

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FULL-METAL-POWER B.V.,
Petitioner,

v.

INFOCUS DOWNHOLE SOLUTIONS USA LLC,
Patent Owner.

Case IPR2025-00391
Patent No. 10,676,992

**PATENT OWNER INFOCUS DOWNHOLE SOLUTIONS USA LLC'S
REQUEST FOR DISCRETIONARY DENIAL**

TABLE OF CONTENTS

I.	STATEMENT OF THE PRECISE RELIEF REQUESTED.....	1
II.	FACTUAL BACKGROUND.....	1
III.	LEGAL STANDARD.....	2
IV.	DISCRETIONARY DENIAL IS PROPER UNDER <i>FINTIV</i>	3
A.	<i>Fintiv</i> Factor 1: The district court has not granted a stay, nor has any party requested one.....	3
B.	<i>Fintiv</i> Factor 2: The District Court Litigation’s trial date is earlier.....	4
C.	<i>Fintiv</i> Factor 3: The parties have invested resources in the District Court Litigation.	5
D.	<i>Fintiv</i> Factor 4: The Petition and District Court Litigation invalidity contentions are nearly identical.	6
E.	<i>Fintiv</i> Factor 5: Petitioner is a defendant in the District Court Litigation.	7
F.	<i>Fintiv</i> Factor 6: The Petition is meritless.	7
V.	CONCLUSION	10

TABLE OF AUTHORITIES

Cases

<i>Apple v. Fintiv</i> , IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential) <i>passim</i>	
<i>Elbit Sys. of Am., LLC v. Thales Visionix, Inc.</i> , 881 F.3d 1354 (Fed. Cir. 2018)	9
<i>Harmonic Inc. v. Avid Tech., Inc.</i> , 815 F.3d 1356 (Fed. Cir. 2016)	2
<i>Icon Health & Fitness, Inc. v. Strava, Inc.</i> , 849 F.3d 1034 (Fed. Cir. 2017)	9
<i>In re Larson</i> , 340 F.2d 965 (C.C.P.A. 1965)	9
<i>In re Magnum Oil Tools Int’l, Ltd.</i> , 829 F.3d 1364 (Fed. Cir. 2016)	9
<i>In re Nuvasive, Inc.</i> , 842 F.3d 1376 (Fed. Cir. 2016)	9
<i>Mintz v. Dietz & Watson, Inc.</i> , 679 F.3d 1372 (Fed. Cir. 2012)	10
<i>NHK Spring Co. v. Intri-Plex Techs., Inc.</i> , IPR2018-00752, Paper 8 (P.T.A.B. Sept. 12, 2018) (precedential)	6
<i>Sand Revolution II LLC v. Cont’l Intermodal Grp. – Trucking LLC</i> , IPR2019-01393, Paper 24 at 7 (P.T.A.B. June 16, 2020) (informative)	3, 4, 7
<i>Stryker Corp v. Karl Storz Endoscopy-America, Inc.</i> , IPR 2015-00677, Paper 15 (P.T.A.B. Sept. 2, 2015)	9

Statutes

35 U.S.C. § 314	1, 2, 4
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Regulations

37 C.F.R. § 42.100	4, 10
37 C.F.R. § 42.107	4

EXHIBIT LIST

Exhibit	Description
1001	U.S. Patent No. 10,676,992 (“the ’992 Patent”)
1002	Amendment After Non-Final Rejection dated December 1, 2019, in Prosecution History of the ’992 Patent (“ROA”)
1003	Notice of Allowance, in Prosecution History of the ’992 Patent (“NOA”)
1004	CA2961629 – “the ’629 priority application”
1005	Chinese Patent Publication Number CN102501016A – Translated (“Zhilong”)
1006	Yang, F., Ren, T., Wang, H., Liu, B., & Chen, M. (2016). Analysis of Flow Field for Electrochemical Machining Metal Screw Pump Stator. <i>The International Journal of Advanced Manufacturing Technology</i> . https://doi.org/10.1007/s00170-016-9187-y ("Yang")
1007	U.S. Patent Application Publication No. 2010/0006342 (“Froehlich”)
1008	U.S. Patent Application Publication No. 2016/0168912 (“Mitchell”)
1009	U.S. Patent No. 9,976,227 (“Wangenheim”)
1010	Chinese Patent Publication Number CN201 I 21583Y - Translated (“Jinqi”)
1011	Chinese Patent Publication Number CN102139440A – Translated (“Jinglong”)
1012	Chinese Patent Publication Number CN102051016A – Untranslated
1013	Chinese Patent Publication Number CN201121583Y – Untranslated
1014	Chinese Patent Publication Number CN102139440A – Untranslated
1015	Affidavit for Translations of CN102501016A and CN102139440A
1016	Affidavit for Translation of CN201121583Y
2001	Declaration of Archibald Cruz in Support of Motion for Pro Hac Vice Admission
2002	Declaration of Archibald Cruz in Support of Request for Discretionary Denial
2003	Docket Control Order (ECF No. 27), <i>InFocus Downhole Solutions USA LLC v. Full-Metal Power B.V.</i> , No. 2:24-cv-00875 (E.D. Tex.)
2004	Defendants’ invalidity contentions, <i>InFocus Downhole Solutions USA LLC v. Full-Metal Power B.V.</i> , No. 2:24-cv-00875 (E.D. Tex.)
2005	File History of CA2985258

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 314(a), the memorandum on *Interim Processes for PTAB Workload Management* issued March 26, 2025 (the “Memorandum”), and the Notice Extending Deadline for Discretion Briefing issued March 28, 2025 (Paper 10), Patent Owner InFocus Downhole Solutions USA LLC (“Patent Owner”) respectfully requests that the Board exercise its discretion to deny institution of *inter partes* review (“IPR”) of U.S. Patent No. 10,676,992 (the “’992 Patent”).

II. FACTUAL BACKGROUND

On October 30, 2024, Patent Owner filed suit in the Eastern District of Texas for infringement of the ’992 Patent against Petitioner, among other defendants (the “District Court Litigation”). Ex. 2002 ¶ 3. The District Court Litigation continues to proceed without deviation from the court’s Docket Control Order. Ex. 2003. For instance, the District Court Litigation defendants, including Petitioner, served invalidity contentions on March 4, 2025. Ex. 2004. Pursuant to the Docket Control Order, the parties are on track for trial starting the week of June 22, 2026. Ex. 2003.

Meanwhile, Petitioner requested IPR on all claims of the ’992 Patent on December 27, 2024. Paper 1. The Petition uses most of the same references and asserts nearly identical grounds for unpatentability as in the District Court Litigation defendants’ invalidity contentions. *Compare* Paper 1 at 11–13 *with* Ex. 2004 at 1–7. The Notice of Filing Date Accorded issued on January 30, 2025. Paper 5.

III. LEGAL STANDARD

Institution is discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”) (citing 35 U.S.C. § 314(a)). Where, as here, there is a parallel, co-pending proceeding concerning the same patent, the Board considers the following factors articulated in *Apple Inc. v. Fintiv, Inc.*:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

IPR2020-00019, Paper 11 at 6 (P.T.A.B. Mar. 20, 2020) (precedential). For the reasons provided below, the *Fintiv* analysis supports denial of the Petition.

IV. DISCRETIONARY DENIAL IS PROPER UNDER *FINTIV*

Institution of the Petition would lead to duplicative efforts, unnecessary costs, and potentially inconsistent results—especially given the earlier trial date and significant overlap in issues. Because the *Fintiv* balancing test weighs in favor of denial, Patent Owner respectfully requests that the Board exercise its discretion to deny institution.

A. *Fintiv* Factor 1: The district court has not granted a stay, nor has any party requested one.

The first factor considers “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.” *Fintiv*, IPR2020-00019, Paper 11 at 6.

This factor is neutral. Petitioner stated that “[d]ue to the recency of the [District Court Litigation] filing, there has been no motion to stay” but claimed that “Petitioner will timely file in view of this IPR.” Paper 1 at 11 (filed December 27, 2024). Yet, in the four months since the filing of the Petition, no party has moved to stay the District Court Litigation, and the court has not entered a stay. Ex. 2002 ¶ 4. Further, whether the district court would grant a stay is speculative. *See Sand Revolution II LLC v. Cont’l Intermodal Grp. – Trucking LLC*, IPR2019-01393, Paper 24 at 7 (P.T.A.B. June 16, 2020) (informative) (“In the absence of specific evidence, we will not attempt to predict how the district court in the related district

court litigation will proceed because the court may determine whether or not to stay any individual case, including the related one, based on a variety of circumstances and facts beyond our control and to which the Board is not privy.”). Thus, this factor is neutral. *See id.*

B. *Fintiv* Factor 2: The District Court Litigation’s trial date is earlier.

The second factor addresses “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.” *Fintiv*, IPR2020-00019, Paper 11 at 6. “If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of” denial. *Id.* at 9.

This factor weighs in favor of discretionary denial. The trial date in the District Court Litigation is June 22, 2026. Ex. 2003. By contrast, given the Notice of Filing Date Accorded issued January 30, 2025 (Paper 5), the institution decision would be expected to issue no later than July 30, 2025. *See* 35 U.S.C. § 314(b) (setting the deadline for institution decision at three months after the patent owner’s preliminary response); 37 C.F.R. § 42.107(b) (setting the deadline for patent owner’s preliminary response at three months after the notice of filing date accorded). Thus, the projected deadline for a final written decision would be July 30, 2026—over a month after the trial in the District Court Litigation. *See* 37 C.F.R. § 42.100(c) (setting the deadline for a final written decision at one year after institution). Accordingly, given the significant overlap in issues between the Petition and the invalidity contentions

(discussed more under *Fintiv* factor 4, *infra*), these issues will likely be decided in the District Court Litigation *before* the final written decision is issued, incurring duplicative costs and potentially conflicting decisions.

C. *Fintiv* Factor 3: The parties have invested resources in the District Court Litigation.

The third factor considers “investment in the parallel proceeding by the court and the parties.” *Fintiv*, IPR2020-00019, Paper 11 at 6.

This factor is neutral. While the court has yet to substantively rule on the ’992 Patent, the parties and the court *have* invested resources in actively litigating this case. As of this writing, it has been about six months since the District Court Litigation began. Ex. 2002 ¶ 3 (suit filed October 30, 2024). In that time, the parties have followed the district court’s Docket Control Order, including exchanging infringement and invalidity contentions. *Id.* ¶¶ 4, 7; Ex. 2003. Additionally, a dismissal issue has been fully briefed; the parties exchanged discovery and disclosures pursuant to Eastern District of Texas practice; plaintiff has propounded interrogatories, to which one defendant has responded; and the court has reviewed and approved the parties’ negotiated Discovery Order, Protective Order, and E-Discovery Order. Ex. 2002 ¶¶ 6–9. Thus, the court and the parties have invested resources in the District Court Litigation.

D. *Fintiv* Factor 4: The Petition and District Court Litigation invalidity contentions are nearly identical.

The fourth factor looks at the “overlap between issues raised in the petition and in the parallel proceeding.” *Fintiv*, IPR2020-00019, Paper 11 at 6. Where a petition raises “substantially identical prior art arguments that were at issue in the district court,” the “concerns of inefficiency and the possibility of conflicting decisions were *particularly strong*.” *Id.* at 12 (citing *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (P.T.A.B. Sept. 12, 2018) (precedential)) (emphasis added).

Given the significant overlap in issues between the Petition and the invalidity contentions in the District Court Litigation, this factor weighs heavily in favor of discretionary denial. For instance, the Petition challenges all 19 claims of the ’992 Patent. Paper 1 at 11. The invalidity contentions challenge all but two claims of the ’992 Patent.¹ Ex. 2004. Similarly, *all seven* references used in the Petition are likewise used in the invalidity contentions. *Compare* Paper 1 at 60–61 *with* Ex. 2004 at 1–2 (sharing *Zhilong, Yang, Froehlich, Mitchell, Wangenheim, Jinqi, and Jinglong*). Further still, the grounds argued in the Petition mirror those in the

¹ Specifically, the two claims excluded from the invalidity contentions are the two claims that Patent Owner did *not* assert in district court. Ex. 2002 ¶ 10.

invalidity contentions. *Compare* Paper 1 at 12 (relying on *Zhilong* and *Froehlich* for Ground 1) *with* Ex. 2004 at 2 (same); Paper 1 at 12 (relying on *Yang* and *Jinqi* for Ground 4) *with* Ex. 2004 at 4 (same).²

In other words, the Petition and the invalidity contentions challenge nearly all the same claims, use most of the same prior art, and argue almost identical grounds for unpatentability. Accordingly, instituting this Petition would implicate the same “concerns of inefficiency and possibility of conflicting decisions” that *Fintiv* seeks to avoid. *See Fintiv*, IPR2020-00019, Paper 11 at 12–13.

E. *Fintiv* Factor 5: Petitioner is a defendant in the District Court Litigation.

The fifth factor considers “whether the petitioner and the defendant in the parallel proceeding are the same party.” *Fintiv*, IPR2020-00019, Paper 11 at 6. More specifically, if the petitioner is *unrelated* to a defendant, then the Board weighs this factor against denial. *Id.* at 13–14.

However, here, Petitioner *is* a defendant in the District Court Litigation. Thus, this factor weighs in favor of denial. *See Sand Revolution II*, Paper 24 at 12–13.

F. *Fintiv* Factor 6: The Petition is meritless.

The fifth factor asks if there are “other circumstances that impact the Board’s exercise of discretion, including the merits.” *Fintiv*, IPR2020-00019, Paper 11 at 6.

² The other grounds—Grounds 2, 3, 5, 6 and 7—concern only dependent claims.

“[I]f the merits of the grounds raised in the petition are a closer call, then that fact has favored denying institution when other factors favoring denial are present.” *Id.* at 15. This factor does not call for a full merits assessment at this stage, but the Board may consider “strengths or weaknesses regarding the merits” as part of the *Fintiv* analysis. *Id.* at 15–16.

Because the Petition lacks merit, this factor weighs in favor of discretionary denial.³ As an initial matter, Petitioner admits that “some of the prior art” used in the Petition were cited in prosecution history of the ’992 Patent. Paper 1 at 10. Petitioner argues that *Yang*—a primary reference used in over half of the Petition’s grounds—was not cited during the prosecution of the ’992 Patent. *Id.* While technically true, this overlooks the fact that it was considered during the prosecution of the corresponding Canadian patent (CA2985258). The prosecuting attorney disclosed *Yang* and requested that the examiner consider it along with the references cited in the prosecution of the ’992 Patent. Ex. 2005 at 247. Nevertheless, the application was allowed, and the patent issued. *Id.* at 170. Thus, the patentability of the claims

³ Pursuant to the Memorandum, the merits will be discussed in more detail in the Preliminary Response. Because a full merits analysis is unnecessary at this stage, this Brief identifies specific facial weaknesses of the Petition relevant to this factor.

has been upheld *notwithstanding* primary reference *Yang* and the Petition's other cited references.

Furthermore, the Petition notably lacks expert support for *any* of its contentions. It is well-settled that “attorney argument is not evidence.” *Elbit Sys. of Am., LLC v. Thales Visionix, Inc.*, 881 F.3d 1354, 1359 (Fed. Cir. 2018) (quoting *Icon Health & Fitness, Inc. v. Strava, Inc.*, 849 F.3d 1034, 1043 (Fed. Cir. 2017)). “To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016); *see also In re Nuvasive, Inc.*, 842 F.3d 1376, 1383 (Fed. Cir. 2016) (mere “conclusory statements” are “insufficient articulations of motivation to combine”).

Here, Petitioner argues that, even if *Zhilong* fails to disclose a stator “formed from a single integral block of material” as recited in the claims, it nevertheless “would be merely a matter of obvious engineering choice.” Paper 1 at 19 (quoting *In re Larson*, 340 F.2d 965, 968 (C.C.P.A. 1965)). Such a conclusory statement, without *any* other evidence to support it, deserves no weight. *See, e.g., Stryker Corp v. Karl Storz Endoscopy-America, Inc.*, IPR 2015-00677, Paper 15 at 37 (P.T.A.B. Sept. 2, 2015) (“The mere recitation of the words ‘common sense’ or ‘design choice,’ however, without any evidentiary support, adds nothing to the obviousness

equation.” (citing *Mintz v. Dietz & Watson, Inc.*, 679 F.3d 1372, 1377 (Fed. Cir. 2012))). Thus, Petitioner’s argument is fatally deficient.

Similarly, as Petitioner admits, each claim is construed “in accordance with the ordinary and customary meaning of such claim *as understood by one of ordinary skill in the art* and the prosecution history pertaining to the patent.” Paper 1 at 13 (quoting 37 C.F.R. § 42.100(b)) (emphasis added). Yet, the Petition fails to explain how one of ordinary skill in the art would understand the recited features of “a sufficiently narrow clearance” and “an efficient pumping seal without seizing the progressive cavity section in use” broadly means an operable stator/rotor arrangement. See Paper 1 at 15. Without expert opinion, this is merely attorney argument and thus insufficient to support the Petition.

These deficiencies highlight the weaknesses of the Petition. Therefore, considering the *Fintiv* analysis as a whole, the Board should deny institution.

V. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Board exercise its discretion to deny institution of the Petition.

Dated: April 21, 2025

Respectfully submitted,

/Jerry R. Selinger/

Jerry R. Selinger (Reg. No. 26,582)

jselinger@pattersonsheridan.com

Patterson + Sheridan LLP

1700 Pacific Avenue, Suite 2650

IPR2025-00391
Patent 10,676,992 B2

Dallas, Texas 75201
Telephone: 214-272-0957
Facsimile: 713-623-4846

Kyrie K. Cameron (Reg. No. 77,830)
kcameron@pattersonsheridan.com
Archibald D. Cruz (admitted *pro hac vice*)
acruz@pattersonsheridan.com

Patterson + Sheridan LLP
24 Greenway Plaza, Suite 1600
Houston, Texas 77046
Telephone: 713-623-4844
Facsimile: 713-623-4846

Attorneys for Patent Owner
InFocus Downhole Solutions USA LLC

CERTIFICATE OF COMPLIANCE

This Brief complies with the type-volume limitation of 14,000 words, comprising 2,298 words, as counted using the Microsoft Word software that was used to prepare this paper, excluding the parts exempted by 37 C.F.R. § 42.24(a).

Dated: April 21, 2025

Respectfully submitted,

/Jerry R. Selinger/

Jerry R. Selinger (Reg. No. 26,582)

jselinger@pattersonsheridan.com

Patterson + Sheridan LLP

1700 Pacific Avenue, Suite 2650

Dallas, Texas 75201

Phone: 214-272-0957

LEAD COUNSEL FOR PATENT OWNER

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the above document was served on April 21, 2025, by filing this document through the Patent Trial and Appeal Case Tracking System (P-TACTS) as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioner:

Michael Locklar
Reg. No. 44,878
Ewing & Jones, PLLC
6363 Woodway, Suite 1000
Houston, Texas 77057
Phone: (832) 830-8945
mlocklar@ewingjones.com

Chance Hardie
Reg. No. 55,247
Ewing & Jones, PLLC
6363 Woodway, Suite 1000
Houston, Texas 77057
Phone: (832) 830-8489
chardie@ewingjoines.com

Dated: April 21, 2025

Respectfully submitted,

/Jerry R. Selinger/

Jerry R. Selinger (Reg. No. 26,582)
jselinger@pattersonsheridan.com
Patterson + Sheridan LLP
1700 Pacific Avenue, Suite 2650
Dallas, Texas 75201
Phone: 214-272-0957

LEAD COUNSEL FOR PATENT OWNER