

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WEATHERFORD INTERNATIONAL, LLC

Petitioner,

v.

BAKER HUGHES OILFIELD OPERATIONS, LLC

Patent Owner.

Case IPR2019-00708

Patent RE46,137

**PETITIONER'S REPLY TO PATENT OWNER'S
RESPONSE TO PETITION FOR *INTER PARTES* REVIEW**

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I. INTRODUCTION

The Petition showed that Giroux anticipates claims 1-2, 4-7, 12-25, 31-35, and 41-44, and that Giroux in combination with a POSITA's knowledge, the admitted prior art, and/or Patel '853 renders claims 1-44 obvious. In the face of these assertions on February 19, 2020, Patent Owner ("PO") disclaimed claims 2-7, 12-15, 18-30, 32, 33, 35-40, 43, and 44. Paper 19 at 1. That leaves only claims 1, 16, 17, 31, 34, 41, and 42 at issue in Ground 1 and claims 1, 8-11, 16, 17, 31, 34, 41, and 42 at issue in Grounds 2 and 3. Notably, PO's apparent concession that claims 2 and 35 are invalid necessarily means that independent claims 1 and 34 from which 2 and 35 depend, respectively, are also invalid.

II. GROUND 1 – GIROUX'S PREFERRED EMBODIMENT ANTICIPATES CLAIM 1

PO's only argument that remaining claim 1 is not anticipated by Giroux's Preferred Embodiment is that the claim requires an initially-closed sleeve. PO Response (Paper 16) ("Resp.") 15. PO's reasons for such a construction fail. Resp. 3-15.

First, PO claims that without a temporal limitation, "first" and "second" would be superfluous because the two positions are already defined by other characteristics. Resp. 4. That is false. Claim 1 uses "first" and "second" as shorthand labels for closed and partially-open positions, just like claims 8 and 16.

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