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MARATHON OIL COMPANY C/O LAW OFFICE OF JACK E. EBEL 165 SOUTH UNION BOULEVARD SUITE 750 LAKEWOOD, CO 80228			ANDREWS, DAVID L	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PHILIP M. SNIDER

Appeal 2015-001070
Application 12/102,687
Technology Center 3600

Before JOHN C. KERINS, BRANDON J. WARNER, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Philip M. Snider (“Appellant”) appeals under 35 U.S.C. § 134(a) from the Examiner’s decision rejecting claims 1, 3–6, 8, 10, 15–17, 19, 20, and 26–30.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

¹ Appellant submits the real party in interest is Marathon Oil Company. Appeal Br. 3.

THE CLAIMED SUBJECT MATTER

Claim 1, reproduced below, is illustrative of the claimed subject matter.

1. A process comprising [:]
positioning tools in a well penetrating a subterranean environs, said tools capable of being operated in any desired sequence after being positioned in the well; and
fracturing the subterranean environs in any desired sequence at spaced apart locations along the well penetrating the subterranean environs, said tools being used in and remaining in the well during said fracturing.

REJECTIONS

- 1) Claims 1, 4–6, 8, 10, 15–17, 19, 20, and 26–28 are rejected under 35 U.S.C. § 103(a) as unpatentable over Szarka (US 5,029,644, iss. July 9, 1991).
- 2) Claim 3 is rejected under 35 U.S.C. § 103(a) as unpatentable over Szarka and Phi (WO 2006/101618 A2, pub. Sept. 28, 2006).
- 3) Claims 29 and 30 are rejected under 35 U.S.C. § 103(a) as unpatentable over Szarka and Aronstam (US 6,443,228 B1, iss. Sept. 3, 2002).

DISCUSSION

Rejection 1

Appellant argues claims 1, 4–6, 8, 10, 15–17, 19, 20, and 27–28 as a group.² Appeal Br. 6. Pursuant to 37 C.F.R. § 41.37(c)(1)(iv), we select

² Appellant argues claim 26 separately. Appeal Br. 10. Thus, we address claim 26 below.

claim 1 to decide the rejection as to these claims. The other claims stand or fall with claim 1.

The Examiner finds that Szarka discloses the subject matter of claim 1 including one sequence of fracturing the subterranean environs. Final Act. 3; Ans. 3. Appellant contends that Szarka discloses “fracturing a subterranean well bore in one particular sequence, i.e. opening the lowermost casing valve first and fracturing the formation, then the next lowest casing valve and finally the valve closest to the surface along the well.” Appeal Br. 8. Appellant also contends that Szarka’s disclosure at column 17, lines 52–57, concerns reopening the valves selectively after fracturing the subsurface formations and is “standard oil field practice,” not a disclosure of the limitation “fracturing the subterranean environs in any desired sequence.” *Id.* Appellant also contends that a skilled artisan would not be led by Szarka to reopen valves in any desired sequence but would be led to do so “in a sequence beginning with casing valve 28 adjacent the lowermost zone deemed productive . . . and proceeding upwardly to the next lowermost zone.” *Id.* at 9–10. The Examiner responds that Szarka column 17, lines 52–57, is “relied on only to show that the system is capable of having the valves opened in any sequence,” and the sequence in Szarka “is at least one of ‘any desired sequence.’” Ans. 3. For the following reasons, we sustain the rejection.

Appellant does not dispute that Szarka discloses selective reopening of the valves, which the Examiner finds discloses the recited “tools capable of being operated in any desired sequence.” Final Act. 3. Appellant also does not dispute that Szarka discloses one of the recited “desired” sequences for fracturing the subterranean environs. Appeal Br. 8. Appellant, thus, fails

to persuasively apprise us of error in the Examiner's factual findings or rationale for the rejection, which we determine to be reasonable and supported by rational underpinnings. We, thus, sustain the rejection of claims 1, 4–6, 8, 10, 15–17, 19, 20, and 27–28 under 35 U.S.C. § 103(a).

Claim 26, which depends from claim 1, recites “the sequence of fracturing comprises fracturing the subterranean environs at one of said spaced apart locations after fracturing the subterranean environs at another of said spaced apart locations which is closer to the surface of the earth along the well.” Appeal Br. 18 (Claims App.). Appellant contends “this concept is not disclosed in Szarka et al., nor would it be obvious to modify Szarka et al. to do so, without any disclosure, suggestions or teaching to do so.” Appeal Br. 10. The Examiner responds it would be obvious “to choose among a finite number of identified, predictable solutions (i.e. sequences of operation) with a reasonable expectation of success, particularly as provided with a system such as that of Szarka et al. enabling such a choice of sequence.” Ans. 4. The Examiner does not direct us to any disclosure in Szarka of the sequence recited in claim 26, nor does the Examiner provide any evidentiary support for the assertion that the recited sequence is a predictable solution with a reasonable expectation of success. The rejection of claim 26 thus, lacks rational underpinnings and we do not sustain the rejection.

Rejection 2

The Examiner finds that Szarka discloses the limitations of claim 3 except for “fracturing from two of the spaced apart locations simultaneously.” Final Act. 4. The Examiner finds that Phi “discloses a process of fracturing a plurality of spaced apart locations . . . and teaches

that multiple spaced apart locations operated together . . . would provide for fracturing simultaneously.” *Id.* The Examiner reasons it would have been obvious to modify the process of Szarka “to include fracturing from multiple locations simultaneously since it may provide for a more efficient operation depending on well design.” *Id.*

Appellant contends that in Phi, “the sequence in which the burst disks . . . rupture must be determined at the surface prior to running the liner into the well bore.” Appeal Br. 11. Appellant argues that Phi is “devoid of tools capable of being operated in any desired sequence once positioned within the well” because the “pressure ratings of the burst disks of Phi et al. are determined at the surface of the earth.” *Id.* at 11–12. The Examiner responds that Phi “was not relied on in any rejection for” the limitation that the tools be capable of “being operated in any desired sequence.” Ans. 4. Appellant’s argument is, thus, directed to this limitation in claim 1. As noted above, we sustain the rejection of claim 1 based on Szarka alone. We, thus, sustain the rejection of claim 3 because Appellant does not apprise us of error in the Examiner’s rejection of claim 3 which is based on the combination of Szarka and Phi.

Rejection 3

The Examiner finds that Szarka discloses the limitations of claims 29 and 30 except for the tools operated by a signal device. Final Act. 4. The Examiner finds that Aronstam discloses a method of actuating tools “wherein a signal device is conveyed in the well.” *Id.* The Examiner reasons that it would have been obvious to obvious to modify “the process of Szarka et al. to include a signal device in order to efficiently actuate the tools without inserting an entire length of string.” *Id.*

Appellant contends that Aronstam discloses “multilateral well systems,” but fails to disclose “using sliding sleeves during the fracturing of a well, let alone how to circulate flowable devices to control a sliding sleeve used in a fracturing process.” Appeal Br. 12–13. Appellant also contends that it would not be obvious “to circulate the flowable devices within the casing of Szarka et al. to activate the sliding sleeves contained therein since Aronstam et al. is totally devoid of any disclosure, suggestion or teaching of controlling operations of tools deployed in the same well in which the flowable devices thereof are circulated.” *Id.* at 13.

The Examiner relies on Szarka, not Aronstam, for disclosure of the use of sliding sleeves during fracturing of a well as recited in claim 10, from which claim 30 depends. Ans. 4; Szarka, col. 3, ll. 7–8.³ Appellant’s argument amounts to an attack on Aronstam individually, while the rejection is based on the combined teachings of Szarka and Aronstam. However, nonobviousness cannot be shown by attacking references individually when the rejection is based on a combination of references. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Appellant, thus, fails to persuasively apprise us of error in the Examiner’s factual findings or rationale for the rejection of claims 29 and 30, which we determine to be reasonable and supported by rational underpinnings. We thus, sustain the rejection of claims 29 and 30.

DECISION

The Examiner’s decision rejecting claims 1, 3–6, 8, 10, 15–17, 19, 20, and 27–30 is affirmed.

³ Appellant did not dispute the Examiner’s finding that Szarka discloses the use of sliding sleeves, as recited in claim 10, in connection with rejection 1. Appeal Br. 6–10. We sustain the rejection of claim 10 as discussed above.

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The Examiner's decision rejecting claim 26 is reversed.

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).

AFFIRMED-IN-PART