

The opinion in support of the decision *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BERND-GEORG PIETRAS, JOERG-ERICH SCHULZE-
BECKINGHAUSEN, AND ANDREAS CARLSSON

Appeal 2007-3299
Application 10/747,011¹
Technology Center 3700

Decided: October 17, 2007

Before RICHARD TORCZON, SALLY C. MEDLEY, and MICHAEL P.
TIERNEY, *Administrative Patent Judges*.

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DECISION ON APPEAL

1 This is a 35 U.S.C. § 134 appeal in the above-referenced case² of
2 claims 14-19 and 23-27. The remaining pending claims, claims 1-11, 13 and

¹ The application on appeal 10/747,011 is a reissue application of U.S. Patent No. 6,332,377, which issued on December 25, 2001 from U.S. Application 09/355,545.

² The real party in interest is Weatherford/Lamb, Inc. (Appeal Br. 3).

1 20-22, have been identified as allowable by the Examiner. (Answer 3). We
2 have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).³

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STATEMENT OF THE CASE

6 The field of the invention is a gripping arrangement for gripping
7 casing. ('377 Patent, Abstract). Applicants (Weatherford's) specification
8 states that during the construction of wells a wellbore is drilled into the
9 ground and a string of tubular ("casings") is lowered into the wellbore.
10 ('377 Specification, col. 1, ll. 8-12). Weatherford's specification states that
11 each length of casing is screwed onto the next and tightened. (*Id.* at ll. 13-
12 17). Weatherford's specification states that a problem in the art is that the
13 walls of the casing may be damaged by conventional jaw assemblies, which
14 have teeth. (*Id.* at ll. 18-22).

15 There are six independent claims on appeal, claims 14, 16, 23-25 and
16 27. Claims 14, 16 and 23-25 are directed to a gripping arrangement for
17 gripping wellbore tubulars. Claim 27 is directed to a method of rotating a
18 wellbore tubular with a tong. Independent claim 14 is representative of the
19 claims on appeal and reads as follows:

20 14. A gripping arrangement for gripping a wellbore
21 tubular, comprising:
22 an arcuate gripping surface assembly comprising a
23 flexible member with a first surface at least partially coated
24 with a grit along an inside curve formed by the gripping surface
25 assembly, wherein the gripping surface assembly is capable of
26 transmitting a circumferential force to a jaw holder; and
27 an arcuate pad of resilient material, wherein the pad
28 contacts a second surface of the flexible member and urges the

³ Jurisdiction over the proceeding has passed to the Board. 37 C.F.R.
§ 41.35

1 first surface against the circumference of a length of the
2 wellbore tubular to substantially conform thereto during use.

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4 (Appeal Br., claims appendix).

5 The Examiner has set forth two prior art rejections. The rejections are
6 as follows:

7 1) Claims 14-19 and 23-26 are rejected as obvious
8 over Bouligny PCT/US90/04616 (Bouligny) in view of Jansch,
9 U.S. Pat. 5,221,099 (Jansch).

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11 2) Claim 27 has been rejected as obvious over
12 Bouligny and Jansch in view of Slator, U.S. Pat. 4,869,137
13 (Slator).

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15 The Examiner states that Bouligny teaches the claimed subject matter,
16 except for the flexible member being at least partially coated with grit.

17 (Answer 5). In particular, the Examiner cites Bouligny for its description of
18 a friction sleeve or coating that is used to increase the coefficient of friction
19 between the gripping surface of Bouligny and a tubular member. (Answer 5,
20 citing Bouligny, p. 7, ll. 1-20). The Examiner cites Jansch as describing a
21 flexible lining containing granular particles, such as diamond dust granules
22 or other crystalline materials, such as quartz or glass. (Answer 5). The
23 Examiner states that it would have been obvious to one of ordinary skill in
24 the art to employ the particles of Jansch, such as diamond dust, in the
25 gripping arrangement of Bouligny to better compensate for the unevenness
26 of the parts to be clamped. (*Id.*).

27 Weatherford generally contends that the prior art fails to teach or
28 suggest a gripping arrangement having a flexible member at least partially
29 coated with a grit. (Appeal Br. at 11-14). In particular, Weatherford

1 contends that Bouligny avoids the use of a gripping mechanism that is
2 abrasive or ploughs the tubing being gripped. Weatherford further contends
3 that the principle of operation in gripping utilizing grit is different than the
4 principle of operation taught by Bouligny. (Appeal Br., 12). Additionally,
5 Weatherford contends that Jansch requires pinned elements for point contact
6 for gripping whereas Bouligny “leads away” from utilizing such point
7 contact. (Appeal Br., 12-13). As summarized in Weatherford’s Reply Brief,
8 Weatherford contends that the proposed modification of Bouligny would
9 change the principle of operation of the friction grip. Weatherford’s
10 Evidence Appendix does not direct the Board’s attention to any evidence to
11 support Weatherford’s contentions.

12 We affirm the Examiner’s rejections.

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14 ISSUE

15 The issue is whether Weatherford has shown that the Examiner erred
16 in rejecting the claims. Specifically, the issue is:

17 Has Weatherford demonstrated that the Examiner was incorrect
18 in finding that one of ordinary skill in the art would have had
19 reason to form a gripping arrangement having a flexible
20 member that is at least partially coated with grit?

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ANALYSIS

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2 There are two grounds of rejection on appeal, each of which is based
3 on obviousness under 35 U.S.C. § 103. We affirm the Examiner's rejections
4 for the reasons of record. For purposes of completeness we provide the
5 following additional commentary.

6 The United States Patent & Trademark Office is tasked with
7 interpreting claims as broadly as their terms reasonably allow. *In re Zletz*,
8 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Indeed, *Zletz*
9 held that the Board erred in reading unwritten limitations into claims on
10 appeal and stated that it was incorrect for the Board to construe claims
11 narrowly, such as is done in courts confronting issues of infringement and
12 validity.

13 Weatherford's claims on appeal are directed to a gripping
14 arrangement and a method of rotating a wellbore tubular. Weatherford's
15 claims on appeal are not limited to a particular friction or ploughing effect
16 when the gripping arrangement is used to rotate a wellbore tubular. Further,
17 Weatherford's claims do not exclude scoring or damage to a wellbore
18 tubular when rotating the tubular with the claimed gripping arrangement.

19 The Examiner has demonstrated that the prior art teaches a gripping
20 arrangement that employs friction to turn a tube. The Examiner has
21 demonstrated that it was known in the gripping art to employ particles such
22 as diamond dust and glass to aid in gripping a pipe to be rotated. Based
23 upon the record presented, we find that Applicants' claimed subject matter
24 combines familiar elements of the prior art according to known methods to
25 yield predictable results, the formation of a gripping arrangement having
26 particles to better grip the surface to be rotated. Weatherford has failed to

1 provide sufficient evidence of secondary considerations to rebut this finding.
2 We conclude that claims 14-19 and 23-27 are obvious over the prior art cited
3 by the Examiner. *Anderson's-Black Rock v. Pavement Co.*, 396 U.S. 57, 61,
4 163 USPQ 673, 674 (1960) (combination of old elements that added nothing
5 to the nature and quality of the product was obvious).

6 Oral argument was scheduled for October 17, 2007 for this appeal. A
7 request for continued examination (RCE) was filed on October 16, 2007.
8 Prior to action being taken in response to the RCE, e.g., entry of a remand,
9 the panel had already decided the appeal on the merits. 37 C.F.R. §
10 41.35(c). Further, in rendering our decision we did not consider the
11 amendment and response filed with the RCE as they do not form a part of
12 the record for appeal.

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CONCLUSION

15 Weatherford has failed to demonstrate that the Examiner erred in
16 rejecting claims 14-19 and 23-27 over the cited prior art references. We
17 AFFIRM the Examiner's final rejection of claims 14-19 and 23-27.

18 No time period for taking any subsequent action in connection with
19 this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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Application 10/747,011

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