

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 IPR2016-01496
Patent 7,134,505

MOTION FOR JOINDER WITH CASE IPR2016-00596

I. STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioners move for joinder of this IPR (the “1496 Proceeding”) with instituted IPR2016-00596 (the “596 Proceeding”), which involves the same patent, the same challenged claims, the same proposed claim constructions, the same parties, and the same expert for Petitioners. The primary reference (Lane-Wells) in the 1496 Proceeding—which Petitioners discovered several months after filing the 596 Proceeding—is different than the primary reference (Thomson) of the 596 Proceeding, but the secondary references in the 1496 Proceeding (Hartley, Echols, and Ellsworth) are the same.

Petitioners have requested permission to file a motion to change the Due Dates in the 596 Proceeding to approximate the Due Dates of the 1496 Proceeding if it is instituted. But, if allowed, this scheduling change should only minimally prejudice Patent Owner (if at all) because in the underlying litigation involving the challenged patent, the parties have stipulated to a stay that would extend through the conclusion of the 1496 Proceeding. Furthermore, no deposition of Petitioners’ expert in the 596 Proceeding has been scheduled, so consolidation would allow for only one deposition of him. Petitioners are also agreeable to any deposition time-limit, word-count, and page-limit increases that Patent Owner believes are necessary, provided Petitioners receive comparable increases.

II. STATEMENT OF MATERIAL FACTS

1. On February 12, 2016, Petitioners filed IPR2016-00596 against claims 1-7, 11, and 14-27 of U.S. Pat. No. 7,134,505 (“the ’505 Patent”). The petition raised eight grounds of unpatentability: (1) claims 1-7, 11, 14-22, and 24-26 are anticipated by Thomson (SPE Paper 37482, published in 1997); (2) claim 15 is obvious over Thomson and Hartley (U.S. Patent No. 5,449,039); (3) claims 23 and 27 are obvious over Thomson and Ellsworth (a paper co-authored by one of the inventors (Themig) and published in the proceedings of a 1999 conference in Calgary); (4) claim 11 is obvious over Thomson and Echols (U.S. Patent No. 5,375,662); (5) claims 1-7, 11, 14-22, and 24-26 are obvious over Thomson and Brown (U.S. Patent No. 4,018,272); (6) claim 15 is obvious over Thomson, Hartley, and Brown; (7) claims 23 and 27 are obvious over Thomson, Ellsworth, and Brown; and (8) claim 11 is obvious over Thomson, Echols, and Brown.

2. Petitioners became aware of Lane-Wells on or around June 20, 2016.

3. Lane-Wells was published in 1955 as part of an annual publication known as the Composite Catalog, and was not text-searchable. *See* Ex. 1002.

4. Petitioners are not aware of a corresponding patent directed to the tool (the “Tubing Port Valve”) in Lane-Wells on which Petitioners rely in this proceeding.

5. On July 30, 2016, prior to the one-year litigation bar of 35 U.S.C. § 315(b), the 1496 Proceeding was filed. Its petition includes four grounds of unpatentability: (1) claims 1-7 and 14-27 are obvious over Lane-Wells and Ellsworth; (2) claim 15 is obvious over Lane-Wells, Ellsworth, and Hartley; (3) claim 11 is obvious over Lane-Wells, Ellsworth, and Echols; and (4) claims 7 and 19 are obvious over Lane-Wells, Ellsworth, and the knowledge of a person of ordinary skill in the art (“POSITA”), as reflected, for example, in Brown and Thomson.

6. On August 24, 2016, the Board instituted the 596 Proceeding on all challenged claims and all grounds. *See* IPR2016-00596 at Paper 13.

7. On September 7, 2016, Petitioners (as Defendants) renewed a motion to stay Civil Action No. 6:15-cv-724 (“the Litigation”), in which Rapid Completions LLC, Patent Owner’s exclusive licensee and the acting party in these proceedings, sued Petitioners for allegedly infringing the ’505 Patent. *See Rapid Completions LLC v. Baker Hughes Incorporated, et al.*, Civil Action No. 6:15-cv-724-RWS-KNM at Dkt. No. 228.

8. On September 9, 2016, Rapid Completions LLC filed a response, opposing the stay, at least in part because Petitioners would not agree to estoppel under 35 U.S.C. § 315(e)(2) based on the July 29, 2016 IPR filed by co-Defendant Weatherford International, LLC (IPR2016-01517). *See id.* at Dkt. No. 229.

9. On September 16, 2016, Rapid Completions LLC and Petitioners reached an agreement in which Rapid Completions LLC would agree to an immediate stay “through all final written decisions in IPR trials instituted on presently-filed [as of September 16] IPR petitions on the 505, 634, 774, 009, and 451 patents-in-suit,” and Petitioners would agree to be estopped under Section 315(e)(2) based on the Weatherford IPR. The parties filed a notice of this stipulation and corresponding proposed order. *See id.* at Dkt. Nos. 233 and 233-1.

10. Since that filing, an issue arose about whether Petitioners should be estopped based on the Weatherford IPR, as reflected in a joint notice the parties filed on September 23, 2016. *See id.* at Dkt. Nos. 242 and 242-1; *see also id.* at Dkt. Nos. 240 and 240-1, and 241 and 241-1. In the September 23, 2016 joint notice, the parties indicate that they “believe that this issue is better addressed when and if the stay is ultimately lifted should the issue then remain.” *See id.* at Dkt. Nos. 242 and 242-1. Despite this issue, the parties remain in agreement that the Litigation should be stayed through all final written decisions in both proceedings. *See id.*

11. As of the date of this Motion, the Court has not yet granted the September 23, 2016 stipulated stay.

12. On September 20, 2016, Petitioners requested the Board’s permission to seek to change the Due Dates in the 596 Proceeding to approximate the Due

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