

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTELLIGENT WELLHEAD SYSTEMS, INC.,
Petitioner,

v.

DOWNING WELLHEAD EQUIPMENT, LLC,
Patent Owner.

PGR2025-00002
U.S. Patent No. 12,134,952

**OPPOSITION TO PETITIONER'S MOTION
TO WAIVE WORD COUNT**

TABLE OF CONTENTS

I. Introduction.....1

II. Petitioner voluntarily filed a single petition challenging ALL claims
instead of following the Consolidated Trial Practice Guide 2

III. The Proposed Petition contravenes the purpose of the Board’s word
count rules.....6

IV. The number of words in the claims do not justify exceeding the word
limit.....8

V. Conclusion 10

Certificate of Service 11

PATENT OWNER'S EXHIBIT LIST

Ex.2001	Email from Trials dated 01/10/25
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I. INTRODUCTION

On November 14, 2024, Intelligent Wellhead Systems, Inc. (“Petitioner”) filed a Petition seeking post-grant review of claims 1–78 of U.S. Patent 12,134,952 (the “’952 patent”). Paper 2, “Proposed Petition.” Petitioner’s counsel certified that the word count for the Proposed Petition was **23,020 words**—more than 4,300 words over the 18,700 word count limit for post-grant review petitions set forth in 37 C.F.R. § 42.24(a)(1)(ii). Concurrently with filing the Proposed Petition, Petitioner filed a motion to waive the word count pursuant to 37 C.F.R. § 42.24(a)(2) (Paper 4, “Motion”), as well as an “Abbreviated Petition” (Paper 3) that Petitioner’s counsel certified is compliant with the word limit. Downing Wellhead Equipment, LLC (“Patent Owner”) opposes the motion to waive the word count and respectfully requests that the Board only consider the Abbreviated Petition. Authorization for this opposition was provided by the Board via email on January 10, 2025. Ex.2001.

The Motion should be denied because Petitioner’s alleged inability to comply with the word count limit is the result of its own choices. First, Petitioner elected to challenge an unasserted patent that it has not been accused of infringing. Second, Petitioner elected to challenge all 78 claims, rather than waiting to understand which claims may be relevant in a hypothetical litigation. But, *even if* all 78 claims were relevant, the Consolidated Trial Practice Guide explains that the

proper course of action would be to file more than one petition. Third, Petitioner elected to challenge the claims under *ten distinct grounds*—including multiple § 112 grounds and four different §§ 102/103 grounds—rather than presenting only its strongest arguments. The very purpose of the word count rule is to prevent unduly burdensome petitions like the one proposed by Petitioner. Even ignoring all this, Petitioner’s main justification for requesting extra words—the “5,941 words” in the claims—is facially deficient. Petitioner only reproduced a small fraction of those 5,941 words in the body of the petition, relying instead on references to a “Table of Claims” outside of the word count limit.

Petitioner’s Motion should be denied.

II. PETITIONER VOLUNTARILY FILED A SINGLE PETITION CHALLENGING ALL CLAIMS INSTEAD OF FOLLOWING THE CONSOLIDATED TRIAL PRACTICE GUIDE

Petitioner’s request for the Board to waive one of its rules is not reasonable when the Consolidated Trial Practice Guide (“CTPG”) sets forth a course of action that would avoid such waiver, multiple petitions.

As an initial matter, proceedings before the Board are “voluntar[y],” even when the challenged patent has been asserted in district court. *Dragon Intell. Prop. LLC v. DISH Network L.L.C.*, 101 F.4th 1366, 1371 (Fed. Cir. 2024). Here, the ’952 patent has not been asserted, so Petitioner has even less basis for its assertion that “all claims must be challenged.” Motion, 4. Moreover, under 35 U.S.C.

§ 321(c), Petitioner had until August 2025—nine months from the date of issuance of the '952 patent—to determine if the '952 patent would even be asserted, and if so, which claims would be asserted. But instead, Petitioner hurried to file the Proposed Petition without knowing the relevant issues, or whether it would be sued on the '952 patent *at all*. Willful blindness is not a reasonable basis for exceeding the word count limit.

Even assuming Petitioner was somehow required to challenge all 78 claims of the '952 patent, the CTPG sets forth the proper course of action Petitioner should have taken in this case—file multiple petitions. Although the CTPG acknowledges that one petition is usually sufficient to challenge the claims of a patent, it also recognizes that “there may be circumstances in which more than one petition may be necessary, including, for example, *when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references.*” CTPG, 59 (emphasis added). This case falls squarely under these circumstances, where Petitioner alleges that there is a “high likelihood that all 78 claims of the '952 Patent will otherwise be asserted against Petitioner in litigation” and the Proposed Petition “addresses priority” due to the '952 patent's “complicated” family history. Motion, 4–5. “In such cases two petitions by a petitioner may be needed.” CTPG, 59.

Although Petitioner alleges that parallel petitions are “disfavored,” Motion, 8, this argument is contradicted by the CPTG, which expressly acknowledges that parallel petitions may be “necessary” in cases such as this one. CTPG, 59. Indeed, Petitioners routinely file multiple petitions based on the number and length of the claims.¹ See, e.g., *Freewheel Media, Inc. v. Intent IQ, LLC*, IPR2024-00421, Paper 9, 12–13 (Oct. 2, 2024); IPR2024-00422, Paper 10, 12–15 (Oct. 2, 2024) (granting institution on multiple petitions challenging all claims of a patent containing 152 claims “spanning over 10 columns”); *Samsung Electronics Co., Ltd. v. CardWare Inc.*, PGR2023-00012, Paper 14, 13–14 (Aug. 11, 2023); PGR2023-00013, Paper 14, 12–16 (Aug. 11, 2023) (granting institution on multiple petitions challenging all 27 claims of a patent, where one petition challenged the claims under 35 U.S.C. §§ 101 and 112 and the second petition challenged the claims under obviousness); *Samsung Electronics America, Inc. v. Snik LLC*, IPR2020-01427, Paper 10, 12–13 (Mar. 9, 2021); IPR2020-01428,

¹ Patent Owner does not concede that the Board should institute on multiple petitions in this case. Patent Owner only argues that, if Petitioner wanted to challenge all claims on multiple grounds and bypass the word limit, the proper course of action was to file multiple petitions complying with the Board’s word count limit.

Paper 10, 13 (Mar. 9, 2021); IPR2020-01429, Paper 10, 12–13 (Mar. 9, 2021) (granting institution and explaining that three petitions were warranted due to “the large number of claims at issue” in the form of “55 claims spanning five columns of patent text”).

Petitioner argues that parallel petitions “would not necessarily solve the word count issue” because the overlap and interrelatedness of claims “makes it impossible to divide the claims into separate petitions without duplicating claim language, arguments, and grounds across all petitions.” Motion, 8. But a review of the grounds challenged in the Proposed Petition reveals that this issue was easily avoidable if Petitioner were so motivated. The Proposed Petition presents invalidity challenges under several different statutory grounds: §§ 101, 112, 102, 103. Proposed Petition, 5–6. Rather than including all ten grounds in a single Petition, Petitioner could have, for example, filed one petition challenging the claims under §§ 101 and 112 and a second petition challenging the claims under §§ 102 and 103, avoiding duplication of grounds and arguments, as demonstrated in *Samsung*, PGR2023-00012, Paper 14, 13–14; PGR2023-00013, Paper 14, 12–16. Alternatively, Petitioner could have reduced the claim sets filed in a petition by filing one set of claims in a first petition and the remaining set in a second petition. Petitioner had many avenues to avoid a word count issue, but instead chose to file an overly long and burdensome petition.

Because (i) Petitioner's own questionable choices are driving its request to waive the word count limit, and (ii) the CTPG provides a solution that would avoid such waiver, the Board should deny the Motion.

III. THE PROPOSED PETITION CONTRAVENES THE PURPOSE OF THE BOARD'S WORD COUNT RULES

The CTPG explains that the purpose of word count limits is to “ease the burden on both the parties and the courts” and require the parties to focus the Board's attention on the most compelling arguments. CTPG, 39 (first citing *Spaziano v. Singletary*, 36 F.3d 1028, 1031 n.2 (11th Cir. 1994); then citing *Microsoft Corp. v. DataTern, Inc.*, 755 F.3d 899, 910 (Fed. Cir. 2014)). Indeed, the CTPG recognizes that word count limits apply to post grant proceedings because “[t]he Board's experience is that the presentation of an overwhelming number of issues tends to detract from the argument being presented, and can otherwise cause meritorious issues to be missed or discounted.” *Id.* Accordingly, the CTPG indicates that “parties should 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.” *Id.* In other words, word count limits ensure parties make strategic calls and only present their strongest arguments to the Board, rather than present an overwhelming number of issues.

Rather than presenting only its strongest arguments, the Proposed Petition attempts to shoehorn in every possible argument against all 78 claims of the '952 patent—unduly burdening Patent Owner and taxing the Board's finite resources. As explained above, the Proposed Petition presents *ten different grounds* challenging the validity of the '952 patent claims, including *four* different challenges under § 112 and *four* alternative prior art combinations under §§ 102 and 103. Proposed Petition, 5–6. Moreover, this is not a case where multiple prior art grounds are needed to address different sets of claims. Instead, the Proposed Petition challenges *all 78 claims* under *four different prior art combinations*. Proposed Petition, 5–6. These duplicative efforts indicate that the Proposed Petition is not presenting the most “meritorious issues” and easing the burden of the Board, as the CTPG instructs. Instead, the Proposed Petition is an attempt to add additional grounds unworthy of Board consideration that should be weeded out by the word count.

Petitioner also argues that the Board's word limit is insufficient for Petitioner “to address all 78 claims” while still “meet[ing] its burden of proof.” Motion, 2. But Petitioner's inability to meet its burden of proof under *ten different grounds* and *four different prior art combinations* under the governed word count is a strategic choice and a problem of its own making.

In asking the Board to waive the word count, Petitioner does exactly what

word count limits are intended to prevent—present “an overwhelming number of issues” that will “detract from the argument being presented” and “cause meritorious issues to be missed or discounted.” CTPG, 39. Accordingly, the Motion should be denied.

IV. THE NUMBER OF WORDS IN THE CLAIMS DO NOT JUSTIFY EXCEEDING THE WORD LIMIT

Petitioner requests extra words because “the claims by themselves are 5,941 words” and “[s]imply reproducing words of the claims would account for nearly a third of the 18,700 word limit.” Motion, 1, 3 (emphasis omitted). But here, the number of words in the claims do not justify exceeding the word limit because Petitioners *only reproduced a fraction of the claim language* in the body of the Proposed Petition.²

The Proposed Petition included a “Table of Claims” designating claim and limitation numbers associated with the claim language. Proposed Petition, xv–xxxviii. But the words in the Table of Claims are not included in Petitioner’s certification of the number of words, which “exclude[es] those portions identified

² Patent Owner estimates that the Proposed Petition only reproduced approximately 1,900 words out of the 5,900 words in the claims—roughly only 32% of the total words in the claims.

in 37 C.F.R. § 42.24(a),” such as a “claim listing.” Proposed Petition, 145; 37 C.F.R. § 42.24(a). In the portion of the Proposed Petition that does count towards the word limit, Petitioner predominantly refers to the claims simply by their claim and limitation number, without including the corresponding claim language. *See, e.g.,* Proposed Petition, 41, 49, 85, 88, 90–91, 95, 111–119, 128, 132–138. Because Petitioner does not include most of claim language in body of the Proposed Petition, Petitioner's main rationale for waiving the word count fails.³

Petitioner's attempt to waive the word count limit and file a single petition is an attempt to bypass the Board's word limit rules and avoid the filing fees associated with multiple petitions. Although Petitioner alleges that it includes with its Proposed Petition filing fees “totaling \$135,950,” including “excess claim fees of \$88,450 for the 58 claims in excess of 20,” it acknowledges that the total filing fees for two petitions “would be at least \$174,300.” Motion, 6, 8 n.10. Petitioner further suggests it is “doubtful” that it would be able to challenge the remaining 72 claims not addressed in its Abbreviated Petition in one petition “without exceeding the 18,700 word limit.” Motion, 8 n.10. But this *also* is a problem of Petitioner's

³ Because Petitioner did not reproduce around 4,000 words of the claims—and now seeks an additional 4,300 words—Petitioner effectively gains an extra 8,300 words, which is equivalent to a 27,000 word petition.

own making. Petitioner chose to include in the Abbreviated Petition all but one of the ten grounds in the Proposed Petition rather than present only the most meritorious arguments. Abbreviated Petition, 5 (presenting nine grounds under §§ 101, 112, 102, 103).

V. CONCLUSION

For the foregoing reasons, Petitioner's motion to waive the word count should be denied.

Respectfully submitted,

Dated: January 17, 2025
HAYNES AND BOONE, LLP
2801 N. Harwood Ave, Ste 2300
Dallas, Texas 75201
Customer No. 27683

/Scott T. Jarratt/
Scott T. Jarratt
Lead Counsel for Petitioner
Registration No. 70,297

CERTIFICATE OF SERVICE

This will certify that pursuant to 37 C.F.R. § 42.6(e), a true and correct copy of the foregoing was served on Petitioner as detailed below:

Date of Service January 17, 2025

Manner of Service Electronic Service: terry@obwb.com;
margonis@obwb.com;
cooper@obwb.com;
witbeck@obwb.com;
schechter@obwb.com;
OBWB-IWS-Downing@obwb.com

Document served ***Opposition to Petitioner's Motion to Waive Word Count and Ex.2001***

Persons served Tammy J. Terry
Lisa E. Margonis
Laura J. Witbeck
Califf T. Cooper
Peter C. Schechter
OSHA BERGMAN WATANABE & BURTON LLP
1100 Louisiana St., Suite 4900
Houston, Texas 77002

/Scott T. Jarratt/

Scott T. Jarratt
Lead Counsel for Petitioner
Registration No. 70,297