

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BAKER HUGHES INCORPORATED
and
BAKER HUGHES OILFIELD OPERATIONS, INC.,
Petitioners

v.

PACKERS PLUS ENERGY SERVICES, INC.
Patent Owner

Case IPR2016-00598
Patent 7,861,774

MOTION TO SUBMIT SUPPLEMENTAL INFORMATION

I. STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.123(a), Petitioners move to submit the following four exhibits as supplement information that have already been served as supplement evidence: Exhibits 1015-1017, each of which is an affidavit or declaration addressing the public accessibility and therefore prior art status of Thomson (Ex. 1002), and Exhibit 1018, which is a declaration addressing the public accessibility and therefore the prior art status of Ellsworth (Ex. 1003).

Rapid Completions (exclusive licensee of Patent Owner, and acting party in this proceeding) has challenged the publication—and therefore the prior art status—of Thomson in its Preliminary Response (and as reflected in the Institution Decision) and of both Thomson and Ellsworth in its evidence objections. The challenged grounds on which trial has been instituted depend on the prior art nature of both Thomson and Ellsworth. Petitioners received authorization to file this motion after timely requesting Board authorization by email on September 22, 2016.

II. STATEMENT OF MATERIAL FACTS

1. On February 19, 2016, Petitioners filed IPR2016-00598 against claims 1-16 of U.S. Pat. No. 7,861,774 (“the ’774 Patent” – Ex. 1001). The petition raised two grounds of unpatentability: (1) claims 1-16 are obvious over Thomson (Ex. 1002, a 1997 SPE paper) and Ellsworth (Ex. 1003, a paper co-authored by one of

the inventors (Themig) and published in the proceedings of a 1999 conference in Calgary); and (2) claim 15 is obvious over Thomson, Ellsworth, and Hartley (U.S. Patent No. 5,449,039). Paper 1 at, *e.g.*, 4. The petition asserts that both Thomson and Ellsworth are prior art under Section 102(b). *Id.*

2. Ex. 1014, filed with the petition, is a February 19, 2016 declaration by Dr. Hawkes, who attended a 1999 conference on horizontal well technology at which Ellsworth was presented and distributed to registered attendees. *See* Ex. 1014 at ¶¶ 1, 2, 4. Dr. Hawkes presented a paper he co-authored at that conference. *Id.* at ¶ 2. While at the conference, he received a copy of the conference proceedings. *Id.* at ¶ 4. He compared his personal copy of the conference proceedings (which was not included in the declaration) with a copy that was included with the declaration, and confirmed that the two appeared to be the same and that the copy included with his declaration appeared to be a true and correct copy. *Id.* at ¶ 3.

3. Ellsworth (Ex. 1003) appears at pages 102-110 of Ex. 1014.

4. The earliest-claimed priority date of the '774 Patent is November 19, 2001, making the Section 102(b) critical date November 18, 2000 (the “Critical Date”). *See* Ex. 1001.

5. Rapid Completions challenged the publication of Thomson, and therefore its status as prior art, in its Preliminary Response. *See* Paper 7 at 20-25.

6. On August 22, 2016, trial was instituted on all challenged claims based on all asserted grounds. *See* Paper 8 at 11. The Board directed the parties to 37 C.F.R. § 42.64, regarding objections to evidence, and to 37 C.F.R. § 42.123, regarding the submission of supplemental information. *See id.* at 9, fn. 4.

7. Thomson includes the indicators of pre-critical date public dissemination listed by the Board on page 9 of the Institution Decision (Paper 8).

8. In its September 6, 2016 evidence objections (Paper 10), Rapid Completions again challenged the publication of Thomson, and therefore its status as prior art:

To the extent Petitioners rely on the contents of this document for the truth of the matter asserted (*for example, to establish public accessibility as a printed publication*), Rapid Completions objects to such contents as inadmissible hearsay under FRE 801 and 802 that does not fall under any exceptions, including those of FRE 803, 804, 805, or 807.

Paper 10 at 1-2 (emphasis added).

9. Also in its September 6, 2016 evidence objections, Rapid Completions challenged the publication of Ellsworth, and therefore its status as prior art, using the same language quoted above for Thomson. *See* Paper 10 at 2.

10. On September 20, 2016, Petitioners timely served on Rapid Completions supplemental evidence consisting of Exs. 1015, 1016, and 1017 described below, pursuant to 37 C.F.R. § 42.64(b)(2).

11. On September 22, 2016, Petitioners emailed Ex. 1018 (described below) to counsel for Rapid Completions, and asked whether they would oppose Petitioners' forthcoming request to file this motion.

12. Also on September 22, 2016, and one month from institution, Petitioners emailed the Board, requesting permission to file this motion. Petitioners were granted permission on September 26, 2016.

13. Ex. 1015 is a July 28, 2016 affidavit of Nancy Chaffin Hunter, the Coordinator of Acquisitions and Metadata Services at Colorado State University Libraries ("CSU Libraries") in Fort Collins, Colorado, concerning a volume of the proceedings from a Society of Petroleum Engineers ("SPE")-sponsored conference in Bahrain (the "Book") in which a copy of Thomson—identical to the Thomson of Ex. 1002 (though the quality of the images in the figures differs between the copies)—appears. The affidavit explains that CSU Libraries maintains records of the dates on which books are received and catalogued using its software. The affidavit also includes a copy of the portions of the Book showing Thomson, a copy of a publicly-accessible CSU Libraries webpage showing the bibliographic record for the Book, and copies of screenshots Ms. Hunter generated using the

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