

Paper No. __

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GREENE'S ENERGY GROUP, LLC

Petitioner

v.

OIL STATES ENERGY SERVICE, L.L.C.

Patent Owner

Case IPR2014-00216

Patent No. 6,179,053

PETITIONER REPLY

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EXHIBIT LIST

Ex. #	Exhibit
1001	U.S. Pat. No. US 6,179,053 (“’053 Patent”)
1003	Canadian Pat. Appl. 2,195,118 (“Dallas ’118”)
1008	March 13, 2014 Deposition of L. Murray Dallas (“3/13/14 Dallas Dep.”)
1009	October 28, 2014 Deposition of L. Murray Dallas (“10/28/14 Dallas Dep.”)
1010	November 13, 2014 Deposition of Max R. Wood (“Wood Dep.”)
1011	November 12, 2014 Deposition of Gary R. Wooley (“Wooley Dep.”)
1012	U.S. Patent No. 6,289,993 (“Dallas ’993”)
1026	File History for Dallas ’118
2001	U.S. Patent 5,819,851 (“Dallas ’851”)
2012	Declaration of Gary R. Wooley (“Wooley Response Decl.”)
2013	Declaration of L. Murray Dallas
2015	August 8, 2014 Deposition of Donald Shackelford

I. Introduction

Greene's Energy Group, LLC's ("Petitioner" or "GEG") petition for *inter partes* review of claims 1 and 22 of U.S. Patent 6,179,053 (the "'053 patent") (Ex. 1001) was granted by the Patent Trial and Appeal Board (the "Board") on June 10, 2014. The Board instituted trial finding that Petitioner demonstrated a reasonable likelihood of prevailing on its challenge to claims 1 and 22 of the '053 patent as anticipated by Canadian Patent Application 2,195,118 ("Dallas '118") (Ex. 1003).

Oil States Energy Services, LLC ("OSES" or "Patent Owner") filed its Patent Owner Response on August 27, 2014. OSES alleges that only a single element is missing from claims 1 and 22 - the "second lockdown mechanism." OSES' position is based on three flawed claim construction arguments, one of which was presented for the first time in the Patent Owner Response.

First, OSES asserts that because the tool of Dallas '118 relies on hydraulic pressure to position the mandrel, the tool cannot "lock" the mandrel in its operative position as that term should be construed in claims 1 and 22. In fact, the '053 patent disclosure proclaims just the opposite. In the Background of the Invention, inventor Mr. Murray Dallas explained that the tool of U.S. Patent 5,819,851 (the U.S. equivalent of Dallas '118) (Ex. 2001), functioned to "**hydraulically lock** the mandrel in an operative position" (emphasis added) and was "widely accepted in the industry." '053 patent, 2:48-51, 2:58-62.

Recognizing the weakness of the first argument, OSES attempts to achieve the same goal by arguing that the phrase “without the use of hydraulic pressure” should be read into the claims to limit the way the “second lockdown mechanism” locks a mandrel in position. However, as discussed below, OSES’ proposal is contrary to the ’053 specification and claims, which actually require one embodiment of the invention to use hydraulic pressure to lock the mandrel in position.

Finally, OSES asserts that an additional undefined element, a “setting tool,” should be added to the claims and that the “second lockdown mechanism” be “separate from the setting tool.” OSES’ proposed claim construction is devoid of any support in the ’053 patent, would render the claims indefinite and does not distinguish Dallas ’118.

II. Dallas ’118 “Locks” the Mandrel in an Operative Position

OSES makes the incredible assertion that it is not possible to “lock” a mandrel in an operative position in the manner required by claims 1 and 22 with hydraulic pressure. OSES goes on to argue that Dallas ’118 cannot meet the limitations of claims 1 and 22 and is therefore not enabling because it uses hydraulic pressure. OSES’ position is contrary to the facts and the law.

OSES’ argument is based on a newly presented claim interpretation of the term “lock.” There was no need for the Board to interpret this term in its institution

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