

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 MOTION TO EXCLUDE EX. 1012'S
2011-USE STATEMENT AS HEARSAY**

I. Introduction

Patent Owner objected to Ex. 1012's statement that an "operator ... began incorporating [Ex. 1012's] valve in the second quarter of 2011" ("2011-Use Statement") (Ex. 1012 at 4) as hearsay. Paper 10 at 1. Petitioner offered no supplemental evidence to cure that objection.

Petitioner relies on the 2011-Use Statement to argue that Ex. 1012 is evidence of simultaneous invention (Petition at 65-66), but that statement is hearsay to which no exception applies. The Board should therefore exclude it.

II. Ex. 1012 Cannot Be Evidence of Simultaneous Invention Without Its 2011-Use Statement

Petitioner sets the required "comparatively short space of time" within which the alleged simultaneous inventions were made at a few months. *Geo M. Martin Co. v. Alliance Mach. Sys. Int'l LLC*, 618 F.3d 1294, 1305 (Fed. Cir. 2010) (cited in Petition at 65). That space of time cannot be as long as twenty-two months: "[b]ecause [Ex. 1009] was so much earlier"—twenty-two months (Ex. 1009 at 1)—"I do not view it as simultaneous invention." Chambers at ¶ 52 (cited in Petition at 65-66). It also cannot be as long as 9-10 months in view of Petitioner's and Mr. Chambers's reliance on Ex. 1011 to establish a May 2011 priority date for Ex. 1010 despite its May 2012 filing date. Petition at 65-66; Chambers at ¶ 53 ("Thus, the provisional application was filed nearly three months before the earliest filing date for the '137 Patent" and discussing only Ex. 1011 in any detail (emphasis added))

(cited in Petition at 65-66). Petitioner and Mr. Chambers eschewed reliance on Ex. 1012’s alleged October-November 2012 publication date—fifteen months after the ’137 Patent’s invention—in favor of its 2011-Use Statement, which allegedly places Ex. 2012’s valve within a few months of the ’137 Patent’s invention. Petition at 65-66; Chambers at ¶ 54 (Ex. 1012 “was presented ... from October 30, 2012 to November 1, 2012[; h]owever, it describes [second quarter, 2011] fracturing jobs run with [its] hydraulically actuated sleeve” (emphasis added)) (cited in Petition at 55-56).

Absent the 2011-Use Statement, Ex. 1012 does not fit Petitioner’s simultaneous invention case.

III. The 2011-Use Statement Is Hearsay

The 2011-Use Statement is hearsay because it was made out of court, and Petitioner offers it to prove that what it asserts is true. FRE 802; Petition at 65-66 (characterizing Ex. 1012 as “a substantially similar sleeve used in the second quarter of 2011” (emphasis added)); Chambers at ¶ 54 (introducing the 2011-Use Statement

with “[i]n fact” and concluding based on the same that “[t]his operator thus began using the RDV in wells in the second quarter of 2011.”) (cited in Petition at 65-66)).

IV. Conclusion

The 2011-Use Statement is both relied on by Petitioner and is hearsay to which no exception applies. The Board should therefore exclude it.

Dated: May 20, 2020

Respectfully submitted,

/Mark T. Garrett/

Mark T. Garrett (Reg. No. 44,699)

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on May 20, 2020, a copy of Patent Owner's Motion to Exclude Ex. 1012's 2011-Use Statement as Hearsay was served on Lead and Backup Counsel for Petitioner via email (by consent) to:

Lead Counsel: Douglas R. Wilson (Reg. No. 54,542)
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