

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ENSIGN US SOUTHERN DRILLING LLC,
Petitioner,

v.

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

Case No. IPR2023-00804
U.S. Patent No. 10,976,016

**PATENT OWNER'S PRELIMINARY RESPONSE
TO PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT NO. 10,976,016**

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I. INTRODUCTION

Patent Owner submits this Preliminary Response to the Petition by Ensign US Southern Drilling (“Petitioner”) seeking inter partes review of claims 1, 2, and 23 of U.S. Patent No. 10,976, 016 (the “’016 Patent”). The Petition should be denied for numerous independent and incurable reasons.

First, the Petition is procedurally deficient. For example, the Petition fails to identify, with particularity, its obviousness combinations—instead making prolific use of “and/or” for its myriad of potential prior art combinations. This is compounded by Petitioner failing to take a clear position on the meaning of material claim terms—first stating that it “currently believe[s] that no terms need to be expressly construed for purposes of this IPR because the plain and ordinary meaning applies,” but then identifying constructions that “may be employed.” Pet. 19-20. The Board (and Patent Owner) should not be expected to “comb through Petitioner’s arguments in order to decipher the strongest argument or to determine the strongest combination of references to challenge the claims.”

Edwards Lifesciences Corp. v. Bos. Sci. Scimed, Inc., IPR2017-01295, 2017 WL 4862064, at *2 n.1 (PTAB Oct. 25, 2017). Further compounding the issue, Petitioner’s expert declaration merely repeats the Petition verbatim without providing additional evidence or technical reasoning for many, if not most, of the claim limitations, and, as such, should be given little to no weight. *Xerox Corp. v.*

Bytemark, Inc., IPR2022-00624, Paper 9 at 15 (PTAB Aug. 24, 2022).

Second, Petitioner fails to show how the references teach many of the claim limitations, including (i) a “crown deck”; (ii) a “mounting pole”; and (iii) either “a bracket configured to attach the mounting pole to the crown deck of the rig” or a “bracket” that “is connected to the crown deck of the rig using bolts.” These substantive deficiencies—which permeate every challenged claim—cannot be remedied.

Third, Petitioner provides no supported, non-hindsight based motivation to combine the references in all of the obviousness Grounds 2-4. Instead, Petitioner parrots boilerplate *KSR* motivations that are entirely conclusory. Any remaining attempts at providing a motivation to combine are clearly based on impermissible hindsight reasoning or the ipse dixit of its expert. What is more, Petitioner never establishes that a POSITA would be able to combine the references with a reasonable expectation of success.

Fourth, per *Fintiv*, the Board should discretionarily deny institution in view of the parallel district court proceeding, which is far advanced with a *Markman* hearing set for August 24, 2023. Petitioner waited until the last possible moment to file its Petition, on the eve of the statutory deadline, after significant progress has been made in the district court case and over 8 months after identifying its primary reference (“Gowanlock”). Now, Petitioner raises substantially the same

prior art, challenges the same claims, and offers no *Sotera*-style stipulation. What is more, the district court proceeding involves additional counts completely unaffected by this IPR, including claims for breach of contract and infringement of a second patent that Petitioner has not challenged in an IPR (and cannot now), making a stay there unlikely. As such, it is not an efficient use of the Office's resources to proceed here, only to address a subset of the issues from the district court case. Even if the district court trial occurs around the same time as the anticipated Final Written Decision ("FWD"), potentially conflicting decisions from the Board and the district court will lead to a race to appeal.

For each of these reasons, the Petition should be denied.

II. OVERVIEW OF THE '016 PATENT

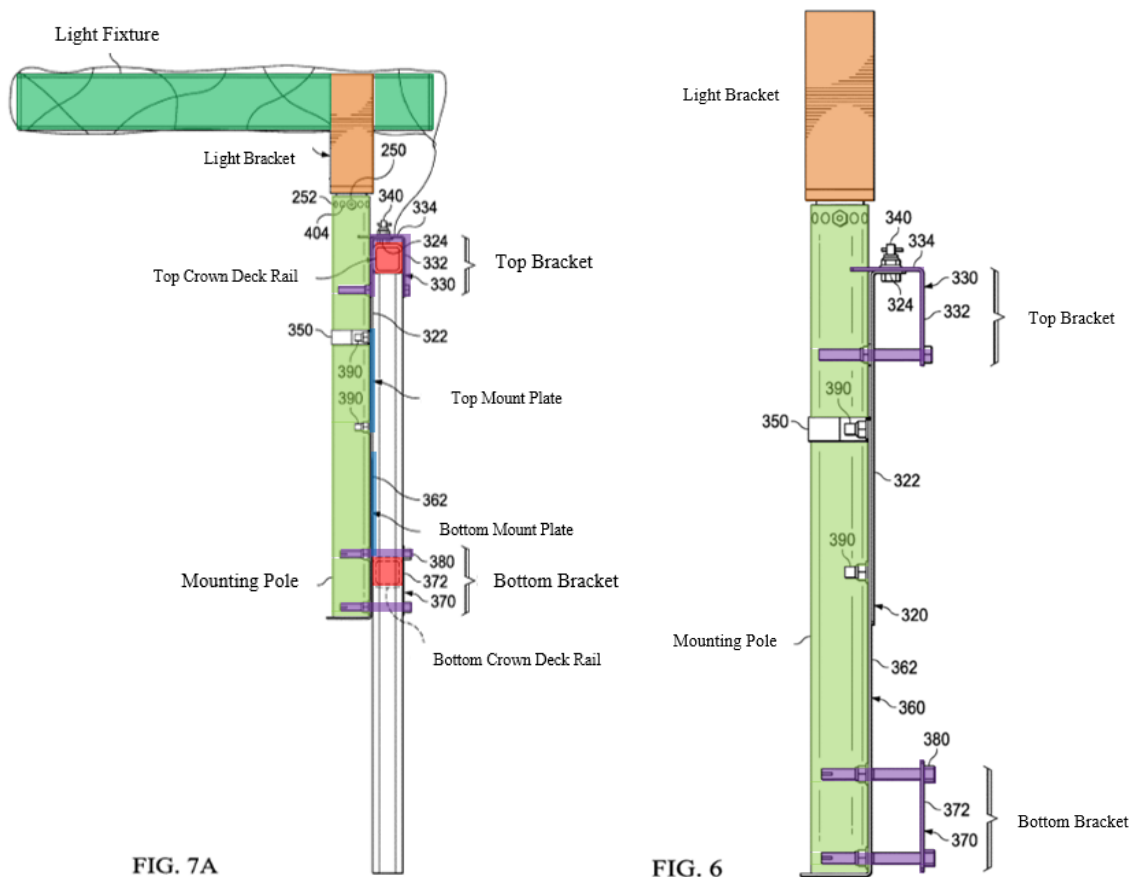
The '016 Patent generally relates to lighting systems used on drilling rigs. Ex. 1001 ('016 Pat.) at Abstract. These systems are "critical to ensure continuous and safe operation of well sites." *Id.* at 1:13-14. The '016 Patent explains that, "[t]o ensure even and effective lighting of the well site, lighting systems have previously been installed on the uppermost portion of the drilling rig, also referred to as the 'crown' of the rig." *Id.* at 1:14-17. According to the '016 Patent, "[p]rior art crown-mounted lighting systems developed for oil rigs are limited in several ways," including that "[t]heir designs are complicated and designed for specific rigs or rig types" and, "[t]ypically, once they are designed for a particular rig or a

particular type of rig, the lighting systems designs are limited and are not able to be adapted for other uses.” *Id.* at 1:17-22.

Specifically, “[p]rior art lighting systems for drilling rigs are fixed, monolithic structures that are typically crown or frame systems, with a single size and layout accommodating one type of light and rig.” *Id.* at 1:23-26. Thus, “they are heavy and typically require cranes along with multiple workers for installation, removal, and adjustments.” *Id.* at 1:27-28. For example, “[a] typical rig lighting frame system may require between 6 and 12 hours for installation.” *Id.* at 29-30. “Due to the high cost of operating a rig, any such delay is extremely inefficient for the operator of a wellsite.” *Id.* at 1:35-37. These inefficiencies “also increase the time required to be spent on maintaining these systems, which also increases safety risk.” *Id.* at 1:37-39.

Unlike the prior art, the '016 Patent claims, among other things, a modular lighting system mounted on a rig where a plurality of light units are each separately attached to a crown deck of the rig and comprise a mounting pole, a light fixture having one or more lights, and a bracket configured to attach the mounting pole to the crown deck of a rig. *See, e.g., id.* at claim 1. Generally, these have a “low profile to minimize the wind shear forces that may be experienced by the light units at the top of a structure.” *Id.* at 4:58-60.

Figures 6 and 7A (below) provide an overview of one embodiment. *Id.* at 2:10-15, 3:5-8. Light fixture 248 (green) may be connected to light bracket 400 (orange). *Id.* at 4:31-40. Mounting pole 240 (light green) is attached to the crown deck using brackets 300 and 310 (Top and Bottom) (purple) that attach to top rail 242 (red) and bottom rail 244 (red). *Id.* at 3:38-59, 4:30-53.



III. THE PETITION'S PROCEDURAL FAILURES WARRANT DENYING INSTITUTION

Before turning to the merits, the Petition should be denied due to two procedural deficiencies: (i) the Petition does not identify *how* the challenged claims are to be construed, and (ii) Petitioner impermissibly incorporates swaths of

conclusory statements from its expert's declaration with no further elaboration, support, or analysis. These deficiencies alone warrant denial.

A. The Petition Takes Inconsistent Positions on Claim Construction

Petitioner flouts the requirement to identify “how the challenged claim is to be construed,” 37 C.F.R. § 42.104 (b)(3), by proposing alternative constructions and committing to none. The “failure to take a clear position on the [claim terms] is grounds alone for denying the Petition.” *Mentor Graphics Corp. v. In-Depth Text LLC*, IPR2017-02094, Paper 8 at 9 (PTAB Mar. 14, 2018); *see 3Shape A/S v. Align Tech. Inc.*, IPR2020-00222, Paper 12 at 16 (PTAB May 26, 2020) (denying institution where, inter alia, Petitioner appeared to ask the Board to apply two sets of constructions and, thus, failed to identify how the construed claim is unpatentable as required by the rules).

Petitioner asserts that none of the claims need “to be expressly construed for purposes of this IPR because the plain and ordinary meaning applies,” but then proceeds to provide claim constructions adopted by the Western District of Texas Court that “*may* be employed” by the Board.¹ Pet. 19-22.

¹ The Patent Owner believes claim constructions adopted in the parallel proceeding should apply here.

Further exacerbating the issue, Petitioner asserts that the “crown deck” limitation is disclosed by prior art figures in a manner that is *inconsistent* with Petitioner's own definition. For example, neither the Gowanlock Figure 1A nor the purported AAPA Figure 1 incorporate a “collection of structures within the crown that includes a **walking surface, parts supporting the walking surface, and any associated handrail.**”² Compare Pet. 20, with *id.* at 55, 66, 79, 88.

B. Petitioner's Conclusory Expert Declaration Should be Given No Weight and Does Not Cure The Petition's Deficiencies

Petitioner's expert Jake Hamdan is employed as its VP of Engineering, Ex. 1008 ¶ 2, which significantly undermines his credibility as providing impartial testimony. *E.g., NOF Corp. v. Nektar Therapeutics*, IPR2019-01396, Paper 28 at 6-7 (PTAB Jun. 10, 2020) (finding expert testimony less persuasive when the expert was employed by Petitioner). And although Mr. Hamdan states that he has “extensive experience in all aspects of rigs, including engineering and design work related to...well site lighting,” Ex. 1008 ¶ 11, his CV shows none, Ex. 1007.³

² Patent Owner maintains that “crown deck” means the “collection of structures within the crown that includes a walking surface, parts supporting the walking surface, and any associated handrail.” Ex. 1009 at 6.

³ For this Response only, Patent Owner does not dispute the Petitioner's definition of a POSITA.

But the crux of the issue with Mr. Hamdan's declaration is that he provides no technical reasoning or evidence to support his opinions, which warrants giving his opinions "little weight." *Xerox*, Paper 9 at 16 (PTAB Aug. 24, 2022) (affording declaration little weight when expert "offer[ed] only a *verbatim* restatement of the assertion being supported, without any supporting evidence or technical reasoning"). *See also, e.g., TQ Delta, LLC v. CISCO Sys., Inc.*, 942 F.3d 1352, 1362-63 (Fed. Cir. 2019) (expert's conclusory opinions are "inadequate to support the Board's fact finding"); *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 851 F.3d 1270, 1274-75 (Fed. Cir. 2017) (expert may not "fill in missing limitations" by alleging a POSITA would envision them). For example, where the references fail to disclose an element, Mr. Hamdan attempts to fill the gaps with his opinion about what was allegedly "known" or "well-known" or statements about what a POSITA "would readily" do without any supporting evidence or technical reasoning. *See, e.g., Ex. 1008 at ¶¶ 60, 62, 86, 90, 98, 101, 107, 110 & pp. 53, 58, 71, 82.*

As another example, Mr. Hamdan opines that a POSITA would have reasonably expected to succeed in combining PCT Publication WO 2018/0423348 ("Gowanlock") and Swivelpole Product Catalogue NEC V2-4. Printed March 2014 ("Swivelpole") "because lights with mounting poles attached with brackets have been attached to many items such as guardrails for years using tools available in

most hardware stores and commonly fabricated in oil field equipment fabrication shows and rig upyards.” Ex. 1008 at ¶ 87; *see id.* ¶¶ 98 (Ground 3), 107 (Ground 4). Yet Mr. Hamdan “does not provide any facts, data, or analysis to support the opinion stated.” *Content Square SAS v. Medallia Inc.*, IPR2022-00316, Paper 13 at 38 (PTAB July 14, 2022). These types of conclusory, unsupported statements proliferate the entirety of Mr. Hamdan’s so-called “opinions,” and cannot be given any weight.

Instead, Mr. Hamdan’s declaration simply “repeats the Petitioner’s arguments and offers little or no elaboration.” *InfoBionic, Inc. v. Cardionet, Inc.*, IPR2015-01704, Paper 11 at 6 (PTAB Feb. 16, 2016). For example, where Mr. Hamdan purports to offer “analysis and identification of how claims 1, 2, and 23 are unpatentable,” he merely repeats the Petition’s “summary chart[s].” *Compare* Pet. 55-58 (“Summary Chart” for Ground 1), *with* Ex. 1008 at 51-54 (same chart for Ground 1). Mr. Hamdan takes the same approach for the remaining Grounds. *Compare* Pet. 65-69 (Ground 2), 76-80 (Ground 3), 85-89 (Ground 4), *with* Ex. 1008 at 54-59 (Ground 2), 67-73 (Ground 3), 78-83 (Ground 4). “Merely repeating an argument from the Petition in the declaration of a proposed expert does not give that argument enhanced probative value.” *Kinetic Techs., Inc. v. Skyworks Sols., Inc.*, IPR2014-00529, Paper 8 at 15 (PTAB Sept. 23, 2014).

Alternatively, if Petitioner simply copied Mr. Hamdan’s conclusory charts

and statements, then Petitioner is no better off, as parties “that incorporate expert testimony by reference in their petitions, motions, or replies without providing explanation of such testimony risk having the testimony not be considered by the Board.” *See Consolidated Trial Practice Guide at 35-36 (Nov. 2019)).*⁴ For example, Petitioner’s commentary on motivations to combine consists of an introductory statement and a wholesale repeat (including paragraph numbering) of Mr. Hamdan’s declaration. Pet. 33-51. Again, Mr. Hamdan’s opinions should not be considered. *Farmers Edge, Inc., v. AGI Suretrack, LLC*, IPR2023-00158, Paper 14 at 21 (PTAB May 11, 2023) (the Board “need not consider” expert’s “conclusory” testimony “that is improperly incorporated by reference (without discussion) into the Petition.”) (citation omitted).

IV. PETITIONER FAILS TO DEMONSTRATE A REASONABLE LIKELIHOOD OF SUCCESS

The Board may not institute an IPR unless “the information presented in the petition...shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged.” 35 U.S.C. § 314(a). The Petition should be denied because Petitioner fails to satisfy this burden for each of its four Grounds.

⁴ *Available at:* <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

A. Petitioner has not demonstrated a reasonable likelihood of prevailing on Ground 1 (Gowanlock)

Ground 1 fails for independent four reasons.⁵

First, each of the challenged claims requires a “crown deck,” which Gowanlock does not disclose.

Second, each challenge claim requires a “mounting pole,” which Gowanlock does not disclose.

Third, Petitioner does not demonstrate that Gowanlock discloses “a bracket configured to attach the mounting pole to the crown deck of the rig” as claims 1 and 2 require.

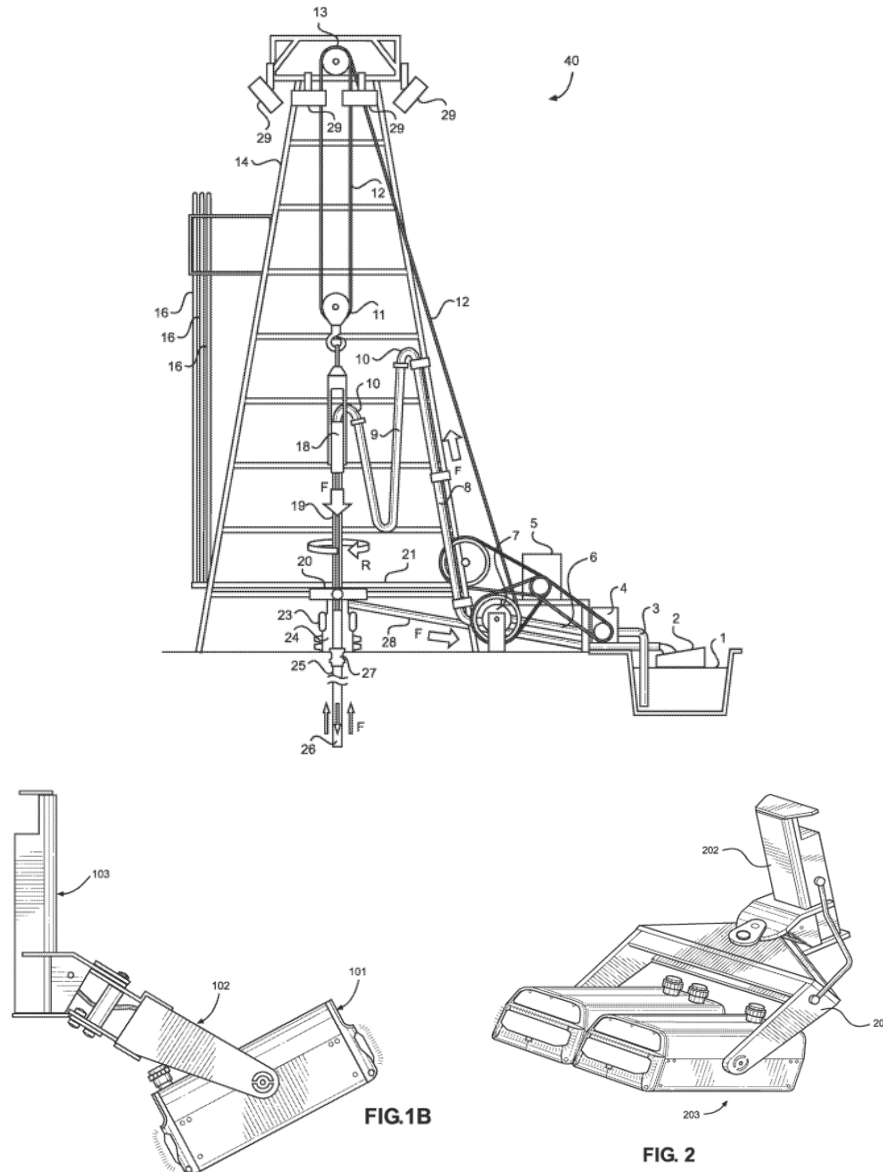
Fourth, dependent claim 2 requires that “the bracket” be “connected to the crown deck of the rig using bolts,” which Gowanlock does not disclose.

⁵ The Gowanlock reference on which Petitioner relies (WO 2018/042348) is the same as CA3034206 to Gowanlock, which was considered by the Office during prosecution. Ex. 1001 (citing CA 3034206 as first for “FOREIGN PATENT DOCUMENTS”); Ex. 1002 at 278, 282; Pet. at 22 n.13 (admitting that “CA3034206 listed on the face of the ’016 Patent is a Canadian counterpart of PCT Publication WO 2018/0423348[.]”).

i. Ground 1 fails to establish that Gowanlock discloses a “crown deck”

For each “crown deck” limitation, Petitioner cites to Figures 1A, 1B, and 2 on pages 10-11 of Gowanlock without further explanation. Pet. 52-57. In fact, Petitioner never identifies a “crown deck” in these figures. Nor can it.

For example, Figure 1A (below) shows “a lighting system mounted on a drilling rig.” Ex. 1003 at [0012]. Although Gowanlock discusses a “crown block 13” in connection with Figure 1A, *id.*, it does not include a “crown **deck**,” which is something different—i.e., a “collection of structures within the crown that includes a walking surface, parts supporting the walking surface, and any associated handrail.” Pet. 19-20; Ex. 1008 ¶ 20. Likewise, Figures 1B and 2 (below) show a “light fixture” (101, 203), “bracket” (102, 204), and “light fixture attachment” (103, 202). Ex. 1003 at [0019]. But Petitioner has not identified a “crown deck” in either of these figures (because it does not exist).



Petitioner next cites paragraph 81 of Mr. Hamdan's Declaration as purported support. Pet. 52-54. However, that paragraph merely reproduces the Petition's same "summary chart," and provides no technical reasoning or evidentiary support. *Compare* Ex. 1008 ¶ 81, with Pet. 55-57. Per *Xerox*, Paper 9 at 15, this conclusory opinion should be given no weight.

Therefore, Petitioner has not shown that Gowanlock discloses a "crown

deck,” and has incurably failed to meet its burden. For this reason alone, institution should be denied.⁶

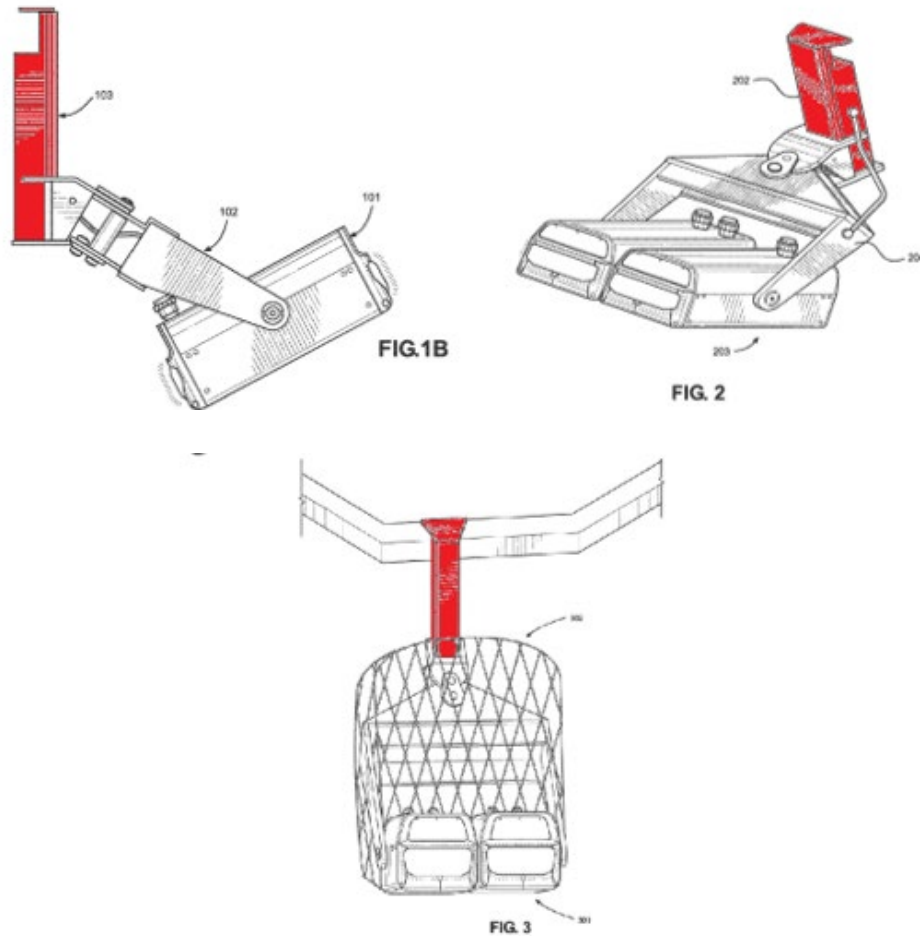
ii. Ground 1 fails to establish that Gowanlock discloses a “mounting pole”

Petitioner has not shown that Gowanlock discloses a “mounting pole.”

First, Petitioner contends that “Gowanlock discloses a short mounting pole which it describes as a ‘light fixture attachment (103 and 202)’ in paragraph [0019].” Pet. at 52. Petitioner cites Figures 1A, 1B, and 2 in support. *Id.* Yet Petitioner never explains how or why a POSITA would understand Gowanlock’s “light fixture attachment,” identified as items 103 and 202 in Figures 1B and 2, to be the claimed “mounting pole.” *Id.*

As shown in Figures 1B, 2, and 3 (below), Gowanlock’s “light fixture attachment” (red) is a short, singular component with a rectangular indentation at one end that hangs off the rig. Gowanlock discusses the “light fixture attachment” just once: “[a]nd in this embodiment, the light fixture is connected to the crown directly through the light fixture attachment (103 and 202).” Ex. 1003 at [0019].

⁶ None of the other references disclose, nor are they relied upon as disclosing, a crown deck.



Petitioner never explains how or why Gowanlock's "light fixture attachment" constitutes "a pole used for mounting something," according to each word's plain and ordinary meaning. Pet. 20-21 (construction of "mounting pole" that "may be employed"); Ex. 1008 ¶ 20 (construction of "mounting pole" used for analysis). In fact, Figure 1A (below) to which Petitioner cites does not show a "light fixture attachment" at all, let alone a "mounting pole."

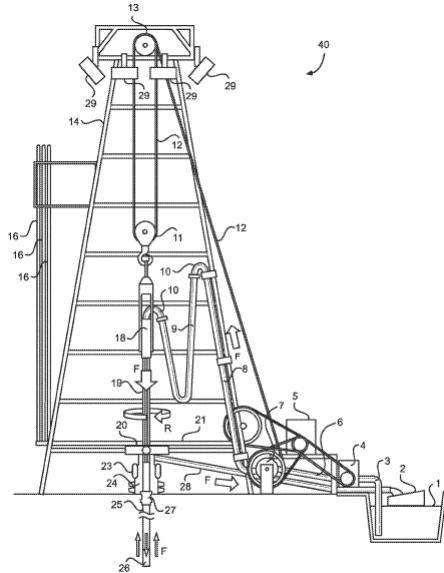


FIG. 1A

Second, citing Mr. Hamdan's Declaration, Petitioner asserts that "Gowanlock discloses a short mounting pole which it describes as a 'light fixture attachment (103 and 202)' in paragraph [0019]." Pet. 52. But again, Mr. Hamdan repeats the Petition's "summary chart" for the "mounting pole" limitations, offering no analysis or evidence beyond the following statement: "FIGS. 1A, 1B, and 2 above show a mounting pole for light fixtures 29. For example see 202 in Figure 1B." Ex. 1008 ¶ 81.

Therefore, Petitioner has not shown that Gowanlock discloses a "mounting pole," and for this reason alone, institution should be denied.

- iii. Ground 1 fails to establish that Gowanlock discloses "a bracket configured to attach the mounting pole to the crown deck of the rig"

Petitioner fails to show that Gowanlock discloses "a bracket configured to

attach the mounting pole to the crown deck of the rig,” as required by claims 1 and 2. Ex. 1001 at 7:31-41.

Petitioner incorrectly contends that “Gowanlock discloses a bracket (102 and 204) configured to attach the mounting pole to the crown deck of the rig,” citing Figures 1A, 1B, and 2 in support. Pet. 52. First, as discussed above, Gowanlock does not disclose a crown deck, so it simply cannot disclose a bracket configured to attach a mounting pole to a crown deck. Also, Gowanlock does not disclose a mounting pole. And although Gowanlock describes items 102 and 204 in Figures 1B and 2, respectively, as a “bracket,” Ex. 1003 at [0019], Petitioner does not explain how or why items 102 and 204 are “configured to attach the mounting pole to the crown deck of the rig.” For example, Gowanlock explains: “[t]he light fixture (101 and 203) as shown in this embodiment also in Figure 1B and in perspective view in Figure 2 is held by a bracket (102 and 204) which permits the light fixture to swivel both in a horizontal and vertical orientation.” Ex. 1003 at [0019]. It is only “through the light fixture attachment (103 and 202)” that “the light fixture is connected to the crown.” Ex. 1003 at [0019]. This configuration with a “bracket” (green) is also shown in Figures 1B and 2 below. In other words, Gowanlock’s “bracket” is not configured to attach a pole to a crown deck.

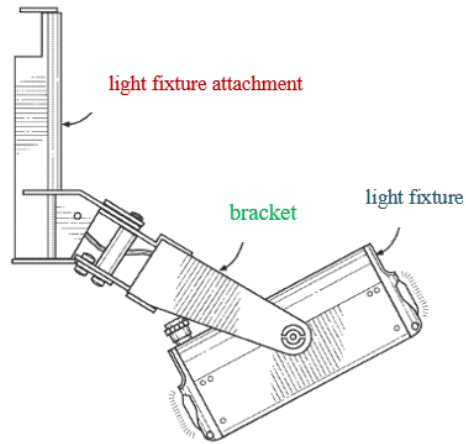


FIG. 1B

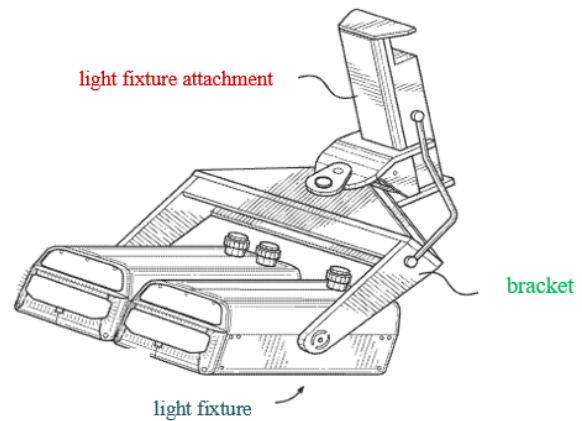


FIG. 2

Ex. 1003 at Figs. 1B, 2 (annotated).

Petitioner's citation to the expert declaration fares no better, as Mr. Hamdan repeats the Petition's "summary chart," and fails to identify where Gowanlock discloses the limitation or provide any technical reasoning or other evidentiary support, and, as such, should be ignored. Pet. 52; Ex. 1008 ¶ 81; *see Xerox*, Paper 9 at 15.

Moreover, Petitioner's "summary chart" is misleading. Pet. 57; Ex. 1008 at 52. As shown below, the statements after the citation to Gowanlock's [0019] are not quotes from [0019] at all, but *Petitioner's* own words passed off as quotes (shown in red). In fact, the words "crown deck," "deck," "mounting pole," "pole," and "handrail" appear *nowhere* in Gowanlock.

Pet. 57	Ex. 1003 at [0019] (in relevant part)
"[0019] The light fixture (101 and 203) as shown in this embodiment also in Figure 1B and in perspective view in Figure 2 is held by a bracket (102 and	"[0019] ... The light fixture (101 and 203) as shown in this embodiment also in Figure 1B and in perspective view in Figure 2 is held by a bracket (102 and

204) which permits the light fixture to swivel both in a horizontal and vertical orientation. The brackets and mounting poles also allow mounting or affixing the lights to differently configured, designed, or configured crown decks, including handrails. "	204) which permits the light fixture to swivel both in a horizontal and vertical orientation. And in this embodiment, the light fixture is connected to the crown directly through the light fixture attachment (103 and 202). ..."
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Compare Pet. 57, and Ex. 1008 at p. 52-53, with Ex. 1003 at [0019].

Therefore, Petitioner fails to show that Gowanlock discloses this limitation, and for this reason alone, institution should be denied.

iv. Ground 1 fails to establish that Gowanlock discloses that "the bracket is connected to the crown deck of the rig using bolts"

Petitioner does not demonstrate that Gowanlock discloses that "the bracket is connected to the crown deck of the rig using bolts," as claim 2 requires. Ex. 1001 at 7:40-41.

Because bolts are found nowhere in Gowanlock, Petitioner contends that "Gowanlock discloses a bracket (102 and 204) which is *inherently* connected to the crown deck of the rig using bolts." Pet. 53; *see id.* at 57 ("FIGs. 1B and 2 above inherently employ bolts to connect the brackets to the crown deck").

But to inherently disclose a claim element "that missing characteristic [needs to be] *necessarily* present, or inherent, in the single anticipating reference."

Pungkuk Wire Mfg. Co. v. Seong, IPR2016-00763, 2017 WL 3535009, at *3 (PTAB Aug. 16, 2017) (citation omitted). Nothing in Gowanlock shows that the bolts of claim 2 are *necessarily present* or are *the natural result* of the

Gowanlock's disclosure, and Petitioner provides no reasoning or analysis in support of its inherency argument. *See* Pet. 53, 57. And nothing in Gowanlock indicates that bolts, rather than some other way of attaching, like a weld, is necessarily present.

Mr. Hamdan's declaration does not remedy the deficiency—instead incorrectly opining that “FIGs. 1B and 2 above show bolts employed to connect the bracket to the crown deck.” Ex. 1008 at p. 53; *id.* ¶ 75. But he never identifies the alleged “bolts,” and Figures 1B and 2 (above) show no such thing.

Thus, Petitioner does not meet its burden to show that Gowanlock discloses “the bracket is connected to the crown deck of the rig using bolts,” and institution should be denied.

B. Petitioner has not demonstrated a reasonable likelihood of prevailing on Ground 2 (Gowanlock and Swivelpole).

Ground 2 fails for many of the same reasons as Ground 1, as Swivelpole does not remedy any of Gowanlock's deficiencies detailed above.⁷ For example,

⁷ The Swivelpole catalog on which Ensign relies (“Swivelpole Product Catalogue NEC V2-4. Printed March 2014”) was disclosed during prosecution. *See* Ex. 1001 at 1 (“Swivelpole Brochure; Swivelpole Product Catalog NEC V2-4. Printed Mar. 2014, pp. 5-9”); Pet. at 22 n.13 (admitting that “Pages 5-9 of the Swivelpole catalog appears on the face of the '016 Patent.”). Although Petitioner

neither Gowanlock nor Swivelpole disclose a “crown deck” or the “bracket”

limitations. Ground 2 also fails for three additional reasons.

First, Petitioner fails to identify the proposed combination for Ground 2 with particularity. Given Petitioner's prolific use of “and/or” in discussing Ground 2 in whole or in part, it is unclear what Ground 2 encompasses and what evidence Petitioner relies on to establish the alleged unpatentability.

Second, Petitioner fails to establish a supportable, non-hindsight reason why a POSITA would have been motivated to combine the references.

Third, Petitioner makes no showing that a POSITA would have had a reasonable expectation of successfully combining the disparate systems disclosed in Gowanlock and Swivelpole to achieve the claimed invention.

i. Ground 2 fails to identify with particularity the proposed combination.

Petitioners must “adhere to the requirement that the initial petition *identify* ‘with particularity’ the ‘evidence that supports the grounds for the challenge to

cites two pages that fall outside the range of pages disclosed during prosecution, Pet. 25; Ex. 1008, ¶ 77, Petitioner does not rely on these pages for its arguments, Pet. 58-80; Ex. 1008, ¶¶ 83, 102. Instead, Petitioner and its expert solely rely on disclosures on pages 6 and 8 of the Swivelpole catalog, which fall within the specific page range disclosed during prosecution. *See* Pet. at 25; Ex. 1008, ¶ 77.

each claim.”” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (quoting 35 U.S.C. § 312(a)(3)); see *InVue Sec. Prods., Inc. v. Mobile Tech, Inc.*, PGR2019-00019, Paper 7 at 8-9 (PTAB May 29, 2019) (denying institution where obviousness challenges were “not set forth with particularity” and it was “unclear what each challenge encompasses and what evidence Petitioner relies upon to establish unpatentability under each challenge”).

For Ground 2, Petitioner purports to rely on Gowanlock and Swivelpole. Pet. 11. However, Petitioner argues that nearly every claim limitation is rendered obvious based on either (i) Gowanlock, “**and/or**” (ii) Swivelpole, “**and/or**” (iii) knowledge of a POSITA, “**and/or**” (iv) common knowledge, **and** (vi) **any combination of these**. See e.g., Pet. 59-69.⁸

Ultimately, there are *over a million* possible combinations outlined in Petitioner’s description of the ground and **768 combinations** based on the accompanying claim chart alone. *Edwards*, 2017 WL 4862064, at *2 n.1 (“use of ‘and/or’ expands what is identified as three grounds of unpatentability into several distinct combinations of references”). But the Board and Patent Owner should not have to “comb through Petitioner’s arguments in order to decipher the strongest argument or to determine the strongest combination of references to challenge the

⁸ Emphasis added throughout unless otherwise noted.

claims.” *Id.*

ii. Ground 2’s references fail to disclose a “crown deck”

For the reasons discussed above in connection with Ground 1, incorporated here, Petitioner has not demonstrated that Gowanlock discloses a “crown deck.”

For Ground 2, Petitioner reuses the same arguments for “crown deck” as in Ground 1. Pet. 58-59, 63, 65-69.

Petitioner also contends that, “[t]o the extent that Gowanlock is asserted to somehow be missing this limitation, this limitation was common knowledge **and/or** well-known by a POSITA **and/or** the limitation is described in the Swivelpole catalog.” Pet. 59. In support, Petitioner cites only Swivelpole generally (Ex. 1004) and Mr. Hamdan’s summary chart that parrots the Petition. *See id.* (citing Ex. 1004; Ex. 1008, ¶83). Neither Petitioner nor its expert ever identify any alleged “crown deck” in Swivelpole. Nor could they. And to the extent Petitioner and its expert rely on “common knowledge” or what was allegedly “well-known,” that is unsupported by evidence and cannot be used for improper gap filling. *Xerox*, Paper 9 at 16.

Petitioner further contends that “[a] POSITA would readily employ the lights, mounting poles, and brackets shown in the Swivelpole catalog above to separately attach a plurality of light units to a crown deck or a hand railing, i.e., guard rail, around the crown deck.” Pet. 66-67. To the extent the “figure above”

refers to the figures on Swivelpole's page 6, neither Petitioner nor Mr. Hamdan identify what on page 6 allegedly constitutes a "crown deck." That is because there is nothing on page 6 that disclosed a crown deck. Ex. 1004 at p. 6.

At best, Swivelpole's page 6 shows a "Stanchion Mounted" and "Stanchion and Structure Mounted" product for the following "Applications": "Walkway lighting, platforms, stairways, spiral stairways, conveyors." Ex. 1004 at p. 6. But nowhere does it disclose a "crown deck." This is not surprising, as Swivelpole is a lightweight solution never intended for the demands of a rig's crown deck application where it would be high in the air above workers, subject to vibrations from rig operation and the weather.

Therefore, Petitioner has not shown Ground 2 discloses a "crown deck," and does not meet its burden. For this reason alone, institution should be denied.

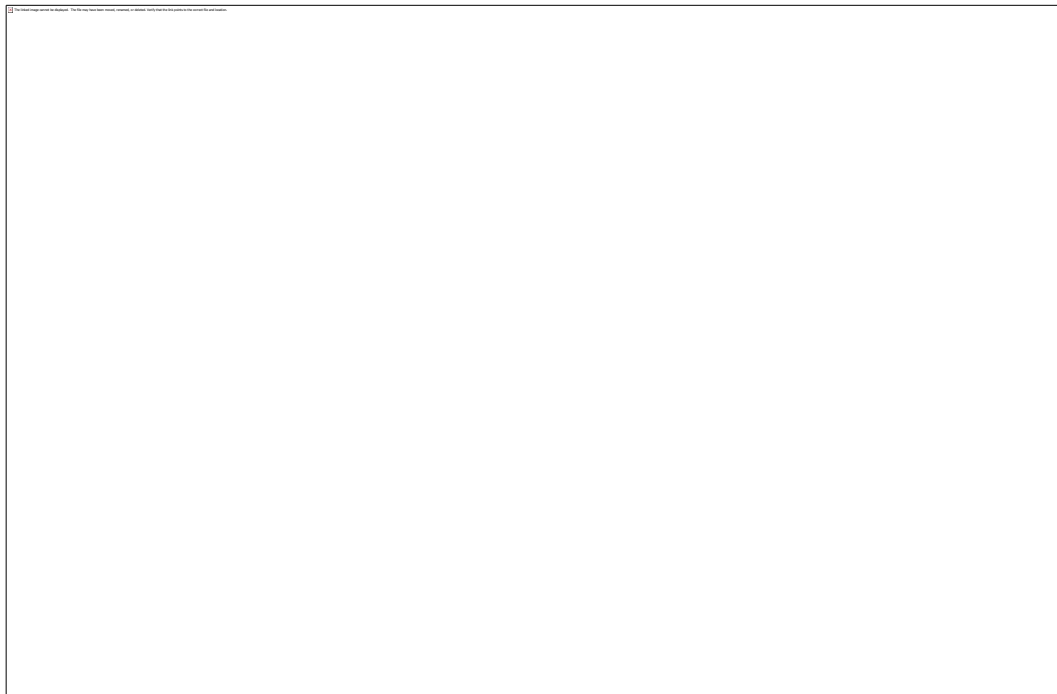
iii. Ground 2's references fail to disclose a "mounting pole"

For the reasons discussed above for Ground 1, incorporated here, Petitioner has not shown that Gowanlock discloses a "mounting pole." The combination of Gowanlock and Swivelpole for Ground 2 fares no better.

According to Petitioner, if "Gowanlock is asserted to somehow be missing this limitation, it was common knowledge and/or well-known by POSITA to use a bracket to attach a mounting pole to a crown deck (or anything else) as is described and/or shown throughout the Swivelpole catalog." Pet. 61; Ex. 1008 ¶ 83 (same).

Putting aside Petitioner's failure to show a "crown deck," as described above

(Section IV(B)(ii)), Petitioner fails to explain how Gowanlock's heavy under sling "light fixture attachment" and lights could be combined atop Swivelpole's long, slender pole. After all, in the challenged claims, the "mounting pole" is part of the light unit as a whole. The result, which Petitioner fails to specifically address, would be impractical and unsafe, as shown below.



Petitioner's statement that "it was common knowledge and/or well-known by POSITA to use a mounting pole with a light as, for example, is described and/or shown throughout the Swivelpole catalog," Pet. 60, 64-65, 67-69; Ex. 1008 ¶ 83, is wholly insufficient to meet its burden, as it lacks any evidentiary support or analysis. *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1363 (Fed. Cir. 2016) (invoking "common sense" must "be supported by evidence and a reasoned

explanation”). And the conclusory statement from Petitioner’s expert cannot fill the gap. *Xerox*, Paper 9 at 16 (PTAB Aug. 24, 2022).

Thus, Petitioner fails to show that Ground 2 discloses the “mounting pole” limitations, and institution should be denied.

iv. *Ground 2’s references fail to disclose “a bracket configured to attach the mounting pole to the crown deck of the rig”*

For the reasons discussed above for Ground 1, incorporated here, Petitioner fails to show that Gowanlock discloses “a bracket configured to attach the mounting pole to the crown deck of the rig.”

Similarly, Petitioner fails to show that Swivelpole discloses this limitation. According to Petitioner, if “Gowanlock is asserted to somehow be missing this limitation, it was common knowledge and/or well-known by POSITA [sic] to use a bracket to attach a mounting pole to a crown deck (or anything else) as is described and/or shown throughout the Swivelpole catalog.” Pet. 61; *id.* (same for claim 2 but adding “using bolts”).

But Petitioner never identifies any such bracket in Swivelpole. *See id.* (citing Ex. 1004 generally). Instead, Petitioner relies on Mr. Hamdan’s declaration—a carbon copy of the Petition’s “summary chart.” *Compare* Pet. 65-69, *with* Ex. 1008 at ¶83. In the summary chart, Petitioner and Mr. Hamdan contend that Swivelpole “shows a bracket configured to attach the mounting pole to the crown deck or a hand railing, i.e., guard rail, around the crown deck.” Pet.

68; Ex. 1008 at pp. 57. But again, Petitioner never identifies where any bracket is so configured to attach to a crown deck. Nor can it. In fact, beyond these ambiguous, unsupported statements, Petitioner never relies on Swivelpole as disclosing a “crown deck.”

Beyond that, Petitioner merely references “[t]he Swivelpole catalog figure above.” Pet. 68. Although not readily clear, if Petitioner intends to reference the figure on Swivelpole’s page 6, that page shows only a “Stanchion Mounted” and “Stanchion and Structure Mounted” product for the following “Applications”: “Walkway lighting, platforms, stairways, spiral stairways, conveyors.” Ex. 1004 at p. 6. It also discloses “Mounting Kits,” “Junction Box Plates,” a “Security Cover,” “Multi-Purpose Mounts,” and “Luminaire Mounts,” generally. *Id.* But nowhere does it disclose “a bracket configured to attach the mounting pole to the crown deck of the rig.” In fact, Petitioner never specifically identifies anything as meeting the limitation. And walkways, platforms, stairways, and conveyors are not crown decks. Nor does Petitioner or its expert contend they are. A “crown deck” is a specific structure disclosed in neither Gowanlock nor Swivelpole.

Thus, Petitioner has not shown that Ground 2 discloses “a bracket configured to attach the mounting pole to the crown deck of the rig,” and institution should be denied.

- v. Ground 2's references fail to disclose that "the bracket is connected to the crown deck of the rig using bolts"

For the reasons discussed above for Ground 1, incorporated here, Petitioner fails to show that Gowanlock discloses a "bracket [] connected to the crown deck of the rig using bolts."

Likewise, Petitioner fails to show that Swivelpole discloses this limitation. Petitioner alleges that "[t]he Swivelpole catalog figure above shows a bracket that may be connected to the crown deck or a hand railing, i.e., guard rail, around the crown deck using bolts." Pet. 68; *id.* at 61; Ex. 1008 at p. 58 (same). But no support in Swivelpole is identified.

If reference to the "figure above" means the figures on Swivelpole's page 6, neither Petitioner nor Mr. Hamdan identify what on page 6 allegedly constitutes "a bracket configured to attach the mounting pole to the crown deck of the rig." At best, Swivelpole's page 6 shows a "Stanchion Mounted" and "Stanchion and Structure Mounted" product for the following "Applications": "Walkway lighting, platforms, stairways, spiral stairways, conveyors." Ex. 1004 at 6. It also discloses "Mounting Kits," "Junction Box Plates," a "Security Cover," "Multi-Purpose Mounts," and "Luminaire Mounts," generally. *Id.* Nowhere does it disclose "the bracket" of claim 1 that "is connected to the crown deck of the rig using bolts," as claim 2 requires.

Petitioner also states that "bolts are a well-known attachment mechanism for

use with brackets.” Pet. 57. But “[t]he obviousness analysis requires more than an *ipse dixit* assertion that everything in a reference was also well known in the art.” *Samsung Elecs. Co. v. Imperium (Ip) Holdings*, IPR2015-01233, 2015 WL 9599164, at *9 (PTAB Dec. 1, 2015). And, even if bolts were generally well-known in isolation, the claim is not limited to “bolts” generally; instead, it requires that “the bracket is connected to the crown deck of the rig using bolts.” There is no basis to contend that Ground 2 discloses this specific limitation. And the only support for this “well known” argument is the expert declaration, which parrots the petition without providing any supporting evidence or technical reasoning, and must be given little to no weight. *Xerox*, Paper 9 at 15 (PTAB Aug. 24, 2022). If this was something that was easy for Petitioner to find in the prior, then they should have done so, instead of trying to take a shortcut by saying it was well known without any evidentiary support.

Thus, Petitioner has not shown that Ground 2 discloses “the bracket is connected to the crown deck of the rig using bolts,” and institution should be denied.

- vi. Petitioner fails to establish a supportable, non-hindsight reason why a POSITA would have been motivated to combine the references
 - a. Petitioner's KSR catchphrases are unsupported

For most of its purported motivations to combine, Petitioner provides no

more than unsupported catchphrases from *KSR*, which are insufficient. *In re Nuvasive, Inc.*, 842 F.3d 1376, 1384 (Fed. Cir. 2016) (“[Petitioner’s] arguments amount to nothing more than conclusory statements that a [POSITA] would have been motivated to combine the prior art references[.]”).

“Combination of known elements to obtain predictable results.” Petitioner contends it would be “a simple combination of known elements to obtain predictable results, i.e., separately attached pole mounted lights with brackets attached to a crown deck or a hand railing around a crown deck.” Pet. 35. Yet, Petitioner never identifies the allegedly “known elements” that would be combined or why it would be a “simple combination.” Nor does Petitioner explain the proposed lighting system resulting from the alleged combination, how a POSITA would install it on a rig’s crown deck, or how and why the components would be combined to produce the claimed lighting system.

“Obvious and predictable result.” Petitioner argues that “a POSITA would combine the references for the obvious and predictable result of placing or improving modular lighting on a crown deck of a rig.” Pet. 34. Yet, Petitioner never explains *why* such a combination would “improv[e] modular lighting.” Instead, Petitioner appears to argue that a POSITA *could have* combined unidentified teachings from the references in some unspecified ways to provide general improvements—a generic assertion that is insufficient for obviousness.

Matterport, Inc. v. Appliance Computing III, Inc., IPR2021-00939, Paper 15 at 21

(PTAB Nov. 23, 2021) (“That a [POSITA] *could have* done so *is not enough*.”).

“Simple substitution.” Petitioner argues that the combination would be a “simple substitution of one known element (the Swivelpole catalog lights) for another (Gowanlock’s separately attached crown deck lights) to obtain predictable results.” Pet. 35.⁹ But Petitioner provided no reason why swapping these components or features would be a “simple substitution” or why the resulting substitution is predictable. If anything, these substitutions would be far from “simple,” given the myriad issues outlined in the “reasonable expectation of success” section below.

“Known techniques.” Also deficient is Petitioner’s argument that a POSITA would be motivated to combine the references because “the use of known techniques (attaching lights with brackets and poles to a crown deck or a hand

⁹ This alleged motivation to combine appears to introduce a different proposed combination where Swivelpole’s lights are swapped for Gowanlock’s lights. Pet. at 35. In contrast, the Petitioner elsewhere appears to suggest that Gowanlock’s heavy underslung lights are placed atop Swivelpole’s slender pole. *See* Pet. at 34. Either way, the Petitioner fails to provide anything more than a conclusory, unsupported assertion that would have never withstood the rigors of a rig.

railing around a crown deck) to improve similar devices in the same way.” Pet.

35-36. Petitioner never identifies evidence of any specific “technique” being “known.” In fact, none of the references for Ground 2 disclose a “crown deck,” let alone any “known technique” of “attaching lights with brackets and poles to a crown deck or a hand railing around a crown deck.”

Further, Petitioner never identifies the alleged “improve[ment],” “similar devices” or “same way.” Nor does Petitioner explain *why* a POSITA would be motivated to use the purported technique to combine the specific references to arrive at the claimed invention. Such an unsupported motivation is insufficient. *See Nikon Corp. v. ASML Netherlands B.V., Carl Zeiss AG*, IPR2018-00227, Paper 9 at 29 (PTAB Jun. 4, 2018) (denying institution where, inter alia, there was no non-hindsight explanation for why a POSITA “would have been motivated to make the particular combination of features in [the asserted references] to achieve the particular improvements recited in the claims”).

“Ordinary skill and common sense.” Petitioner contends that a POSITA “had good reasons to pursue the known options in the Swivelpole catalog using ordinary skill and common sense to arrive at” the challenged claims. Pet. 37-38. But “references to ‘common sense’...cannot be used as a wholesale substitute for reasoned analysis and evidentiary support.” *Microsoft Corp. v. Enfish, LLC*, 662 F. App’x 981, 989 (Fed. Cir. 2016) (citation omitted). Indeed, if it were only a

matter of “ordinary skill and common sense,” Petitioner should have been able to readily identify a clear example of its use long ago.

“Finite number of ways.” Petitioner further argues that “[t]here are only a finite number of ways to attach lights to a crown deck or a surrounding hand railing.” Pet. 37. But Petitioner never identifies the alleged “finite ways” to which it refers. And simply repeating catchphrases from *KSR* does not, by itself, provide a reason *why* a POSITA would have made the specific choices that resulted in the claimed invention. *In re Nuvasive, Inc.*, 842 F.3d at 1384.

“Known problems.” Petitioner contends that “the combination addresses the known problems (admitted in the Background of the ’016 patent) with certain types of rig lighting that used heavy frames that added weight and were potentially difficult to install because cranes were required.” Pet. 35; Ex. 1008 at ¶ 86. But suggesting a problem was known in the industry by pointing solely to the patent’s discussion is textbook hindsight reasoning. *See Orexo AB v. Actavis Elizabeth LLC*, 903 F.3d 1265, 1271 (Fed. Cir. 2018) (“It is inappropriate to use the template provided by the inventor, to render the inventor’s contribution obvious.”); *KSR Int’l. Co. v. Teleflex Inc.*, 550 U.S. 398, at 421 (2007) (“A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.”). And this purported motivation ignores the reasons the proposed combination could not address the problems faced

in the field, including the height and location of installation and the harsh environmental conditions as discussed below regarding reasonable expectation of success.

b. *Petitioner's remaining motivations to combine are based on impermissible hindsight*

Beyond Petitioner's use of *KSR* catchphrases, Petitioner throws in a slew of purported motivations to combine—none of which are credible, supported, or free of hindsight.

For example, Petitioner contends that a POSITA would be motivated to combine the references because “the Swivelpole products” “swivel to allow installation, adjustment, and maintenance of the light fixtures, [to] provide functionality and flexibility to the rig lighting.” Pet. 35. But Petitioner identifies no evidence, not even from its expert, to support this position.

Petitioner also argues that “lights with mounting poles attached with brackets have been attached to many items such as guardrails for years using tools available in most hardware stores and commonly fabricated in oil field equipment fabrication shops and rig upyards.” Pet. 36. But Petitioner identifies no such evidence that any of the references other than Gowanlock and Chinese '413 could be used in oil fields. At best, the assertion is unsupported ipse dixit from its expert. *See Samsung*, 2015 WL 9599164, at *9.

Petitioner further suggests that “use of ... mounting poles with brackets and

bolts allows mounting or affixing the lights to differently configured, designed, or configured crown decks, including those with or without handrails.” Pet. 34-35; Ex. 1008 ¶ 85 (Mr. Hamdan parroting the same). But this alleged benefit echoes the exact advantages described by the ’016 Patent without more, confirming that it is based on pure hindsight. *See, e.g.*, Ex. 1001 at 2:53-61 (explaining that the disclosed lighting system “is modular and assembled using multiple standalone pieces that may be configured to different structures,” and “[t]here is no master frame or master support structure, which allows for configurability and customization”), 6:1-21 (in discussing “configurations of rig mounting brackets” that “may be used to connect light fixtures 248 to the handrail of the crown deck,” explaining that, “[t]o accommodate various configurations of rigs and illumination requirements, the light fixtures 248 may be mounted to the structure using any combination of the mounting examples above”).

Petitioner falls into the same hindsight trap in alleging that a POSITA would be motivated to combine the references to “make the lights more accessible and easier to adjust.” Pet. 34. Again, this simply tracks the advantages described in the ’016 Patent, and it does so in a conclusory fashion. *See, e.g.*, Ex. 1001 at 2:42-45 (describing embodiment as “modular, which allows it to be assembled on site without the use of heavy equipment, cranes, harnesses, supports, cables, etc.”), 6:40-43 (“As noted above, due to the high costs of rig operation, reducing time for

installation and maintenance and improving safety are significant factors to reducing operation costs.”). Nothing in the prior art discloses these benefits. They were simply cited from the '016 Patent by Petitioner.

As yet another example, Petitioner contends that “a POSITA would readily attach lights ... to a ... mounting pole on a crown deck and/or handrail” because “the Swivelpole pole, which swivels from a point on the pole, would make the lights more accessible and easier to adjust.” Pet. 34. But this purported motivation ignores the incompatibility of the references for any proposed combination, as discussed below in connection with a reasonable expectation of success. For example, even if a Swivelpole would provide accessibility and adjustability in isolated scenarios, there is no evidence that the type of accessibility and adjustability it offers (hinged, two-part pole) would be acceptable to a POSITA for use on a crown deck of a rig. Indeed, nothing in Swivelpole discusses a “crown deck.”

Finally, Petitioner also argues that Swivelpole “shows that its mounting poles *may be* readily attached to hand railings.” Pet. 34. However, the inquiry is whether a POSITA would be motivated to do so, not if it could be done.

Matterport, Inc., Paper 15 at 21 (“That a person of ordinary skill in the art *could have done is not enough*.”).

- vii. Petitioner fails to establish that a POSITA would have had a reasonable expectation of success in combining the references.

Even if all of the limitations of the challenged claims could be found somewhere in the references (which they cannot), a POSITA would not have had a reasonable expectation of success in combining the references as claimed.

For example, Petitioner contends that “[a] POSITA would readily know to combine the mounting poles and brackets shown in the Swivelpole catalog with the method to separately attach a plurality of light units to a crown deck or a hand railing, i.e., guard rail, around the crown deck as taught by Gowanlock.” Pet. 34.

But this statement does not explain *how* Gowanlock could be combined with Swivelpole. Indeed, Gowanlock discloses bulky and heavy underslung light fixtures “attached directly to the crown ... through the light fixture attachment (103 and 202).” Ex. 1003 at [0019]. Swivelpole, in contrast, teaches a long slender pole structure that uses “mounting kits,” such as “Stanchion mounted” or “Stanchion & structure mounted” kits, and it does not specifically specify exactly how the light is attached to the other end. *See, e.g.*, 1004 at 12-13.

Moreover, unlike Gowanlock’s bracket (102 and 204), which holds the light fixture so that the fixture can swivel, the light in Swivelpole appears stationary by design; it is a pole that effectively snaps in half at a hinge, thereby “swiveling” the top half of the structure downward, as shown below.

Gowanlock	Swivelpole (Ex. 1004 at 3)

Neither Petitioner nor its expert explain how these distinct structures could be physically combined, modified for combination, or how any specific combination would operate. *See Johns Manville Corp. v. Knauf Insulation, Inc.*, IPR2018-00827, Paper 9 at 13-14 (PTAB Oct. 16, 2018) (rejecting reasonable expectation of success arguments because “the extent of the modifications proposed by Petitioner, the reasons for such modifications, and whether there would be a reasonable expectation of success are not adequately supported”).

Nor does Petitioner address how a POSITA would have a reasonable expectation of success in doing so. Combining bulky lights installed under the crown at the top of a slender pole that ‘swivels’ into position is (1) not “simple”

and (2) does it involve a “simple substitution of one known element.” Pet. 35.

Petitioner leaves the concerns of structural integrity and safety of such a combination entirely unaddressed.

C. Petitioner has not demonstrated a reasonable likelihood of prevailing on Ground 3 (Chinese ‘413, Swivelpole, and APA).

Ground 3 of the Petition similarly fails for several reasons. Again, Ground 3 does not disclose a “crown deck” or “bracket,” as claimed. But there is more:

First, like with Ground 2, Petitioner fails to identify with particularity the proposed combination on which it intends to rely.

Second, Petitioner repeats the same boilerplate *KSR* catchphrases as alleged motivations to combine without technical analysis or evidentiary support. Most are plagued by an improper attempt to reconstruct the claims in hindsight, relying on conclusory picking-and-choosing by the expert. None provide a supported reason why a POSITA would modify the references or combine them to produce the claimed invention.

Third, Petitioner's arguments regarding a reasonable expectation of success are unsupported, leaving unknown what the combination from these references would look like, how it could be installed on a rig's crown deck, which distinct components such a combined system would consist of, or how and why the components would be modified and combined to produce the claimed lighting system.

i. Ground 3 fails to identify with particularity the proposed combination

As with Ground 2, Petitioner fails to identify the Ground 3 combination with particularity. Petitioner merely relies on an ill-defined combination of “the Admitted prior art, the Swivelpole Catalog, Chinese ’413 *and/or* as commonly known by a POSITA.” Pet. 70; *see id.* at 72 (“Swivelpole catalog, Chinese ‘413, and/or as commonly known by a POSITA”), 73.

Lumping together multiple references for one or more ambiguous combinations by using “and/or” in this way does not satisfy Petitioner’s burden. *See, e.g., Adaptics Ltd., v. Perfect Co.*, IPR2018-01596, Paper 20 at 19 (PTAB Mar. 6, 2019) (even if the Board “consider[ed] only the two-reference combinations encompassed by Petitioner’s asserted ground, Petitioner’s contention encompass[ed] ... a total of seventeen possible combinations,” rendering it “unduly burdensome”). Indeed, there are *almost 70,000* possible combinations based on the narrative portion of the Petition and *1,153* based on the claim chart.

ii. Ground 3’s references fail to disclose a “crown deck”

Petitioner has not shown that Swivelpole satisfies the “crown deck” limitations for the reasons discussed above in connection with Ground 2, which are incorporated here. Similarly, Petitioner fails to show that Chinese ’413 or “Admitted Prior Art” discloses a “crown deck.”

Petitioner points to Figure 1 from the ’016 Patent as purported APA

“show[ing] a lighting system mounted on a rig.” Pet. 76. But a “rig” is not a “crown deck,” which is specific collection of structures according to Petitioner’s own construction. *Compare id, with id.* at 20.

Indeed, the ’016 Patent describes Figure 1 as showing “a prior art crown-mounted frame-based lighting system.” Ex. 1001 at 1:63-64. As Petitioner acknowledges, a “crown” is a collection of structures at the uppermost portion of a drilling rig. Pet. 20. But a crown is not a “crown deck,” which is a collection of structures *within the crown* that includes a walking surface, parts supporting the walking surface, and any associated handrail. *Id.*

Petitioner also cites a “Swivelpole catalog figure” and Figure 1 from Chinese ’413 for this limitation, providing the following conclusory statement without ever identifying a “crown deck”: “A POSITA would readily employ lights, mounting poles, and brackets...to make a modular lighting system *mounted on a rig* as it is admitted in the ’016 Background that the existing system in Figure 1 is too heavy and difficult to install.” *Id.* at 76-77. But mounting a light anywhere on a rig is not what is claimed, and Petitioner nowhere identifies a “crown deck” in either figure. Nor can it. Thus, Petitioner has again failed to meet its burden.

Moreover, to the extent Petitioner cites the undated and unauthenticated pictures listed as Exhibits 1012 and 1012-A as showing “common knowledge,” Pet. 39, 70, the Board should disregard these documents altogether, as Petitioner

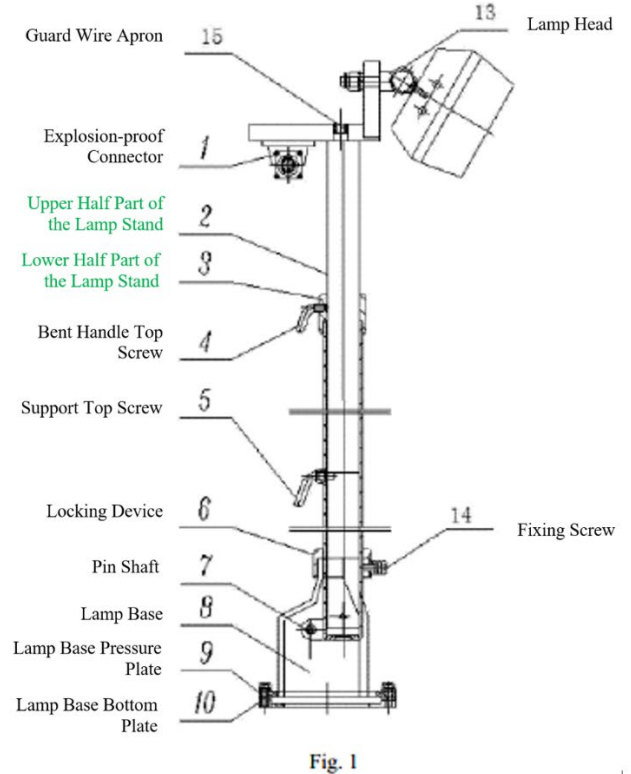
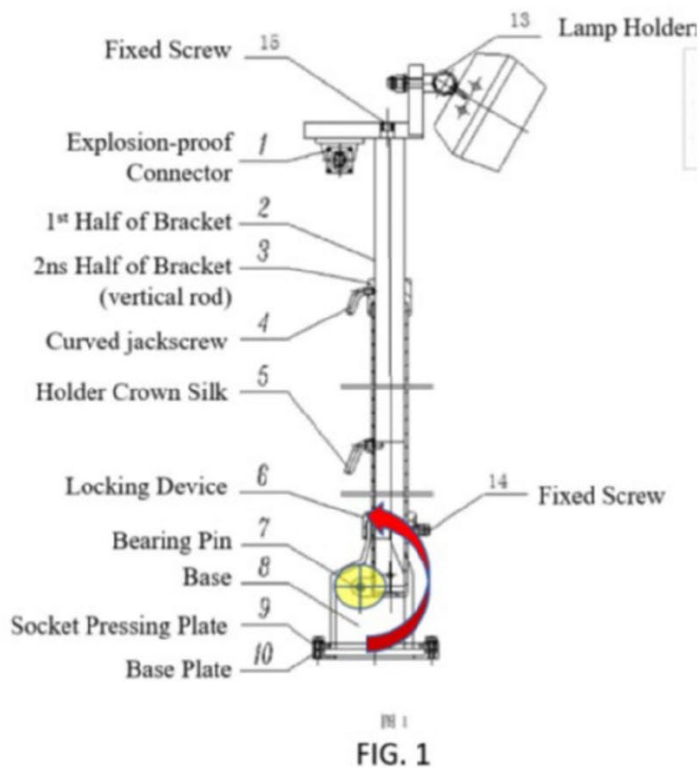
did not identify these pictures as part of its Ground. *Apple Inc. v. AliveCor, Inc.*, IPR2022-00873, Paper 7 at 16 n.1 (“We give no weight to the picture ... because the Petition does not identify the source or date of the picture.”).

iii. Ground 3’s references fail to disclose “a bracket configured to attach the mounting pole to the crown deck of the rig”

For the reasons discussed above in connection with Ground 2, incorporated here, Petitioner fails to show that Swivelpole discloses “a bracket configured to attach the mounting pole to the crown deck of the rig.” Similarly, Petitioner fails to show that Chinese ’413 discloses this limitation.

Petitioner alleges that “Chinese ’413 figure [] show[s] a bracket configured to attach the mounting pole to the crown deck or a hand rail, i.e., guard rail, around the crown deck.” Pet. 79. Petitioner purports to identify items 2 and 3 in Figure 1 of Chinese ’413 as the claimed “bracket.” This is wrong for multiple reasons.

First, Petitioner’s annotated Figure 1 (bottom left) misrepresents Chinese ’413. Compare Pet. 78, and Hamdan Decl. ¶79 with Ex. 1005 at ¶ 18. Items 2 and 3 in Figure 1 are part of a lamp stand. Chinese ’413 explains that Figure 1 shows “2. upper half part of the lamp stand” and “3. lower half part of the lamp stand.” Ex. 1005 at [0018]. It adds that “[a] lamp stand part 2 and lamp stand part 3 are two fully independent parts.” Ex. 1005 at [0023].



Compare Pet. 78, with Ex. 1005 at Fig. 1 (annotated).

Second, Chinese '413's lamp stands part 2 and 3 are not as Petitioner contends "configured to attach the mounting pole to the crown deck or a hand rail, i.e., guard rail, around the crown deck." Pet. 79. Chinese '413 never discusses a "crown deck," "hand rail," or even a "guard rail." Petitioner identifies no evidence to the contrary.

Third, the only discussion in Chinese '413 of attaching the lamp stand is by welding, not a bracket. The Chinese '413 states that "[t]here is a fixing plate 10 under the lamp base, which can be welded on top of a platform of a part that needs lighting." Ex. 1005 at [0023].

Thus, Petitioner has not shown that Ground 3 discloses this limitation, and institution should be denied.

- iv. Ground 3's references fail to disclose a "bracket [] connected to the crown deck of the rig using bolts"

For the reasons discussed above in connection with Ground 2, incorporated here, Petitioner fails to show that Swivelpole discloses "a bracket [] connected to the crown deck using bolts."

Similarly, Petitioner fails to show that Chinese '413 discloses this limitation. Petitioner alleges that "Chinese '413 figure above show[s] a bracket that *may be* connected to the crown deck using bolts." Pet. 79. But Chinese '413 never mentions bolts or a crown deck, let alone shows them in figures.

- v. Petitioner fails to establish a supportable, non-hindsight reason why a POSITA would have been motivated to combine the references

- a. Petitioner's KSR catchphrases are unsupported

As with Ground 2, the majority of Petitioner's purported reasons to combine the references for Ground 3 are based on unsupported catchphrases from KSR, which are insufficient. *In re Nuvasive, Inc.*, 842 F.3d at 1384.

"Combination of known elements to obtain predictable results."

Petitioner's argument that it would be "a simple combination of known elements to obtain predictable results, i.e., separately attached pole mounted lights with brackets attached to a crown deck or a hand railing around a crown deck," Pet. 42,

is problematic for the same reasons noted for Ground 2. *Supra* Section

IV(B)(vi)(a). Indeed, Petitioner reprises this purported motivation to combine verbatim.

“Obvious and predictable result.” Petitioner’s suggestion that “a POSITA would combine the references for the obvious and predictable result of placing or improving modular lighting on a crown deck of a rig,” Pet. 39, 41, fails for the same reason it did in connection with Ground 2. *Supra* Section IV(B)(vi)(a).

“Simple substitution.” Petitioner argues that the combination would be a “simple substitution of one known element (a plurality of the Swivelpole catalog lights attached to the crown deck) for another (prior art Figure 1 frame lights attached to the crown deck) to obtain predictable results.” Pet. 42. But Petitioner articulates no specific reason *why* this would be a “simple substitution” or why the resulting substitution is predictable. This assertion amounts to no more than the conclusory say-so of Petitioner and its mouthpiece expert.

“Known techniques.” Petitioner reprises for Ground 3 that “the use of known techniques (attaching lights with brackets and poles to a crown deck or a hand railing around a crown deck) to improve similar devices in the same way.” Pet. 42. This is insufficient for the reasons discussed for Ground 2. *See supra* at Section IV(B)(vi)(a).

“Ordinary skill and common sense.” Petitioner next contends that a

POSITA “had good reasons to pursue the known options in the Swivelpole catalog or ’413 Chinese using ordinary skill and common sense ... using ordinary skill and common sense to arrive at” the challenged claims. Pet. 44. But “references to ‘common sense’ ... cannot be used as a wholesale substitute for reasoned analysis and evidentiary support.” *Microsoft*, 662 F. App’x at 989. Indeed, if it were only a matter of “ordinary skill and common sense,” Petitioner could identify a clear example of its use long ago.

“Finite number of ways.” Petitioner’s argument that “[t]here are only a finite number of ways to attach lights to a crown deck or surrounding hand railing,” Pet. 44, is unsupported as described for Ground 2 where Petitioner tries the same argument. *Supra* Section IV(B)(vi)(a).

b. *Petitioner’s remaining motivations to combine are based on impermissible hindsight.*

Beyond Petitioner’s use of *KSR* catchphrases, Petitioner throws in a slew of purported motivations to combine—none of which are credible, supported, or free of hindsight. Each of the following arguments offered by Petitioner are repeats of those offered for Ground 2, and they fail for the same reasons, which are incorporated here:

- Petitioner suggests a POSITA would have reasonably expected to succeed in combining the identified references “because lights with mounting poles attached with brackets have been attached to many

items such as guardrails for years using tools available in most hardware stores and commonly fabricated in oil field equipment fabrication shops and rig upyards.” *Compare* Pet. 43, with *supra* Section IV(B)(vi)(b).

- Petitioner further suggests that “use of...mounting poles with brackets and bolts allows mounting or affixing the lights to differently configured, designed, or configured crown decks, including those with or without handrails.” *Compare* Pet. 40 and Ex. 1008 ¶¶ 95, 97, with *supra* Section IV(B)(vi)(b).
- Petitioner falls into the same hindsight trap in alleging that a POSITA would be motivated to combine the references for each of Ground 3 because “to make lights in prior art Fig. 1 less heavy, easier to install, easier to uninstall, and safer.” *Compare* Pet. 39, with *supra* Section IV(B)(vi)(b).
- Petitioner contends that a POSITA would be motivated to combine the references because “the Swivelpole products” and the ’413 Chinese reference “swivel” or “move to allow installation, adjustment, and maintenance of the light fixtures, to provide functionality and flexibility to the rig lighting.” *Compare* Pet. 42, with *supra* Section IV(B)(vi)(b).

- Petitioner argues that at least one of the references “shows that its mounting poles *may be* readily attached to hand railings.” *Compare* Pet. 39, with *supra* Section IV(B)(vi)(b).

vi. *Petitioner fails to establish that a POSITA would have had a reasonable expectation of success in combining the references*

Even if all limitations of the challenged claims could be found somewhere in the references (not the case here), a POSITA would not have had a reasonable expectation of success combining the references.

For example, Petitioner fails to explain how a POSITA would combine these references or how any combination would result in the claimed invention. *See* Pet. 38-44. In fact, whereas the Chinese ‘413 Patent discloses sliding a top pole inside a bottom pole, Ex. 1005 at [0023], Swivelpole discloses swiveling a top pole relative to a bottom pole, Ex. 1004 at 4. The two simply cannot be combined in a manner that works for either reference’s intended purpose.

Accordingly, it is impossible to determine what the combination of these references would look like, how it could be installed on a rig’s crown deck, the distinct components such a combined system would consist of, or how and why the components would be modified and combined to produce the claimed lighting system.

D. Petitioner has not demonstrated a reasonable likelihood of prevailing on Ground 4 (Magnalight Video and APA).

Ground 4 of the Petition also fails. As with Grounds 2-3, Petitioner fails to identify the Ground 4 combination with the required particularity. Instead, Petitioner attempts to hedge its bets by linking the Larson Electronics / Magnalight YouTube video (“Magnalight”), APA, or “knowledge” with “**and/or**” throughout. Beyond that, like for Grounds 1-3, Petitioner fails to establish Ground 4 discloses a “crown deck,” “mounting pole,” or “bracket” limitation. And Petitioner does not identify any supportable, non-hindsight motivation to combine or reasoned, supported basis for a reasonable expectation of success.

i. Ground 4 fails to identify with particularity the proposed combination.

Petitioner fails to identify the Ground 4 combination with particularity. Although Petitioner purports to rely on a combination of “Larson Electronics / Magnalight YouTube video in light of Admitted prior art in ’016 Background and Figure 1,” Pet. 11, Petitioner’s Ground 4 analysis is rife with the use of “and/or,” as with Grounds 2 and 3.

For example, for claim 1’s limitation reciting “a plurality of light units, each light unit separately attached to a crown deck of the rig ...,” Petitioner states the “limitation was common knowledge **and/or** it was well-known or common sense to a POSITA ... in light of the Admitted prior art **and/or** the limitation is described

and/or shown in the Magnalight YouTube video **and/or** as commonly known to a POSITA.” *Id.* at 81. This results in over **18,400** possible combinations.

And throughout the Petition, Petitioner merely cites the “Magnalight YouTube video” exhibit in full without pinpoint citations to anything specific, referencing nearly identical statements from the expert’s declaration that offer no analysis or reasoning. *See, e.g., id.* (“Ex. 1001, Ex. 1006, and Ex. 1008, including ¶¶ 103-11”).

Because it is unclear what Ground 4 encompasses and what evidence Petitioner relies on to establish unpatentability, institution should be denied. *InVue*, PGR2019-00019, Paper 7 at 8-9.

ii. Ground 4’s references fail to disclose a “crown deck”

Petitioner again contends that this limitation is shown in Figure 1 of the ’016 Patent because it purportedly “shows a lighting system mounted on a rig.” Pet. 81, 83, 87, 88. But, as discussed above, Petitioner does not demonstrate that this Figure discloses a “crown deck.” *See supra* Section IV(C)(ii).

AAPA aside, Petitioner does not (and cannot) rely on Magnalight as disclosing a “crown deck.” *See* Pet. 81, 83, 87, 88. Instead, the video appears to show a person in what looks like a parking lot or industrial work area, with no rig or crown deck in sight.

Thus, Petitioner fails to show that Ground 4 discloses a “crown deck,” and

institution should be denied.

iii. Ground 4's references fail to disclose a "mounting pole"

Petitioner summarily states that “[l]ight units comprising a separate mounting pole for each light are depicted in the Magnalight YouTube video” without citing anything from the video in support. Pet. 88. Instead, the Petition identifies an “aluminum mount,” Pet. 48; Ex. 1008 ¶ 106, and a “J-hook bottom bracket.” The video presenter easily lifts the mount off the metal stand, and it appears to wobble as the presenter does so, confirming that this device could never withstand the rigors of a rig. Ex. 1006 at 0:35-0:37.

Beyond that, Mr. Hamdan only provides (i) an unidentified and undated photo as allegedly showing that “a light fixture or other items are commonly attached to a handrail via a pole, a bracket, and/or more screws or bolts,” Ex. 1008 ¶ 108, and (ii) a picture of a flag pole in support of the conclusory statement that “[p]oles have been attached to crown deck hand railing with flag, airplane lights, and other structures attached,” *id.* at ¶ 1009. These assertions without more are “conclusion[s] rather than the requisite articulate reasoning with rationale underpinning.” *Charter Commc’ns v. Sprint Commc’ns Co., L.P.*, IPR2019-01137, Paper 9 at 26 (PTAB Dec. 9, 2019). They should be given no weight. *Xerox*, Paper 9 at 15.

Thus, Petitioner fails to show that Ground 4 discloses the “mounting pole”

limitations, and institution should be denied.

iv. Ground 4's references fail to identify "a bracket configured to attach the mounting pole to the crown deck of the rig"

Petitioner does not identify any bracket in Magnalight that is "**configured** to attach the mounting pole to the crown deck of the rig." Magnalight employs a temporary J-hook attachment for mounting. It appears to be an easy-to-install and easy-to-remove light system suited for use in occluded or, at the very least, stable environment. This system with its unsecure, flimsy connection does not appear suitable for attaching lights to the rig's crown deck, which is high off the ground and subject to extreme weather and working conditions. And, as discussed above, AAPA Figure 1 does not disclose a "crown deck" or a "mounting pole." *See supra* Section IV(C)(ii).

Thus, Petitioner fails to show that Ground 4 discloses this limitation, and institution should be denied.

v. Ground 4's references fail to disclose that "the bracket is connected to the crown deck of the rig using bolts"

Petitioner incorrectly states that "[t]he Magnalight Youtube video shows a bracket that **may be connected** to the crown deck or a hand railing, i.e., guard rail, around the crown deck **using bolts**." Pet. 88. Magnalight never discloses a crown deck or even a rig. And Magnalight's connection does not use bolts. Instead, its bracket is a "J-hook bottom bracket." Exhibit 1006-A. The video presenter easily

lifts the mount off the rail without more—i.e., no bolts are removed—again confirming that this consumer device is not designed for the rigors of a rig. Ex. 1006 at 0:35-0:37.

Petitioner's statement that "[t]he Magnalight YouTube video **and/or** as commonly known by a POSITA disclose a bracket that *may be used* to connect to the crown deck of the rig using bolts," Pet. 82, is also unsupported. Just because something *could be* done does not mean that a POSITA *would have been motivated* to do so. *See InTouch Techs., Inc. v. VGO Commc'ns, Inc.*, 751 F.3d, 1327, 1352 (Fed. Cir. 2014). The only support is conclusory expert declaration that must be given little or no weight. *Xerox*, Paper 9 at 15.

vi. *Petitioner fails to establish a supportable, non-hindsight reason why a POSITA would have been motivated to combine the references*

a. *Petitioner's KSR catchphrases are unsupported*

As with Grounds 2-3, most of Petitioner's purported reasons to combine the references for Ground 4 are based on catchphrases from *KSR*, which are unsupported and insufficient. *In re Nuvasive, Inc.*, 842 F.3d at 1384.

"Combination of known elements to obtain predictable results."

Petitioner's contention that it would be "a simple combination of known elements to obtain predictable results, i.e., separately attached pole mounted lights with brackets attached to a crown deck or a hand railing around a crown deck," Pet. 48,

is problematic for the same reasons as noted for Ground 2. *Supra* Section

IV(B)(vi)(a). Petitioner reiterates this purported motivation to combine verbatim.

“Obvious and predictable result.” Petitioner’s suggestion that “a POSITA would combine the references for the obvious and predictable result of placing or improving modular lighting on a crown deck of a rig,” Pet. 48, also fails for the same reason as it does in Ground 2. *See supra* at Section IV(B)(vi)(a).

“Simple substitution.” Petitioner argues that the combination would be a “simple substitution of one know element (a plurality of Magnalight YouTube video attached to the crown deck) for another (prior art Figure 1 frame lights attached to the crown deck) to obtain predictable results.” Pet. 49. But Petitioner articulates no specific reason *why* any of these swaps would be a “simple substitution.” This assertion is a merely a conclusory say-so of Petitioner and its mouthpiece expert.

“Known techniques.” Petitioner contends a POSITA would be motivated to combine the references because “the use of known techniques (attaching lights with brackets and poles to a crown deck or a hand railing around a crown deck) to improve similar devices in the same way.” Pet. 49. This is insufficient for the reasons discussed for Ground 2. *See supra* at Section IV(B)(vi)(a).

“Ordinary skill and common sense.” Petitioner further contends that a POSITA “had good reasons to pursue the known options in the Larson Electronics

/ Magnalight YouTube video using ordinary skill and common sense to arrive at” the challenged claims. Pet. 50-51. But “references to ‘common sense’ ... cannot be used as a wholesale substitute for reasoned analysis and evidentiary support.” *Microsoft*, 662 F. App’x at 989. If it were only a matter of “ordinary skill and common sense,” Petitioner could identify a clear example of its use long ago.

“Finite number of ways.” Petitioner’s argument that “[t]here are only a finite number of ways to attach lights to a crown deck or surrounding hand railing,” Pet. 50, is unsupported for the same reason as described for Ground 2 where Petitioner attempts the same argument. *See supra* Section IV(B)(vi)(a).

vii. *Petitioner’s remaining motivations to combine are based on impermissible hindsight.*

Beyond Petitioner’s use of *KSR* catchphrases, Petitioner throws in a slew of purported motivations to combine—none of which are credible, supported, or free of hindsight. *In re Nuvasive, Inc.*, 842 F.3d 1376, 1384 (Fed. Cir. 2016). Each of the following arguments offered by Petitioner are repeats of those offered for Ground 2, and they fail for the same reasons, which are incorporated here:

- Petitioner suggests a POSITA would have reasonably expected to succeed in combining the identified references “because lights with mounting poles attached with brackets have been attached to many items such as guardrails for years using tools available in most hardware stores and commonly fabricated in oil field equipment

fabrication shops and rig upyards.” *Compare* Pet. 49, *with supra*

Section IV(B)(vi)(b).

- Petitioner falls into the same hindsight trap in alleging that a POSITA would be motivated to combine the references for each of Ground 4 because “to make lights in prior art Fig. 1 less heavy, easier to install, easier to uninstall, and safer.” *Compare* Pet. 45, *with supra* Section IV(B)(vi)(b).
- Petitioner argues that at least one of the references “shows that its mounting poles *may be* readily attached to hand railings.” *Compare* Pet. 48, *with supra* Section IV(B)(vi)(b).

viii. Petitioner fails to establish that a POSITA would have had a reasonable expectation of success in combining the references.

Even if all limitations of the challenged claims could be found somewhere in the references (which they cannot), a POSITA would not have had a reasonable expectation of success combining the references to achieve the claimed invention.

For example, Petitioner fails to explain why a POSITA would have a reasonable expectation of success in combining the product shown in the Mangalight video with purported “admitted prior art” to achieve the claimed invention. *See Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016) (“[O]ne must have a motivation to combine accompanied by a reasonable expectation of achieving what is claimed in the

patent-at-issue.”). The J-Hook rail mount shown in the Magnalight video visibly wobbles and shifts along the rail even at the slightest amount of pressure applied to it. Ex. 1006 at 0:16-0:18, 0:28-0:29. And the mount is removed by simply lifting the mount upwards. *Id.* at 0:35-0:37.

Magnalight's product used on a rig's crown deck hundreds of feet in the air, with high winds, and people working below is not only unsuitable for its intended use, but downright dangerous if lights shift position or fall, thereby posing safety risks that the '016 Patent was explicitly avoiding. Ex. 1001 at 2:45 (discussion the claimed invention “reduc[ing] the risk of accidents”), 4:54-57 (“Safety cables connected between the light fixture 248 and cap 246 may be used as a backup in the event that pins 250 back out or are sheared during an extreme weather condition.”), 4:58-61 (“Generally, the light units 210, 220, and 230 have a low profile to minimize the wind shear forces that may be experienced by the light units at the top of a structure (such as a rig) to which they are mounted.”).

V. THE BOARD SHOULD DENY INSTITUTION UNDER § 314(a)

As detailed below, the *Fintiv* factors on balance favor denial.¹⁰

A. Factor 1: A Stay is Highly Unlikely in the Parallel Proceeding

¹⁰ The Petitioner already addressed the *Fintiv* factors in the Petition and should not be afforded an opportunity to Reply on this basis. Pet. at 89-93.

The first factor is neutral or favors denial of institution because there is presently no stay in the parallel proceeding before the Western District of Texas, and Petitioner has not moved for one despite its alleged intent to do so. *See* Pet. 90. Even so, a stay is unlikely. The district court case is advancing through claim construction proceedings and includes several issues that go beyond the scope of this proceeding. Only one of three causes of action in the district court case would be affected by a decision here, as Patent Owner also alleges infringement of a different patent that Petitioner have not petition for¹¹ and breach of contract. *See* Ex. 2001.¹²

B. Factor 2: The Median Time to Trial Is Before the Deadline for a Final Written Decision

This factor is likely neutral or slightly favors denial. The trial in the parallel district court proceeding is set for January 21, 2025. But, in the Southern District of Texas, the median time-to-trial is 30.7 months.¹³ This yields an expected trial

¹¹ The Petitioner has not and cannot challenge the '626 Patent in an IPR because the statutory deadline has passed. *See* 35 U.S.C. § 315(b)

¹² If the Board declines to speculate on the possibility of a stay, this factor is—at most—neutral. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (PTAB May 13, 2020).

¹³ Available at https://www.uscourts.gov/sites/default/files/data_tables/fcms_na_

date of September 24, 2024—about a week before the Final Written Decision is expected here.

Even if the FWD and trial date were to occur at roughly the same time, this means that the trial would proceed on a crash course with the FWD. This could result in conflicting decisions from the Board and the district court at nearly the same time, and the parties racing to the Federal Circuit, which will face potentially inconsistent decisions with different records and different findings. Combining this inefficiency and conflict with the other factors discussed below, the Board should exercise its discretion to deny institution. *Fintiv*, Paper 11 at 9 (“If the court’s trial date is at or around the same time as the projected statutory deadline, the decision whether to institute will likely implicate other factors...”).

C. Factor 3: The Parties Have Invested Significant Time and Money in The Parallel Proceeding, Which Has Been Pending for Over 16 Months

This factor strongly favors denying institution. The parties having already committed substantial resources to the parallel proceeding, which has been pending for over 16 months. Patent Owner served its preliminary infringement contentions on December 13, 2022, and Petitioner served its preliminary invalidity contentions on March 13, 2023. The parties have completed claim construction briefing, and fact discovery is underway with the *Markman* hearing to on August 24, 2023. Given the stages of the district court proceeding, this favor favors denying

institution.

Petitioner also waited until March 30, 2023—just days before the statutory deadline—to file its Petition, which is over 8 months *after* it identified its primary “Gowanlock” reference in the amended answer. This further favors denying institution. *Fintiv*, Paper 11 at 11-12 (facts favor denial “[i]f [] the evidence shows that the petitioner did not file the petition expeditiously, such as at or around the same time that the patent owner responds to the petitioner’s invalidity contentions, or even *if the petitioner cannot explain the delay in filing its petition*”); *Canon Inc. v. Optimum Imaging Techs. LLC*, IPR2020-01322 Paper 9 at 8 (PTAB Mar. 1, 2021) (asking “whether a petitioner acts promptly with respect to activities in the parallel litigation, such as *filing petition ‘promptly after becoming aware of the claims being asserted.’*”).

D. Factor 4: The Petition Challenges the Same Claims Using Substantially the Same Prior Art That Petitioner Asserts in the Parallel Proceeding

This factor weighs heavily in favor of denying the Petition because the Petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceedings. *Fintiv*, Paper 11

In the parallel proceeding, Petitioner challenges the same claims of the ’016 patent. *See* Ex. 2002, Suppl. Preliminary Invalidity Contentions. For Grounds 1-3, Petitioner charted all of the same the references too. *Compare, e.g.,* Pet. 11, *with*

Ex. 2003, Suppl. Invalidity Chart. With only one out of four Grounds as different, the Petition still asserts substantially the same claims using substantially the same evidence. *See, e.g., Samsung Elecs. Co. v. Clear Imaging Rsch.*, IPR2020-01399, Paper 13 at 24 (PTAB Feb. 3, 2021) (factor favoring discretionary denial where only two out of four references were asserted in the parallel proceeding because “there [would] likely be overlap between the issues[.]”).

Nor has Petitioner offered to withdraw all grounds that could have reasonably been raised in the petition—i.e., the full scope of estoppel if this IPR proceeds to a final written decision. 35 U.S.C. § 315(e)(2); *Sand Revolution II, LLC v. Cont’l Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 12 n.5 (PTAB June 16, 2020) (informative). Instead, Petitioner only “stipulates that if the Board institutes the petition, it will not seek resolution in the District Court on Grounds 1-4 asserted herein.”¹⁴ Pet. 92.

Because Petitioner has not offered a *Sotera* stipulation, this factor favors denial. *See, e.g., Google LLC v. Ikorongo Tech. LLC*, IPR2021-00205, Paper 13 at 7-13 (PTAB June 7, 2021) (denying institution where stipulation proposed in the

¹⁴ Moreover, the Petitioner’s stipulation can only address one out of the two patents at issue in the district court proceeding and leaves the other non-patent cause of action marching full speed ahead.

petition did not cover all potential grounds that reasonably could have been raised; it only covered the grounds cited in the petition); *Samsung Elecs. Co. v. Ancora Techs., Inc.*, IPR2020-01184, Paper 11 at 18-22, 27-28 (PTAB Jan. 5, 2021) (denying institution where stipulation did not cover all potential grounds that reasonably could have been raised).

E. Factor 5: The Parties in Both Proceedings are the Same

Factor 5 favors denial of institution because “petitioner and the defendant in the parallel proceeding are the same party.” *Fintiv*, IPR2020-00019, Paper 15 at 15; see *SK Innovation Co., LTD v. LG Chem, LTD*, IPR2020-01239, Paper 14 at 20-21 (PTAB Jan. 12, 2021).

F. Factor 6: Petitioner's Arguments Do Not Plainly Lead to a Conclusion of Unpatentability

Petitioner does not present a compelling invalidity challenge sufficient to outweigh the preceding five factors. See Katherine K. Vidal, *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (June 21, 2022)¹⁵ (“Vidal Memo”) at 5 & n.6; *Vector Flow, Inc. v. HID Glob. Corp.*, IPR2023-00353, Paper 8 at 25 (PTAB July 17, 2023) (“A

¹⁵ Available at:

https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf

conclusion of unpatentability *cannot* ‘plainly’ follow from an analysis that declines to offer nothing more than ‘possibilities’ as how the claims might be understood.”).

Further, given that Petitioner does not meet the reasonable likelihood of success standard for institution (as explained above), it cannot meet the significantly higher standard for a compelling invalidity challenge. Vidal Memo at 4. Accordingly, this factor favors denying institution.

VI. CONCLUSION

For these reasons, Patent Owner respectfully requests that the Board deny the Petition in full.

Dated: July 28, 2023

Respectfully Submitted,

/ Dion M. Bregman /

Dion M. Bregman, Reg. No. 45,645

CERTIFICATION OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This PATENT OWNER PRELIMINARY RESPONSE to Petition includes 13,102 words, as counted by Microsoft Word, and is therefore in compliance with the 14,000-word limit established by 37 C.F.R. § 42.24(b)(1). Accordingly, pursuant to 37 C.F.R. § 42.24(d), lead counsel for Patent Owner hereby certifies that this paper complies with the applicable type-volume limits.

Dated: July 28, 2023

Respectfully Submitted,

/ Dion M. Bregman /

Dion M. Bregman, Reg. No. 45,645

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), lead counsel for Patent Owner hereby certifies that on July 28, 2023, a copy of this PATENT OWNER'S PRELIMINARY RESPONSE was served to the email correspondence address of record for Petitioner's counsel of record:

Gregory Porter (gregporter@andrewskurth.com)
Daniel Shanley (dshanley@kenyon.com)

Dated: July 28, 2023

Respectfully Submitted,

/ Dion M. Bregman /
Dion M. Bregman, Reg. No. 45,645