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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LOC GIA HOANG

Appeal 2014-009188
Application 12/577,142
Technology Center 3700

Before LINDA E. HORNER, LISA M. GUIJT, and ERIC C. JESCHKE,
Administrative Patent Judges.

JESCHKE, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Loc Gia Hoang (“Appellant”)¹ seeks review under 35 U.S.C. § 134(a) of the Examiner’s decision, as set forth in the Final Office Action dated December 18, 2013 (“Final Act.”), rejecting claims 1–23 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.² We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Appellant identifies Cameron International Corporation as the real party in interest. Appeal Br. 2.

² The Examiner rejected various claims under 35 U.S.C. § 103(a) as unpatentable over certain prior art references. *See* Final Act. 3–12. In the Answer, the Examiner withdraws these rejections. *See* Ans. 3–4.

BACKGROUND

The disclosed subject matter “relates to a smart valve for monitoring valve performance and for measuring the pressure of a process fluid flowing through the smart valve.” Spec. ¶ 1. Claims 1, 11, and 17 are independent. Claim 1 is reproduced below:

1. A gate valve, comprising:
 - a body having a flow path in a first direction;
 - a stem;
 - a gate coupled to the stem, wherein the gate comprises a port;
 - an actuator coupled to the stem, wherein the actuator selectively moves the stem in a second direction to adjust a position of the gate between an open position and a closed position, the first and second directions are crosswise relative to one another, the open position of the gate has the port positioned within the flow path to enable flow of a fluid through the flow path and the port, and the closed position of the gate has the port positioned away from the flow path to block flow of the fluid through the flow path and the port;
 - a force sensor coupled to the stem and configured to obtain feedback indicative of an amount of force exerted on the stem, wherein the force sensor is disposed in a location isolated from the flow path of the fluid; and
 - a controller coupled to the actuator and the force sensor, wherein the controller is configured to analyze the feedback to at least estimate a pressure of the fluid, and the controller is configured to control the actuator to adjust the position of the gate at least partially based on the pressure of the fluid estimated based on the feedback.

DISCUSSION

The Examiner rejected claims 1–23 as failing to comply with the written description requirement. Final Act. 3. The Examiner stated that Appellant explained in prior arguments “that the invention relies on fluid trapped in the chamber during valve opening and closing to provide an indication of process pressure, however this is not provided for in the written description and as such has only become evident during the course of arguments in prosecution.” *Id.* In addition, the Examiner rejected claims 5 and 14 as failing to comply with the written description requirement, stating that these claims “indicate that the fluid pressure will be measured using a combination of the forces exerted within the port and on the distal end of the flow element” and stating that “[t]he [S]pecification is found to critically lack any indication of the relevance of the fluid pressure of the chamber in the finding of the process pressure.” *Id.* at 2.

Appellant argues “that the pressurized fluid is able to fill the interior chamber of the valve, such that the fluid pressure creates an upward force on a lowermost end of the gate 32” and that “[t]he pressurized fluid fills the interior chamber through one or more passages or gaps.” Appeal Br. 7. According to Appellant, “one of ordinary skill in the art would recognize that a gap would form between the upstream seat and the gate 32 while the pressurized fluid biases the gate 32 against the downstream seat” and that, “[a]s a result, the force sensor 74 is able to measure the force on the gate 32, thereby enabling an estimation of pressure of the fluid.” *Id.*

The Examiner states: “As [A]ppellant gives no indication in the [S]pecification that this gap is required to obtain full functionality of the claimed invention and it is not inherent to seals that they are required to leak,

the Examiner maintains that the written description is inadequate to support claims 5 and 14.” Ans. 4. The Examiner also states: “Within the art of valve design it is assumed that when seats are provided that they seal against the valve element they interact with, and while there are valve seats that are designed to leak or form a gap, these are not standard in the art.” *Id.* The Examiner “respectfully disagree[s]” that “Appellant had no obligation to disclose that the valve seats must be designed to leak.” *Id.* at 4–5.

In reply, Appellant contends that “one of ordinary skill in the art would recognize that Appellant’s gate valve relies on upstream pressure of the fluid in the valve connection 48 to create a seal between the valve gate 32 and the seat 44.” Reply Br. 2. Appellant also contends that “one of ordinary skill in the art would understand that in forming the seal between the valve gate 32 and the seat 44 enables the valve gate 32 to separate slightly from the seat 42 forming a gap between the valve gate 32 and the seat 42” and that “[i]n operation, the gap enables fluid to enter and fill the interior chamber of the valve, such that the fluid pressure creates an upward force on a lowermost end of the gate 32.” *Id.* According to Appellant, “[a]s a result, the force sensor 74 is able to measure the force on the gate 32, thereby enabling an estimation of the fluid pressure.” *Id.*

We are not apprised of error in either the rejection of claims 1–23 or the rejection of claims 5 and 14. The test for compliance with the written description requirement is “whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). Here, Appellant does not identify any specific disclosure in the

Specification to support the arguments on appeal. *See* Appeal Br. 7 (stating that “the specification and drawings provide a clear written description of the claimed subject matter”); Reply Br. 2 (stating that “the specification and drawings provide written description of the claimed subject matter”). For example, Appellant identifies no disclosure of the “fluid pressure” allegedly present in the “interior chamber of the valve” (either using Appellant’s phrasing or in other terms). *See* Appeal Br. 7; Reply Br. 2; *see also Ariad*, 598 F.3d at 1352 (stating that “the description requirement does not demand . . . that the specification recite the claimed invention *in haec verba*”).

Moreover, although Appellant is correct that, “[i]f a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met” (Reply Br. 2),³ here, Appellant has not provided any evidence—rather, only attorney argument—to support the position that one of ordinary skill in the art would have understood that the inventor had possession of the claimed subject matter as of the filing date. *See Ariad*, 598 F.3d at 1351 (stating that the test for sufficiency of written description “requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art”).

For these reasons, we sustain both the rejection of claims 1–23 as failing to comply with the written description requirement and the rejection

³ *See, e.g., In re Alton*, 76 F.3d 1168, 1175 (Fed. Cir. 1996) (“If a person of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate written description requirement is met.”).

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of claims 5 and 14 as failing to comply with the written description requirement.

DECISION

We AFFIRM the decision to reject claims 1–23 under 35 U.S.C. § 112, first paragraph.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED