

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CLINT E. MICKEY

Appeal No. 2006-1576
Application No. 10/223,170

HEARD: JUNE 8, 2006

Before FRANKFORT, BAHR and NAPPI, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 4, 7, 10 through 12, 16 and 21. Claims 5, 6, 8, 9, 13 through 15, 17 through 20 and 22, all of the other claims remaining in the application, stand allowed.

As noted on page 1 of the specification, appellant's invention relates to downhole expansion sealing devices, such as packers or bridge plugs, that use sealing elements that are compressed, and more particularly to features that close leak paths created peripherally on the compressed sealing element. It is an important

aspect of the invention that the high expansion packer or bridge plug include an outer soft material that flows into leak paths or voids formed when the sealing element is subjected to longitudinal compression. Appellant notes that the sealing element is preferably an elastomer such as cured rubber, while the outer material is a soft uncured or somewhat cured rubber (specification, page 3). Independent claim 1 is representative of the subject matter on appeal and a copy of that claim may be found in the Appendix attached to appellant's brief.

The prior art references relied upon by the examiner in rejecting the appealed claims are:

Urbanosky	3,288,222	Nov. 29, 1966
Wagner et al. (Wagner)	4,482,086	Nov. 13, 1984
Culpepper	5,579,839	Dec. 3, 1996

Claims 1 through 4, 7 and 16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Urbanosky.

Claims 10 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Urbanosky in view of Wagner.

Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Urbanosky in view of Culpepper.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the final rejection (mailed July 29, 2004), the answer (mailed February 24, 2005) and the supplemental answer (mailed July 5, 2005) for the examiner's reasoning in support of the rejections, and to appellant's briefs and reply briefs for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Before addressing the merits of the rejections on appeal, we note that the sole issue raised by appellant is whether claims 1-4, 7 and 16 are properly rejected for anticipation by Urbanosky (main brief, page 2 and corrected brief, page 2). The above statement was followed in the main brief by an indication that “[a]ll the rejected dependent claims stand or fall with claim 1.” Thus, we look only to independent claim 1 to decide the appeal in the present case, with all of the dependent claims standing or falling with our determination on claim 1.

Independent claim 1 is directed to a sealing apparatus for selectively sealing a tubular downhole, comprising a mandrel; a sealing element mounted to the mandrel and made of a first material; and a second material on said sealing element, wherein the second material is “movable, in a direction other than radially toward the tubular, with respect to said first material, to obstruct at least one void created between said first material and the tubular, when the first material is compressed into contact with the tubular.” In reading claim 1 on the expandable well packer of Urbanosky, the examiner has determined that Urbanosky discloses a sealing apparatus for selectively sealing a tubular downhole (69), wherein the sealing apparatus comprises a mandrel (12); a

sealing element (61) mounted to the mandrel and made of a first material; and a second material (60) on said sealing element, where the second material is an elastomeric material that is softer and has a modulus of elasticity that is less than that of the first material. Thus, Urbanosky appears to have a packer-type sealing apparatus having the same or similar elements as set forth in claim 1 on appeal and arranged in the same manner required in claim 1.

As generally set out in In re Schreiber, 128 F.3d 1473, 44 USPQ2d 1429 (Fed Cir 1997), during examination, statements in a claim reciting the purpose or intended use of the claimed invention must be evaluated to determine whether such recited purpose or intended use results in a structural difference between the claimed invention and the prior art applied by the examiner. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a device is, not what a device does (Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)). Thus, if the prior art sealing apparatus in Urbanosky is capable of performing the function or intended use as recited in claim 1, then it meets the claim.

Moreover, although it is true that anticipation under 35 U.S.C. 102(b) is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element or limitation of a claimed invention, we observe that the law of anticipation does not require that the reference teach what the appellant has disclosed but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 871 (Fed. Cir. 1983).

In this case, while it is clear that there is nothing in Urbanosky which expressly indicates that the progressively expanded multi-layered packing element therein will function in the particular manner set forth in appellant's claim 1, we find that claim 1 "reads on" the packer of Urbanosky and, given the arrangement and relative material characteristics of the layers shown therein and the high level of compression used with such packers, that the softer second material (60) in Urbanosky will necessarily function in the manner required in claim 1 on appeal and thus be movable in a direction other than radially toward the tubular casing to fill a void created between the first material

(61) and the tubular casing (69) when the first material is compressed into contact with the tubular casing.

As was made clear in In re Schreiber, at 129 F.3d at 1473, 44 USPQ2d at 1429, by choosing to define an element functionally as in claim 1 on appeal, appellant assumes a risk, that risk being that where the Patent and Trademark Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied upon. In the present case, appellant has provided no evidence to prove that the outer softer elastomeric material (60) of Urbanosky pointed to by the examiner lacks, or is incapable of achieving the functionally defined limitations set forth in claim 1 on appeal.

For the above reasons, we will sustain the examiner's rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by the sealing apparatus of Urbanosky.

Based on appellant's statement on page 2 of the main brief, and the failure to argue any of the dependent claims separately, we also conclude that claims 2 through 4, 7, 10 through 12, 16 and 21 will fall with claim 1. Thus, the examiner's rejections of claims 2 through 4, 7 and 16 under 35 U.S.C. § 102(b), claims 10 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Urbanosky in view of Wagner, and claims 11 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Urbanosky in view of Culpepper, are also sustained.

In accordance with the foregoing, the decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

CHARLES E. FRANKFORT)
Administrative Patent Judge)
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) BOARD OF PATENT
JENNIFER D. BAHR) APPEALS
Administrative Patent Judge) AND
) INTERFERENCES
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