

PGR2025-00002
Patent No. 12,134,952

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
Patent No. 12,134,952

**PETITIONER'S REPLY IN SUPPORT OF MOTION TO WAIVE WORD
COUNT PURSUANT TO 37 C.F.R. § 42.24(a)(2)**

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Intelligent Wellhead Systems, Inc. (“IWS”/“Petitioner”) respectfully submits this Reply in Support of its Motion to Waive Word Count. Patent Owner (“PO”) responds to Petitioner’s Motion by falsely casting Petitioner’s choices as “questionable,” and mischaracterizing the Consolidated Trial Practice Guide (“CTPG”), associated rules, and case law as though Petitioner was *required* to file multiple petitions. PO’s arguments are fundamentally incorrect and miss the point. As discussed in Petitioner’s Motion, the Proposed Petition (Paper 2) serves efficiency, preserves resources, and ensures a complete and fair adjudication of the issues presented in this case. The Board should therefore grant IWS’s motion.

I. PRECEDENT SUPPORTS PETITIONER’S REQUEST

The Board increases word counts where, like here, the increase is justified and necessary to serve efficiency, preserve resources, and ensure a complete and fair adjudication. *See, e.g., Merck Sharp & Dohme LLC v. Johns Hopkins Univ.*, IPR2024-00240, Paper 36, 3 (Oct. 2, 2024) (increasing word count for POR by 3500 words to address 8 invalidity grounds challenging 42 claims); *Twitter, Inc. v. Palo Alto Research Center, Inc.*, IPR2021-01398, Paper 12, 47 (Mar. 15, 2022) (granting petitioner’s motion to waive word count); *Assoc. British Foods PLC et al. v. Cornell Research Foundation, Inc.*, IPR2019-00577, Paper 49, 4 (Nov. 6, 2019) (granting motion to increase word count). PO ignores these relevant cases and instead cites cases involving multiple petitions—but none of those cases stand for the proposition

that a petitioner cannot request waiver of word count. Here, the increase in word count is justified and will promote efficiency and a complete resolution.

II. THE CTPG SUPPORTS PETITIONER'S REQUEST

PO's argument that Petitioner should have filed multiple petitions rather than requesting a word count waiver (Opp. at 2) is without merit. Contrary to PO's assertions otherwise, the CTPG does *not* mandate multiple petitions in cases like this. Although the CTPG says that multiple petitions "may be needed," nowhere does it state that in every instance filing multiple petitions is "the proper course," as PO argues. To the contrary, two petitions (with 37,400 words) would have unnecessarily duplicated claim language; background explanations of the technology, patent, and prior art; legal standards; priority analysis; and other arguments and evidence, leading to inefficiencies that a single 23,020-word petition avoids. Indeed, the CTPG *expressly authorizes* motions to waive word count. CTPG, 37.

In arguing that IWS should have split the petition into two petitions, PO misses the point. Dividing types of grounds into two petitions still would have required repeating claim language for all 78 claims, not to mention other sections, and so would *not* actually reduce word count nor reduce the burden on the Board. Nor does dividing claims into different petitions solve the word count issue or reduce burden on the Board because both petitions would have to repeat the same Section 101/112 grounds due to language similarity across the claims (see Exhibit 1007).

Even more troubling are the estoppel effects under 35 U.S.C. § 325(e) that would have resulted from multiple petitions—a point PO completely ignores. If, for example, IWS had separated Section 101/112 grounds in one petition and Section 102/103 grounds in another petition (as PO suggests), a significant estoppel problem could have resulted if the Board denied institution of the Section 101/112 petition but granted institution of the Section 102/103 petition. In such a case, the '952 Patent might never receive review on Section 101/112 issues in any venue, even though a final written decision regarding that petition never issued. In such a scenario, the Section 101/112 issues would never receive appellate review because institution decisions are not appealable, and estoppel would prevent consideration of such issues in district court because Section 101/112 issues arguably “reasonably could have been raised” in the Section 102/103 petition that was instituted.

If, on the other hand, Petitioner had split claims between two petitions as PO suggests, strikingly similar claims could receive irreconcilably inconsistent results. Neither result is in the interest of justice.

III. WORD LIMITS SHOULD NOT PREVENT A COMPLETE CHALLENGE

This patent has 78 claims, including 6 independent claims, that together encompass nearly 6,000 words. With 78 claims there are going to be more grounds than in a petition challenging a patent with fewer claims, particularly in a PGR, which allows challenges under §§ 101, 112, 102, and 103. Contrary to PO's

arguments that Petitioner failed to narrow its grounds to its strongest, Petitioner put considerable effort into narrowing issues and only including the strongest grounds.

Indeed, Petitioner selected only four Section 102/103 grounds based on *only two primary references*. And, significantly, one of those primary references required additional extensive priority and prior-art exception analyses, further adding to the necessary word count. Meanwhile, the only other grounds are a Section 101 ground, which applies to all claims, and four Section 112 grounds that are only so divided because of claim groupings resulting from *PO's chosen claim language and claim count*. PO's argument that the number of grounds presented in the petition is somehow excessive is a meritless red herring.

PO's claim-listing argument is another red herring. Petitioners are required to specifically set forth the grounds of unpatentability in a petition, which requires discussion of claim language sufficient to provide the analysis necessary for the Board to render decisions on unpatentability. That is exactly what Petitioner has done. PO ignores, for example, the multitude of claim charts throughout the Petition that explicitly recite each and every limitation of the claims. PO further ignores extensive discussion of claim language throughout the Petition. Indeed, the Proposed Petition presents the arguments and evidence in a streamlined organized manner that reduces unnecessary burden on the Board.

PO's argument that the '952 Patent claims have not yet been asserted is yet another red herring. Any "person who is not the owner of a patent" may file a request for PGR of that patent. 35 U.S.C. § 321(a). There is no requirement that a petitioner must have been sued on the challenged patent. Regardless, all evidence suggests that IWS has no choice but to challenge all claims. PO initiated litigation against IWS nearly 2 years ago asserting the '952 Patent's parent and grandparent patents. Given the substantial overlap in subject matter between patents, and that most of '952's claims are even broader than the claims asserted in the related litigation, the only reasonable assumption was that PO was planning to assert these claims against IWS. Besides, notably missing from PO's response is any stipulation from PO *not* to assert certain claims against IWS. Without such a stipulation, PO's argument rings hollow.

Finally, PO's argument that granting the waiver would unfairly advantage Petitioner is belied by Petitioner's statement that it would not oppose a proportional increase in PO's response limit. PO's fairness concerns are unfounded.

IV. CONCLUSION

In the interests of justice, Petitioner respectfully requests waiver of the word count requirement and acceptance of Petitioner's Proposed Petition.

Dated: January 24, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that a true and correct copy of the foregoing **Petitioner's Reply In Support Of Motion to Waive Word Count Pursuant to 37 C.F.R. § 42.24(a)(2)** was served on January 24, 2025, via email to all counsel for Patent Owner at the following:

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