UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INTELLIGENT WELLHEAD SYSTEMS, INC.,
*Petitioner*,

v.

DOWNING WELLHEAD EQUIPMENT, LLC
*Patent Owner*

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IPR2024-00583
Patent No. 11,401,779

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**PETITIONER'S AMENDED MANDATORY NOTICES PURSUANT TO 37 C.F.R. § 42.8**

## PETITIONER'S AMENDED MANDATORY NOTICES

Pursuant to 37 C.F.R. § 42.8, Petitioner, Intelligent Wellhead Systems, Inc. ("Petitioner"), submits the following amended mandatory notices in connection with the above-captioned *inter partes* review proceeding concerning United States Patent No. 11,401,779 (the '779 Patent).

## REAL PARTIES IN INTEREST

Pursuant to 37 C.F.R. § 42.8(b)(1), Petitioner identifies Intelligent Wellhead Systems, Corp., IWS USA Corp., and Pason Systems Corp. as real parties-in-interest.

## RELATED MATTERS

Pursuant to 37 C.F.R. § 42.8(b)(2), as of the filing date of this notice, related matters are:

### A. Litigations Involving the Patent-at-Issue

The following matters would affect, or be affected by, a decision in this proceeding regarding the '779 Patent:

1. *Downing Wellhead Equipment, LLC v. Intelligent Wellhead Systems, Inc., et al.*, No. 1:23-cv-01180-RMR-SP, in the United States District Court for the District of Colorado.

a. Downing asserted the Challenged Claims against Petitioner, Intelligent Wellhead Systems, Corp., and IWS USA Corp., in *Downing Wellhead Equipment, LLC v. Intelligent Wellhead Systems, Inc., et al.*, No. 1:23-cv-01180-RMR-SP (D. Colo.) ("the Litigation"). Ex. 1007, 1046.

b. The Litigation is in its early stages. Claim construction has not occurred, a claim construction hearing has not been set, and, as of February 14, 2024, all claim construction briefing deadlines have been stayed. A trial date has not been set.

c. On February 14, 2024, the district court stayed the Litigation pending the Patent Trial and Appeal Board's institution decisions in related IPR2024-00256 and IPR2024-00300 ("related IPRs"). Ex. 1045, 1042, 1043. ECF No. 65. The stay affects all deadlines and litigation activities with the exception of allowing either side to conduct third-party discovery relating to *Krupa* (U.S. 2022/0268141, Ex. 1003) as prior art. *Id.* at 22. The parties submitted a joint status report to the court on June 17, 2024. ECF No. 69. Neither party has sought, nor has the court entered *sua sponte*, a lift of the stay.

2. *Intelligent Wellhead Systems, Inc. v. Downing Wellhead Equipment, LLC*, Case No. IPR2024-00256, before the Patent Trial and Appeal Board, involving U.S. Patent No. 11,401,779, which is the parent to the '770 Patent (the patent challenged in this IPR). On June 5, 2024, the Patent Trial and Appeal Board denied institution. Paper 11.

3. *Intelligent Wellhead Systems, Inc. v. Downing Wellhead Equipment, LLC,* Case No. IPR2024-00300, before the Patent Trial and Appeal Board, involving U.S. Patent No. 11,560,770, which is a continuation of the '779 Patent (the patent challenged in this IPR). On June 10, 2024, the Patent Trial and Appeal Board granted institution. Paper 10.

4. *Intelligent Wellhead Systems, Inc. v. Downing Wellhead Equipment, LLC*, Case No. IPR2024-00584, before the Patent Trial and Appeal Board, involving U.S. Patent No. 11,401,770. The petition in IPR2024-00584 was filed on March 1, 2024, Downing filed a preliminary response on June 17, 2024, and the Board's decision on institution is expected to issue on or before September 17, 2024.

## LEAD AND BACK-UP COUNSEL

Pursuant to 37 C.F.R. § 42.8(b)(3), Petitioner designates the following Lead and Back-up Counsel:

| Lead Counsel: | Backup Counsel: |
|---|---|
| Tammy J. Terry (Reg. No. 69,167)<br>**OSHA BERGMAN WATANABE & BURTON LLP**<br>1100 Louisiana Street, Suite 4900<br>Houston, TX 77002<br>Tel. 713.228.8600 \| Fax. 713.228.8778<br>Email: terry@obwb.com | Lisa E. Margonis (Reg. No. 57,123)<br>Califf T. Cooper (*Pro Hac Vice* to be requested)<br>Laura J. Witbeck (Reg. No. 59,766)<br>Peter C. Schechter (Reg. No. 31,662)<br>**OSHA BERGMAN WATANABE & BURTON LLP**<br>1100 Louisiana Street, Houston, TX 77002<br>Tel. 713.228.8600 \| Fax. 713.228.8778<br>Emails:<br>margonis@obwb.com;<br>cooper@obwb.com;<br>witbeck@obwb.com;<br>schechter@obwb.com; and,<br>OBWB-IWS-Downing@obwb.com |

## SERVICE INFORMATION

Pursuant to 37 C.F.R. § 42.8(b)(4), Petitioner directs that papers concerning this matter should be served on Lead and Back-up counsel. Petitioner consents to service by email at OBWB-IWS-Downing@obwb.com.

## PAYMENT OF FEES BY DEPOSIT ACCOUNT

The Patent Trial and Appeal Board is authorized to charge any fees payable by Petitioner associated with IPR2024-00583 to Deposit Account 50-0591.

Dated: June 26, 2024

Respectfully submitted,

*/Tammy J. Terry/*
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***Counsel for Petitioner Intelligent Wellhead Systems, Inc.***

## CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that a true and correct copy of the foregoing Petitioner's Amended Mandatory Notices was served on June 26, 2024, via email to counsel for Patent Owner at the following:

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