UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIBERTY ENERGY, INC. AND LIBERTY OILFIELD SERVICES LLC,
Petitioners,

v.

U.S. WELL SERVICES, LLC,
Patent Owner.

IPR2025-00031
U.S. Patent No. 10,655,435

PATENT OWNER'S PRELIMINARY SUR-REPLY TO PETITIONER'S PRELIMINARY REPLY

TABLE OF AUTHORITIES

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Cases

Apple Inc. v. Fintiv Inc.,
IPR2020-00019, Paper 11 (PTAB March 20, 2020) 1, 2, 3

Corning Optical Comm'ns LLC v. Dali Wireless v,
IPR2021-00762, Paper 8 (PTAB Oct. 13, 2021) 3

Kia Corp. et al. v. Emerging Automotive LLC,
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Samsung Electronics Co., *LTD et al. v. Empire Tech Dev. LLC*,
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Statutes

35 U.S.C. § 314 1

PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	U.S. Pat. Pub. No. 2017/0226842, Gregoire Omont et al., "Monitoring Health of Additive Systems" ("Omont842"), PCT application filed July 31, 2015, published Aug. 10, 2017.
2002	*Threshold*, Merriam-Webster.com, https://www.merriam-webster.com/dictionary/threshold (last visited Jan. 22, 2025) (defining *threshold* as "a level, point, or value above which something is true or will take place and below which it is not or will not").
2003	*Threshold*, CollinsDictionary.com, https://www.collinsdictionary.com/us/dictionary/english/threshold (last visited Jan. 22, 2025) (defining *threshold* as "an amount, level, or limit on a scale," and explaining that "[w]hen a threshold is reached, something else happens or changes").
2004	*Threshold*, Britannica.com, https://www.britannica.com/dictionary/threshold (last visited Jan. 22, 2025) (defining *threshold* as "the point or level at which something begins or changes," and illustrating usage with example that "sounds that are above/below the threshold of hearing" are "sounds that are too high/low to be heard").
2005	*Rate*, Merriam-Webster.com, https://www.merriam-webster.com/dictionary/rate (last visited Jan. 22, 2025) (defining *rate* as a "quantity, amount, or degree of something measured per unit of something else").
2006	Patent Case Scheduling Order, *U.S. Well Services, LLC, et al v. Liberty Energy, Inc.*, et al, 4:2-cv-008939-KPE (S.D. Tex.), ECF No. 30.
2007	Petitioner's Invalidity Contentions Cover Pleading, *U.S. Well Services, LLC, et al v. Liberty Energy, Inc.*, et al, 4:2-cv-008939-KPE (S.D. Tex.).
2008 (new)	USPTO Announcement Rescinding Memorandum Addressing Discretionary Denial Procedures and Accompanying Memorandum

Patent Owner explained how all *Fintiv* factors either favor denial of institution or are neutral. POPR at 47–50. In its reply, Petitioner primarily relies on USPTO guidance that has been rescinded. Although Petitioner agreed to a *Sotera* Stipulation, that is no longer controlling and is not enough to overcome the other factors. Because all factors when considered holistically support denying institution, Patent Owner requests that Board do so under 35 U.S.C. § 314.

Factor 1: Petitioner now "intends" to file a motion to stay but has not yet done so. As such, it remains purely speculative whether a stay motion will be filed and accordingly Factor 1 weighs in favor of denying institution or, alternatively, is at best neutral.

Factor 2: Patent Owner acknowledges that while the *Markman* hearing was recently rescheduled, the February 2, 2026, trial date still stands. *See* EX-2006, 4. Petitioner argues that the subsequent case deadlines are keyed off the *Markman* ruling, Reply at 1, but the schedule allows for these deadlines to move without affecting the close of fact discovery and service of opening expert reports. *See* EX-2006, 3. Petitioner needs the entire case schedule to slip by nearly three months just to have a chance that the Board's final decision will occur before the trial date. *See Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper No. 11 at 9 (PTAB March 20, 2020) (precedential) ("If the court's trial date is earlier than the projected statutory deadline, the Board generally has weighed this factor in favor of authority to deny

institution under *NHK*."). But Petitioner cites no evidence suggesting that the Court will delay trial by any significant degree. *See* EX-1029. Finally, Petitioner's argument about current time-to-trial statistics is predicated on rescinded guidance. EX-2008, 4 (rescinding guidance stating "the PTAB will consider the median time from filing to disposition of the civil trial for the district in which the parallel litigation resides."). Given that the currently scheduled trial date is nearly three months before the Board issues its FWD, this factor weighs in favor of denying institution.

Factor 3: Petitioner's reply rehashes many of the same arguments that it presented in its Petition. Once the Court reschedules the *Markman* hearing, it anticipates issuing a ruling "within 6 weeks after the Markman hearing." *See* EX-2006, 3. By the time the Board issues an institution decision, the parties will have already invested significant time and resources in the district court to favor denial. Similarly, the Court will have invested significant resources in hearing oral argument at *Markman* and preparing a claim construction order. *Fintiv*, at 10 (describing sufficient time invested in parallel proceedings favors denial when district court issues a claim construction order.).

Petitioner's arguments do not address the significant resources that the parties and the Court will have undertaken by the time the Board decides whether to institute. Instead, Petitioner focuses on its alleged diligence in filing a petition.

Reply at 2. But, even if true, that does not negate the significant resources invested by the Parties or the Court, as shown by the inapposite cases cited in Petitioner's reply. *Corning Optical Comm'ns LLC v. Dali Wireless v*, IPR2021-00762, Paper 8 at 9–10 (PTAB Oct. 13, 2021) (noting "no Markman hearing was necessary," so the record did not show that "the district court's investment" had "been substantial"; *Sotera Wireless, Inc., v. Masimo Corp.*, IPR2020-01019, Paper 12 at 13, 17 (PTAB Dec. 12, 2020) (noting all *Markman* deadlines were vacated, including the hearing, and Petitioner had a good excuse for its belated filing because it faced a "large number of patents and claims challenged" resulting in "the increased difficulty in preparing the Petitions due to concurrent office closures" due to the COVID pandemic); *Kia Corp. et al. v. Emerging Automotive LLC*, IPR2024-01167, Paper 14 at 14; *Samsung Electronics Co., LTD et al. v. Empire Tech Dev. LLC*, IPR2024-00896, Paper 15 at 10 (both applying rescinded "*Fintiv* Guidance").

Given the above, this factor is either neutral or weighs in favor of denial.

Factor 4: Relying on the rescinded Guidance, *see* EX-2008, Petitioner offered a *Sotera* Stipulation in its Reply. *See* Reply at 3. Although this stipulation means Factor 4 weighs in favor of institution, this alone is now no longer enough. *See* EX-2008, 4 (rescinding guidance stating "the PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner

presents a [Sotera] stipulation."); *see id*, 8-9.

Factor 5: Petitioner and Patent Owner are the same parties in the related district court litigation. Reply at 3. Factor 5 also supports denying institution.

Factor 6: Petitioner's attempts to fix the Petition's deficiencies are meritless.

First, Petitioner argues that it is clear that a threshold comparison is both disclosed in and obvious over Norris despite none of its cited evidence mentioning a threshold or limit. Even if Norris did so, as pointed out in the POPR, Petitioner's reply never addresses the irreconcilable difference between a "desired" threshold and the claimed "acceptable" threshold. *See* POPR at 19–22.

Second, for Ground 3, Petitioner's argument about Omont's "broad teachings" cannot be reconciled with the Petition's specific mapping to Omont's system, *see* Pet. 48–51, and shows that Petitioner cannot address the intrinsic record of what Omont discloses, and how the Examiner considered the same exact disclosures. Ground 3 also does not rely on Norris for limitation 1[e][i], nor provide a sufficient unpatentability explanation using Norris. *See* Pet. 42–43.

Finally, Patent Owner did not misread the Petition. Petitioner appears to argue that it mapped the claimed "first parameter" to "other pump parameters." *See* Pet. 67; POPR at 43–44. Even if true (it's not), these other pump parameters are not the same parameter used in a comparison in step 1[e][ii]. *See id*.

Factor 6 thus weighs in favor of denying institution.

Dated: March 7, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 7th day of March, 2025, I caused to be served a true and correct copy of the foregoing "Patent Owner's Preliminary Sur-Reply" and accompanying exhibit by electronic mail on the following:

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