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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte IVES LORETZ, ALOK DWIVEDI and
PIERRE HOSATTE

Appeal 2010-009480
Application 11/559,554
Technology Center 3600

Before: PHILLIP J. KAUFFMAN, BENJAMIN D. M. WOOD and
BRADFORD E. KILE, *Administrative Patent Judges.*

KILE, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Ives Loretz et al. (Appellants¹) appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1-6, 8-11, 13-16 and 19-23. Claims 7, 12, 17 and 18 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Appellants identify the real party in interest as Schlumberger Technology Corporation.

THE CLAIMED INVENTION

The claimed invention is directed to a method for assembling a well tool using selected arrangements of different types of functional modules. Spec., para. [001]. Claims 1 and 11 are the independent claims on appeal. Independent claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method of assembling a well tool, comprising:

maintaining, at an assembly location, an inventory of plural different types of functional modules prior to receiving a purchase order;

receiving, from a customer at an order processing system associated with the assembly location, the purchase order for a well tool having a specified first application; and

assembling, at the assembly location and in response to the purchase order, the well tool by adding one or more of the plural types of functional modules from the inventory to a base configuration to form the well tool.

THE REJECTIONS

1. Claims 1-6, 8-11, 13, 16 and 19-21 stand rejected as unpatentable under 35 U.S.C. § 103(a) over Rytlewski (US 2005/0189115 A1, pub. Sep. 1, 2005) and Huber-Buschbeck (US 2007/0106411 A1, pub. May 10, 2007).

2. Claims 14 and 15 stand rejected as unpatentable under 35 U.S.C. § 103(a) over Rytlewski, Huber-Buschbeck and Nuth (US 2002/0170711 A1, pub. Nov. 21, 2002).

3. Claims 22 and 23 stand rejected under 35 U.S.C. § 112, first paragraph.

OPINION

A. Claims 1-6, 8-11, 13, 16, and 19-21.

1. Claims 1-5, and 9²

The Examiner found that Rytlewski discloses a method of assembling a well tool, comprising intervention equipment 150, that may be assembled and tested before being introduced into a well bore located on the sea floor. Ans. 4. The Examiner further found the Rytlewski intervention tool modules can include valves (controlled electrically or hydraulically) or sensors and monitors that can be selectively included depending on the needs present at a well. Ans. 4; Rytlewski, para. [0066]. The Examiner concluded that Rytlewski discloses all of the limitations of claim 1 “with the exception of receiving a customer order with a system associated with an assembly location.” Ans. 5. With respect to the concept of a purchase order, the Examiner found that Huber-Buschbeck discloses a system associated with an inventory location where a purchase order is received and then an ordered item is delivered.

The Examiner concluded that

[i]t would have been obvious to a person having ordinary skill in the art at the time of the invention to receive a customer

² Appellants argue claims 1-5 and 9 as a group. App. Br. 5-8. We select independent claim 1 as a representative claim. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2011). Appellants assert that “[t]he claims do not stand or fall together. Instead, Appellant presents separate arguments for various independent and dependent claims.” App. Br. 4. Where claims have been argued separately those claims will be addressed seriatim.

order on the vessel of Rytlewski in view of Huber-Buschbeck so that the vessel can assemble tool assemblies enroute to a well location after a customer order is made.

Ans. 5.

Appellants respond by noting that Rytlewski fails to disclose receiving a purchase order at an order processing system associated with an assembly location. App. Br. 6. With respect to order processing, Appellants note that Huber-Buschbeck discloses “receiving a customer order,” “checking availability of ordered products,” and “delivering the ordered products,” however, Appellants assert that Huber-Buschbeck does not disclose receiving a purchase order for a well tool having a specified first application, and assembling, at the assembly location and in response to the purchase order, the well tool by adding one or more of the plural types of functional modules from inventory to a base configuration to form a well tool. *Id.*

We are not persuaded by Appellants’ arguments. We agree with the Examiner that Rytlewski discloses assembling well tools by assembling modules to a base configuration. “[T]he intervention tool **150** includes sensors or monitors used for collecting measurements regarding various well attributes (e.g., temperature, pressure, etc.)” Rytlewski, para. [0066]. Appellants argument amounts to an attack on an individual reference when the rejection is predicated upon a combination of prior art disclosures, and is therefore unavailing. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). We affirm the Examiner’s rejection of claims 1-5 and 9.

2. *Claims 6, 8, and 21*

The claims in this group have been argued with respect to claim 6. App. Br. 9-10. Claim 6 depends from claim 1 and adds the provision of a

second purchase order for a second well tool having a specified second application and assembling the second well tool by adding together a different combination of functional modules. Claim 6; App. Br. 9.

The Examiner found that all of the limitations of claim 6 are disclosed in the combination of Rytlewski and Huber-Buschbeck except for “explicitly disclosing assembling a second tool to be used at a second or third location with a different combination of functional modules.” Ans. 5. The Examiner concluded, however, that duplication of essential steps at a second location would have been obvious to a person of ordinary skill in the art, since “mere duplication of essential steps of a method involves only routine skill in the art.” *Id.* at 5-6.

Appellants respond by asserting that this constitutes application of a *per se* rule that is legally incorrect. App. Br. 9. The Examiner replies that repetition of process steps would be obvious to one of skill in the art. Ans. 5-6. Appellants do not assert that the claimed subject matter produced a new or unexpected result or otherwise would not have been obvious, and for that reason we agree with the Examiner. *See, e.g., In re Vogel*, 427 F.2d 790, 793 (CCPA 1970); *In re Citron*, 326 F.2d 418, 420 (CCPA 1964); *In re Harza*, 274 F.2d 669, 671 (CCPA 1960). We affirm the Examiner’s rejection of claims 6, 8, and 21.

3. Claim 10

Claim 10, depends from claim 1, and recites,

wherein receiving the purchase order and assembling the well tool are performed using a build-to-order approach in which purchase orders for different well tools are fulfilled by providing the base configuration and adding the plural types of functional modules as options to the base configuration to provide the different well tools.

Appellants contend that Huber-Buschbeck contains no hint of multiple purchase orders for different well tools that are fulfilled by providing the base configuration and adding the plural types of functional modules as options to the base configuration as called for in claim 10. App. Br. 10.

The Examiner responds that “any method used to receive the order for assembling the intervention assembly . . . is essentially a system for processing that order” and that “[a]s the assembly is built for each specific well operation, the described apparatus is built to order.” Ans. 5. The Rytlewski patent discloses at [0066] that a variety of intervention tool configurations and functions are contemplated. One of ordinary skill in the art would appreciate that performing customer functions with various intervention tools will necessarily involve processing customer orders. Appellants have failed to convince us that Examiner’s reasoned rejection of claim 10 is in error.

4. Claims 11, 13, 16, 19 and 20

Claim 11 is an independent claim, however, Appellants merely assert that claim 11, and this group of claims, are allowable for the reasons expressed with respect to claims 1 and 10. Our analysis and conclusions with respect to claims 1 and 10 are repeated by reference. We affirm the Examiner’s rejection of claims 11, 13, 16, 19 and 20 for the reasons stated above.

B. Claims 14 and 15

Claims 14 and 15 directly or ultimately depend from claim independent claim 11. Appellants merely refer to claim 11 and assert that claims 14 and 15 are allowable because in Appellants’ view the rejection of

claim 11 has been overcome. As we held above, the Examiner's rejection of claim 11 has not been overcome and claims 14 and 15 fall along with our decision with respect to claim 11.

C. Claims 22 and 23

Claims 22 and 23 stand rejected under the provisions of 35 U.S.C. § 112, first paragraph. The Examiner found that claims 22 and 23 fail to comply with the written description requirement of section 112.

Claim 22 reads as follows:

22. The method of claim 1, wherein receiving the purchase order comprises receiving the purchase order that does not identify the plural types of functional modules.

The Examiner found that the Specification does not contain a written description of the claimed subject matter in such a way as to reasonably convey that Appellants had possession of the claimed invention at the time of filing the application. The Examiner noted that “[t]he specification describes receiving application specific orders but does not describe receiving a purchase order that does not identify the plural types of functional modules.” Ans. 3.

Appellants respond by explaining that “[d]ifferent orders from different customers can specify different applications.” App. Br. 4-5; Spec. [0025]. “The Specification thus implicitly teaches that the order does not identify the plural types of functional modules” *Id.* at 5.

Claim 22 contains the negative limitation that the purchase order not identify the plural types of functional modules. The portion of the Specification cited by Appellants states that, “[d]ifferent orders from

Appeal 2010-009480
Application 11/559,554

different customers can specify different applications that correspond to well tools according to different configurations.” Spec. [0025]. This disclosure does not describe a reason to exclude the relevant limitation. *See e.g., Santarus v. Par Pharmaceutical, Inc.*, 694 F.3d 1344, 1351 (Fed. Cir. 2012) (“Negative claim limitations are adequately supported when the specification describes a reason to exclude the relevant limitation.”). For that reason, we find Appellants’ argument unpersuasive.

DECISION

The decision of the Examiner to reject claims 1-6, 8-11, 13-16 and 19-23 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). *See* 37 C.F.R. § 1.136(a)(1)(iv)(2011).

AFFIRMED

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