

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.

IPR2019-00768
Patent RE46,137 E

Before MITCHELL G. WEATHERLY, JON B. TORNQUIST, and
RYAN H. FLAX, *Administrative Patent Judges*.

WEATHERLY, *Administrative Patent Judge*.

ORDER
Staying Reexam
37 C.F.R. § 42.122(a); 35 U.S.C. § 315(d)

I. INTRODUCTION

In this proceeding, we instituted *inter partes* review as to claims 1–44 of U.S. Patent No. RE46,137 E (Ex. 1001, “the ’137 patent”). *See* Paper 8. Patent Owner filed a request for *ex parte* reexamination of claims 2, 4–7, 12–15, 18, 19, 23–30, 32–40, 43, and 44 the ’137 patent. Ex. 1043, 1. The Office granted the request in Reexamination Control No. 90/014,418 (the

“Reexam” or “Reexamination”) and further included independent claim 1 within the scope of the reexamination because claims depending from claim 1 “cannot be reexamined without a reexamination of claim 1.” Ex. 1044, 3. Thus, claims 1, 2, 4–7, 12–15, 18, 19, 23–30, 32–40, 43, and 44 of the ’137 patent are subject to reexamination.

The Board has authority to stay or terminate a reexamination involving a patent challenged in an *inter partes* review. 37 C.F.R. § 42.122(a) (2019); *see also* 35 U.S.C. § 315(d) (2012). For the reasons discussed below, we determine that it is appropriate to stay the Reexamination.

II. FACTUAL AND PROCEDURAL BACKGROUND

We instituted review of claims 1–44 in this proceeding on September 5, 2019. Paper 8. Patent Owner filed its request for *ex parte* reexamination on December 9, 2019. Ex. 1043, 36. Without conceding that the claims are unpatentable, the request set forth that Patel ’427 raised a substantial new question of patentability (“SNQ”) under 35 U.S.C. § 303(a) with respect to claims 2, 4–7, 12–15, 18, 19, 23–30, 32–40, 43, and 44 of the ’137 patent, based, in part, upon Petitioner’s argument in this proceeding that Patel ’427 anticipates claims 2, 4–7, 12–15, 18, 19, 23–30, 32–40, 43, and 44. Ex. 1043, 4, 13. Patent Owner also sought entry of new claims 45–97. *Id.* at 5–12.

On January 29, 2020, the Examiner ordered reexamination as to claims 2, 4–7, 12–15, 18, 19, 23–30, 32–40, 43, and 44. The Examiner further ordered reexamination of all other original claims of the ’137 patent and indicated that the newly presented claims would also be entered and

examined in view of the similarities to the claims for which Patent Owner requested reexamination. Ex. 1044, 11.

We authorized Petitioner via e-mails on February 13 and 18, 2020, to file a motion to terminate or stay the Reexam and Patent Owner to file an opposition. Petitioner filed its Motion to Terminate and/or Stay. Paper 21 (“Mot.” or “Motion”). Patent Owner filed its opposition to the Motion. Paper 23 (“Opp.” or “Opposition”). Before filing the Opposition, Patent Owner filed a statutory disclaimer of claims 2–7, 12–15, 18–30, 32, 33, 35–40, 43, and 44. Opp. 4; Ex. 2005. Therefore, of the claims in the ’137 patent, only claims 1, 8–11, 16, 17, 31, 34, 41, and 42 remain in this proceeding and the Reexamination (the “Remaining Claims”).

III. TERMINATION OF THE REEXAM

We have reviewed Petitioner’s arguments for terminating the Reexam to foreclose alleged “gamesmanship” by Patent Owner before the Office. Mot. 5–7. We determine that Petitioner’s arguments are unpersuasive because they are based upon speculation about Patent Owner’s allegedly improper intent to delay resolution of the dispute between the parties. Moreover, Patent Owner’s filing of a request for reexamination during an *inter partes* review is expressly recognized as proper by the Office. *See* Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding, 84 Fed. Reg. 16,654, 16,656 (Apr. 22, 2019) (“Notice Regarding Amendment Options”). Accordingly, we deny Petitioner’s motion for termination of the Reexam.

IV. STAY OF THE REEXAM

Office guidance outlines factors the Board considers in AIA trials in deciding whether to stay a parallel reexamination involving the same patent. Notice Regarding Amendment Options, 84 Fed. Reg. at 16,657. Based on our consideration of each of those factors as described below, we grant Petitioner's motion for a stay of the Reexam.

A. Whether the claims challenged in the AIA proceeding are the same as or depend directly or indirectly from claims at issue in the concurrent parallel Office proceeding

All Remaining Claims are subject to reexamination and review in this proceeding. Accordingly, this factor favors a stay.

B. Whether the same grounds of unpatentability or the same prior art are at issue in both proceedings

Both proceedings involve analysis of the patentability of the claims in view of Patel '427 as the primary reference. Patent Owner points out that other references may be cited as a basis for examination of the newly added claims in the Reexam. Opp. 4. However, the newly presented claims recite many substantively similar limitations as the Remaining Claims. *Compare, e.g., Ex. 1043 (claim 45), with Ex. 1001, 4:42–51 (claim 1).* Moreover, the focus on Patel '427 as a primary reference in both proceedings favors staying the Reexam so that we can complete our analysis of the Remaining Claims in view of Patel '427. This factor favors a stay.

C. Whether the concurrent parallel Office proceeding will duplicate efforts within the Office

Because the Remaining Claims and Patel '427 are also at issue in the Reexam, allowing both to proceed concurrently would duplicate efforts within the Office. This factor favors a stay.

D. Whether the concurrent parallel Office proceeding could result in inconsistent results between proceedings (e.g., whether substantially similar issues are presented in the concurrent parallel Office proceeding)

The Reexam and this proceeding address all Remaining Claims and Patel '427, which raises the possibility of inconsistent analyses by the Board and the Examiner. This factor favors a stay.

E. Whether amending the claim scope in one proceeding would affect the claim scope in another proceeding

Patent Owner has submitted a preliminary amendment in the Reexam that seeks to add 53 new claims to the '137 patent. Ex. 1043, 5–12. Our analysis of Patel '427 as it applies to the Remaining Claims may affect the manner in which the Examiner applies Patel '427 and other prior art during the Reexam. This factor favors a stay.

F. The respective timeline and stage of each proceeding

This proceeding is at an advanced stage, and the Reexam is at a relatively early stage, before a first office action. The deadline for entering a final decision in this proceeding is no later than September 4, 2020. A decision in this case would likely occur before a decision in the Reexam rendering the Board the preferred forum for addressing common issues. This factor favors a stay.

G. The statutory deadlines of the respective proceedings

This proceeding is subject to a statutory deadline that requires a final decision by no later than September 4, 2020, absent a rare extension. 35 U.S.C. § 316(a)(11). The Reexam is required to be conducted with “special dispatch,” but is not subject to a specific statutory deadline. 35 U.S.C. § 305. This factor favors a stay.

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