

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PACKERS PLUS ENERGY SERVICES INC.,
Petitioner,

v.

BAKER HUGHES OILFIELD OPERATIONS, INC.,
Patent Owner.

IPR2016-01000 (Patent 9,038,656 B2)¹
IPR2016-01003 (Patent 8,261,761 B2)

Before BEVERLY M. BUNTING, and ROBERT L. KINDER,
Administrative Patent Judges.

ROBERT L. KINDER, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5(a)

¹ This order addresses issues common to all cases; therefore, we issue a single order to be entered in each case. The parties are not authorized to use this style heading for any subsequent papers. For convenience, paper numbers refer to those filed in IPR2016-01003.

IPR2016-01000 (Patent 9,038,656 B2)

IPR2016-01003 (Patent 8,261,761 B2)

On May 23, 2017, Patent Owner sent email correspondence to the Board seeking a conference call to request authorization to file a Sur-Reply of seven pages in both IPR2016-01000 and IPR2016-01003. Pursuant to a request from the Board, both parties submitted a joint email on May 25, 2017, briefly setting forth the reasons for Patent Owner's request, and the basis of Petitioner's opposition to the request to file a sur-reply.

Patent Owner seeks to file a seven page sur-reply directed to two issues. First, the parties dispute the claim construction of certain "counter" limitations. At issue in each proceeding is whether the "counter" limitations are means-plus-function limitations subject to 35 U.S.C. § 112 ¶ 6. Patent Owner contends that additional briefing is necessary to respond to Petitioner's contention, raised for the first time in Petitioner's Replies, that the term "counter" denotes a particular class of structures. Also, Patent Owner seeks to address new evidence (Exs. 1012, 1014, and 1018) produced by Petitioner. Patent Owner also seeks to respond to Petitioner's characterization of deposition testimony on the meaning of "counter" by Patent Owner's expert.

Petitioner contends that Patent Owner should have already addressed the presumption related to whether a term not reciting the traditional "means for" language should invoke § 112, ¶ 6. Petitioner also contends its arguments are directly responsive to those arguments raised by Patent Owner in its Response, and are not the proper subject of a sur-reply—particularly Patent Owner's requests to respond to case law and "characterizations" of deposition testimony.

IPR2016-01000 (Patent 9,038,656 B2)

IPR2016-01003 (Patent 8,261,761 B2)

Under the particular circumstances of this case, and for this issue, we exercise our discretion under 37 C.F.R. § 42.20(d) and grant Patent Owner's request for authorization to file a sur-reply. Petitioner raises a valid objection, namely that a sur-reply is not a proper mechanism to address "characterizations" of deposition testimony. Accordingly, Patent Owner's sur-reply may only address new evidence and argument related to the "counter" limitations. The briefing should not attempt to recant or reform prior deposition testimony. The time for redirect is past and the Board is capable of parsing out any alleged mischaracterizations, which Patent Owner may also address and bring to our attention during oral hearing.

Patent Owner also seeks additional briefing to address issues raised in Petitioner's Replies as to whether the Howell reference, asserted as § 102 prior art in the proceedings, is properly enabled. Patent Owner seeks to respond to Petitioner's contention that newly produced Exhibits 1012, 1014, 1016, and 1018 demonstrate that a POSITA would have been able to predictably implement Howell's mechanism. We agree that briefing related to these new exhibits and argument is proper considering, as Petitioner recognizes, "it is Patent Owner's burden to demonstrate non-enablement." Paper 18, 10–11. We are mindful of Petitioner's objection that Patent Owner is seeking to remedy deficiencies in its original *Wands* analysis. Although we exercise discretion to allow Patent Owner to file a sur-reply, the briefing should only address new evidence and argument from Petitioner's Reply and not attempt to characterize Patent Owner's original analysis, or reargue what may or may not be present in Patent Owner's Response.

IPR2016-01000 (Patent 9,038,656 B2)

IPR2016-01003 (Patent 8,261,761 B2)

Under the particular circumstances of this case, we exercise our discretion under 37 C.F.R. § 42.20(d) and grant Patent Owner's request for authorization to file a seven-page sur-reply. Our decision to authorize a Sur-Reply is influenced by the fact that Petitioner's Reply presents certain new evidence and argument. Patent Owner did not request, and is therefore not authorized, to present any new evidence or expert testimony with the sur-reply.

Accordingly, it is:

ORDERED that Patent Owner's request for authorization to file a Sur-Reply is *granted*;

FURTHER ORDERED that Patent Owner's Sur-Reply is limited to seven pages;

FURTHER ORDERED that Patent Owner shall file its Sur-Reply no later than June 2, 2017;

FURTHER ORDERED that no new evidence or testimony of any kind shall be introduced or filed with Patent Owner's Sur-Reply; and

FURTHER ORDERED that Petitioner is not authorized to file a responsive submission.

IPR2016-01000 (Patent 9,038,656 B2)

IPR2016-01003 (Patent 8,261,761 B2)

PETITIONER:

Scott McKeown

Stefan Koschmieder

Christopher Ricciuti

OBLON, MCCLELLAND, MAIER & NEUSTADT, LLP

CPDocketMcKeown@oblon.com

CPDocketSK@oblon.com

CPDocketRicciuti@oblon.com

PATENT OWNER:

Mark Garrett

Eagle Robinson

NORTON ROSE FULBRIGHT US LLP

mark.garrett@nortonrosefulbright.com

eagle.robinson@nortonrosefulbright.com