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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,615	07/24/2009	5474142	026664-000500US	8642

7590 08/21/2009

WILDCAT SERVICES, L.P.
17219 Houston Dr.
Cypress, TX 77433

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/21/2009

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

David W. Boyd
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Two Embarcadero Center, Eighth Floor
San Francisco, CA 94111-3834

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/010,615*.

PATENT NO. *5474142*.

ART UNIT *3993*.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Order Granting / Denying Request For Ex Parte Reexamination	Control No.	Patent Under Reexamination	
	90/010,615	5474142	
	Examiner	Art Unit	
	PETER C. ENGLISH	3993	

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

The request for *ex parte* reexamination filed *24 July 2009* has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a)☐ PTO-892, b)☒ PTO/SB/08, c)☐ Other: _____

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☐ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

a) ☐ by Treasury check or,

b) ☐ by credit to Deposit Account No. _____, or

c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

cc:Requester (if third party requester)

DECISION GRANTING *EX PARTE* REEXAMINATION

1. A substantial new question of patentability affecting claims 1-8 and 11-15 of United States Patent Number 5,474,142 is raised by the present request for *ex parte* reexamination.

New Prior Art Teachings Forming Basis of Substantial New Questions of Patentability

2. Claims 1-8 and 11-15 of Patent No. 5,474,142 were considered patentable during the earlier-concluded reexamination proceeding (Control No. 90/006,919) because the prior art cited failed to teach an automatic drilling system that operates a drill string controller to effect an increase in the rate of release of a drill string in response to a decrease in drilling system pressure, and that operates the drill string controller to effect a decrease in the rate of release of the drill string in response to an increase in drilling system pressure. See the Statement of Reasons for Patentability and/or Confirmation mailed on 23 November 2005.

Dillon et al. (US 2,005,889) teaches an automatic drilling system that controls the rate of release of a drill string as a function of drill string tension (which corresponds to bit weight), load on a drilling motor, speed of the drilling motor, and drilling fluid pressure (see the paragraph spanning the left and right columns on page 1). The system includes a drill string tension sensor 33 and a drilling fluid pressure sensor 104-106 that supply signals to controller 65 which in turn controls the rate of release of a drill string by controlling a drive motor 26 and brake 27 of a drill line drum 29 (see the paragraph spanning the left and right columns on page 2; also page 3, right-hand column, lines 30-52; page 4, left-hand column, lines 14-32). The drilling fluid pressure sensor 104-106 is selectively used to provide input to the controller 65 via a selector switch 98 (see page 4, left-hand column, lines 14-40). The controller 65 also controls the rate of release of the drill string in response to inputs from a drilling motor load sensor and a drilling motor speed sensor (see page 3, left-hand column, lines 29-62).

Hobhouse (US 3,550,697) teaches an automatic drilling system that controls the rate of release of a drill string as a function of drilling motor torque and bit weight. The system includes a drilling motor torque sensor 8 and a bit weight sensor (see column 7, lines 40-45) that supply signals to control console 1 which in turn controls the rate of release of a drill string 3 by controlling a lift cylinder 4 of the drill string 3 (see column 4, lines 24-46; column 5, lines 50-69;

column 7, lines 27-59). A control selector 42 allows for selection of control based on any one of drilling motor torque and bit weight or a combination of both variables (see column 5, lines 50-69). In the embodiment of Fig. 8, drilling fluid pressure sensors 107 input signals to a drilling fluid pressure regulator 109 which in turn inputs drilling fluid pressure signals to a control console 111, the control console 111 controlling the rate of release of a drill string by controlling a drill string lift cylinder 99 (see column 7, line 74 to column 8, line 51).

LeCompte et al. (US 1,891,329) teaches an automatic drilling system that controls the rate of release of a drill string as a function of drilling fluid pressure. A supply line (see Fig. 2) delivers a drilling fluid pressure signal to a pressure sensing and indicating device W. The device W includes a Bourdon tube 21 for sensing the drilling fluid pressure, which is then indicated via a pointer 22 and pressure-indicating dial 20, the Bourdon tube 21 also operating a switch mechanism 35 for selectively lighting a safe operation lamp 49, a warning lamp 50, and a dangerous operation lamp 51 (see page 4, lines 27-122). A portion 82 of the supply line (see Fig. 2) also delivers a drilling fluid pressure signal to a valve 80 that functions as a pressure regulator. The valve 80 controls a pneumatic cylinder 67 as a function of the drilling fluid pressure, and the cylinder 67 actuates a brake lever 60 to control the rate of release of a drill string cable E from a cable drum D (see page 5, lines 24-74). When the drilling fluid pressure increases, the valve 80 opens to actuate the cylinder 67, thereby decreasing the rate of release of the cable E (see page 5, line 75 to page 6, line 48).

Brett et al. ("Field Experiences With Computer-Controlled Drilling") teaches an automatic drilling system that controls the rate of release of a drill string as a function of drilling motor RPM, drill bit torque, drilling motor torque, and drilling fluid pressure (see the first full paragraph on page 201, and the first two paragraphs of APPENDIX I on page 206).

Accordingly, Dillon et al., Hobhouse, LeCompte et al. and Brett et al. all teach automatic drilling systems that control the rate of release of a drill string as a function of drilling fluid pressure. In addition, Dillon et al., Hobhouse and Brett et al. all teach automatic drilling systems that control the rate of release of a drill string as a function of a plurality of variables, these variables including drilling fluid pressure, bit weight, drilling motor torque, and drilling motor speed. Dillon et al. and Hobhouse further teach selectors allowing for the selection of one or more control variables. These are new teachings which were not considered during the earlier-

concluded examinations of Patent No. 5,474,142. These new teachings in Dillon et al., Hobhouse, LeCompte et al. and Brett et al. form the basis for the substantial new questions of patentability set forth below affecting claims 1-8 and 11-15.

Substantial New Questions of Patentability Proposed by Requester

3. The request indicates that the third party requester considers the following substantial new questions of patentability to be raised by the prior art cited in the request:

A. The third party requester considers a substantial new question of patentability as to claims 1-8 and 11-15 of Patent No. 5,474,142 to be raised by Bowden '359 (US 3,265,359) taken together with Ball (US 4,662,608), Dillon et al. (US 2,005,889) and Hobhouse (US 3,550,697).

B. The third party requester considers a substantial new question of patentability as to claims 1 and 11 of Patent No. 5,474,142 to be raised by LeCompte et al. (US 1,891,329) taken alone.

C. The third party requester considers a substantial new question of patentability as to claims 1 and 11 of Patent No. 5,474,142 to be raised by Brett et al. ("Field Experiences With Computer-Controlled Drilling") taken alone.

D. The third party requester considers a substantial new question of patentability as to claims 1 and 11 of Patent No. 5,474,142 to be raised by Hobhouse (US 3,550,697) taken alone.

E. The third party requester considers a substantial new question of patentability as to claims 2-4 and 12-15 of Patent No. 5,474,142 to be raised by Hobhouse (US 3,550,697) taken together with Dillon et al. (US 2,005,889).

F. The third party requester considers a substantial new question of patentability as to claim 14 of Patent No. 5,474,142 to be raised by Dillon et al. (US 2,005,889) taken alone.

4. It is agreed that consideration of Bowden '359 (US 3,265,359) taken together with Ball (US 4,662,608), Dillon et al. (US 2,005,889) and Hobhouse (US 3,550,697) raises a substantial new question of patentability as to claims 1-8 and 11-15 of Patent No. 5,474,142.

In the claim chart found on pages 45-62 of the request for *ex parte* reexamination, the requester has provided a detailed explanation of the pertinency and manner of applying the Bowden '359, Ball, Dillon et al. and Hobhouse references to claims 1-8 and 11-15. This explanation provided by the requester is hereby incorporated by reference.

There is a substantial likelihood that a reasonable examiner would consider the above teachings important in deciding whether or not claims 1-8 and 11-15 are patentable. Accordingly, Bowden '359 taken together with Ball, Dillon et al. and Hobhouse raises a substantial new question of patentability as to claims 1-8 and 11-15, which question has not been decided in a previous examination of Patent No. 5,474,142.

5. It is agreed that consideration of LeCompte et al. (US 1,891,329) taken alone raises a substantial new question of patentability as to claims 1 and 11 of Patent No. 5,474,142.

In the claim chart found on pages 29-31 of the request for *ex parte* reexamination, the requester has provided a detailed explanation of the pertinency and manner of applying the LeCompte et al. reference to claims 1 and 11. This explanation provided by the requester is hereby incorporated by reference.

There is a substantial likelihood that a reasonable examiner would consider the above teachings important in deciding whether or not claims 1 and 11 are patentable. Accordingly, LeCompte et al. raises a substantial new question of patentability as to claims 1 and 11, which question has not been decided in a previous examination of Patent No. 5,474,142.

6. It is agreed that consideration of Brett et al. ("Field Experiences With Computer-Controlled Drilling") taken alone raises a substantial new question of patentability as to claims 1 and 11 of Patent No. 5,474,142.

In the claim chart found on pages 32-33 of the request for *ex parte* reexamination, the requester has provided a detailed explanation of the pertinency and manner of applying the Brett et al. reference to claims 1 and 11. This explanation provided by the requester is hereby incorporated by reference.

There is a substantial likelihood that a reasonable examiner would consider the above teachings important in deciding whether or not claims 1 and 11 are patentable. Accordingly,

Brett et al. raises a substantial new question of patentability as to claims 1 and 11, which question has not been decided in a previous examination of Patent No. 5,474,142.

7. It is agreed that consideration of Hobhouse (US 3,550,697) taken alone raises a substantial new question of patentability as to claims 1 and 11 of Patent No. 5,474,142.

In the claim chart found on pages 34-36 of the request for *ex parte* reexamination, the requester has provided a detailed explanation of the pertinency and manner of applying the Hobhouse reference to claims 1 and 11. This explanation provided by the requester is hereby incorporated by reference.

There is a substantial likelihood that a reasonable examiner would consider the above teachings important in deciding whether or not claims 1 and 11 are patentable. Accordingly, Hobhouse raises a substantial new question of patentability as to claims 1 and 11, which question has not been decided in a previous examination of Patent No. 5,474,142.

8. It is agreed that consideration of Hobhouse (US 3,550,697) taken together with Dillon et al. (US 2,005,889) raises a substantial new question of patentability as to claims 2-4 and 12-15 of Patent No. 5,474,142.

In the claim chart found on pages 36-42 of the request for *ex parte* reexamination, the requester has provided a detailed explanation of the pertinency and manner of applying the Hobhouse and Dillon et al. references to claims 2-4 and 12-15. This explanation provided by the requester is hereby incorporated by reference.

There is a substantial likelihood that a reasonable examiner would consider the above teachings important in deciding whether or not claims 2-4 and 12-15 are patentable. Accordingly, Hobhouse taken together with Dillon et al. raises a substantial new question of patentability as to claims 2-4 and 12-15, which question has not been decided in a previous examination of Patent No. 5,474,142.

9. It is agreed that consideration of Dillon et al. (US 2,005,889) taken alone raises a substantial new question of patentability as to claim 14 of Patent No. 5,474,142.

In the claim chart found on pages 42-44 of the request for *ex parte* reexamination, the requester has provided a detailed explanation of the pertinency and manner of applying the Dillon et al. reference to claim 14. This explanation provided by the requester is hereby incorporated by reference.

There is a substantial likelihood that a reasonable examiner would consider the above teachings important in deciding whether or not claim 14 is patentable. Accordingly, Dillon et al. raises a substantial new question of patentability as to claim 14, which question has not been decided in a previous examination of Patent No. 5,474,142.

Not All Claims Reexamined

10. Since requester did not request reexamination of claims 9 and 10 and did not assert the existence of a substantial new question of patentability (SNQ) for such claims (see 35 U.S.C. § 302; see also 37 CFR 1.510b and 1.515), such claims will not be reexamined. This matter was squarely addressed in *Sony Computer Entertainment America Inc., et al. v. Jon W. Dudas*, Civil Action No. 1:05CV1447 (E.D.Va. May 22, 2006), Slip Copy, 2006 WL 1472462. The District Court upheld the Office's discretion to not reexamine claims in a reexamination proceeding other than those claims for which reexamination had specifically been requested. The Court stated:

> "To be sure, a party may seek, and the PTO may grant...review of each and every claim of a patent. Moreover, while the PTO in its discretion may review claims for which...review was not requested, nothing in the statute compels it to do so. To ensure that the PTO considers a claim for...review, [the statute] requires that the party seeking reexamination demonstrate why the PTO should reexamine each and every claim for which it seeks review. Here, it is undisputed that **Sony** did not seek review of every claim under the '213 and '333 patents. Accordingly, **Sony** cannot now claim that the PTO wrongly failed to reexamine claims for which **Sony** never requested review, and its argument that AIPA compels a contrary result is unpersuasive."

Remarks

11. Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a

reexamination proceeding. Additionally, 35 U.S.C. 305 requires that *ex parte* reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

12. Any proposed amendment filed in this reexamination proceeding must be made in accordance with 37 CFR 1.530(d)-(j) and comply with the formal requirements of 37 CFR 1.52(a) and (b). See MPEP 2250.

13. Responses to this Office action may be submitted by facsimile and should be directed to the Central Reexamination Unit using facsimile number 571-273-9900. A confirmation of receipt will be generated automatically for all papers transmitted via this facsimile number.

All responses to be delivered by the United States Postal Service (USPS) should be addressed as follows:

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Central Reexamination Unit
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be labeled "Attn: Central Reexamination Unit" and delivered to:

Customer Service Window
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

Submissions for reexamination proceedings may also be submitted through EFS-Web (the USPTO's web-based document submission system).

14. Any document filed by either the patent owner or third party requester ***must be served*** on the other party (or parties in a merged proceeding) in the reexamination proceeding in the manner provided by 37 CFR 1.248. See 37 CFR 1.550(f) and MPEP 2266.03.

15. The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving the patent throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

16. Any inquiry concerning this communication or earlier communications from the Reexamination Examiner should be directed to Peter English whose telephone number is (571)272-6671. The examiner can normally be reached on Monday through Thursday (7:00 AM - 5:00 PM). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andres Kashnikow, can be reached at 571-272-4361.

For general information regarding reexamination proceedings please call the Central Reexamination Unit at 571-272-7705. For guidance on reexamination practice and procedure please call the Office of Patent Legal Administration at 571-272-7703. Information regarding this reexamination proceeding may be obtained from the Patent Application Information Retrieval (PAIR) system. For more information about the PAIR system, see http://pair-direct.uspto.gov.

8/19/09

Peter C. English
Primary Examiner
Central Reexamination Unit

Conferees: MCG
BKJ2

pe
19 August 2009

90/010,615

PTO/SB/08A&B (06-09)

Substitute for form 1449/PTO

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Use as many sheets as necessary)

Sheet 1 of 2

Complete if Known	
Application Number	~~08/050,527~~
Filing Date	04-19-1993
First Named Inventor	Bowden
Art Unit	Not Assigned
Examiner Name	Not Assigned
Attorney Docket Number	026664-000500US

U.S. PATENT DOCUMENTS

Examiner Initials*	Cite No.[1]	Document Number Number Kind Code[2] (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
PE	AA	US-3,265,359	~~08-07-1962~~ 8/1966	Bowden	
	AB	US-4,662,608	~~05-24-1984~~ 5/1987	Ball	
	AC	US-2,005,889	~~11-12-1982~~ 6/1935	Dillon et al.	
	AD	US-~~3,550,697~~ 3,550,697	~~12-29-1967~~ 12/1970	Hobhouse	
	AE	US-~~1,890,329~~ 1,891,329	~~12-06-1932~~ 12/1932	LeCompte et al.	
	AF	US-3,223,183	~~12-28-1965~~ 12/1965	Varney	
PE	AG	US-4,854,397	~~08-10-1988~~ 8/1989	Warren et al.	
	AH	US-			

FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No.[1]	Foreign Patent Document Country Code[3] Number[4] Kind Code[5] (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T[6]
	AI					☐

NON PATENT LITERATURE DOCUMENTS

Examiner Initials *	Cite No.[1]	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T[2]
PE	AJ	J.F. BRETT, T.M. WARREN, and D.E. WALT, "Field Experiences With Computer-Controlled Drilling", Society of Petroleum Engineers publication SPE 20107 (1990)	☐
PE	AK	F.S. YOUNG, JR., "Computerized Drilling Control", Journal of Petroleum Technology, April 1969	☐
	~~AL~~	~~U.S. Patent Application 08/050,527, U.S. Patent 5,474,142, Examiner's Action, dated March 8, 1994~~	☐

Examiner Signature		Date Considered	8/17/09

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 809. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.
[1] Applicant's unique citation designation number (optional). [2] Applicant is to place a check mark here if English language Translation is attached.

62139792 v1

90/010,615

PTO/SB/08A&B (06-09)

Substitute for form 1449/PTO				Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT				Application Number	~~08/050,527~~
				Filing Date	04-19-1993
				First Named Inventor	Bowden
				Art Unit	Not Assigned
(Use as many sheets as necessary)				Examiner Name	Not Assigned
Sheet	2	of	2	Attorney Docket Number	026664-000500US

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials *	Cite No.[1]	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T[2]
	~~AM~~	~~U.S. Patent Application 08/050,527, U.S. Patent 5,474,142, Amendment A, dated June 10, 1994~~	☐
	~~AN~~	~~U.S. Patent Application 08/050,527, U.S. Patent 5,474,142, Second Examiner's Action, dated August 10, 1994~~	
	~~AO~~	~~U.S. Patent Application 08/050,527, U.S. Patent 5,474,142, Amendment After Final Under 37 C.F.R. § 1.116, dated November 7, 1994~~	☐
	AP		☐

Examiner Signature		Date Considered	8/17/09

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.
[1] Applicant's unique citation designation number (optional). [2] Applicant is to place a check mark here if English language Translation is attached.

62139792 v1

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Bib Data Sheet

CONFIRMATION NO. 8642

SERIAL NUMBER	FILING OR 371(c) DATE	CLASS	GROUP ART UNIT	ATTORNEY DOCKET NO.
90/010,615	07/24/2009 RULE	175	3993	026664-000500US

APPLICANTS

5474142, Residence Not Provided;
WILDCAT SERVICES, L.P.(OWNER), Cypress, TX;
PASON SYSTEMS USA CORP(3RD PTY REQ), Golden, CO;
David W. Boyd, San Francisco, CA

** CONTINUING DATA **********

This application is a REX of 08/050,527 04/19/1993 PAT 5,474,142

** FOREIGN APPLICATIONS **********

Foreign Priority claimed ☐ yes ☒ no 35 USC 119 (a-d) conditions met ☐ yes ☒ no ☐ Met after Allowance Verified and Acknowledged Examiner's Signature Initials	STATE OR COUNTRY	SHEETS DRAWING	TOTAL CLAIMS 15	INDEPENDENT CLAIMS 4

ADDRESS

WILDCAT SERVICES, L.P.
17219 Houston Dr.
Cypress, TX77433

TITLE

Ex Parte Reexamination of U.S. Patent No. 5,474,142

FILING FEE RECEIVED	FEES: Authority has been given in Paper	
2520	No. _____ to charge/credit DEPOSIT ACCOUNT No. _____ for following:	☐ All Fees ☐ 1.16 Fees (Filing) ☐ 1.17 Fees (Processing Ext. of time) ☐ 1.18 Fees (Issue) ☐ Other _____ ☐ Credit

Search Notes	Application/Control No.	Applicant(s)/Patent under Reexamination	
	90/010,615	5474142	
	Examiner	Art Unit	
	PETER C. ENGLISH	3993	

SEARCHED			
Class	Subclass	Date	Examiner
NONE		8/19/2009	PE

INTERFERENCE SEARCHED			
Class	Subclass	Date	Examiner

SEARCH NOTES (INCLUDING SEARCH STRATEGY)		
	DATE	EXMR
Reviewed IFW for Pat. No. 5,474,142	8/19/2009	PE
Reviewed Litigation Search dated 7/27/2009	8/19/2009	PE