



## **DETAILED ACTION**

### ***Notice of Pre-AIA or AIA Status***

1. The present application, filed on or after March 16, 2013, is being examined under the first inventor to file provisions of the AIA.

### ***Claim Objections***

2. Claim 19 is objected to because of the following informalities: on line 7 of the claim the term “pipt” should be changed to --pipe--. Appropriate correction is required.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on nonstatutory double patenting provided the reference application or patent either is shown to be commonly owned with the examined application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. See MPEP § 717.02 for applications subject to examination under the first inventor to file provisions of the AIA as explained in MPEP § 2159. See MPEP § 2146 *et seq.* for applications not subject

to examination under the first inventor to file provisions of the AIA. A terminal disclaimer must be signed in compliance with 37 CFR 1.321(b).

The filing of a terminal disclaimer by itself is not a complete reply to a nonstatutory double patenting (NSDP) rejection. A complete reply requires that the terminal disclaimer be accompanied by a reply requesting reconsideration of the prior Office action. Even where the NSDP rejection is provisional the reply must be complete. See MPEP § 804, subsection I.B.1. For a reply to a non-final Office action, see 37 CFR 1.111(a). For a reply to final Office action, see 37 CFR 1.113(c). A request for reconsideration while not provided for in 37 CFR 1.113(c) may be filed after final for consideration. See MPEP §§ 706.07(e) and 714.13.

The USPTO Internet website contains terminal disclaimer forms which may be used. Please visit [www.uspto.gov/patent/patents-forms](http://www.uspto.gov/patent/patents-forms). The actual filing date of the application in which the form is filed determines what form (e.g., PTO/SB/25, PTO/SB/26, PTO/AIA/25, or PTO/AIA/26) should be used. A web-based eTerminal Disclaimer may be filled out completely online using web-screens. An eTerminal Disclaimer that meets all requirements is auto-processed and approved immediately upon submission. For more information about eTerminal Disclaimers, refer to [www.uspto.gov/patents/apply/applying-online/eterminal-disclaimer](http://www.uspto.gov/patents/apply/applying-online/eterminal-disclaimer).

4. Claims 19-22 are rejected on the ground of nonstatutory double patenting as being unpatentable over claims 10-13 of U.S. Patent No. 11,781,421. Although the claims at issue are not identical, they are not patentably distinct from each other because the claims of the present invention merely remove limitations or use obvious changes in the claim language which do not rise to the level of patentably distinct from the claims of the '421 document.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 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 –

(a)(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.

(a)(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

**6. Claim(s) 1-4, 6-8 and 18 is/are rejected under 35 U.S.C. 102(a)(1) as being anticipated by Kuckes (US 9759060).**

With regards to claims 1 and 18, it discloses an apparatus for magnetic ranging comprising: a power supply (24); at least one section of drill pipe (57) operatively connected to the power supply; at least one wire (90) inside the at least one section of drill pipe that connects the power supply and the at least one section of drill pipe, wherein the connection between the wire and the drill pipe is a rigid connection (the spring loaded contacts, col. 10:11-16, are broadly read as a “rigid connection” since they maintain connection between the wire 90 and the pipe 57) that is capable of maintaining its rigid connection as the at least one section of drill pipe is drilling (while the spring loaded contact is used when not drilling. It is inherently “capable” of being used while drilling as it would maintain contact); a first electrically insulated member (71) electrically connected with the at least one section of drill pipe and that is capable of causing electrical energy (130) to exit a section of drill pipe; a sensor (102) for detecting a magnetic ranging signal.

With regards to claim 2, it discloses a second electrically insulated member (72) located further downhole from the first electrically insulated member.

With regards to claim 3, it discloses the sensor (102) is part of the bottom hole assembly.

With regards to claim 4, the sensor (102) is part of the drill pipe.

With regards to claim 6, it discloses the drill pipe (57) is a section of threaded drill pipe (col. 8:60-64).

With regards to claim 7, it discloses that the power supply (24) is connected to the drill pipe (57) using at least one wire (90) of a multiribbon wire (the wireline is disclosed as capable of carrying data and current, hence it is inherently a multiribbon wire).

With regards to claim 8, it discloses the power supply (24) is connected to the drill pipe using one or more conductors (col. 9:58-10:16).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

**8. Claim(s) 5 is/are rejected under 35 U.S.C. 103 as being unpatentable over Kuckes.**

With regards to claim 5, Kuckes shows all the limitation of the present invention except, it doesn't explicitly disclose that the drill pipe is coiled tubing. It is taken as Official Notice that many types of tubing/casing are used downhole and that coiled tubing applications would be comparable to applications done with threaded drill string where more flexibility is required. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was filed to use the drill pipe apparatus of Kuckes with coiled tubing. This would be done to allow for continuous feed of the drill downhole.

***Allowable Subject Matter***

9. Claims 9-17 are allowed.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited prior art all show similar features to those of the claimed invention.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL P STEPHENSON whose telephone number is (571)272-7035. The examiner can normally be reached M-F 10am-6pm.

Examiner interviews are available via telephone, in-person, and video conferencing using a USPTO supplied web-based collaboration tool. To schedule an interview, applicant is encouraged to use the USPTO Automated Interview Request (AIR) at <http://www.uspto.gov/interviewpractice>.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tara Schimpf can be reached on 571-270-7741. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/DANIEL P STEPHENSON/  
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