

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEADRILL AMERICAS, INC.,
SEADRILL GULF OPERATIONS AURIGA, LLC,
SEADRILL GULF OPERATIONS VELA, LLC,
SEADRILL GULF OPERATIONS NEPTUNE, LLC,
Petitioner,

v.

TRANSOCEAN OFFSHORE DEEPWATER DRILLING, INC.,
Patent Owner.

Case IPR2015-01990
Patent 6,068,069

Before WILLIAM V. SAINDON, BARRY L. GROSSMAN, and
TIMOTHY J. GOODSON, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Petitioner requests an *inter partes* review of claims 17–19 of U.S. Patent No. 6,068,069 (Ex. 1001, “the ’069 patent”). Paper 1 (“Pet.”). Patent Owner filed a Preliminary Response to the Petition. Paper 7 (“Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Upon consideration of the Petition and Patent Owner’s Preliminary Response, we institute an *inter partes* review on all challenged claims of the ’069 patent.

Our factual findings and conclusions at this stage of the proceeding are based on the evidentiary record developed thus far. This is not a final decision as to the patentability of claims for which *inter partes* review is instituted. Our final decision will be based on the record as fully developed during trial.

A. Related Matters

Petitioner represents that the following matters would affect, or be affected by, a decision in this proceeding: *Transocean Offshore Deepwater Drilling, Inc., v. Seadrill Americas, Inc., et al.*, Civil Action No. 4:15-cv-00144 filed on January 16, 2015, in the U.S. District Court for the Southern District of Texas; *Transocean Offshore Deepwater Drilling, Inc. v. Pacific Drilling SA et al.*, Civil Action No. 4:13-cv-1088, filed on April 16, 2013, in the U.S. District Court for the Southern District of Texas; and *Inter Partes* Review Nos. IPR2015-01929 and IPR2015-01989. Pet. 1–2; Paper 5, 1.

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Patent Owner indicates that the '069 patent has been asserted against other parties in other lawsuits, some of which we address next. Prelim. Resp. 2–3.

B. Prior Litigation History

Although Petitioner was not a party, the '069 patent has been involved in prior litigation including *Transocean Offshore Deepwater Drilling, Inc. v. Pacific Drilling SA et al.*, Civil Action No. 4:13-cv-1088 (S.D. Tex) (hereinafter the “*Pacific Lawsuit*”), *Transocean Offshore Deepwater Drilling, Inc. v. GlobalSantaFe Corp. et al.*, Civil Action No. 4:03-cv-02910 (S.D. Tex) (hereinafter the “*GlobalSantaFe Lawsuit*”), *Transocean Offshore Deepwater Drilling, Inc. v. Stena Drilling Ltd. et al.*, Civil Action No. 4:08-cv-03287 (S.D. Tex) (hereinafter the “*Stena Lawsuit*”), and *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Contractors USA Inc.*, Civil Action No. 4:07-cv-02392 (S.D. Tex) (hereinafter the “*Maersk Lawsuit*”). The *Maersk Lawsuit* had subsequent appeals *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Contractors USA, Inc.*, 617 F.3d 1296 (Fed. Cir. 2010) (hereinafter “*Transocean I*”) and *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Contractors USA, Inc.*, 699 F.3d 1340 (Fed. Cir. 2012) (hereinafter “*Transocean II*”). Pet. 1–2, 44; Prelim. Resp. 2–4.

The court in the *Pacific Lawsuit* held a *Markman* hearing and construed several limitations of the '069 patent. Ex. 1009. *Markman* hearings were also conducted in the *Stena Lawsuit* (Ex. 2005), the *GlobalSantaFe Lawsuit* (Ex. 2007), and the *Maersk Lawsuit* (Ex. 2006). In the *Maersk Lawsuit*, the district court granted summary judgment for defendant, *inter alia*, on invalidity of all asserted claims based on

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obviousness. *Transocean I*, 617 F.3d at 1302. On appeal, the Federal Circuit held “that the teachings of the references as well as th[e] reason to combine support a *prima facie* case that the claims would have been obvious to one of ordinary skill in the art,” *id.* at 1304, but reversed the grant of summary judgment in part “[b]ecause there remain genuine issues of material fact regarding objective evidence of nonobviousness.” *Id.* at 1313; *see also id.* at 1304–05 (disagreeing that the district court “is required to consider only the first three [*Graham*] factors” and determining that “the district court ignored . . . objective evidence of nonobviousness”).¹ On remand, after review of the evidence of nonobviousness, a jury found that the defendant had not established by clear and convincing evidence that the claims were obvious, but the district court granted a motion for judgment as a matter of law (JMOL) that the claims were invalid as obvious. *Transocean II*, 669 F.3d at 1346. On appeal, the Federal Circuit reversed the district court’s grant of JMOL, finding that the jury’s findings regarding objective evidence of nonobviousness were supported by substantial evidence. *Id.* at 1349–55.

C. The '069 Patent

The '069 patent is directed to a multi-activity offshore drilling apparatus, such as a drillship. Ex. 1001, Abstr. The apparatus has a single derrick but multiple tubular activity stations, such that primary drilling activity and auxiliary drilling activity may be conducted from the same derrick at the same time. *Id.*; *see also* Ex. 1007 ¶¶ 18–35; Prelim. Resp. 5–

¹ The references referred to by the Federal Circuit as demonstrating a *prima facie* case of obviousness are also asserted in this proceeding.

12 (providing background information on conventional and multi-activity drilling).

D. Challenged Claims

Petitioner challenges claims 17–19, of which claim 17 is independent.

Claim 17 is reproduced below.

17. A multi-activity drilling assembly operable to be supported from a position above the surface of a body of water for conducting drilling operations to the seabed and into the bed of the body of water, said multi-activity drilling assembly including:
- a drilling superstructure operable to be mounted upon a drilling deck for simultaneously supporting drilling operations for a well and operations auxiliary to drilling operations for the well;
 - a first tubular advancing station connected to said drilling superstructure for advancing tubular members to the seabed and into the bed of body of water;
 - a second tubular advancing station connected to said drilling superstructure for advancing tubular members simultaneously with said first tubular advancing station to the seabed and into the body of water to the seabed; and
 - an assembly positioned adjacent to said first and second tubular advancing stations operable to transfer tubular assemblies between said first tubular advancing station and said second tubular advancing station to facilitate simultaneous drilling operations auxiliary to said drilling operations, wherein drilling activity can be conducted for the well from said drilling superstructure by said first or second tubular advancing stations and auxiliary drilling activity can be simultaneously conducted for the well from said drilling superstructure by the other of said first or second tubular advancing stations.

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