

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HALLIBURTON ENERGY SERVICES, INC.,
Petitioner,

v.

SCHLUMBERGER TECHNOLOGY CORPORATION,
Patent Owner.

Case IPR2017-01779
Patent 8,220,543 B2

Before HYUN J. JUNG, JEREMY M. PLENZLER, and
JAMES J. MAYBERRY, *Administrative Patent Judges*.

PLENZLER, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Halliburton Energy Services, Inc. (“Petitioner”) filed a Petition to institute an *inter partes* review of various claims from U.S. Patent No. 8,220,543 B2 (“the ’543 patent”). Paper 2 (“Pet.”). In our Decision Denying Institution, we determined that Petitioner had failed to establish a reasonable likelihood of prevailing at trial on any of the claims challenged in the Petition. Paper 17 (“Decision” or “Dec.”). Petitioner requests rehearing of that Decision. Paper 18 (“Request” or “Req. Reh’g”). Having considered Petitioner’s arguments, the Request is denied for the reasons provided below.

II. STANDARD OF REVIEW

When considering a request for rehearing, the Board reviews its decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may arise if the decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if an unreasonable judgment is made in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). We further note that 37 C.F.R. § 42.71(d) states:

The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

III. ANALYSIS

Petitioner's Request alleges that "the Board was misled by Patent Owner" (Req. Reh'g 1) and, as a result, we misapprehended Dusterhoft's extreme overbalanced perforating embodiment (*id.* at 4–8) and the scope of claims 32 and 42 (*id.* at 8–11).

The Request centers on the proper understanding of claim 32's recitation of "jetting a slurry into a formation in the interval to bypass near wellbore damage in the formation," and claim 42's corresponding recitation of "a . . . source to . . . supply a slurry to cause the jetting sub to produce jets to bypass near wellbore damage in the formation," and whether Dusterhoft's extreme overbalanced perforating embodiment teaches those limitations.

Initially, we note that our decision to deny institution was based on Petitioner's failure to establish a reasonable likelihood of success at trial based on the argument and evidence provided in the Petition, rather than accepting Patent Owner's representations regarding Dusterhoft. *See* Dec. 8 ("Based on the record before us, we are apprised of no persuasive reason as to why the combined teachings of Dusterhoft and Willett teach jetting a slurry into a formation in the interval "to bypass near well bore damage in the formation.")). Further, as we noted in our Decision, the Petition offers essentially no explanation as to why Dusterhoft teaches "bypass[ing] near wellbore damage in the formation" in the manner recited in the claims. *See id.* at 6–7 ("[T]he challenge's only discussion of 'bypass[ing] near wellbore damage in the formation' is a conclusory statement at the beginning of the portion of the Petition directed to that limitation . . . a quote from Dusterhoft . . . and a conclusion at the end of the relevant discussion that 'a [person of ordinary skill in the art] would understand Dusterhoft in view of Willett

teaches jetting a slurry into a formation in the interval “to bypass near well bore damage in the formation.””).

Even if the additional explanation, provided for the first time in the Request, is correct, the problem is that explanation is not in the Petition. It is Petitioner’s obligation to explain its challenges in the Petition. Any alleged misrepresentation by Patent Owner does not change this obligation.

For at least these reasons, Petitioner does not apprise us of sufficient basis to reconsider our Decision.

IV. ORDER

For the reasons given, it is

ORDERED that Patent Owner’s Request for Rehearing is *denied*.

IPR2017-01779
Patent 8,220,543 B2

PETITIONER:

Henry A. Petri
James P. Murphy
POL SINELLI PC
hpetri@polsinelli.com
jpmurphy@polsinelli.com

PATENT OWNER:

Michael L. Kiklis
Christopher Ricciuti
Lisa Mandrusiak
Marc K. Weinstein
OBLON, MCCLELLAND, MAIER & NEUSTADT, LLP
CPDocketKiklis@oblon.com
CPDocketRicciuti@oblon.com
CPDocketmandrusiak@oblon.com
CPDocketWeinstein@oblon.com