Expert Reply Declaration for the OSES Motion to Amend in IPR2014-00216 for U.S. Patent No. 6,179,053 by Dallas for Lockdown Mechanism for Well Tools Requiring Fixed-Point Packoff

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I. The Proposed Amended Claims Would Not Have Been Obvious in View of the Dallas '118 Application.

1. The Dallas '118 Application Does Not Disclose a Separate Setting Tool that Is "Arranged to Insert a Bottom End of the Mandrel through the Wellhead, and Is Removable from the Other Portions of the Apparatus."

1. Petitioner's expert, Mr. Perkin, argues in his declaration that "the term 'setting tool' does not have a precise meaning in the oil and gas field." Perkin Declaration (Ex. 1014) at ¶ 44. Although that might be true in a vacuum, the language of proposed amended claim 1 clearly sets out the defining characteristics of the "setting tool" in this particular context: (1) it is "arranged to insert a bottom end of the mandrel through the wellhead"; and (2) it is "separate from" the first and second lockdown mechanisms and thus "removable from the other portions of the apparatus."

2. Mr. Perkin also argues that "the term 'setting tool' could mean any device that is used to align the mandrel with the wellhead so that the mandrel can be inserted without interference." Perkin Declaration at ¶ 44. He later uses this assertion as his support for arguing the alleged inherent presence in the '118 Application of some device that would fit this definition of "setting tool." *Id*. at ¶¶ 52, 54.

3. This assertion is incorrect in at least two important ways. First, there is nothing in the '053 Patent that discusses the setting tool being used to "align the

mandrel with the wellhead." In his deposition, Mr. Perkin could identify no portion of the '053 Patent that describes the setting tool being used to align the mandrel with the wellhead. The only portion of the specification he identified actually discusses the setting tool *itself* being aligned with the wellhead, as opposed to the setting tool being used to align the mandrel. '053 Patent, col. 9, lines 2-6; Perkin Depo. at 24:18-25:23; 40:5-41:6. Indeed, one of ordinary skill in the art would know that a setting tool is not used for that purpose. Although something must be done to align the mandrel with the central bore of the wellhead, that is not a function performed by the setting tool. Moreover, regardless of what is in the specification, the claim language makes clear which features the setting tool is required to have, and it says nothing about the capability of aligning the mandrel with the wellhead.

4. Similarly, Mr. Perkin argues (twice) that the "stay rods" of the setting tool shown in one embodiment of the '053 invention "help guide the mandrel into the wellhead." Perkin Declaration at ¶¶ 46 and 58 (citing '053 Patent, col. 8, line 43-col. 9, line 20 and col. 9, lines 57-62). However, the cited portions of the '053 Patent say nothing at all about the stay rods being used to "guide" the mandrel into the wellhead.

5. Second, the function of the setting tool is not to ensure that "the mandrel *can be inserted* without interference," as argued by Mr. Perkin. Perkin

Declaration at ¶ 44. As clearly required by the language of the proposed amended claim, it is the setting tool itself that performs the act of "insert[ing] a bottom end of the mandrel through the wellhead," as opposed to merely facilitating that insertion by some other unspecified component.

6. The most fundamental problem with Mr. Perkin's discussion of a setting tool in ¶¶ 42-59 of his declaration is that his position is an effort to rewrite the actual language of the claims. Both proposed amended claims require that the setting tool be "arranged to insert a bottom end of the mandrel ***through*** the wellhead." After reciting this language in ¶ 41 of his declaration, Mr. Perkin spends the next 11 pages pretending that the claim uses the word "into," rather than "through." At least nine times, Mr. Perkin refers to a setting tool as inserting a mandrel "into" a wellhead, but never once makes an effort to apply the actual claim language requiring that the setting tool insert the mandrel "through" the wellhead.

7. The distinction between these two concepts is demonstrated by contrasting a portion of the '053 Patent specification with Mr. Perkin's characterization of that same portion of the patent. In ¶ 45 of his declaration, Mr. Perkin asserts that the setting tool shown in Figure 7 of the '053 Patent inserts the mandrel "*into* the well," after which the setting tool is removed. In support, he cites to column 8, lines 5-34 of the patent specification. In contrast, however, that

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