

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDERSECRETARY AND DIRECTOR OF
THE UNITED STATES PATENT AND TRADEMARK OFFICE

PROPPANT EXPRESS INVESTMENTS, LLC,
PROPPANT EXPRESS SOLUTIONS, LLC,
Petitioner,

v.

OREN TECHNOLOGIES, LLC,
Patent Owner.

IPR2018-00733
Patent 9,440,785 B2

Before ANDREW HIRSHFELD, *Commissioner for Patents, Performing the
Functions and Duties of the Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent and Trademark Office.*

ORDER

Oren Technologies, LLC (“Patent Owner”) requests Director review of the Patent Trial and Appeal Board (“Board”) Final Written Decision determining all challenged claims of U.S. Patent No. 9,440,785 B2 (“the ’785 patent”) unpatentable (Paper 80, “Decision” or “Dec.”). Paper 94; Ex. 3100. In the Final Written Decision, the Board found claims 1, 3, 6, 9, 10, 13, and 15 unpatentable as having been obvious over the Sheesley,¹ Hurst,² Harris ’554³ or Harris ’809,⁴ and Luharuka⁵ references. *See* Dec. 63. The Board found claims 7, 8, 11, 14, 16–19, and 21–23 unpatentable as having been obvious over the Sheesley, Hurst, Harris ’554 or Harris ’809, Wietgreffe,⁶ and Luharuka references. *See id.* The Board declined to give weight to Patent Owner’s objective evidence of nonobviousness because the Board determined that Petitioner rebutted Patent Owner’s presumption of nexus by showing that Patent Owner’s commercial success and industry praise were the result of additional, unclaimed features of the Sandbox Product. *Id.* at 58–62.

Patent Owner argues that Director review is appropriate because the Board erred by failing to give appropriate weight to Patent Owner’s objective evidence of nonobviousness. Paper 94, 1–2, 7–9. Patent Owner argues that the Board applied a similar analysis in its final written decision in *Proppant Express Investments, LLC v. Oren Technologies, LLC*, IPR2017-01918, Paper 83 (PTAB Feb. 14, 2019), which the U.S. Court of Appeals for the Federal Circuit vacated and remanded for further analysis of objective evidence of nonobviousness. *See* Paper 94, 9–12

¹ US 2013/0206415 A1, published August 15, 2013 (Ex. 1003).

² US 5,413,154, issued May 9, 1995 (Ex. 1004).

³ US 2014/0083554 A1, published March 27, 2014 (Ex. 1007).

⁴ US 2016/0332809 A1, published November 17, 2016 (Ex. 1008).

⁵ US 9,624,036 B2, issued April 18, 2017 (Ex. 1006).

⁶ US 8,387,824 B2, issued March 5, 2013 (Ex. 1005).

(citing *Oren Techs., LLC v. Proppant Express Invs. LLC*, No. 2019-1778, 2021 WL 3120819, at *7–8 (Fed. Cir. July 21, 2021) (unpublished) (finding that “failure to address the Sandbox container-specific evidence [of nonobviousness] was legal error by the Board”) (“*Oren Techs.*”).

I have considered Patent Owner’s request. The Board’s analysis of Patent Owner’s objective evidence of nonobviousness in this case is substantially similar to the Board’s analysis at issue in the Federal Circuit case noted above. As such, I grant Director review for the Board to address Patent Owner’s objective evidence of nonobviousness in light of the Federal Circuit’s decision in *Oren Techs.* Accordingly, this case is remanded to the Board to weigh any evidence of record showing that the patented invention itself, in addition to any unclaimed elements, contributes to the commercial success and praise of the Sandbox Product. *See Oren Techs.*, 2021 WL 3120819, at *7.

Accordingly, based on the foregoing, it is:

ORDERED that the Board’s Final Written Decision (Paper 80) is vacated;
and

FURTHER ORDERED that the Board shall issue a new final written decision that addresses Patent Owner’s objective evidence of nonobviousness as to the patented invention’s contributions to the commercial success and praise of the Sandbox Product.

IPR2018-00733
Patent 9,440,785 B2

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