

ENTERED

December 14, 2023

Nathan Ochsner, Clerk

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF TEXAS
HOUSTON DIVISIONCANATEX COMPLETION SOLUTIONS, §
INC., §

Plaintiff, §

VS. §

WELLMATICS, LLC, *et al.*, §

Defendants. §

CIVIL ACTION NO. 4:22-CV-03306

ORDER

Before the Court are Plaintiff's Opening Claim Construction Brief (Doc. #84), Defendants' Response Brief (Doc. #85), and Plaintiff's Reply (Doc. #89). The Court held a hearing on September 26, 2023, in accordance with *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), during which the parties presented arguments in support of their proposed constructions. Having reviewed the parties' arguments, the evidence, and applicable legal authorities, the Court construes the disputed terms as follows.

I. Background

This is a patent infringement case involving a downhole release tool that was patented by Plaintiff Canatex Completions Solutions, Inc. ("Plaintiff") as the "Releasable Connection for a Downhole Tool String," U.S. Patent No. 10,794,122 (the "'122 Patent"). Doc. #29 ¶ 14–16; Doc. #84 at 1. The release tool has "an internal source of fluid pressure (e.g., a combustible) that can be reliably activated to release a tool string stuck miles deep in an oil well." Doc. #84 at 1. Plaintiff alleges that Defendant Wellmatics, LLC's ("Wellmatics") PHIRE Escape Release Tool ("PHIRE") infringes on the '122 Patent. Doc. #29 ¶ 10. Plaintiff further contends that Wellmatics sells or

distributes PHIRE to Defendants GR Energy Services Management, LP, GR Energy Services Operating GP, LLC, and GR Wireline, LP (collectively with Wellmatics, “Defendants”), who then sell PHIRE to customers in the energy field. *Id.* Thus, Plaintiff alleges that Defendants infringe the ‘122 Patent by “importing, making, using, selling and/or offering to sell” PHIRE because it “satisfies every element of at least claim 1.” *Id.* ¶¶ 23, 26.

There are five claim phrases in the ‘122 Patent that are in dispute. Doc. #78. The Court will begin its analysis with the claim phrase, “a release position that permits the releasable engagement profile to expand radially to release the connection profile of the second part.” Doc. #78, Ex. 1. Plaintiff acknowledges that this claim phrase contains an error and asks the Court to judicially correct it. Defendants, on the other hand, urge the Court to find that the claim phrase is indefinite. *Id.* Because the erroneous phrase is present in all independent claims (claims 1, 7, and 13), a finding that the phrase is indefinite would render the ‘122 Patent invalid. *See* Doc. #29, Ex. 1; Doc. #85 at 7; *see also* 35 U.S.C. § 112(d).

II. Legal Standard

“[T]he construction of a patent, including terms of art within its claim, is exclusively within the province of the court.” *Markman*, 517 U.S. at 372. “There is a heavy presumption that claim terms are to be given their ordinary and customary meaning. Courts are required therefore to look to the words of the claims themselves to define the scope of the patented invention.” *Aventis Pharms. Inc. v. Amino Chems. Ltd.*, 715 F.3d 1363, 1373 (Fed. Cir. 2013) (citations omitted). In addition to the claims, courts also look to “the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art.” *Id.* Courts “presume, unless otherwise compelled, that the same

claim term in the same patent or related patents carries the same construed meaning.” *Omega Eng’g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1334 (Fed. Cir. 2003).

In limited circumstances, a court may retroactively correct an error in a patent. *Grp. One, Ltd. v. Hallmark Cards, Inc.*, 407 F.3d 1297, 1302–03 (Fed. Cir. 2005). To do so, the error must be evident from the face of the patent. *Id.* at 1303; *see also Novo Indus., L.P. v. Micro Molds Corp.*, 350 F.3d 1348, 1357 (Fed. Cir. 2013) (“[W]here the error is not evident from the face of the patent itself, . . . it is important that the [United States Patent and Trademark Office] bring its expertise to bear and consider whether such a correction is appropriate.”). Thus, the district court can only correct the patent if “(1) the correction is not subject to reasonable debate based on consideration of the claim language and the specification and (2) the prosecution history does not suggest a different interpretation of the claims.” *Novo Indus., L.P.*, 350 F.3d at 1357. If the court is not authorized to correct the error, it must find that the patent is invalid for indefiniteness. *Id.* at 1358. “[A] patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014).

III. Claim Terms

- a. “a release position that permits the releasable engagement profile to expand radially to release the connection profile of the second part” (Claims 1, 7, and 13)

Plaintiff’s Construction	Defendants’ Construction
The claim phrase contains an obvious error and the correction is not subject to reasonable debate: “a release position that permits the releasable engagement profile to expand radially to release the connection profile of the second <u>first</u> part”	Indefinite

Court's Construction: Indefinite

Plaintiff avers that there is a “clear clerical error” in the phrase that erroneously references “the connection profile of the second part,” when the drafter should have written “the connection profile of the first part.” Doc. #84 at 9. According to Plaintiff, there are a couple of indicators that the error is obvious on the face of the patent. First, Plaintiff notes that the claim term uses the definite article “the,” which in patent parlance “means the term refers back to a connection profile previously identified in the claim.” *Id.* But in claims 1, 7, and 13, there are no “prior reference[s] to a connection profile ‘of the *second* part.’ Instead, the only ‘connection profile’ recited throughout claims 1, 7, and 13 is ‘of the *first* part.’” *Id.* (emphases in original). Therefore, Plaintiff contends that “[b]ecause the claim term as drafted is inconsistent with all other references to the ‘connection profile,’ a POSITA [(person of ordinary skill in the art)] would understand that the claim term contains an error and the drafter intended to refer to the connection profile ‘of the first part,’ which is the only ‘connection profile’ in the claim.” *Id.* at 10. Next, Plaintiff notes that the specification further confirms that there is a minor error in the claim term because the same erroneous phrase is used, which suggests “that the patent drafter made this drafting error early in the patent drafting process[] and simply duplicated the erroneous description of the ‘release of . . . ’ language throughout the specification and claims.” *Id.* at 10–11.

Defendants, on the other hand, argue that the claim is indefinite for the reasons Plaintiff highlights. First, Defendants note that the lack of antecedent basis for a connection profile of the second part—the fact that there is no prior reference to a connection profile of the second part—is and of itself a reason for the Court to find that the claim is indefinite. Doc. #85 at 12 (citing *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1249 (Fed. Cir. 2008) for the proposition that a claim can be indefinite if it lacks a proper antecedent basis). Defendants contend

that the error is not obvious from the face of the patent because the release tool has a first and second part, both of which appear to have connection profiles. *Id.* at 13; *see also* Doc. #85, Ex. 1 at 3. Therefore, Defendants claim that a POSITA “could not discern the boundaries of this term with reasonable certainty, since it is not clear whether the claimed invention encompasses a connection profile only on the first part *or* two different connection profiles with one on the first part and the other on the second.” Doc. #85 at 13 (emphasis in original); *see also* Doc. #85, Ex. 1 at 3. Further, Defendants assert that the repeated use of the erroneous language in the specification (and in the abstract) further complicates, rather than clarifies, the matter. Indeed, because the error is repeated throughout the patent and the specification, it “would only leave a [POSITA] to infer that it was not an error, but an intentional (yet unclear) drafting choice.” Doc. #85 at 14.

Here, the Court finds that the error is not evident from the face of the patent and the correction to the claim is not as simple as Plaintiff makes it seem. It is undisputed that the release tool at issue has two parts, the first part and the second part, and that the erroneous language is repeated in independent claims, 1, 7, and 13, and in the specification. As such, the pervasiveness of the error could suggest that it was an intentional drafting choice and not an error at all. Further, while the error could be that the drafter intended to reference the connection profile of the first part instead of the connection profile of the second part, as Plaintiff suggests, it could also be that the drafter intended to provide an antecedent basis for a connection profile of the second part, thus making the error the use of “the” instead of “a.” As Defendants note, it appears that both parts have a connection profile, so either construction could be reasonable. *See* Doc. #85, Ex. 1 at 3. Further, the prosecution history is not helpful in this case because it, too, contains the same error. Doc. #84 at 12. Thus, the error is not evident from the face of the patent, and judicial correction is not proper.

The Court also notes that pursuant to Sections 254 and 255 of Title 35 of the United States Code, the United States Patent and Trademark Office (“PTO”) is authorized to correct mistakes in a patent by issuing a certificate of correction. 35 U.S.C. §§ 254–255; *see also Grp. One, Ltd.*, 407 F.3d at 1302–03. However, Plaintiff has not sought correction from the PTO, stating, “As with the countless other patentees who have corrected clear errors in a patent during litigation, Canatex is not required to spend years at the [PTO] seeking a certificate of correction to correct such a minor error.” Doc. #89 at 6. Similarly, during the parties’ *Markman* hearing, when questioned about seeking correction from the PTO, Plaintiff’s counsel stated that Plaintiff could seek relief from the PTO but “[t]ime is of the essence” and “judicial correction is an avenue that is available to the patent holder.” Doc. #96 at 66:21-23. However, Plaintiff’s counsel could not cite to any cases wherein the court judicially corrected a non-obvious error in a patent because the PTO would take too long to do so. In fact, in *Smith v. ORBCOMM, Inc.*, the United States District Court for the Eastern District of Texas found in part that an error was not evident from the face of the patent *because* the plaintiff failed to seek correction from the PTO, stating,

Here, the Court finds that the error is not evident from the face of the patent. If the error was evident from the face of the patent, then Plaintiff would not continue to argue for an alternative construction. Instead, once identified, Plaintiff could have sought to correct the error with the PTO.

As Plaintiff’s counsel stated during the claim construction hearing in this case, he didn’t think it was necessary or a requirement to seek correction from the PTO. He further stated that there is support in the specification Given this, the Court finds that Plaintiff’s arguments and actions in this case remove any possibility that the ‘no reasonable debate’ standard has been overcome. Moreover, the record indicates that Plaintiff has no intent to seek correction from the PTO. Accordingly, the Court finds that it ‘does not have authority to correct the patent in such circumstances.’

No. 2:14-cv-666 (Lead Case), 2015 WL 5302815, at *13 (E.D. Tex. Sept. 10, 2015) (citations omitted) (quoting *H-W Tech. L.C. v. Overstock.com, Inc.*, 758 F.3d 1329, 1334 (Fed. Cir. 2014)).

Like in *Smith*, Plaintiff's refusal to seek correction from the PTO, despite knowing that it would be proper to do so, further suggests that the error in the '122 Patent is not evident on its face. As such, the Court does not have the authority to correct the error in the '122 Patent and finds that claims 1, 7, and 13 are invalid for indefiniteness.

b. Remaining Claim Terms

Court's Construction: Indefinite

Because the Court has invalidated claims 1, 7, and 13—all of the independent claims in the '122 Patent—all other disputed claim terms found in the dependent claims are also invalid. *See* 35 U.S.C. § 112(d).

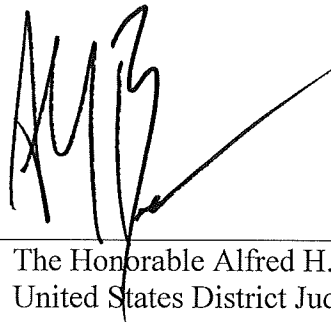
IV. Conclusion

The Court hereby adopts the above constructions of the disputed claim terms.

It is so ORDERED.

DEC 14 2023

Date

A handwritten signature in black ink, appearing to read 'AHB', is written over a horizontal line. The signature is stylized and fluid.

The Honorable Alfred H. Bennett
United States District Judge