

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES A. PRAMANN, II, DIANA ORZECHOWSKI and
PATRICK W. BIXENMAN

Appeal No. 2007-4053
Application No. 10/280,400
Technology Center 3600

Decided: November 28, 2007

Before TERRY J. OWENS, MURRIEL E. CRAWFORD and ANTON W.
FETTING, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

In the Final Rejection (mailed July 12, 2005, pp. 2-5) the Examiner states that the claims are rejected as follows: claims 17-24, 41 and 43-45 under 35 U.S.C. § 102(b) as anticipated by US 5,875,852 to Floyd et al. (Floyd), claims 42 and 47 under 35 U.S.C. § 103 as obvious over Floyd, and claim 46 under 35 U.S.C. § 103 as obvious over Floyd in view of US 6,325,144 to Turley et al. (Turley).

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In the After Final Response and Amendment (filed Sep. 6, 2005) the Appellants state that “[t]he examiner rejected claims 17-24 and 41-47 under 35 U.S.C. § 102(b) as being anticipated by Floyd et al., U.S. 5,475,852”, and the Appellants request that new claim 48 be entered (p. 7). A “DO NOT ENTER” notation appears on the first page of that After Final Response and Amendment.

In the Advisory Action (mailed Sep. 16, 2005) the Examiner indicates that the After Final Response and Amendment will not be entered, but the Examiner omits the status of the claims.

In the Pre-Appeal Brief Request for Review (filed Oct. 12, 2005) the Appellants state (p. 1):

Claims 17-24 and 41-47 are pending in this Application. Claims 17-24, 41 and 43-45 are rejected under 35 U.S.C. § 102(b) as being anticipated by Floyd et al., U.S. 5,875,852 (hereinafter, “the ‘852 patent”). Claims 42 and 47 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘852 patent. Claim 46 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘852 patent in view of Turkey [sic, Turley] et al, U.S. 6,325,144.

In the Notice of Panel Decision from Pre-Appeal Brief Review (mailed Nov. 21, 2005) the Examiner indicates that the rejected claims are claims 17-24 and 41-47.

In the Appeal Brief (filed Dec. 21, 2005) the Appellants state (p. 2):

Claims 17-24 and 41-47 are pending in the case and stand rejected. Appellant appeals the rejection of claims 17-24 and 41-47. Claims 1-16 and 25-40 have been canceled.

The Appellants’ Grounds of Rejection to be Reviewed section of the Appeal Brief (p. 3), however, includes only the anticipation rejection of independent claims 17

and 41 under 35 U.S.C. § 102(b) over Floyd. Yet in the Summary section of the Appeal Brief (p. 5) the Appellants state:

Appellant respectfully submits that the inventions as claimed in independent claims 17 and 41 are novel and unobvious. Appellant further submits that Floyd et al. fails to disclose or suggest a sealing element having a side thicker than the remainder of the body and the examiner [sic] and therefore claims 17-24 and 41-47 are not anticipated.

In the Examiner's Answer (mailed Mar. 14, 2006) the Examiner states (p. 3): "Claims 17 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Floyd et al., U.S. 5,875,852, as set forth in the final office action mailed 12 July 2005." In the Examiner's Answer the Examiner does not mention the rejections set forth in the Final Rejection of claims 18-24 and 43-45 under 35 U.S.C. § 102(b) as anticipated by Floyd, claims 42 and 47 under 35 U.S.C. § 103 as obvious over Floyd, and claim 46 under 35 U.S.C. § 103 as obvious over Floyd in view of Turley.

In the Reply Brief (filed May 9, 2006) the Appellants do not specifically refer to any particular claim.

Thus, the status of the rejections of claims 18-24 and 43-45 under 35 U.S.C. § 102(b) as anticipated by Floyd, claims 42 and 47 under 35 U.S.C. § 103 as obvious over Floyd, and claim 46 under 35 U.S.C. § 103 as obvious over Floyd in view of Turley is unclear.

We remand the application to the Examiner for the Examiner to clearly set forth:

- 1) which claims are rejected,
- 2) the status of any non-rejected claims,
- 3) the statute section relied upon in rejecting each claim,

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- 4) the reference or references relied upon in rejecting each claim, and
- 5) an explanation as to why each rejected claim is considered by the Examiner to be unpatentable.

We also remand the application for the Appellants to respond on the record to the Examiner's explanation as to why each claim is rejected.

REMANDED

JRG

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