

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL JARRETT

Appeal 2008-1246
Application 10/230,705
Technology Center 1700

Decided: February 27, 2008

Before CHARLES F. WARREN, LINDA M. GAUDETTE, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

COLAIANNI, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 the final rejection of claims 2-10, 12-20, 23, 24, 26, 27, and 133-144. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

We AFFIRM.

INTRODUCTION

Appellant discloses a method for maintaining electrical stability in a drilling, drill-in, or completion fluid comprising adding a high lignin lost circulation material (HLLCM) (Specification ¶ [0007]). Appellant indicates that lost circulation material (LCM), usually consisting of a cellulose

material, is added to the drilling fluid to prevent lost circulation in the drilling fluid by penetration of the drilling fluid into sandy soil or layers of soil or rock having cavities (Specification ¶¶ [0003] to [0005]). Appellant discloses that the electrical stability of the fluid is enhanced by using HLLCM (Specification ¶¶ [0025] to [0028]).

Claims 133, 136, 137, and 139 are illustrative:

133. A method for maintaining electrical stability in emulsion type fluids during one or more drilling operation selected from the group consisting of drilling, drill-in, and completion operations, the method comprising performing the one or more drilling operation using a treated emulsion type fluid comprising one or more fibrous lost circulation material (LCM) consisting essentially of a quantity of high lignin lost circulation material (HLLCM), the treated emulsion type fluid having effective rheology and fluid loss control properties and maintaining an electrical stability value during the one or more drilling operation which is a maximum of 20% less than the electrical stability value produced using the same emulsion type fluid in the absence of the fibrous LCM.

136. A method for maintaining electrical stability in invert emulsion type fluids during one or more drilling operation selected from the group consisting of drilling, drill-in, and completion operations, the method comprising performing the one or more drilling operation using a treated invert emulsion type fluid having effective rheology and fluid loss control properties, said treated invert emulsion type fluid comprising one or more fibrous lost circulation material (LMC) consisting essentially of a quantity of high lignin lost circulation material (HLLCM) having a water retention value of about 1 or less.

137. A method for maintaining electrical stability in emulsion type fluids during one or more drilling operation selected from the group consisting of drilling, drill-in, and completion operations, the method comprising performing the one or more drilling operation using a treated emulsion type fluid comprising a fibrous lost circulation material consisting essentially of grape pumice.

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139. A method for maintaining electrical stability in invert emulsion type fluids during one or more drilling operations selected from the group consisting of drilling, drill-in, and completion operations, said method comprising performing the one or more drilling operation using a treated invert emulsion type fluid comprising a fibrous lost circulation material consisting essentially of grape pumice.

The Examiner relies on the following prior art reference as evidence of unpatentability:

Rose US 6,399,545 B1 Jun. 4, 2002

The rejections as presented by the Examiner are as follows:

1. Claims 2-10, 12-20, 23, 24, 26, 27, and 133-144 are rejected under 35 U.S.C. § 102(e) as being unpatentable over Rose.
 2. Claims 2-10, 12-20, 23, 24, 26, 27, and 133-144 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rose.

Appellant argues the electrical stability, the water retention value, the HLLCM being grape pumice, the fluid being an emulsion, and the fluid emulsion being an invert emulsion type fluid claim features. These claim features are found in various claims. Because claims 133, 136, 137, and 139 collectively contain the argued claim features, we select claims 133, 136, 137, and 139 as representative claims on which to render our decision.

OPINION

35 U.S.C. § 102(e) REJECTION OVER ROSE

Appellant argues that the Examiner has not established that Rose inherently discloses using an emulsion, or more specifically an invert

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emulsion, as the drilling fluid (Amended App. Br. 11-12 and 14). Appellant contends that the Examiner has not shown where Rose discloses the claimed electrical stability or water retention value for an emulsion type fluid (Amended App. Br. 12-13). Appellant argues that Rose discloses several “tannin-containing organic waste products” that include yellow pine, yellow pine bark and wood bark, but the Examiner has not pointed to any teaching in Rose to select only those tannin containing organic waste products that are HLLCMs (Amended App. Br. 13).

We have considered all of Appellant’s arguments and are unpersuaded for the reasons below.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). A reference anticipates a claim if it discloses the claimed invention “such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention.” *In re Graves*, 69 F.3d 1147, 1152 (Fed. Cir. 1995) (*quoting, In re LeGrice*, 301 F.2d 929, 936 (CCPA 1962)). When considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826-27 (CCPA 1968).

The thrust of Appellant's arguments are directed to whether Rose discloses adding grape pomace (i.e., grape pumice)¹ to an emulsion-type (or an invert emulsion-type) fluid. Accordingly, we must determine whether Rose discloses such a combination so as to anticipate Appellant's claims.

Regarding Appellant's argument that Rose fails to provide any teaching to select only those tannin-containing organic waste materials that are HLLCM, we understand Appellant to be arguing that Rose's disclosure of acceptable tannin-containing organic wastes is insufficient to anticipate using grape pomace (i.e., grape pumice) with an emulsion-type fluid. A reference that discloses a limited class of compounds included within a generic disclosure of the compounds is a description of each of the compounds of the limited class. *In re Schaumann*, 572 F.2d 312, 316-17 (CCPA 1978).

In the present case, Rose modifies the broad disclosure of tannin-containing organic waste as the acceptable additives by indicating a preference for grape pomace (i.e., grape pumice), tomato pomace, beet pomace, yellow pine bark, yellow pine, wood bark (Rose, col. 3, ll. 52-53). Rose further discloses that before Rose's disclosure the art had not recognized the advantages of using grape pomace (i.e., grape pumice) in drilling fluids (Rose, col. 3, ll. 27-31). These disclosures clearly indicate a limited class of tannin-containing organic wastes that includes grape pomace (i.e., grape pumice). *Schaumann*, 572 F.2d at 316-17. In fact, Rose indicates that it is advantageous to use grape pomace (i.e., grape pumice) (Rose, col. 3, ll. 27-31). Accordingly, we find that Rose's limited class of

¹ The Examiner finds that Rose's "grape pomace" is the same as Appellant's claimed "grape pumice" (Supp. Ans. 5). Appellant does not dispute the Examiner's finding.

tannin-containing organic wastes anticipates the use of grape pomace (i.e., grape pumice) in drilling fluids.

Regarding Appellant's emulsion arguments, Rose discloses that it is known that the addition of cellulose materials tends to "break" emulsions in the drilling fluids, which adversely affects the drilling fluid properties (Rose, col. 2, ll. 10-20). Rose discloses adding tannin-containing organic waste products such as grape pomace (i.e., grape pumice), tomato pomace, beet pomace, yellow pine bark, yellow pine, wood bark and the like to the drilling fluid (Rose, col. 2, ll. 63-66). Rose discloses that there are advantages to using grape pomace (i.e., grape pumice) in drilling fluids for fluid loss and seepage control (Rose, col. 3, ll. 28-32). Rose discloses that the additives (e.g., grape pumice) can be used with both "water-base or oil base muds and fluids" (Rose, col. 4, ll. 30-31).

An "invert-emulsion mud" is defined as "[a] drilling mud whose dispersed phase is fresh or salt water and whose continuous phase is some type of oil." (i.e., a mud in which oil is the base into which water is mixed to form an emulsion with water being the dispersed phase (an oil base mud)).² An "invert oil mud" is defined as "[a] drilling mud constituting an emulsion in which water is the dispersed phase" (i.e., an oil base mud).³

As evidenced by the above definitions, Rose's disclosure that the tannin-containing organic waste (e.g., grape pumice) can be used with oil base muds, would have been understood by a skilled artisan as disclosing the combination of grape pumice with an invert emulsion mud (i.e., an oil base

² *McGraw-Hill Dictionary of Scientific and Technical Terms*, 1047 (5th Ed., Sybil P. Parker, ed. 1994).

³ *McGraw-Hill Dictionary of Scientific and Technical Terms*, 1047 (5th Ed., Sybil P. Parker, ed. 1994).

mud), or, more broadly, an emulsion-type drilling fluid. *Graves*, 69 F.3d at 1152. Stated differently, Rose's disclosure of combining an oil base mud and grape pumice would have put a skilled artisan in possession of combining grape pumice with an invert oil mud (i.e., an oil base mud emulsion per the above definitions). *Id.* Accordingly, Appellant's arguments that Rose fails to disclose the combination of an emulsion-type fluid or an invert emulsion-type fluid with a HLLCM such as grape pumice are without persuasive merit.

Moreover, we are unpersuaded by Appellant's argument that the Examiner has not established that Rose discloses the claimed electrical stability or water retention value. The mere recitation of a newly discovered property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re Best*, 562 F.2d 1252, 1254 (CCPA 1977). 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 on. *Id.* at 1254-55.

In the present Appeal, as noted above, the Examiner has established that Rose discloses a method that is identical to Appellant's method and includes using an HLLCM, grape pumice, which is identical to the HLLCM disclosed by Appellant, such that the claimed electrical stability and water retention value are inherent properties of the composition used in Rose's method. *Id.* Accordingly, the burden was properly shifted to Appellant to

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provide evidence that Rose's method and composition do not possess the inherent properties. *Id.*

However, Appellant has proffered no evidence that Rose's method and composition does not possess the claimed electrical stability or water retention value. By Appellant's own admission, the Rule 132 Declaration submitted March 11, 2005 and entered by the Examiner, is not relevant to the claimed invention because the information contained therein relates to combining non-emulsions and HLLCMs (Amended App. Br. 18-19).

Accordingly, Appellant's burden has not been satisfied.

For the above reasons, we sustain the Examiner's § 102(e) rejection of claims 2-10, 12-20, 23, 24, 26, 27, and 133-144 over Rose.

35 U.S.C. § 103 REJECTION OVER ROSE

The Examiner rejects all the claims under § 103 over Rose. Because we find above that Rose anticipates Appellant's invention recited in claims 2-10, 12-20, 23, 24, 26, 27, and 133-144 over Rose, we sustain the Examiner's § 103 rejection of claims 2-10, 12-20, 23, 24, 26, 27, and 133-144 over Rose. *In re Fracalossi*, 681 F.2d 792, 794 (CCPA 1982) (anticipation is the ultimate of obviousness).

DECISION

The Examiner's decision is affirmed.

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

AFFIRMED

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