

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.

IPR2025-00778
U.S. Patent No. 11,959,533

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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PATENT OWNER'S EXHIBIT LIST

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2002	Order Denying Motion to Stay Pending <i>Inter Partes</i> Review
2003	June 3, 2024 Amended Complaint
2004	Notice of <i>Markman</i> Hearing Set for April 30, 2025
2005	<i>Markman</i> Hearing Memorandum and Order
2006	<i>Liberty Energy, Inc. and Liberty Oilfield Services LLC v. U.S. Well Services, LLC</i> , IPR2025-00066, Paper No. 10 (Apr. 29, 2025) (Institution Decision Denying Institution of <i>Inter Partes</i> Review)
2007	May 15, 2025 Amended Scheduling Order
2008	Liberty Email to PTAB Requesting Board to Terminate IPR2025-00105
2009	<i>Liberty Energy, Inc. and Liberty Oilfield Services LLC v. U.S. Well Services, LLC</i> , IPR2025-00105, Paper No. 7 (Apr. 8, 2025) (Order Dismissing Petition for <i>Inter Partes</i> Review as Premature)
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2012	U.S. Patent No. 10,598,258
2013	Durham Declaration ISO 258 Patent IPR
2014	Petitioners Email Stipulation (dated June 16, 2025)
2015	Liberty's Preliminary Invalidity Contentions

I. INTRODUCTION

Pursuant to the Acting Director's March 26, 2025 Memorandum titled *Interim Processes for PTAB Workload Management*, Patent Owner U.S. Well Services Holdings, LLC ("U.S. Well" or "Patent Owner") submits this Brief requesting that the Director deny the instant Petition on discretionary grounds. For the reasons explained herein, U.S. Well submits that there are multiple reasons supporting discretionary denial.

First, institution should be denied under the *General Plastic*¹ factors. The patent at issue here—U.S. Patent No. 11,959,533 (the "533 patent")—was the subject of a materially identical IPR petition (IPR2025-00105) filed by Petitioners² on November 5, 2024. EX-2011. But in their haste to rush out IPR petitions against U.S. Well's patents, Petitioners failed to recognize that the 533 patent's issue date was April 16, 2024, meaning that the 533 patent was not eligible for *inter partes* review until January 16, 2025. 35 U.S.C. § 311(c)(1). Petitioners nonetheless

¹ *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper No. 19 (Sep. 6, 2017) (precedential as to § II.B.4.i).

² Liberty Energy, Inc. and Liberty Oilfield Services LLC (collectively, "Liberty" or "Petitioners").

allowed the IPR to proceed, with U.S. Well filing its Patent Owner Preliminary Response on February 21, 2025.³ Only then did Petitioners admit that the 533 patent was not eligible for IPR when the November 5, 2024 petition was filed. The Board thereafter terminated the first IPR against the 533 patent on April 8, 2025. EX-2009.

These undisputed facts compel denial under *General Plastic*. The same petitioners previously filed a petition directed to the same claims of the same 533 patent. The same prior art is used in both petitions. By the time Petitioners filed their second petition (this one), they had received U.S. Well's POPR in the previous IPR. Petitioners have no adequate explanation for the time elapsed between filing the multiple petitions. And the Board's finite resources should not be used to excuse Petitioners for their negligence in failing to perform the most basic investigation—the issue date of the 533 patent—prior to filing the previous petition.

This proceeding should also be discretionarily denied pursuant to the *Fintiv* factors. The trial in the parallel litigation between the parties involving the 533

³ *Liberty Energy, Inc. and Liberty Oilfield Servs. LLC v. U.S. Well Servs., LLC*, IPR2025-00105, Paper No. 6 (Feb. 21, 2025).

patent is scheduled to start on March 30, 2026, nearly *six months* before an anticipated October 2026 Final Written Decision in this proceeding. The magistrate judge overseeing pretrial proceedings in the parallel litigation found, when *denying* Petitioners' motion to stay the case, that the "parties have already expended significant resources in the prosecution and defense of this case." EX-2002 at 6. The parties to this proceeding are the same as in the parallel litigation. And, as explained in more detail below, the grounds in the Petition here are exceptionally weak, as demonstrated by the fact that the Board previously denied institution based on the merits in another IPR (IPR2025-00066) involving the parent patent to the 533 patent in which Petitioners presented the *same* prior art and the *same* obviousness arguments as here.

Finally, there are other reasons why discretionary denial is warranted. Petitioners rely on a 286-page declaration (EX-1003) from their technical expert to present arguments regarding eleven different references across sixteen different obviousness grounds. This is plainly not the "focused expert testimony" that the Board expects when considering workload management. *See FAQs for Interim Processes for PTAB Workload Management*, FAQ 21. Moreover, the Petition contains voluminous and excessive grounds that warrant discretionary denial "in the interests of efficient administration of the Office and integrity of the patent system and as a matter of procedural fairness to Patent Owner." *Adaptics Ltd. v.*

Perfect Co., IPR2018-01596, Paper No. 20 at 24 (PTAB Mar. 6, 2019)

(informative).

Accordingly, Patent Owner respectfully requests that under 35 U.S.C. § 314, the Director grant its request for discretionary denial and order that no trial be instituted.

II. BACKGROUND FACTS

Patent Owner and Petitioners are parties to the litigation *U.S. Well Services, LLC et. al. v. Liberty Energy, Inc., et al.*, Case No. 4:24-cv-00839 (S.D. Tex.). The case is not limited to patent infringement but includes claims of breach of contract and trade secret misappropriation. *See* EX-2003 at 17–25 (June 3, 2024 Amended Complaint). U.S. Well added a claim for infringement of the 533 patent on June 3, 2024. *See id.* The other asserted patents include U.S. Patent Nos. 10,598,258 (the parent of the 533 patent), 10,655,435, and 11,208,878.⁴

⁴ The 258 patent was the subject of IPR2025-00066. The Board denied institution of trial in that proceeding on the merits on April 29, 2025. *See* EX-2006. The 435 patent is the subject of IPR2025-00031. The Board instituted trial in that matter on April 29, 2025, and U.S. Well's Request for Director Review of that

The district court case is proceeding apace. Claim construction briefing was completed on February 13, 2025. When pretrial proceedings in the case were assigned to Magistrate Judge Bryan, the *Markman* hearing was moved to April 30, 2025. EX-2004 (Notice of Hearing). The *Markman* hearing took place as scheduled and on May 30, 2025, Judge Bryan issued her Claim Construction Order. EX-2005.

Fact discovery is scheduled to close on August 8, 2025. EX-2007 (May 15, 2025, Amended Scheduling Order). U.S. Well has served its final infringement contentions, and Liberty's final invalidity contentions were served on June 13, 2025. *See id.* The deadline for the parties to complete expert discovery is October 17, 2025. Trial was initially scheduled to begin on February 2, 2026, but the Court's Amended Scheduling Order moved the trial to March 30, 2026, to accommodate the *Markman* hearing being moved to April 30, 2025. *Id.*

On March 19, 2025, Petitioners moved to stay the district court case pending IPR. On May 9, 2025, the Court denied that motion. EX-2002.

decision is pending. The 878 patent is the subject of IPR2025-00139. The Board recently instituted a trial for that proceeding on June 11, 2025.

As noted above, on November 5, 2024, Petitioners filed a petition for IPR of the 533 patent. EX-2011 (IPR2025-00105). On February 21, 2025, U.S. Well filed its POPR in that proceeding. That POPR extensively and substantively addressed the merits of Liberty's Petition. On March 28, 2025, Petitioners filed the Petition in the instant proceeding. On April 2, 2025, Petitioners emailed the Board in IPR2025-00105 to request permission to file a motion to terminate that proceeding because "Petitioners recently discovered that IPR2025-00105 involving [the 533 patent] was filed prematurely under 35 USC 311(c)." EX-2008 (EX-3001 in IPR2025-00105). The Board on April 8, 2025, issued an Order Dismissing the Petition for *Inter Partes* Review as Premature. EX-2009.

III. TRIAL IN THIS PROCEEDING SHOULD BE DENIED PURSUANT TO THE *GENERAL PLASTIC* FACTORS

This IPR involves a "follow-on" petition from the one filed in the now-terminated IPR2025-00105. When deciding whether to institute *inter partes* review of follow-on petitions, the Board considers seven factors (the "*General Plastic* Factors"):

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;

3. whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha, IPR2016-01357, Paper No. 19 at 9–10 (PTAB Sep. 6, 2017) (precedential as to Section II.B.4.i.). Patent Owner requests that the Director deny institution here because all seven *General Plastic* Factors favor denial.

Factor 1: Petitioners cannot deny that they previously filed a petition in IPR2025-00105 challenging “the same claims of the same patent” as are challenged in this IPR. Indeed, in requesting that the Board terminate IPR2025-

00105 as prematurely filed, Petitioners told the Board that they “filed a new IPR on the ‘533 patent (IPR2025-00778) ... with *identical grounds and analysis* as in IPR2025-00105[.]”⁵ EX-2008. This factor therefore favors denial. *General Plastic*, Paper 19, at 10, 19 (finding factor 1 weighed against institution where “the same claims of the same patent were at issue in the follow-on petitions”).

Factor 2: Petitioners obviously knew of all prior art cited in the current petition when they filed IPR2025-00105 challenging the 533 patent on identical grounds. EX-2008 at 1; EX-2011 (*Liberty Energy Inc. and Liberty Energy Servs. LLC v. U.S. Well Servs. Holdings, LLC*, No. IPR2025-00105, Paper No. 1 (PTAB Nov. 5, 2024)). This factor also favors denial.

Factor 3: Petitioners filed the current petition on March 28, 2025, over a month after receiving U.S. Well's POPR in IPR2025-00105 on February 21, 2025, addressing the same prior art grounds as asserted in the current petition. This too favors denial. *General Plastic*, Paper No. 19, at 10, 19 (finding factor 3 weighed against institution where “[a]t the time Petitioner filed the follow-on petitions, Patent Owner had filed its Preliminary Responses to the first-filed petitions[.]”). It is significant that even though the 533 patent was eligible for IPR by January 16, 2025 (*see* EX-1001, issue date), and Petitioners could have filed the current

⁵ All emphases added herein.

petition then and requested termination of IPR2025-00105 before receiving U.S. Well's POPR, they did not do so. Instead, Petitioners waited until *after* U.S. Well filed its POPR in IPR2025-00105. This resulted in Patent Owner expending unnecessary resources to prepare a substantive POPR in IPR2025-00105 when Petitioners had wrongly certified that the 533 patent "is eligible for inter partes review" when it was not. *See* EX-2011 (IPR2025-00105 Petition) at 2.

Factors 4 and 5: Petitioners knew of the prior art relied on in the current Petition by at least November 5, 2024—almost five months before filing IPR2025-00778—as shown by their petition in IPR2025-00105 challenging the 533 patent on identical grounds. EX-2008 at 1 ("On March 28 Petitioners filed a new IPR on the '533 patent (IPR2025-00778) ... with identical grounds and analysis as in IPR2025-00105[.]"). Petitioners plainly cannot provide an "adequate explanation" for the lapse in time between filing the two petitions under these facts. Moreover, Petitioners' April 2, 2025 allegation that they "recently discovered that IPR2025-00105 ... was filed prematurely under 35 USC 311(c)" (EX-2008 at 1) does not excuse their nearly three-month delay in filing the current Petition, given that the 533 patent was eligible for IPR as of January 16, 2025. Further, it is self-evident that Petitioners could have "discovered that IPR2025-00105 ... was filed prematurely" (EX-2008 at 1) through the "exercise of reasonable diligence." *General Plastic* at 11. Factors 4 and 5 thus favor denial. *Id.* at 10–11, 19 (finding

factors 4 and 5 weighed against institution where Petitioner provided no reasonable explanation of any unexpected circumstances that prompted its new prior art searches or for its delay).

Factor 6: Petitioners have already wasted the finite resources of the Board by prematurely filing IPR2025-00105 in violation of 35 U.S.C. § 311(c). Petitioners' error caused both the Board and Patent Owner to expend unnecessary resources in IPR2025-00105 before Petitioners finally requested that the Board terminate IPR2025-00105 on April 2, 2025. In situations like this one, "it is more efficient for the parties and the Board to address a matter once rather than twice." *Samsung Elec. Co. v. Rembrandt Wireless Techs., LP*, IPR2015-00114, Paper No. 14 at 6 (PTAB Jan. 28, 2015). Patent Owner should not pay the price for Petitioners' mistake, nor should Petitioners be rewarded for it. *Butamax Advanced Biofuels LLC v. Gevo, Inc.*, Case IPR2014-00581, Paper No. 8 at 13 (PTAB Oct. 14, 2014) ("Allowing similar, serial challenges to the same patent, by the same petitioner, risks harassment of patent owners and frustration of Congress's intent in enacting the Leahy-Smith America Invents Act."); *General Plastic* at 11 ("the filing of sequential attacks against the same claims, with the opportunity to morph positions along the way, imposes inequities on [Patent Owner]" (internal quotations omitted)). Further, Petitioners attempt to waste the finite resources of the Board even further by failing to identify with particularity each claim challenged, in

violation of 35 U.S.C. § 312(a)(3), as discussed *infra*. Factor 6 thus also favors denial.

Factor 7: Patent Owner is not aware of any issue that might prevent the Board from issuing a FWD within the one-year deadline under 35 U.S.C. § 316(a)(11), other than the concerns expressed in the Director's March 26, 2025 Memorandum concerning workload issues. Nonetheless, because follow-on petitions present "an inefficient use of the *inter partes* review process," *General Plastic* at 18, Patent Owner asserts that Factor 7 at least marginally favors denial.

For these reasons, Patent Owner requests that the Director apply the *General Plastic* factors here and grant Patent Owner's request for discretionary denial.

IV. TRIAL IN THIS PROCEEDING SHOULD BE DENIED PURSUANT TO THE *FINTIV* FACTORS

It is likewise the case that trial in this IPR should be denied under 35 U.S.C. § 314 based on the *Fintiv* factors. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper No. 11 at 6 (PTAB Mar. 20, 2020) (precedential):

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.

As further explained below, Patent Owner requests that the Director deny institution based on these factors.

Factor 1: On May 9, 2025, the Court denied Petitioners' motion for stay. EX-2002. Petitioners will make much of the fact that the Court noted that Petitioners "may re-urge their motion to stay at such time as a decision on IPR as to all Asserted Patents has been issued." *Id.* at 7. But there are numerous reasons why such a renewed motion will be futile.

First, the parallel district court case is not limited to patent claims but includes U.S. Well's claims for breach of contract and trade secret misappropriation. EX-2003 (Amended Complaint) at 17–25. Indeed, the Court in denying the motion to stay relied on the non-patent claims as a reason for denial. EX-2002 at 3-4 ("Even if a stay of the patent infringement claims would not be

prejudicial [to U.S. Well], the same is clearly not true of [U.S. Well's] non-patent claims.”); *see also id.* at 5 (“[T]he PTAB’s decision will not impact Plaintiff’s breach of contract claim.”). There is no reason to believe that the Court will change its mind as to this prejudice to U.S. Well regarding the non-patent claims should Petitioners refile their motion to stay.

Second, the Court found that the trial date would be “all but certain to be extended by several months if a stay is granted. This factor weighs against granting a stay.” *Id.* at 5. The same logic will apply if Petitioners refile any motion to stay, rendering it highly unlikely that a renewed motion to stay would be granted.

Third, the Court also relied on the fact that the “parties have already expended significant resources in the prosecution and defense of this case” in denying the stay motion. *Id.* at 6. As the case is proceeding ahead, further significant resources are being expended, which also strongly shows that the Court is unlikely to entertain another motion to stay.

Thus, this factor weighs in favor of denying institution. *See Samsung Elecs. Co. v. Cal. Inst. of Tech.*, IPR2023-00130, Paper No. 10 at 16 (PTAB May 4, 2023) (finding that the district court’s decision to deny a motion to stay “weighs in favor of exercising authority to deny institution”).

Factor 2: Trial in the related district court proceeding has been rescheduled for March 30, 2026. EX-2007 (amended scheduling order) at 4. If the Board issues

its institution decision here in October 2025, the statutory deadline for the final written decision will be October 2026—that is, over six months after the scheduled trial date. *See Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper No. 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*.”); *ARM Ltd. v. Daedalus Prime LLC*, IPR2025-00207, Paper No. 10 (Director Decision on Discretionary Denial) (May 16, 2025) (denying institution and noting that the projected FWD due date is June 2026, whereas trial in the parallel case was scheduled for January 26, 2026).

Petitioners’ attempt to cloud the issue with general trial statistics (Pet. at 14) does not consider the specifics of this case—namely, that the trial date has already been rescheduled to account for any delay in the previous rescheduling of the *Markman* hearing and there is nothing in the schedule suggesting that the trial date would need to be pushed again. Thus, *Fintiv* factor 2 strongly favors denial.

Factor 3: The *Markman* hearing was held on April 30, 2025, and the Court issued its *Markman* Order on May 30, 2025. EX-2005. U.S. Well served its final infringement contentions and Petitioners served their final invalidity contentions on June 13, 2025. *See* EX-2007 (Amended Scheduling Order). By the time that the Board’s Institution Decision is due, fact discovery (completion deadline: August 8, 2025) and effectively expert discovery (completion deadline: October 17, 2025)

will also be completed. *Id.* Thus, both the Court and the parties have already invested, and will continue to invest, significant resources in the parallel case.

Indeed, in denying Petitioners' motion to stay, the Court highlighted the "significant resources" expended by the parties and the Court to date: "The parties have ***already expended significant resources*** in the prosecution and defense of this case." EX-2002 at 6. The District Court is in the best position to evaluate the investment the parties and the Court have made in the case, and given the above acknowledgment by the District Court, Patent Owner submits that *Fintiv* Factor 3 weighs heavily in favor of denying institution.

Factor 4: Both the District Court and the Board will engage in duplicative efforts addressing the same invalidity challenges unless the Board exercises its discretion to deny institution. For example, the same prior art and proposed combinations set forth in the Petition are used in Petitioner's invalidity contentions. *See* EX-2015, 21–22. These duplicative efforts by the Board and the Court raise the possibility of conflicting decisions from them because Patent Owner will face the same invalidity issues in both proceedings.

Patent Owner recognizes that Petitioners offered a *Sotera* stipulation.⁶ *See* Pet. at 14 (“Petitioners stipulate that, if the Board institutes IPR in this proceeding

⁶ Petitioner emailed a new stipulation to Patent Owner on June 16, 2025—that is, the due date for Patent Owner's discretionary denial briefing. Consequently, this new stipulation is untimely as Patent Owner was not given sufficient time to address this new stipulation. *See FAQs for Interim Processes for PTAB Workload Management*, FAQ 14 (“A petitioner should file a *Sotera* or *Sand* stipulation as soon as practicable, so that a patent owner may address the impact of the stipulation in its discretionary denial brief.”). In that email, Petitioners stipulated that “if the Patent Trial and Appeal Board institutes trial on U.S. Patent No. 11,959,533 on the grounds presented in the petition in Case No. IPR2025-00778, Petitioners will not pursue an invalidity defense in the related district court action Case No. 4-24-cv-00839 (SDTX) that the patent claims subject to the instituted IPR are invalid based on grounds that were raised or reasonably could have been raised in the IPR.” EX-2014. Petitioners' stipulation does not foreclose the District Court from having to address all invalidity defenses, such as defenses based on system art. *See Ingenico Inc. v. IOENGINE, LLC*, No. 2023-1367 (Fed. Cir. May 7, 2025).

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.”). A *Sotera* stipulation, however, is no longer enough to avoid discretionary denial. *See* EX-2010, 4 (rescinding guidance and stating that “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; *Motorola Sols. v. Stellar, LLC*, IPR2024-01205, Paper No. 19, *on director review* (Mar. 28, 2005) (vacating institution and denying institution, and holding that a *Sotera* stipulation did not outweigh the significant investment in parallel proceedings).

Further, by the time the Board issues an institution decision that would potentially trigger Petitioners’ *Sotera* (or any broader) stipulation, the parties will have completed fact and expert discovery. Consequently, Liberty’s stipulations will not mitigate the duplicative work the parties will engage in addressing Petitioners’ same invalidity arguments here and in the parallel case. This raises “concerns of

inefficiency,” *Fintiv* at 12, that can be largely avoided if Patent Owner's request for discretionary denial is granted.⁷ Factor 4 thus weighs in favor of denial.

Factor 5: Petitioners and Patent Owner are the same parties involved in the related district court litigation. EX-1018 at 1. This factor favors discretionary denial.

Factor 6: The merits of Petitioners' Grounds are weak, as demonstrated by the Board's decision denying institution in *Liberty Energy v. U.S. Well Services*, IPR2025-00066, Paper No. 10 (PTAB Apr. 29, 2025) involving U.S. Well's 258 patent (the parent of the 533 patent) (EX-2006, referred to herein as the “258 Patent ID”).

The 533 patent is a continuation of the 258 patent (*see* EX-1001, Related U.S. Application Data). The 258 patent claims, *inter alia*, a “plurality of motors driving a multi-plunger hydraulic fracturing pump” using a “gear train” having

⁷ Patent Owner understands that the Director's decision will issue “within 1 month” of the POPR being filed. *See FAQs for Interim Processes for PTAB Workload Management*, FAQ 8. If institution is denied by August 16, 2025, the parties will avoid having to address Liberty's invalidity grounds here and instead can focus their efforts solely on the litigation.

“multiple pinion gears in rotational contact with the motors,” the gear ratio and speed of the motors being selected to limit a maximum pump speed.” EX-2012 (258 patent, claim 1).

In the 258 patent IPR, Petitioners asserted eighteen different obviousness grounds, with two different primary references: Buckley and Yi. *See* 258 Patent ID at 7–10. For every ground, Petitioners added a secondary reference (Bergan), “the knowledge of a POSITA, and, in the alternative, Jeleska.” *Id.* Depending on the challenged claim(s), Petitioners added further secondary references to their obviousness combinations: Tutterow; Nesbitt; Rosman; and/or Payne. For example, grounds 12 and 13 (identified by Petitioners as “6A” and “6B”) asserted: Buckley, Bergan, Payne, Rosman, the knowledge of a POSITA, and, in the alternative, Jelaska and Nesbitt; and Yi, Bergan, Payne, Rosman, the knowledge of a POSITA, and, in the alternative, Jelaska and Nesbitt; respectively. *Id.*

Petitioners were thus required to show, at a minimum, that a POSITA would have been motivated to combine Buckley with Bergan, and/or Yi with Bergan. Patent Owner disputed that Petitioners had done so, arguing, *inter alia*, that “Petitioner’s combinations are based on impermissible hindsight.” *Id.* at 19. The Board agreed. *Id.* While Buckley and Bergan both disclosed motors connected to gear systems, they were designed for different purposes and uses. As the Board found with respect to combining Buckley and Bergan:

Although both Buckley and Bergan relate to oil and gas drilling systems, Buckley and Bergan *do not use their motors and gear systems for a sufficiently similar purpose*. Buckley and Bergan's gear systems drive different types of devices and, thus, are designed for different purposes. Buckley is concerned with "an electric drive pump used to drive a fluid end for the pumping of a fracturing fluid into a well." [Citation Omitted]. Bergan is concerned with driving the drum of a hoist in a manner that provides both active and passive heave compensation on a floating rig.

258 Patent ID at 19-20. The Board pointed out that gear systems of the type disclosed and claimed in the 258 patent "are designed differently for different purposes" and cited with approval the testimony of Patent Owner's expert that "[f]ailing to meticulously design, test, and manufacture a gear system for a specific application can be catastrophic." *Id.* at 20.

Because Buckley and Bergan were designed for different purposes, it was incumbent on Petitioners to explain why a POSITA would have been motivated to modify Bergan's gear system for use in Buckley's system in the manner set forth in the 258 patent claims. But as the Board found, Petitioners failed to do so:

Petitioner *does not sufficiently show* that a POSITA would have known that Bergan's planetary gear system, which is designed to

drive, and provide heave compensation to, a hoisting drum on a floating platform, *would be suitable for use* in Buckley to drive an electric drive pump used to drive a fluid end for the pumping of a fracturing fluid into a well. Petitioner appears to acknowledge that at least some changes would be needed to Bergan's planetary gear system to make it suitable to drive Buckley's fracturing pump. Pet. at 18 ("A POSITA would have been motivated to combine Bergan's planetary gear system, with appropriate changes to gear sizes that would have been obvious to a POSITA, with Buckley's pump system . . ."). Neither Petitioner nor Dr. Durham [Petitioners' expert] *sufficiently explains what changes would be needed or why a POSITA would have been motivated* to make such changes.

258 Patent ID at 20. Thus, the Board found that Petitioners and their expert impermissibly relied on hindsight bias to "stitch[] together prior art patches into something that is the claimed invention." *Id.* at 22 (quoting *Metalcraft of Mayville, Inc. v. The Toro Co.*, 848 F.3d 1358, 1367 (Fed. Cir. 2017)).

The Board found that Petitioners' attempt to combine Yi with Bergan fared no better. As the Board explained, "Petitioner's analysis for claim 1 under Ground 1B parallels Petitioner's analysis for claim 1 under Ground 1A, except that Petitioner substitutes Yi for Buckley." *Id.* at 25. Further, "Petitioner's rationales for

modifying Yi with Bergan, the knowledge of a POSITA, and Jelaska are substantially similar to Petitioner's rationales for modifying Buckley with Bergan, the knowledge of a POSITA, and Jelaska." *Id.* The Board thus found that this combination likewise failed:

For the same reasons explained in connection with Ground 1B [Buckley and Bergan], we determine Petitioner does not sufficiently establish that a POSITA would have been motivated to first incorporate Bergan's planetary gear system into Yi's fracturing pump and to then further modify the planetary gear system so that a gear ratio is selected to limit a maximum pump speed, given a POSITA's knowledge and Jelaska's teaching of how to calculate a gear ratio. *Id.* at 25. The Board therefore denied the 258 patent petition "for failing to show a reasonable likelihood that any of claims 1-20 is unpatentable." *Id.* at 26.

The Board's analysis in the 258 Patent ID applies with equal, if not greater, force here as to the 533 patent. The 533 patent, like the 258 patent, claims, *inter alia*, "a multi-plunger hydraulic fracturing pump," a "plurality of motors positioned to power" the fracturing pump, and a "planetary gear train" having a "plurality of input pinion gears connected to the plurality of motors." EX-1001, claim 1.

Turning to the Petition, Liberty asserts sixteen different obviousness grounds, but once again it relies on the *same* two primary references—Buckley and Yi—and the *same* main secondary reference—Bergan—as in the 258 patent IPR. *See* Pet. at 11-12. And Petitioners' arguments for combining Buckley and Bergan, and Yi and Bergan, are the *same* as those that the Board found lacking in the 258 Patent ID. *Compare* EX-2013 (Durham Declaration in Support of 258 patent IPR) ¶¶ 141–50, *with* EX-1003 (Durham Declaration in Support of 533 patent IPR) ¶¶ 148–56 (Petitioners' expert making materially identical arguments for why a POSITA would have combined Buckley and Bergan in both proceedings); EX-2013 (Durham Declaration in Support of 258 patent IPR) ¶¶ 180–91, *with* EX-1003 (Durham Declaration in Support of 533 patent IPR) ¶¶ 216–27 (Petitioners' expert making materially identical arguments for why a POSITA would have combined Yi and Bergan in both proceedings).

Because the Board has already found in the 258 Patent ID that these arguments for combining Buckley and Bergan and Yi and Bergan are lacking, it necessarily follows that those combinations have no merit against the 533 patent claims either. If anything, Petitioners' Grounds against the 533 patent are even weaker. The minimum number of references that Petitioners require to argue obviousness here is five (*see* Pet. at 11, Grounds 1A, 1B (asserting five-reference obviousness combinations of Buckley, Bergan, August, Joyner, Morris for Ground

1A and Yi, Bergan, August, Joyner, Morris for Ground 1B). For some grounds, the combinations balloon to eight references. *See* Grounds 8A, 8B. This is the epitome of hindsight. *See Interconnect Planning Corp. v. Feit*, 774 F.2d 1132, 1138–39 (Fed. Cir. 1985) (“From its discussion of the prior art it appears to us that the court, guided by the defendants, treated each reference as teaching one or more of the specific components for use in the Feil system, although the Feil system did not then exist. Thus, the court reconstructed the Feil system, using the blueprint of the Feil claims. As is well established, this is legal error.”).

For at least these reasons, there is objective evidence in the form of the Board's 258 Patent ID showing that the merits of Petitioners' grounds in this IPR are weak. Accordingly, *Fintiv* factor 6 also favors denial.⁸

⁸ 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 *Fintiv* factor 6.

For these reasons, all *Fintiv* factors favor that this Petition be denied on discretionary grounds. Patent Owner respectfully requests that the Director so find and grant Patent Owner's request for discretionary denial.

V. THE DIRECTOR SHOULD DENY INSTITUTION BECAUSE THE PETITION FAILS TO PROVIDE FOCUSED EXPERT TESTIMONY AND ALSO FAILS THE PARTICULARITY REQUIREMENT UNDER 35 U.S.C. § 312(A)(3)

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.*

A better example of failing to provide focused expert testimony than what Petitioners have proffered here would be hard to find. Petitioners rely on a 286-page expert declaration containing 445 numbered paragraphs addressing sixteen different grounds applying eleven different references. *See* EX-1003. The expert declaration is (by page count) three 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.

Finally and relatedly, discretionary denial is also appropriate because the Petition fails to identify “with particularity, each claim challenged” (35 U.S.C. § 312(a)(3)), and this failure “results in voluminous and excessive grounds [here, sixteen grounds with up to eight possible references per ground]”⁹ that warrant denial “in the interests of efficient administration of the Office and integrity of the patent system and as a matter of procedural fairness to Patent Owner.” *Adaptics* at 24 (informative).

The law is clear that a petition must identify “with particularity, each claim challenged, the grounds on which the challenges to each claim are based, and the evidence that supports the grounds for challenge to each claim.” 35 U.S.C. § 312(a)(3); *see also Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (noting the importance of the “initial petition identify[ing] with particularity the evidence that supports the grounds for the challenge to each claim.”). Where a petition fails to meet the particularity requirement, the Board may exercise its discretion to deny the entire petition. *Adaptics* at 24. This discretionary denial authority is particularly important even if only one ground fails to meet the particularity requirement because the Board must

⁹ Grounds 8A and 8B rely on eight separate references.

either institute review of all claims and challenges or of no claims and deny institution. *See* 37 C.F.R. § 42.108(a); Consolidated Trial Practice Guide (“CTPG”),¹⁰ 64 (PTAB Nov. 2019); *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1359–62 (Fed. Cir. 2018); *Adidas AG v. Nike, Inc.*, 894 F.3d 1256, 1258 (Fed. Cir. 2018). The Board may “retain[] discretion to deny institution of the petition as a whole . . . even when the petition includes at least one claim subject to a challenge that otherwise meets the criteria for institution.” CTPG, 64 (citing *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper No. 7 (PTAB Jan. 24, 2019) (informative); *Chevron Oronite Co. v. Infineum USA L.P.*, IPR2018-00923, Paper No. 9 (PTAB Nov. 7, 2018) (informative)).

As explained herein, all of Petitioner's sixteen grounds are obviousness grounds based on a multiplicity of prior art combinations. Pet. at 11–12. Indeed, all sixteen grounds require the Board to evaluate obviousness based on a minimum of five references, with many grounds relying on more than five references. *Id.* Most egregious, Grounds 8A and 8B each contain a minimum of eight references—excessive combinations that the Board would have to analyze for Claims 24 and 25

¹⁰ Available at: <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

alone. Pet. at 12.¹¹ Petitioner does not offer any substantive analysis or explanation of either Ground 8A or 8B for Claims 24 and 25, other than referring back to Petitioner's same arguments with respect to Claims 5 and 6, respectively. Pet. at 94–95. Indeed, Grounds 8A and 8B are comparable to the “catch-all” ground in *Adaptics* that was determined to be “not reasonably bounded in scope and unduly burdensome for both Patent Owner and the Board to address.” *Adaptics* at 21. Rightfully so, as such an undertaking to analyze Petitioners' voluminous combinations would be an unduly burdensome task for Patent Owner and an inefficient use of the Board's time and resources.

As previously noted, a petition that “results in voluminous and excessive grounds” may be denied institution. *Adaptics* at 24. The Trial Practice Guide also advises Petitioners to “avoid submitting a repository of all the information that a judge could possibly consider, and instead focus on concise, well-organized, easy-to-follow arguments supported by readily identifiable evidence of record.” Office

¹¹ As to Claims 24 and 25, Ground 8A recites Buckley, Bergan, August, Joyner, Morris, Rosman, Payne, and Karassik. Similarly, Ground 8B addressing Claims 24 and 25 recites Yi, Bergan, August, Joyner, Morris, Rosman, Payne, and Karassik.

Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,763 (Aug. 14, 2012). But submitting “concise, well-organized, [and] easy-to-follow arguments” is not what the Petitioners have done here—Petitioners instead submitted *sixteen* distinct grounds and ask the Board to analyze up to eight references in a single ground to cobble together a single theory of invalidity. *See, e.g.*, Pet. at 94–95 (Grounds 8A and 8B). This is improper. *Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365, 1371–72 (Fed. Cir. 2023) (condemning strategy of “throwing mountains of evidence at the Board without explanation or identification of the relevant portions of that evidence” and stating that judges “are not like pigs, hunting for truffles buried in briefs”); *see also Microsoft Corp. v. FG SRC, LLC*, 860 F. App’x 708, 713 (Fed. Cir. 2021) (“It is not the Board’s job to cobble together assertions from different sections of a petition or citations of various exhibits in order to infer every possible permutation of a petitioner’s arguments.”).

For these reasons also, Patent Owner requests that the Director grant Patent Owner’s request for discretionary denial.

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.

IPR2025-00778
Patent 11,959,533

Patent Owner's Discretionary Denial Brief

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 6,186 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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