

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL L. SMITH, LESLIE D. SKINNER,
and CHARLES C. OVERSTREET

Appeal 2008-3952
Reissue Application 10/317,675
of U.S. Patent 6,158,516
Technology Center 3600

Decided: September 11, 2008

Before BRADLEY R. GARRIS, *Administrative Patent Judge*,
FRED E. McKELVEY, *Senior Administrative Patent Judge*, and
ROMULO H. DELMENDO, *Administrative Patent Judge*.

DELMENDO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 20-77 (Appeal Brief filed Nov. 15, 2006, hereinafter “App. Br.”;

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Final Office Action mailed Apr. 21, 2006).¹ We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

Appellants state they invented an “apparatus for drilling, completion, well workovers and well control, combining an integrated hydraulic jacking lifting unit and a coiled tubing unit, the . . . apparatus permit[ting] [the] running [of] jointed pipe . . .” (Specification of United States Patent 6,158,516, hereinafter “Spec.,” col. 6, ll. 6-12).²

Claim 20, which is representative, reads as follows (underlining omitted):

20. A system for performing wellbore operations permitting the running of pipe, said system comprising:

a hydraulic workover unit comprising a hydraulic jack assembly having a frame and at least two vertically oriented hydraulic cylinders, stationary slips, and traveling slips mounted to a traveling head, said traveling head having a rotary table; and

a coiled tubing unit having a guide arch assembly mounted to a guide system above said hydraulic workover unit wherein said assembly is movable from a first position over the centerline of the wellbore to a second position away from the centerline of the wellbore.

The Examiner did not rely on any prior art to reject the claims on appeal (Examiner’s Answer mailed Sep. 26, 2007, hereinafter “Ans.” 2).

¹ Claims 1-19, the only other pending claims, are allowed.

² Except for amended claims 10 and 11 and newly added claims 20-77, the descriptions in the original patent and the subject application are identical. Accordingly, we use the description in the ‘516 Patent when referring to the Specification of the present Application.

Claims 20-77 stand rejected under 35 U.S.C. § 251 as being based upon a defective Reissue Declaration (Ans. 3-4).

ISSUE

Have Appellants demonstrated error in the Examiner's determination that the appealed claims do not comply with the requirements of 35 U.S.C. § 251 as being based upon a defective Reissue Declaration in violation of 37 C.F.R. § 1.175?

FINDINGS OF FACT

1. The real party in interest is said to be CUDD PRESSURE CONTROL, INC. (App. Br. 1).
2. The present Application was filed on December 12, 2002 as a Reissue Application of the '516 Patent, which issued on December 12, 2000.
3. The Reissue Declaration filed on May 9, 2003 was executed by two of the three named inventors (Leslie D. Skinner and Charles C. Overstreet).
4. The May 9, 2003 Reissue Declaration executed by Overstreet and Skinner states:

Due to mistake and inadvertence during preparation of the original application that resulted in claims 1 through 19 of Patent 6,158,516, patentee failed to include claims to patentably novel and unobvious subcombinations of the invention disclosed in the original application, thus claiming less than the patentee had a right to claim resulting in error in the patent. *Newly submitted claims 20 through 77 are representative of*

subcombinations less a “multi-function injector head.” [Emphasis added.]

5. On August 3, 2005, inventors Overstreet and Skinner supplemented their earlier Declaration as follows:

Due to mistake and inadvertence and without deceptive intent during prosecution of the original application, Applicant failed to fully claim the full scope of the disclosed invention. *In error, Applicant claimed in claim 1, the sole independent apparatus claim “an integrated workover unit . . . , wherein said integrated workover unit . . . comprises a multi-function injector head” rendering the issued original patent partly inoperative.* [Emphasis added.]

6. On August 5, 2005, the third of three inventors (Michael L. Smith) declared as follows:

Due to mistake and inadvertence, without deceptive intent, during prosecution of the original application, the Applicant failed to fully claim the full scope of the disclosed invention. *In error, Applicant claimed in claim 1, the sole independent apparatus claim, “an integrated workover unit . . . , wherein said integrated workover unit . . . comprises a multi-function injector head” rendering the issued original patent partly inoperative.* [Emphasis added.]

7. Claim 1 of the ‘516 Patent recites “an integrated [hydraulic] workover unit . . . , wherein said integrated workover unit . . . comprises a multi-function injector head.”
8. All remaining apparatus claims in the ‘516 Patent depend from claim 1.

PRINCIPLES OF LAW

35 U.S.C. § 251 “is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally.”” *In re Doyle*, 293 F.3d 1355, 1358 (Fed. Cir. 2002)(quoting *In re Weiler*, 790 F.2d 1576, 1579 (Fed. Cir. 1986)).

37 C.F.R. § 1.175 states:

(a) The reissue oath or declaration in addition to complying with the requirements of § 1.63, must also state that:

(1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and

(2) All errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without any deceptive intention on the part of the applicant.

(b)

(1) For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant. Any supplemental oath or declaration required by this paragraph must be submitted before allowance and my be submitted:

(i) With any amendment prior to allowance; or

(ii) In order to overcome a rejection under 35 U.S.C. 251 made by the examiner where it is indicated that the submission of a supplemental oath or declaration as required by this paragraph will overcome the rejection.

(2) For any error sought to be corrected after allowance, a supplemental oath or declaration must accompany the

requested correction stating that the error(s) to be corrected arose without any deceptive intention on the part of the applicant.

(c) Having once stated an error upon which the reissue is based, as set forth in paragraph (a)(1), unless all errors previously stated in the oath or declaration are no longer being corrected, a subsequent oath or declaration under paragraph (b) of this section need not specifically identify any other error or errors being corrected.

(d) The oath or declaration required by paragraph (a) of this section may be submitted under the provisions of § 1.53(f).

(e) The filing of any continuing reissue application which does not replace its parent reissue application must include an oath or declaration which, pursuant to paragraph (a)(1) of this section, identifies at least one error in the original patent which has not been corrected by the parent reissue application or an earlier resissue application. All other requirements relating to oaths or declarations must also be met.

ANALYSIS

The Examiner believes that the Reissue Declarations executed by the inventors are “defective” because they allegedly do not identify the specific changes to the claims of the ‘516 Patent (Ans. 3). In support of this position, the Examiner relied on MPEP § 1414-II(C) (8th ed., Rev. 5), which states that a “statement of ‘. . . failure to include a claim directed to . . .’ and then presenting a newly added claim, would not be considered a sufficient ‘error’ statement . . .”

We cannot agree. As explicitly provided in 37 C.F.R. § 1.175(a)(1), “[a]ll that is needed for the oath/declaration statement as to error is the identification of ‘at least one error’ relied upon.”

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Here, the Reissue Declarations of the inventors state that the original ‘516 Patent is partly inoperative because the claims of the patent contain the recitation “an integrated [hydraulic] workover unit. . . , wherein said integrated workover unit . . . comprises a multi-function injector head” (Facts 3-8). Even a cursory review of appealed claim 20 reveals that this limitation is no longer recited. Thus, in a manner consistent with MPEP § 1414-II(C), the Reissue Declarations do identify at least one error as required by 37 C.F.R. § 1.175.

CONCLUSION

On this record, we determine that Appellants have shown error in the Examiner’s rejection of claims 20-77 as failing to comply with the requirements of 35 U.S.C. § 251.

DECISION

The Examiner’s decision to reject appealed claims 20-77 is reversed.

REVERSED

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