signed and/or submitted filings to the Patent Office and/or been  
26 substantively involved in the prosecution and preparation of the then-pending applications for the  
27 '492 and '076 patents, owed a duty to disclose material information to the Patent Office in  
28 connection with prosecution of then-pending applications for the '492 and '076 patents.

1           104. The Patent Office issued the '492 patent on November 13, 2018.

2           105. On November 19, 2018, before issuance of the '076 patent, Galyn Gafford and  
3 Jason Mueller, having signed and/or submitted filings to the Patent Office and/or been  
4 substantively involved in the prosecution and preparation of the then-pending applications for the  
5 '492 and '076 patents, owed a duty to disclose material information to the Patent Office in  
6 connection with prosecution of then-pending application for the '076 patents.

7           106. The Patent Office issued the '076 patent on November 20, 2018.

8           107. At no point during prosecution of the '492 and '076 patents did Galyn Gafford or  
9 Jason Mueller disclose information regarding the 2018 N.D. Cal. Action to the Patent Office.

10           108. Galyn Gafford and Jason Mueller having signed and/or submitted filings to the  
11 Patent Office and/or been substantively involved in the prosecution and preparation of the then-  
12 pending applications for the '492 and '076 patents, had a duty to disclose information that is  
13 material to the patentability of the claims that they were requesting that the Patent Office issue.  
14 *See* 37 C.F.R. § 1.56; Manual of Patent Examining Procedure § 2001.06(c).

15                           **4. Arkansas Action**

16           109. Twelve days after this Court issued its claim construction order finding that the  
17 “scored flexural strength” terms were indefinite, on December 11, 2018, Pacific Coast sued  
18 CertainTeed Gypsum Manufacturing, Inc. in the Western District of Arkansas and alleged  
19 infringement of the '492 and '076 patents by the same SilentFX QuickCut product that Pacific  
20 Coast accused of infringement in the 2017 and 2018 N.D. Cal. Actions. *See Pac. Coast Bldg.*  
21 *Prods., Inc. v. CertainTeed Gypsum Mfg., Inc.*, No. 4:18-cv-04165-SOH (W.D. Ark.) (the  
22 “Arkansas Action”). Both Jason Mueller and Galyn Gafford were identified as attorneys for  
23 Pacific Coast on this complaint. To file this new case within 12 days of the claim construction  
24 order, Jason Mueller and Galyn Gafford (as counsel in the prosecution of the '492 and '076  
25 patents, the 2018 N.D. Cal. Action and the Arkansas Action) must have been aware of the scope  
26 of the claims in the '492 and '076 patents before their issuance and tracking the potential claims  
27 against CertainTeed. On August 27, 2019, the court stayed and administratively terminated the  
28 Arkansas Action pending resolution of this case. Dkt. No. 60, *Arkansas Action* (2019 WL

1 4046550 (W.D. Ark. Aug. 27, 2019)). In doing so, the court recognized that Pacific Coast’s  
 2 filing of the Arkansas Action, brought “[l]ess than two weeks after [this Court’s indefiniteness]  
 3 ruling” in the 2018 N.D. Cal. Action, “suggest[ed] an effort to avoid adverse rulings in the  
 4 Northern District of California and remedy past mistakes in a new forum.” *Id.* at 12.

5 **Unenforceability of the ’492 and ’076 Patents Due to Inequitable Conduct**

6 110. A patent is unenforceability due to inequitable conduct if: “(1) an individual  
 7 associated with the filing and prosecution of a patent application made an affirmative  
 8 misrepresentation of a material fact, failed to disclose material information, or submitted false  
 9 information; and (2) the individual did so with a specific intent to deceive the PTO.” *See In re*  
 10 *BP Lubricants USA, Inc.*, 637 F.3d 1307, 1327 n.3 (Fed. Cir. 2011).

11 111. A pleading of inequitable conduct “must include sufficient allegations of  
 12 underlying facts from which a court may reasonably infer that a specific individual (1) knew of  
 13 the withheld material information or of the falsity of the material misrepresentation, and (2)  
 14 withheld or misrepresented this information with a specific intent to deceive the PTO.” *Exergen*  
 15 *Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 1328 (Fed. Cir. 2009).

16 **A. Individuals Who Owed a Duty of Candor to the Patent Office**

17 112. Each individual associated with the filing and prosecution of a patent application  
 18 has a duty of candor and good faith in dealing with the Patent Office, which includes a duty to  
 19 disclose to the Patent Office all information known to that individual to be material to the  
 20 patentability of the pending claims. *See* 37 C.F.R. § 1.56(a).

21 113. The duty to disclose information exists with respect to each pending claim until  
 22 the claim is cancelled or withdrawn from consideration, or the patent application becomes  
 23 abandoned. *See* 37 C.F.R. § 1.56(a).

24 114. Where the subject matter for which a patent is or has been involved in litigation  
 25 and/or a trial proceeding, or the litigation and/or trial proceeding yields information material to  
 26 the currently pending applications, the existence of such litigation and any other material  
 27 information arising therefrom must be brought to the attention of the examiner or other  
 28

1 appropriate official at the U.S. Patent and Trademark Office. *See* Manual of Patent Examining  
2 Procedure § 2001.06(c).

3 115. Individuals associated with the filing or prosecution of a patent application that  
4 owe a duty to disclose information material to patentability to the U.S. Patent and Trademark  
5 Office during patent prosecution include each attorney or agent who prepares or prosecutes the  
6 application. *See* 37 C.F.R. § 1.56(c)(2).

7 116. Individuals associated with the filing or prosecution of a patent application within  
8 the meaning of 37 C.F.R. § 1.56(a) include (1) inventors, (2) the attorneys or agents who prepare  
9 or prosecute the application, and (3) every other person who is substantively involved in the  
10 preparation or prosecution of the application and who is associated with the inventor, the  
11 applicant, an assignee, or anyone to whom there is an obligation to assign the application. *See*  
12 Manual of Patent Examining Procedure § 2001.01.

13 117. Individuals who are “substantively involved in the preparation or prosecution of  
14 an application” under 37 C.F.R. § 1.56(a) are those whose “involvement relates to the content of  
15 the application or decisions related thereto, and that the involvement is not wholly administrative  
16 or secretarial in nature.” *Avid Identification Sys., Inc. v. Crystal Import Corp.*, 603 F.3d 967, 974  
17 (Fed. Cir. 2010) (holding district court did not clearly err in finding individual whose role at the  
18 company “involved in all aspects of the company’s operation, from marketing and sales to  
19 research and development” and who hired the inventors but was not himself an inventor was  
20 substantively involved in prosecution and owed a duty of candor to the Patent Office).

21 **1. Galyn Gafford Owed a Duty of Candor to the Patent Office**

22 118. Galyn Gafford is an attorney who prosecuted U.S. Patent Application Nos.  
23 13/783,165 and 13/783,179—which issued as the ’492 and ’076 patents, respectively. *See, e.g.*  
24 *supra* ¶¶ 67–106.

25 119. At a minimum, Galyn Gafford was substantively involved in prosecution of U.S.  
26 Patent Application Nos. 13/783,165 and 13/783,179—which issued as the ’492 and ’076 patents,  
27 respectively—and was associated with the assignee of these applications, at least insofar as  
28

1 Galyn Gafford acted on behalf of the assignee in making submissions and arguments to the  
2 Patent Office during prosecution.

3 120. During prosecution of U.S. Patent Application Nos. 13/783,165 and 13/783,179—  
4 which issued as the '492 and '076 patents, respectively—Galyn Gafford was a registered patent  
5 attorney with the U.S. Patent and Trademark Office (Registration No. 52,929). He had been  
6 registered as a patent attorney since October 18, 2004, and before then was registered as a patent  
7 agent since February 28, 2003.

8 121. Galyn Gafford was listed as an “Attorney/Agent” for the patent applications that  
9 issued as the '492 patent (i.e., App. No. 13/783,165) and the '076 patent (i.e., App. No.  
10 13/783,179).

11 122. Galyn Gafford began signing responses to office actions and other documents in  
12 the prosecution history for the application that issued as the '492 patent (i.e., App. No.  
13 13/783,165) at least as early as October 1, 2013, and for the application that issued as the '076  
14 patent (i.e., App. No. 13/783,179) at least as early as October 2, 2013.

15 123. Galyn Gafford prosecuted the application that issued as the '492 patent (i.e., App.  
16 No. 13/783,165) since at least October 1, 2013, and for the application that issued as the '076  
17 patent (i.e., App. No. 13/783,179) since at least October 2, 2013.

18 124. Galyn Gafford owed a duty of candor to the Patent Office in connection with  
19 prosecution of U.S. Patent Application No. 13/783,165 and the '492 patent.

20 125. Galyn Gafford owed a duty of candor to the Patent Office in connection with  
21 prosecution of U.S. Patent Application No. 13/783,179 and the '076 patent.

22 126. At some point between receiving the Hirata Invalidity Contentions and issuance  
23 of the '492 patent, Galyn Gafford owed a duty of candor to the Patent Office in connection with  
24 prosecution of the patent applications that issued as the '492 and '076 patents.

25 127. At some point between receiving the Miller Declaration and issuance of the '492  
26 patent, Galyn Gafford owed a duty of candor to the Patent Office in connection with prosecution  
27 of the patent applications that issued as the '492 and '076 patents.

28

1                   **2. Jason Mueller Owed a Duty of Candor to the Patent Office**

2           128. Jason Mueller is an attorney who (together with Galyn Gafford) prosecuted U.S.  
3 Patent Application Nos. 13/783,165 and 13/783,179—which issued as the '492 and '076 patents,  
4 respectively. *See, e.g. supra* ¶¶ 67–106.

5           129. At a minimum, Jason Mueller was substantively involved in prosecution of U.S.  
6 Patent Application Nos. 13/783,165 and 13/783,179—which issued as the '492 and '076 patents,  
7 respectively—and was associated with the assignee of these applications, at least insofar as Jason  
8 Mueller acted on behalf of the assignee in making submissions to the Patent Office during  
9 prosecution.

10           130. For example, on February 17, 2014, Jason Mueller submitted to the U.S. Patent  
11 and Trademark Office an assignment of U.S. Patent Application Nos. 13/783,165 and  
12 13/783,179 from PABCO Building Products LLC to Pacific Coast Building Products, Inc.  
13 Exhibit E. Jason Mueller signed this submission. The '492 patent would later issue from U.S.  
14 Patent Application No. 13/783,165; and the '076 patent would later issue from U.S. Patent  
15 Application No. 13/783,179.

16           131. As another example, on May 2, 2014 Jason Mueller submitted to the U.S. Patent  
17 and Trademark Office an assignment of U.S. Patent Application Nos. 13/783,165 and  
18 13/783,179 from Serious Energy, Inc. to PABCO Building Products LLC. Exhibit F. Jason  
19 Mueller signed this submission. The '492 patent would later issue from U.S. Patent Application  
20 No. 13/783,165; and the '076 patent would later issue from U.S. Patent Application No.  
21 13/783,179.

22           132. On information and belief, Jason Mueller assisted and/or supervised Galyn  
23 Gafford in prosecuting U.S. Patent Application Nos. 13/783,165 and 13/783,179—which issued  
24 as the '492 and '076 patents, respectively. Such assistance included communicating with Galyn  
25 Gafford about Office Action rejections, responses, and other submissions to or from the Patent  
26 Office.

27           133. For example, file-folder covers for the '492 and '076 patent prosecution files  
28 produced by Pacific Coast indicate that Jason Mueller was substantively involved in prosecution

1 of these patents and the '568 patent—containing Jason Mueller’s initials (JEM) with and in front  
 2 of Galyn Gafford’s initials (GDG) (highlighting added):

'492 patent (App. No. 13/783,165), Ex. G	'076 patent (App. No. 13/783,179), Ex. H
'568 patent (App. No. 11/697,691), Ex. I	

13 134. Other prosecution-related folders for the '492 and '076 patents have only Jason  
 14 Mueller’s initials (highlighting added):

'492 patent (App. No. 13/783,165), Ex. J	'076 patent (App. No. 13/783,179), Ex. K

22 135. On information and belief, Jason Mueller was Sheppard Mullin’s billing attorney  
 23 for invoices from Sheppard Mullin to Pacific Coast for work performed (at between May 2018  
 24 through October 2018) on prosecution of the then-pending applications for the '492 and '076  
 25 applications. As such, Mr. Mueller was responsible for reviewing all bills sent to Pacific Coast  
 26 regarding the prosecution of the then-pending applications for the '492 and '076 applications.  
 27 To review and approve these bills, Mr. Mueller must have been knowledgeable about the work  
 28 that was actually being performed and the quality of that work. For example, Mr. Mueller must



1 have been knowledgeable about the scope of the claims in then-pending applications for the '492  
2 and '076 applications and what materials had and had not been disclosed to the Patent Office.

3 136. During prosecution of U.S. Patent Application Nos. 13/783,165 and 13/783,179—  
4 which issued as the '492 and '076 patents, respectively—Jason Mueller was a registered patent  
5 attorney with the U.S. Patent and Trademark Office (Registration No. 64,647). He had been  
6 registered as a patent attorney since August 7, 2009, and before then was registered as a patent  
7 agent since June 22, 2009.

8 137. Jason Mueller was listed as an “Attorney/Agent” for the patent applications that  
9 issued as the '492 patent (i.e., App. No. 13/783,165) and the '076 patent (i.e., App. No.  
10 13/783,179).

11 138. Jason Mueller was listed as an “Attorney/Agent” for the patent applications that  
12 issued as the '492 patent (i.e., App. No. 13/783,165) and the '076 patent (i.e., App. No.  
13 13/783,179) since at least June 8, 2018 though issuance of these patents.

14 139. Jason Mueller was also lead counsel in the 2018 N.D.Cal. Action. As such, Jason  
15 Mueller was responsible for following the scope of the claims and tracking the prosecution of the  
16 '492 and '076 patents because these patents were related to the '568 patent at issue in the 2018  
17 N.D.Cal. Action, could generate relevant evidence and could generate claims against  
18 CertainTeed. In fact, Jason Mueller concluded that the prosecution of the '492 and '076 patents  
19 did generate claims against CertainTeed. As a result, Mr. Mueller was substantively involved in  
20 the prosecution of the '492 and '076 patents because the prosecution of those patents was  
21 directly relevant to the 2018 N.D.Cal. Action.

22 140. Jason Mueller owed a duty of candor to the Patent Office in connection with  
23 prosecution of U.S. Patent Application No. 13/783,165 and the '492 patent.

24 141. Jason Mueller owed a duty of candor to the Patent Office in connection with  
25 prosecution of U.S. Patent Application No. 13/783,179 and the '076 patent.

26 142. At some point between receiving the Hirata Invalidity Contentions and issuance  
27 of the '492 patent, Jason Mueller owed a duty of candor to the Patent Office in connection with  
28 prosecution of the patent applications that issued as the '492 and '076 patents.

1           143. At some point between receiving the Miller Declaration and issuance of the '492  
2 patent, Jason Mueller owed a duty of candor to the Patent Office in connection with prosecution  
3 of the patent applications that issued as the '492 and '076 patents.

4           **B. Material Information and Affirmative Misrepresentation of a Material Fact**

5           **1. The Miller Declaration Was Material to Patentability**

6           144. The Miller Declaration was material to the patentability of issued claims 7–8 of  
7 the '492 patent and issued claims 7–8 of the '076 patent.

8           145. The Miller Declaration was material to the patentability of issued claims 7-8 of  
9 the '492 patent and issued claims 7-8 of the '076 patent at least because it included testing data  
10 showing that those claims were invalid as indefinite based on the term “scored flexural  
11 strength.”

12           146. The Patent Office would not have allowed claims 7–8 of the '492 patent and  
13 claims 7–8 of the '076 patent to issue had it been aware of the Miller Declaration because the  
14 Patent Office would have known those claims were not patentable due to at least the term  
15 “scored flexural strength.”

16           147. The Patent Office can rely on expert declarations to determine patentability of  
17 pending patent applications. *See* 37 C.F.R. § 1.132 (“[A]ny evidence submitted to traverse the  
18 rejection or objection on a basis not otherwise provided for must be by way of an oath or  
19 declaration under this section.”); *In re Kumar*, 418 F.3d 1361, 1368-69 (Fed. Cir. 2005) (holding  
20 it error to refuse to consider an expert declaration). The Patent Office would have used the  
21 Miller Declaration in the same manner in prosecution of the '492 and '076 patents.

22           148. The Patent Office often relies on expert declarations to determine patentability of  
23 pending patent applications. The Patent Office would have used the Miller Declaration in the  
24 same manner in prosecution of the '492 and '076 patents.

25           149. The Miller Declaration was not included, submitted, or otherwise considered by  
26 the Patent Office in prosecution of the '492 and '076 patents.

27           150. The Miller Declaration includes test data and analysis that were not included,  
28 submitted, or otherwise considered by the Patent Office in prosecution of the '492 and '076

1 patents. Nothing of record in the '492 and '076 patent prosecution histories disclosed any testing  
2 or other materials showing how testing “scored flexural strength” according to the ASTM  
3 standard varied based on score depth, orientation, or method of conversion. Nothing of record,  
4 for example, described the impact on varying the score depth on measuring “flexural strength”  
5 according to the ASTM standard. Nothing of record described the impact of varying the  
6 orientation of the panel between parallel, face-up; parallel, face-down; perpendicular, face-up;  
7 and perpendicular, face-down on measuring “flexural strength” according to the ASTM standard.  
8 Nothing of record described the impact of different methods of converting “flexural strength” for  
9  $\frac{5}{8}$ -inch panels and  $\frac{1}{2}$ -inch panels on “scored flexural strength.”

10 151. The Miller Declaration is not cumulative of other information that was included,  
11 submitted, or otherwise considered by the Patent Office in prosecution of the '492 and '076  
12 patents.

13 152. The Miller Declaration includes test data and analysis that are not cumulative of  
14 other information that was included, submitted, or otherwise considered by the Patent Office in  
15 prosecution of the '492 and '076 patents.

16 153. Pacific Coast never contended in the 2018 N.D. Cal. Action or on appeal from  
17 that action that the Miller Declaration was cumulative of any other information included,  
18 submitted, or otherwise considered by the Patent Office in prosecution of the '568 patent. And  
19 the Miller Declaration is not cumulative of any additional information included, submitted, or  
20 otherwise considered in prosecution of the '492 and '076 patents.

21 154. Claim 21 of the '568 patent was directed to a “laminated, sound-attenuating  
22 structure” and required the following:

23 a scored flexural strength of the laminated structure is about 22 pounds per  $\frac{1}{2}$  inch  
24 thickness of the structure;  
25 the scored flexural strength being the flexural strength of the laminated structure  
26 after the outer, paper-clad surface of one of the first and second gypsum  
27 boards has been scored.  
28

1           155. Claim 7 of the '492 patent states: "The structure of claim 1, wherein said  
2 structure has a scored flexural strength of less than about 50 pounds force when one of the first  
3 or second outer clad surfaces is scored."

4           156. Claim 8 of the '492 patent states: "The structure of claim 7, wherein said  
5 structure has a scored flexural strength of about 22 pounds force when one of the first or second  
6 outer clad surfaces is scored."

7           157. Claim 7 of the '076 patent states: "The method of claim 1, wherein said finished  
8 laminated, sound-attenuating structure has a scored flexural strength of less than about 50 pounds  
9 force when one of the first or second outer clad surfaces has been scored."

10           158. Claim 8 of the '076 patent states: "The method of claim 7, wherein said finished  
11 laminated, sound-attenuating structure has a scored flexural strength of about 22 pounds force  
12 when one of the first or second outer clad surfaces has been scored."

13           159. Thus claim 21 of the '568 patent, claims 7–8 of the '492 patent, and claims 7–8 of  
14 the '076 patent all require the claimed structure to have a particular "scored flexural strength."

15           160. The Miller Declaration showed that "there is no common understanding in the art  
16 of how to measure scored flexural strength." *See* Dkt. No. 100 at 16, 2018 N.D. Cal. Action.

17           161. Dr. Miller "conducted extensive testing using a sample of Pacific Coast's  
18 QuietRock EZ-Snap 5/8 inch product," which Pacific Coast contended "meets all the claim  
19 elements of claim 21." *See* Dkt. No. 100 at 16 & n.2, 2018 N.D. Cal. Action.

20           162. The Miller Declaration explained that because the '568 patent "leaves score depth  
21 undefined and the industry standard referenced in the ['568 patent] is only used to test flexural  
22 strength and not scored flexural strength, Dr. Miller had to modify the industry standard testing  
23 protocol in order to arrive at values for *scored* flexural strengths of test specimens." *See* Dkt.  
24 No. 100 at 16, 2018 N.D. Cal. Action. The same is true for the '492 and '076 patents, which  
25 have materially the same specification and do not include any additional disclosure that would  
26 inform with reasonable certainty those skilled in the art about the scope of the "scored flexural  
27 strength" requirements of claims 7–8 of the '492 patent and claims 7–8 of the '076 patent.

28

1           163. The Miller Declaration “explain[ed] that the industry standard referenced in the  
2 [’568 patent] does not disclose what is meant by scored flexural strength.” *See* Dkt. No. 100 at  
3 16, 2018 N.D. Cal. Action. The Miller Declaration “note[d] that the [’568 patent] discloses a  
4 standard—American Society of Testing and Materials (‘ASTM’) C473-06a—to test the flexural  
5 strength of gypsum panel products.” *See* Dkt. No. 100 at 17, 2018 N.D. Cal. Action (citing  
6 Miller Decl. at ¶¶ 3, 48-49). The Miller Declaration explained, however, that “neither the ASTM  
7 C473-06a standard nor the ’568 patent provide any guidance for determining the ‘scored’  
8 flexural strength of a gypsum panel product or how deep to score the laminated structure. The  
9 flexural strength test specimens in the ASTM C473-06a standard are not scored.” *See* Dkt. No.  
10 100 at 17, 2018 N.D. Cal. Action (quoting Miller Decl. at ¶ 49). The same is true for the ’492  
11 and ’076 patents, which have materially the same specification and do not include any additional  
12 disclosure that would inform with reasonable certainty those skilled in the art about the scope of  
13 the “scored flexural strength” requirements of claims 7–8 of the ’492 patent and claims 7–8 of  
14 the ’076 patent.

15           164. The Miller Declaration reported on Dr. Miller’s flexural strength tests, which  
16 were conducted by scoring Pacific Coast’s QuietRock EZ-Snap <sup>5</sup>/<sub>8</sub>-inch panel at different depths  
17 and “show[ed] that the scored flexural strength of the panel varies with the score depth.” *See*  
18 Dkt. No. 100 at 17, 2018 N.D. Cal. Action (citing Miller Decl. at ¶ 120). The Miller Declaration  
19 demonstrated that, consequently, “the depth of the scoring matters in determining the scored  
20 flexural strength of the panel.” *Id.* The same is true for “scored flexural strength” in claims 7–8  
21 of the ’492 patent and claims 7–8 of the ’076 patent.

22           165. The Miller Declaration identified “eleven different variables that might affect  
23 score depth during construction: personal preference, knife/blade used, sharpness or dullness of  
24 blade, cleanliness of blade, time of day and level of fatigue, amount of leverage and angle of the  
25 blade, horizontal or vertical position of the panel during scoring, thickness of the panel, type of  
26 panel, size of the panel, and number of scores.” *See* Dkt. No. 100 at 17-18, 2018 N.D. Cal.  
27 Action (citing Miller Decl. at ¶ 50). The Miller Declaration demonstrated that, as a result,  
28 “[s]coring will vary from installer-to-installer and even from product-to-product for an individual

1 installer.” *See id.* at 18 (quoting Miller Decl. at ¶ 50). Thus, the Miller Declaration “show[ed]  
2 that there is no scoring and fracturing in a ‘standard manner’ used in construction, and that  
3 ASTM C473-06a does not disclose a method of measuring scored flexural strength.” *See id.*  
4 The same is true for “scored flexural strength” in claims 7–8 of the ’492 patent and claims 7–8 of  
5 the ’076 patent.

6 166. The Miller Declaration explained that “the industry standard to which the [’568]  
7 patent refers for measuring flexural strength reports four results for flexural strength, not one.”  
8 *See* Dkt. No. 100 at 16-17, 2018 N.D. Cal. Action. Thus, the Miller Declaration demonstrated  
9 that “even if the industry standard [referenced in the ’568 patent] could be used to measure  
10 scored flexural strength, one of skill in the art would not know which of the four results  
11 corresponds to the single measurement” of “scored flexural strength” in claim 21 of the ’568  
12 patent. *See id.* The same is true for the ’492 and ’076 patents, which have materially the same  
13 specification and do not include any additional disclosure that would inform with reasonable  
14 certainty those skilled in the art about the scope of the “scored flexural strength” requirements of  
15 claims 7–8 of the ’492 patent and claims 7–8 of the ’076 patent.

16 167. The Miller Declaration explained that “ASTM C473-06a—the standard  
17 referenced in the [’568 patent] for measuring flexural strength—reports four results for flexural  
18 strength, not one number like in [claim 21 of the ’568 patent].” *See* Dkt. No. 100 at 18, 2018  
19 N.D. Cal. Action (citing Miller Decl. ¶ 51). The same is true for “scored flexural strength” in  
20 claims 7-8 of the ’492 patent and claims 7-8 of the ’076 patent.

21 168. The Miller Declaration explained that “ASTM C473-06a specifies that to conduct  
22 a test of a gypsum panel, the panel should be cut into 12 inch by 16 inch specimens.” *See* Dkt.  
23 No. 100 at 18, 2018 N.D. Cal. Action (citing Miller Decl. ¶ 51). The Miller Declaration  
24 explained that “[f]our test specimens should be produced, as ASTM C473-06a instructs the tester  
25 to ‘[c]ut four specimens, each 12 in. ... by 16 in. ... from each gypsum panel product in the  
26 sample, two having the 16-in. dimension parallel to the edge [of the gypsum panel] and two  
27 having the 16-in. dimension perpendicular to the edge [of the gypsum panel].’” *See id.* The  
28 Miller Declaration explained that “[a]fter cutting the test specimens, the specimens are

1 conditioned for testing before being tested in a ‘three-point bearing apparatus.’” *See id.*  
2 (quoting Miller Decl. at ¶¶ 55–56).

3 169. The Miller Declaration explained that “ASTM C473-06a tests half of the  
4 specimens face-up and half face-down. For the two specimens having the 16 in. dimension cut  
5 *parallel* to the ‘long edge’ (of the original gypsum panel product), one specimen is arranged and  
6 tested ‘face up’ and the other is arranged and tested ‘face down.’” *See* Dkt. No. 100 at 18, 2018  
7 *N.D. Cal. Action* (citing Miller Decl. ¶ 59). The Miller Declaration explained that “[f]ace up’  
8 means that it is tested with the paper-clad side facing up, and ‘face down’ means the paper-clad  
9 side faces down when tested.” *Id.* (citing Miller Decl. at ¶ 59). The Miller Declaration  
10 explained further that “for the 2 specimens having the 16 in. diameter cut *perpendicular* to the  
11 ‘long edge’ of the gypsum panel, they are tested the same way: in a face-up and a face-down  
12 configuration.” *Id.* (citing Miller Decl. at ¶ 59). The Miller Declaration explained that  
13 “[t]herefore, four values for the flexural strength are reported after testing: ‘(1) parallel, face up;  
14 (2) parallel, face down; (3) perpendicular, face up; (4) perpendicular, face down.’” *Id.* (citing  
15 Miller Decl. at ¶ 66). The Miller Declaration explained further that “[i]n contrast, and as  
16 aforementioned, the ’568 Patent reports only one value for the scored flexural strength of the  
17 panel.” *Id.* at 18–19. The Miller Declaration demonstrated, therefore, that “using the ASTM  
18 C473-06a standard, it is unclear to *which* testing value this scored flexural strength of the panel  
19 refers: parallel face up or face down, or perpendicular face up or face down. A person of skill in  
20 the art would not be able to tell to which measurement the [’568 patent] is referring.” *Id.* The  
21 same is true for the ’492 and ’076 patents, which have materially the same specification and do  
22 not include any additional disclosure that would inform with reasonable certainty those skilled in  
23 the art about the scope of the “scored flexural strength” requirements of claims 7–8 of the ’492  
24 patent and claims 7–8 of the ’076 patent.

25 170. The Miller Declaration demonstrated that “whether a specimen is tested in a  
26 parallel or perpendicular orientation has an effect on the measurements of scored flexural  
27 strength.” *See* Dkt. No. 100 at 19, 2018 *N.D. Cal. Action*.

28

1           171. The Miller Declaration demonstrated that “the scored flexural value of a product  
2 varies depending on whether the test specimen was cut so that its 16-in. dimension was parallel  
3 or perpendicular to the long edge of the original gypsum panel product.” *See* Dkt. No. 100 at 20,  
4 *2018 N.D. Cal. Action* (quoting Miller Decl. at ¶ 126).

5           172. The Miller Declaration demonstrated that “the scored flexural strength of a  
6 product varies depending on how deeply the product is scored.” *See* Dkt. No. 100 at 20, *2018*  
7 *N.D. Cal. Action* (quoting Miller Decl. at ¶ 120).

8           173. “[T]here are multiple ways to measure scored flexural strength, which Dr. Miller  
9 proved [through the Miller Declaration] by scoring the panels he tested at different depths. As  
10 Dr. Miller’s test results showed, scoring at different depths resulted in different scored flexural  
11 strength values.” *See* Dkt. No. 100 at 21, *2018 N.D. Cal. Action* (quoting Miller Decl. at ¶ 120).

12           174. The Miller Declaration “explained, following the [’568 patent’s] own directions  
13 to use ASTM C473-06a to test for scored flexural strength would result in four values for  
14 flexural strength—perpendicular face up and face down, and parallel face up and face down—  
15 not one value as in” claim 21 of the ’568 patent. *See* Dkt. No. 100 at 21-22, *2018 N.D. Cal.*  
16 *Action*. The same is true for “scored flexural strength” in claims 7-8 of the ’492 patent and  
17 claims 7-8 of the ’076 patent.

18           175. The Miller Declaration “demonstrate[d] that there are major sources of  
19 imprecision resulting from the lack of clarity about the score depth and the applicable testing  
20 methodology.” *See* Dkt. No. 100 at 22, *2018 N.D. Cal. Action* (adding that “the very  
21 methodology disclosed by the ’568 Patent to quantify flexural strength, ASTM C473-06a, does  
22 not disclose a way to measure scored flexural strength”). The same is true for “scored flexural  
23 strength” in claims 7–8 of the ’492 patent and claims 7–8 of the ’076 patent.

24           176. This Court determined, by clear and convincing evidence, in the 2018 N.D. Cal.  
25 *Action* that the “scored flexural strength” terms in the ’568 patent are indefinite.

26           177. The clear and convincing evidence standard used by this Court in the 2018 N.D.  
27 Cal. *Action* is a higher standard than the standard used by the Patent Office when rejecting or  
28 issuing patent claims.



1           178. The Patent Office would not have allowed claims 7–8 of the '492 patent and  
2 claims 7–8 of the '076 patent to issue had it been aware of the Miller Declaration. The Patent  
3 Office instead would have rejected these claims as indefinite based on the Miller Declaration.

4           179. Pacific Coast is currently prosecuting U.S. Patent Application No. 16/171,315,  
5 which is a continuation of the patent application that issued as the '492 patent.

6           180. Pacific Coast is currently prosecuting U.S. Patent Application No. 16/277,847,  
7 which is a continuation of the patent application that issued as the '076 patent.

8           181. Pacific Coast submitted the Miller Declaration to the Patent Office during  
9 prosecution of U.S. Patent Application Nos. 16/171,315 and 16/277,847.

10                   **2. The Hirata Invalidity Contentions Were Material to Patentability**

11           182. The Hirata Invalidity Contentions demonstrated that claim 21 of the '568 patent  
12 was invalid based on the Hirata prior art reference under 35 U.S.C. §§ 102 and/or 103. The  
13 Hirata Invalidity Contentions map, on an element-by-element basis, the disclosure of Hirata to  
14 claim 21 of the '568 patent. The '492 patent is a continuation of the '568 patent, and the '076  
15 patent is a divisional of the '568 patent. The '492 and '076 patents include the same written  
16 description of the invention as the '568 patent and very similar claims as the '568 patent. Claim  
17 21 of the '568 patent, claims 1–4 of the '492 patent, and claims 1–4 of the '076 patent are  
18 directed to a laminated structure of two gypsum boards glued together, in which the entire inner  
19 surface of both gypsum boards is unclad. The below chart reproduces claim 21 of the '568  
20 patent, claim 1 of the '492 patent, and claim 1 of the '076 patents side-by-side:

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	<b>'568 patent claim 21</b>	<b>'492 patent claim 1</b>	<b>'076 patent claim 1</b>
1 2 3	21. A laminated, sound-attenuating structure which comprises:	1. A laminated building structure, comprising:	1. A method of foil ling [sic] a laminated, sound-attenuating structure, comprising:
4 5 6 7 8 9	a first gypsum board having two surfaces, the first of said two surfaces comprising an outer, paper-clad surface and the second of said two surfaces comprising an inner surface, wherein the entire inner surface of the first gypsum board is unclad;	a first gypsum board having two surfaces, said two surfaces including a first outer clad surface and a first inner unclad surface, wherein the entire inner surface of the first gypsum board is unclad;	forming a first gypsum board having two surfaces, said two surfaces including a first outer clad surface and a first inner unclad surface, wherein the entire inner surface of the first gypsum board is unclad;
10 11	a layer of viscoelastic glue on the second of two surfaces; and	a first layer of viscoelastic glue placed directly on the first inner unclad surface; and	placing a first layer of viscoelastic glue directly on the first inner unclad surface; and
12 13 14 15 16 17 18 19 20	a second gypsum board over said viscoelastic glue, said second gypsum board having two surfaces, the first of said two surfaces of said second gypsum board comprising an outer, paper-clad surface and the second of said two surfaces of said second gypsum board comprising an inner surface, wherein the entire inner surface of the second gypsum board is unclad;	a second gypsum board located proximate to said first layer of viscoelastic glue, said second gypsum board having two surfaces, said two surfaces including a second outer clad surface and a second inner unclad surface, wherein the entire inner surface of the second gypsum board is unclad.	placing a second gypsum board proximate to said first layer of viscoelastic glue, said second gypsum board having two surfaces, said two surfaces including a second outer clad surface and a second inner unclad surface, wherein the entire inner surface of the second gypsum board is unclad.
21 22 23	a scored flexural strength of the laminated structure is about 22 pounds per ½ inch thickness of the structure;		
24 25 26 27 28	the scored flexural strength being the flexural strength of the laminated structure after the outer, paper-clad surface of one of the first and second gypsum boards has been scored.		

1 As evident from a comparison of the claim language in this chart, element-by-element mapping  
2 in the Hirata Invalidity Contentions of the disclosure in Hirata to claim 21 of the '568 patent  
3 claims is the same as an element-by-element mapping of the disclosure in Hirata to claim 1 of  
4 the '076 and claim 1 of the '492 patent claims, and therefore, shows exactly why the claims of  
5 the '076 and '492 patent were not patentable and are invalid.

6 183. The Hirata prior art reference anticipates and/or renders obvious claims 1–4 of the  
7 '492 patent and claims 1–4 of the '076 patent at least for the same reasons explained in the  
8 Hirata Invalidity Contentions.

9 184. The Hirata Invalidity Contentions were material to the patentability of issued  
10 claims 1–4 of the '492 patent and issued claims 1–4 of the '076 patent because those claims  
11 would not have issued but for the failure to disclose them to the Patent Office.

12 185. The Patent Office would not have allowed claims 1–4 of the '492 patent and  
13 claims 1–4 of the '076 patent to issue had it been aware of the Hirata Invalidity Contentions.

14 186. The Patent Office can rely on contentions served in litigation to determine  
15 patentability of pending patent applications. *See* 37 C.F.R. § 1.105 (“In the course of examining  
16 or treating a matter in a pending or abandoned application, in a patent, or in a reexamination  
17 proceeding ... the examiner or other Office employee may require the submission, from  
18 individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably  
19 necessary to properly examine or treat the matter, for example: ... (viii) Technical information  
20 known to applicant. Technical information known to applicant concerning the related art, the  
21 disclosure, the claimed subject matter, other factual information pertinent to patentability, or  
22 concerning the accuracy of the examiner’s stated interpretation of such items.”). The Patent  
23 Office would have used the Hirata Invalidity Contentions to show how claim 1 in the '492 and  
24 '076 patents would not have issued.

25 187. The Hirata Invalidity Contentions were not included, submitted, or otherwise  
26 considered by the Patent Office in prosecution of the '492 and '076 patents.

27 188. The Hirata Invalidity Contentions include technical explanations that were not  
28 included, submitted, or otherwise considered by the Patent Office in prosecution of the '492 and

1 '076 patents. The Hirata Invalidity Contentions mapped the disclosure of Hirata to claim 21 of  
2 the '568 patent. Claim 1 in the '492 and '076 patents include elements identical to those claim  
3 21 of the '568 patent. As a result, the mapping of the disclosure of Hirata to claim 21 of the '568  
4 patent was effectively the same as mapping the disclosure in Hirata to claims in '492 and '076  
5 patents because the claims in the '492 and '076 patents are materially the same.

6 189. The Hirata Invalidity Contentions are not cumulative of other information that  
7 was included, submitted, or otherwise considered by the Patent Office in prosecution of the '492  
8 and '076 patents. Nothing of record in '492 and '076 patents mapped the disclosure in Hirata, a  
9 Japanese patent, to the claim limitations of the '568, '492, or '076 patents.

10 190. The Hirata Invalidity Contentions include explanations that are not cumulative of  
11 other information that was included, submitted, or otherwise considered by the Patent Office in  
12 prosecution of the '492 and '076 patents.

13 191. Pacific Coast is currently prosecuting U.S. Patent Application No. 16/171,315,  
14 which is a continuation of the patent application that issued as the '492 patent.

15 192. Pacific Coast is currently prosecuting U.S. Patent Application No. 16/277,847,  
16 which is a continuation of the patent application that issued as the '076 patent.

17 193. Pacific Coast submitted the Hirata Invalidity Contentions to the Patent Office  
18 during prosecution of U.S. Patent Application Nos. 16/171,315 and 16/277,847.

19 194. In U.S. Patent Application Nos. 16/171,315 and 16/277,847, Pacific Coast has  
20 tried to obtain issuance of claims where “the interior surface of the gypsum board is unfaced  
21 across less than an entire face of the board,” which also is how Pacific Coast wants to construe  
22 the “inner surface” and “inner unclad surface” in claim 1 of the '492 and claim 1 of the '076  
23 patent. *See* Dkt. No. 106 at 2, 13 (proposing the same construction of “the interior surface not  
24 covered by edge cladding” for both “inner surface” and “inner unclad surface”).

25 195. Only after Pacific Coast submitted the Hirata Invalidity Contentions to the Patent  
26 Office during prosecution of U.S. Patent Application Nos. 16/171,315 and 16/277,847 did the  
27 Patent Office reject these patent applications based on the Hirata prior art reference.

28

1           196. That the Patent Office rejected U.S. Patent Application Nos. 16/171,315 and  
2 16/277,847 based on the Hirata prior art reference only after receiving the Hirata Invalidation  
3 Contentions is evidence that the Hirata Invalidation Contentions are not cumulative of the Hirata  
4 prior art reference itself. The Hirata Invalidation Contentions do not simply repeat the disclosures  
5 of Hirata but rather explain on a limitation-by-limitation basis why claim 21 of the '568 patent  
6 was invalid based on Hirata. This detailed explanation is not contained in Hirata itself.

7           197. The Patent Office has finally rejected the claims in U.S. Patent Application Nos.  
8 16/171,315 and 16/277,847 as anticipated and/or rendered obvious based on the Hirata prior art  
9 reference.

10           198. Patent Office Examiner Theodore Adamos examined U.S. Patent Application  
11 Nos. 16/171,315 and 16/277,847.

12           199. Patent Office Examiner Theodore Adamos examined the patent applications that  
13 issued as the '492 and '076 patents.

14           200. Galyn Gafford's statement to the Patent Trial and Appeal Board that removal of  
15 the paper from the inner surfaces of the gypsum boards is "what distinguishes [the then-pending  
16 claims in the applications that issued as the '492 and '076 patents] from the prior art"  
17 demonstrates that explanations of prior art references in particular that disclose laminated panels  
18 without interior paper are material to the patentability of those claims. *See* Record of Oral Hr'g  
19 at 6, *Ex parte Brandon D. Tinianov*, Appeal Nos. 2016-03810, 2016-03995 (PTAB May 22,  
20 2018).

21           201. The Hirata Invalidation Contentions demonstrate on a limitation-by-limitation basis  
22 that Hirata anticipates and/or renders obvious claim 21 of the '568 patent. Given the similarity  
23 of claim 21 of the '568 patent to both claim 1 of the '492 and claim 1 of the '076 patent, the  
24 Hirata Invalidation Contentions were material to patentability of claims that issued in the '492 and  
25 '076 patents. As explained above, the Hirata Invalidation Contentions explain that Hirata  
26 discloses, under Pacific Coast's construction of the claims, a laminated structure where the inner  
27 surfaces of the gypsum boards are exposed.

28

1           202. The Hirata Invalidity Contentions demonstrate that the Hirata prior art reference  
2 discloses the following requirement in claim 1 of the '492 patent: “[a] laminated building  
3 structure.”

4           203. The Hirata Invalidity Contentions demonstrate that the Hirata prior art reference  
5 discloses the following requirement in claim 1 of the '492 patent: “a first gypsum board having  
6 two surfaces, said two surfaces including a first outer clad surface.”

7           204. The Hirata Invalidity Contentions demonstrate that the Hirata prior art reference  
8 discloses the following requirement in claim 1 of the '492 patent, under Pacific Coast’s  
9 construction of the claim: “a first gypsum board having two surfaces, said two surfaces  
10 including ... a first inner unclad surface, wherein the entire inner surface of the first gypsum  
11 board is unclad.”

12           205. The Hirata Invalidity Contentions demonstrate that the Hirata prior art reference  
13 discloses the following requirement in claim 1 of the '492 patent, under Pacific Coast’s  
14 construction of the claim: “a first layer of viscoelastic glue placed directly on the first inner  
15 unclad surface.”

16           206. The Hirata Invalidity Contentions demonstrate that the Hirata prior art reference  
17 discloses the following requirement in claim 1 of the '492 patent, under Pacific Coast’s  
18 construction of the claim: “a second gypsum board located proximate to said first layer of  
19 viscoelastic glue, said second gypsum board having two surfaces, said two surfaces including a  
20 second outer clad surface.”

21           207. The Hirata Invalidity Contentions demonstrate that the Hirata prior art reference  
22 discloses the following requirement in claim 1 of the '492 patent, under Pacific Coast’s  
23 construction of the claim: “a second gypsum board located proximate to said first layer of  
24 viscoelastic glue, said second gypsum board having two surfaces, said two surfaces including ...  
25 a second inner unclad surface, wherein the entire inner surface of the second gypsum board is  
26 unclad.”

27  
28

1           208. The Hirata Invalidity Contentions demonstrate that the Hirata prior art reference  
2 discloses the following requirement in claim 1 of the '076 patent: “A method of foil ling [sic] a  
3 laminated, sound-attenuating structure.”

4           209. On April 27, 2021, the Patent Office issued a Certificate of Correction for the  
5 '076 patent, to correct “A method of foil ling [sic] a laminated, sound-attenuating structure” in  
6 claim 1 of the '076 patent to “A method of forming a laminated, sound-attenuating structure.”  
7 Exhibit B.

8           210. The Hirata Invalidity Contentions demonstrate that the Hirata prior art reference  
9 discloses the following requirement in claim 1 of the '076 patent: “A method of forming a  
10 laminated, sound-attenuating structure.”

11           211. The Hirata Invalidity Contentions demonstrate that the Hirata prior art reference  
12 discloses the following requirement in claim 1 of the '076 patent: “forming a first gypsum board  
13 having two surfaces, said two surfaces including a first outer clad surface.”

14           212. The Hirata Invalidity Contentions demonstrate that the Hirata prior art reference  
15 discloses the following requirement in claim 1 of the '076 patent, under Pacific Coast's  
16 construction of the claim: “forming a first gypsum board having two surfaces, said two surfaces  
17 including ... a first inner unclad surface, wherein the entire inner surface of the first gypsum  
18 board is unclad.”

19           213. The Hirata Invalidity Contentions demonstrate that the Hirata prior art reference  
20 discloses the following requirement in claim 1 of the '076 patent, under Pacific Coast's  
21 construction of the claim: “placing a first layer of viscoelastic glue directly on the first inner  
22 unclad surface.”

23           214. The Hirata Invalidity Contentions demonstrate that the Hirata prior art reference  
24 discloses the following requirement in claim 1 of the '076 patent, under Pacific Coast's  
25 construction of the claim: “placing a second gypsum board proximate to said first layer of  
26 viscoelastic glue, said second gypsum board having two surfaces, said two surfaces including a  
27 second outer clad surface.”

28

1           215. The Hirata Invalidity Contentions demonstrate that the Hirata prior art reference  
2 discloses the following requirement in claim 1 of the '076 patent, under Pacific Coast's  
3 construction of the claim: "placing a second gypsum board proximate to said first layer of  
4 viscoelastic glue, said second gypsum board having two surfaces, said two surfaces including ...  
5 a second inner unclad surface, wherein the entire inner surface of the second gypsum board is  
6 unclad."

7           216. The Patent Office would not have allowed claim 1 of the '492 patent and claim 1  
8 of the '076 patent to issue had it been aware of the Hirata Invalidity Contentions.

9                           **3. Withholding Existence of 2018 N.D. Cal. Action Was Material to**  
10                           **Patentability**

11           217. Galyn Gafford and Jason Mueller never disclosed the existence of the 2018 N.D.  
12 Cal. Action to the Patent Office during prosecution of the '492 and '076 patents.

13           218. The 2018 N.D. Cal. Action involved claim construction, invalidity, and alleged  
14 infringement of the '568 patent, to which the '492 and '076 patents claim priority.

15           219. The 2018 N.D. Cal. Action was litigation related to the '492 and '076 patents, and  
16 specifically the subject matter and prosecution of the '492 and '076 patents.

17           220. Material information may come from sources such as related litigation. *See*  
18 *Manual of Patent Examining Procedure* § 2001.06(c); *Nilssen v. Osram Sylvania, Inc.*, 504 F.3d  
19 1223, 1233-34 (Fed. Cir. 2007).

20           221. Withholding the existence of related litigation from the Patent Office may be  
21 material for purposes of patentability and inequitable conduct.

22           222. Withholding the existence of the 2018 N.D. Cal. Action from the Patent Office  
23 was material to the patentability of claims in the '492 and '076 patents.

24           223. For example, had the Patent Office been informed of the existence of the 2018  
25 N.D. Cal. Action, the Examiner would have known the schedule for claim construction, reviewed  
26 the claim construction briefs, learned about CertainTeed's indefiniteness arguments and  
27 identified the Miller Declaration. A reasonable Examiner likely also would have requested other  
28 documents from the N.D. Cal. Action, such as the Hirata Invalidity Contentions. The Examiner



1 also would have delayed the issuance of the '492 and '076 patents until after receiving the  
2 Court's claim construction order.

3 224. Thus the existence of the 2018 N.D. Cal. Action—and specifically the  
4 withholding thereof—was material to the patentability of issued claims 1–4 and 7–8 of the '492  
5 patent and issued claims 1–4 and 7–8 of the '076 patent.

6 225. The Patent Office would not have allowed claims 1–4 and 7–8 of the '492 patent  
7 and issued claims 1–4 and 7–8 of the '076 patent to issue had it been aware of the 2018 N.D.  
8 Cal. Action.

9 226. The Patent Office can rely on material from related litigation to determine  
10 patentability of pending patent applications. The Patent Office would have used the existence of  
11 the 2018 N.D. Cal. Action in the same manner in prosecution of the '492 and '076 patents.

12 227. The Patent Office often relies on material from related litigation to determine  
13 patentability of pending patent applications. The Patent Office would have used the existence of  
14 the 2018 N.D. Cal. Action in the same manner in prosecution of the '492 and '076 patents.

15 228. The existence of the 2018 N.D. Cal. Action was not included, submitted, or  
16 otherwise considered by the Patent Office in prosecution of the '492 and '076 patents.

17 229. The existence of the 2018 N.D. Cal. Action is not cumulative of other information  
18 that was included, submitted, or otherwise considered by the Patent Office in prosecution of the  
19 '492 and '076 patents.

20 **C. Galyn Gafford's and Jason Mueller's Intent to Deceive**

21 230. During prosecution of the '492 and '076 patents, Galyn Gafford and Jason  
22 Mueller committed inequitable conduct by failing to disclose information material to  
23 patentability of the '492 and '076 patents with specific intent to deceive the Patent Office. Such  
24 inequitable conduct is inextricably tied to the 2017 and 2018 N.D. Cal. Actions and renders the  
25 '492 and '076 patents unenforceable.

26 231. Jason Mueller was lead counsel for Pacific Coast in the 2018 N.D. Cal. Action.  
27 Galyn Gafford also represented Pacific Coast in the 2018 N.D. Cal. Action. Galyn Gafford and  
28 Jason Mueller received copies and were aware of the Miller Declaration and the Hirata Invalidity

1 Contentions, and were aware of the 2018 N.D. Cal Action. Galyn Gafford and Jason Mueller  
2 knew that they were material because, as shown above, the Miller Declaration was submitted in  
3 support of CertainTeed’s positions that claims with the term “scored flexural strength” were  
4 invalid under 35 U.S.C. § 112 and the Hirata Invalidation Contentions were submitted to show  
5 claims were invalid under 35 U.S.C. §§ 102 and 103.

6 232. As a result of the Miller Declaration and upcoming claim construction hearing,  
7 Galyn Gafford and Jason Mueller knew that the Court was about to invalidate the ’568 patent.  
8 They also knew that the other patent asserted in the 2018 N.D. Cal. Action was invalid based on  
9 prior art, which is why they ultimately voluntarily dismissed the other asserted patent and  
10 granted CertainTeed a covenant not to sue for past, present and future products. *See* Dkt. No.  
11 118, 2018 N.D. Cal. Action.

12 233. Because Jason Mueller and Galyn Gafford knew that they were losing the first  
13 suit, they also knew that they needed to find additional claims to assert against CertainTeed or  
14 else the dispute was lost. Jason Mueller and Galyn Gafford, however, had been tracking the  
15 status of the prosecution of the ’492 and ’076 patents throughout the prosecution of the 2018  
16 N.D. Cal. Action because the prosecution of the ’492 and ’076 patents could produce evidence  
17 relevant to the parent ’568 patent and potentially assertable claims. As a result, Jason Mueller  
18 and Galyn Gafford knew that they needed the ’492 and ’076 patents to issue as soon as possible  
19 so they could file another suit (i.e., the Arkansas Action) against CertainTeed. However, they  
20 also knew that, if they disclosed the existence of the 2018 N.D. Cal. Action, the Miller  
21 Declaration or the Hirata Invalidation Contentions to the Patent Office, the Patent Office would  
22 reject the pending claims and any pressure against CertainTeed would be lost. As a result, Galyn  
23 Gafford and Jason Mueller intentionally did not disclose the existence of the 2018 N.D. Cal.  
24 Action, the Miller Declaration, or the Hirata Invalidation Contentions to the Patent Office because  
25 they knew it would stop issuance of the ’492 and ’076 patents, prevent them from filing a second  
26 case in a new forum, and prevent them from having any leverage, including the ongoing burden  
27 of legal fees, to coerce a settlement.

28

1           234. Galyn Gafford and Jason Mueller (aware that the 2018 N.D. Cal. Action, Miller  
2 Declaration, and Hirata Invalidation Contentions were material to the pending claims in the  
3 applications that issued as the '492 and '076 patents) withheld the Miller Declaration, the Hirata  
4 Invalidation Contentions, and the existence of the 2018 N.D. Cal. Action from the Patent Office.

5           235. Jason Mueller and Galyn Gafford withheld this information from the Patent  
6 Office to avoid stopping the issuance of the '492 and '076 patents so that they could assert these  
7 patents in the Arkansas Action.

8           236. Pacific Coast, represented by Galyn Gafford and Jason Mueller as outside  
9 counsel, asserted the '492 and '076 patents against CertainTeed's SilentFX QuickCut product 12  
10 days after this Court held that the "scored flexural strength" terms in the parent '568 patent were  
11 indefinite when Pacific Coast sued CertainTeed Gypsum Manufacturing Inc. in the Arkansas  
12 Action.

13           237. On information and belief, Galyn Gafford and Jason Mueller withheld the Miller  
14 Declaration, the Hirata Invalidation Contentions, and the existence of the 2018 N.D. Cal Action  
15 from prosecution of the applications that issued as the '492 and '076 patents with specific intent  
16 to deceive the Patent Office. Galyn Gafford and Jason Mueller were aware of CertainTeed's  
17 allegations regarding the "scored flexural strength" terms and Hirata for over a year prior to  
18 issuance of the '492 and '076 patents. During that time, Pacific Coast, in filings signed by Galyn  
19 Gafford, continued to prosecute the applications that issued as the '492 and '076 patents. Galyn  
20 Gafford even argued to the Patent Trial and Appeal Board that he still had not seen prior art that  
21 described laminated panels made without interior paper, despite having previously signed Pacific  
22 Coast's interrogatory responses admitting that Hirata discloses a panel made of two boards that  
23 have surfaces lacking face paper that are glued together. Moreover, Galyn Gafford deposed  
24 CertainTeed's expert, Dr. Miller, regarding the Miller Declaration and the indefiniteness of the  
25 "scored flexural strength" claim terms. Yet at no time during prosecution of the applications that  
26 issued as the '492 and '076 patents did Galyn Gafford or Jason Mueller inform the Patent Office  
27 of the Miller Declaration, the Hirata Invalidation Contentions, or the 2018 N.D. Cal. Action.

28



**COUNT II FOR DECLARATORY JUDGMENT**

**(Declaratory Judgment of Unenforceability of the '076 Patent)**

245. CertainTeed incorporates by reference and realleges Paragraphs 1-244 above as though fully restated herein.

246. This declaratory judgment claim arises under the United States Patent Laws, 35 U.S.C. § 100 et seq., including 35 U.S.C. § 271(a)-(c), and the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202. Subject matter jurisdiction is proper under 28 U.S.C. §§ 1331 and 1338(a).

247. Pacific Coast purports to be the lawful owner by assignment of all rights, title, and interest in the '076 patent, including the right to sue for patent infringement and damages, including past damages. PABCO purports to be the exclusive licensee of the '076 patent. Pacific Coast and PABCO have sued CertainTeed Gypsum Manufacturing, Inc. in the Western District of Arkansas, alleging that the SilentFX QuickCut product infringes the '076 patent.

248. CertainTeed sells the SilentFX QuickCut product.

249. The '076 patent is unenforceable due to inequitable conduct for the reasons set forth in Paragraphs 1-244 above, incorporated herein by reference. Pacific Coast's conduct renders this case exceptional under 35 U.S.C. § 285.

250. An actual and justiciable controversy exists between the parties with respect to the '076 patent—including specifically the unenforceability of the '076 patent. CertainTeed is entitled to a declaratory judgment that the '076 patent is unenforceable.

**COUNT III FOR DECLARATORY JUDGMENT**

**(Noninfringement of the '492 Patent)**

251. CertainTeed incorporates by reference and realleges Paragraphs 1-250 above as though fully restated herein.

252. This declaratory judgment claim arises under the United States Patent Laws, 35 U.S.C. § 100 et seq., including 35 U.S.C. § 271(a)-(c), and the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202. Subject matter jurisdiction is proper under 28 U.S.C. §§ 1331 and 1338(a).

1           253. Pacific Coast purports to be the lawful owner by assignment of all rights, title, and  
2 interest in the '492 patent, including the right to sue for patent infringement and damages,  
3 including past damages. PABCO purports to be the exclusive licensee of the '492 patent.  
4 Pacific Coast and PABCO have sued CertainTeed Gypsum Manufacturing, Inc. in the Western  
5 District of Arkansas, alleging that the SilentFX QuickCut product infringes the '492 patent.

6           254. CertainTeed sells the SilentFX QuickCut product.

7           255. CertainTeed does not infringe and has not infringed—either directly,  
8 contributorily, or by inducement—any valid and enforceable claim of the '492 patent, either  
9 literally or under the doctrine of equivalents with respect to the SilentFX QuickCut product.

10           256. CertainTeed does not directly infringe any valid and enforceable claim of the '492  
11 patent at least because SilentFX QuickCut products do not embody the limitation that “the entire  
12 inner surface of the [first and second] gypsum board is unclad.” As a result of the manufacturing  
13 process used to create SilentFX QuickCut products, there is paper cladding on the inner surface  
14 of the gypsum cores.

15           257. By reason of the proceedings in the U.S. Patent and Trademark Office during  
16 prosecution of the '492 patent—including statements, arguments, amendments, assertions, and/or  
17 representations made by or on behalf of the applicant(s) for the '492 patent—the scope of the  
18 '492 patent's claims are limited. Prosecution history estoppel bars the assertion of infringement  
19 under the doctrine of equivalents against, for example, products for which the entire inner  
20 surface of the first and second gypsum boards is not unclad at least because otherwise the  
21 limitation that the *entire* inner surface of the gypsum board is unclad would be vitiated. Pacific  
22 Coast failed to allege in any of its complaints in the 2017 and 2018 N.D. Cal. and Arkansas  
23 Actions infringement under the doctrine of equivalents as to any particular claim limitation, but  
24 to the extent that Pacific Coast nevertheless attempts to assert infringement under the doctrine of  
25 equivalents, Pacific Coast is estopped from doing so.

26           258. An actual and justiciable controversy exists between the parties with respect to the  
27 '492 patent—including specifically noninfringement of the '492 patent. CertainTeed is entitled  
28 to a declaratory judgment that the SilentFX QuickCut products do not infringe the '492 patent.

**COUNT IV FOR DECLARATORY JUDGMENT**

**(Noninfringement of the '076 Patent)**

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2  
3 259. CertainTeed incorporates by reference and realleges Paragraphs 1-258 above as  
4 though fully restated herein.

5 260. This declaratory judgment claim arises under the United States Patent Laws, 35  
6 U.S.C. § 100 et seq., including 35 U.S.C. § 271(a)-(c), and the Declaratory Judgment Act, 28  
7 U.S.C. §§ 2201 and 2202. Subject matter jurisdiction is proper under 28 U.S.C. §§ 1331 and  
8 1338(a).

9 261. Pacific Coast purports to be the lawful owner by assignment of all rights, title, and  
10 interest in the '076 patent, including the right to sue for patent infringement and damages,  
11 including past damages. PABCO purports to be the exclusive licensee of the '076 patent.  
12 Pacific Coast and PABCO have sued CertainTeed Gypsum Manufacturing, Inc. in the Western  
13 District of Arkansas, alleging that the SilentFX QuickCut product infringes the '076 patent.

14 262. CertainTeed sells the SilentFX QuickCut product.

15 263. CertainTeed does not infringe and has not infringed—either directly,  
16 contributorily, or by inducement—any valid and enforceable claim of the '076 patent, either  
17 literally or under the doctrine of equivalents with respect to the SilentFX QuickCut product.

18 264. CertainTeed does not directly infringe any valid and enforceable claim of the '076  
19 patent at least because SilentFX QuickCut products do not embody the limitation that “the entire  
20 inner surface of the [first and second] gypsum board is unclad.” As a result of the manufacturing  
21 process used to create SilentFX QuickCut products, there is paper cladding on the inner surface  
22 of the gypsum cores.

23 265. By reason of the proceedings in the U.S. Patent and Trademark Office during  
24 prosecution of the '076 patent—including statements, arguments, amendments, assertions, and/or  
25 representations made by or on behalf of the applicant(s) for the '076 patent—the scope of the  
26 '076 patent's claims are limited. Prosecution history estoppel bars the assertion of infringement  
27 under the doctrine of equivalents against, for example, products for which the entire inner  
28 surface of the first and second gypsum boards is not unclad at least because otherwise the

1 limitation that the *entire* inner surface of the gypsum board is unclad would be vitiated. Pacific  
2 Coast failed to allege in any of its complaints in the 2017 and 2018 N.D. Cal. and Arkansas  
3 Actions infringement under the doctrine of equivalents as to any particular claim limitation, but  
4 to the extent that Pacific Coast nevertheless attempts to assert infringement under the doctrine of  
5 equivalents, Pacific Coast is estopped from doing so.

6 266. An actual and justiciable controversy exists between the parties with respect to the  
7 '076 patent—including specifically noninfringement of the '076 patent. CertainTeed is entitled  
8 to a declaratory judgment that the SilentFX QuickCut products do not infringe the '076 patent.

9 **PRAYER FOR RELIEF**

10 267. WHEREFORE, CertainTeed respectfully requests that this Court enter judgment  
11 in its favor as follows:

- 12 a) that the Court find and declare that the '492 patent (including all claims of the  
13 '492 patent) is unenforceable due to inequitable conduct, and thus without any force  
14 or effect against any of CertainTeed and its officers, employees, agents and attorneys;
- 15 b) that the Court find and declare that the '076 patent (including all claims of the  
16 '492 patent) is unenforceable due to inequitable conduct, and thus without any force  
17 or effect against any of CertainTeed and its officers, employees, agents and attorneys;
- 18 c) that the Court find and declare that CertainTeed does not infringe and has not  
19 infringed any claim of the '492 patent with respect to the SilentFX QuickCut product;
- 20 d) that the Court find and declare that CertainTeed does not infringe and has not  
21 infringed any claim of the '076 patent with respect to the SilentFX QuickCut product;
- 22 e) that the Court find and declare that this is an exceptional case under 35 U.S.C. § 285  
23 and that CertainTeed be awarded all of its costs, expenses, and attorneys' fees,  
24 together with pre-judgment and post-judgment interest; and
- 25 f) that the Court grant CertainTeed such other and additional relief, in law or in equity,  
26 as the Court deems just and proper.  
27  
28



1 Dated: May 14, 2021

Respectfully submitted,

CERTAINTEED GYPSUM, INC.

4 /s/ Richard G. Frenkel

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