

IPR2024-00583
Patent No. 11,401,779

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

IPR2024-00583
Patent No. 11,401,779

**PETITIONER'S REASONS FOR PARALLEL PETITIONS AND
PETITION RANKING**

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Intelligent Wellhead Systems, Inc. (“IWS”/“Petitioner”) is filing parallel petitions challenging U.S. Patent No. 11,401,779 (“’779 Patent”/“’779” (Ex. 1001)) claims 1-3, 6, 8-10, 13, 15-18, 25-28, 31, and 36 (“Challenged Claims”) on different grounds in IPR2024-00256 (“Petition 1”) and in this proceeding (“Petition 2”).

The Board should institute both petitions for three reasons. First, after initially refusing to identify information relevant to the ’779 Patent’s priority date and after IWS filed Petition 1, Patent Owner revealed new information related to ’779’s priority date and alleged applicability of prior art exceptions under 35 U.S.C. § 102(b)(2)(A) and/or (B), which, if taken as true, could affect the grounds the Board can consider. Second, the number, length, and nature of the claims, the complicated family history of 17 related patent applications (*see* Ex. 1011), and the fact that space in Petition 1 had to be dedicated to discussing the priority date issue in detail because of Downing’s refusal to provide relevant information on the issue make it impossible to have addressed all challenged claims on all available grounds within one petition. Third, the petitions are not duplicative and efficiently address the validity of the ’779 Patent. Each petition challenges the asserted claims on different grounds. Moreover, the petitions are organized to minimize burden on the Board.

I. REASONS WARRANTING ADDITIONAL PETITIONS

A. Claim Number/Length and Downing’s Newly-Alleged Priority-Related Dispute Require Multiple Petitions

As the Board has recognized, “there may be circumstances in which more than

one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references.” *See* PTAB Consolidated Trial Practice Guide (“TPG”) (November 2019) at 59.

This is such a circumstance. First, Downing has asserted eighteen claims from the ’779 Patent against IWS in co-pending litigation in the United States District Court for the District of Colorado (“the Litigation”) (Ex. 1046), and those claims are lengthy, resulting in significant word count. In fact, the claims alone take up 1,740 words of the 14,000-word limit. Second, there also is a dispute relating to priority date requiring arguments under multiple prior art references. Prior to filing Petition 1, when asked in the Litigation to identify ’779’s priority date, Downing refused¹, stating it would first need to see IWS’s invalidity contentions. Ex. 1014, 5-7. IWS therefore filed Petition 1 based on and including a necessarily detailed discussion

¹ IWS objected to Downing’s refusal to provide such information, citing various cases including *Vehicle Interface Techs., LLC v. Jaguar Land Rover N. Am., LLC*, C.A. No. 12-1285-RGA, D.I. 25, 21:19-22 (D. Del., Jun 17, 2013) (“to the extent that any of [plaintiff’s interrogatory] answers depends on the idea that you don’t have to provide the [priority date] information now, because [defendants] haven’t provided invalidity contentions, I reject that.”).

regarding the earliest possible priority date determined from support in the '779's extensive family² of applications: May 17, 2021. *See* Ex. 1042, Section IX. Just that discussion took up 1,030 words. Thus, the claim language and the priority discussion alone (2,770 words) took up nearly 20% of Petition 1's 14,000-word limit.

After receiving IWS's invalidity contentions and after Petition 1 was filed, Downing supplemented its interrogatory answer regarding priority (Ex. 1040), stating that the earliest effective filing date was May 17, 2021, while asserting for the first time that Downing allegedly disclosed the invention claimed in '770 on September 1, 2020, which would "remove" various references as prior art. Then, on January 19, 2024, in response to IWS's invalidity contentions (Ex. 1039 at 9-10) Downing alleged for the first time that the subject matter of *Krupa* (a primary reference in Petition 1 (Ex. 1003)) was derived from that alleged September 2020 disclosure and that *Krupa* therefore falls under one or more exceptions of 35 U.S.C. § 102(b)(2)(A) and/or (B) and does not qualify as prior art.

Because of Downing's recent allegations relating to *Krupa*, of which IWS was not aware prior to filing Petition 1, IWS submits Petition 2 to present additional Grounds of '779's unpatentability that do not include *Krupa*. Petition 2's Grounds

² '779 claims priority to Provisional Application No. 63/189,663, filed May 17, 2021, as well as seven non-provisional and nine other provisional applications.

could not be presented in Petition 1 due to the IPR petition word limit. Had IWS been aware of Downing's public disclosure/derivation assertions before filing Petition 1, *e.g.*, when Downing was first asked about priority, Petition 1 could have included grounds from Petition 2 instead of *Krupa*-based grounds.

B. The Petitions are Materially Different from Each Other and Efficiently Address the Validity of the '779 Patent

Although in most situations, “one petition should be sufficient to challenge the claims of a patent” (TPG at 59), here information relevant to priority of the challenged patent and availability of prior art was not revealed until after filing of a first IPR petition—Petitioner should be allowed to present grounds that could not otherwise be presented due to IPR petition word limits. As it is Petitioner's burden to establish unpatentability of the challenged claims, Petitioner should be able to rely on the most relevant prior art references for a given priority/disclosure date.

Here, the petitions are materially different. While both address all Challenged Claims, IPR2024-00256 and IPR2024-00583 present different grounds (*see* Section II table, *infra*). Additionally, it would be efficient to institute both petitions because while not filed simultaneously, they are filed close enough in time and prior to the patent owner's preliminary response in IPR2024-00256, such that the two IPRs can be consolidated, significantly lowering the burden on the parties and the Board.

C. The Petitions Do Not Constitute an Abuse of Process

IWS's two petitions are the only petitions filed by anyone challenging the '779 Patent. As noted above, mapping the lengthy and numerous claims based on prior art considering the priority and alleged public disclosure issues requires extensive discussion, and instituting review on both petitions will allow the efficient consideration of all applicable grounds against all challenged claims. Both petitions are also filed prior to any preliminary response. There is no abuse of process.

II. ORDERING OF THE PETITIONS

Petitioner requests the Board consider the petitions in the following order and not exercise its discretion to deny either:

Rank	Petition	Challenged Claims	Numbered Grounds
1	IPR2024-00256	All	(1) & (2) <i>Krupa</i> (Anticipation)/(Obviousness)
		All	(3) <i>Kajaria</i> in view of <i>Jackson</i>
		All	(4) <i>Krupa</i> in view of <i>Jackson</i>
		All	(5) <i>Kajaria</i> in view of <i>Jackson</i> and <i>Martino</i>
2	IPR2024-00583	1-3, 6, 15, 16, 18, 36	(1) <i>Ciezobka</i> (Anticipation)
		All	(2) <i>Ciezobka</i> (Obviousness)
		6, 8-10, 13, 16-18, 25-28, 31	(3) <i>Ciezobka</i> in view of <i>McNeel</i>
		All	(4) <i>Beuterbaugh</i> in view of <i>Jackson</i>

Dated: March 1, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(a), the undersigned hereby certifies that on March 1, 2024, a true and correct copy of the foregoing **Petitioner's Reasons for Parallel Petitions and Petition Ranking** and copies of all supporting materials and exhibits was served by Federal Express on the following correspondence address of record as listed on USPTO's Patent Center (formerly PAIR):

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Pursuant to 37 C.F.R. § 42.105(a), the undersigned hereby certifies that on March 1, 2024, a true and correct copy of the foregoing **Petitioner's Reasons for Parallel Petitions and Petition Ranking** and copies of all supporting exhibits was served by Federal Express on the Patent Owner at the following address known to the Petitioner as likely to effect service:

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