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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* DAVID LABONTE and RICKY GERELUK

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Appeal 2018-002373  
Application 14/458,991  
Technology Center 3700

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Before JILL D. HILL, LISA M. GUIJT, and PAUL J. KORNICZKY,  
*Administrative Patent Judges.*

KORNICZKY, *Administrative Patent Judge.*

DECISION ON APPEAL

## STATEMENT OF THE CASE<sup>1</sup>

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>2</sup> appeals from the Examiner’s decision, as set forth in the Final Office Action, rejecting claims 1–13. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

## THE CLAIMED SUBJECT MATTER

The application is directed to a method and apparatus for manufacturing continuous sucker rods. Spec. ¶ 2. Claim 1, the only independent claim on appeal, is reproduced below with disputed limitations italicized for emphasis:

1. A system for manufacturing a continuous sucker rod coil, the system comprising:
  - a single production line, comprising:
    - a coil straightener configured to straighten input coils, each input coil having the same uniform hardness;
    - a welding machine that is configured to:
      - fuse adjacent input coils together to form one continuous length of fused input coils, wherein fusing creates a heat-affected zone at each fused joint; and
      - treat the heat-affected zones to alleviate irregularities induced during fusing, wherein the welding machine selectively treats sections of the fused input coils to form treated sections and untreated sections;

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<sup>1</sup> In this Decision, we refer to (1) the Examiner’s Final Office Action dated March 16, 2017 (“Final Act.”) and Answer dated November 2, 2017, (“Ans.”) and (2) Appellant’s Appeal Brief dated September 11, 2017 and Reply Brief dated January 2, 2018 (“Reply Br.”).

<sup>2</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Weatherford Technology Holdings, LLC. Appeal Br. 3.

a flaw detection system for inspecting a surface of the straightened coils;  
a surface treating machine configured to clean a surface of the input coils and induce compressive stress in the surface; and  
a transport reel to receive the continuous length of fused coils.

#### REFERENCES

In rejecting the claims on appeal, the Examiner relied upon the following prior art:

Beasock	US 4,865,309	Sept. 12, 1989
Spiegelberg	US 5,217,158	June 8, 1993
Widney	US 6,481,082 B1	Nov. 19, 2002
Uesugi	US 2002/0154308 A1	Oct. 24, 2002

#### REJECTIONS

The Examiner made the following rejections:

1. Claims 1–10, 12, and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Widney, Spiegelberg, and Applicant’s Admitted Prior Art (AAPA).

2. Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Widney, Spiegelberg, AAPA, and Uesugi or Beasock.

Appellant seeks our review of these rejections.

## DISCUSSION

*Rejection 1: Claims 1–10, 12, and 13  
as Unpatentable Over Widney, Spiegelberg, and AAPA*

Appellant argues claims 1–10, 12, and 13 as a group. Appeal Br. 6–8. We select independent claim 1 as the representative claim, and claims 2–10, 12, and 13 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner finds that the combined teachings of Widney, Spiegelberg, and AAPA disclose the limitations in claim 1. Final Act. 2–4. In particular, the Examiner finds that Widney’s Background discloses that it is conventional for welding machines to fuse adjacent input coils together to form one continuous length of fused input coils (at 23), wherein fusing creates a heat-affected zone at each fused joint and along the whole continuous length of fused input coils (at 25). Final Act. 2–3; Ans. 2–3. The Examiner, however, finds that Widney does not disclose a “welding machine [that] selectively treats sections of the fused input coils to form treated sections and untreated sections” as recited in claim 1. Final Act. 2–3; Ans. 2–3. The Examiner further finds that this limitation is disclosed by Spiegelberg. Final Act. 3 (citing Spiegelberg, 1:29–2:2).

The Examiner reasons that it would have been obvious to one of ordinary skill in the art “to have modified the system of Widney by substituting his welding machine for the one taught by Spiegelberg, when welding pre-hardened sucker rods to form the continuous length of fused input coils” because it would “save on power that would be needed to heat-treat the whole continuous length of fused input coils” and “not require any skill to remove one machine and replace it with another machine having the desired capabilities for producing products being made in the production

line.” Final Act. 3. The Examiner further explains that Spiegelberg’s selective heat treatment “would enable an efficient way of treating the components utilizing less power by specifically heat treating specific portions of a component” and “a more efficient system for manufacturing a continuous sucker rod coil.” Ans. 3.

Appellant argues that the Examiner’s rejection is erroneous because Widney “teaches away from the use of heat treatment devices, and therefore, one skilled in the art would not modify the apparatus of Widney [] to include the selective heat treatment device of Spiegelberg [], as asserted by the Examiner.” Appeal Br. 6. Appellant explains:

*Widney et al.* discloses a portable continuous sucker rod manufacturing process and device (See abstract). The device of *Widney et al.* seeks to cure the deficiencies of the prior art, for example, coil transportation (See column 2, lines 14-18). To address these deficiencies, *Widney et al.* invented a method/device which is portable, so that sucker rods can be manufactured at the point of use, such as a well site (See column 2, lines 13-17). In order to be portable and to be able to use the device/method at the point of use, *Widney et al.* eliminated two processes from conventional approaches: (1) flash butt welding; and (2) heat treatment.

*Id.* at 6–7. According to Appellant, “*Widney et al.* discloses excluding heat treatment because ‘heat treating equipment requires too much power to be portable and available at any given location.’” *Id.* at 7 (quoting Widney, 2:27–28).

Appellant’s argument is not persuasive because Widney does not criticize, discredit, or otherwise discourage the Examiner’s proposed combination of Widney and Spiegelberg. *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1327 (Fed. Cir. 2009) (A “reference

does not teach away, however, if it merely expresses a general preference for an alternative invention but does not ‘criticize, discredit, or otherwise discourage’ investigation into the invention claimed.”) (quoting *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004)). The Federal Circuit has explained that just because better alternatives exist in the prior art does not mean that an inferior combination is inapt for obviousness purposes. *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). “The fact that the motivating benefit comes at the expense of another benefit, however, should not nullify its use as a basis to modify the disclosure of one reference with the teachings of another. Instead, the benefits, both lost and gained, should be weighed against one another.” *Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 n.8 (Fed. Cir. 2000).

Here, Widney states that flash butt welding and heat treatment are well-known and conventional steps for making sucker rods. Widney, 1:53–2:30. As Appellant readily admits, Widney only eliminated flash butt welding and heat treatment steps from conventional manufacturing approaches “[i]n order to be *portable* and to be able to *use the device/method at the point of use.*” Appeal Br. 6–7 (emphases added). Contrary to Appellant’s argument, Widney does not state that heat treatment steps are never useful and never provide any benefits. If portability or power usage is not a concern, there appears to be little advantage to Widney’s device. In addition, Widney does criticize, discredit, or otherwise discourage the Examiner’s proposal to use Spiegelberg’s selective heat treatment in place of Widney’s continuous heat treatment so as to provide “an efficient way of treating the components utilizing less power by specifically heat treating specific portions of a component” and “a more efficient system for

manufacturing a continuous sucker rod coil.” Ans. 3. In light of Widney’s assertion that “[h]eat treating equipment requires too much power to be portable” (Widney, 2:27–28), Spiegelberg’s selective heat treatment, which minimizes power usage, would seem to be consistent with Widney’s desire to minimize power requirements.

For the reasons above, Appellant’s arguments are not persuasive and the Examiner’s rejection of claim 1 is sustained, and claims 2–10, 12, and 13 fall with claim 1.

*Rejection 2: Claims 11  
as Unpatentable Over Widney, Spiegelberg, AAPA, and Uesugi/Beasock*

Appellant argues that the rejection of claim 11 is erroneous because of the deficiencies of the combination of Widney and Spiegelberg discussed above in connection with claim 1, and Uesugi and Beasock do not cure these deficiencies. As discussed above, Appellant’s arguments are not persuasive. Like claim 1, the rejection of claim 11 is sustained.

CONCLUSION

In summary:

<b>Claims Rejected</b>	<b>Basis (35 U.S.C.)</b>	<b>Affirmed</b>	<b>Reversed</b>
1–10, 12, 13	§ 103 Widney, Spiegelberg, AAPA	1–10, 12, 13	
11	§ 103 Widney, Spiegelberg, AAPA, Uesugi, Beasock	11	
<b>Overall Outcome</b>		1–13	

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For the above reasons, we AFFIRM the Examiner's rejection of claims 1–13 under 35 U.S.C. § 103.

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