

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF TEXAS
HOUSTON DIVISION

C&M OILFIELD RENTALS, LLC D/B/A
C-MOR ENERGY SERVICES,

Plaintiff,

V.

ENSIGN US SOUTHERN DRILLING
LLC,

Defendant.

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CIVIL ACTION NO. 4:22-CV-00965

ENSIGN’S SUPPLEMENTAL PRELIMINARY INVALIDITY
CONTENTIONS

I. Introduction

Pursuant to Plaintiff’s April 19 2023 invitation for Ensign to supplement and pursuant to the Southern District of Texas’s Patent Local Rules 3-3 (*Preliminary Invalidity Contentions*) and 3-4 (*Document Production Accompanying Preliminary Invalidity Contentions*), Defendant Ensign US Southern Drilling LLC (“Ensign”) hereby submits its Supplemental Preliminary Invalidity Contentions and Document Production.

Plaintiff served Ensign with Plaintiff’s Disclosure of Asserted Claims and Preliminary Infringement Contentions for U.S. Patent Nos. 10,976,016 and 10,900,626 pursuant to P.R. 3-1 and 3-2, wherein Plaintiff alleged infringement of claims 1-2, and 23 of the ’016 patent and claims 9 and 19 of the ’626 patent. Ensign timely served its Preliminary Invalidity Contentions and Plaintiff invited Ensign to supplement those. The original Preliminary Invalidity Contentions and the Supplemental Invalidity Contentions are collectively referred to as “Preliminary Invalidity Contentions” or “Invalidity Contentions” unless the connotation suggests otherwise.

Ensign does not provide any Preliminary Invalidity Contentions regarding any claims not

asserted against Ensign. To the extent Plaintiff is permitted to assert additional claims against Ensign in the future, Ensign reserves all rights to disclose new or supplemental invalidity contentions regarding such claims.

In these Invalidity Contentions, with respect to each Asserted Claim, Ensign: (i) identifies each currently known item of prior art that either anticipates or renders obvious each Asserted Claim; (ii) specifies whether each such item of prior art anticipates or renders obvious the applicable claims; (iii) submits charts for illustrative prior art references identifying where each limitation of each Asserted Claim is disclosed or rendered obvious by the prior art; and (iv) identifies the grounds for invalidating the Asserted Claims based on enablement and/or written description under 35 U.S.C. § 112. Ensign reserves the right to supplement these Invalidity Contentions pursuant to the Federal Rules of Civil Procedure, the Court's Local Rules, or any other order or schedule entered by the Court.

II. General Statements and Objections

Ensign's Preliminary Invalidity Contentions are based on Ensign's knowledge, understanding, and belief as to the facts and information available as of the date of these Preliminary Invalidity Contentions. Discovery in the case is proceeding and Ensign has not yet completed their investigation, collection of information, discovery, or analysis relating to this action, and additional discovery may require Ensign to supplement or modify these contentions. For example, Plaintiff has not produced all of the information relevant to Ensign's counterclaims and defenses. For these and other reasons, including those set forth below, Ensign reserves the right to further supplement or alter the positions taken and information disclosed in these Preliminary Invalidity Contentions including, without limitation, the prior art and grounds of invalidity set forth herein, to take into account information or defenses that may come to light as a result of these continuing efforts. Ensign

further reserves the right to introduce and use such supplemental materials at trial.

Ensign provides the information below and in the attached claim charts, as well as the accompanying document production, in a good faith effort to comply with the Local Rules and the Court's Scheduling Order. Ensign reserves the right to amend, modify, and/or supplement these Preliminary Invalidity Contentions. In addition, Ensign reserves the right to prove the invalidity of the Asserted Claims on bases other than those required to be disclosed in these Preliminary Invalidity Contentions.

A. Plaintiff's Infringement Contentions

These Preliminary Invalidity Contentions are made in response to Plaintiff's Infringement Contentions. Should Plaintiff modify any assertion or contention in Plaintiff's Infringement Contentions, Ensign reserves the right to supplement or otherwise amend these Preliminary Invalidity Contentions and the accompanying document production. Ensign notes that Plaintiff's Infringement Contentions are deficient in a number of respects, including without limitation, relying on allegations made upon insufficient evidence, incorrect reasoning, and positions in direct conflict with the plain meaning of the claims. By setting forth their Preliminary Invalidity Contentions in response to Plaintiff's Infringement Contentions, Ensign does not waive their objections to Plaintiff's deficient Infringement Contentions, nor do Ensign's Preliminary Invalidity Contentions acquiesce to or implicitly agree with any of the reasoning, analysis, conclusions, or other basis set forth in Plaintiff's Infringement Contentions.

B. Claim Construction

The Court has not yet construed the Asserted Claims of either patent. Ensign reserves the right to identify other prior art or to supplement these Preliminary Invalidity Contentions because Ensign's position on invalidity of certain claims may depend on how those claims are construed by the Court. Ensign's Preliminary Invalidity Contentions are based, at least in part, on their present

understanding of the Asserted Claims and/or their present understanding of the claim constructions Plaintiff appears to be using—based on Plaintiff’s Infringement Contentions— whether or not Ensign agrees with such claim constructions.

To the extent that these Preliminary Invalidity Contentions reflect constructions of claim terms that may be consistent with or implicit in Plaintiff’s Infringement Claim Charts, no inference is intended or should be drawn that Ensign agree with such claim construction(s). Ensign takes no position on any matter of claim construction in these Preliminary Invalidity Contentions. Any statement herein describing or tending to describe any claim element is provided solely for the purpose of understanding the relevant prior art. Ensign expressly reserves the right to propose any claim construction they consider appropriate and/or to contest any claim construction they consider inappropriate. Indeed, Ensign may disagree with Plaintiff’s interpretation of the meaning of many terms and phrases in the Asserted Claims.

Similarly, nothing stated herein shall be treated as an admission or suggestion that Ensign agree with Plaintiff regarding either the scope of any of the Asserted Claims or the claim constructions advanced directly or implicitly by Plaintiff. Additionally, nothing in these Preliminary Invalidity Contentions shall be treated as an admission that any accused product meets any limitations of any of the Asserted Claims.

Ensign anticipates the Court’s construction of claim terms may significantly affect the scope of the Asserted Claims. Therefore, Ensign reserves the right to supplement or modify these Preliminary Invalidity Contentions based upon any future claim construction ruling.

C. Ongoing Discovery and Disclosures

Ensign provides these Preliminary Invalidity Contentions as provided for in the Scheduling Order in this matter. Discovery in this case is ongoing, however, and Ensign’s investigation, including Ensign’s search for prior art, is ongoing. Ensign therefore reserves the right to further

supplement or alter the positions taken and information disclosed in these Preliminary Invalidity Contentions including, without limitation, the prior art and grounds of invalidity set forth herein, to take into account information or defenses that may come to light as a result of these continuing efforts. Ensign hereby incorporates by reference the testimony of any fact witnesses that are deposed, that provide declarations, or that otherwise testify in this lawsuit or related lawsuits such as the Apollo and Nabors lawsuits with C&M. Ensign also hereby incorporates by reference the forthcoming reports and testimony of Ensign's expert witnesses regarding invalidity of the patents. Ensign incorporates and reserves the right to rely upon any and all prior art references and/or other invalidity or unenforceability defenses or claims asserted in the Apollo or Nabors pleadings, the Apollo or Nabors Invalidity Contentions, or in the Apollo or Nabors expert reports in the cases of *C&M v. Apollo Lighting*, Case No.21-cv-00544, Western District of Texas, Waco Division and/or *Nabors v. C&M*, Case No. 4:22-cv-02140. Southern District of Texas, Houston Division. In addition, Ensign reserves the right to rely upon any invalidity defenses asserted and/or raised in any USPTO proceeding including, but not limited to, any *inter parte review* petition involving any asserted patent.

Ensign bases these Preliminary Invalidity Contentions on their current knowledge and understanding of the Asserted Claims, Plaintiff's Infringement Contentions, the prior art, and other facts and information available as of the date of these contentions. Ensign has not yet completed their investigation, collection of information, discovery, or analysis relating to this action, and additional discovery may require Ensign to supplement or modify these contentions. For example, Plaintiff has not produced all of the information relevant to Ensign's claims, counterclaims and defenses. Ensign therefore reserves the right to further supplement or alter the positions taken and information disclosed in these Preliminary Invalidity Contentions including, without limitation, the prior art and grounds of invalidity set forth herein, to take into account information or defenses that

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