

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GD ENERGY PRODUCTS, LLC
Petitioner,

v.
KERR MACHINE COMPANY
Patent Owner.

PGR2025-00031
U.S. Patent 12,152,582

**PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST
FOR DISCRETIONARY DENIAL OF INSTITUTION**

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EXHIBIT LIST

Exhibit No.	Title
Ex. 1001	U.S. Patent No. 12,152,582 (“Foster”)
Ex. 1002	File History for U.S. Patent No. 12,152,582
Ex. 1003	Expert Declaration of William D. Marscher, P.E.
Ex. 1004	Kerr KP-3300HP Plunger Pump Service Manual (“Kerr”)
Ex. 1005	Dupagro Apex SC65 Manual (“Apex”)
Ex. 1006	U.S. Patent No. 7,186,097 to Blume (“Blume”)
Ex. 1007	U.S. Pre-Grant Publication No. 2005/0200081 to Stanton et al. (“Stanton”)
Ex. 1008	U.S. Patent No. 7,773,833 to Wilkinson et al. (“Wilkinson”)
Ex. 1009	Affidavit of Tanya Zeif
Ex. 1010	Igor J. Karassik, Pump Handbook (4 th ed. 2008), Chapter 3
Ex. 1011	Kerr Pump KP-3300HP Spec Sheet
Ex. 1012	Kerr Website Homepage Screenshot from March 7, 2012
Ex. 1013	Kerr Website PT-3300HP Offer For Sale from December 28, 2014
Ex. 1014	Kerr Website Classic Pump Products from January 18, 2016
Ex. 1015	Buckhorn Pumps Website Kerr Plunger Pump Manuals from March 17, 2016
Ex. 1016	RESERVED
Ex. 1017	Dupagro Manuals and Parts Lists Website from May 12, 2016
Ex. 1018	Declaration of Mark DeBoy

Ex. 1019	DECLARATION IN SUPPORT OF PETITIONER'S MOTION FOR <i>PRO HAC VICE</i> ADMISSION OF LARRY L. SHATZER
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I. Introduction

Pursuant to Acting Director Stewart’s March 26, 2025 Memorandum titled “Interim Processes for PTAB Workload Management” (“Workload Memo”), GD Energy Products, LLC (“Petitioner”) provides this Opposition to Patent Owner Kerr Machine Company’s (“Patent Owner”) Request for Discretionary Denial of Institution (“Request”).

The purpose of post grant review is to provide a meaningful avenue to challenge the validity of a patent without a lawsuit, thereby avoiding litigation costs. Indeed, when Congress created post grant review procedures, the stated aim was to provide an efficient adjudication mechanism with which to improve patent quality. *E.g.*, 157 Cong. Rec, vol. 157, num. 33, S1326 (March 7, 2011). In seeking discretionary denial precisely because Patent Owner has yet to file a suit based on U.S. Patent No. 12,152,582 (“the ‘582 Patent”), the Request not only ignores this purpose but seeks to have the Director turn this purpose on its head. In so doing, the Petition also improperly asks the Director to ignore the overwhelming strength of the invalidity grounds presented in the Petition.

Moreover, the Request foregoes any analysis of the *Fintiv* factors because discretionary denial under *Fintiv* is clearly inappropriate – there is no litigation proceeding in parallel with the present post grant review. *See Apple Inc. v. Fintiv, Inc.*, Case IPR2020-00019, Paper 11 (March 20, 2020). Instead, the Request draws

on a subset of the factors enumerated in the Workload Memo. Workload Memo at 2-3. Patent Owner's arguments, however, ignore the goals of improved efficiency and consistent application of discretionary considerations in the institution of AIA proceedings. *Id* at 3. Instead, Patent Owner asks the Board to discretionarily deny the Petition based on principles that are contrary to the purpose of post grant review and that, if accepted, will waste substantial Board and judicial resources.

Appropriate consideration of the factors shows that discretionary denial is not appropriate and that '582 Patent claims' validity is ripe for adjudication by the PTAB.

II. The Strength of the Invalidity Grounds Favors Institution

Despite 2 ½ months having elapsed between the filing of the Petition and the filing of the Request, Patent Owner argues that "Because Kerr has not completed its analysis of the petition's asserted grounds, at this stage of the proceeding, [the strength/weakness of the validity challenge] should be considered neutral." Request at 11. Nothing could be further from the truth and Patent Owner cannot obviate the significance of this factor simply by choosing not to address it. Indeed, the Petition presents *multiple* extremely strong invalidity grounds, some of which are based on *Patent Owner's own products that were publicly advertised and on sale years prior to the earliest effective filing date of the '582 Patent*. The strength of the invalidity grounds strongly disfavors discretionary denial of the Petition and favors institution.

a) Brief Technical Background

By way of background, the '582 Patent is directed to a reciprocating pump. *See, e.g.,* EX1001, 2:60-65. Reciprocating pumps are a class of positive displacement pumps widely used in various industries for transferring fluids by utilizing a back-and-forth (reciprocating) motion. *Id.* The reciprocating motion of a piston or plunger within a cylinder creates alternating low and high-pressure zones, facilitating fluid intake and discharge. EX1003, ¶33.

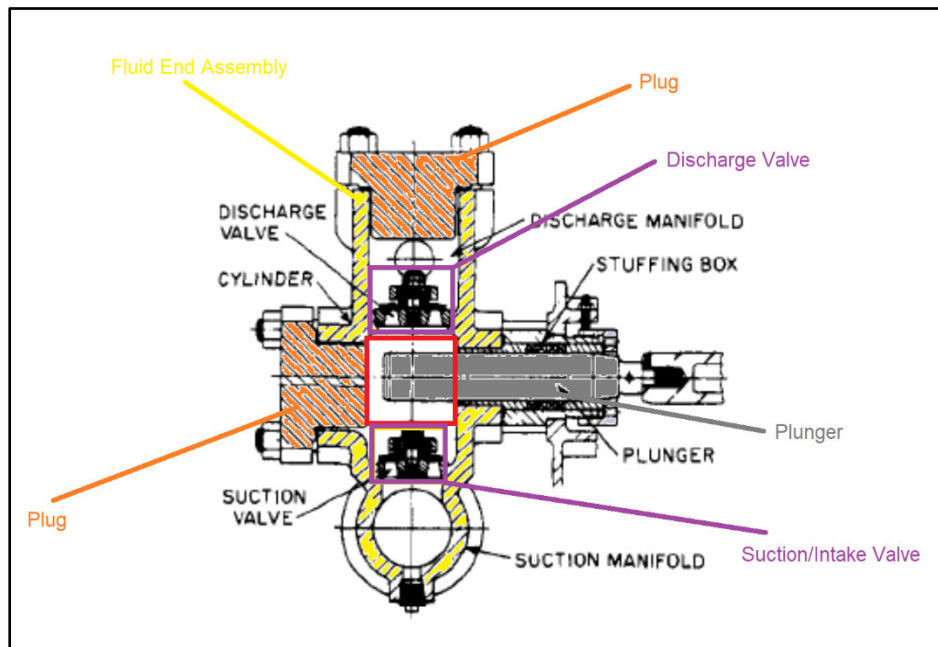
A reciprocating pump primarily includes two main sections: the liquid or fluid end and the power end. EX1010 at 22, 28. The power end is responsible for converting mechanical energy into the reciprocating motion that drives the fluid end. EX1010 at 28-33. The power end comprises components that generate and transfer the necessary force to move the piston or plunger, including a motor or engine that drives the pump. *Id.* The motor/engine connects to a crankshaft that converts rotational motion into the reciprocating motion of the piston/plunger. EX1010 at 28-30. Connecting rods link the crankshaft to the piston/plunger. EX1010 at 31.

The fluid end defines or houses the pumping structures and mechanisms responsible for pressurizing and directing the fluid. EX1010 at 22-28. For example, fluid ends contain at least one internal chamber into which fluid enters and exits in response to reciprocation of the plunger/piston. EX1010 at 22-24. A suction valve arranged within the fluid end allows fluid to enter into one of the internal chambers

during the intake stroke and prevents backflow during the discharge stroke. EX1003, ¶37; EX1010 at 27. A discharge valve arranged within the fluid end permits fluid to exit the internal chamber during the discharge stroke and seals off the chamber during the intake stroke. EX1003, ¶37; EX1010 at 27. Each internal chamber may have a pair of suction and discharge valves.

The reciprocating motion of plungers or pistons inside the fluid end creates the pumping action. EX1003, ¶38 EX1010 at 24-25. Packing seals and/or stuffing boxes surround the plunger or piston to prevent fluid leakage and to maintain pressure. EX1003, ¶38; EX1010 at 25-26.

The figure below illustrates a typical reciprocating horizontal power pump fluid end cross-section, taken from Chapter 3 of the Pump Handbook edited by Igor Karassik (EX1010) and annotated for clarity. EX1003, ¶39; EX1010 at 22. The conventional fluid end includes an internal chamber formed from a horizontal bore and a vertical bore, a piston or plunger driven by the power end arranged in the horizontal bore, suction and discharge valves arranged in the vertical bore, and plugs covering the bores that provide access to the valves and internal chamber. EX1003, ¶39; EX1010 at 22. When the plunger/piston is retracted by the power end (*i.e.*, the intake stroke), fluid is drawn into the chamber via the suction valve, and when the plunger/piston is extended (*i.e.*, the discharge stroke), the fluid is driven out of the chamber via the discharge valve. EX1003, ¶39.



EX1010, 22 (annotated).

Reciprocating pumps can be single cylinder, meaning they have a single reciprocating plunger or piston. EX1003, ¶42; EX1010 at 21-22. Reciprocating pumps can also be constructed as multiplex pumps. EX1003, ¶42; EX1010 at 21-22. Multiplex pumps, such as duplex (two plungers/pistons) or triplex (three plungers/pistons) configurations, use multiple plungers/pistons operating in staggered sequences. EX1003, ¶42; EX1010 at 21-22. Skilled artisans (i.e., “persons of ordinary skill in the art” or “POSITAS”) understand that each of the plunger/piston assemblies has the same structure. EX1003, ¶ 89.

b) The Invalidity Grounds

The features recited in the claims of the ‘582 Patent, as will be shown below, are all notoriously well-known components used in reciprocating pumps prior to the

filing of the earliest application in the ‘582 Patent priority chain. Petitioner has presented a number of very strong invalidity grounds, and therefore, this consideration weighs strongly in favor of institution of the Petition.

All of the features of independent claim 1 of the ‘582 Patent would have been obvious to the POSITA based on the Kerr KP-3300HP Plunger Pump Service Manual (“Kerr Pump”, EX1004) which describes *Patent Owner’s own prior art* PT-3300HP Pump, which Patent Owner failed to disclose during the prosecution of the application that issued as the ‘582 Patent. The vast majority of the features claimed in the independent claims of the ‘582 Patent are illustrated in the cross-sectional images from the ‘582 Patent and the Kerr Pump:

1. A fluid end assembly, comprising:

a housing made of a single, integrally-formed piece

[annotated in yellow] and comprising:

a first horizontal bore [annotated in green] and a first vertical bore [annotated in blue] formed within the housing, the first vertical bore intersecting the first horizontal bore to form a first internal chamber [annotated in red];

...

a first pair of valves [annotated in dark purple], each valve installed within the first vertical bore and positioned on opposite sides of the first internal chamber;

...

a first plug [annotated in orange] and a first reciprocating plunger [annotated in grey] installed within the first horizontal bore and positioned on opposite sides of the first internal chamber;

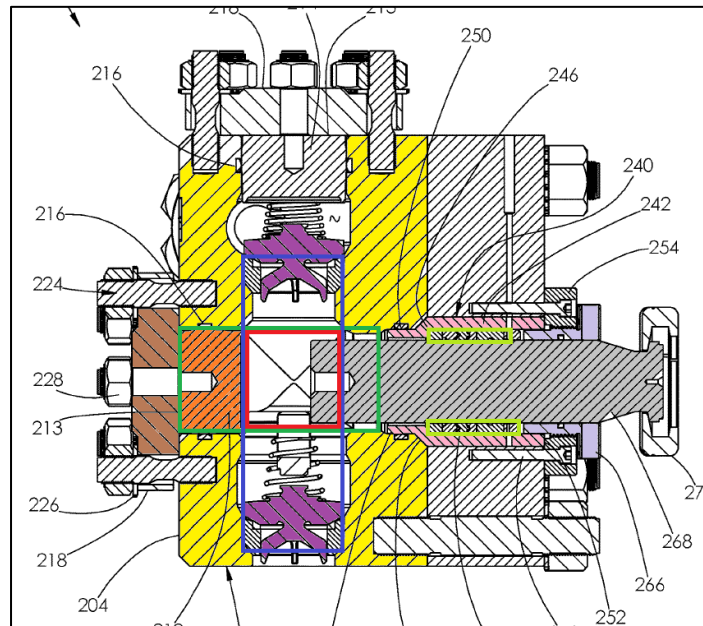
...

a plate [annotated in brown] fastened to the housing along an exterior surface containing openings to the first and second horizontal bores;

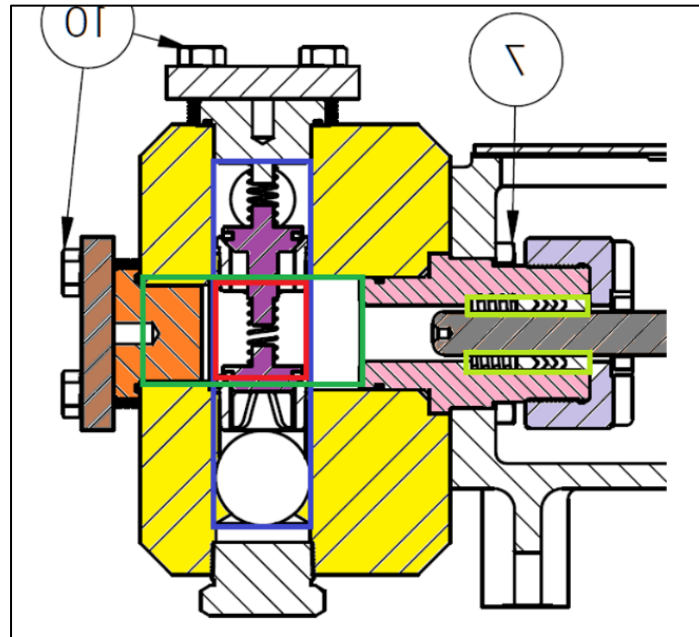
a first component [annotated in pink] having a central opening formed therein, at least a portion of the first component installed within the first horizontal bore and at least a portion of the first reciprocating plunger installed within the central opening of the first component;

a first plurality of packing seals [annotated in light green] installed within the first component and engaging the first reciprocating plunger; and

a first packing nut [annotated in light purple] attached to the first component and holding the first plurality of packing seals within the first component.



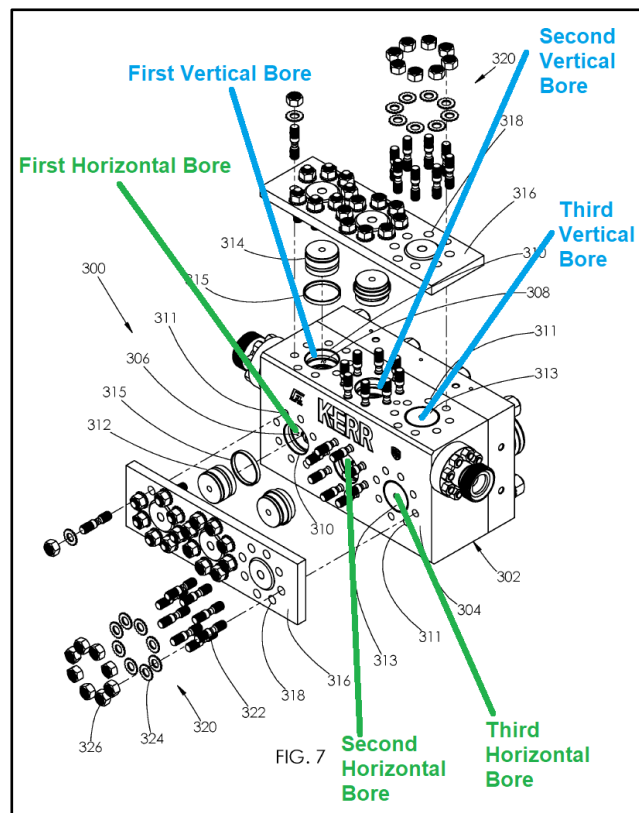
EX1001, FIG. 6 (annotated)



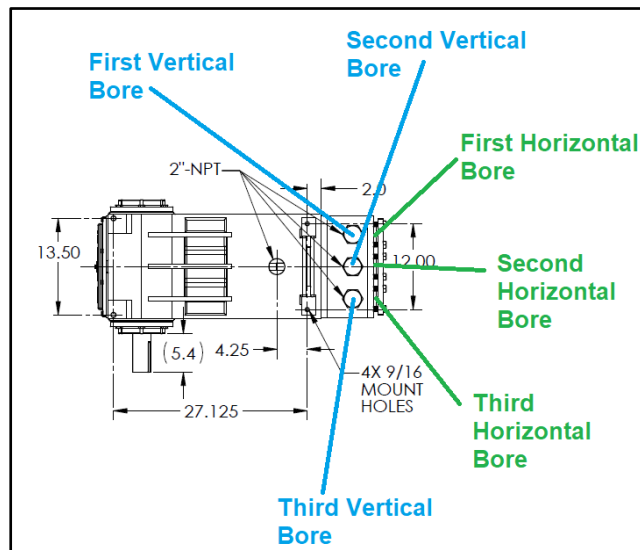
EX1004, 26 (flipped and annotated)

The remaining features from the independent claims of the '582 Patent are also present in Patent Owner's Kerr Pump, as they are all "second" versions of other

elements arranged within a different plunger assembly of the disclosed triplex pump. As illustrated in the annotated figures below, the exemplary embodiments from the '582 Patent and the Kerr Pump are triplex pumps both of which include three plunger assemblies, in which each plunger assembly is provided in a side-by-side relationship with the other plunger assemblies.



EX1001, FIG. 7 (annotated)



EX1004 at 25 (annotated)

As further explained by Petitioner’s expert, “each plunger assembly is one of a homologous series (of three in this case, given the triplex pump being the example), each member of which has the same structure.” EX1003, ¶ 89. Accordingly, it would have been obvious to the POSITA that Patent Owner’s prior art Kerr Pump also includes the remaining features from claim 1, specifically:

a second horizontal bore and a second vertical bore formed within the housing, the second vertical bore intersecting the second horizontal bore to form a second internal chamber;

in which the second horizontal bore, the second vertical bore, and the second internal chamber are situated in a side-by-side relationship with the first horizontal bore, the first vertical bore, and the first internal chamber;

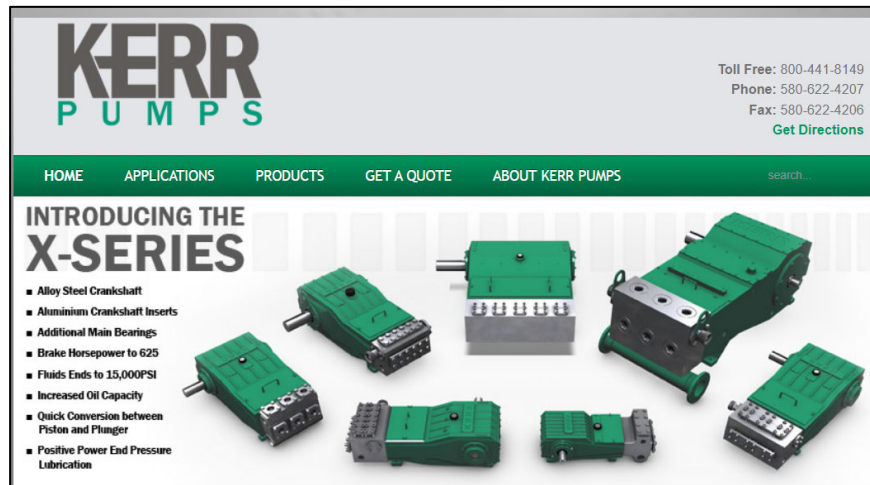
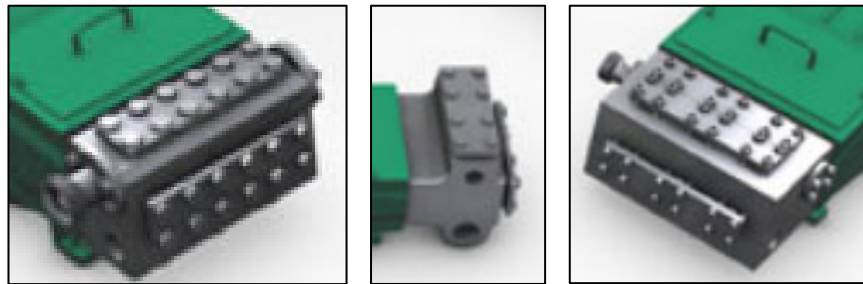
...

a second pair of valves, each valve installed within the second vertical bore and positioned on opposite sides of the second internal chamber;

...

a second plug and a second reciprocating plunger installed within the second horizontal bore and positioned on opposite sides of the second internal chamber;

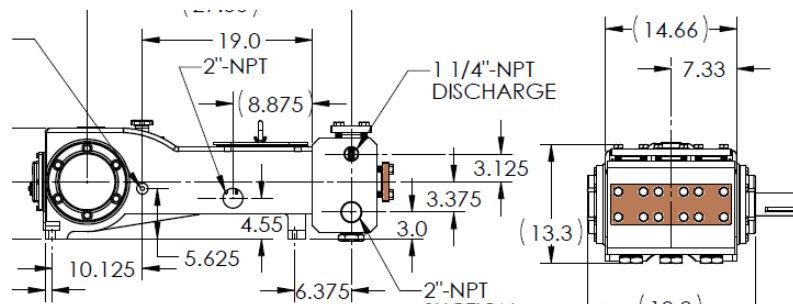
Far from being neutral, Petitioner submits that the invalidity grounds presented are instead extremely strong. This should not come as a surprise. The vast majority of the features recited in the claims are conventional components of a reciprocating plunger pump fluid end (*see* Section II.a, *supra*), with the purported novelty of the ‘582 Patent attributed to securing the horizontal bore plugs (i.e., the recited “first plug” and “second plug”) with “a plate fastened to the housing along an exterior surface containing openings to the first and second horizontal bores.” EX1002, 6 (“Allowable Subject Matter”). Patent Owner has, however, disclosed such plates on its website going back to *at least* 2012, *five years prior to the July 14, 2017 filing date of the first filed application in the ‘582 Patent’s priority chain*:



EX1009 at 23.

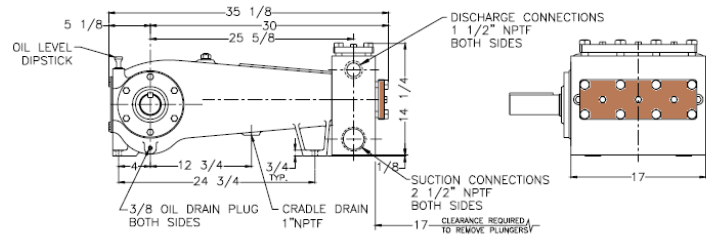
It is precisely due to the conventional nature of all of the features of the claims of the '582 Patent, including the allegedly novel "plate," that Petitioner has been able to present *numerous* strong invalidity grounds, grounds showing the obviousness of providing such a "plate" based on:

- Petitioner's own prior art (Grounds 1 and 4)



EX1004 at 25 (annotated).

- Patent Owner's competitors' products and printed publications
(Ground 2)



EX1005 at 8 (annotated).

- Patent literature dating back to the late 1980s (Ground 3)

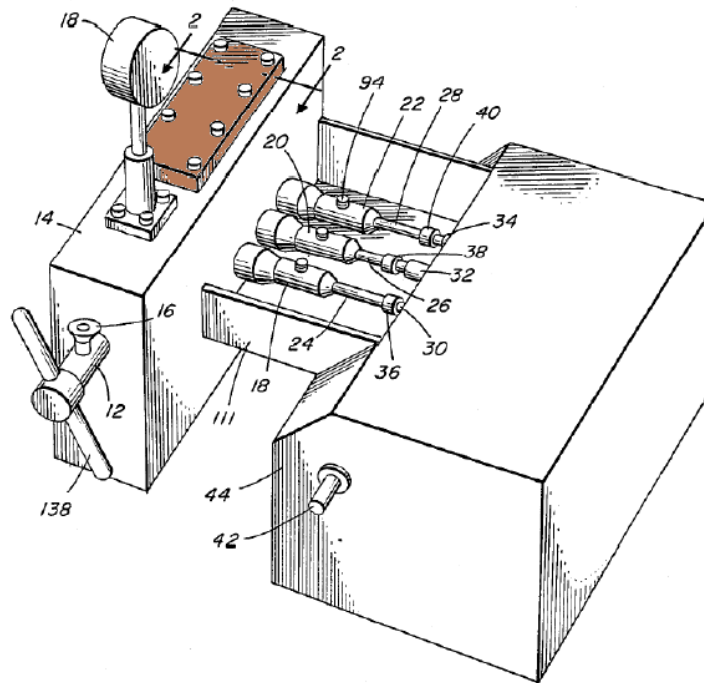


FIG. 1

EX1008, FIG. 1 (annotated).

The grounds in the Petition are strong. To characterize them otherwise, or to contend Patent Owner has not had enough time to evaluate these grounds when they are based, in significant part, on its own products, strains credulity and their strength strongly favors institution of the Petition.

III. The Petition Will Serve as an Alternative to Litigation, Favoring Institution

Patent Owner's main argument is that the Board should focus its resources on cases where an infringement suit has already been filed, alleging that absent a previously filed lawsuit, post grant review cannot serve as an alternative to litigation. Request at 8-9. Patent Owner's position turns the entire purpose of post grant review on its head. First, Patent Owner's position ignores the estoppel provisions of 35 U.S.C. § 325(e). Second, this argument is contrary to how post grant review was understood by its drafters and how it has been implemented for over a decade. From its initial inception, post grant review was considered an alternative to litigation precisely because it allows a party to meaningfully challenge the validity of a patent without a lawsuit, thereby avoiding litigation costs:

The bill creates a new post-grant review of patents, which can be sought within the first 9 months after the patent is issued and used to raise any challenge to the patent. **This will allow invalid patents that were mistakenly issued by the PTO to be fixed early in their life, before they disrupt an entire industry or result in expensive litigation.**

157 Cong. Rec, vol. 157, num. 33, S1326 (March 7, 2011) (emphasis added).

The bill will also create a new post-grant review process for patents that recently issued to improve the quality of patents in the system, as recommended by the National Academy of Sciences, and it will streamline the current "inter partes" system so that it will be **a more efficient alternative to litigation.**

157 Cong. Rec, vol. 157, num. 33, S1350 (March 8, 2011) (emphasis added).

As one way to improve patent quality, the Committee is considering modification to the post grant review process, such as creating a brand new administrative system to review patents after their issuance or revising the current system. Such a process should serve to either solidify the patent's validity or to catch a patent that should have been rejected during the initial examination. The process should be timely and streamlined and should take issues off the table that cannot be resurrected in subsequent litigation, **providing a cost effective alternative to litigation.**

S. Rept. 110-259 at 71 (2007)¹ (emphasis added).

As noted above, post grant review was intended to provide patent validity challenges "before they ... result in expensive litigation." As further noted above, post grant review was intended to be an "alternative to litigation," not a parallel procedure. Finally, as noted above, post grant review was intended to take issues

¹ <https://www.congress.gov/congressional-report/110th-congress/senate-report/259/1?outputFormat=pdf>

off the table in “subsequent litigation.” Patent Owner is simply wrong that post grant review cannot serve as an alternative to litigation where no suit has been filed. To the contrary, a post grant review filed before a district court proceeding is precisely a true alternative to litigation as it may resolve validity issues before any litigation costs are incurred. These true alternatives to litigation should be encouraged by the Board as they serve the intended purpose of the proceeding.

Other problems with Patent Owner’s position should be readily apparent. First, Patent Owner is arguing that the petitions which the Board should institute are those most likely to require duplicative efforts by the Board and courts. The Board, through its *Fintiv* cases, has already indicated a preference to discretionarily deny a petition when a co-pending related litigation will complete before the corresponding post grant proceeding. *Apple Inc. v. Fintiv, Inc.*, Case IPR2020-00019, Paper 11 (March 20, 2020). Patent Owner would have the Board add an additional preference to discretionarily deny petitions in cases where an infringement suit has not yet been filed. Request at 8-9. If the Board were to adopt Patent Owner’s argument here, the petitions most likely to be granted by the Board are those most likely to proceed in parallel with district court litigation. *Fintiv* says cases that will be decided first in litigation should not be addressed by the Board (*Fintiv* at 5) and Patent Owner says cases in which there is no litigation should not be addressed by the Board (Request, *passim*). In other words, Patent Owner is arguing that the Board should exercise its

discretion to favor the cases most likely to waste resources by proceeding in parallel with district court litigation. This cannot be the correct solution.

Second, post grant review and *inter partes* review are intended to allow mistakes by the Patent Office “to be fixed early in their life, before they disrupt an entire industry or result in expensive litigation.” 157 Cong. Rec, vol. 157, num. 33, S1326 (March 7, 2011). If adopted, Patent Owner’s position would encourage parties to delay post grant review challenges until after expensive litigation is initiated. The Patent Office should not encourage behavior that frustrates the purpose of post grant review, and therefore, Patent Owner’s argument cannot be the correct approach.

Because the post grant review of the ‘582 Patent would serve as a true alternative to litigation for a patent that should never have been issued in the first place, this consideration strongly favors institution.

IV. Compelling Economic and National Security Interests Favor Institution

Patent Owner argues that “there is a compelling economic interest in innovative manufacturing companies, such as Kerr, developing new patented technology, which can then be used by its customers to more efficiently and effectively carry out drilling and fracturing operations throughout the United States.” Request at 10. The relevant point here, apparently lost on Patent Owner, is that the compelling economic interest is in developing new patented technology. Patenting

old technologies, as is the case with the ‘582 Patent (*see* Section II.b, *supra*), is contrary to the public interest and contrary to carrying out effective and efficient drilling operations in the United States.

Specifically, there is a strong public interest in rejecting or invalidating patent claims that could embrace and therefore monopolize the prior art. The public has “a paramount interest in seeing that patent monopolies are kept within their legitimate scope.” *Medtronic, Inc. v. Mirowski Family Ventures, LLC*, 134 S. Ct. 843, 851 (2014) (punctuation omitted). That is because a patent is “an exception to the general rule against monopolies and to the right to access to a free and open market.” *Precision Instrument Mfg. Co. v. Auto. Maint. Mach. Co.*, 324 U.S. 806, 816 (1945). Patents, therefore, must be carefully restricted to only those covering novel inventions. *See Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 5-11 (1966).

The ‘582 Patent attempts to monopolize the prior art, claiming conventional subject matter that Patent Owner themselves (*see* EX1003; EX1009, EX1011) and others (*see* EX1005) had been practicing for *years* prior to the earliest priority date for the ‘582 Patent. The compelling economic and national security interests *strongly* favor returning the conventional subject matter claimed in the ‘582 Patent to the public domain, allowing Patent Owner and its competitors to “efficiently and effectively carry out drilling and fracturing operations throughout the United States.” By monopolizing conventional, prior art technologies, the ‘582 Patent substantially

hinders the ability of numerous organization to “efficiently and effectively carry out drilling and fracturing operations throughout the United States.”² Therefore, compelling economic and national security interests strongly favor institution.

V. The Petition’s Reliance on Focused Expert Testimony Favors Institution

The Request argues that the Petition’s reliance on expert testimony is “extensive” and “unfocused,” and therefore, the Board should exercise its discretion to deny the Petition. Request at 11-12. Patent Owner confuses the completeness of Petitioner’s expert testimony with “unfocused” and “extensive reliance” on the testimony.

² Patent Owner has a history of seeking to enforce its patents thus making the invalidity of the ‘582 Patent a potential threat to efficient and effective drilling and fracturing operations in the United State. *See, e.g., Kerr Machine Co. v. Vulcan Energy Services LLC, et. al.*, Civil Action No. 6:20-cv-200 (W.D. Tex. 2020) (U.S. Patent No. 10,591,070 (“Sealing High Pressure Flow Devices”)); *Kerr Machine Co. v. Vulcan Energy Services LLC, et. al.*, Civil Action No. 6:21-cv-00044 (W.D. Tex. 2021) (U.S. Patent No. 10,895,325 (“Sealing High Pressure Flow Devices”)); *Kerr Machine Co. v. Vulcan Energy Services LLC, et. al.*, Civil Action No. 6:21-cv-307 (W.D. Tex. 2021) (U.S. Patent No. 10,962,001 (“Fluid End Assembly”)).

First, Petitioner's expert testimony is *complete* in order to conform with the legal and regulatory requirements that have been established to ensure the reliability of expert testimony. The Patent Office's regulations explain that "Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight." 37 C.F.R. § 42.65(a). The courts have long held that an expert's opinion must be supported by factual support. *Upjohn Co. v. Mova Pharm. Corp.*, 225 F.3d 1306, 1311 (Fed. Cir. 2000) ("Lack of factual support for expert opinion to factual determinations, however, may render the testimony of little probative value in a validity determination.") (quoting *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 294 (Fed. Cir. 1985)); *Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d 135, 138 (Fed. Cir. 1986); *Rohm and Haas Co. v. Brotech Corp.*, 127 F.3d 1089, 1092 (Fed. Cir. 1997) (fact finder not required to give credit to expert testimony without adequate support)). Accordingly, when Patent Owner describes the number of pages and number of paragraphs in Mr. Marscher's declaration (Request at 11), Patent Owner is actually highlighting the ample factual support for Mr. Marscher's conclusion that the claims of the '582 Patent are non-obvious and conventional.

As the Board knows well, the factual inquiries required for a conclusion of obviousness include:

- the scope and content of the prior art;

- differences between the prior art and the claims; and
- the level of ordinary skill in the pertinent.

Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17 (1966).

Mr. Marscher's declaration is long in order to provide the *required* factual inquiry into the content or the prior and the differences (limited as they are) between the prior art and the claims needed to support Mr. Marscher's conclusions of obviousness. Had Mr. Marscher failed to provide these required factual inquiries, Patent Owner would no doubt be arguing that Petitioner's testimony is unfounded and to be given little weight.

Furthermore, Mr. Marscher's conclusions relied upon in the Petition are quite focused. Petitioner does not rely on Mr. Marscher's testimony to fill holes in the prior art. Instead, the Petition relies on Mr. Marscher's expertise for just a few focused conclusions:

1. Each plunger arrangement in the multiplex prior art pumps has the same structure (*see, e.g.*, Petition at 33, 39, 42, 43, 55-57, 62, 64, 73, 76, 78, 92-94, 99, 101, 108, 111, 113, 141);
2. Reciprocating pump fluid ends are generally made of an integrally formed single piece (*see, e.g.*, Petition at 34, 69-70, 105); and

3. Reasons why the POSITA would have found it obvious to combine the teachings of specific prior art references (*see, e.g.*, Petition at 68, 82, 104, 122, 140).

The fact the Petition makes numerous citations to Mr. Marscher’s testimony for these conclusions is due to the large number claims in the ‘582 Patent and the multiple strong invalidity grounds presented; it is not an indication of unfocused expert testimony.

Finally, Petitioner notes that the Office has explained that “reasonable disputes between experts on dispositive issues may suggest that the questions are better resolved in an Article III court.”³ Patent Owner, however, has failed to identify a single reasonable dispute to be had with Mr. Marscher’s testimony. In spite of having the Petition for more than 2½ months, Patent Owner was unable to identify a single issue likely to result in a “battle of the experts.” The present case, therefore, is precisely the type of case that the Board is best equipped to handle – a case based almost exclusively on the technical disclosures of prior art references.

³ FAQs for Interim Processes for PTAB Workload Management, at #21 (published Apr. 25, 2025), <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management> (last visited May 21, 2025).

In light of the above, Petitioner submits that its reliance on expert testimony is focused, and therefore, this consideration favors institution.

VI. The Remaining Factors from the Workload Memo Support Institution

The Workload Memo provides the following factors that Patent Owner did not address, all of which favor institution:

- Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims;
- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
- Settled expectations of the parties, such as the length of time the claims have been in force.

The validity of the claims of the ‘582 Patent has not been adjudicated by the PTAB or another forum, favoring institution.

There have been no changes in the law or judicial precedent affecting the validity of the ‘582 Patent claims since their issuance, favoring institution.

The ‘582 Patent recently issued on November 26, 2024. There are, therefore, no settled expectations of the parties regarding the claims, favoring institution. Additionally, it should be noted that this factor is contrary to Patent Owner’s position that the Board should wait until a litigation is filed to address mistakenly issued patents in post grant review. As this factor recognizes, the right time to address the

validity of a patent is early in its life, before the expectations of the parties are settled, and before resources are expended asserting and defending a patent in litigation.

VII. Conserving Board Resources Favors Institution and Denial will be Prejudicial to Petitioner

Patent Owner argues that Petitioner will not be prejudiced if the Petition is discretionarily denied, conceding the public availability of some of Petitioner's art, thereby making it available for use in a later-filed *inter partes* review. Request at 10, n. 1 (“[T]he current Petition is for a PGR, Grounds 1-3 rely on patents and printed publications, which may be included in a subsequent IPR.”). Implicit in this concession is that Patent Owner anticipates a time when *inter partes* review may be appropriate. Accordingly, the correct time to address the validity of the ‘582 Patent is now so that the proceeding may serve as a true alternative to litigation and avoid wasting the Board's resources in evaluating the merits and procedural considerations of a later filed *inter partes* review petition.

Discretionarily denying the Petition would, in fact, prejudice Petitioner. Petitioner has expended substantial effort and financial resources in preparing the Petition. Wasting a party's resources is a form of prejudice. *See, e.g., Bortex Indus. Co. v. Fiber Optic Designs, Inc.*, 296 F.R.D. 373, 385 (E.D. Pa. 2013)(discovery dispute costs are prejudicial). Furthermore, while Petitioner's Grounds 1 and 4 are similar, the evidentiary and procedural considerations between the two grounds are

different. Specifically, Ground 1 is based on a prior art printed publication describing Patent Owner's KP-3300HP Plunger Pump, while Ground 4 is based on the offer for sale of the KP-3300HP Plunger Pump by Patent Owner. Because Patent Owner was responsible for the design, construction and sale of the KP-3300HP Plunger Pump, Patent Owner will have a more robust obligation to "serve relevant information that is inconsistent with a position advanced by the party during the proceeding concurrent with the filing of the documents or things that contains the inconsistency" under Ground 4 than it does under Ground 1. 37 C.F.R. § 42.51. This requirement substantially alters the potential counter arguments that Patent Owner may make in the proceeding.

For example, Patent Owner may, theoretically, argue that some claimed feature is not illustrated in or otherwise obvious from the Kerr Pump manual printed publication. If such a feature were, however, included in the actual KP-3300HP Plunger Pump, Patent Owner would be unable to make this same argument with respect to Ground 4, as Patent Owner would be required to provide Petitioner with discovery illustrating this inconsistency. In other words, Ground 4 holds Patent Owner's "feet to the fire" ensuring Patent Owner cannot exploit an incomplete publication in an attempt to patent features contained in its prior art products. Therefore, Petitioner would, in fact, be prejudiced if the Board discretionarily denies

the Petition in favor of a later-filed *inter partes* review petition as Petitioner were no longer be able to present Ground 4 to the Board.

Accordingly, for these additional reasons, institution is appropriate and the Petition should not be discretionarily denied.

VIII. CONCLUSION

In light of the above, Petitioner respectfully submits that all relevant considerations, whether under the guidance provided by *Fintiv* or the Workload Memo, favor institution of post grant review on the Petition. Therefore, Petitioner requests that the Discretionary Denial Panel deny the Request and refer the Petition to a three member panel of the PTAB pursuant to the Standard Operating Procedure.

May 28, 2025
EDEL, SHAPIRO & FINNAN, LLC
9801 Washingtonian Blvd., Suite 750
Gaithersburg, MD 20878

Respectfully submitted:
/Mark J. DeBoy/
Mark J. DeBoy, Reg. No. 66983
Attorney for Petitioner
Telephone: 301.424.3640

CERTIFICATE OF SERVICE

I certify that the foregoing **PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION** was served May 28, 2025, by email, as previously consented to by counsel, to:

james@chzfirm.com
stephen@chzfirm.com
paralegal@chzfirm.com

May 28, 2025
EDELL, SHAPIRO & FINNAN, LLC
9801 Washingtonian Blvd., Suite 750
Gaithersburg, MD 20878
Telephone: 301.424.3640

Respectfully submitted:
/Mark J. DeBoy/
Mark J. DeBoy, Reg. No. 66983
Attorney for Petitioner