

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.

IPR2025-00139
U.S. Patent No. 11,208,878

PATENT OWNER'S SUR-REPLY TO PETITIONERS' REPLY

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I. INTRODUCTION

In response to Petitioners' reply ("Reply") (Paper No. 7) to Patent Owner's preliminary response ("POPR") (Paper No. 6), Patent Owner ("PO") respectfully submits that the *Fintiv* factors strongly favor discretionary denial, shown below.

II. THE *FINTIV* FACTORS FAVOR DISCRETIONARY DENIAL

Factor 1: Petitioners moved for a stay (EX-1045) but admit that "the Board has declined to speculate whether the district court would grant a stay." Reply at 1. The Court has not granted—and indeed may not grant—a stay. Moreover, the Board recently terminated one of the IPR proceedings mentioned in Liberty's motion to stay as prematurely filed. *Compare Liberty Energy Inc., et al. v. U.S. Well Services, LLC*, IPR2025-00105, Paper 7 (PTAB Apr. 8, 2025), with EX-1045, 3–4 (listing IPR2025-00105). Although Liberty recently filed another IPR petition challenging the same patent, *see Liberty Energy Inc., et al. v. U.S. Well Services, LLC*, IPR2025-00778, Paper 1 (PTAB Mar. 28, 2025), it is unclear how the Court will treat Liberty's mistake requiring it to file another IPR, which affects the issues in its stay motion. This factor either is neutral or weighs slightly in favor of denial, given the potential for the district court to deny a stay.

Factor 2: Trial in the related district court proceeding has been scheduled for February 2, 2026. EX-2003, 4. The *Markman* hearing has been rescheduled to April 30, 2025, EX-1046, and the Court's decision on claim construction is due six

weeks later on June 11, *see* EX-2003, 3. Importantly, the trial date remains unchanged. If the Board issues its institution decision in June 2025, the statutory deadline for the final written decision will be June 2026—four months after the scheduled trial date. Even assuming a day-for-day slip in schedule due to the rescheduled *Markman* hearing—despite the scheduled February 2, 2026 trial date to the contrary—the Board's final written decision would still be two months after the scheduled trial date. *See Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11, at 9 (PTAB Mar. 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*.”). *Fintiv* factor 2 favors denial.

Factor 3: Petitioners' Reply rehashes many of the same arguments that they presented in their Petition. The *Markman* hearing is scheduled for April 30, 2025, EX-1046, and the Court anticipates issuing a ruling by June 11. EX-2003, 3. By the time the Board issues an institution decision (estimated no later than June 16), the parties and the Court will have invested significant resources in briefing and participating in a *Markman* hearing, along with preparing a claim construction order. *Fintiv*, at 10 (finding that significant time invested in parallel proceedings favors denial when district court issues a claim construction order).

Petitioners fail to address these significant expended resources but instead focus on their 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 Petitioners' Reply. *Corning Optical Commc'ns LLC v. Dali Wireless, Inc.*, 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) (excusing petitioner 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); *Samsung Elecs. Co. v. Harbor Island Dynamic, LLC*, IPR2024-01405, Paper 9, at 35–36 (PTAB Mar. 24, 2025) (*Markman* hearing scheduled for four months after institution decision; incomparable case investment factors); *Kia Corp. v. Emerging Automotive LLC*, IPR2024-01167, Paper 14, at 14 (PTAB Jan. 27, 2025) (applying rescinded “*Fintiv* Guidance”). This factor is neutral or weighs in favor of denial.

Factor 4: Petitioners offered a *Sotera* stipulation. *See* Reply at 3. But a *Sotera* stipulation is no longer enough to escape discretionary denial. *Motorola Sols. v. Stellar, LLC*, IPR2024-01205, Paper 19, *on director review* (Mar. 28, 2025) (vacating decision granting institution and denying institution and holding *Sotera* stipulation did not outweigh the substantial investment in parallel proceedings).

Factor 5: Petitioners admit factor 5 favors discretionary denial. Reply at 3.

Factor 6: Petitioners' arguments emphasize the problems with the Petition.

Petitioners argue that their petition did not lack particularity, but their Reply arguments highlight the confusion that PO and the Board face in how the Petition addressed the challenged claims. *Compare* Pet. at 30 (“Morris and Oehring IV both teach a VFD connected to and controlling an electric motor’s speed. . .”) *with* Reply at 5 (“The Board should ignore PO’s arguments that Morris alone does not disclose a VFD (POPR, 15–18), because the Petition relies on combining Morris and Oehring IV to teach this claim element.”). Picking and choosing disclosures from multiple references makes the Petition unclear as to which prior art discloses or renders obvious the challenged claim, such as whether Morris teaches the claimed VFD, *see* POPR at 13–18. This lack of particularity requires PO and the Board to address every potential prior art combination.

Petitioners cannot distinguish their Petition from *Adaptics* (IPR2018-01596, Paper 20 (PTAB Mar. 6, 2019)) because it includes the similar “catch-all” grounds that conflate the rationale from multiple Grounds. Nine Grounds (Grounds 6B through 10B) are addressed in fewer than four pages with each Ground incorporating the reasoning of multiple previous grounds. Pet. at 73–76. In *Samsung*, six grounds in the Petition “lacked particularity” and it was noted that the Petitioner was limited only to Grounds properly presented in the Petition. *Samsung Elecs. et al. v. Resonant Sys., Inc.*, IPR2023-00993, Paper 17 at 28–29

(PTAB Jan. 10, 2024). Unlike in *Samsung*, the Petition's Grounds 6B through 10B are almost half of the total 20 Grounds, and the remaining grounds are not pled with particularity (as they were in *Samsung*, *see id.*) as they pick and choose disclosures among multiple references to satisfy the challenged claims. *Cf. id.* Denial is appropriate because Liberty's Petition is more like the *Adaptics* petition than *Samsung's* petition.

Petitioners' remaining arguments about their purported combination are flawed for two reasons. First, the Petition's purported rationale (Reply at 5) to combine the prior art is nowhere in the expert declaration. Dr. Durham's declaration never mentions the terms "varying electrical loads" or "varying loads." *See generally* EX-1003. Second, the Petition provides no reason why such varying loads would have motivated a POSITA to use VFD in Morris' system. Pet. at 22 (stating only "[a] POSITA would have known to use VFDs, as taught in Oehring IV, to control motor speeds in Morris for varying loads."). As argued in the POPR, the Petition's statement addresses only that a POSITA could have used a VFD—which "at best, merely posits that a skilled artisan could have modified" the prior art without explaining why. *AT&T Servs. v. Innovative Sonic*, IPR2024-01143, Paper 15 at 37–38 (PTAB Feb. 11, 2025) (denying institution for same). Without supporting expert testimony, let alone a sufficient explanation, Petitioner's purported motivation to combine is flawed.

Dated: April 21, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 21st day of April, 2025, I caused to be served a true and correct copy of the foregoing "Patent Owner's Sur-Reply to Petitioners' Reply" and accompanying exhibits by electronic mail on the following:

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