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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/521,648	09/28/2012	Wee Ming Ong	SFPASS-PT001	2310
3624	7590	07/30/2014	EXAMINER	
VOLPE AND KOENIG, P.C. UNITED PLAZA 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103			RO, YONG-SUK	
			ART UNIT	PAPER NUMBER
			3676	
			NOTIFICATION DATE	DELIVERY MODE
			07/30/2014	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

eoffice@volpe-koenig.com

Office Action Summary	Application No. 13/521,648	Applicant(s) ONG ET AL.	
	Examiner YONG-SUK (PHILIP) RO	Art Unit 3676	AIA (First Inventor to File) Status No

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 7/11/2012.
 A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.
- 4) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims*

- 5) Claim(s) 1-12 is/are pending in the application.
5a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 6) Claim(s) _____ is/are allowed.
- 7) Claim(s) 1-8, 11 and 12 is/are rejected.
- 8) Claim(s) 9 and 10 is/are objected to.
- 9) Claim(s) _____ are subject to restriction and/or election requirement.

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

Application Papers

- 10) The specification is objected to by the Examiner.
- 11) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

- a) All b) Some** c) None of the:
 - 1. Certified copies of the priority documents have been received.
 - 2. Certified copies of the priority documents have been received in Application No. _____.
 - 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

** See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b)
Paper No(s)/Mail Date _____.
- 3) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 4) Other: _____.

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The present application is being examined under the pre-AIA first to invent provisions.

DETAILED ACTION

Specification

The abstract of the disclosure is objected to because it is a single run-on sentence. Correction is required. See MPEP § 608.01(b).

Claim Objections

Claims 1, 6 objected to because of the following informalities: Phrase "capable of" is not a positive limitation and does not constitute in any patentable sense. *In re Hutchinson*. 69 USPQ 138.

Claim Rejections - 35 USC § 112

The following is a quotation of 35 U.S.C. 112(b):

(b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

The following is a quotation of 35 U.S.C. 112 (pre-AIA), second paragraph:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 7, 3, 4 rejected under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor, or for pre-AIA the applicant regards as the invention. Independent claims 1 and 7 respectively recite preamble regarding a wellhead and a well. However, body of the claims 1 and 7 fail to

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address respective wellhead and well, which creates inconsistency between the preamble and the claim body, and the claims 1 and 7 are extremely broad. Thus, it is unclear whether the system (claim 1) and method (claim 7) will be used in a wellhead and a well or used outside a wellhead or a well (i.e., as a gasket in automobile or in a valve system of pump, etc...).

Claims 3, 4 recite "when". The use of the term "when" renders the claim indefinite because "when" indicates that the respective limitation is not required. Therefore, it is not possible for the examiner to determine the metes and bounds of the claim.

Claim 5 recite "may be". A limitation followed by linking terms (e.g., preferably, may be, for instance, especially) is considered indefinite since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of pre-AIA 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 11-12 rejected under pre-AIA 35 U.S.C. 102(b) as being anticipated by Lurie et al. (20080271924).

Lurie et al. discloses a device and method, comprising:

Re claims 1 and 7 (method claims 7 is pertinent because when put the device in operation will result in the steps as caked for in the method claim, and as best understood by examiner, see 112 issue and claim objection above):

a first circular bore 22 extending through said unitary body 4; and a second circular bore 6 adjacent said first circular bore and extending through said unitary body; wherein said seal adapter 7 is capable of being installed in said conductor housing (i.e., pgh. 67:6, casing is *metal*).

Re claim 2, at least one seal 7 (packer) extending around a perimeter (inner perimeter) of said unitary body 4, said at least one seal contacting said conductor housing 4 (metal casing).

Re claims 3, 8 (as best understood by examiner, see 112 issue above), said seal adapter receives a high pressure riser (expandable packer generally requires hydraulic or mechanical pressure/high pressure riser to expand the packer) in said first circular bore 22 when said seal adapter is installed in said conductor housing, said high pressure riser having a lower surface that contacts said flange (portion of metal casing 4 that packer 7 contacts/engages) and at least one seal extending around an outside perimeter of said riser, said at least one seal contacting said side wall to facilitate well drilling operations through said high pressure riser and said first bore for a first well.

Re claims 4, 11 (as best understood by examiner, see 112 issue above), an upper and lower planar surface (top and bottom of packer 7), wherein said lower planar surface rests on a flange of said conductor housing and said upper planar surface is

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substantially co-planar with an upper surface of said conductor housing when said seal adapter is installed in said conductor housing.

Re claim 5 (as best understood by examiner, see 112 issue above), said seal adapter 7 may be rotated 180 degrees and installed in said conductor housing to facilitate well drilling operations for a second well. It will be operator's choice to rotate adapter/packer 180 degrees, 90 degrees, 45 degrees, or any range of degree because the rotation does not affect any functional purpose (seal) of the packer/adapter (i.e. packer is round annular shape).

Re claims 6, 12 (as best understood by examiner, claim objection), adapter is capable of operating at well pressures up to 34.5 Mega Pascals. Lurie et al. discloses the limitations/packer 7 of this claim since it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*. 69 USPQ 138. Further, the packer can be used under various pressure range, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Allowable Subject Matter

Claims 9-10 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lew (6736212), Bridges (5810086), Collins (5655602), and Monjure et al. (6142235) all discloses unitary conductor housing/body with two circular bores extending therethrough.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YONG-SUK (PHILIP) RO whose telephone number is (571)270-5466. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shane Bomar can be reached on 571-272-7026. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/YONG-SUK (PHILIP) RO/

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Primary Examiner, Art Unit 3676