UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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WEATHERFORD INTERNATIONAL, LLC,
Petitioner,

v.

BAKER HUGHES OILFIELD OPERATIONS, LLC,
Patent Owner.

_____

Case IPR2019-00708
Patent RE46,137

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PATENT OWNER'S REPLY ISO MOTION TO EXCLUDE EX. 1012'S 2011-USE STATEMENT AS HEARSAY

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I. Petitioner's New Theory Fails

"[I]f the Board ignores [the] second quarter 2011 use of the RDV," Patent Owner agrees it need not be excluded. Paper 31 ("Opp."), 2. Patent Owner disagrees, however, that Ex. 1012 would nevertheless be evidence of simultaneous invention in view of its alleged October 30, 2012 presentation date. *Id.*

For Ex. 1012 to evidence simultaneous invention, Petitioner needed to establish its valve was made "within a comparatively short space of time" around the '137 Patent's invention. *Geo. M. Martin Co. v. All. Mach. Sys. Int'l LLC*, 618 F.3d 1294, 1305-06 (Fed. Cir. 2010). Petitioner's cases show there is no bright-line rule for that space of time; instead, it depends on, *inter alia*, the state of the art at the time of the invention, the invention's contribution to that art, and the problems addressed by that contribution. *See Felburn v. New York Cent. R. Co.*, 350 F.2d 416, 426 (6th Cir. 1965) ("Felburn and Behrens, working independently, attacked the same problems at about the same time and arrived at the same solutions."). The only evidence that might speak to such a space of time is Mr. Chambers's conclusory assertion that Ex. 1012 "provides [an] example of a simultaneous invention" because its valve was allegedly used "in the second quarter of 2011." Chambers1, ¶55.

Petitioner now seeks to broaden that space of time to "[f]ifteen months" based on Ex. 1012's alleged October 30, 2012 presentation date. Opp., 2. This untimely attorney argument should be ignored. But it is also foreclosed by Mr. Chambers's

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tacit refusal to rely on that presentation date in favor of its 2011-Use Statement: Ex. 2012 "was presented at an SPE Conference … from October 30, 2012 to November 1, 2012[;h]owever, it describes [second quarter, 2011] fracturing jobs run with [its valve]." Chambers1, ¶55 (emphasis added). Patent Owner made this contention in Paper 30 (at 2), and Petitioner did not contest it. *See* Opp., 3-4 (only addressing Patent Owner's contentions regarding Exs. 1010 and 1011).

Petitioner's new, broader space of time also fails substantively. Without citing to any evidence, Petitioner contends that "[f]ifteen months (or less) is within the amount of time courts have allowed for inventions to be considered 'simultaneous.'" Opp., 2. That's true, but based on facts Petitioner lacks here. In *Geo*, the court found that a 1996 first machine and a 1998 second machine, each of which was shown to possess all but a couple, obvious features of the 2001 invention, set a "comparatively short space of time" for simultaneous invention that encompassed a 2002 third machine having the missing features. *Geo*, 618 F.3d at 1302-06 (absent the first and second machines, patentee's "argument would have more force"). Similarly, in *Felburn*, the court referenced "the numerous earlier patents" mapped to the invention to decide that "Felburn and Behrens … attacked the same problems at about the same time." *Felburn*, 350 F.2d at 425-426. *Columbia* did not address the space of time for simultaneous invention. *Trustees of Columbia Univ. v. Illumina, Inc.*, 620 F. App'x 916, 929-30 (Fed. Cir. 2015).

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But Petitioner mapped Giroux to the claims. Petition, 5-6; *see also* Chambers1, ¶¶54-55 (no mappings for any of Exs. 1010-1012). And per Mr. Chambers, Giroux is too old to establish a space of time for simultaneous invention. *See* Chambers1, ¶53 ("[b]ecause [Ex. 1009] was so much earlier"—twenty-two months (Ex. 1009, 1)—"I do not view it as simultaneous invention."); Giroux at 1 (at least 9 years before the '137 Patent's invention).

Petitioner pivots again to "other unchallenged statements in Ex. 1012" that allegedly "shorten[] any gap between its invention and the '137 Patent filing date." Opp., 3. Neither Petitioner nor Mr. Chambers relied on these statements before, and Petitioner cannot now. *See* Chambers1, ¶55 (relying exclusively on the 2011-Use Statement); Petition, 65-66 (same). This new reliance also renders those statements hearsay that should—for the same reasons as the 2011-Use Statement—be excluded.

It is not Patent Owner's burden to show that Petitioner's new 15-month space of time is too long (Opp., 3)—it was Petitioner's burden to assert it and support it. Petitioner did not and cannot. *Supra*. Finally, Petitioner argues that it did not rely on a few-month space of time. Opp., 3. But Petitioner only engages with Patent Owner's Exs. 1010 and 1011 evidence and arguments, contending that Petitioner and Mr. Chambers relied on both Ex. 1010's date (9-10 months after the '137 Patent's invention) and Ex. 1011's date (3 months before) for their allegedly common valve. *See* Chambers1, ¶54 (only addressing Ex. 1011 in any detail and

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stating that "I consider the '483 Application and the resulting '684 Patent to be an example of simultaneous invention." (emphasis added)). But that makes no sense because that valve was only invented once—per Petitioner, by Ex. 1011's date. *Id.*

II. Petitioner's Reliance on the Residual Exception Fails

"The residual hearsay exception is to be used only rarely, in truly exceptional cases." *Pozen Inc. v. Par Pharm., Inc.*, 696 F.3d 1151, 1161 n.6 (Fed. Cir. 2012) (citation omitted). Petitioner has not shown this is such a case. For example, Petitioner "has made no showing that it could not have produced, through reasonable efforts, evidence that is more probative" of the alleged 2011 use of Ex. 1012's valve as FRE 807 requires, such as "testimony from [one of Ex. 1012's authors] in the form of a declaration in this proceeding." Opp., 4; *US Endodontics, LLC v. Gold Standard Instruments, LLC*, PGR2015-00019, Paper 54 ("*US Endodontics*"), 40-42 (P.T.A.B. Dec. 28, 2016). Petitioner's conclusory statement that it could not have produced more probative evidence is insufficient to warrant application of FRE 807. *US Endodontics*, 40-42 (inapplicable when "there is no apparent reason why [a party] could not have offered testimony from [the out-of-court declarant] in the form of a declaration"); *Xactware Sols., Inc. v. Pictometry Int'l Corp.*, IPR2016-00594, Paper 46, 15-16 (P.T.A.B. Aug. 24, 2017) (not applying when the party did "not specify … why it could not have obtained 'more probative' evidence").

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