

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. IPR2024-00005
U.S. Patent No. 10,900,626

**PATENT OWNER'S PRELIMINARY RESPONSE
TO PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT NO. 10,900,626**

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I. INTRODUCTION

C&M Oilfield Rentals, LLC d/b/a C-MOR Energy Services (“Patent Owner”) submits this Preliminary Response to the Petition by Ensign US Southern Drilling LLC (“Petitioner”) seeking *inter partes* review of claims 9 and 19 of U.S. Patent No. 10,900,626 (the “’626 Patent”). The Board should deny the Petition for multiple independent reasons, none of which can be cured by Petitioner.

First, Petitioner mistakenly argues that the asserted prior art “was not applied by the Examiner” and, accordingly, “the Petition should not be denied on the basis of 35 U.S.C. § 325(d).” Pet. at 17. Yet, this is not the standard followed by the Board. Three of the four asserted references were presented—and considered—during prosecution. The Office determined they these references did not render obvious the invention disclosed by the ’626 Patent. The only remaining reference, Magnalight, is cumulative of Swivelpole—previously considered by the Office—as evidenced by Petitioner’s reliance on substantively identical disclosures in both references as disclosing identical limitations. Despite its apparent awareness of these facts, Petitioner did not even attempt to address the second part of the *Advanced Bionics* framework and explain how the Office erred in a manner material to the patentability of the challenged claims. Accordingly, the Board should deny institution under 35 U.S.C. § 325(d).

Second, the Board should discretionarily deny institution in view of the parallel, district court proceeding. The Board's decision on institution will occur after claim construction in the district court proceeding; fact discovery will be over, and the expert discovery will be nearing its end. Petitioner asserts substantially the same prior art, and challenges the same claims, as in the district court. Yet, despite being aware of all the asserted references at the time the second amended complaint was filed, Petitioner delayed filing the petition until 6 months after the the '626 Patent was added to the district court action. The Final Written Decision would be due ***after*** the district court trial. Thus, if the Board were to institute review, all would be for naught; there will have been a resolution of the issues by a jury before the Board's FWD, and judicial resources would go to waste. What is more, Petitioner's "stipulation" on estoppel in the district court lacks the clarity of an unambiguous Sotera stipulation, leaving the specific contours of the estoppel undefined.

Third, Petitioner does not provide any supportable, non-hindsight-based motivation to combine the asserted prior art with a reasonable expectation of success. Instead, Petitioner cites entire paragraphs from the declaration of its ***own*** Vice President of Engineering, Jake Hamdan. Yet, the vast majority of the substantive portion of his declaration consists of ***verbatim*** recitals of the Petition with neither factual nor evidentiary support for the opinions expressed. More so, it wholly ignores the overwhelming evidence of the commercial success of Patent

Owner's products and Petitioner's copying giving rise to the district court dispute in the first place.

Fourth, Petitioner fails to show how any of the references teach the (i) “crown deck” and (ii) “mounting pole” limitations of claims 1 and 19. This substantive deficiency—which permeates every element of the challenged claims—cannot be remedied.

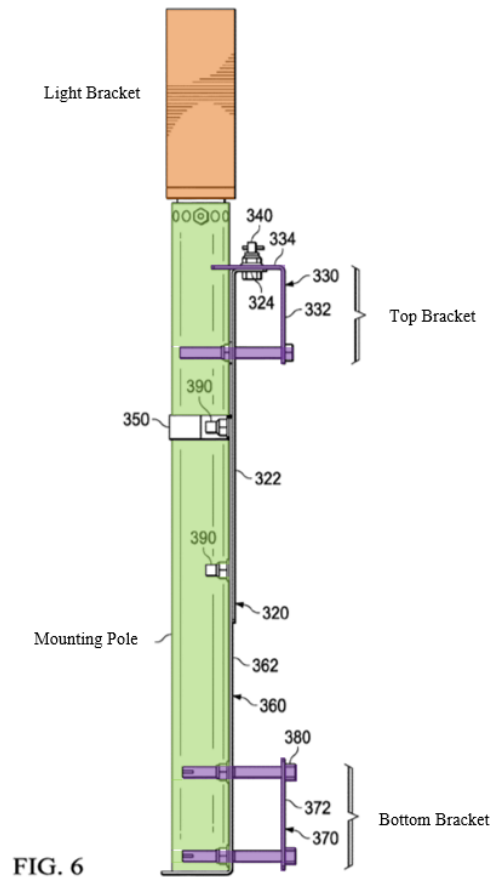
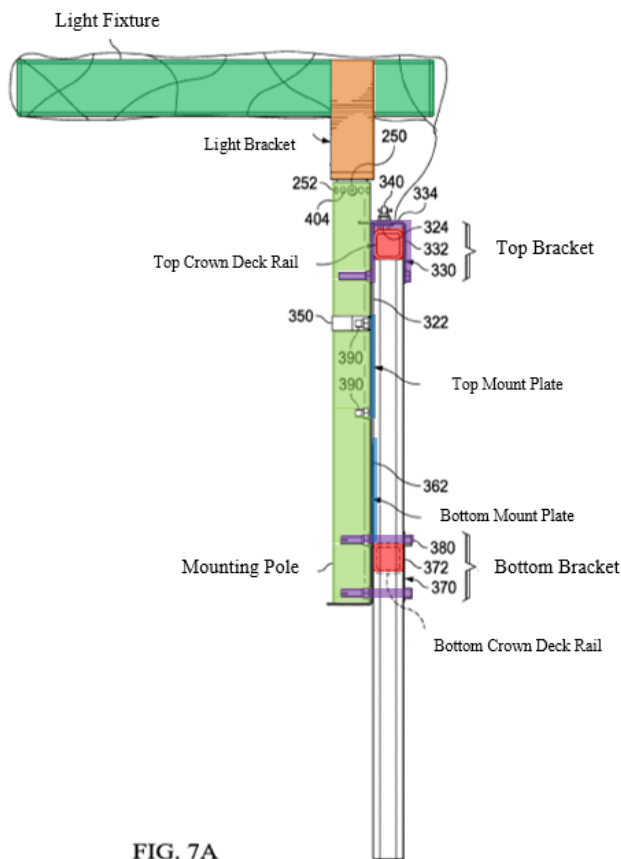
Accordingly, the Board should not institute review.

II. OVERVIEW OF THE '626 PATENT

The '626 Patent generally relates to an elevated structure-mounted lighting system used on drilling rigs and for other industrial applications that may use tower/mast type equipment. Ex. 1001 at Abstract. Generally, lighting systems for drilling rigs and their surrounding areas are “critical to ensure continuous and safe operation of well sites.” *Id.* at 1:12-14. According to the '626 Patent, prior art lighting systems are “single structural unit[s, that are] heavy and typically require cranes along with multiple workers for installation, removal, and adjustments.” *Id.* at 1:26-28. Thus, “[a] typical rig lighting frame system may require between 6 and 12 hours for installation.” *Id.* at 1:29-30. These factors “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 '626 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 handrail on a crown and comprise a single mounting pole coupled with a light fixture having one or more lights. *See, e.g., id.* at 2:49-51, claim 9.

Figures 6 and 7A (below) provide an overview of one embodiment. *Id.* at 2:10-15, 3:1-4. Light fixture 248 (green) may be connected to light bracket 400 (orange). *Id.* at 4:23-40. 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 3:1-4, 3:49-52.



III. CLAIM CONSTRUCTION

Petitioner asserts that “no terms need to be expressly construed for purposes of this IPR because the plain and ordinary meaning applies.” Pet. 18-19. Yet Petitioner points out (for no clear reason) that the parties agreed to constructions for “crown deck,” “attached,” and “handrail” in the parallel district court proceeding.” *Id.* at 19. Patent Owner agrees for purposes of this proceeding that the agreed constructions for each of “crown deck,” “attached,” and “handrail” employed in the parallel proceeding should apply here too. *See id.*

Moreover, despite suggesting that the Board need not “construe ‘mounting pole.’” Petitioner goes on to reprise the parties’ dispute about the term as it was briefed in the district court. *Id.* at 20-21. But, in the end, the only distinction between Petitioner’s proposal now and the one that Patent Owner proposed (which the district court has since adopted) is the use of “elongated” and “far.” *Id.* at 21.

In the end, whether it is “plain and ordinary meaning,” Petitioner’s proposed construction in the district court, or Patent Owner’s proposed construction in the district court (which the court adopted), any distinction does not matter for purposes of this proceeding. Should there be any possibility that the distinction matters, Patent Owner addresses it on a ground-by-ground basis below.

IV. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER § 325(d).

The Board should deny institution because (1) the same or substantially the same art or arguments were previously presented to the PTO; and (2) Petitioner has not demonstrated that the PTO erred in a manner material to the challenged claims' patentability. 35 U.S.C. § 325(d); *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper 6 at 7-11 (PTAB Feb. 13, 2020) (precedential).

A. The Same or Substantially the Same Art and Arguments Were Previously Presented.

The first *Advanced Bionic* prong is satisfied because the Petition advances the "same or substantially the same art previously [] presented to the Office." *Id.* at 8. "Previously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent." *Id.* at 7-8.

Here, all of the Petition's Grounds rely on one of two primary references: **Gowanlock 1** or **Gowanlock 2**, as shown in the summary table below. These references are identical to or substantially the same as (and cumulative of) references considered during prosecution of the '626 Patent.

Gowanlock 1 (WO 2018/042348) is the PCT application corresponding to CA 3034206, which was considered during prosecution and is cited on the face of the '626 Patent. *See* Ex. 1001 (listing CA 3034206 as first "FOREIGN PATENT

DOCUMENT[]"); Ex. 1002 at 225-237 (providing CA 3034206 during prosecution of '626 Patent). Indeed, their disclosures are identical. *Compare* Ex. 1002 at 225-237 (CA 3034206), *with* Ex. 1003 (Gowanlock 1).

Similarly, **Gowanlock 2** (US 9,316,390) was considered during prosecution and is expressly cited on the face of the '626 Patent. Ex. 1001 (listing Gowanlock 2 as third "U.S. PATENT DOCUMENT[]"); Ex. 1002 at 240, 55, 43, 18.

No.	Ground
1	WO 2018/042348 ("Gowanlock 1") in view of Swivelpole catalog
2	US 9,316,390 ("Gowanlock 2") in view of Swivelpole catalog
3	WO 2018/042348 ("Gowanlock 1") or US 9,316,390 ("Gowanlock 2") in view of Larson Electronics Magnalight YouTube Video ("Magnalight")

Swivelpole was also previously presented to the Office during prosecution of the challenged claims, as shown here:

OTHER PUBLICATIONS
Swivelpole Brochure; Swivelpole Product Catalogue NEC V2-4. Printed Mar. 2014, pp. 5-9.

Ex. 1001 at p.1.

Nevertheless, Petitioner notes that "the examiner was only provided with pages 5-9 of the Swivelpole catalog and not provided with the other 23 pages." Pet.

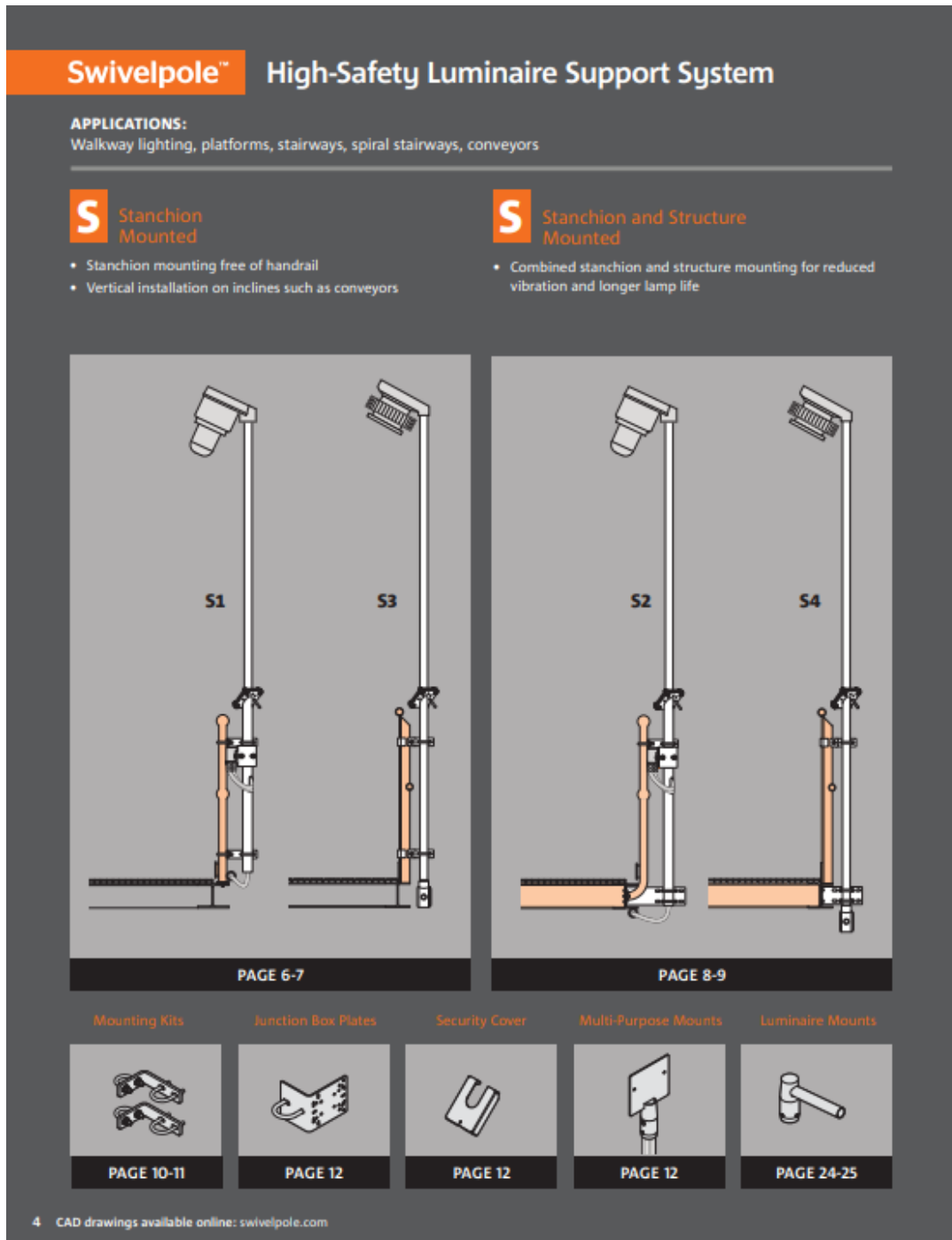
27. But this has no bearing on the *Advanced Bionic* analysis. Pages 5-9 are representative of the remaining pages, as they include detailed descriptions of the Swivelpole products, and there is nothing outside of these pages that provides teachings or disclosures that a POSITA would not have already gathered from pages 5-9.

Even if the full Swivelpole catalog on which Petitioner relies is not identical to the pages 5-9 presented to the Office during prosecution, it is certainly “**substantially the same** prior art.” For example, Petitioner references only the following, two figures from the Swivelpole Catalog as allegedly disclosing certain aspects of certain limitations (Pet. 61-62, 64-65, 68 (Ground 1); *id.* at 71-72, 74-75, 78 (Ground 2)):



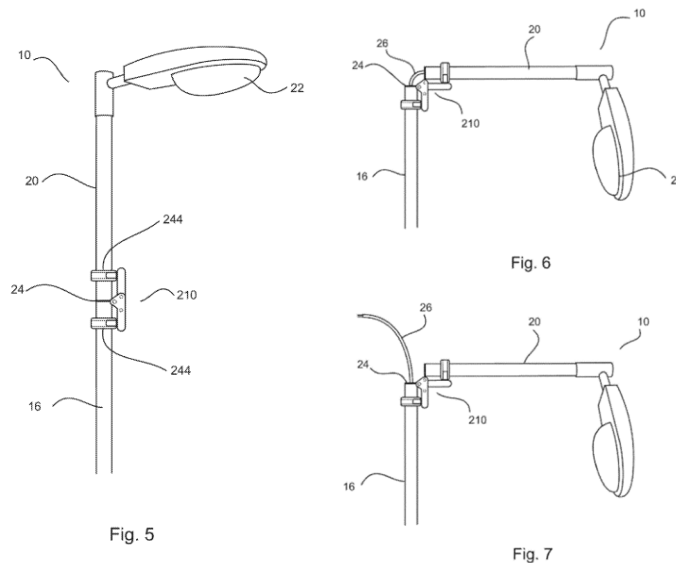
Ex. 1004 at 1, 15.

Swivelpole's pages 5-9 that were submitted during prosecution show at least the same disclosures as those on which Petitioner now relies; if anything, pages 5-9 provide *more* detail on the product. For example:



Ex. 1004 at 6.

In addition, the following patents were presented to the Office during prosecution—all of which were assigned to Swivelpole: US Patent Nos. 8,814,221; 9,534,626; 9,945,143; 10,392,826; and 10,598,359. *See* Ex. 1002 at 241-43. For example, US Patent No. 10,392,826 to Swivelpole discloses “substantially the same prior art or argument as that on which Petitioner relies from the Swivelpole Catalog in the petition, as shown by the exemplary figures below.



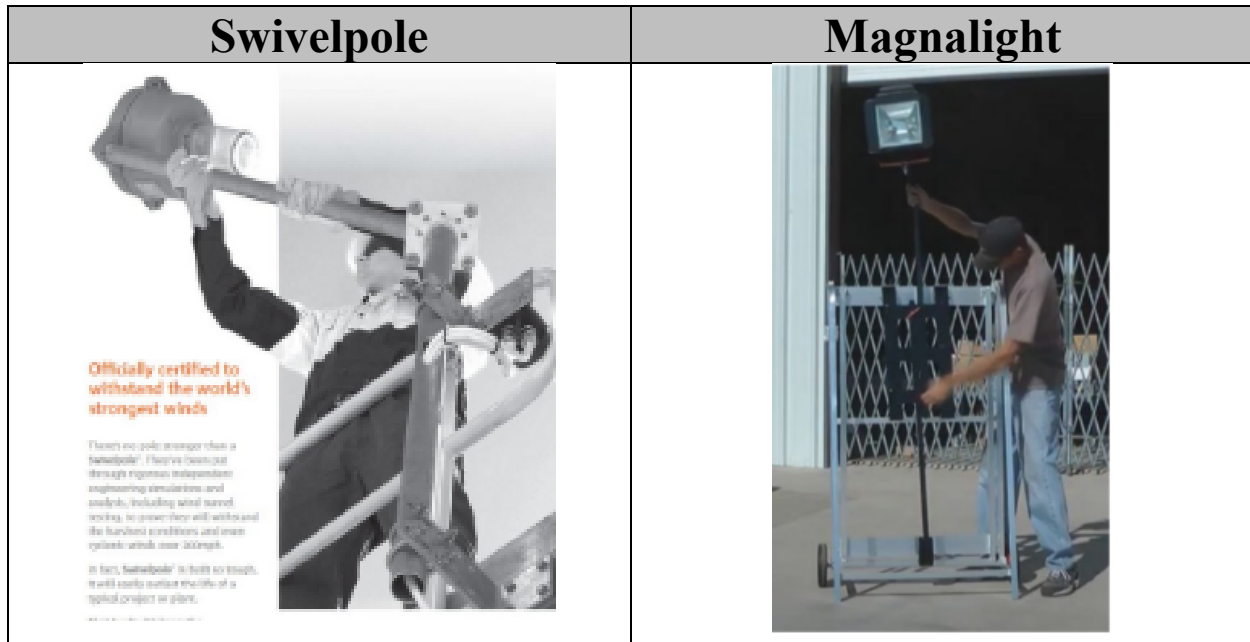
Ex. 2005, Figs. 5-7.

This all confirms that the Petition advances the “same or substantially the same art previously presented to the Office” in connection with the Swivelpole reference. *Advanced Bionics*, Paper 6 at 8.

The sole remaining reference—the **Magnalight YouTube Video** (Ex. 1006)—is cumulative of art and arguments previously presented to the Office.

Petitioner relies on Magnalight as allegedly disclosing only three limitations: **9.b** (Pet. 84-85), **19.b.** (Pet. 87-90), and **19.c.** (Pet. 90-91); *see* Pet. 93, 95. And Petitioner cites two images from the Magnalight video for each. Pet. 84-85. Likewise, Petitioner relies upon Swivelpole as disclosing the same three limitations: **9.b** (Pet. 61-63, 70-72), **19.b** (Pet. 64-65, 73-75), and **19.c** (Pet. 65-66, 75-76); *see* Pet. at 67-68, 77-79.

As shown below, even the figures that the Petition cites from each reference shows substantially the same disclosures. Petitioner does not rely on any disclosure from one that is not also present in the other. Thus, Magnalight “do[es] not provide any additional information relevant to the claim limitations at issue that was not already presented to, and considered by, the Office.” *Biocon Pharma Ltd. v. Novartis Pharms. Corp.*, IPR2020-01263, Paper No. 12 at 10-11 (PTAB Feb. 16, 2021).



Tellingly, Petitioner failed to provide *any* analysis of why its art was not cumulative—which “is, by itself, fatal under [*Advanced Bionics*] part one.” *Parse Biosciences, Inc. v. 10X Genomics, Inc.*, IPR2023-01033, Paper 8 at 14 (PTAB Dec. 19, 2023).

Nevertheless, Petitioner contends that, “[d]uring prosecution of the ‘626 Patent the other available prior art such as that described in the instant Petition was not applied by the Examiner.” Pet. 17. If by “not applied by the Examiner” Petitioner means the Examiner did not issue a *rejection* of the then-pending claims based on Gowanlock 1, Gowanlock 2, or Swivelpole, then Petitioner misses the mark. Cited but “unapplied” references during prosecution are still “previously presented” to the Office. *See, e.g., Vital Connect, Inc. v. Bardy Diagnostics, Inc.*, IPR2023-00381, Paper at 7 at 14 (PTAB July 11, 2023) (“There can be no dispute that Oster was

before the Office. Oster was listed in an [IDS] and appears on the face of the '743 patent.”); *Eyenovia, Inc. v. Sydnexis*, IPR2022-00963, Paper 7 at 10-11 (PTAB Nov. 8, 2022) (IDS references were “‘previously presented’ for purposes of” § 325(d)); *Biocon Pharma Ltd. v. Novartis Pharm. Corp.*, IPR2020-01263, Paper 12, 9 (PTAB Feb. 16, 2021) (cited but unapplied references supported denying institution); *Clim-A-Tech Ind., Inc. v. William A. Ebert*, IPR2017-01863, Paper 13, at 18-19 (PTAB Feb. 12, 2018) (denying institution even though the “Examiner did not base a rejection” on the reference in the petition).

B. Petitioner fails to identify any material error by the Office.

Petitioner fails to argue any material error by the Office in its perfunctory § 325(d) analysis. Because this lack of analysis is insufficient to meet the second part of the *Advanced Bionic* test, denial under § 325(d) is appropriate. *Advanced Bionics* at 8-9 (“If a condition in the first part of the framework is satisfied and Petitioner fails to make a showing of material error, the [Board] generally will exercise discretion not to institute *inter partes* review”); see *Microsoft Corp. v. AlmondNet, Inc.*, IPR2022-01319, Paper 9 at 11 (PTAB Jan. 30, 2023) (denying institution under § 325(d) where Petitioner did not sufficiently address whether the Office materially erred).

Because the first part of the *Advanced Bionics* framework is satisfied, and because Petitioner failed to make a showing of material error for the second part, the

Board should exercise discretion not to institute review. *See Advanced Bionics*, IPR2019-01469, Paper 6 at 8-9; *Albany Int'l Corp. v. Kimberly-Clark Worldwide, Inc.*, PGR2021-00019, Paper 22, 10-11 (PTAB June 22, 2021).

V. THE BOARD SHOULD EXERCISE ITS DISCRETION AND DENY INSTITUTION UNDER § 314(a).

The six factors considered for discretionary denial under 35 U.S.C. § 314(a) warrant denying institution here.¹ *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (“*Fintiv*”).

A. Factor 1: The district court has already denied Petitioner's motion to stay.

The first factor weighs heavily in favor of denying institution because the district court in the parallel proceeding **has already denied** Petitioner's motion to stay pending IPR. Ex. 2001 at 13-16. And, in that order, the court gave no indication

¹ Because Petitioner addressed the *Fintiv* factors in the Petition, it should not be afforded an opportunity to file a reply to address what was a reasonably foreseeable. Pet. at 97-100; *Victoria's Secret Stores LLC v. Andra Grp., LP*, IPR2020-00853, Paper 11 at 3 (Aug. 13, 2020) (“When determining whether a petitioner has shown good cause for a reply to a preliminary response, the Board may assess whether the argument at issue in the preliminary response was reasonably foreseeable.”) (citation omitted).

that it would reconsider if IPR is instituted. *See Apple Inc., v. Pinn, Inc.*, PGR2020-00066, Paper 16 at 10 (PTAB Dec. 8, 2020) (“[W]hen a district court has denied a motion to stay and has not indicated it would reconsider if a [IPR] is instituted, the facts underlying this factor weigh in favor of denying institution.”) (citation omitted).

B. Factor 2: Trial is scheduled to begin before the Final Written Decision.

This factor heavily favors denying institution because the district court “trial date is earlier than the projected statutory deadline.” *Fintiv*, IPR2020-00019, Paper 11 at 9. Specifically, trial is scheduled to begin on January 21, 2025—which is *over two months before* the Final Written Decision (April 5, 2025) would be due in this proceeding. *See* Ex. 2007 at 4. And the Board has routinely found this factor to weigh in favor of denial when the anticipated trial date preceded the Final Written Decision by a similar (or even shorter) amount of time. *See e.g., Stanley Black & Decker, Inc., et al. v. Zircon Corp.*, IPR2020-01572, Paper 10 at 12 (PTAB April 19, 2021) (three months); *Next Caller, Inc. v. TrustID, Inc.*, IPR2019-00961, Paper 10 at 14-15 (PTAB Oct. 16, 2019) (three months); *E-One, Inc. v. Oshkosh Corp.*, IPR2019-00161, Paper 16 at 6 (PTAB May 15, 2019) (one month).

Citing *In re Apple*, 979 F.3d 1332 (Fed. Cir. 2020), and *DISH Network L.L.C. v. Broadband iTV, Inc.*, IPR2020-01280, Paper 17 (PTAB Feb. 4, 2021), Petitioner

asserts that the Board should not rely on the scheduled trial date because “[t]rial dates...are unreliable and should not be used to deny institution.” Pet. at 98.

But *Apple* involved a motion to transfer from one district court to another; it did not address the *Fintiv* factors, or even a decision by the Board. 979 F.3d at 1336. *DISH Network* involved the then-pertinent issue of the COVID pandemic that was likely to result in delay of the trial date. IPR2020-01280, Paper 17 at 13-18. And *Sand Revolution*—which Petitioner cites for the proposition that “[t]he Board has repeatedly been persuaded by the uncertainty in litigation timeliness regardless the set trial date, especially within a few months of the expected FWD” (Pet. 98)—concerned the district court having previously extended multiple deadlines and including the “or as available” qualifier for the scheduled trial dates. *Sand Revolution II, LLC v. Cont’l Intermodal Grp. -Trucking LLC*, IPR2019-01393, Paper 24 at 8-9 (PTAB June 16, 2020).

Even if there were some potential unreliability in the scheduled trial date (which Petitioner has not shown), the Board may evaluate “evidence regarding the most recent statistics on median time-to-trial for civil actions in the district court in which the parallel litigation resides.” See Katherine K. Vidal, *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court*

Litigation (June 21, 2022)² (“Vidal Memo”) at 8-9. Here, the median time-to-trial in the Southern District of Texas is 30.7 months³, yielding an expected trial date of September 24, 2024—*more than six months* before the Final Written Decision would be due.

C. Factor 3: The parties have invested significant time and money in the parallel proceeding.

This factor weighs strongly in favor of denial because the parties have already committed substantial resources to the parallel proceeding. *See, e.g., Supercell OY v. Gree, Inc.*, PGR2020-00039, Paper 14 at 14 (PTAB Sept. 14, 2020) (“We understand that fact discovery closed on September 3, 2020, and expert discovery is schedule[ed] to close on October 2, 2020. [] These activities demonstrate that the district court and the parties have made some investments in the parallel proceeding, *which weighs in favor of denying institution.*”); *see also 10X Genomics, Inc. v. President & Fellows of Harvard Coll.*, IPR2020-01467, Paper 21 at 13 (PTAB Feb.

² Available at:

https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621.pdf.

³ Available at:

https://www.uscourts.gov/sites/default/files/data_tables/fcms_na_distprofile0331.2023.pdf.

22, 2021).

The district court litigation has been pending for almost 2 years, claim construction is over, the *Markman* order has been issued, and—by the time the institution decision will be rendered—fact discovery will be closed, and expert discovery will be closing a month thereafter. *See NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (“The district court proceeding, in which Petitioner asserts the same prior art and arguments, is nearing its final stages, with expert discovery ending on November 1, 2018.”). Indeed, in denying Petitioner’s motion to stay the parallel proceeding, the district court agreed with Patent Owner that the stage of the proceedings do not favor a stay. Ex. 2001 at 16.

In addition, Petitioner waited to file its Petition until October 5, 2023—approximately 6 months after the ’626 patent was asserted in the parallel proceeding—despite being in possession of all asserted references from the outset. Thus, “Petitioner did not file the petition expeditiously,” and this fact favors denial. *Fintiv*, Paper 11 at 11-12; *Samsung Elecs. Co., Ltd. v. Clear Imaging Rsch., LLC*, IPR2020-01402, Paper 12 at 18 (PTAB Mar. 4, 2021) (“If the petitioner, ‘faced with the prospect of a looming trial date, waits until the district court trial has progressed significantly before filing a petition, that decision may impose unfair costs to a patent owner.’”) (internal citations omitted).

D. Factor 4: The Petition challenges the same claims using substantially the same prior art that Petitioner asserts in the parallel proceeding.

The fourth factor weighs heavily in favor of denial because “the [p]etition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding.” *Fintiv*, Paper 11 at 12.

In the parallel proceeding, Petitioner challenges the same claims of the '626 Patent as in the Petition. *See* Ex. 2009, Suppl. Preliminary Invalidity Contentions. Indeed, for all asserted grounds, Petitioner fully charted the same primary references (Gowanlock 1 and 2) and one out of two of the same secondary references (Swivelpole). *Compare, e.g.*, Pet. at 11, *with* Ex. 2010, Suppl. Invalidity Chart.

Although Petitioner does not rely on Magnalight in the district court case, it serves as a mere, supplemental reference for Ground 3 here. Pet. at 11. And, as explained, the asserted teachings of Magnalight are cumulative of those in Swivelpole. *See supra* Section IV.A. Thus, with only one out of four references in the Petition being unique from those in the parallel proceeding, 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 23-24 (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[.]”).

Moreover, Petitioner has not clearly and unambiguously 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. Instead, Petitioner only stipulates as follows: “Petitioner stipulates that if the Board institutes the petition, **consistent with 35 U.S.C. § 315(e)(2)**, it will not seek resolution in the District Court on the same grounds asserted here in – Grounds 1-3 – or any grounds that could have reasonably been raised in the petition.” Pet. at 99. This differs from a *Sotera* stipulation in that, pursuant to 35 U.S.C. § 315(e)(2), it would not become effective until ***after*** the Board issues its Final Written Decision. As the trial is scheduled to occur before any possible final decision by this Board, Petitioner merely agrees to abide by an already-existing statute. Tellingly, Petitioner incorporates the “***consistent with 35 U.S.C. § 315(e)(2)***” condition, does not cite *Sotera* anywhere in Petition, and devotes four pages to a discussion of why the Petition should not be discretionary denied.

E. Factor 5: The parties are the same in both proceedings.

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.

F. Factor 6: The Petition is weak on the merits.

This factor “reflects that the PTAB considers the merits of a petitioner’s challenge when determining whether to institute a post-grant proceeding.” Vidal

Memo at 4. Only a compelling invalidity challenge is sufficient to outweigh the preceding *Fintiv* factors. *Id.* at 4-5. A “compelling challenge” can only be found when a Petition “would plainly lead to a conclusion that one or more claims are unpatentable.” *Id.* at 5 n.6 (citing *Illumina Inc. v. Trs. of Columbia Univ.*, IPR2020-00988, Paper 20 (PTAB Dec. 8, 2020)).

Given that Petitioner did not meet the reasonable likelihood of success standard for institution (as explained below), it certainly cannot meet the significantly higher standard for a compelling invalidity challenge. *Id.* at 4.

At a minimum, and as discussed in the following sections, the Petition is insufficient to warrant a plain conclusion that one or more claims are unpatentable. *See Ericsson Inc. v. Godo Kaisha IP Bridge 1*, IPR2022-00725, Paper 10 at 28-29 (PTAB Nov. 2, 2022) (Factor 6 favored denial where “the evidence Petitioner advances for [the] position is not compelling” where the references did not teach one of the limitations). Accordingly, this factor warrants denying institution.

VI. PETITIONER’S EXPERT’S OPINION SHOULD BE AFFORDED LITTLE WEIGHT, IF ANY, AND DOES NOT CURE THE PETITION’S DEFICIENCIES.

In assessing the probative value of an expert opinion, the Board “consider[s] three factors: (1) the interest of the expert in the outcome of the case, (2) the presence or absence of factual support for the expert’s opinion, and (3) the strength of any opposing evidence.” *See EC Data Sys. Inc., v. J2 Global, Inc.* No. 2014-008203,

2014 WL 7171966 at *4 (PTAB Dec. 15, 2014) (*citing Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 294-295 (Fed. Cir. 1985)⁴).

Here, the Board should afford little to no weight to the opinions of Petitioner's expert, Jake Hamdan, because (1) he is Petitioner's Vice President of Engineering, (2) his opinion merely parrots the petition with conclusory testimony and fails to cite to any factual evidence showing a motivation to combine the asserted references with a reasonable expectation of success, and (3) there is strong evidence of secondary considerations contradicting Mr. Hamdan's opinions.

A. Mr. Hamdan has direct interest in the outcome of this proceeding.

Petitioner's expert Jake Hamdan is employed by Petitioner as its VP of Engineering. Ex. 1007 at 3. He is directly responsible for "develop[ing] plans and goals for improving existing equipment," "new product development," and "planning, execution and technical support of all designs and equipment." *Id.* As a result, he "has a substantial interest in the outcome of the case." *Ex Parte Magna Elecs., Inc.*, No. 2013-004164, 2014 WL 2360424 at *3 (PTAB May 28, 2014) (an expert who "was employed by Patent Owner when he provided the expert opinion ... has a substantial interest in the outcome of the case").

⁴ An additional factor for consideration is the "nature of the matter sought to be established," *Ashland Oil*, 776 F.2d at 294, which is obviousness here.

This, alone, renders Mr. Hamdan's opinion significantly less persuasive. *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); *see also EC Data Sys. Inc.*, 2014 WL 7171966, at *5 (PTAB Dec. 15, 2014) (“[The Expert] was employed by Patent Owner when he provided the expert opinion and therefore has a substantial interest in the outcome of the case.”).

B. Mr. Hamdan's opinions are conclusory and unsupported.

Mr. Hamdan's conclusory opinions should be afforded little weight because they are unsupported and lacking in explanation. *See 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”); *SEKI S.p.A. v. CM2W JSC*, PGR2020-00006, Paper 16 at 13-14 (PTAB May 4, 2020) (“Because Mr. Zatarian's conclusory testimony is not supported by the cited paragraphs, we do not find it persuasive.”); *Roxane Lab'ys., Inc. v. Novartis AG*, IPR2016-01461, Paper 9, 10 (PTAB Feb. 13, 2017) (“As the Board has stated repeatedly, conclusory expert testimony is entitled to little or no weight.”).

For example, in *Xerox*, Petitioner's only evidence in support of at least one, key argument was the opinion of its expert declarant. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15 (PTAB Aug. 24, 2022) (precedential). The Board reviewed the relevant excerpt from the declaration and “note[d] that it merely

repeats, *verbatim*, the conclusory assertions for which it is offered to support.” *Id.* The expert did “not cite to any additional supporting evidence or provide any technical reasoning to support his statement.” *Id.* As such, the Board determined that the proffered expert testimony was entitled to little weight because “the cited declaration testimony is conclusory and unsupported [and] adds little to the conclusory assertion for which it is offered to support.” *Id.* (collecting cases); *see also id.* at 16 (concluding the same for an additional argument).

Here, as in *Xerox*, the only “evidence” that Petitioner cites for certain of its key arguments is the unsupported, conclusory opinions from its expert. As just one example, Petitioner cites paragraph 101 of Mr. Hamdan’s declaration stating that “a POSITA would readily substitute the crown deck lighting in Gowanlock 1 or Gowanlock 2 with the lights, mounting poles, and brackets shown in Larson Electronics / Magnalight YouTube video to separately attach a plurality of light units to a handrail, e.g., guard rail, around the crown deck [of a rig].” Pet. at 57. However, Mr. Hamdan does not provide any reasoning for why a POSITA would “readily make” such a substitution despite the fact that nothing in the video, or the accompanying description, mentions its suitability for oil rigs and the disclosed lighting system is flimsy, visibly shaking at the application of slightest pressure. Ex. 1008 at ¶¶ 101-103.

This shows one of two things: either Petitioner repeated verbatim the unsupported, conclusory statements offered by Mr. Hamdan in his declaration, or Mr. Hamdan merely repeated the argument from the Petition without any additional analysis. Regardless, Mr. Hamdan's declaration that lacks technical reasoning and analysis provides no additional probative value. *See, e.g., 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); *Kinetic Techs., Inc. v. Skyworks Sols., Inc.*, IPR2014-00529, Paper 8 at 15 (PTAB Sept. 23, 2014) ("Merely repeating an argument from the Petition in the declaration of a proposed expert does not give that argument enhanced probative value.").

The Board's decision in *NVIDIA Corp. v. Advanced Cluster Sys., Inc.*, IPR2021-00020, Paper 9 (PTAB May 5, 2021), also provides guidance. There, the Board rejected Petitioner's argument that a specific figure in a reference disclosed the required limitation where the petition's "analysis" consisted of a "block quotation" that was "repeated in the Petition verbatim from [the expert's] Declaration." *Id.* at 26-27. The expert did not "provide a citation to any portion of [the reference] to support his testimony." *Id.* at 27. Thus, "[b]ecause this testimony is conclusory and not supported by objective evidence, it is entitled to little or no

weight.” *Id.* (collecting cases); *see also id.* at 28-29 (explaining the same for another argument).

Here, as in *NVIDIA*, Petitioner’s “analysis” for the alleged motivations to combine the prior art consist of mere block quotations repeated in the Petition verbatim from Mr. Hamdan’s declaration. *See* Pet. at 36-43 (excerpting as block quotes verbatim paragraphs 81-87 from expert declaration for motivation to combine Gowanlock 1 and Swivelpole references), 43-51 (same for paragraphs 89-96 from expert declaration for Gowanlock 2 and Swivelpole), 51-60 (same for paragraphs 98-106 for Gowanlock 1 or 2 and Magnalight YouTube video), 66-69 (excerpting verbatim the “summary chart” from expert declaration for Gowanlock 1 and Swivelpole’s alleged disclosures), 77-80 (same for “summary chart” from expert declaration for Gowanlock 2 and Swivelpole’s alleged disclosures), 91-96 (same for “summary chart” from expert declaration for Gowanlock 1 or Gowanlock 2 and Magnalight YouTube video’s alleged disclosures).

Although Mr. Haman purports to provide citations to the references in the material that the Petition excerpts verbatim, those citations objectively do not support his opinions. For example, Mr. Hamdan cites Figure 1A of Gowanlock 1 as allegedly disclosing a “crown deck.” Ex. 1008 at ¶ 70. But it is undisputed that “crown deck” means “a collection of structures within the crown that includes a *walking surface, parts supporting the walking surface, and any associated*

handrail.” Pet. at 19. The argument that Figure 1A of Gowanlock 1 discloses a “crown deck” is objectively baseless because nothing in the figure, or the accompanying patent, discloses a walking surface, any parts supporting it, or even a handrail. *See, e.g.*, Ex. 1003. Tellingly, Mr. Hamdan does not provide any further support for this proposition. *See, e.g.*, Ex. 1008 ¶¶ 67-71. Thus, “[b]ecause this testimony is conclusory and not supported by objective evidence, it is entitled to little or no weight.” *NVIDIA Corp.*, IPR2021-00020, Paper 9 at 27.

C. There is strong opposing evidence.

The strength of the opposing evidence discussed below in Section VII also undermines the probative value of Mr. Hamdan's opinions. *Rockwell Automation, Inc. v. Automation Middleware Sols., Inc.*, IPR2017-00469, Paper 10 at 18-19 (PTAB July 18, 2017) (giving expert testimony little weight when “the evidence of record introduced by Patent Owner contradict[ed] Petitioner's [and its expert's] identification of [the invention] as a primitive operation.”).

VII. PETITIONER FAILS TO DEMONSTRATE A REASONABLE LIKELIHOOD OF SUCCESS

Petitioner has not met its burden of showing a reasonable likelihood that it would prevail in its challenge to either claim 9 or 19 because the Petition does not show that the prior art teaches or discloses each limitation of the claims. Moreover, the Petition does not establish any supported reason to combine and/or modify the prior art as Petitioner suggests. Nor does Petitioner show that a POSITA would have

a reasonable expectation of success that the proposed combination and/or modification of the prior art would have operated for its intended purposes. As such, the Petition should be denied.

A. Ground 1: The Petition Fails to Establish that the Challenged Claims are Obvious over Gowanlock 1 in View of Swivelpole.

Ground 1 fails for three independent reasons.

First, neither reference discloses a “crown deck” with its “handrail” as each challenged claim requires.

Second, neither reference discloses the “mounting pole” limitations of claims 9 and 19.

Third, Petitioner fails to establish that a POSITA would have been motivated to combine Gowanlock 1 and Swivelpole.

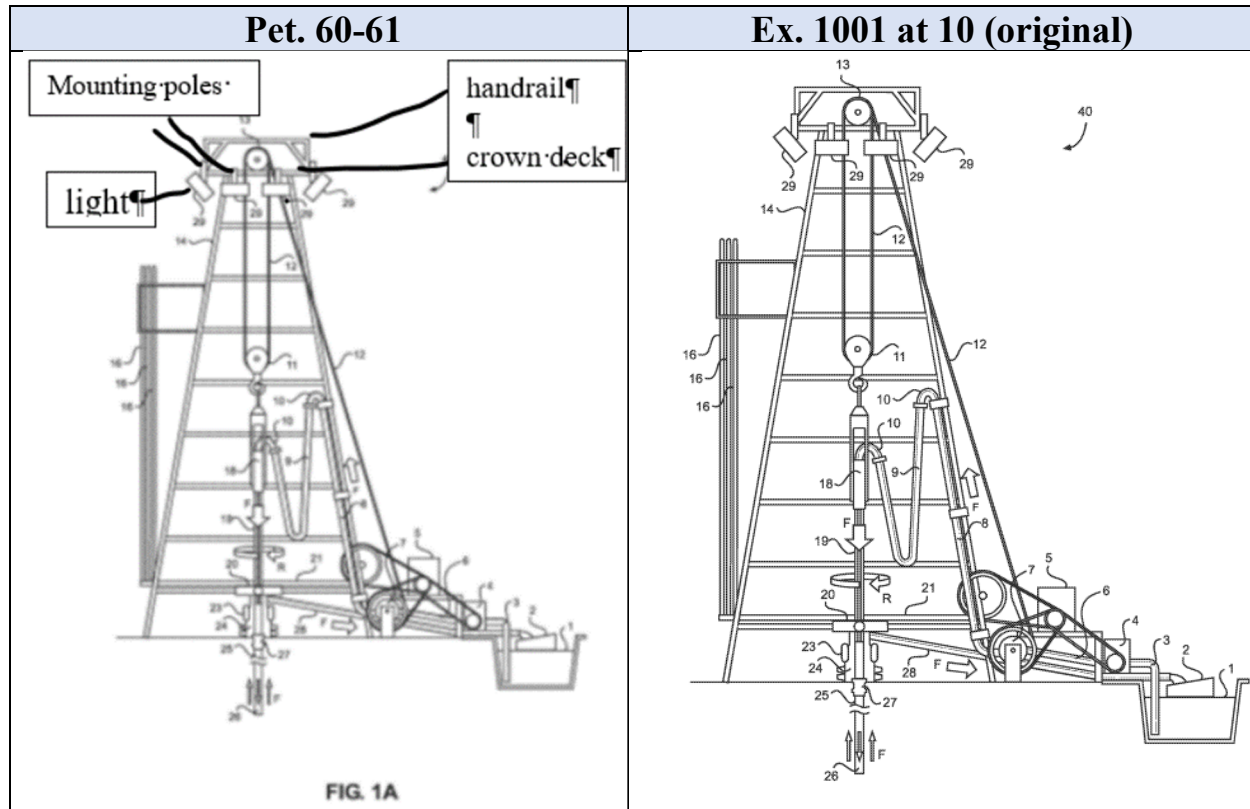
Fourth, Petitioner does not provide a reasoned explanation how a POSITA would have had a reasonable expectation of success in combining these references.

1. Ground 1 does not disclose a “crown deck” with “handrail.”

Claim 9 recites a rig comprising, *inter alia*, “**a crown deck at the top of the derrick, the crown deck comprising a handrail**” and “a plurality of light units attached to **the handrail**.” Claim 19 similarly requires the step of “mounting a plurality of mounting poles on **a crown deck of a rig**, wherein each of the plurality of mounting poles is attached to **a handrail of the crown deck**.”

For these “crown deck” limitations, Petitioner alleges that “Gowanlock 1 discloses a derrick with a crown deck at the top which has a handrail.” Pet. at 60. In support, Petitioner purports to identify a “crown deck” in Figure 1A on page 10 of Gowanlock 1. *Id.* But this is wrong for multiple reasons:

Petitioner's annotated Figure 1A (bottom left) misrepresents Gowanlock 1's teachings. *Compare* Pet. 60-61 *and* Ex. 1008 at ¶ 70, *with* Ex. 1001 at 10 (Figure 1A in Gowanlock 1). Critically, nowhere does Gowanlock 1 describe the items to which Petitioner points as a “crown deck” or “handrail.” Indeed, the terms “crown deck” and “handrail” appear nowhere in Gowanlock 1. *See, e.g.*, Ex. 1003.



Rather, Figure 1A (above) shows “a lighting system mounted on a drilling rig.” Ex. 1003 at [0012]. Likewise, it describes that “the light fixture is connected to the crown directly through the light fixture attachment (103 and 202),” i.e., it describes the crown or top of the rig, but makes no mention of a *crown deck* or in fact any walking surface, parts supporting a walking surface, and any associated handrail at the crown. Ex. 1003 at [0019]. Although Gowanlock discusses a “crown block 13” in connection with Figure 1A, *id.*, a “crown block” is understood in the art to refer to an “assembly of sheaves mounted on beams at the top of the derrick and over which the drilling line is reeved.” Ex. 2011; *see also* Ex. 2012; Ex. 2013. Both a “crown” and a “crown block” are meaningfully different from a “crown

deck,” which is construed as a “collection of structures within the crown that includes a walking surface, parts supporting the walking surface, and any associated handrail.” *See* Pet. 19. Nothing in Gowanlock 1 discloses a “crown deck.”

Nevertheless, Petitioner cites the summary chart contained in Mr. Hamdan's declaration in purported support. Pet. at 66. However, that chart is the exact same as the chart reproduced in the Petition and contains the same conclusory, unsupported conclusion without more. *Compare* Pet. at 66 with Ex. 1008 at ¶ 80.

Petitioner does not (and cannot) rely on Swivelpole as disclosing a “crown deck” with its “handrail” as required by both claims 9 and 19. *See* Pet. 64-67. Instead, Petitioner merely alleges that “[t]he Swivelpole catalog describes and shows attaching a mounting pole for a light to a handrail and attaching a light to it.” *Id.* at 64. And “a handrail” generally is not a “crown deck comprising a handrail” (claim 9) or “a handrail of the crown deck” (claim 19).

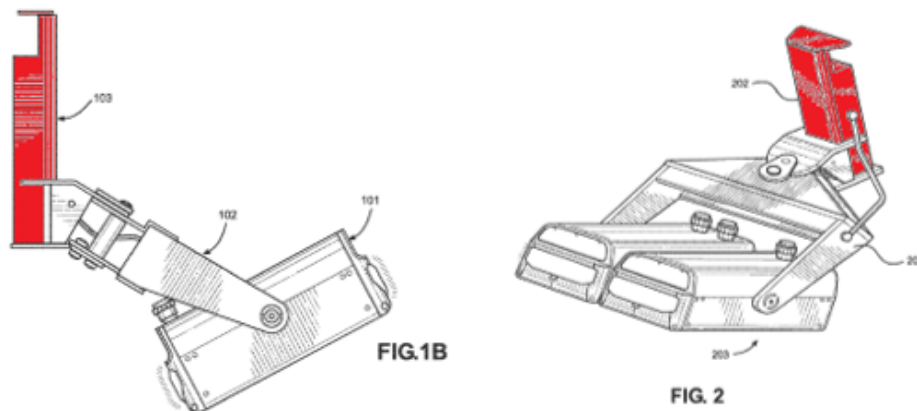
Therefore, the Petition fails to show that Gowanlock 1 or Swivelpole discloses a “crown deck comprising a handrail,” and for this reason alone, institution must be denied.

2. *Ground 1 does not disclose the “mounting pole” limitations.*

Neither Gowanlock 1 nor Swivelpole disclose the limitation of claims 9 and 19 requiring a “mounting pole.”

First, Petitioner asserts that Gowanlock 1 discloses “a plurality of light units with each light unit separately attached to a crown deck of the rig with a mounting pole for illuminating a wellsite.” Pet. at 61. Petitioner cites Figures 1A, 1B, and 2 in support. *Id.* Yet Petitioner never explains how or why a POSITA would understand Gowanlock 1’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 1’s “light fixture attachment” (red) is a short, singular component with a rectangular indentation at one end that hangs off the rig. Gowanlock 1 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].



Petitioner never explains how or why Gowanlock 1’s “light fixture attachment” constitutes “a pole used for mounting something,” according to each

word's plain and ordinary meaning. Pet. at 18-19 (advocating for plain and ordinary meaning). Or if the Board construes "mounting pole" as an "elongated structure fixed at one end and for mounting where the length of the structure far exceeds the width," Gowanlock 1's "light fixture attachment" does not meet that construction either because there is nothing to suggest that the length of the structure far exceeds its width.

Still, Petitioner asserts that "Gowanlock 1 discloses a short mounting pole and that each light unit comprises a separate short mounting pole such that the system comprises a plurality of mounting poles each of which mounting poles it describes as a 'light fixture attachment (103 and 202) in paragraph [0019]." Pet. at 23. Petitioner's only support for this conclusion is a citation to Mr. Hamdan's declaration. *Id.* But there, Mr. Hamdan merely repeats the Petitioner's "summary chart" for the "mounting pole" limitation, offering no analysis or evidence beyond the following statement: "FIG. 1A of Gowanlock 1 shows a modular lighting system with each light unit independently attached to a crown deck with a mounting pole." *Compare* Pet. at 66-67 *with* Ex. 1008 at 53-55. As such, Mr. Hamdan's opinion should be given no weight. *Xerox*, Paper 9 at 15.

Second, Petitioner is incorrect to content that "[t]he Swivelpole catalog describes and shows attaching a mounting pole for a light to a handrail and attaching a light to it." Pet. 61. In support, Petitioner cites only the following two figures

from Swivelpole without any supporting explanation or analysis from it or its expert.

See id. at 62.



Petitioner appears to suggest that pointing to any purportedly pole-like structure in the prior art would suffice. But it is the specific “mounting pole” of the claims that must be disclosed. Here, neither Petitioner nor its expert make any effort to identify in Swivelpole “a mounting pole, wherein each light unit comprises a separate mounting pole, such that the system comprises a plurality of mounting poles,” as claim 9 requires. And the same analysis is lacking for the particular “mounting pole” of claim 19.

Third, Gowanlock does not disclose a “mounting pole” regardless of whether the Board adopts the SDTX district court’s construction in the parallel proceeding,

Petitioner's construction in the district court proceeding, or plain and ordinary meaning without more. This is because "light fixture attachment (103 and 202)" is not a pole used for mounting something, and its length does not far exceed its width.

Fourth, Petitioner contends for the "mounting pole" limitations that "[i]t would be obvious to attach a plurality of mounting poles with lights to the handrail of the crown deck as shown in the Swivelpole catalog instead of Gowanlock 1's pole mounted lights near the internal floor of the crown." Pet. 62-63 (referencing Section VIA of Petition). This conclusory statement (which lacks any evidentiary support or further explanation) is wrong for numerous reasons.⁵ But chief amongst them is the incorrect premise that Swivelpole discloses "attach[ing] a plurality of mounting

⁵ Other problems include that (1) Swivelpole does not disclose the specific "mounting pole" limitations as discussed *supra* at Section VII(A)(1); (2) Gowanlock does not disclose "pole mounting lights near the internal floor of the crown" but instead discloses a "light fixture attachment," which does not meet the limitations as discussed *supra* at Section VII(A)(2); and (3) a POSITA would not be motivated to swap Gowanlock's "light fixture attachment" for any pole-like structure from Swivelpole in a manner that results in the claimed invention, let alone with a reasonable expectation of success for the reasons discussed *infra* at Section VII(A)(3).

poles with lights to the **handrail of the crown deck**,” as Petitioner does not rely on Swivelpole as allegedly disclosing the crown deck when the term is introduced in the claim. *See* Pet. 60-61 (relying on only Gowanlock 1 as allegedly disclosing this limitation). And Swivelpole does not in any way describe or show “a collection of structures *within the crown* that includes a *walking surface, parts supporting the walking surface, and any associated handrail*,” and, therefore, cannot disclose a “crown deck.” Nor does Petitioner attempt to explain with any objective evidence that Swivelpole discloses a *crown deck*.

As a result, Petitioner is wrong that “[i]t would be obvious to attach a plurality of mounting poles with lights to the handrail of *the crown deck as shown in the Swivelpole* catalog instead of Gowanlock 1’s pole mounted lights near the internal floor of the crown.” *See* Pet. 62-63

Because Petitioner failed not meet its burden to show that either reference in Ground 1 discloses a “mounting pole” as claimed by the ’626 Patent, the Board should deny institution.

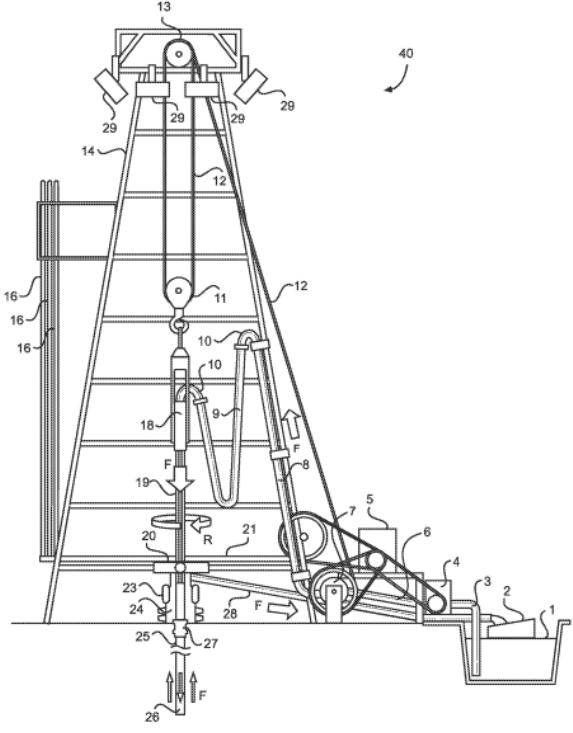
3. *There is no motivation to combine these references.*

There are several independent reasons why a POSITA would not have been motivated to combine the references with a reasonable expectation of success.

First, *neither reference teaches a “crown deck,” as claimed*. Petitioner argues that “[a] POSITA would readily know to employ the mounting poles associated with

lights which are shown attached to a handrail in the Swivelpole catalog and attach the mounting poles with associated lights on the handrail instead of the side of Gowanlock 1's floor of the crown deck." Pet. at 36-37; Ex. 1008, ¶ 81.

But this statement does not explain **how** Gowanlock 1 could be combined with Swivelpole. Indeed, Gowanlock 1 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. Unlike Gowanlock 1's bracket (103 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 1	Swivelpole (Ex. 1004 at 3)
	

Moreover, Gowanlock 1 does not disclose a “crown deck” for the reasons discussed in Section VII.A.1. Accordingly, there are no “handrails” of a crown deck to which the Swivelpole could attach. Neither Petitioner nor its expert explain how these distinct structures could be physically combined, modified for combination, or how any specific combination would operate.

Nor does Petitioner address how a POSITA would have a reasonable expectation of success in doing so. As discussed previously, attaching Swivelpole’s long and slender swiveling pole to a crown with no handrails or walking decks is (1)

not “simple” and (2) does it involve a “simple substitution of one known element.”

Pet. 35. The swivel mechanism risks the proposed system’s structural stability by introducing an additional—and unnecessary—point of failure. It is incompatible with Gowanlock 1 absent substantial redesign to ensure its safety. Moreover, Swivelpole is plainly not compatible with the goal of illuminating a well site 100 feet below the crown deck because its sole purpose is to provide light for a walkway immediately beneath. Ex. 1004 at 6. Petitioner leaves unaddressed these significant concerns of structural integrity, safety, and even the capability of achieving the desired purpose, which is precisely why a POSITA would not be motivated to combine the references to arrive at the claimed invention with a reasonable expectation of success..

More so, neither reference discloses a “crown deck” and its handrail. For this reason alone, there can be no motivation to combine. If somehow combined, a POSITA would either use the Swivelpole on a general walkway or stairway around the wellsite as disclosed therein, or the Swivelpole would somehow be used with Gowanlock 1’s system at the **crown**, but not Swivelpole attached to a crown deck, as neither reference even teaches a **crown deck**.

Next, Petitioner argues “a POSITA would combine the references for the obvious and predictable result of placing or improving modular lighting on a railing associated with a crown deck of a rig,” specifically suggesting “a POSITA would

readily attach the lights and associated mounting poles shown in Swivelpole to an associated handrail of a crown deck as shown in Gowanlock 1 because the Swivelpole pole, which swivels from a point on the pole, would make the lights more accessible and easier to adjust.” Pet. 39; Ex. 1008 ¶ 82.

To reach this conclusion, Petitioner clearly started with claims and worked backwards, the very definition of impermissible hindsight reasoning, as the references do not disclose a “crown deck” or its associated handrail. *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.”).

This is not a “simple combination of known elements to obtain predictable results.” Petitioner contends it would be “a simple combination of known elements to obtain predictable results” to “separately attached pole mounted lights attached to an associated handrail of a crown deck.” Pet. at 40; Ex. 1008, ¶ 83. Yet, Petitioner never identifies the allegedly “known elements” that would be combined or why it would be a “simple combination.” Indeed, such a combination is anything but “simple.”

For the reasons explained above, combining the two references would not

only go against their teachings but would also introduce numerous issues that Petitioner never addressed. Such a combination would require extensive redesign and testing to ensure that Swivelpole is capable of illuminating the wellsite 100+ of feet away and can do so safely—something it was never designed to do.

“Obvious and predictable result.” Petitioner also argues that “a POSITA would combine the references for the obvious and predictable result of placing or improving modular lighting on a railing associated with a crown deck of a rig.” Pet. at 39; Ex. 1008, ¶ 81. And, according to Petitioner, a POSITA would be motivated to combine the references based on “the use on known techniques (attaching poles with lights to an associated handrail of a crown deck) to improve similar devices in the similar way.” *Id.* at 41; Ex. 1008, ¶ 83. But this is circular reasoning. According to Petitioner, the invention is predictable because it is arranged as in the claims (i.e., by “placing ... [a] modular lighting on a railing associated with a crown deck of a rig”) and is an improvement over itself, as there were no earlier crown deck crown deck lighting systems with such a design. Pet. at 39; Ex. 1008, ¶ 82. Similarly circular is the suggestion that a “known technique” was “attaching poles with lights to an associated handrail of a crown deck”—the very invention itself—despite the fact that none of the references disclose a “crown deck,” let alone a combination of the two. All the while, Petitioner never identifies what constitutes the “similar devices” for this alleged motivation or the “same way” it purports to exist. *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”).

Petitioner next contends that “the combination addresses the known problems (admitted in the Background of the ’626 patent) with certain types of rig lighting that were difficult to install and adjust.” Pet. 40-41; Ex. 1008 at ¶ 83. But suggesting a problem was known in the industry by pointing to the patent’s identification of the problem addressed by the invention is textbook hindsight reasoning. *See Orexo*, 903 F.3d at 1271 (“It is inappropriate to use the template provided by the inventor, to render the inventor’s contribution obvious.”); *KSR*, 550 U.S. at 421 (“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.”). Petitioner never points to this problem in the cited references, because it simply is not there. 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.

Petitioner also 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. at 42-43; Ex. 1008, ¶87. 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). 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.

Petitioner further argues that “[t]here are only a finite number of ways and places to attach lights to a crown deck or a surrounding handrail.” Pet. 42. But (i) nobody had ever attached lights to a crown deck, and (ii) Petitioner never identifies the alleged “finite ways” to which it refers. The Swivelpole catalog—alone—identifies a non-exhaustive list of various ways a pole could be attach to a handrail, each designed with a specific purpose in mind. Ex. 1004 at 12-14. 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 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[.]”).

Petitioner also 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 envisaged by Gowanlock 1” Pet. 40. But Petitioner identifies no evidence, not even from its expert, to support this position. Indeed, as discussed previously, Swivelpole is not designed to be underslung from Gowanlock 1’s crown, and for the reasons explained herein would never be used extending upward from the crown using Gowanlock 1’s heavy lights to illuminate the ground at the wellsite. Worse, the “swivel” mechanism introduces structural instability to the pole. Regardless of whether the proposed combination contemplates Swivelpole’s lighting system attached to the bottom or the top of the rig, a POSITA would have recognized this mechanism to be inherently dangerous when the pole is exposed to conditions at the crown including high winds from different directions, swaying of the rig, and the wide variety of other factors common at the top of a crown deck. Petitioner does not address any of this in its Petition.

Next, Petitioner argues that Swivelpole “shows that its mounting poles may be readily attached to handrails.” Pet. 38. But saying “[t]hat a [POSITA] *could have done is not enough.*” *Matterport, Inc. v. Appliance Computing III, Inc.*, IPR2021-00939, Paper 15 at 21 (PTAB Nov. 23, 2021). And, even so, suggesting that Swivelpole “may be” attached to handrails generally does not mean a POSITA would be motivated to attach Swivelpole to the handrail of a **crown deck**. Indeed, neither Gowanlock 1 nor Swivelpole even discloses a crown deck with a handrail

for the reasons discussed *supra* in Section VII(A)(1).

B. Ground 2: The Petition Fails to Establish that the Challenged Claims are Obvious over Gowanlock 2 in view of Swivelpole.

Ground 2 fails for essentially the same reasons as Ground 1: (1) neither reference discloses a “crown deck” with its “handrail” as each challenged claim requires; (2) neither reference discloses the “mounting pole” limitations; (3) Petitioner fails to establish a motivation to combine or modify the references to arrive at the claimed invention; and (4) Petitioner fails to establish that a POSITA would have had a reasonable expectation of success in so combining or modifying the references.

1. Ground 2 does not disclose a “crown deck” or a “handrail.”

Petitioner cites Gowanlock 2's Figure 1 (below) as allegedly showing “a crown deck at the top of the derrick, the crown deck comprising a handrail.” Pet. 70; *see also* Ex. 1008 at ¶ 88. In doing so, Petitioner provides its own, unsupported annotations purporting to show a “handrail” and a “crown deck.” *Id.* But, again, nothing in Gowanlock 2 discusses a “crown deck” or otherwise identifies the portion of Figure 1 to which Petitioner points as showing a “crown deck.” And, critically, Petitioner fails to point to any evidence (there is none) that shows “a walking surface” as required by the construction of the term “crown deck.” *See* Pet. 19.

Instead, Figure 1 (below) discloses the “base 105 [which] provides an internal floor to the crown 100.” Ex. 1058 at 4:52-53. As can be seen from Gowanlock's

Figure 1 below, the base 105 of the crown is not a “crown deck,” as it fails to include “a collection of structures within the crown that includes a *walking surface, parts supporting the walking surface, and any associated* handrail,” per the parties’ agreed construction. . In fact, this area of the crown is not suitable for an operator to occupy as it is an incredibly dangerous area with cutouts and unprotected rotating crown blocks etc. In fact, Gowanlock 2 makes no mention of a crown deck or any walking surfaces, instead disclosing that the “frame” is attached “**to the crown**” (not a crown deck). Ex. 1058 at 2:20-24.

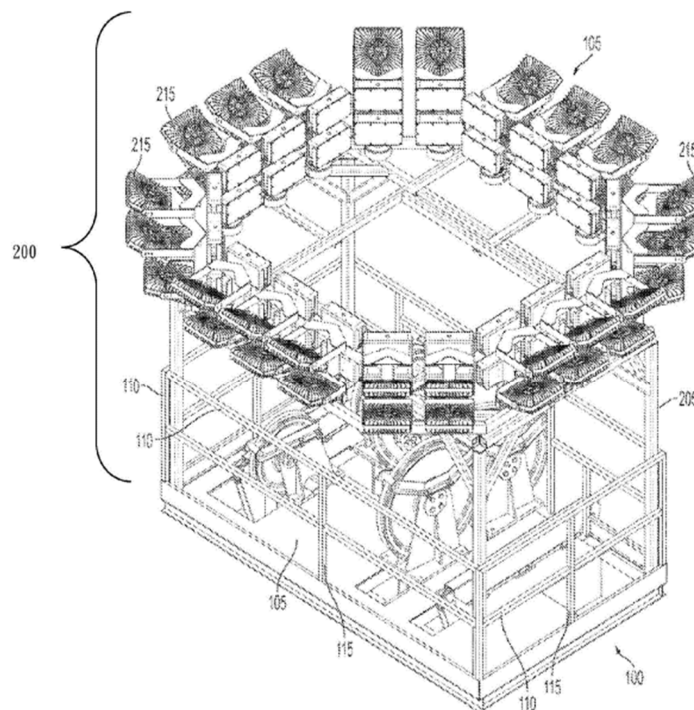


FIG. 1

Petitioner then cites to Mr. Hamdan’s “summary chart” that merely makes the same mistake of conflating a “crown” with a “crown deck.” See Ex. 1008 at ¶ 88.

Petitioner does not primarily rely on Swivelpole as disclosing the “crown deck” limitations, as it also does not disclose them. *See* Pet. 69-70. Yet it elsewhere asserts that “[i]t would be obvious to attach a plurality of mounting poles with lights to the handrail of the crown deck as shown in the Swivelpole catalog.” Pet. 71-72. As discussed above, Swivelpole does not disclose a crown deck or its handrail.

2. *Ground 2 does not disclose a “mounting pole.”*

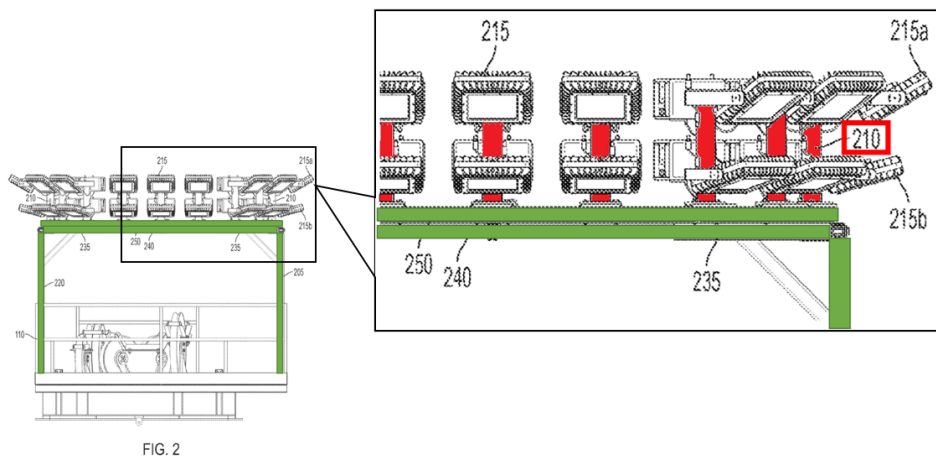
Without any explanation, Petitioner reproduces the following excerpt from Gowanlock 2 as allegedly disclosing the “mounting pole” limitations (Pet. 70-71, 73-76, 79):

“...a plurality of light support posts 210 arranged around a perimeter of the lighting frame and extending vertically such that one or more light fixtures 215, 215 a and 215 b may be connected to each light support post 210. The plurality of light fixtures 215 arranged and separated vertically from each other by their positioning on the light support posts 210 permits for light to be directed in a predetermined region proximate the crown 100 and at a predetermined region encompassing a ground area surrounding the drill rig. That is, one group of lights may be directed towards particular equipment on the drilling rig, while another group may be directed to an area surrounding the drilling rig to provide maximum lighting for personnel working in or around the drilling rig.”

Ex. 1058, 4:63-5:10.

If Petitioner intends to identify “light support posts 210” as the alleged “mounting poles” in Gowanlock 2, then Petitioner is incorrect. Reproduced below is Figure 2 from Gowanlock 2 with item 210 colored (red) and magnified. As shown therein, “light support posts 210” are short, stubby posts that are part of a unitary

frame structure with multiple lights around a lighting frame 205 (green).⁶ Indeed, Gowanlock 2 explains that “[t]he plurality of light fixtures 215” are “arranged and separated vertically from each other by their positioning on the light support posts 210.” Ex. 1058 at 5:1-3. This is materially different from claim 9, which requires a plurality of light units where “each light unit comprises a separate mounting pole.” And it is materially different from claim 19, which requires “each of the plurality of lights is mounted to only one of the plurality of mounting poles.”



In addition, if the Board construes “mounting pole” as Patent Owner proposes (and as the district court ordered in the parallel case), then a “mounting pole” is an

⁶ Tellingly, each time that Petitioner excerpts the block quote above in its Petition, it omits the very first phrase in the paragraph: “Lighting system 200 generally includes a lighting frame 205 (shown in FIG. 6, and described in more detail herein below). . . .” Pet. 70-71, 73-76, 79

“elongated structure fixed at one end and for mounting where the length of the structure far exceeds its width.” *See* Ex. 2001 at 5 (showing proposed construction), 13 (adopting proposed construction). This proposed construction in the parallel proceeding was supported by expert testimony that a “mounting pole” is understood to have a length that far exceeds its width, which distinguishes it from other structures, such as a “post” that is “shorter or more ‘squat’” and has a “lesser slenderness ratio than a pole.” *Id.* at 11; *see also id.* at 10 (“Due to the importance of a patent giving notice and clarity to a POSITA, it is significant that C&M’s expert witness’ statement that a POSITA would not be understood as a short, stubby post to also qualify as a ‘mounting pole’ when considering Ensign’s proposed construction.”).

Here, Gowanlock 2’s “light support posts 210” are exactly what a “mounting pole” **is not**. As shown in Figure 2 above, “light support posts 210” are posts that are shorter or more squat and have a lesser slenderness ratio than a pole. And it cannot be said that the length of the “light support posts 210” far exceeds their width. Thus, Petitioner has failed to show (and cannot show) that Gowanlock 2 discloses the “mounting pole” limitations.

Petitioner’s reliance on Swivelpole for the “mounting pole” limitations in Ground 2 is identical to its reliance on Swivelpole in Ground 1. For the same reasons discussed above in connection with Ground 1, which are expressly incorporated

here, Petitioner has not shown that Swivelpole discloses the “mounting pole” limitations.

3. *There is no motivation to combine these references.*

Petitioner's “arguments amount to nothing more than conclusory statements that a [POSITA] would have been motivated to combine the prior art references.” *In re Nuvasive*, 842 F.3d at 1384. Each is addressed in turn.

Neither reference discloses a crown deck or a mounting pole. For the reasons described above, neither of the two references discloses a “crown deck” or a “mounting pole.” A POSITA would never be motivated to modify these references to create a modular lighting system that is attached to a crown deck that none of them the references contemplated.

The combination is based on pure hindsight. Petitioner alleges that “a POSITA would readily know to employ the lights, mounting poles, and brackets shown in the Swivelpole catalog to separately attach a plurality of light units to a handrail [] around the crown deck.” Pet. at 45-46; Ex. 1008, ¶ 91. However, such a combination goes against the fundamental teachings of both references, neither of which disclose a crown deck.

Gowanlock 2 discloses a “frame **attached to a crown** of the drilling rig.” Ex. 1058 at 2:20-24. It was designed with a specific purpose of “increas[ing] the visibility during hours of low daylight.” Ex. 1058 at 2:4-6. Swivelpole long, slender

lighting system, on the other hand, was designed with a specific purpose of illuminating the area immediately beneath the light. Ex. 1004 at 6. Assuming *arguendo* that Gowanlock 2 discloses a crown deck (it does not), a POSITA would have never been motivated to combine it with Swivelpole's "lights, mounting poles, and brackets" that illuminate the area directly under the light. Such a combination would frustrate the primary purpose of Gowanlock 2 to illuminate the ground below the rig.

Likewise, Swivelpole was never designed with the idea that it could be used to illuminate anything beyond its adjacent walkway. Ex. 1004 at 6. This is further supported by the catalog disclosing the F2 system whose purpose is to provide "low level flood lighting" and which has a substantially different design necessary to achieve this goal. Ex. 1004 at 20. Such a combination would frustrate the primary purpose of Swivelpole to illuminate the ground directly below the light. The only way that a POSITA could arrive at the claimed features from the cited references, would have been to start with the challenged claims and work backward, picking out favorable disclosures from otherwise incompatible references. As discussed previously in Section VII(A)(3), this is impermissible hindsight reasoning.

"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. 48; Ex. 1008 at ¶ 93, is problematic for the same reasons noted for Ground 1. *Supra* Section VII(A)(3). Indeed, Petitioner reprises this purported motivation to combine verbatim.

“Obvious and predictable result.” Petitioner’s suggestion that “a POSITA would combine Gowanlock 2 and the Swivelpole catalog for the obvious and predictable result of placing or improving modular lighting on a crown deck,” Pet. 47; Ex. 1008 ¶ 92, fails for the same reason it did in connection with Ground 1. *Supra* Section VII(A)(3).

“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 handrail) for another ([Gowanlock 2] Figure 1 frame lights attached to the crown deck) to obtain predictable results.” Pet. 48. But Petitioner articulates no specific reason **why** this would be a “simple substitution” or why the resulting substitution is predictable. Gowanlock 2 discloses a frame-based system with short posts around the structure. Ex 1058 at Fig. 1. Swivelpole, in contrast, discloses a product with a pole that “swivels” and can be used for general walkways or stairways. Ex. 1004 at 4. A POSITA would not be able to use a long, slender Swivelpole, designed to hoist a small light 8 feet above a walkway and illuminate the area directly beneath on a frame-based system contemplated by Gowanlock.

Absent substantial—and unnecessary—redesign efforts, such a combined system (1) would be unable to illuminate anything beyond the crown and (2) would be prone to failure due to structural deficiencies inherent from Swivelpole's height and the "swivel" itself. Petitioner's assertion amounts to little more than a conclusory say-so.

"Known techniques." Petitioner reprises for Ground 2 that "the use of known techniques (attaching lights with brackets and poles to a handrail around a crown deck) to improve similar devices in the same way." Pet. 58. This is insufficient for the same reasons as discussed in Ground 1. *See supra* at Section VII(A)(3).

"Ordinary skill and common sense." Petitioner next contends that a POSITA "had good reasons to pursue the known options in the Swivelpole catalog and attach its pole mounted lights to the handrail of a crown deck in Gowanlock 2 instead of the heavy frame light system 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. 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 and places to attach lights to a crown deck or a surrounding handrail," Pet. 50, is similarly unsupported as described in Ground 1 where

Petitioner tries the same. *See supra*, Section VII(A)(3).

The “swivel.” Petitioner similarly contends that a POSITA would be motivated to combine the references because “the Swivelpole products” “swivel” or “move to allow installation, adjustment, and maintenance of the light fixtures, to provide functionality and flexibility to the rig lighting.” Pet. 48. Yet, as discussed previously, such a swiveling mechanism would be highly disfavored because it introduces unnecessary points of failure with nothing in return. *See supra*, Section VII(A)(3).

“May be readily attached.” Petitioner also argues that Swivelpole “shows that its mounting pole *may be* readily attached to hand railings.” Pet. 39. However, as described above, this argument fails because it does not provide a *motivation* for a POSITA combine the two references. *See supra*, Section VII(A)(3).

“Use of mounting poles with brackets and bolts allows mounting or affixing the lights to differently configure or designed handrail on crown decks.” Petitioner further suggests that “use of mounting poles with brackets and bolts allows mounting or affixing the lights to differently configured or designed handrails on crown decks.” Pet. 47-48; Ex. 1008 ¶ 92 (Mr. Hamdan parroting the same). But this alleged benefit echoes the exact advantages described by the ’626 Patent without more, confirming that it is based on pure hindsight. *See, e.g.*, Ex. 1001 at 2:49-57 (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.”).

4. *Petitioner fails to establish that a POSITA would have had a reasonable expectation of success in modifying and/or combining the references.*

Petitioner's provided motivations to combine the references asserted in Ground 2 largely echo those of Ground 1. Accordingly, they fail for the same reasons.

Here, Petitioner also contends that “[a] POSITA would readily know to employ the lights, mounting poles, and brackets shown in the Swivelpole catalog to separately attach a plurality of light units to a handrail[.]” Pet. 45. But this statement does not explain **how** Gowanlock 2 could be combined with Swivelpole. The Swivelpole catalog provides a non-exhaustive list of 32 possible brackets used for attaching their lighting systems to a handrail, all designed and developed with a specific purpose in mind. Ex. 1004 at 12-13. Petitioner does not—and cannot—identify any of these as suitable for operating on a crown deck. Yet, the rigors of installing a lighting system atop a crown deck require a unique approach necessary to ensure their safe and prolonged operation (*e.g.*, high winds, sudden changes in wind pressure and direction, sway of the rig, and lightning safety among others). As was explained in great detail in connection with Ground 1, installing Swivelpole's

lighting systems on top of the crown deck would require substantial efforts in redesign to ensure all of these issues are addressed. *See supra*, Section VII(A)(3).

Accordingly, there is no reasonable expectation of success in combining these references.

C. Ground 3: The Petition Fails to Establish that the Challenged Claims are Obvious over Gowanlock 1 or 2 in view of Magnalight.

Ground 3 of the Petition also fails. For instance, Petitioner fails to establish that Ground 3 discloses a “crown deck” and a “mounting pole” limitations. More so, Petitioner does not identify any supportable, non-hindsight motivation to combine or reasoned, supported basis for a reasonable expectation of success.

1. Ground 3's references fail to disclose a “crown deck.”

Petitioner asserts that either Gowanlock 1 or Gowanlock 2 disclose a “crown deck” Pet. 82. Although these references are not interchangeable and include different disclosures, the Board should come to the same conclusion regardless. As was explained in Section VII(A)(1), Gowanlock 1 does not disclose any structures remotely resembling a “crown deck.” To the extent Petitioner attempts to assert that Gowanlock 2 discloses the “crown deck,” it was also explained that the provided “crown” lacks any structures or disclosures indicating a “walking surface” or the “parts supporting [one].” *See supra*, Section VII(B)(1).

Petitioner does not (and cannot) rely on Magnalight as disclosing a “crown deck.” *See* Pet. 81-82, 87-88, 91, 95. 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 3 discloses a “crown deck,” and institution should be denied.

2. *Ground 3's references fail to disclose a “mounting pole.”*

Petitioner summarily states that “Magnalight YouTube video discloses a light fixture comprising one or more lights and that the light fixture is coupled to the mounting pole attached to a handrail” without citing anything from the video in support. Pet. 84. Instead, the Petition identifies an “aluminum mount.” Pet. 33; Ex. 1008 ¶ 102.

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 ¶ 104, 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 ¶ 105. 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*, IPR2022-00624, Paper 9 at 15.

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

limitations, and institution should be denied.

3. *There is no motivation to combine these references.*

Next, Petitioner argues that, because Magnalight “shows that its lights on a mounting pole *may be* readily attached to handrails, i.e., guardrails.” Pet. 57; Ex. 1008 ¶ 102. However, saying “[t]hat a [POSITA] could have done so is not enough.” *Matterport*, IPR2021-00939, Paper 15 at 21. And, even so, suggesting that Magnalight “may be” attached to handrails generally still would not mean a POSITA would be motivated to attach Magnalight to the **crown deck**’s handrails. Indeed, none of the Ground 4 references even discloses a crown deck with a handrail for the reasons discussed *supra* in Section VII(C)(1).

Undeterred, Petitioner argues “a POSITA would combine the references as suggested to use the Magnalight on the handrail instead of Gowanlock 1’s pole mounted lights near the internal floor or the crown or the heavy frame lights on Gowanlock 2 for the obvious and predictable result of placing or improving modular lighting on a crown deck of a rig to make a plurality of lights less heavy, easier to install, easier to uninstall, easier to adjust, safer to install, and safer to access for maintenance each of which is an obvious motivating factor.” Pet. 57; Ex. 1008 ¶ 102.

But Gowanlock 1 does not disclose “pole mounted lights,” and none of Magnalight, Gowanlock 1, or Gowanlock 2 disclose a handrail of a **crown deck** for

the reasons discussed *supra* in Sections VII(A)(1), (B)(1). So those non-existent features cannot provide a motivation to combine the references in the manner Petitioner proposes. Moreover, Petitioner never explains *why* “us[ing] the Magnalight on the handrail instead of Gowanlock 1’s pole mounted lights near the internal floor or the crown or the heavy frame lights on Gowanlock 2” would “make a plurality of lights less heavy, easier to install, easier to uninstall, easier to adjust, safer to install, and safer to access for maintenance each of which is an obvious motivating factor.” Indeed, the **only** “evidence” that the Petition cites for this proposition is Mr. Hamdan’s declaration, which provides no more than insufficient “conclusory statements” sans any support, rationale, or analysis. *In re Nuvasive*, 842 F.3d at 1384.

Petitioner next argues that “a POSITA would readily attach lights to a mounting pole on a handrail and be motivated to do so because it would make lights more accessible and easier to adjust.” Pet. 57; Ex. 1008 ¶ 102. But the claims recite handrails of a **crown deck**, not just “a handrail.” And “one must have a motivation to combine accompanied by a reasonable expectation of achieving *what is claimed in the patent-at-issue*.” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016).

Petitioner further suggests 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 handrail around a crown deck.” Pet. 57-58; Ex. 1008 ¶ 103. This is incorrect for the same reasons discussed for Grounds 1 and 2 (Sections VII(A)(3), (B)(3)), which are incorporated here. Petitioner reiterates this purported motivation to combine verbatim.

In addition. Petitioner argues that the combination would be a “simple substitution of one known element (a plurality of Magnalight YouTube video pole mounted lights attached to the crown deck handrail) for another (Gowanlock 1’s pole mounted lights near the internal floor of the crown of prior art Figure 1 and Gowanlock 2 frame lights attached to the crown deck) to obtain predictable results.” Pet. 58; Ex. 1008, ¶ 103.

But Petitioner articulates no specific reason *why* this would be a “simple substitution.” It would not be for the reasons explained above in Section VII(A)(3), (B)(3). Nor is there any “predictable result” where Petitioner fails to ever explain how Gowanlock would be modified in light of Swivelpole. Instead, one is left to speculate and, as explained above, a POSITA would never modify Gowanlock based on Swivelpole.

Petitioner further argues that a POSITA would be motivated to combine the references because Magnalight “is readily available for purchase without any apparent patent licensing issues or can be assembled by a POSITA using components (metal bars, bolts, nuts, and hooks) that are also readily available or could be

constructed.” Pet. 58; Ex. 1008 ¶ 103. The only “evidence” Petitioner cites for the purported fact that Magnalight is “readily available for purchase without any apparent patent licensing issues” is Mr. Hamdan’s say-so. Neither Petitioner nor Mr. Hamdan provides any support, and the Board cannot rely on it. Moreover, the Petition’s suggestion that Mangalight “can be assembled by a POSITA using components (metal bars, bolts, nuts, and hooks) that are also readily available or could be constructed” is (i) irrelevant because the claims do not recite Magnalight, and (ii) irrelevant because what a POSITA “can” do does not show what a POSITA would be motivated to do. *Matterport*, IPR2021-00939, Paper 15 at 21.

In addition, Petitioner argues that a POSITA would be motivated to combine the references based on “the use of known techniques (attaching lights with brackets and poles to a handrail around a crown deck) to improve similar devices in the same way.” Pet. 58; Ex. 1008 ¶ 103. But this is improper circular reasoning: the Petition suggests that a “known technique[]” was “attaching lights with brackets and poles to a crown deck or a hand railing around a crown deck”—recited in the challenged claims—despite the fact none of the references disclose a “crown deck” or “a hand railing around a crown deck.” And “[e]ven if a [POSITA] would have this knowledge,” of some “known technique” as Petitioner contends, “it does not necessarily follow that such an artisan would have any *motivation* to combine the prior art in this manner.” *Provisur Techs., Inc. v. Weber, Inc.*, No. 2021-1851, 2022

WL 17688071, at *5 (Fed. Cir. Dec. 15, 2022)

Yet, according to Petitioner and its expert, “a light fixture or other items are commonly attached to a handrail via a pole, a bracket, and/or one or more screws or bolts,” and “[p]oles have been attached to crown deck handrail[]s with flag, airplane lights, and other structures attached.” Pet. 58-59; Ex. 1008 ¶¶ 104-105. However, “a patent ... is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *Purdue Pharma L.P. v. Depomed, Inc.*, 643 F. App'x 960, 965 (Fed. Cir. 2016). And here, Petitioner has not even shown that each element was independently known, as a general “handrail” or “pole” is not what is claimed.

Petitioner also argues that “[t]here are only a finite number of ways to attach lights to a crown deck or its surrounding handrail.” Pet. 59-60; Ex. 1008 ¶ 106. But this **assumes** a POSITA would be motivated to “attach lights to a crown deck or its surrounding handrail” in the first instance. The Petition identifies no such motivation, especially given that none of Magnalight, Gowanlock 1, or Gowanlock 2 disclose “a crown deck or its surrounding handrail” anyways.

Finally, Petitioner contends that a POSITA “had good reasons to pursue the known options in [Magnalight] to replace Gowanlock 1’s pole mounted lights near the internal floor of the crown or the heavy frame lights of Gowanlock using ordinary skill and common sense to arrive at” the challenged claims. Pet. 59-60; Ex. 1008

¶ 106. 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; *In re Zurko*, 258 F.3d 1379, 1385 (Fed. Cir. 2001) (“We cannot accept these findings by the Board. This assessment of basic knowledge and common sense was not based on any evidence in the record and, therefore, lacks substantial evidence support.”). The Petition provides no such analysis or support. Instead, the Petition falls prey to hindsight reasoning.

4. *Petitioner fails to establish that a POSITA would have had a reasonable expectation of success in modifying and/or 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 Gowanlock 1 and 2 to achieve the claimed invention. *See Intelligent Bio-Sys.*, 821 F.3d at 1367. The J-Hook rail mount shown in the Mangalight 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.

Such a substitution would not only be **not** obvious but, if attempted, would

require an extensive redesign on behalf of a POSITA as Magnalight is not suitable for operations under the kind of stress endured by a crown deck atop an oil rig. As just one example, 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 outright dangerous if lights shift position or fall, thereby posing significant safety risks that the '016 Patent was explicitly avoiding. Ex. 1001 at 2:41-44 (discussing how the claimed invention is "reduc[ing] the risk of accidents"), 4:41-44 ("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.").

VIII. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests the Board to deny the institution of this proceeding.

Dated: January 19, 2024

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 13,975 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: January 19, 2024

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 January 19, 2024, a copy of this PRELIMINARY RESPONSE was served to the email correspondence address of record for Petitioner's counsel of record:

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Dated: January 19, 2024

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