

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

GREENE'S ENERGY GROUP, LLC,

Petitioner,

v.

OIL STATES ENERGY SERVICES, LLC,

Patent Owner.

Case IPR2014-00216

Patent No. 6,179,053

PATENT OWNER'S MOTION TO AMEND
UNDER 37 C.F.R. § 42.121

I. INTRODUCTION

This Motion to Amend is submitted in compliance with 37 C.F.R. § 42.121. As required, Patent Owner conferred with the Board regarding filing this Motion to Amend in a conference call conducted on August 14, 2014.

II. LISTING OF PROPOSED SUBSTITUTE CLAIMS

28. (Proposed Substitute Claim for Claim 1) An apparatus for securing a mandrel of a well tool in an operative position requiring fixed-point packoff above the casing of the well and within a tubing head spool of a [in the] wellhead assembly, the apparatus comprising:

a setting tool that is arranged to insert a bottom end of the mandrel through the wellhead, and is removable from the other portions of the apparatus;

a first and a second mechanical lockdown mechanism that are separate from the setting tool and arranged so that the mandrel is locked in the operative position only when both the first and the second mechanical lockdown mechanism are in respective lockdown positions;

the first mechanical lockdown mechanism adapted to detachably maintain the mandrel in proximity to the fixed-point packoff when in the lockdown position,

the first mechanical lockdown mechanism including a base member for connection to a wellhead of the well and a locking member for detachably engaging the base member; [and]

the second mechanical lockdown mechanism having a range of adjustment adequate to ensure that the mandrel can be moved into the operative position, and then locked down in the operative position without the use of hydraulic pressure while the first mechanical lockdown mechanism is in the lockdown position; and the mandrel including a packoff assembly that seals against the fixed-point packoff within the tubing head spool.

29. (Proposed Substitute Claim for Claim 22) A method for lockdown of a mandrel of a well tool in an operative position in which the mandrel is packed off against a fixed-point above the casing of the well and within a tubing head spool of a [in the] wellhead assembly, the method comprising steps of:

a) mounting above a wellhead of the well an apparatus for securing the mandrel of the well tool in the operative position, comprising:

i) a setting tool that is arranged to insert a bottom end of the mandrel through the wellhead, and is removable from the other portions of the apparatus;

ii) a first and a second mechanical lockdown mechanism that are separate from the setting tool and arranged so that the mandrel is locked in the operative position only when both the first and second mechanical lockdown mechanisms are in respective lockdown positions;

iii) the first mechanical lockdown mechanism being adapted to detachably maintain the mandrel in proximity to the fixed-point for packoff, and including a base member for connection to a top of a wellhead of the well and a locking member for detachably engaging the base member; [and]

iv) the second mechanical lockdown mechanism having a range of adjustment to ensure that the mandrel can be moved into the operative position, and then locked down in the operative position without the use of hydraulic pressure while the first mechanical lockdown mechanism is in the lockdown position; and

v) the mandrel including a packoff assembly that seals against the fixed-point packoff within the tubing head spool;

b) after inserting the mandrel through the wellhead into proximity to the fixed-point in the well, engaging the locking member of the first lockdown mechanism with the base member so that the mandrel is only moveable within the range of adjustment;

c) moving the mandrel into the operative position if the mandrel is not yet packed off against the fixed-point; [and]

d) locking the second lockdown mechanism in the lockdown position;

and

e) removing the setting tool from the well tool.

III. STATEMENT OF SUBSTITUTION CONTINGENCIES

Consistent with 37 C.F.R. §42.121(a)(3), this Motion includes one substitute claim for each claim to be replaced. Pursuant to 37 C.F.R. §42.121(a)(2), the amendments respond to potential grounds of unpatentability involved in the trial, and do not seek to enlarge the scope of the claims or introduce new subject matter.

Claims 28 and 29 are contingent substitute claims to replace original claims 1 and 22, respectively, only if claims 1 and 22 are found to be unpatentable. These substitute claims merely (1) explicitly recite the setting tool and identify that it is separate from the first and second lockdown mechanisms and removable from the rest of the tool; (2) clarify where the fixed-point packoff is located within the wellhead assembly; and (3) explicitly recite that the “first lockdown mechanism” and “second lockdown mechanism” are *mechanical* lockdown mechanisms and, thus, that the second lockdown mechanism locks the mandrel in the operative position without the use of hydraulic pressure.

IV. SUPPORT FOR THE PROPOSED AMENDMENTS

As required under 37 C.F.R. § 42.121(b), the substitute claims are supported by the original disclosure of the '053 Patent. Attached as Exhibit 2021 is a chart showing where each element of the proposed amended claims was disclosed in the original specification, claims, and figures of Application No. 09/373,418.

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