

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIBERTY ENERGY, INC. AND LIBERTY ENERGY SERVICES LLC,
Petitioners,

v.

U.S. WELL SERVICES, LLC,
Patent Owner.

IPR2025-01539
U.S. Patent No. 11,668,420

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Declaration of Richard H. Quarles ISO PHV Admission
2002	Civil Action No. 2:24-cv-00884-JRG-RSP – Defendants' Amended Answer and Counterclaims (Adding Patent Infringement Counterclaims) to Plaintiff's Complaint
2003	Case No. 2:24-cv-00884-JRG-RSP – Order to Sever Counterclaims
2004	Case No. 2:25-cv-00522-JRG-RSP – Scheduling Order
2005	Case No. 2:25-cv-00522-JRG-RSP – Liberty's Invalidity Contentions
2006	Federal Court Management Statistics-Profiles, <i>available at</i> https://www.uscourts.gov/data-news/reports/statistical-reports/federal-court-management-statistics/federal-court-management-statistics-june-2025 (last visited Nov. 5, 2025)
2007	USPTO Rescission of Memorandum Addressing Discretionary Denial Procedures
2008	Case No. 4:24-CV-00839-KPE – Liberty Motion to Stay
2009	Case No. 2:25-cv-00522-JRG-RSP – Joint (Agreed) Motion for Entry of Docket Control Number

Pursuant to the Acting Director's March 26, 2025 Memorandum titled *Interim Processes for PTAB Workload Management*, Patent Owner U.S. Well Services, 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.

I. INTRODUCTION

Petitioners Liberty Energy, Inc. and Liberty Energy Services LLC ("Petitioners") attempt to burden the Board and Patent Owner with duplicative litigation despite clear U.S. Patent and Trademark Office precedent striking down such "significant duplication of effort" that results in "additional [and needless] expense for the parties" as exemplified by a wave of recent discretionary denial decisions denying institution where parallel litigation is scheduled to begin before anticipated final written decision. *Tesla, Inc. v. Granite Vehicle Ventures LLC*, IPR2025-00943, Paper No. 17 at 2–3 (PTAB Sep. 26, 2025) (granting discretionary denial where trial date was scheduled four months before projected final written decision, based on the "significant duplication of effort" and "additional expense for the parties"); *Tesla, Inc. v. Granite Vehicle Ventures LLC*, IPR2025-01034, Paper No. 13 at 2 (PTAB Oct. 10, 2025) (same); *Klein Tools, Inc., v. Milwaukee Elec. Tool Corp. & Keter Home & Garden Prods., Ltd.*,

IPR2025-01018, Paper No. 14 at 2–3 (PTAB Oct. 10, 2025) (granting discretionary denial where target date for completion of parallel litigation in the ITC was ***less than three weeks*** before projected final written decision); *Samsung Elecs. Co. v. Genghiscomm Holdings, LLC*, IPR2025-00899, Paper No. 10 at 2 (PTAB Sep. 26, 2025) (granting discretionary denial where trial date was scheduled five months before projected final written decision).

Here, trial in the parallel district court case is scheduled to begin October 5, 2026, nearly ***six months before*** the projected April 9, 2027 final written decision due date. Even when applying the median 25.1-month time to trial statistic, trial in the parallel district court case would commence December 4, 2026—still ***over four months before*** the projected final written decision due date. This case thus represents a textbook example where referral to the Board “would be an inefficient use of Board resources,” thus meriting discretionary denial. *NVIDIA Corp. v. Neural AI, LLC*, IPR2025-00606, Paper No. 18 at 3 (PTAB July 31, 2025).

This proceeding should also be discretionarily denied pursuant to the additional *Fintiv* factors as discussed *infra*, including (1) the parties to this proceeding are the same as in the parallel litigation; (2) a stay in the district court litigation is highly unlikely; and (3) there is a significant overlap between issues raised in the petition and in the parallel proceeding.

Finally, as explained below, 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 order that no trial be instituted.

II. BACKGROUND FACTS

Patent Owner and Petitioners are parties to the litigation *Liberty Energy Services, LLC v. ProFrac Services, LLC*, Case No. 2:24-cv-00884 (E.D. Tex.) (the “884 District Case”), which was filed on November 1, 2024. Patent Owner, as one of the Defendants (Counterclaim-Plaintiffs) in the 884 District Case, brought six patent infringement counterclaims against Petitioners (EX-2002, 20–43), who are Plaintiffs (Counterclaim Defendants) in the 884 District Case. Specifically, Patent Owner accused Petitioners of infringing six of Patent Owner's patents, including U.S. Patent No. 11,668,420 (the “420 Patent”) (the patent in this proceeding), U.S. Patent No. 11,211,801 (the “801 Patent”), U.S. Patent No. 11,009,162 (the “162 Patent”), U.S. Patent No. 12,012,952 (the “952 Patent”), U.S. Patent No. 11,067,481 (the “481 Patent”), and U.S. Patent No. 11,674,868 (the “868 Patent”). *Id.*

On May 11, 2025, Magistrate Judge Payne, the presiding judge in the 884 District Case, ordered that Patent Owner's six patent infringement counterclaims be severed from the 884 District Case and moved into a new case. EX-2003, 1–2. Accordingly, on May 13, 2025, *ProFrac Services, LLC, et al. v. Liberty Energy Services LLC*, Case No. 2:25-cv-00522 (E.D. Tex.) (the “522 District Case” or the “Parallel Litigation”) was opened to address Patent Owner's six patent infringement counterclaims against Petitioners that included, *inter alia*, infringement of the 162 Patent.

On October 6, 2025, Petitioners filed a petition for *inter partes* review of the 420 Patent (i.e., the instant IPR2025-01539 proceeding). Prior to the instant IPR2025-01539 proceeding, on August 27, 2025, Petitioners filed a petition for *Inter Partes* review of the 801 Patent. *See Liberty Energy Inc. v. U.S. Well Servs., LLC*, IPR2025-01424, Paper No. 1 (PTAB Aug. 27, 2025). And on August 29, 2025, Petitioners filed an IPR petition against the 162 Patent, to which the '420 Patent is a continuation. *See Liberty Energy Inc. v. U.S. Well Servs., LLC*, IPR2025-01445, Paper No. 1 (PTAB Aug. 29, 2025).

The Parallel Litigation is proceeding apace. By the time of the institution decision here (April 9, 2026), the parties will have completed claim construction discovery and claim construction briefing, with the *Markman* hearing scheduled soon thereafter on April 29, 2026. EX-2004, 3. Trial in the Parallel Litigation is

scheduled for October 5, 2026 (*Id.* at 1), which is nearly six months before the projected April 9, 2027 final written decision deadline in this IPR.

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

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: This factor weighs strongly against institution because it is highly unlikely that a stay would be granted in the Parallel Litigation. Petitioners have not sought a stay, and the institution decision here is expected by April 9, 2026. Based on the fact that the parties are direct competitors in the oilfield space, and the timing and number of additional asserted patents not subject to *inter partes* review in the Parallel Litigation, it is highly unlikely that Magistrate Judge Payne would grant a stay even if the Petition is instituted.

First, Petitioners cannot deny that they are direct competitors of Patent Owner in the oilfield space. *See, e.g.*, EX-2008, 6 (“The companies involved in this case provide hydraulic fracturing services and related technologies in oil and natural gas basins. Plaintiffs [U.S. Well] allegedly market and sell an all-electric hydraulic fracturing system called Clean Fleet.... The Liberty defendants have a fully integrated electric frac pump system called ‘digiFrac.’”). The Eastern District of Texas courts routinely deny motions to stay pending IPR when the parties are competitors. *Netlist, Inc. v. Samsung Elecs. Co.*, No. 2:22-CV-00293-JRG, 2024 WL 6043769, at *2 (E.D. Tex. Mar. 11, 2024) (denying motion to stay because, *inter alia*, the “delay caused by a stay is especially burdensome where the parties are competitors in the marketplace” (collecting cases)); *FlatFrog Lab ’ys, AB v.*

Chemtronics Co., No. 2:23-CV-0306-JRG-RSP, 2024 WL 3014621, at *3 (E.D. Tex. June 14, 2024) (Payne, J.) (denying stay and holding that the status of the parties as competitors “weighs significantly against staying this case”). Indeed, in *FlatFrog*, Magistrate Judge Payne denied the motion to stay even though the case was still in its early stages **and** the PTAB had instituted trials against all patents in the case. In denying the motion, Magistrate Judge Payne held that while “the Court might otherwise be inclined to grant a stay where Final Written Decisions on all asserted claims are expected very close to trial, the parties being direct competitors relevant to the accused products changes the balancing of factors.” *FlatFrog*, 2024 WL 3014621, at *3.

Moreover, as noted above, in the Parallel Litigation, Patent Owner has asserted infringement of five other patents in addition to the 420 Patent. Petitioners have not filed *inter partes* review petitions against three out of the six asserted patents, thus eliminating the possibility to date that the PTAB will institute review of all asserted claims of all asserted patents. In the Eastern District of Texas, “[i]t has been [the District] Court’s consistent and long-established practice to deny motions to stay pending IPR ... when [as here] the PTAB or PTO have instituted review on less than **all** asserted claims of **all** asserted patents.” *AGIS Software Dev. LLC v. Google LLC*, No. 2:19-CV-00359-JRG, 2021 WL 465424, at *2 (E.D. Tex. Feb. 9, 2021) (emphases added); *Force Mos Tech., Co. v. ASUSTek Computer*,

Inc., No. 2:22-CV-00460-JRG, 2024 WL 1586266, at *4 (E.D. Tex. Apr. 11, 2024) (“[T]he Court finds that the Motion [to Stay] should be ***denied with prejudice*** given that only two of the three Asserted Patents have been challenged at the PTAB. Specifically, because Defendant has not challenged [one patent at issue], the IPR[s] ***cannot simplify*** the issues related to the [unchallenged patent] in this case.”) (emphases added) (internal citations omitted).

A stay in the Parallel Litigation is thus ***highly unlikely***, and Factor 1 strongly favors discretionary denial.

Factor 2: This factor strongly favors discretionary denial. Trial in the related district court proceeding is scheduled to begin October 5, 2026. EX-2004, 1. If the Board issues its institution decision here in April 2026, the statutory deadline for the final written decision will be April 2027—that is, over ***six months after*** the scheduled trial date. *See Fintiv*, IPR2020-00019, Paper No. 11 at 9 (“If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising 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 final written decision due date is June 2026, whereas trial in the parallel case was scheduled for January 26, 2026).

As discussed *supra*, Magistrate Judge Payne ordered the original district court litigation—the 884 District Case—to be severed and moved into a new case, which resulted in the creation of the current 522 District Case (i.e., the Parallel Litigation). The 884 District Case was filed on November 1, 2024. Thus, even assuming a 25.1-month time-to-trial statistics period (EX-2006, 35) from the November 1, 2024 filing date of the 884 District Case, trial in the Parallel Litigation would still occur December 4, 2026—over *four months before* the Board's statutory deadline of April 9, 2027, in this IPR. Thus, *Fintiv* factor 2 strongly favors denial.¹

Factor 3: This factor favors denial. The parallel district court case will have progressed significantly by the institution deadline of April 9, 2026. Claim construction discovery, substantial completion of document production, and opening and responsive claim construction briefing will have already been completed, with the *Markman* hearing scheduled close behind on April 29, 2026.

¹ Any argument from Petitioners that trial in the Parallel Litigation is likely to be delayed is mere speculation and contrary to the record. The parties jointly agreed to the schedule entered by Magistrate Judge Payne, so Petitioners well knew that trial would take place on an accelerated schedule. *See* EX-2009.

EX-2004, 3–4. Thus, both the Court and the parties will have already invested significant resources in the parallel case.

Factor 4: This factor favors denial. Both the district court and the Board will engage in duplicative efforts addressing similar invalidity challenges unless the Board exercises its discretion to deny institution. For example, the same prior art references in the Petition² are used extensively in Petitioners' invalidity contentions as illustrated below. *Compare* EX-2005, 21–22, *with* Pet. at 16 (annotating prior art used in both proceedings as color coded and showing very high level of overlap).

² Gardner-Denver (Petition) was published in 2001 whereas Gardner-Denver (Invalidity Contentions) was published in 2005. Otherwise, all references set forth in the Petition except ANSI/HI 6.1 are also set forth in Petitioners' Invalidity Contentions.

Patent	Claims	Combinations
'420 patent	1-20	Cicci '348 alone or in combination with Liu 2003, Beisel '2855, the Evolution Wells System, Coli '5734, CNC Fittings, Kemper Fittings, Kajaria '545, Gardner Denver, and/or Dixon Frac Fittings
	1-20	Beisel '2855 alone or in combination with CNC Fittings, Liu 2003, Kemper Fittings, Beisel '2855, Kajaria '545, Gardner Denver, and/or Dixon Frac Fittings
	1-20	EWS System alone or in combination with CNC Fittings, Liu 2003, Kemper Fittings, Beisel '2855, Gardner Denver, Kajaria '545, Cicci '348, and/or Dixon Frac Fittings
	1-20	Kajaria '545 alone or in combination with Liu 2003, Beisel '2855, the Evolution Wells System, Coli '5734, CNC Fittings, Kemper Fittings, Cicci '348, and/or Dixon Frac Fittings
	1-20	Dixon Fittings alone or in combination with Liu 2003, Beisel '2855, the Evolution Wells System, Coli '5734, Cicci '348, Kajaria '545, Gardner Denver, and/or Kemper Fittings
	1-20	Coli '5734 alone or in combination with CNC Fittings, Cicci '348, Beisel '2855, the Evolution Wells System, Kajaria '545, Liu 2003, Kemper Fittings, Gardner Denver, and/or Dixon Frac Fittings
	1-20	ProFrac System alone
	1-20	Liberty Energy System alone or in combination with Liu 2003, Beisel '2855, the Evolution Wells System, or Coli '5734

EX-2005 (Liberty invalidity contentions), 21–22 (annotated).

Ground	Claims	Basis (35 U.S.C. §)	Prior Art
1	1-7, 9-16, 18-19	103	<i>Cicci</i> , <i>Coli</i> , <i>Dixon</i> , and <i>Liu</i>
2	1-19	103	<i>Cicci</i> , <i>Coli</i> , <i>Dixon</i> , <i>Liu</i> , and <i>Gardner-Denver</i>
3A	20	103	<i>Cicci</i> , <i>Coli</i> , <i>Dixon</i> , <i>Liu</i> , and <i>Kajaria</i>
3B	20	103	<i>Cicci</i> , <i>Coli</i> , <i>Dixon</i> , <i>Liu</i> , <i>Gardner-Denver</i> , and <i>Kajaria</i>
4	8, 17	103	<i>Cicci</i> , <i>Coli</i> , <i>Dixon</i> , <i>Liu</i> , <i>Kajaria</i> , <i>Gardner-Denver</i> , and <i>ANSI/HI 6.1</i>

Pet. at 16 (annotated).

Patent Owner recognizes that Petitioners offered a *Sotera* stipulation. EX-1060, 1 (“If IPR is instituted in IPR2025-01539, unless institution is later vacated, reversed, or otherwise withdrawn by rehearing, Director Review, or otherwise, Petitioners Liberty Energy, Inc. and Liberty Energy Services LLC stipulate that they and their co-defendant Liberty Advanced Equipment Technologies LLC will not pursue in the related district court case, Case No. 2:25-cv-00522 (E.D. Tex.), against U.S. Patent No. 11,668,420, the specific grounds asserted in the IPR, any other ground that could have been reasonably raised in the IPR (*i.e.*, any ground that could have been raised under §§ 102 or 103 on the basis of prior art patents or printed publications), and combinations of the prior art asserted in the IPR with unpublished system prior art (or any other type of prior art).”). A *Sotera* stipulation, however, is no longer enough to avoid discretionary

denial. *See* EX-2007, 1, 4 (rescinding guidance 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—expected April 9, 2026—the parties will have completed claim construction discovery, substantial completion of document production and exchange of opening and responsive claim construction briefing, with the *Markman* hearing scheduled close behind on April 29, 2026. EX-2004, 3–4. Consequently, Liberty's stipulations will not mitigate the duplicative work the parties will engage in addressing Petitioners' similar 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. Factor 4 thus weighs in favor of denial. *See Samsung Elec. Co. v. Mullen Indus. LLC*, IPR2024-01472, Paper No. 19 at 3 (PTAB July 17, 2025) (reversing Board's institution decision and rejecting argument that a *Sotera* stipulation supported the Board's decision because “[u]nder *Fintiv*'s holistic assessment, the merits of the Petition and Petitioner's *Sotera*

stipulation do not outweigh *Fintiv* factors 2 and 3. As such, the facts and circumstances indicate that the efficiency and integrity of the system are best served by denying institution.”).

Factor 5: Petitioners and Patent Owner are the same parties involved in the related district court litigation. EX-1001, 1. This factor strongly favors discretionary denial.

Factor 6: This factor favors denial because the Petition fails to identify “with particularity, each claim challenged” (35 U.S.C. § 312(a)(3)), as discussed *infra* in Section IV. Further, the merits of Petitioners’ grounds—which will be fully addressed in Patent Owner’s Preliminary Response—are weak, as further demonstrated by Petitioners’ inclusion in their invalidity contentions of a minimum of three additional references (“IC Asserted References”)—and, in most cases, four additional IC Asserted References—for each ground in their invalidity contentions (“Invalidity Contentions Grounds”) containing one or more asserted references from the Petition (“Petition Asserted References”). Even for Invalidity Contentions Grounds containing six Petition Asserted References, Petitioners included up to four additional IC Asserted References, as illustrated below. EX-2005, 21–22.

Patent	Claims	Combinations
'420 patent	1-20	Cicci '348 alone or in combination with Liu 2003, Beisel '2855, the Evolution Wells System, Coli '5734, CNC Fittings, Kemper Fittings, Kajaria '545, Gardner Denver, and/or Dixon Frac Fittings
	1-20	Beisel '2855 alone or in combination with CNC Fittings, Liu 2003, Kemper Fittings, Beisel '2855, Kajaria '545, Gardner Denver, and/or Dixon Frac Fittings
	1-20	EWS System alone or in combination with CNC Fittings, Liu 2003, Kemper Fittings, Beisel '2855, Gardner Denver, Kajaria '545, Cicci '348, and/or Dixon Frac Fittings
	1-20	Kajaria '545 alone or in combination with Liu 2003, Beisel '2855, the Evolution Wells System, Coli '5734, CNC Fittings, Kemper Fittings, Cicci '348, and/or Dixon Frac Fittings
	1-20	Dixon Fittings alone or in combination with Liu 2003, Beisel '2855, the Evolution Wells System, Coli '5734, Cicci '348, Kajaria '545, Gardner Denver, and/or Kemper Fittings
	1-20	Coli '5734 alone or in combination with CNC Fittings, Cicci '348, Beisel '2855, the Evolution Wells System, Kajaria '545, Liu 2003, Kemper Fittings, Gardner Denver, and/or Dixon Frac Fittings
	1-20	ProFrac System alone
	1-20	Liberty Energy System alone or in combination with Liu 2003, Beisel '2855, the Evolution Wells System, or Coli '5734

EX-2005, 21–22 (annotated with additional references in gold and showing Petitioners rely on *significant* additional art to supplement the references also asserted in the Petition). *Fintiv* factor 6 thus favors denial.

For these reasons, all *Fintiv* factors favor that this Petition be denied on discretionary grounds. Patent Owner respectfully requests that the Director deny trial in this proceeding.

IV. THE DIRECTOR SHOULD DENY INSTITUTION BECAUSE THE PETITION FAILS THE PARTICULARITY REQUIREMENT UNDER 35 U.S.C. § 312(a)(3) BY PRESENTING A MULTITUDE OF UNFOCUSED VOLUMINOUS GROUNDS

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, five grounds with up to *seven* possible references per ground]”³ 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). Indeed, Petitioners once again ignore the clear directive that “as a matter of policy, it is not an efficient use of Office resources to institute and maintain a trial when a petition presents a multitude of unfocused grounds leaving the work to be done by the Office.” *Zhuhai Cosmx Battery Co. v. Ningde Amperex Tech. Ltd.*, IPR2025-00405, Paper No. 24 at 2 (PTAB Oct. 15, 2025) (vacating the Board’s decision granting institution of *inter partes* review and denying institution of *inter partes* review).

The law is clear that a petition must identify “with particularity, each claim challenged, the grounds on which the challenges to each claim is based, and the

³ Ground 4 relies on seven separate references.

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”) (citation omitted). 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 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”),⁴ 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))

⁴ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

(informative); *Chevron Oronite Co. v. Infineum USA L.P.*, IPR2018-00923, Paper No. 9 (PTAB Nov. 7, 2018) (informative)).

All of Petitioners' five grounds are obviousness grounds based on a multiplicity of prior art combinations. Pet. at 16. Indeed, all five grounds require the Board to evaluate obviousness based on a minimum of four references, with four grounds relying on five or more references. *Id.* Most egregious, Ground 4 contains a minimum of **seven** references—excessive combinations that the Board would have to analyze for Claims 8 and 17 alone. *Id.*⁵ Indeed, Ground 4 is 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, 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

⁵ As to Claims 8 and 17, Ground 4 recites Cicci, Coli, Dixon, Liu, Kajaria, Gardner-Denver, and ANSI/HI 6.1.

judge could possibly consider, and instead focus on concise, well-organized, easy-to-follow arguments supported by readily identifiable evidence of record.” Office 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 Petitioners have done here—Petitioners instead submitted *five* distinct grounds and ask the Board to analyze up to *seven* references in a single ground to cobble together a single theory of invalidity. *See, e.g.*, Pet. at 85–91 (Ground 4). 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”) (citation omitted); *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 deny institution.

V. CONCLUSION

For the above reasons, Patent Owner respectfully requests that the Director order that no trial be instituted.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 9th day of December, 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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