

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

REFLEX USA LLC,
Petitioner,

v.

LONGYEAR TM, INC. and GLOBALTECH CORPORATION PTY LTD.,
Patent Owner.

IPR2023-00642
Patent 10,830,013 B2

Before BENJAMIN D. M. WOOD, JEREMY M. PLENZLER, and
CYNTHIA L. MURPHY, *Administrative Patent Judges*.

WOOD, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE
PATENT OWNER'S MOTION TO AMEND

I. INTRODUCTION

On September 26, 2023, we instituted trial as to claims 1–4, 14, 15, 19–22, 24, and 25 of U.S. Patent No. 10,830,013 B2. Paper 11. After institution, Patent Owner filed a Motion to Amend that is contingent on the patentability of claim 1. Paper 20 (“Motion” or “Mot.”). Petitioner did not file an opposition to the Motion to Amend.

In the Motion, Patent Owner requests that we provide preliminary guidance on the Motion in accordance with the Board’s pilot program concerning motion to amend practice and procedures. Mot. 1; *see also Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board*, 84 Fed. Reg. 9,497 (Mar. 15, 2019) (providing a patent owner with the option to receive preliminary guidance from the Board on its motion to amend) (“Notice”).

In this Preliminary Guidance, we provide information indicating our initial, preliminary, non-binding views on whether Patent Owner has shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend in an *inter partes* review and whether Petitioner (or the record) establishes a reasonable likelihood that the substitute claim is unpatentable. *See* Notice, 84 Fed. Reg. at 9,497 (“The preliminary guidance . . . provides preliminary, non-binding guidance from the Board to the parties about the [motion to amend]”); *see also* 35 U.S.C. § 316(d) (statutory requirements for a motion to amend); 37 C.F.R. § 42.121 (regulatory requirements and burdens for a motion to amend); *Lectrosonics, Inc. v Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential) (providing information and guidance regarding motions to amend).

For purposes of this Preliminary Guidance, we focus on the proposed substitute claim, and specifically on the amendments proposed in the Motion. *See* Notice, 84 Fed. Reg. at 9,497. We do not address the patentability of the originally challenged claims. *Id.* Moreover, in formulating our preliminary views on the Motion, we have not considered the parties’ other substantive papers on the underlying merits of Petitioner’s challenges. We emphasize that the views expressed in this Preliminary Guidance are subject to change upon consideration of the complete record, including any revision to the Motion filed by Patent Owner. Thus, this Preliminary Guidance is not binding on the Board when rendering a final written decision. *See id.* at 9,500.

II. PRELIMINARY GUIDANCE

A. Statutory and Regulatory Requirements

“A patent owner bears the burden of persuasion to show, by a preponderance of the evidence, that the motion to amend complies with the requirements of paragraphs (1) and (3) of 35 U.S.C. § 316(d), as well as paragraphs (a)(2), (a)(3), (b)(1), and (b)(2) of this section.” 37 C.F.R. § 42.121(d)(1). For the reasons discussed below, at this stage of the proceeding, and based on the current record, it appears that Patent Owner has shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend (with one exception regarding new matter).

1. Reasonable Number of Substitute Claims

Does Patent Owner propose a reasonable number of substitute claims? (35 U.S.C. § 316(d)(1)(B))
Yes, Patent Owner proposes only one substitute claim, namely, proposed substitute independent claim 26, for sole original independent claim 1. Mot. 1.

Based on the current record, we do not view Patent Owner as proposing to amend *any* of the current dependent claims of the '013 patent. Patent Owner does not, for example, (1) propose to cancel the dependent claims (all of which depend either directly or indirectly from claim 1) if claim 1 is found to be unpatentable; or (2) propose to amend the original dependent claims to change their dependency to proposed substitute claim 26 if claim 1 is found to be unpatentable. *Compare* Mot. 27–30 (listing only proposed substitute independent claim 26), *with Lectrosonics*, Paper 15 at 8 (“A motion to amend must include a claim listing reproducing each proposed substitute claim. *See* 37 C.F.R. § 42.121(b). Any claim with a changed scope subsequent to the amendment should be included in the claim listing as a proposed substitute claim, and should have a new claim number. *This includes any dependent claim that a patent owner intends to be depending from a proposed substitute independent claim.* For each proposed substitute claim, the motion must show clearly the changes in the proposed substitute claim with respect to the original patent claim that it is intended to replace.” (emphasis added)). If Patent Owner intended otherwise with its Motion to Amend, clarification is required.

2. Respond to Ground of Unpatentability

Does the Motion respond to a ground of unpatentability involved in the trial? (37 C.F.R. § 42.121(a)(2)(i))

Yes. Patent Owner responds to the grounds of unpatentability at pages 19–25 of the Motion. At least one amendment presented is responsive to a ground of unpatentability.

3. Scope of Amended Claims

Does the amendment seek to enlarge the scope of the claims? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))

No. Proposed substitute claim 26 retains all features of original claim 1 and includes narrowing limitations.

4. New Matter

Does the amendment seek to add new subject matter? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))

With one exception, and based on our preliminary review, it appears that the proposed amendment does not add new subject matter. Patent Owner asserts that written description support for the added limitations of proposed substitute claim 26 are set forth in U.S. Patent Application No. 16/588,026 (Ex. 1002) from which the '013 patent issued, and in U.S. Provisional Application No. 61/982,052 (Ex. 2004) from which the '013 patent claims priority. Petitioner does not argue otherwise as an opposition was not filed. Patent Owner provides specification citations to these applications in the table on pages 3–19 of the Motion. Mot. 3–19.

On this record, we find Patent Owner has set forth written description support for the proposed amendments, with the exception of Limitation 26.13, as noted below.¹

Limitation 26.1²: an integral elongate tube body having an exterior surface.³ Mot. 3–4 (citing Ex. 1002, 253 ¶ 9, 259 ¶ 44, 260 ¶¶ 45–47, 261–262 ¶ 52, 262–263 ¶¶ 54–55, Figs. 3–7; Ex. 2004 ¶¶ 8, 39, 40–42, 47, 49, 50, 53, claims 1–2, Figs. 3–7).

Limitation 26.1.1: a first interior cavity defined within the elongate tube body. Mot. 4 (citing Ex. 1002, 260 ¶¶ 45, 46, 268 ¶ 75, 283 claim 1, Figs. 3, 5–7; Ex. 2004 ¶¶ 40, 41, 59, Figs. 3, 5–7).

Limitation 26.1.2: selectively sealed interior cavity defined within the elongate tube body and spaced distally from the first interior cavity, ~~[[and]]~~⁴ the selectively sealed interior cavity having a closed proximal end. Mot. 4–5 (citing Ex. 1002, 260 ¶¶ 46–47, 261–263 ¶¶ 49, 52–55, Figs. 3, 5–7; Ex. 2004 ¶¶ 41–44, 47–50, claims 1–2, Figs. 3, 5–7).

Limitation 26.1.5: an open and threaded distal end portion, wherein the selectively sealed interior cavity extends distally to the open and threaded distal end portion of the core barrel head assembly, and wherein the open and threaded distal end portion includes male threads defined on the exterior surface. Mot. 6–7 (citing Ex. 1002, 261–262 ¶¶ 52, 54, 264 ¶ 61, 284 claim 8, Figs. 3–7; Ex. 2004 ¶¶ 47, 49, Figs. 3–7).

¹ For brevity's sake, we do not reproduce all added claim language.

² We use the same claim limitation identifiers used by Patent Owner.

³ Underlining represents added claim language.

⁴ Double bracket represents deleted claim language.

Limitation 26.2: a seal coupler configured to be sealingly received in the open and threaded distal end portion of the elongate tube body. Mot. 7 (citing Ex. 1002, 261–263 ¶¶ 52, 54–55, 284 claim 9, Figs. 3–6; Ex. 2004 ¶¶ 47, 49–50, Figs. 3–6).

Limitation 26.3: an O-ring seal for preventing any pressurized fluid from entering the selectively sealed interior cavity of the elongate tube body, wherein the O-ring seal is mounted on a portion of the seal coupler and is configured to seal between a portion of the seal coupler and a portion of an interior surface of the open and threaded distal end portion of the elongate tube body. Mot. 8–9 (citing Ex. 1002, 262 ¶ 52, 284 claim 10, Figs. 3–6; Ex. 2004 ¶ 47, Figs. 3–6).

Limitation 26.4.1: a check valve assembly configured to affect a hermetical seal of the selectively sealed interior cavity of the elongate tube body and to provide fluid control for wire line operation. Mot. 9 (citing Ex. 1002, 262 ¶ 53, 285 claim 11, Figs. 3–6; Ex. 2004 ¶ 48, Figs. 3–6).

Limitation 26.4.2: wherein the check valve assembly comprises a check ball, a coupled proximal end assembly, and a distally tapered seat that defines an interior chamber for operative receipt of the check ball, wherein the check ball is sized to selectively block the distally tapered seat. Mot. 9–10 (citing Ex. 1002, 262 ¶ 53, 263 ¶ 57, 285 claims 12, 15, Figs. 3–6; Ex. 2004 ¶¶ 48, 52, Figs. 3–6).

Limitation 26.5.1: wherein the proximal end assembly of the check valve assembly defines a female threaded coupling that is configured to be threadably coupled to the male threads defined on the exterior surface of the open and threaded distal end portion of the elongate tube body. Mot. 10–11 (citing Ex. 1002, 262 ¶ 54, 285 claim 13; Ex. 2004 ¶ 49).

Limitation 26.5.2: the proximal end assembly of the check valve assembly is further configured such that as the proximal end assembly of the check valve assembly is threadably coupled to the male threads defined on the exterior surface of the open and threaded distal end portion of the elongate tube body, the seal coupler is driven into a sealed position within the selectively sealed interior cavity of the elongate tube body to affect complete hermeticity. Mot. 11–12 (citing Ex. 1002, 262 ¶ 54, Figs. 3, 5, 6; Ex. 2004 ¶ 49, Figs. 3, 5, 6).

Limitation 26.6: wherein the interior chamber of the check valve assembly extends to a distal end of the check valve assembly, and wherein

the check valve assembly further defines a plurality of ports that extend from an exterior surface of the check valve assembly and are in fluid communication with the interior chamber of the check valve assembly, and wherein the plurality of ports are angularly spaced an unequal number of degrees apart. Mot. 12–13 (citing Ex. 1002, 261 ¶ 56, 285 claim 14, Figs. 3–6; Ex. 2004 ¶ 51, Figs. 3–6).

Limitation 26.7: wherein the interior chamber of the check valve assembly is sized and shaped to allow the check ball to selectively move axially between an open position, in which the check ball is spaced proximally away from the surface of the tapered seat so that pressurized fluid can move through the distal end of the check valve assembly and subsequently through the interior chamber to exit out of the at least one port, and a closed position, in which the check ball is pressurized against the surface of the tapered seat so that pressurized fluid cannot move through the check valve assembly. Mot. 13–14 (citing Ex. 1002, 263 ¶ 57, 285 claim 16; Ex. 2004 ¶ 52).

Limitation 26.8: a window that extends from the exterior surface of the elongate tube body into optical communication with the selectively sealed interior cavity of the elongate tube body proximate the closed proximal end of the selectively sealed interior cavity. Mot. 14–15 (citing Ex. 1002, 260 ¶ 47, 261 ¶ 50, 283, claim 1, Figs. 3–7; Ex. 1004 ¶¶ 45, 42, Figs. 3–7).

Limitation 26.9: at least one electronic instrument that is configured to obtain core orientation data, wherein the at least one electronic instrument comprises a memory, a timer, an LCD display at one end, and at least one digital and/or electro-mechanical sensor in a core orientation data recording tool. Mot. 15–16 (citing Ex. 1002, 259 ¶¶ 42–43, 270–271 ¶ 84, 283 claim 1, Figs. 3–6; Ex. 2004 ¶¶ 37, 76, claims 1–2, Figs. 3–6).

Limitation 26.11: an orientation indicator module disposed in the closed proximal end of the selectively sealed interior cavity, wherein the orientation indicator module is disposed in operative contact with the at least one electronic instrument when the proximal end assembly of the check valve assembly is threadably coupled to the open and threaded distal end portion of the elongate tube body. Mot. 16–17 (citing Ex. 1002, 260–262 ¶¶ 47–49, 55, 283 claim 4, Figs. 3–6; Ex. 2004 ¶¶ 42–44, 50, 71, Figs. 3–6).

Limitation 26.12: a power source disposed within the selectively sealed interior cavity, wherein the power source is operatively electrically

coupled to the at least one electronic instrument and comprises a rechargeable battery. Mot. 17–18 (citing Ex. 1002, 259 ¶ 42, 260 ¶ 46, 265 ¶ 65, Figs. 3–6; Ex. 2004 ¶¶ 37, 41, Figs. 3–6).

Limitation 26.13: wherein the seal coupler is disposed in operative contact with the power source when the proximal end assembly of the check valve assembly is threadably coupled to the open and threaded distal end portion of the elongate tube body. Mot. 18 (citing Ex. 1002, 262 ¶ 55, Figs. 4–6; Ex. 2004 ¶ 50, Figs. 4–6).

As to Limitation 26.13, although the excerpts from Exhibits 1002 and 2004 disclose that the seal coupler is disposed in “contact” with the at least one electronic instrument 40, the power source 50 and, optionally, the communication means to receive and/or transmit orientation data, the excerpts do not disclose the seal coupler in “*operative* contact with the power source.” It is also not entirely clear what is meant by *operative* contact between the seal coupler and the power source, since the seal coupler is used to effect a hermetic seal and would not seem to require a power source.

Limitation 26.14: wherein the selectively sealed interior cavity is sized and shaped to enclose the at least one electronic instrument, the orientation indicator module, and the power source. Mot. 19 (citing Ex. 1002, 260–261 ¶¶ 46–47, 49, 262 ¶ 55, Figs. 3, 5, 6; Ex. 2004 ¶¶ 41, 42, 44, 50, Figs. 3, 5, 6).

B. Patentability

Generally, “[a] petitioner bears the burden of persuasion to show, by a preponderance of the evidence, that any proposed substitute claims are unpatentable.” 37 C.F.R. § 41.121(d)(2). Nonetheless, “the Board may, in the interests of justice, exercise its discretion to grant or deny a motion to amend only for reasons supported by readily identifiable and persuasive evidence of record.” *Id.* at (d)(3); *see also Hunting Titan Inc. v. DynaEnergetics Europe GmbH*, IPR2018-00600, Paper 67 at 13 (PTAB July 6, 2020) (precedential) (“[T]here may be situations where certain evidence of unpatentability has not been raised by the

petitioner, but is readily identifiable and persuasive such that the Board should take it up in the interest of supporting the integrity of the patent system, notwithstanding the adversarial nature of the proceedings.”).

Petitioner did not file an opposition to Patent Owner’s Motion to Amend, and therefore necessarily does not show unpatentability of the proposed substitute claim based on any combination of references. Based on our preliminary review of the current record,⁵ we are not aware of readily identifiable and persuasive evidence in the record that shows proposed substitute claim 26 to be unpatentable.

Does the record establish a reasonable likelihood that the proposed substitute claim is unpatentable?

We are not aware of readily identifiable and persuasive evidence in the record that establishes, by a preponderance of the evidence, that proposed substitute claim 26 is unpatentable. Specifically, it appears that the record does not show that claim 26 would have been obvious over Beach-127 ⁶ or the combination of Beach-127 and Wiese. ⁷
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For example, claim 26 recites several new limitations that add specific structure to hermetically seal the distal end of the selectively sealed interior cavity of the elongate tube body. Proposed substitute claim 26 recites that the elongate tube body have at its distal end an “open and [male-] threaded distal end portion” in which a “seal coupler” with an “O-ring seal” mounted thereon is “sealingly received”; and a “check valve assembly” having a female-threaded “proximal end assembly” that is configured to be “threadably coupled” to the male-threaded distal end portion to “drive[]” the seal coupler “into a sealed position within the selectively sealed interior cavity of the elongate tube body to affect complete hermeticity.” Mot. 27–30. Patent Owner asserts that neither Beach-127 nor Wiese teaches this structure. <i>Id.</i> at 21–23. Patent Owner
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⁵ We express no view on the patentability of original claims 1–4, 14, 15, 19–22, 24, and 25 in this Preliminary Guidance. Instead, we focus on limitations added to claim 1 in Patent Owner’s Motion to Amend.

⁶ WO 2008/113127 (Sept. 25, 2008) (Ex. 1003).

⁷ US Pub. No. 2008/0001775 (Jan. 3, 2008) (Ex. 1004).

further argues that during prosecution of U.S. Patent No. 11,466,529, which is a child patent to the '013 patent, “the examiner allowed the pending claims over Beach-127 in response to amendments reciting ‘a seal coupler’ and ‘a check valve assembly.’” *Id.* at 22–23 (citing Ex. 1013, 28, 63). We agree that, on the current record, neither Beach-127 nor Wiese, alone or in combination, teaches this structure.

III. CONCLUSION

This concludes the Preliminary Guidance, which is Patent Owner’s first option under the Board’s pilot program. Notice, 84 Fed. Reg. at 9,497. Patent Owner has an additional option under the Board’s pilot program to file a revised MTA by DUE DATE 3. Paper 12.

In addition to those two options under the Board’s pilot program, Patent Owner is reminded that amendments of the challenged claims may also be pursued in a separate reissue or reexamination proceeding before, during, or after an AIA trial proceeding, including subsequent to the issuance of the Final Written Decision. We draw Patent Owner’s attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. See 37 C.F.R. § 42.8(a)(3), (b)(2).

IPR2023-00642
Patent 10,830,013 B2

FOR PETITIONER:

Scott Weidenfeller
Peter Chen
COVINGTON & BURLING LLP
sweidenfeller@cov.com
pchen@cov.com

FOR PATENT OWNER:

Scott Jarratt
Joseph Matal
Caroline Fox
Brooke Cohen
HAYNES AND BOONE, LLP
scott.jarratt.ipr@haynesboone.com
joseph.matal.ipr@haynesboone.com
caroline.fox.ipr@haynesboone.com
brooke.cohen.ipr@haynesboone.com