From: Director_PTABDecision_Review
To: Walters, Chad
Cc: Ferguson, Brian E.; Border, Scott; Quarles, Rick; McDonald, Jacob; DL Liberty v US Well Services IPRs
Subject: RE: Request to File Director Review Requests in IPR2025-00031 and IPR2025-00139
Date: Monday, October 20, 2025 2:11:00 PM
Attachments: image001.png

Counsel,

Patent Owner request for authorization to submit new Requests for Director Review in the above identified proceedings is denied.

Thank you.

From: Walters, Chad <chad.walters@bakerbotts.com>
Sent: Tuesday, October 7, 2025 10:24 PM
To: Director_PTABDecision_Review <Director_PTABDecision_Review@uspto.gov>
Cc: Ferguson, Brian E. <BEFerguson@winston.com>; Border, Scott <SBorder@winston.com>; Quarles, Rick <RQuarles@winston.com>; McDonald, Jacob <jacob.mcdonald@bakerbotts.com>; DL Liberty v US Well Services IPRs <DLLibertyvUSWellServicesIPRs@BakerBotts.com>
Subject: RE: Request to File Director Review Requests in IPR2025-00031 and IPR2025-00139

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Dear Honorable Director Squires,

We are counsel to Petitioners Liberty Energy, Inc. and Liberty Oilfield Services LLC (collectively, "Liberty") in the above-referenced IPRs. Petitioners oppose Patent Owner's request to submit new Requests for Director Review.

The litigation report alleged by Patent Owner to violate the *Sotera* stipulation is a report from a third party expert engaged by the defendants to analyze the patents at issue. The report includes a number of potential invalidity positions, some of which the expert included for background and for completeness.

Liberty fully intends to comply with its *Sotera* stipulation. Notably, while the *Sotera* stipulation applies to defenses in the district court action, Patent Owner did not attempt to contact either Petitioners' litigation counsel or the district court to initially raise the issue. In fact, Petitioners only learned that Patent Owner had an issue with the expert report because it copied Petitioners' counsel on its email below to Director Squires.

Hours after receiving Patent Owner's email to Director Squires, Petitioners' litigation counsel sent the attached correspondence to Patent Owner's counsel confirming Petitioners' intent to comply with the *Sotera* stipulation and making clear that it does not intend to pursue an invalidity defense in the S.D. Tex. action based on a number of specific invalidity grounds that were included in the report.

Petitioners' litigation counsel also offered to further discuss these issues with Patent Owner's counsel if helpful.

There has not been a violation of the stipulation. This is an issue best addressed in the current stage of the litigation, and Petitioners believe no additional Director Review requests are warranted in connection with the IPRs.

Respectfully,

Chad Walters
Lead Counsel for Petitioners

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From: Ferguson, Brian E. <BEFerguson@winston.com>
Sent: Tuesday, October 7, 2025 11:28 AM
To: Director_PTABDecision_Review <director_ptabdecision_review@uspto.gov>
Cc: Border, Scott <SBorder@winston.com>; Quarles, Rick <RQuarles@winston.com>; Walters, Chad <chad.walters@bakerbotts.com>; McDonald, Jacob <jacob.mcdonald@bakerbotts.com>; DL Liberty v US Well Services IPRs <DLLibertyvUSWellServicesIPRs@BakerBotts.com>
Subject: Request to File Director Review Requests in IPR2025-00031 and IPR2025-00139

[EXTERNAL EMAIL]

Dear Honorable Director Squires:

We are counsel to Patent Owner U.S. Well Services, LLC in IPR proceedings identified as IPR2025-00031 and IPR2025-00139 (the "Proceedings"). We are writing to request that the Director allow Patent Owner to submit new Requests for Director Review in the Proceedings. Patent Owner submits that new evidence has come to light that impacts the Board's decision to institute trial in the Proceedings. This new evidence presents an important issue of first impression that Patent Owner respectfully submits warrants the Director's consideration.

As background, Patent Owner sued Petitioners Liberty Energy, Inc. and Liberty Oilfield Services LLC (collectively, "Petitioners") in the Southern District of Texas for infringement of several patents, including the two patents at issue in the Proceedings (U.S. Patent Nos. 10,655,435 and 11,208,878, respectively). Petitioners thereafter filed the IPR petitions that are the basis of the Proceedings. In both Proceedings, Patent Owner argued in the Patent Owner Preliminary Responses that the Board should deny institution on discretionary grounds based on the parallel Texas litigation, under the Board's precedential *Fintiv* guidance.

In their reply briefs, Petitioners included the following stipulation: "if the Board institutes IPR in this proceeding on the grounds presented in the Petition, Petitioners will not pursue an invalidity defense in the district court action (C.A. No. 4:24-cv-00839) that the patent claims subject to the instituted IPR are invalid based on the grounds that were raised or any grounds Petitioners reasonably could have raised in the IPR." Petitioners argued that based on these stipulations, "*Fintiv* factor 4 weighs 'strongly in favor' of not exercising discretion to deny institution. *See Sotera Wireless, Inc. v. Masimo Corp*., IPR2020-01019, Paper 12, 18-19 (PTAB Dec. 1, 2020) (precedential as to § II.A)." *See* IPR2025-00031, Paper 7 at 3; IPR2025-00139, Paper 7 at 3.

The Board instituted trial in both Proceedings. In doing so, the Board relied heavily on Petitioners' *Sotera* stipulations in rejecting Patent Owner's request for discretionary denial, stating that "*Fintiv* factor 4 weighs in favor of not exercising discretion to deny institution, because Petitioner's *Sotera* stipulation mitigates concerns of duplicative efforts and potentially conflicting decisions." IPR2025-00031, Paper 9 at 16; *see also* IPR2025-00139, Paper 14 at 14 ("Petitioner's stipulation is similar to that provided in *Sotera Wireless, Inc. v. Masimo Corp*., IPR2020-01019, Paper 12, 18–19 (PTAB Dec. 1, 2020) (precedential in relevant part), which was found to obviate much, if not all, of any potential overlap between the issues in the proceeding and the district court proceeding…. Accordingly, the facts underlying this factor weigh strongly against exercising our discretion to deny institution.").

Patent Owner requested Director Review of both Institution Decisions, which the then-Acting Director denied without analysis. *See* IPR2025-00031, Paper 17; IPR2025-00139, Paper 19. The Proceedings are thus on-going, with Final Written Decisions due in IPR2025-0031 by April 29, 2026, and in IPR2025-00139 by June 11, 2026.

In the Texas litigation, Petitioners on September 18, 2025, served their invalidity Expert Report. The Expert Report violates the *Sotera* stipulations by pursuing grounds that are explicitly the same as the grounds in the Proceedings, as well as grounds that "reasonably could have" been raised in the Proceedings. Thus, Petitioners represented to the Board one thing to convince the Board to institute the Proceedings and have now violated that representation by doing in the litigation what Petitioners told the Board they would not do—pursuing in the litigation the same grounds as in the Proceedings and grounds that reasonably could have been raised in the Proceedings.

To Patent Owner's knowledge, no Director has expressly addressed what should happen if a Petitioner violates a *Sotera* Stipulation that the Board relied on in instituting a proceeding. Patent Owner submits that such violations undermine the integrity of PTAB proceedings, and the Director may in his discretion terminate these proceedings for such violations. *See*, e.g., *Interactive Communications Int'l, Inc. v. Blackhawk Network Inc*., IPR2024-00465, Paper 39 (Director Decision Oct. 1, 2025) (granting Director Review and exercising discretion to terminate the proceeding based on inconsistent expert testimony); 37 C.F.R. § 42.12 (stating that the Board may dismiss a proceeding for, *inter alia*, "misrepresentation of a fact").

As explained above, Patent Owner previously submitted timely Requests for Director Review of the Institution Decisions in the proceedings, which were denied. Patent Owner therefore respectfully requests that, given the circumstances here where Petitioners only recently violated the *Sotera* stipulations, the Director allow Patent Owner to file new Requests for Director Review to bring to light the new evidence showing violation of the *Sotera* Stipulations and to allow the Director to address this important matter of first impression. *See* https://www.uspto.gov/patents/ptab/decisions/director-review-process at 2.E (holding that "[s]ubject to authorization by the Director, which may be requested by submitting an email to Director_PTABDecision_Review@uspto.gov, the submission of new evidence or arguments may be warranted in cases addressing issues of first impression or issues involving intervening changes in the law or USPTO procedures, guidance, or decisions").

Counsel for Petitioners are copied on this email.

Respectfully submitted,

Brian E. Ferguson
Lead Counsel for Patent Owner

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