

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.

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Case IPR2019-00768

Patent RE46,137

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**MOTION TO TERMINATE AND/OR STAY EX PARTE  
REEXAMINATION NO. 90/014,418 UNDER 35 U.S.C. § 315(d)**

## I. STATEMENT OF RELIEF REQUESTED

Weatherford International, LLC (“Petitioner”) requests termination of *Ex Parte* Reexamination of U.S. Patent No. RE46,137, No. 90/014,418, or a stay pending resolution of this IPR under 35 U.S.C. § 315(d) and 37 C.F.R. § 42.122(a). The Board authorized this motion via email on February 13 and 18, 2020.

## II. STATEMENT OF RELEVANT FACTS

**Patent Owner Threatens Petitioner with ’960 Patent:** Baker Hughes Oilfield Operations, LLC (“PO”) first threatened Petitioner with U.S. Patent 8,555,960, the predecessor to RE46,137 at issue in this IPR, in July 2014. EX1013. In response, Petitioner told PO that the asserted claims of the ’960 Patent were invalid in view of Giroux, U.S. Patent 6,834,726. EX1014. The parties exchanged correspondence regarding invalidity of the ’960 claims, disputing whether the claims required an initially closed position and thereby could distinguish Giroux. EX1015; EX1016; EX1017. Petitioner also sent a claim chart to PO showing how certain claims of the ’960 Patent were invalid in view of Giroux. EX1017.

**PO Seeks Reissue of ’960 Patent Without Disclosing Giroux Issue:** PO then hatched a plan to file a reissue application in light of invalidity based on Giroux. But instead of candidly telling the PTO that the reissue was precipitated by Giroux and Petitioner’s invalidity positions, PO asserted that the basis for reissue was the omission of a method claim. EX1018 at 172. PO added new method claims 34-44

in the reissue application. *Id.* at 195-97. Without explaining to the PTO why it was doing so, PO also added new apparatus claims 23-33 that recited an “initial closed position” limitation. *Id.* at 194-95. In fact, even the new method claims 34-44 recited the “initial closed position” limitation. PO did not disclose to the PTO that this limitation was to distinguish Giroux. PO buried Giroux in an IDS as item 9 along with 64 previously-considered references. *Id.* at 141-47. PO did not submit Petitioner’s correspondence or claim chart regarding Giroux, nor did PO ever indicate any concern about validity over Giroux. In a sister IPR, the Board recently determined that Giroux likely invalidates the ’137 Patent. IPR2019-00708, slip op. at 2 (P.T.A.B. Sept. 5, 2019) (Paper 8) (Institution Decision) (finding a reasonable likelihood that independent claims 1, 19, and 21 are unpatentable over Giroux).

**PO Obtains ’137 Patent by Misrepresenting Prior Art:** During the reissue prosecution, the examiner rejected some claims based on U.S. Patent 5,819,853 (“Patel ’853”). EX1018 at 99. PO distinguished Patel ’853 by asserting that it did not disclose a piston that is “selectively isolated from passage pressure as recited by independent claim 1.” *Id.* at 65. The examiner agreed, allowing claims 1-44. *Id.* at 46. But PO’s assertion was at least misleading because Patel ’853 disclosed an example in which the piston was selectively isolated from passage (tubing) pressure, which was used to actuate the piston. EX1004 at 7:53-58, 8:5-31. Nevertheless, the reissue ’137 Patent issued on September 6, 2016, without the examiner recognizing

or resolving the validity issues concerning Giroux (which PO effectively buried) or recognizing Patel '853's disclosure. EX1018 at 10.

**Petitioner Shows PO That Its Reissued Claims Are Invalid Based on**

**Patel:** On May 1, 2017, PO again contacted Petitioner regarding PO's assertion of the '137 Patent against Petitioner. EX1038 at 3. After further correspondence based on Giroux, Petitioner asserted on March 9, 2018 that '137 Patent claims 1-44 were also invalid over U.S. Patent Application Publication 2009/0078427 ("Patel '427") and provided a claim chart to prove it. EX1039. In a response letter dated May 18, 2018, PO acknowledged Patel '427 posed a validity problem for the '137 Patent claims. PO asserted that claims 8, 16, and 31 reciting the "Urging Closed Feature" would not be invalid over Patel '427 and thus "that any *inter partes* review of the claims of the '137 Patent would not result in a finding that all claims are unpatentable." EX1040 at 2-4. In response, Petitioner observed that PO "appears to admit that the '427 application anticipates any claim without [the urging] limitation" and requested that PO confirm that. EX1041 at 1.

**PO Files Suit on Its Invalid Reissue Claims:** Notwithstanding Petitioner's charts proving the invalidity of the '137 Patent claims based on Giroux and Patel '427, on December 20, 2018, PO filed suit against Petitioner asserting willful infringement of claim 1 of the '137 Patent. EX1042 ¶ 16. When confronted again with Patel '427 in this IPR, PO conceded that claims 1-7, 12-15, 18-30, and 32-40

are anticipated by Patel '427 and, thus, that its infringement assertion against Petitioner was baseless. PO Resp. (Paper 16) at 1-2 (Petitioner only contesting patentability of “Urging Claims” and not substantively contesting anticipation of the remaining claims). In fact, PO has now disclaimed 33 of its 44 reissue claims. Paper 20 at 1. Although PO did not disclaim claim 1, its PO Response does not dispute it is anticipated by Patel '427, thus conceding invalidity. PO Resp. at 1-2. PO appears to have only retained independent claims 1 and 34 to keep its reexamination alive.

**PO Files Reexam to Avoid IPR Estoppel:** Following PO’s lawsuit, Petitioner filed IPR2019-00708 based on Giroux and filed this IPR on March 1, 2019, asserting that Patel '427 anticipates most of the '137 Patent claims and renders obvious the rest in combination with other art. Pet. (Paper 2) at 5. The Board instituted this IPR (Paper 8), and PO filed a patent owner response on December 17, 2019 (Paper 16). On the same day PO’s response was originally due (*see* Paper 13 at 1), PO requested reexamination of the '137 Patent. EX1043 at 1. PO’s request relied only on Patel '427 and Weatherford’s arguments from this IPR. *Id.* at 19-36.

PO’s reexam request also proposed 53 new claims, which are nearly identical to the original claims. *Id.* at 5-12. For example, claim 45 adds only very minor features beyond claim 1, such as “said port is covered by said sleeve” when closed, “said sleeve is farther from an end of said valve than is said port” when open, and “a rupture disc.” *Compare* EX1001 at 4:42-51 *with* EX1043 at 5. On January 29, 2020,

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