

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INNOVEX DOWNHOLE SOLUTIONS, INC.,  
Petitioner,

v.

BAKER HUGHES OILFIELD OPERATIONS, LLC,  
Patent Owner.

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Case IPR2019-00158  
Patent 9,080,439 B2

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Before MITCHELL G. WEATHERLY, BEVERLY M. BUNTING, and  
RYAN H. FLAX, *Administrative Patent Judges*.

BUNTING, *Administrative Patent Judge*.

DECISION  
Denying Request for Rehearing  
37 C.F.R. § 42.41(d)

## I. INTRODUCTION

Innovex Downhole Solutions, Inc., (“Petitioner”) filed a Petition (Paper 1, “Petition” or “Pet.”) requesting an *inter partes* review of claims 1–23 (“the challenged claims”) of U.S. Patent No. 9,080,439 B2 (Ex. 1003, “the ’439 patent”). Baker Hughes Oilfield Operations, LLC, (“Patent Owner”) filed a Preliminary Response to the Petition (Paper 6, “Prelim. Resp.”). On April 15, 2019, we entered a Decision on Institution (Paper 9, “Decision” or “Dec.”) in this proceeding, determining that Petitioner had demonstrated a reasonable likelihood that it would prevail in showing the unpatentability of at least one challenged claim of the ’439 patent. Dec. 33. Patent Owner timely filed this Request for Rehearing of the Decision. Paper 12 (“Request” or “Req. Reh’g.”).

We have considered Patent Owner’s Request. For the reasons that follow, Patent Owner’s Request is denied.

## II. ANALYSIS

When considering a request for rehearing, the Board reviews its decision for an abuse of discretion. 37 C.F.R. § 42.71(c). On rehearing, the burden of showing that the Decision should be modified lies with the party challenging the Decision, in this case, Patent Owner. 37 C.F.R. § 42.71(d). A request for rehearing must identify specifically all matters the requesting party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d). In our Decision, when considering the meaning and scope of the claim language, we “preliminarily determine[d] that the term *tool* is used merely as a generic placeholder meant to cover ‘the corresponding structure, material, or acts described in the specification and equivalents thereof.’” Dec. 16. Based on this understanding, we preliminarily agreed with

Petitioner’s proposed construction of *tool*, and construed *tool* “as a means-plus-function limitation having the function of imparting a deforming force on the deformable member, and the corresponding structure is a wedge, swage, shoulder, cone, ramp, mandrel, plug, and dart, as exemplified by tools 102, 122 and 142 disclosed in the ’439 patent.” *Id.* at 17–18. In its Preliminary Response, other than disputing Petitioner’s proposed construction, Patent Owner did not advance its own construction of *tool*. Prelim. Resp. 21–45. Now, Patent Owner’s stated basis for requesting rehearing is that we erred in preliminarily interpreting *tool* as a means-plus-function (“MPF”) term. Req. Reh’g. 1.

*A. That the Board Misapprehended the MPF Standard*

In Patent Owner’s view, we misapprehended “the MPF standard” because: (1) “[t]he presumption against MPF construction is not overcome merely because a term refers to multiple structures” (Req. Reh’g. 3–6); and (2) “that a term is functionally limited does not overcome the presumption against MPF construction” (*id.* at 6–7).

As to its first contention, Patent Owner asserts that the term *tool* “is presumed to convey structure to a POSITA” and this presumption is not overcome if “the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure.” *Req. Reh’g.* 3 (citing *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1349 (*Fed. Cir.* 2015)). Patent Owner supports its position that, despite invoking a variety of different physical structures as indicated in the ’439 patent’s specification, a POSITA would understand the term *tool* as having sufficiently definite meaning so as to identify a distinct structure. *Id.* (citing *Personalized Media Commc’ns, LLC v. Int’l Trade Comm’n*, 161 F.3d 696, 705 (*Fed. Cir.* 1998); *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91

F.3d 1580, 1583 (Fed. Cir. 1996)). Patent Owner further supports its position by simply disputing the testimony of Petitioner’s declarant, Dr. Rodgers. *Id.* at 4–6 (citations omitted).

At this stage, regarding Patent Owner’s first contention, the mere fact that Patent Owner argues *tool* conveys a sufficiently definite structural meaning does not make it so without evidence to support that contention. *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974) (“Attorney’s argument in a brief cannot take the place of evidence.”). Additionally, Patent Owner’s argument is unsupported by evidence, but Petitioner’s arguments on claim interpretation are supported by the intrinsic record as described in the Decision. Accordingly, we have not misunderstood the evidence before us or incorrectly applied the law to the evidence of record.

As to its second contention, i.e., that we “misapprehended the standard for functionally-constrained terms” by relying on the specification, Patent Owner argues that based on controlling law, “that structures covered by a term may be constrained to those with a certain function does *not* support MPF treatment.” Req. Reh’g. 6 (citing *Greenberg*, 91 F.3d at 1583 (“[T]hat a particular mechanism . . . is defined in functional terms is not sufficient to convert a claim element containing that term into a ‘means for performing a specified function’ within the meaning of section 112(6).); and *Personalized Media*, 161 F.3d at 705 (“[N]either the fact that a ‘detector’ is defined in terms of its function, nor the fact that the term ‘detector’ does not connote a precise physical structure in the minds of [POSITAs] detracts from the definiteness of structure.”)).

Patent Owner’s disagreement with our preliminary construction of the claim language does not mean that we misapprehended what Patent Owner refers to as the “MPF standard.” The Decision reflects that the panel

recognized that a presumption that *tool* is not subject to 35 U.S.C. § 112, ¶ 6 exists because the claim does not recite “means,” and we further noted that this presumption may be overcome when “the claim term fails to ‘recite sufficiently definite structure’ or else recites ‘function without reciting sufficient structure for performing that function.’” Dec. 13 (citing *Williamson*, 792 F.3d at 1349 (quoting *Watts*, 232 F.3d 877, 880)). Using the guidance from *Williamson*, we considered “whether the claims recite function without reciting sufficient structure in the context of 35 U.S.C. 112, para 6.” *Id.* (citing *Williamson* 792 F. 3d at 1350 (noting that “module” is simply a generic description for software or hardware that performs a specific function)). Our preliminary construction was not based on whether *tool* referred to one specific structure or multiple structures as Patent Owner suggests in its Request. Indeed, we considered Patent Owner’s unsupported attorney arguments regarding a POSITA’s understanding of the term *tool*, as well as Patent Owner’s unsupported attorney arguments concerning Dr. Rodgers’s testimony, and did not find such arguments convincing in view of the record before us.

*B. That the Board Misapprehended that Petitioner’s Evidence Rebutts the Presumption Against MPF Construction*

Patent Owner argues that Petitioner’s evidence fails to overcome the presumption against MPF construction because it “shows that a POSITA would understand *tool* as referring to multiple structures, as opposed to a ‘specific structure.’” Req. Reh’g. 7 (citing Ex. 1001 ¶ 92). Specifically, Patent Owner challenges the testimony of Dr. Rodgers (*id.* at 8–9 (citing Prelim. Resp. 26–27, 34; Ex. ¶ 92)), a general purpose dictionary definition of *tool* (*id.* at 9 (citing Prelim. Resp. 27, 36–37; Ex. 1001 ¶ 92; Ex. 1056)), and the specification of the ’439 patent (*id.* at 10 (citing Pet. 6–7)).

We recognize that the burden to prove unpatentability is on and remains with Petitioner, not the Patent Owner or the Board. *Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375, 1380 (Fed. Cir. 2015) (noting that the petitioner in an *inter partes* proceeding has the initial burden of production and the burden of persuasion to prove unpatentability). Based on the preliminary record before us at this point in the proceeding, Patent Owner's arguments challenging the sufficiency of Petitioner's arguments and evidence were not convincing. Instead, we were more persuaded by Petitioner's arguments and supporting evidence for purposes of institution. We could not have overlooked or misapprehended something not presented adequately in the Preliminary Response

*C. That the Board Overlooked Evidence Supporting PO's Position*

Patent Owner argues that our analysis of the evidence failed to consider "whether the evidence shows that the term *tool* is 'understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure.'" Req. Reh'g 10–11 (citing *Williamson*, 792 F.3d at 1348.). We disagree. Patent Owner's arguments challenging the specific testimony of Petitioner's declarant, Dr. Rogers, regarding how a person of skill in the art would understand *tool*, were unconvincing based on the record before us prior to institution. Just because we were more persuaded by Petitioner's arguments and evidence for purposes of institution does not mean that we overlooked or misapprehended Patent Owner's arguments and evidence.

*D. That the Board's MPF Construction Improperly Discards Tool's Limits*

Patent Owner also disputes our preliminary construction of *tool*, which is also the construction Petitioner advanced in the Petition. Req. Reh'g. 12–15; See Pet. 7 ("Tool" should be construed pursuant to § 112, ¶ 6

as the term ‘tool’ by itself fails to ‘recites sufficiently definite structure.’”

“The recited function is ‘imparting a deforming force on the deformable member,’ and the disclosed means include ‘a wedge, swage, shoulder, cone, ramp, mandrel’ as exemplified by tools 102, 122 and 142.”). On the one hand, Patent Owner seems to be in agreement with Dr. Rodgers in arguing that Patent Owner “and Dr. Rodgers established that a POSITA would understand tool as a downhole device for achieving a specific function, not mere pieces or surfaces.” *Id.* at 12 (citing Prelim. Resp. 33–42). On the other hand, Patent Owner characterizes Dr. Rodgers’ definition as “results-driven” in arguing that “Dr. Rodgers contended, without explanation or support, that the ’439 Patent uses tool—contrary to its plain meaning—to encompass mere components of tools.” *Id.* at 14 (citing Ex. 1001 ¶ 92). Patent Owner reiterates its argument from the Preliminary Response, namely that “such **shapes**, e.g., ‘cone’ and ‘wedge,’ are explicitly those **for a tool**—e.g., a plug, a dart, or a setting tool—**not tools themselves**.” *Id.* at 15 (citing Prelim. Resp. 41–42).

Patent Owner’s disagreement with our preliminary construction of *tool* does not mean that we overlooked or misunderstood its arguments and evidence. Instead, for purposes of institution and based on the record at hand, we were more persuaded by Petitioner’s arguments and supporting evidence, and our independent review of the ’439 Patent claims and specification, than Patent Owner’s unsupported attorney argument.

#### *E. Summary*

In conclusion, we have reviewed and considered the Request and determine that Patent Owner has not carried its burden of demonstrating that the Board misapprehended or overlooked any matter in rendering our Decision on Institution. Rather, Patent Owner appears to have used their

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Request as an opportunity to re-argue positions which we did not find convincing for purposes of institution. We, therefore, reiterate that our construction of the term *tool* is preliminary, and that our final claim construction, if one is required, will be provided at the close of all the evidence, including any cross-examination testimony of Petitioner's expert, Dr. Rodgers, any rebuttal testimony Patent Owner may offer, and after any hearing.

### III. CONCLUSION

Patent Owner's Request for Rehearing is **denied**.

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