

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 12,134,952 B2

Before BENJAMIN D. M. WOOD, CARL M. DEFRANCO, and
FREDERICK C. LANEY, *Administrative Patent Judges*.

LANEY, *Administrative Patent Judge*.

ORDER
Granting Petitioner's Motion to Waive Word Count
37 C.F.R. § 42.5

Intelligent Wellhead Systems, Inc. (“Petitioner”) filed a Petition seeking post-grant review of claims 1–78 of U.S. Patent 12,134,952 B2 (“the ’952 patent”). Paper 2 (“Proposed Petition”). Petitioner’s counsel certified that the word count for the Proposed Petition was 23,020 words, which is 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. With our authorization (Ex. 2001), Downing Wellhead Equipment, LLC (“Patent Owner”) filed a response opposing the Motion and requests that the Board only consider the Abbreviated Petition. Paper 8 (“Opposition”). And Petitioner filed a reply to Patent Owner’s opposition. Paper 9 (“Opposition Reply”).

Petitioner contends that the additional words are necessary in this case because the ’952 patent has 78 claims, including 6 independent claims that span almost a full patent column each. Motion, 1. Furthermore, in view of the fact that Patent Owner has already asserted other *related* patents against Petitioner’s products and the fact that there are “broad post-grant review estoppel” implications, Petitioner contends that “[g]iven the number and length of ’952’s claims and the variety of their fatal defects, [it] could not properly present challenges covering all 78 claims and all bases of unpatentability within the word limits for a single petition.” *Id.* at 2.

Petitioner represents having “made every effort to present its arguments . . . in one petition that complies with § 42.24(a)(1)(ii)’s word count requirement while meeting Petitioner’s burden of proof” by not “repeat[ing] theories or explanations when claim limitations overlap,” but

still “[t]he overlap is not exact” and additional analysis was still necessary to account for the differences to meet its burden of proof. Motion, 2.

Furthermore, Petitioner contends that

there is no adequate subset of claims that can be challenged without leaving Petitioner exposed to just as much risk of litigation as if no claims had been challenged at all. And because there are several grounds of unpatentability, including patent ineligibility due to the claims being directed to an abstract idea (35 U.S.C. § 101), lack of written description support (§ 112(a)), improper new matter (§ 132), improper dependency (§ 112(d)), and only five §§ 102 & 103 grounds (based on only two different primary references), an increased word count in this case is necessary for Petitioner to fully explain the arguments for cancellation, as required by the [Board’s particularity requirements].

Id. at 4. In Petitioner words, “[t]his is a classic case where adequately presenting all legitimate grounds in a single petition is impossible without modifying the word limit.” *Id.* at 3. The interests of justice weigh in favor of waiving the word limit, according to Petitioner, because the “only other options are either to (a) face wasteful duplicative litigation against unchallenged claims that never should have issued, or (b) file parallel petitions, which . . . can raise complicated estoppel issues, and would cost Petitioner substantially more in filing fees.” *Id.* at 8.

Patent Owner counters by contending that “Petitioner’s alleged inability to comply with the word count limit is the result of its own choices.” Opposition, 1. Patent Owner criticizes Petitioner for *electing to*: (1) “challenge an unasserted patent that it has not been accused of infringing;” (2) “challenge all 78 claims, rather than waiting to understand which claims may be relevant in a hypothetical litigation;” and (3) “challenge the claims under ten distinct grounds—including multiple

§ 112 grounds and four different §§ 102/103 grounds—rather than presenting only its strongest arguments.” *Id.* at 1–2. Patent Owner says, “[t]he very purpose of the word count rule is to prevent unduly burdensome petitions like the one proposed by Petitioner.” *Id.* at 2.

Patent Owner faults Petitioner for filing a single petition, rather than breaking the claims up into two separate petitions. *See* Opposition 2–6. Patent Owner asserts that “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.” *Id.* at 2. Patent Owner contends Petitioner’s decision to seek additional words for a single petition is problematic because the CPTG “expressly acknowledges that parallel petitions may be ‘necessary’ in cases such as this one.” *Id.* at 3. And Patent Owner criticizes Petitioner’s suggestion that the circumstances here are ill-suited for two-petitions because “[r]ather 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.” *Id.* at 5. Ultimately, Patent Owner asserts, “Petitioner had many avenues to avoid a word count issue, but instead chose to file an overly long and burdensome petition.” *Id.*

Patent Owner argues that Petitioner is simply trying to “contravene[] the purpose of the Board’s word count rules.” Opposition, 6. Patent Owner argues that the word count rule is important to “ensure parties make strategic calls and only present their strongest arguments to the Board, rather than present an overwhelming number of issues.” *Id.* And “[r]ather than presenting only its strongest arguments,” Patent Owner asserts that “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.” *Id.* at 7. Patent Owner asserts that, “[i]nstead [of presenting the most ‘meritorious issues’], the Proposed Petition is an attempt to add additional grounds unworthy of Board consideration that should be weeded out by the word count.” *Id.*

After considering the arguments presented by both parties, as well as reviewing the Petition, we are persuaded that, in this case, Petitioner has demonstrated good cause for increasing the word limit by 4,320 words. Most notably, although Patent Owner notes that Petitioner had available other choices, Patent Owner fails to demonstrate how Petitioner's use of the additional words in the Petition are unreasonable or wasteful. Cutting the other way, however, Patent Owner appears to concede that the number, as well as length, of claims in the '952 patent, and issues presented by those claims, would warrant *two* petitions under the Board's CTPG. Under these circumstances, Petitioner's request for additional words to address the voluminous claims of the '952 patent and the associated issues presented by those claims is reasonable. In particular, considering the interrelatedness of the issues presented by the different grounds and length/quantity of the challenged claims, we agree with Petitioner that the fairest and most efficient way to proceed is a single petition, but with an increased word limit. Additionally, we are not persuaded Petitioner, here, should be faulted for not waiting until it has been accused of infringement in litigation in order to, hopefully, be able to file a petition within the defined word limit; this is especially true considering the fact that Patent Owner has already sued Petitioner for infringing related patents. Therefore, we grant the Motion.

Accordingly,

It is ORDERED that the word count limit for the Petition is increased by 4,320 words to 23,020 words total;

It is further ORDERED that the Proposed Petition entered as Paper 2 is accepted and the Abbreviated Petition entered as Paper 3 is not accepted;

It is further ORDERED that the word count limit of the Patent Owner Response, should one become necessary, is likewise increased by 4,320 words to 23,020 words total;

It is further ORDERED that no other changes to word count limits or briefing is authorized at this time.

PETITIONER:

Tammy Terry
Lisa Margonis
OSHA BERGMAN WATANABE & BURTON LLP
terry@obwbip.com
margonis@obwbip.com

PATENT OWNER:

Scott Jarratt
Tiffany Cooke
Andrew B. Drott
Laura Vu
Caroline W. Fox
HAYNES AND BOONE, LLP
scott.jarratt.ipr@haynesboone.com
tiffany.cooke@haynesboone.com
andrew.drott@haynesboone.com
laura.vu.ipr@haynesboone.com
caroline.fox.ipr@haynesboone.com