

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 HOLDINGS, LLC,
Patent Owner.

IPR2025-00661
U.S. Patent No. 11,459,863

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Declaration of Richard Quarles in Support of Petitioner's Unopposed Motion for <i>Pro Hac Vice</i> Admission
2002	Covenant Not to Sue between U.S. Well Services, LLC, ProFrac Holding Corporation, and Liberty Energy, Inc. Liberty Oilfield Services, LLC

I. INTRODUCTION

There is no reason why the Board should expend its limited resources addressing the merits of Petitioners' challenge to U.S. Patent No. 11,459,863 ("the 863 patent"). While Petitioners and Patent Owner U.S. Well Services Holdings LLC ("U.S. Well" or "Patent Owner") have been in litigation over several U.S. Well patents, the 863 patent is *not* one of them. Indeed, U.S. Well withdrew the 863 patent from the litigation pending between the parties.¹ Moreover, any lingering concern Petitioners may have had regarding the 863 patent were eliminated when U.S. Well gave Petitioners a covenant not to sue on the 863 patent. EX-2002.

On March 26, 2025, the Acting Director issued a Memorandum titled "Interim Processes for PTAB Workload Management" ("Interim Processes Memo"). Therein, the Director implemented a series of processes "due, in part, to

¹ The litigation is *U.S. Well Services, LLC et al. v. Liberty Energy, Inc. et al.*, Case No. 4:34-cv-00839- KPE (S.D. Tex.). While the 863 patent was initially asserted, U.S. Well withdrew the 863 patent from the case when it filed on June 3, 2024, an amended complaint (*see* EX-1006). Petitioners concede that that the 863 patent was "subsequently dropped from the Liberty Litigation...." Pet. at 1.

the current workload needs of the PTAB” with the aim to, *inter alia*, “improve PTAB efficiency” and “maintain PTAB capacity to conduct AIA proceedings.” Addressing the merits of the current Petition would result in PTAB *inefficiency* and reduce the PTAB’s capacity to conduct AIA proceedings, for no reason other than Petitioners’ desire to run up costs for Patent Owner in retaliation for Patent Owner’s lawsuit. There is no reason for the Board to use its resources in this manner, and Patent Owner’s request for discretionary denial should be granted for this alone.

But there is a separate reason why Patent Owner’s request for discretionary denial should be granted. The Petition requests a do-over of the prosecution of the 863 patent by using the same references that were considered and meritoriously overcome during prosecution. Out of the universe of prior art, the Petition relies on Fischer (EX-1008) and Morris (EX-1010) as the primary obviousness references across all 20 Grounds.² These are the same references (and the only ones) cited by the Examiner in the Office Action rejecting the claims during prosecution, with Fischer being applied to reject all the pending claims. In response to that Office

² Fischer is the primary reference for Grounds 1-10, and Morris is the primary reference for Grounds 11-20.

Action, Patent Owner made meritorious arguments that overcame the rejection. The Petition fails to acknowledge these arguments and instead alleges that the Examiner made an error—an allegation that is undermined by the prosecution history. The Board's holdings in *Advanced Bionics* and *Becton, Dickinson* protect against such second guessing where Petitions relitigate the prosecution history without showing the Office made any material error: this “framework reflects the commitment to defer to previous Office evaluations of the evidence unless material error is shown.” *Advanced Bionics v. Med-el Elecktromedizinische Gerate GMBH*, IPR2019-01469, Paper No. 6 at 9 (PTAB Feb. 13, 2020) (precedential).

For this reason also, Patent Owner respectfully requests that the Director grant its request for discretionary denial under 35 U.S.C. § 325(d).

II. BACKGROUND FACTS

During prosecution, the Examiner issued an Office Action that rejected the claims under 35 U.S.C. §§ 102, 103 over Fischer (EX-1008). EX-1002, 219–229. In that same Office Action, the Examiner also considered Morris (EX-1010) and concluded that Morris was “prior art made of record and not relied upon” for any claim rejections. *Id.* at 228. Fischer and Morris were the only two references identified by the Examiner in the Office Action.

The Examiner's analysis applying Fischer against the pending claims included alternative mappings that used Fischer's transformer 232 and the

functionality described in Figures 3–6 to satisfy limitation 1[d].³ Addressing independent claim 1, in both mappings, the Examiner found that Fischer's transformer 232 along with its functionality described in Figures 3–6 read against the claimed “transformer” in limitation 1[d]:

6. As concerns claim 1, Fischer shows a hydraulic fracturing system (100), comprising: a support structure (130) having a first area at a first height and a second area at a second height, the first and second areas adjacent one another (Fig. 3); an electric powered, multi-plunger pump (136) with an odd number of plungers (appears to be a quintiplex pump), arranged in the first area, the electric powered pump coupled to a well (109), via outlet piping (Fig. 2), and powered by at least one electric motor (134), also arranged in the first area (Fig. 3); a variable frequency drive (VFD) (132), arranged in the second area, connected to the at least one electric motor, the VFD configured to control at least a speed of the at least one electric motor (Fig. 3-6); and a transformer (232), arranged in the second area, the transformer positioned within an enclosure (200) with the VPD, the transformer configured to distribute power for operation of the electric pump (Fig. 3-6).

EX-1002, 222, first mapping (highlighting added).

³ Pending claim 1 included as limitation 1[d] “a transformer, arranged in the second area, the transformer positioned within an enclosure with the VFD, the transformer configured to distribute power for operation of the electric pump.” *See* EX-1002, 361. This same limitation is in issued claim 1. EX-1001, claim 1.

In the alternative, as concerns claim 1, Fischer shows a hydraulic fracturing system (100), comprising: a support structure (130) having a first area at a first height and a second area at a second height, the first and second areas adjacent one another (Fig. 3); an electric powered, multi-plunger pump (136) with a number of plungers, arranged in the first area, the electric powered pump coupled to a well (109), via outlet piping (Fig. 2), and powered by at least one electric motor (134), also arranged in the first area (Fig. 3); a variable frequency drive (VFD) (132), arranged in the second area, connected to the at least one electric motor, the VFD configured to control at least a speed of the at least one electric motor (Fig. 3-6); and a transformer (232), arranged in the second area, the transformer positioned within an enclosure (200) with the VPD, the transformer configured to distribute power for operation of the electric pump (Fig. 3-6).

EX-1002, 222–223 (alternative mapping) (highlighting added).

The Examiner's analysis as to independent claim 11 was materially the same. The Examiner again provided alternative mappings that used Fischer's transformer 232 and the functionality described in Figures 3–6 to satisfy limitation 11[c].⁴ For both mappings, the Examiner found that Fischer's transformer 232

⁴ Pending claim 11 included as limitation 11[c] “a transformer, arranged on the support structure, configured to distribute power for operation of the electric powered, multi-plunger pump, the power being received from the at least one generator at a voltage higher than an operating voltage of the electric powered

along with its functionality described in Figures 3–6 read against the claimed “transformer” in limitation 11[c]:

12. As concerns claim 11, Fischer shows a hydraulic fracturing system (100), comprising: an electric powered, multi-plunger pump (136), arranged on a support structure (130), the electric powered multi-plunger pump powered by at least one electric motor (134); a variable frequency drive (VFD) (132), arranged on the support structure, connected to the at least one electric motor to control a speed of the at least one electric motor (Fig. 3-6), the VFD positioned separate from the electric powered, multi-plunger pump and within an enclosure (200); and a transformer (232), arranged on the support structure, configured to distribute power for operation of the electric powered, multi-plunger pump, the power being received from at least one generator (110) at a voltage higher than an operating voltage of the electric powered pump, the transformer positioned within the enclosure (Fig. 3-6); wherein the electric powered, multi-plunger pump includes an odd number of plungers (appears to be a quintiplex pump) configured to reduce kinematic flow ripple (Fig. 3).

EX-1002, 225–226, first mapping (highlighting added).

pump, the transformer positioned within the enclosure.” *See* EX-1002, 362–363.

This same limitation is in issued claim 11. EX-1001, claim 11.

In the alternative, as concerns claim 11, Fischer shows a hydraulic fracturing system (100), comprising: an electric powered, multi-plunger pump (136), arranged on a support structure (130), the electric powered multi-plunger pump powered by at least one electric motor (134); a variable frequency drive (VFD) (132), arranged on the support structure, connected to the at least one electric motor to control a speed of the at least one electric motor (Fig. 3-6), the VFD positioned separate from the electric powered, multi-plunger pump and within an enclosure (200); and a transformer (232), arranged on the support structure, configured to distribute power for operation of the electric powered, multi-plunger pump, the power being received from at least one generator (110) at a voltage higher than an operating voltage of the electric powered pump, the transformer positioned within the enclosure (Fig. 3-6); wherein the electric powered, multi-plunger pump includes a number of plungers (Fig. 3). It would have

EX-1002, 226 (alternative mapping) (highlighting added).

Patent Owner, in response to the rejections, argued that Fischer did not qualify as prior art for two reasons: (1) Fischer did not satisfy *Dynamic Drinkware* requirements to establish its entitlement for priority, *see* EX-1002, 185–186; and (2) Fischer did not have sufficient support in its Provisional for the disclosures that the Examiner cited in the Office Action, *see* EX-1002, 188. *See also id.*, 186 (“Fischer, as published, includes 23 figures, 49 columns of description, and 26 claims. In sharp contrast, the [Fischer] provisional is 5 figures, 91 paragraphs, and

20 claims, which appear to be significantly different than the issued claims.”).⁵

Specifically addressing the Examiner's analysis of limitation 1[d], Patent Owner

⁵ The 863 patent claims priority to a provisional application filed on October 3, 2019. *See* EX-1001, cover. Petitioners do not contest for purposes of their Petition that the effective filing date of the 863 patent is October 3, 2019. Pet. at 4. Fischer's application was filed on February 14, 2020, and as such on its face does not qualify as prior art. EX-1008, cover. Fischer claims priority to a provisional application filed on February 14, 2019, *see id.*, and therefore the provisional application must contain written description support for the portions of Fischer relied on by the Examiner. *See Penumbra, Inc. v. RapidPulse, Inc.*, IPR2021-01466, Paper No. 34 at 32 (PTAB Mar. 10, 2023) (precedential) (“[U]nder the AIA, ... the provisional or other application(s) to which the reference patent document claims a right of priority must ‘describe [] the subject matter’ relied upon in the reference patent document as prior art.”) (citing 35 U.S.C. § 102(d)); *see also Forescout Tech., Inc. v. Fortinet, Inc.*, IPR2021-01328, Paper No. 12 at 9-10 (PTAB Jan. 27, 2022) (holding that “subject matter disclosed in [the asserted reference] is only available as prior art to the [challenged] patent to the extent it also is described in [the Provisional].”).

explained why Fischer was not entitled to the provisional filing date for Figures 3–6:

As discussed above, Applicant respectfully submits that Fischer is not entitled to its provisional filing date of February 14, 2019 at least because the Provisional fails to support the claims of Fischer, and moreover, the cited portions of Fischer are directed toward subject matter not found in the Provisional. Applicant respectfully submits that any subsequent Office Actions, if necessary, should cite to the Provisional rather than to Fischer.

By way of example, the Office Action cites to FIGS. 3-6 as allegedly disclosing the claimed “transformer, arranged in the second area, the transformer positioned within an enclosure with the VFD, the transformer configured to distribute power for operation of the electric pump.” *See* Office Action, 3. However, the disclosure of FIGS. 4-6 is not present in the Provisional, and therefore, is not entitled to the provisional filing data and is not prior art. In contrast, the Provisional references a “single VFD 240.” *See, e.g.*, Provisional, ¶ [0031]. Moreover, the “switchgear transformer 335” of the Provisional in FIG. 3 is illustrated as being part of a power distribution system 320 and does not appear to be associated with the VFD 340n. *See id.* at ¶ [0059]; FIG. 3. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 1.

EX-1002, 187–188.

Patent Owner therefore made two arguments⁶ as to why Fischer did not have sufficient written description in its Provisional: first, that the provisional

⁶ Patent Owner argued that claim 11 was “allowable at least for reasons including some of those discussed above in connection with claim 1.” EX-1002,

application did not provide written description support for the disclosure in Fischer concerning the transformer that the Examiner relied on to reject the claims; and second, the disclosure of a “switchgear transformer” in the provisional did not meet the language in limitations 1[d] and 11[c] in the pending claims.

The Examiner thereafter allowed the claims. EX-1002, 13-20. Contrary to the argument in the Petition, the Examiner did not cite to or rely on Patent Owner's *Dynamic Drinkware* argument as the reason for allowance. EX-1002, 19; *see* Pet. at 6 (arguing that “*Dynamic Drinkware* does not apply”). Instead, the Examiner gave as reasons for allowance that “the prior art of record,” which must include Fischer (EX-1008) and Morris (EX-1010), “does not appear to anticipate and/or render obvious” the challenged claims, including limitations 1[d] and 11[c].

188. In addition, Patent Owner argued that independent claim 11 was allowable for an additional reason—that is, the prior art failed to describe the “odd number of plungers configured to reduce kinematic flow ripple.” *Id.* This limitation does not appear in claim 1. EX-1001, claim 1. As discussed herein, the Examiner allowed claims 1 and 11 for the same reasons, *see* EX-1002, 19, and did not address the separate argument regarding claim 11.

Grounds 1 and 11 of the Petition contend that Fischer (EX-1008) and Morris (EX-1010), respectively, render obvious independent claim 1 without any additional references. Pet. 9–10. Similarly, for independent claim 11, Grounds 6 and 16 also contend that Fischer and Morris render obvious limitation 11[c] without any additional references. Pet. 55–56, 80.⁷ The remaining Grounds address dependent claims that rely on the Petition's unpatentability analysis in these Grounds that address claims 1 and 11. *Id.*

III. THE PETITION WASTES PATENT OFFICE RESOURCES BY CHALLENGING A PATENT WHEN PETITIONERS HAVE A COVENANT NOT TO SUE COVERING THE SAME PATENT

As explained in the Introduction hereto, the 863 patent is not asserted against Petitioners in any litigation. *See* EX-1006 (Amended Complaint in parallel litigation, which does not include the 863 patent). Further, Petitioners have no legitimate concern that the 863 patent will ever be asserted against them, as U.S. Well has given Petitioners a covenant not to sue regarding the 863 patent. *See* EX-

⁷ While Grounds 6 and 16 add “in the alternative, Karassik” as a reference, that reference is not applied against limitation 11[c]. *See* Pet. at 56-57 (relying solely on Fischer as allegedly disclosing limitation 11[c]; at 80-81 (relying solely on Morris as allegedly disclosing limitation 11[c])).

2002; *see Dow Jones & Co. v. Abblaise Ltd.*, 606 F.3d 1338, 1348 (Fed. Cir. 2010)

(“The covenant [not to sue] therefore extinguished any current or future case or controversy between the parties....”).

In view of the Director's Interim Processes Memo., Patent Owner submits that these facts support granting its request for discretionary denial. First, the “settled expectations of the parties,” *see id.* at 2, are that there is not now, and never will be, a dispute between them regarding the 863 patent. *See iRhythm Tech., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper No. 10 (On Director Review, June 6, 2025) (granting request for discretionary denial because, *inter alia*, “settled expectations favor denial of institution”). Further, given “the current workload needs of the PTAB,” Interim Processes Memo. at 3, Patent Owner asserts that addressing the merits of the current Petition when there is no cognizable dispute between the parties concerning the 863 patent would not be the best or most efficient use of the Board's limited resources.

Patent Owner notes that the PTO has previously questioned whether institution is appropriate when there is covenant not to sue granted by the Patent Owner to the Petitioner. In its Advanced Notice of Proposed Rulemaking, 2023-08239, 88 F.R. 24503 (April 21, 2023), titled “Changes Under Consideration to Discretionary Institution Practices, Petition Word-Count Limits, and Settlement Practices for America Invents Act Trial Proceedings Before the Patent Trial and

Appeal Board”, the PTO sought “feedback on whether it should discretionarily deny an IPR or PGR if the patent owner provides a covenant not to sue to a for-profit petitioner and its customers prior to initiating litigation against those entities. In addition, the USPTO requests comments on whether it should consider any other covenant or stipulation in determining whether to exercise discretion to deny institution.” *Id.* at 24508.

While the Advanced Notice of Proposed Rulemaking did not result in any regulation being implemented, Patent Owner submits that the PTO's concern regarding using its resources to address the validity of a patent that is not currently asserted in any litigation, and as to the Petitioner in question here will never be asserted against it, is a valid one. The Board's resources are better directed at patents that are the subject of active litigation and where the IPR process is thus used as Congress intended—as a “true alternative” to courtroom litigation. *See* 157 Cong. Rec. S1352 (daily ed. Mar. 8, 2011) (statement of Sen. Udall) (“Inter partes ... proceedings are intended to serve as a less expensive alternative to courtroom litigation and provide additional access to the expertise of the Patent Office on questions of patentability.”).

Patent Owner therefore respectfully requests that the Director grant Patent Owner's request for discretionary denial given the covenant not to sue provided by Patent Owner to Petitioners.

IV. TRIAL SHOULD BE DENIED PURSUANT TO THE *ADVANCED BIONICS* FRAMEWORK AND *BECTON, DICKINSON* FACTORS

Petitioners' Grounds undisputedly rely on the same or substantially the same prior art as was considered during prosecution of the 863 patent. As such, under *Advanced Bionics* and *Becton, Dickinson*,⁸ Petitioners must show that the Patent Office made a material error in issuing the challenged patent. Petitioners, however, cannot meet this burden because the Examiner made no mistake, let alone a material mistake in determining patentability to the challenged claims. And Petitioners' allegation to the contrary is based on mere speculation, unsupported by evidence, that the Examiner withdrew Fischer as a prior art reference based on Patent Owner's *Dynamic Drinkware* argument. Pet. at 13.

A recent precedential decision, *Ecto World v. RAI Strategic Holdings*, summarizes the framework of *Advanced Bionics* as follows:

Advanced Bionics provides a two-part framework for evaluating whether denial under section 325(d) is warranted: (1) whether the same or substantially the same

⁸ *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper No. 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) (“*Becton, Dickinson*”)

prior art or argument previously was presented to the Office; and (2) if the first part is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, Paper No. 6 at 8.

Ecto World, LLC et al. v. RAI Strategic Holdings, IPR2024-01280, Paper No. 13 at 3 (On Director Review, May 19, 2025). The *Becton, Dickinson* factors, in turn, “provide useful insight into how to apply the framework under 35 U.S.C. 325 (d).” *Ecto World* at 3. This “framework reflects the commitment to defer to previous Office evaluations of the evidence unless material error is shown.” *Advanced Bionics* at 9.

As shown below, both the framework in *Advanced Bionics* and the *Becton, Dickinson* factors warrant discretionary denial.

A. The First Part of the *Advanced Bionics* Framework Is Undisputedly Satisfied

Petitioners do not dispute that the first part of the *Advanced Bionics* framework is met because the Petition presents the same prior art previously presented to the Office. See Pet. at 12 (“***Here, the first part of this framework is met***, as both Fischer (EX1008) and Oehring- I (EX1012) were presented to the Office during prosecution of the ’863 patent.”) (emphasis added); see EX-1002,

222 (citing Fischer). Thus, as to Fischer, the first part of the *Advanced Bionics* framework is thus satisfied.⁹

The *Becton Dickinson* factors (a), (b), and (d) further confirm that the first part of the *Advanced Bionic* framework is satisfied for both Fischer and Morris.

Factor (a): The Petition relies on the same prior art—that is, Fischer (EX-1008) and Morris (EX-1010)—identified by the Examiner in the only Office Action. EX-1002, 222–223, 228. Thus, the prior art in both the Petition and during examination is the same.

Factor (b): No prior art beyond Fischer and Morris is used in the Petition's Grounds (Grounds 1 and 11) that address independent claim 1. Likewise, the Petition relies on the same teachings from Fischer and Morris to address the independent claim 11 (Grounds 6 and 16), including limitation 11[c]. Pet. 55–56, 80. Consequently, the Petition presents no new prior art to address the independent claims beyond that already considered during examination.

⁹ Morris is discussed *infra*.

The Petition includes Karassik (EX-1013), in the alternative, to render obvious limitation 11[d]¹⁰ in Grounds 6 and 16. Pet. 57–58, 81. This additional reference adds nothing to the prior art meritoriously overcame during prosecution for two reasons. First, the Petition's reliance on Karassik confirms that it is cumulative over the teachings of Fischer and Morris, as understood by a POSITA. *see* Pet. 57 (“Thus, Fischer renders obvious Limitation 11[d] in view of the knowledge of a POSITA. In the alternative, Fischer renders obvious Limitation 11[d] in view of Karassik for the same reasons.”); Pet. 81 (“It would have been obvious to a POSITA that Morris's pump is “*configured to reduce kinematic flow ripple*” in view of the knowledge of a POSITA and, in the alternative, Karassik for the same reasons discussed above in Ground 6 regarding Limitation 11[d].”). Patent Owner meritoriously overcame Fischer and Morris with arguments addressing a different limitation—that is, limitation 11[c]. Karassik thus does not fix the deficiencies of Fischer and Morris and provides only cumulative teachings addressing only limitation 11[d].

¹⁰ Limitation 11[d] recites “wherein the electric powered, multi-plunger pump includes an odd number of plungers configured to reduce kinematic flow ripple.”

Second, the prosecution history further confirms that limitation 11[d] was not needed to overcome the deficiencies of Fischer and Morris. During prosecution, Patent Owner argued that Fischer, and its provisional, failed to disclose limitation 11[d]. EX-1002, 188 (“Applicant further submits that the cited portions of Fischer, and the Provisional, fail at least to describe the ‘odd number of plungers configured to reduce kinematic flow ripple.’”). Claim 1 does not include this feature described in limitation 11[d]. And, notably, the Examiner allowed the independent claims 1 and 11 for the same reasons. *See* EX-1002, 19. As a result, the Examiner allowed the claims of the 863 patent without considering whether Fischer or its provisional discloses limitation 11[d]—that is, the same limitation supposedly rendered obvious by Karassik.

The Petition's reliance on Karassik is thus cumulative of the prior art evaluated—namely, Fischer and Morris—relied on by the Examiner during examination.

Factor (d): Rather than relying on additional prior art, the Petition's unpatentability Grounds rely on allegedly different¹¹ disclosures from the same

¹¹ Petitioners argue that the Petition did not rely on the same disclosures in Fischer cited in the prosecution history. Pet. 14 (“Further, this Petition does not

prior art that the Examiner previously and substantively considered. This is no different than the Petition's treatment of prior art previously considered during prosecution in *Becton, Dickinson*. There, the Board denied institution because the Petition presented "only a nominally different combination of prior art and considering that Petitioner presents the same arguments as were meritoriously overcome by the Applicant during prosecution." *Becton, Dickinson* at 28; *see id.* at 23 ("We are not persuaded on this record that rearranging previously substantively considered prior art, and advancing essentially the same positions raised by the Examiner during prosecution of the parent application, presents persuasive new evidence of unpatentability that was not evaluated previously by the Office."). Like *Becton, Dickinson*, the Examiner here previously considered the exact same prior art, and further substantively considered Fischer and Morris as explained above. *See* EX-1002, 222–228. And, unlike in *Becton Dickinson*, Petitioners proposed combination relies on the same prior art used during prosecution to address the limitations that were meritoriously overcome during prosecution and uses a new reference, Karassik (EX-1013), to address a limitation that was inconsequential

rely on the portions of Fischer that were identified by the Applicant as being directed to subject matter purportedly not found in the Fischer Provisional.").

during prosecution. *See* Pet. 57, 81; *Compare* EX-1002, 188 (applicant arguing feature of “odd number of plungers to reduce kinematic flow ripple” from limitation 11[d] is not taught by Fischer and its provisional) *with* EX-1002, 19 (allowing claims 1 and 11 for same reasons when claim 1 does not include “reduce kinematic flow ripple”). Thus, Petitioners want to re-litigate the same prior art that was substantively considered during prosecution and meritoriously overcome.

For the reasons above, the first part of the *Advanced Bionics* framework is thus satisfied for both Fischer and Morris.

B. The Second Part of the *Advanced Bionics* Framework Is Satisfied

As explained below, the second part of the *Advanced Bionics* framework is applicable to both Fischer and Morris. Patent Owner respectfully requests that the Director grant its request for discretionary denial under 35 U.S.C. § 325(d) because the Petition fails to show that the Office erred in a manner material to the patentability of challenged claims.

1. Fischer was substantively considered and meritoriously overcome during prosecution.

During prosecution of the 863 patent, the Examiner made no mistake, let alone a material error. To argue otherwise, Petitioners rely on supposition, not evidence. Because the Petition fails to show any material error made by the

Examiner, the second part of the *Advanced Bionics* framework warrants discretionary denial.

Petitioners contend that the Examiner made a material error “by withdrawing Fischer as prior art for allegedly failing to meet the *Dynamic Drinkware* requirement. . .” as the challenged patent is an AIA patent. Pet. at 12; *see id.* at 13 (representing that “the examiner withdrew Fischer as a prior art reference” when allowing the claims). But the Examiner never said that Fischer was being withdrawn as prior art, much less that Patent Owner’s *Dynamic Drinkware* argument was the reason for allowance. *See* EX-1002, 19. Petitioners’ alleged material error argument is thus unsupported by the prosecution history.

Specifically, the prosecution history shows that Patent Owner argued against the disclosures from Fischer that the Examiner relied on to address limitations 1[d] and 11[c]. EX-1002, 187–188. These arguments meritoriously overcame the Examiner’s reliance on Figures 3–6 of Fischer to satisfy these limitations, for two reasons. First, a plain reading of Fischer’s patent and provisional shows that Figures 4–6 are missing from the provisional. *Compare* EX-1008, Figs. 4–6 *with* EX-1009. Second, the transformer 335 in Figure 3 of the Fischer Provisional is (1) different than the transformer 232—that is, the transformer in Fischer that Examiner mapped to the claimed “transformer”—and (2) is part of the power distribution system 320 and not associated with the VFD, contrary to then-pending

claim 1's requirement¹² that the “*VFD and transformer be in the same enclosure.*” See EX-1002, 361 (pending claim 1); 187-188 (arguing that the “switchgear transformer 335’ of the Provisional in Fig. 3 is illustrated as being part of a power distribution system 320 and does not appear to be associated with the VFD 340n”). These arguments, grounded in the disclosures of Fischer and the Provisional and directed to the Examiner's reasons for rejecting the claims, overcame the Examiner's rejection relying on Figures 3–6 of Fischer to satisfy limitations 1[d] and 11[c]. As explained above, the Examiner made no mistake in allowing the challenged claims over Fischer for these reasons.

The Petition acknowledges only the argument regarding Figs. 4-6 and never addresses the argument concerning Fig. 3. Pet. at 13 (“Patent Owner also argued that various cited portions of Fischer are directed to subject matter not found in Fischer Provisional, such as ‘the disclosure of FIGS 4–6’ in Fischer.”). Moreover, Petitioners' allegation of material error is based *solely* on their assertion that the Examiner erroneously relied on Patent Owner's *Dynamic Drinkware* argument in

¹² Then-pending Claim 11 recited a similar requirement with a “the variable VFD positioned...within an enclosure; [and] the transformer positioned within the enclosure.” EX-1002, 363.

allowing the claims (Pet. at 13), which finds no support anywhere in the prosecution history. The full reasons for allowance are copied below, and there is simply no basis to surmise, much less argue, that the Examiner adopted the *Dynamic Drinkware* argument and “withdrew” Fischer as a prior art reference:

1. The following is an examiner's statement of reasons for allowance: the prior art of record does not appear to anticipate and/or render obvious a hydraulic fracturing system having an electric powered, multi-plunger pump, arranged on a support structure, the electric powered multi-plunger pump powered by at least one electric motor, a variable frequency drive (VFD), arranged on the support structure, connected to the at least one electric motor to control a speed of the at least one electric motor, the VFD positioned separate from the electric powered, multi-plunger pump and within an enclosure, and a transformer, arranged on the support structure, configured to distribute power for operation of the electric powered, multi-plunger pump, the power being received from at least one generator at a voltage higher than an operating voltage of the electric powered pump, the transformer positioned within the enclosure, wherein the electric powered, multi-plunger pump includes an odd number of plungers configured to reduce kinematic flow ripple.

EX-1002, 19.

The prosecution history instead shows that the Examiner concluded that the “prior art of record” did not anticipate or render obvious the claims. *Id.* The only “prior art of record” that was considered by the Examiner was Fischer and Morris. EX-1002, 219-229. Thus, the most reasonable interpretation of the file history is

that the Examiner agreed that Fischer did not invalidate the pending claims—not that the Examiner withdrew Fischer based on Patent Owner's *Dynamic Drinkware* argument.

Further, the *Becton, Dickinson* factors (c), (e), and (f) confirm that the second part of the *Advanced Bionics* framework applies to Fischer.

Factor (c): The Examiner substantively considered Fischer (EX-1008). *See* EX-1002, 222–223. Indeed, the Examiner provided alternative mappings of Fischer as allegedly meeting the challenged claims. *Id.* Thus, Fischer was extensively evaluated during examination.

Factor (e): The Petition, as explained above, failed to sufficiently point out how the Examiner erred in evaluating Fischer. The Petition alleges that the Examiner materially erred by accepting Patent Owner's *Dynamic Drinkware* argument. Pet. at 12 (stating that the Examiner “materially erred by withdrawing Fischer as prior art for allegedly failing to meet the *Dynamic Drinkware* requirement. . .”). But the notice of allowance (shown above) does not mention *Dynamic Drinkware* nor specifically reference the pages of that response to the office action. Without doing so, the Petition has failed to show that this was the only reason that the Examiner allowed the challenged claims. Moreover, the Examiner could have relied on the other valid arguments that Patent Owner provided as proper reasons to allow the patent, which Petitioners have not rebutted.

The Petition thus fails to sufficiently point out how the Examiner erred in their evaluation of Fischer during prosecution.

Factor (f): Petitioners' expert acknowledges that Fischer was considered during prosecution but wrongly contends that the "examiner erred in rejecting Fischer as prior art" because "[t]he sections of Fischer that I have relied on to show anticipation or obviousness of the challenged claims are supported by the Fischer provisional." EX-1003, ¶ 144; *see also* EX-1003, ¶¶ 40–43. This supposed error¹³ is not materially different from the alleged material error identified in the Petition. *See* Pet. at 12 (stating that the Examiner "materially erred by withdrawing Fischer as prior art for allegedly failing to meet the *Dynamic Drinkware* requirement. . ."). As explained above, there is no evidence that the Examiner either "withdrew" Fischer as prior art, or "reject[ed] Fischer as prior art." The Petition therefore does not present additional facts or evidence that was not already considered by the Examiner, which would warrant reconsideration of the prior art.

¹³ In compliance with the *FAQs for Interim Processes for PTAB Workload Management*, FAQ 25, Patent Owner will address the merits fully in its POPR, due July 16, 2025, and respectfully requests that the Director consider the merits in accessing *Becton, Dickinson* factor (f).

Because Petitioners' material error argument regarding Fischer is based on a false premise, it should be rejected. *Advanced Bionics* applies here.

2. Although Morris was not used by the Examiner in a rejection, the Examiner carefully considered Morris during prosecution.

Petitioners' entire *Advanced Bionics* argument is that "Morris was not used in a rejection of the claims.... The Board has declined to exercise its discretion to deny institution in situations where the petitioner relied upon prior art that was cited on the face of the challenged patent, but was 'not applied by the examiner . . . in any rejection of claims.'" Pet. at 14 (citing *Comcast Cable Commc'ns, LLC v. Promptu Sys. Corp.*, IPR2018-00342, Paper No. 13 at 17 (PTAB July 19, 2018)).

That is incorrect. Even when an Examiner did not apply a prior art reference in a rejection, "a petitioner **must** provide an analysis" of how the Examiner committed material error with respect to that reference. *Ecto World*, Paper No. 13 at 5 (precedential) (emphasis added). Moreover, in *Ecto World*, the facts showed that the prior art reference in question appeared on an IDS of over 1,000 references. *Id.* at 6-7. The facts here are markedly different. Rather than being included in an IDS submitted by applicants, Morris was instead one of seven references that the Examiner found in conducting a prior art search. See EX-1002, 230. The Examiner cited only two references in the Office Action—Fischer and

Morris. EX-1002, 219-229. And the Examiner concluded that although Morris was not relied on for a rejection, it was “considered pertinent to applicant’s disclosure.” *Id.* at 228.

This record demonstrates that the Examiner carefully considered Morris during prosecution and concluded that its disclosures did not support making a rejection based on them. Petitioners made no effort to demonstrate that “no reasonable examiner” considering Morris would have reached the same conclusion as the one examining the 863 patent application. *Ecto World*, Paper No. 13 at 5. Indeed, “[i]f reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.” *Advanced Bionics* at 9. Patent Owner submits that Petitioners have utterly failed to demonstrate otherwise.¹⁴

The *Becton, Dickinson* factors (c), (e), and (f) further confirm that the second part of the *Advanced Bionics* framework applies to Morris.

¹⁴ To the extent that the Director considers the merits of Petitioners’ Grounds regarding Morris as part of this analysis, Patent Owner’s Preliminary Response, due July 16, 2025, will explain why the merits are weak and the Examiner was thus correct to conclude that Morris did not anticipate or render obvious any claims.

Factor (c): As explained above, the Examiner carefully considered Morris during examination, especially given that Morris was one of only two prior art references mentioned in the office action. The Examiner also specifically considered Morris by finding it to be “prior art made of record and not relied upon” for any claim rejections. EX-1002 at 228. Thus, the Examiner evaluated and considered Morris during examination.

Factor (e): The Petition, as explained above, failed to sufficiently point out how the Examiner erred in evaluating the prior art. Notably, the Petition provided no explanation as to how the Examiner erred in evaluating Morris. *See* Pet. at 14. The Petition's expert likewise does not identify any such error. EX-1003, ¶ 144. Rather, the position of the Petition and supporting expert declaration appears to be that Morris not used in a rejection of a claim. The Examiner, however, considered Morris and listed it as “prior art made of record.” *Id.* at 228. Further, the notice of allowance states that the “prior art of record”—which included Morris—did not anticipate nor render obvious the challenged claims. *See* EX-1002, 19. Thus, the Petition fails to sufficiently point out how the Examiner erred in its evaluation of Morris.

Factor (f): The Petition does not present additional facts or evidence that was not already considered by the Examiner, which would warrant reconsideration of the prior art. As explained above, the Examiner carefully considered Morris

during prosecution. *See* EX-1002 at 228. Grounds 11 and 16, as well as Dr.

Durham's accompanying declaration, similarly rely on Morris to render obvious the independent claims 1 and 11,¹⁵ respectively. The Petition thus does not present additional evidence or facts beyond what was previously considered by the Examiner during prosecution.

Because Petitioner fails to identify any material error argument or new evidence regarding Morris, it should be rejected. *Advanced Bionics* applies here.

V. THE DIRECTOR SHOULD DENY INSTITUTION BECAUSE THE PETITION FAILS TO PROVIDE FOCUSED EXPERT TESTIMONY

The *FAQs for Interim Processes for PTAB Workload Management*, FAQ 21, explains that “extensive reliance on expert testimony and/or reasonable disputes between experts on dispositive issues may suggest that the questions are better resolved in an Article III court.” Further, the “failure to provide *focused* expert testimony may weigh against institution.” *Id.* (emphasis added)

Petitioner failed to provide focused expert testimony. Instead, Petitioners rely on a 228-page expert declaration containing 353 numbered paragraphs

¹⁵ As explained above, *see* § IV.A, the Petition alternatively relies on Karassik (EX-1013), which was cumulative over the teachings of Morris and Fischer.

addressing 20 different grounds applying seven different references. *See* EX-1003.

The expert declaration is (by page count) over two-and-a-half times as long as the Petition itself. Patent Owner submits that this “extensive reliance” on *un*focused expert testimony should weigh against institution, particularly when considered along with the other reasons set forth herein for why Patent Owner's request for discretionary denial should be granted.

VI. CONCLUSION

For the above reasons, Patent Owner respectfully requests that the Director grant Patent Owner's request for discretionary denial, and order that the Petition be denied and no trial instituted.

Dated: June 16, 2025

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CERTIFICATE OF SERVICE

I hereby certify that on this 16th day of June, 2025, I caused to be served a true and correct copy of the foregoing "Patent Owner's Discretionary Denial Brief" and accompanying exhibits by electronic mail on the following:

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CERTIFICATE OF COMPLIANCE

This Discretionary Denial Brief complies with the type-volume limitation of 14,000 words as it contains 5,437 words, excluding the parts exempted by 37 C.F.R. § 42.24(a).

This Discretionary Denial Brief complies with the general format requirements of 37 C.F.R. § 42.24(a) and has been prepared using Microsoft Word in 14-point Times New Roman font.

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