

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 IPR2019-00768
Patent RE46,137

**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO
STAY OR TERMINATE THE *EX PARTE* REEXAMINATION**

PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Shorthand	Description
2001	Fleckenstein	Declaration of William W. Fleckenstein, Ph.D, PE (CA#1666)
2002	Chambers1	Declaration of Michael Chambers, filed in IPR2019-00708 as EX1005
2003		Not used
2004	ChambersDepo.	Transcript of Michael Chamber's November 21, 2019 Deposition
2005	N/A	Disclaimer Filed in U.S. Patent No. RE46,137 on February 19, 2020
2006	Answer	Weatherford International, LLC's Answer, Affirmative Defenses, and Counterclaims to Plaintiff's Original Complaint (Dkt. 9 in Civil Action No. 4:18-cv-4797 (S.D. Tex.))
2007	N/A	January 30, 2020 – February 18, 2020 E-mail Correspondence Between Board and Parties Regarding Petitioner's Renewed Request to File Motion to Terminate and/or Stay Reexam Under Section 315(d)
2008	N/A	Reexamination Operational Statistics from the U.S. Patent and Trademark Office (updated Dec. 2017), https://www.uspto.gov/sites/default/files/documents/Website_Operational_Statistics.pdf

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I. Petitioner Has Not Established a Basis for Terminating the Reexamination.

Petitioner's request to terminate the reexam for gamesmanship should be denied. Petitioner's termination analysis is based on its allegation that the '137 Patent was "fraudulently-obtained." Paper 21 at 5. But that is an issue before the district court. *See* Answer at 8-20 (describing allegations involving Giroux and Patel '853 underlying counterclaim of unenforceability for inequitable conduct), 20-21 (describing allegations underlying counterclaim for unenforceability for unclean hands). Petitioner fails to cite any decision, rule, or statute giving the Board authority to address such an issue when deciding a motion to terminate under Section 315(d). *See* Paper 21 at 1-7; EX2007 at 3 (Petitioner citing Section 315(d) as the basis for requested relief). And the Board has declined to speculate on how a district court might decide an issue before it while evaluating gamesmanship allegations. *Proppant Express Invs., LLC v. Oren Techs., LLC*, IPR2017-01917, Paper 86 at 15 (P.T.A.B. Feb. 13, 2019) (precedential).

Moreover, the alleged gamesmanship concerns acts that occurred in or pertain to other proceedings (Paper 21 at 1-7¹), aside from filing the subject reexam, which

¹ Rule 22(c) specifies that a motion may include a "statement of material fact." 37 C.F.R. § 42.22(c) (emphasis added). Petitioner's motion contains something called a "Statement of Relevant Facts." Paper 21 at 1. In addition to this wording

the Board recognized the Office has expressly suggested (Paper 17, 1-2). *See Aerospace Commc'ns Holdings Co. v. Armor All/Step Prods. Co.*, IPR2016-00441, Paper 12 at 5 (P.T.A.B. June 28, 2016) (“Furthermore, any alleged ‘gamesmanship’ concerning service of process occurred in another proceeding.”); *see also Proppant Express*, Paper 86 at 10-11 (identifying as a “distinct deficienc[y]” that alleged prejudice occurred in another forum involving a claim not before the Board). Thus, those alleged acts do not support Petitioner’s termination position here.

The *Ariosa* decision also does not help Petitioner. Under *Ariosa*, the Board has authority to base a reexam termination decision on the “totality of the circumstances.” *Ariosa Diagnostics, Inc. v. Illumina, Inc.*, IPR2014-01093, Paper 81 at 16 (P.T.A.B. May 24, 2016); *see also Emerson Elec. Co. v. SIPCO, LLC*, IPR2017-00359, Paper 62 at 17 (P.T.A.B. Mar. 21, 2019). But *Ariosa* is otherwise

difference, Petitioner’s statement is not set forth in the format described in Rule 22(c) as “preferabl[e]” (i.e., one numbered sentence for each alleged fact), and Petitioner’s alleged “facts” include several characterizations of Patent Owner’s intent and/or mental statement that are unsupported by its citations (Paper 21 at 1-2). Petitioner’s statement therefore does not fall within the scope of Rule 22(c), nor does it appear Petitioner intended it to. Accordingly, Patent Owner is not obligated to provide a listing of admissions or denials under 37 C.F.R. § 42.23(a).

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