

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 and JON B. TORNQUIST
Administrative Patent Judges.

WEATHERLY, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

I. BACKGROUND

Via e-mail to the Board on December 19, 2019, Petitioner requested authorization to file a motion to terminate or stay *ex parte* Reexamination Control No. 90/014,418, in which a Request for *Ex Parte* Reexamination was filed on December 9, 2019 (the “Request”). The Office has expressly

suggested that a patent owner may seek *ex parte* reexamination of claims at issue in an ongoing *inter partes* review as follows:

[P]atent owners may avail themselves of a reissue application or a request for reexamination before, during, or after an AIA trial proceeding results in a final written decision, as long as the application or request is timely filed as discussed above (i.e., before the Office issues a certificate that cancels all relevant claims, or before the Federal Circuit issues a relevant mandate, as applicable).

Notice Regarding Options for Amendments by Patent Owner through Reissue or Reexamination During a Pending AIA Trial Proceeding, 84 Fed. Reg. 16654, 16655 (April 22, 2019).

Also on December 19, Patent Owner informed the Board via e-mail that the Office had not yet ordered an *ex parte* reexamination. Based on PTO records, we have verified Patent Owner's assertion. Patent Owner also informed the Board that it "intends to disclaim several claims." Because an *ex parte* reexamination has not yet been ordered by the Office, we determine that authorizing the requested motion to terminate or stay is premature. If, and when, the Office orders an *ex parte* reexamination, we will entertain a renewed request from Petitioner for authorization to file such a motion.

II. ORDER

For the reasons given, it is:

ORDERED that Petitioner's request for authorization to move to terminate or stay Reexamination Control No. 90/014,418 is *denied* without prejudice;

FURTHER ORDERED that, Patent Owner is *ordered* to notify the Board immediately of any action taken by the Office in response to Patent

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Owner's Request in Reexamination Control No. 90/014,418 by filing
updated mandatory notices pursuant to 37 C.F.R. § 42.8(b)(2); and

FURTHER ORDERED that Patent Owner shall promptly notify the
Board of any action taken to disclaim or cancel any claim of U.S. Patent
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