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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTELLIGENT WELLHEAD SYSTEMS, INC.,
Petitioner,

v.

DOWNING WELLHEAD EQUIPMENT, LLC,
Patent Owner.

IPR2024-00256 (Patent 11,401,779 B2)
IPR2024-00300 (Patent 11,560,770 B2)[1]

Before BENJAMIN D. M. WOOD, CARL M. DEFRANCO, FREDERICK C. LANEY, and MATTHEW S. MEYERS, *Administrative Patent Judges*.

WOOD, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

[1] This Order addresses issues common to each of the above-captioned proceedings. We exercise our discretion to issue one Order to cover both proceedings. No panel has been expanded. The parties are not authorized to use this style heading in any subsequent papers.

At Petitioner's request,[2] a conference call was held with Judges Wood, Laney, and Meyers, and respective counsel for the parties. The purpose of the call was to discuss whether Petitioner has good cause to submit a Reply to Patent Owner's Preliminary Responses in the above-captioned cases to address Patent Owner's argument that the Krupa reference[3] has not been shown to qualify as prior art.[4] *See* 37 C.F.R. § 42.108(c) (requiring petitioner to show good cause to reply to a preliminary response).

The Petition in each case includes grounds of unpatentability based on Krupa, which is alleged to be prior art under 35 U.S.C. § 102(a)(2).[5] Both Petitions assert that Krupa "claims priority to U.S. Provisional App. No. 63/153,607, filed February 25, 2021" ("the '607 provisional") and that Krupa is prior art to the challenged patents because Krupa's effective filing date of February 25, 2021 is prior to the challenged patents' priority date of May 17, 2021.[6] Petitioner, however, did not introduce the '607 provisional into the record in either proceeding.

In the Preliminary Response in each case, Patent Owner argued that Krupa does not qualify as prior art on its face and that Petitioner had the initial burden in the Petition to show that Krupa was in fact prior art based on disclosure in the '607 provisional.[7] Patent Owner also argued in the

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[2] *See* Ex. 3001.
[3] U.S. Patent Pub. No. 2022/0268141 (Ex. 1003 in each case).
[4] The parties did not retain a court reporter.
[5] IPR2024-00256, Paper 1, 3–4; IPR2024-00300, Paper 1, 3–4.
[6] IPR2024-00256, Paper 1, 6; IPR2024-00300, Paper 1, 4.
[7] IPR2024-00256, Paper 9, 8–9; IPR2024-00300, Paper 8, 8–9.

Preliminary Responses that even if Krupa is entitled to the ’607 provisional filing date, “Krupa is not prior art due to Downing’s public disclosures under § 102(b)(2).”[8]

During the call, Petitioner’s counsel argued that good cause for a reply exists because Petitioner could not reasonably have foreseen Patent Owner’s arguments that Krupa is not prior art, and because it was necessary to respond to Patent Owner’s evidence of prior public disclosure. As to the first reason, Petitioner contended that it was not foreseeable that Krupa’s entitlement to the ’607 provisional’s filing date would be disputed because Krupa’s specification is identical to the ’607 provisional specification. Petitioner also argued that it was not foreseeable that Patent Owner would argue that Krupa is not prior art under 35 U.S.C. § 102(b)(2)(b), or that it would have to respond to Patent Owner’s supporting evidence in the form of Exhibits 2001–2005.

In Response, Patent Owner’s counsel disputed that Krupa’s entitlement to the ’607 provisional’s filing was an unforeseeable issue. Patent Owner further submitted that addressing its prior-inventor-disclosure evidence is only necessary if it is first established that Krupa is entitled to the’607 provisional priority date, which the Petition has not done.

Upon consideration of the parties’ positions, we find Petitioner has not established good cause for further briefing and therefore deny Petitioner’s request to file a Reply to Patent Owner’s Preliminary Response in each case.

[8] IPR2024-00256, Paper 9, 9–19; IPR2024-00300, Paper 8, 9–19.

We are not persuaded that Patent Owner's arguments concerning whether the Petition made the necessary showing for Krupa to obtain the priority benefit of the '607 provisional filing date were unforeseeable when the Petition was filed. "In an IPR, the petitioner has the burden from the outset to show with particularity why the patent it challenges is unpatentable." *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3)). Showing unpatentability of a claim based on anticipation or obviousness necessarily requires any cited reference to be qualified first as being within the scope of prior art available against a challenged claim. Because Krupa issued from an application filed *after* the '779 patent's filing date, and because Krupa's entitlement to the filing date of the '607 provisional cannot be presumed,[9] Krupa cannot be shown to be prior art without record evidence that shows the '607 provisional discloses the relevant information relied upon in Krupa. Thus, Krupa's status as prior art was a foreseeable issue from the outset. It was therefore equally foreseeable that Patent Owner would challenge in the Preliminary Responses whether Petitioner made the necessary showing to qualify Krupa as being properly within the scope of available prior art against the claims challenged. Petitioner's argument that it relied on the alleged similarities between the specifications for the '607 provisional and Krupa is also unpersuasive because the '607 provisional was never entered

[9] *See Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375, 1380 (Fed. Cir. 2015) (holding that "because the PTO does not examine provisional applications as a matter of course," presuming that a patent is entitled to the benefit of the filing date of its provisional precursor is "not justified").

into the record and all we have is unsupported attorney argument. Therefore, Petitioner has not demonstrated that additional briefing to address the prior art status of Krupa is warranted at this time and on this record.

Petitioner's counsel indicated that, as an alternative to submitting replies to Patent Owner's Preliminary Responses, Petitioner would like authorization to file corrected or replacement petitions in each proceeding such that the '607 provisional would be introduced as an exhibit to each corrected petition and the petitions would be amended to include a short explanation "tying the exhibit to the record." Petitioner cites as support for this request *Comcast Cable Communications, LLC v. Rovi Guides, Inc.*, IPR2017-00217, Paper 15 (PTAB Mar. 24, 2017), in which the Board granted Petitioner's motion to file a replacement petition (this decision has not been marked precedential or informative).

Our authority to permit corrections to petitions is found in 37 C.F.R. § 42.104(c). This provision states that "[a] motion may be filed that seeks to correct a clerical or typographical mistake in the petition" and "[t]he grant of such a motion does not change the filing date of the petition." We do not consider the omission of any analysis in the Petitions of the '607 provisional, or the failure to enter the '607 provisional into the record of these proceedings, to be a "clerical or typographical mistake" such that a motion to file a corrected petition would be appropriate. Therefore, we also deny Petitioner's request to file a corrected petition.

Accordingly, it is:

ORDERED that Petitioner's request for authorization to file a Reply to Patent Owner's Preliminary Response is *denied*; and

FURTHER ORDERED that Petitioner's request for authorization to file a corrected petition is *denied*.

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