**IN THE UNITED STATES DISTRICT COURT**
**FOR THE DISTRICT OF COLORADO**

Case No. 1:23-cv-01180-RMR-SBP

DOWNING WELLHEAD
EQUIPMENT, LLC,

Plaintiff,

v.

INTELLIGENT WELLHEAD
SYSTEMS, INC., INTELLIGENT
WELLHEAD SYSTEMS, CORP., and
IWS USA CORP.,

Defendant.

---

**PLAINTIFF DOWNING WELLHEAD EQUIPMENT, LLC'S SUPPLEMENTAL OBJECTIONS AND RESPONSES TO DEFENDANTS' INTERROGATORIES (NOS. 1-2)**

---

Pursuant to Rules 26 and 33 of the Federal Rules of Civil Procedure, Plaintiff Downing Wellhead Equipment, LLC ("Plaintiff" or "Downing") hereby objects and responds to Defendants Intelligent Wellhead Systems, Inc., Intelligent Wellhead Systems, Corp., and IWS USA Corp.'s ("Defendant" or "IWS") Interrogatories ("Interrogatories") Nos. 1 & 2.

## GENERAL OBJECTIONS AND QUALIFICATIONS

The general objections and qualifications listed below are hereby incorporated by reference and made part of Downing's response to every Interrogatory, regardless of whether they are or are not reiterated within the specific responses below.

Downing bases its objections and responses upon information presently available and will further supplement or amend these objections and responses as discovery progresses in accordance with Fed. R. Civ. P. 26(e). Discovery is ongoing and Downing is still pursuing its investigation and analysis of the facts and law pertaining to this lawsuit and has not yet completed its investigation and analysis.

Downing responds to IWS's Interrogatories as Downing interprets and understands each Interrogatory with respect to the issues in this lawsuit. If IWS asserts a different interpretation of any Interrogatory, Downing reserves the right to supplement or amend its responses or objections.

Any response that indicates that Downing will provide information or produce documents should not be construed to mean that responsive information or documents in fact exist; only that, if such relevant, non-privileged, non-objectionable information or documents exist, are in Downing's possession, custody, or control, and are located after a reasonable search of the location or locations where responsive information or documents are likely to be located, such information or documents will be produced in a timely manner.

Downing objects to the Interrogatories, and the definitions and instructions that accompany them, to the extent that they seek to impose obligations and demands on Downing greater than or more extensive than those required by the Federal Rules of Civil Procedure, the Local Rules of the United States District Court for the District of Colorado, or any other applicable authority.

Downing objects to the Interrogatories, and the instructions and definitions that accompany them, to the extent that they seek information or identification for "any," "each," "every," or "all" documents, persons, entities, objects, or events, when a subset of documents, persons, entities, objects, or events will provide the requested information. The burden or expense of collecting or analyzing the information called for by such Interrogatory outweighs its likely benefit.

Downing objects to the Interrogatories, and the instructions and definitions that accompany them, to the extent that they call for information or documents that are not within the possession, custody, or control of Downing.

Downing objects to the Interrogatories, and the instructions and definitions that accompany them, to the extent that they request that Downing create or produce information that Downing does not maintain in the ordinary course of its business, or to the extent they request that Downing create or produce information in a particular format or at a particular level of detail that Downing does not maintain in the ordinary course of its business.

Downing objects to the Interrogatories, and the instructions and definitions therewith, to the extent that they seek information or documents that Downing is not permitted to disclose pursuant to confidentiality obligations to third parties or by court order. To the extent any such information or any such documents are responsive, relevant, and non-privileged, Downing will produce that information and/or those documents in accordance with the Protective Order (Dkt. 44) and after complying with its obligations to third parties and/or court orders.

Downing objects to the Interrogatories, and the definitions and instructions that accompany them, to the extent that they seek information, documents, or things protected from disclosure by the attorney-client privilege, work product doctrine, common-interest privilege, or any other privilege or immunity against disclosure (collectively, as used here, "privilege"). Nothing contained in these responses should be considered a waiver of any privilege. Downing does not intend to provide information or produce documents that would divulge any privileged information. Any such disclosure is inadvertent and shall not be deemed a waiver of any applicable privilege.

Downing objects to the Interrogatories, and the instructions and definitions that accompany them, to the extent that they contain interrogatories with discrete subparts improperly grouped as a single Interrogatory. Any such subparts will be treated as a separate Interrogatory for the purposes of determining the number of interrogatories served by IWS.

Downing objects to the Interrogatories, and the instructions and definitions that accompany them, to the extent that they alter the plain meaning of any specific Interrogatory, on the ground that such alteration renders the Interrogatory vague, ambiguous, overly broad, and/or unduly burdensome.

Downing objects to the definition of "You," "your," and "Downing," and to any Interrogatory incorporating those terms on the grounds that they encompass entities or individuals over whom Downing does not have control and over whose documents Downing does not have possession, custody, or control. Downing

provides these responses exclusively on its own behalf and does not purport to speak for others.

## OBJECTIONS AND RESPONSES TO REQUESTS

**INTERROGATORY NO. 1:**

For each Asserted Claim of the Patents-in-Suit, identify the alleged priority date and describe in detail all facts and circumstances of alleged conception, reduction to practice (actual, and constructive), and diligence in such reduction to practice, including identifying the earliest date You contend that such Asserted Claim was conceived of; the persons involved in the conception and reduction to practice; the earliest date You contend that such Asserted Claim was actually or constructively reduced to practice; where the invention was first reduced to practice; when, where, and to whom it was first disclosed; all persons with knowledge of the relevant facts; and all testimony, Documents (by Bates number) or other evidence relating to any of the foregoing.

**RESPONSE TO INTERROGATORY NO. 1:**

Downing incorporates its General Objections and Qualifications as set forth above.

Downing objects to this Interrogatory to the extent it seeks information protected by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity.

Downing objects to this Interrogatory to the extent it calls for a narrative response and "all testimony," which is more appropriately the subject of a deposition.

Downing objects to this Interrogatory as unduly burdensome and not proportional to the needs of the case to the extent it seeks publicly available information that is equally available to IWS, including from the USPTO database.

Downing objects to this Interrogatory as overly broad, unduly burdensome, not proportional to the needs of the case, and seeking information that is not relevant to any claim or defense, including but not limited to, because this Interrogatory prematurely attempts to shift the burden onto Downing to identify a priority date for each asserted claim of each Asserted Patent prior to Defendants' deadline to serve Invalidity Contentions and before Defendants have identified even a single prior art reference.

Downing objects to this Interrogatory as overly broad, unduly burdensome, not proportional to the needs of the case, and seeking information that is not relevant to any claim or defense, including but not limited to, because it seeks information relevant only to Pre-AIA 35 U.S.C. § 102 (e.g., all information relating to "alleged conception, reduction to practice (actual, and constructive), and diligence in such reduction to practice") despite the asserted claims of the Asserted Patents not being subject to the same given that they have effective filing dates after March 16, 2013. Further, the additional information requested related to such conception and reduction to practice (e.g., "the persons involved in the conception and reduction to practice; the earliest date You contend that such Asserted Claim was actually or constructively reduced to practice; where the invention was first reduced to practice; when, where, and to whom it was first disclosed; all persons with knowledge of the

relevant facts") is equally irrelevant, over broad, unduly burdensome, not proportional to the needs of the case.

Downing further objects to this Interrogatory as premature, including but not limited to, because this Interrogatory improperly seeks Downing's contentions on legal issues when discovery has only just begun. IWS has not produced any documents, identified any alleged prior art, or served its Invalidity Contentions, and the Court has not yet engaged in claim construction.

Subject to, and without waiving the General Objections and Qualifications, and specific objections above, Downing responds as follows:

Following service of Defendants' Invalidity Contentions, Downing will supplement its response to this Interrogatory.

**SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 1 (12/15/2023)**

Downing hereby incorporates its prior objections and responses to this Interrogatory in their entirety.

Downing reiterates its objection to this Interrogatory to the extent it seeks information not related to any claim or defense in this case. Interrogatory No. 1 requests Downing's contentions regarding the priority date, conception, and reduction to practice of the Asserted Patents. However, under the first-to-file regime of the America Invents Act, "priority of invention" is no longer relevant to determining a person's entitlement to a patent or the applicability of prior art.[1]

[1] *See SNIPR Techs. Ltd. v. Rockefeller Univ.*, 72 F.4th 1372, 1375–76 (Fed. Cir. 2023) ("Before the AIA's passage, prior art referred to certain documents available before the actual date of invention. Under the AIA, prior art now refers to certain documents available before the 'effective filing date of the claimed invention.'…Congress also removed the statutory requirement for 'priority of invention'

Subject to its general and specific objections, Downing supplements its response as follows:

**Earliest Effective Filing Date:**

- '779 Patent Claims 1, 2, 3, 6, 8, 9, 10, 13, 15, 16, 17, 18, 25, 26, 27, 28, 31, and 36 are entitled to an earliest effective filing date of May 17, 2021, based upon the filing date of U.S. Provisional Pat. Appl. No. 63/189,663.
- '770 Patent Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, and 38 are entitled to an earliest effective filing date of May 17, 2021, based upon the filing date of U.S. Provisional Pat. Appl. No. 63/189,663.

**35 U.S.C. 102(b)(1)(B):**

In addition to the earliest effective filing date for each asserted claim above, Downing further responds that it intends to assert that one or more of the asserted prior art references set forth in Defendants' Initial Invalidity Contentions, and any supplements thereto, may be removed as prior art under 35 U.S.C. § 102(b)(1)(B) as of the following dates:

- The subject matter of '779 Patent Claims 1, 2, 3, 6, 8, 9, 10, 13, 15, 16, 18, 25, 26, 28, 31, and 36 was disclosed as of September 1, 2020.
- The subject matter of '770 Patent Claims 1, 2, 4, 5, 6, 7, 8, 9, 10, 11, 12,

---

entitling only the first inventor to a patent and eliminated the mechanisms for determining such priority.") (citations omitted).

13, 14, 15, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 30, 31, 32, 33, 34, 35, 36, 37, and 38 was disclosed as of September 1, 2020.

On September 1, 2020, Austin Johnson met with Kevin Anstrom, an employee of Downing customer EQT Corporation, to obtain permission to perform and validate the claimed CP swap on an EQT wellsite. DOWNING003888. During that meeting, Mr. Johnson explained the details of the claimed CP swap to Mr. Anstrom and described Downing's plans to implement the process using Downing's iControl platform. On September 16, 2020, following the meeting between Mr. Johnson and Mr. Anstrom, Mr. Johnson and Jordan Kuehn gave a presentation to a larger group of EQT employees and explained the details of the CP swap and how it would be performed. *See, e.g.*, DOWNING003727; DOWNING003728. On the following day, September 17, 2020, Mr. Johnson and Mr. Kuehn successfully performed the claimed CP swap under the observation of EQT personnel. *See, e.g.*, DOWNING003690; DOWNING003849. Thereafter, EQT personnel continued to perform the CP swap themselves following the instructions provided by Downing.

Shortly after performing the first CP swap with EQT, Downing distributed updated marketing materials to sales personnel which included descriptions of the claimed CP swap invention. *See, e.g.*, DOWNING003697; DOWNING003698; DOWNING003722; DOWNING003724; DOWNING003725; DOWNING003726; DOWNING003734; DOWNING003735; DOWNING003755; DOWNING003756; DOWNING003770; DOWNING003774; DOWNING003780; DOWNING003797; DOWNING003802; DOWNING003803.

On Oct. 12, 2020, Downing updated its website to advertise CP swap as a function of its Freedom Series Completion System with iControl. DOWNING003873; DOWNING003692. During the October 27-29, 2020, SPE Annual Technical Conference and Exhibition, Downing President Brian Wiesner gave a virtual presentation, including a description of Downing's CP swap invention. DOWNING003817.

On Nov. 6, 2020, the claimed CP swap was implemented into Downing's iControl source code and was issued as a software update to the system that was currently installed on an EQT pad. *See* DOWNING003677; DOWNING003874. Following the initial software update, the CP swap update was rolled out to all Downing customers. On December 16, 2020, SEF Energy, LLC CEO Zach Graves gave an interview on episode 63 of the Invest with James West podcast and discussed Downing's CP swap invention and presented Downing marketing materials describing details of the claimed CP swap invention. *See, e.g.*, DOWNING003674; DOWNING003734; DOWNING003735.

Further, pursuant to Rule 33(d) of the Federal Rules of Civil Procedure, Downing identifies the following documents as being responsive to this Interrogatory: DOWNING003675; DOWNING003691; DOWNING003696; DOWNING003828; DOWNING003848; DOWNING003868; DOWNING003871; DOWNING003872; DOWNING003887; DOWNING003891; DOWNING003897; DOWNING003898; DOWNING003899; DOWNING003900; DOWNING003901; DOWNING003904; DOWNING003905; DOWNING003918; DOWNING003920;

DOWNING003921; DOWNING003924; DOWNING003928; DOWNING003930; DOWNING003934.

**INTERROGATORY NO. 2:**

Separately for each Asserted Claim of the Patents-in-Suit, identify and describe each named inventor's and any other person's contribution to the conception or reduction to practice of the claimed invention, or diligence in reducing to practice of the claimed invention, including without limitation, for each contribution, the date(s), location(s), the relevant portion(s) of the claimed invention involved, an identification of all witnesses who can corroborate such contribution, and an identification of all Documents (by Bates number) corroborating such contribution.

**RESPONSE TO INTERROGATORY NO. 2:**

Downing incorporates its General Objections and Qualifications as set forth above.

Downing objects to this Interrogatory to the extent it seeks information protected by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity.

Downing objects to this Interrogatory as overly broad, unduly burdensome, not proportional to the needs of the case, and seeking information that is not relevant to any claim or defense, including but not limited to, because this Interrogatory prematurely attempts to shift the burden onto Downing to identify a date for conception and reduction to practice for each asserted claim of each Asserted Patent prior to Defendants' deadline to serve Invalidity Contentions and

before Defendants have identified even a single prior art reference.

Downing objects to this Interrogatory as overly broad, unduly burdensome, not proportional to the needs of the case, and seeking information that is not relevant to any claim or defense, including but not limited to, because it seeks information relevant only to Pre-AIA 35 U.S.C. § 102 (e.g., "each named inventor's and any other person's contribution to the conception or reduction to practice of the claimed invention, or diligence in reducing to practice of the claimed invention") despite the asserted claims of the Asserted Patents not being subject to the same given that they have effective filing dates after March 16, 2013. Further, the additional information requested related to such conception and reduction to practice (e.g., "for each contribution, the date(s), location(s), the relevant portion(s) of the claimed invention involved, an identification of all witnesses who can corroborate such contribution, and an identification of all Documents (by Bates number) corroborating such contribution.") is equally irrelevant, over broad, unduly burdensome, not proportional to the needs of the case.

Downing further objects to this Interrogatory to the extent it calls for a narrative response that is more appropriately the subject of a deposition.

Downing further objects to this interrogatory as vague and ambiguous to the extent it calls for a description of "the relevant portion(s) of the claimed invention involved" in relation to each contribution by an inventor to a given asserted claim.

Downing further objects to this Interrogatory as premature, including but not limited to, because this Interrogatory improperly seeks Downing's contentions on

legal issues when discovery has only just begun. IWS has not produced any documents, identified any alleged prior art, or served its Invalidity Contentions, and the Court has not yet engaged in claim construction.

Subject to, and without waiving the General Objections and Qualifications, and specific objections above, Downing responds that it is willing to meet and confer with Defendants regarding the scope and relevance of this Interrogatory.

**SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 2 (12/15/2023)**

Downing hereby incorporates its prior objections and responses to this Interrogatory in their entirety.

Downing reiterates its objection to this Interrogatory to the extent it seeks information that is not relevant to any claim or defense and is not proportional to the needs of the case. To the extent the request seeks details related to diligence, such information is irrelevant under the AIA. Likewise, specific details regarding the "date(s), location(s), the relevant portion(s) of the claimed invention involved" for "each" contribution is irrelevant, unduly burdensome, and/or disproportional to the needs of the case, given that the inventors collaborated and jointly contributed to the conception of the claimed invention over a period of years.

Subject to its general and specific objections, Downing supplements its response as follows:

Downing's response to Interrogatory No. 1 is incorporated herein in its entirety.

Jordan Kuehn, Austin Johnson, Ronnie B. Beason, and Nicholas J. Cannon (the "Named Inventors") are the correct and only inventors of the '779 and '770

Patents. Further, for each asserted claim of the Asserted Patents, the Named Inventors each contributed to the conception of the claimed invention. Every asserted claim is directed to innovations in continuous pumping, which the Named Inventors collaboratively developed over a period of several years, culminating in the claimed CP swap method and system, which allowed for near instantaneous transitions between pumping hydraulic fracturing stages in different wells.

Ronnie B. Beason, VP of Research and Development, Automation at SEF Energy, and Nicholas J. Cannon, VP of Research and Development, Systems at SEF Energy, began developing technology related to increasing efficiency of hydraulic fracturing processes as early as 2015 while employed at The Colex Group, Inc. Some of Mr. Beason's and Mr. Cannon's contributions are described in U.S. Pat. No. 10,662,740, entitled "Valve Apparatus," an improved hydraulic fracturing valve system embodied by Downing's Freedom Series Completion System, and U.S. Pat. No. 11,480,028, which relates to novel improvements to hydraulic fracturing control and monitoring systems, both of which name Mr. Beason and Mr. Cannon as inventors and both of which are embodied by Downing's iControl system.

These and other innovations developed by Mr. Beason and Mr. Cannon provided numerous benefits for completion and stimulation operations, including significantly decreased non-productive time ("NPT") during transitions between stages. Prior to the invention of the Asserted Patents, Downing was focusing its development efforts on eliminating the last remaining inefficiencies. *See, e.g.*, Dkt. 29, Ex. 3 at 6; Dkt. 29, Ex. 2 at 4.

In the third quarter of 2019, SEF Energy acquired The Colex Group and brought on Mr. Beason as VP of Research and Development, Automation and Mr. Cannon as VP of Research and Development, Systems. As Downing's heads of R&D, Mr. Beason and Mr. Cannon focused their development efforts on further reducing and/or eliminating the last remaining efficiencies. In so doing, Mr. Beason and Mr. Cannon also worked regularly with Mr. Johnson, VP of Completions at Downing, and Mr. Kuehn, Lead Software Engineer at SEF Energy. Building from their collaborative efforts and working under the direction of Mr. Beason and Mr. Cannon, in and around August of 2020, Mr. Johnson arrived at the initial concept of and procedure for transitioning between hydraulic fracturing stages in separate wells without shutting down the pumps. The Named Inventors discussed this idea and the potential opportunity of live testing with a customer.

Mr. Johnson and Mr. Kuehn subsequently worked together to refine and reduce to practice the CP swap procedure and jointly developed further details of the CP swap, including sequencing of valves during the swap and identifying fluid conditions related to the opening and closing of valves.

The claimed CP swap was fully conceived of no later than September 1, 2020, the date of the first meeting between Downing and EQT. DOWNING003888. The claimed CP swap was subsequently actually reduced to practice on September 17, 2020, when the claimed CP swap was successfully performed on the EQT wellsite. Thereafter, on or before November 6, 2020, Mr. Kuehn completed integrating the source code implementing the claimed CP swap invention into the Downing iControl

software, which was contemporaneously made available to Downing customers. *See, e.g.*, DOWNING003677; DOWNING003874.

DATED: December 15, 2023

*/s/ Tiffany M. Cooke*

Lee F. Johnston
HAYNES AND BOONE, LLP
675 15th St., Suite 2200
Denver, Colorado 80202
Tel. (303) 382-6200
Fax (303) 382-6210
lee.johnston@haynesboone.com

John R. Emerson
Tiffany M. Cooke
HAYNES AND BOONE, LLP
2801 N. Harwood Street, Suite 2300
Dallas, Texas 75201
Tel. (214) 651-5000
Fax (214) 200-0884
russ.emerson@haynesboone.com
tiffany.cooke@haynesboone.com

**ATTORNEYS FOR DOWNING WELLHEAD EQUIPMENT, LLC**

## CERTIFICATE OF SERVICE

I hereby certify that on December 15, 2023, that the foregoing documents was served on all counsel of record via electronic mail.

*/s/ Tiffany M. Cooke*
Tiffany M. Cooke