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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JEFFREY SWIATOWY,
JACOB WILLIAMS, and ALEXANDER GIBERMAN

Appeal 2015-002543
Application 12/885,717
Technology Center 3600

Before STEFAN STAICOVICI, JAMES P. CALVE, and
BRANDON J. WARNER, *Administrative Patent Judges*.

CALVE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the final rejection of claims 1–20. Appeal Br. 7. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

Claims 1 and 14 are independent. Claim 1 is reproduced below.

1. A device for preparing a submerged pipe, said device comprising
a platform,
a clamp on said platform,
said clamp selectively clamping and releasing around a circumference of said submerged pipe,
a frame moveably attached to said platform wherein said frame is moveable in an arc of at least three hundred sixty degrees around said submerged pipe and perpendicular to a central longitudinal axis of said submerged pipe,
a first machine on said frame,
said first machine retaining a first tool rotatable about a first axis extending generally perpendicular and radial to the central longitudinal axis of said submerged pipe,
said first tool adapted to engage a first surface of said submerged pipe,
a second machine on said frame,
said second machine retaining a second tool rotatable about a second axis extending generally perpendicular and radial to the central longitudinal axis of said submerged pipe,
and
said second tool adapted to engage a second surface of said submerged pipe.

REJECTIONS

Claims 1–10, 12, and 13 are rejected under 35 U.S.C. § 103(a) as unpatentable over Motes-Conners (US 4,091,514, iss. May 30, 1978) and Horne (WO 2007/102744 A1, pub. Sept. 13, 2007).

Claim 11 is rejected under 35 U.S.C. § 103(a) as unpatentable over Motes-Conners, Horne, Rose (US 5,199,226, iss. Apr. 6, 1993), and van Voskuilen (US 4,552,594, iss. Nov. 12, 1985).

Claims 14 and 18 are rejected under 35 U.S.C. § 103(a) as unpatentable over Motes-Conners and Lawler (US 2008/0135232 A1, pub. June 12, 2008).

Claims 16 and 19 are rejected under 35 U.S.C. § 103(a) as unpatentable over Motes-Conners, Lawler, Rose, and van Voskuilen.

Claims 15 and 20 are rejected under 35 U.S.C. § 103(a) as unpatentable over Motes-Conners, Lawler, and Tucker (US 6,539,778 B2, iss. Apr. 1, 2003).

ANALYSIS

Claims 1–10, 12, and 13 as unpatentable over Motes-Conners and Horne

Claim 1

The Examiner found that Motes-Conners teaches a device, as recited in claim 1, except a second machine having a second tool rotatable about a second axis and extending generally perpendicular and radial to a central longitudinal axis of a submerged pipe. Final Act. 3–4. The Examiner found that Horne discloses a machine (beveling cutting tool 109) that rotates about an axis perpendicular and radial to an axis of a submerged pipe. *Id.* at 4. The Examiner found that a skilled artisan would understand that Horne's milling tool 109 (Figure 8) is oriented to rotate perpendicularly and move radially to the center longitudinal axis of the pipe. Ans. 16. The Examiner determined it would have been obvious to add a second machine of Horne to Motes-Conners to mill the outer surface of a submerged pipe, remove pipe coatings, simplify operations, and save time. Final Act. 4; Ans. 17. The Examiner also determined it would have been obvious to duplicate the mill of Motes-Conners using routine skill to provide a second machine for the same reasons of time savings and simplification of operations. Ans. 16–18.

Appellants argue that Motes-Conners does not teach or suggest two tools rotatable about two axes with both axes generally perpendicular and radial to a central longitudinal axis of a submerged pipe, and Horne does not teach the orientation of the single tool 109. Appeal Br. 15. Appellants also argue that even if Horner's single tool 109 could be rotatable about an axis that is perpendicular and radial to a longitudinal axis of a pipe, Horne only teaches one such tool and, therefore, is cumulative to Motes-Conners. *Id.* at 15–16. Appellants further argue that nothing in Motes-Conners or Horne teaches or suggests having two tools rotatable with both axes perpendicular and radial to a central longitudinal axis of a pipe, as claimed. *Id.* at 16. Appellants also argue that the Examiner's reliance on generalized benefits that may result from the modification is not sufficient. *Id.* at 17.

The Examiner's reason for modifying Motes-Conners to include a second machine and tool rotatable about a second axis extending generally perpendicular and radial to a central longitudinal axis of a submerged pipe is based on a rational underpinning. The Examiner proposes to add a second machine based on Horne's teaching of a single tool 109 that provides milling and beveling functionalities to remove coatings, simplify operations, and save time. Final Act. 4; Ans. 17. The basis for this reason is supported by a preponderance of evidence based on Horne's express teachings that movable milling *and* beveling tool 109 *mills* outer pipe surfaces to remove coatings, welding seams, and other defects, and also finishes and *bevels* end surfaces of a pipe. Horne, 6:6–10, claim 9, Fig. 8. This multi-functional tool would increase efficiency, save time, and simplify operations, and thus provide the motivation for the proposed change. *E.g., DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1368 (Fed. Cir. 2006).

The Examiner's alternate reason for duplicating milling machine 92 of Motes-Conners as an obvious duplication of parts is supported by rational underpinning as well. Although *per se* rules of obviousness are disfavored, here, the Examiner proposes to duplicate Motes-Conners's milling machine as a simple, obvious way to achieve the same objectives as adding a second machine from Horne. Ans. 16–17. This reasoning also is supported by a rational underpinning for the reasons discussed above. A second machine based on milling machine 92 and/or beveling and milling machine 109 of Horne improves the functionality and efficiency of Motes-Conners's device by reducing the need for multiple separate devices and extra time-consuming steps, such as the preliminary cleaning of pipe coatings before milling, as Motes-Conners must do in the absence of a second machine. *Id.* at 16–18.

The Examiner's finding that Horne's milling and beveler 109 meets the rotational axis and radial limitations of the second machine is supported by a preponderance of evidence. *See id.* at 16. We agree with the Examiner that a skilled artisan would understand Figure 8 of Horne and accompanying disclosure to teach a milling/beveling tool 109 with a rotational axis and a radial orientation as claimed. Figure 8 shows tool 109 in a radial orientation spaced away from an outer surface of pipe 101 so radial movement toward pipe 101 would be required to engage the outer pipe surface for the milling and beveling operations disclosed in Horne. *See Horne*, claim 9. Moreover, Appellants admit that mills can rotate about a wide range of angles (Appeal Br. 15), so that it would have been obvious to modify Horne using routine skill in the art where Appellants do not disclose any unexpected results or criticality for the claimed orientation of the second (or first) machine.

Thus, we sustain the rejection of claim 1.

Claims 2 and 3

The Examiner also determined that a modified Motes-Conners device would render obvious a rotatable tool that includes a milling tool and a bevel cutter (claim 2) and a tool with teeth and a frustoconical surface (claim 3) because such tools and shapes are notoriously well-known in the art as evidenced by Smith (U.S. Patent No. 2,429,375). Final Act. 4; Ans. 19–20.¹

Appellants argue that Motes-Conners fails to teach a machine with “a rotatable tool that includes both a milling tool and a bevel cutter,” as recited in claim 2. Appellants also argue that none of the references cited by the Examiner in taking Official Notice teach or disclose these limitations, so the Examiner is relying on personal knowledge. Appeal Br. 18–19, 20–21.

Appellants’ arguments are not persuasive in view of Smith’s teaching of a tool that includes drill “D” with teeth for milling and countersink 11 for beveling a work piece and Horne’s milling-beveling tool 109. Smith, 2:21–47, Fig. 1; Horne, claim 9. Appellants’ arguments that the Examiner relied on personal knowledge (Reply Br. 9; Appeal Br. 18–20) are not persuasive in view of this evidence. Appellants’ conclusory argument that none of the references disclose claims 2 and 3 (Appeal Br. 19–21) are unpersuasive for similar reasons. *See In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011).

Thus, we sustain the rejection of claims 2 and 3.

Claims 6 and 8

The Examiner found that Motes-Conners, as modified, teaches first, second, and third machines with each performing different functions (claim 6) including the five preparation steps recited in claim 8. Final Act. 5–6.

¹ The Examiner cited Smith to support the Examiner’s taking of Official Notice that such features are well-known. *See* Ans. 19–20.

Appellants argue that Motes-Conners discloses two tools for pipe preparation, and Horne only discloses a single tool. Appeal Br. 22. As a result, Appellants argue that neither reference teaches or suggests a device with three machines and three tools that perform five steps on a submerged pipe as recited in claims 6 and 8. *Id.* at 22–24; *see* Reply Br. 11–12.

The Examiner’s findings that Motes-Conners and Horne teach and render obvious a device with three machines that perform five different pipe preparation steps is supported by a preponderance of evidence. As discussed above, Motes-Conners, as modified by Horne or by obvious duplication, has the claimed first and second machines. Motes-Conners also includes pipe cutter 102, which is “a third machine.” These three machines can perform five preparation steps. Appellants’ arguments that neither reference teaches three machines or five steps do not address these modifications of Motes-Conners, and thus do not persuade us of error in the Examiner’s findings or determination of obviousness of claims 6 and 8. *See In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (approving of Board’s practice as set forth in *Ex Parte Frye* of requiring appellants to identify error in a rejection); *Ex Parte Frye*, 94 USPQ 2d 1072, *4 (BPAI 2010) (precedential) (a panel reviews rejections for error based on the issues identified by an appellant). Merely restating claim limitations and asserting that the limitations are not found in the prior art does not identify error in a rejection. *See Lovin*, 652 F.3d at 1357; 37 C.F.R. § 41.37(c)(1)(iv).

Thus, we sustain the rejection of claims 6 and 8.

Claim 9

The Examiner found that a modified Motes-Conners device has three machines moving independently radially, as recited in claim 9. Final Act. 6.

Appellants' arguments that Horne does not teach a radial orientation of tool 109 and Motes-Conners lacks three such machines (Appeal Br. 25) are not persuasive for the reasons discussed above for claim 1. Appellants' conclusory argument that the Examiner's reliance on a duplication of parts rationale is deficient also is not persuasive of error for the reasons discussed above for claim 1. *See* Reply Br. 12–13; *In re Jung*, 637 F.3d 1356, 1365. In this regard, Motes-Conners teaches first and second machines 92, 102 that move radially, as recited in claim 9. Motes-Conners, 4:38–68. Duplication of milling machine 92, or adding Horne's tool 109, as proposed for claim 1, provides a third machine that moves independently radially, as claimed.

Thus, we sustain the rejection of claim 9.

Claim 10

The Examiner found that Motes-Conners discloses a mechanical lock for locking the clamp against movement in the event of loss of hydraulic pressure from a source. Final Act. 6. The Examiner reasoned that release 35 functions as a lock and can be latched and unlatched by mechanical means or hydraulic means. *Id.*

Appellants argue that Motes-Conners does not teach a mechanical lock that locks the jaws of a clamp against movement in the event of loss of hydraulic pressure from said source as recited in claims 10 and 14. Appeal Br. 26–29. Appellants also argue that if the components relied on by the Examiner as the mechanical lock are powered by hydraulic means, then the components would not function with the loss of hydraulic means and would not lock without hydraulic pressure. Reply Br. 13–14. Appellants further argue that neither handles 38, 39 or toggle link 35 are mechanical locks. Appeal Br. 29.

The Examiner has established by a preponderance of evidence that Motes-Conners includes a mechanical lock, as recited in claim 10. Motes-Conners teaches that fixed handles 38, 39 may be used to manipulate toggle link 35 manually, if desired, to disengage clamps 19, 20 from pipe 18. Motes-Conners 3:7–10, Fig. 2. The Examiner reasonably found that these mechanical elements function as a lock that can unlock and lock clamps 19, 20 against pipe 18 without reliance on hydraulic pressure and thus satisfies the requirements of claim 10. Ans. 22, 24. Appellants do not point to any recited structural or functional features that define the claimed “mechanical lock” over the lock disclosed in Motes-Conners. Appellants’ recitation of the language of claim 10 and bare assertion that Motes-Conners does not teach these features does not provide effective argument, and thus does not persuade us of error in the Examiner’s findings in this regard.²

Thus, we sustain the rejection of claim 10.

Claims 4, 5, 7, 12, and 13

Appellants do not present separate arguments for dependent claims 4, 5, 7, 12, or 13. *See* Appeal Br. 13–31. Therefore, we sustain the rejection of those claims as unpatentable over Motes-Conners and Horne.

² Although Appellants disclose an embodiment where rodlock device 410 automatically clamps around rod 416 to prevent longitudinal movement of rod 416, claim 10 recites a mechanical lock *for* locking the clamp against movement. This intended use does not require a mechanical lock to lock automatically or in a way that excludes the manually-activated locking feature of Motes-Conners. Moreover, claim 10 does not specify how the hydraulic pressure is applied to the device or even how the hydraulic pressure affects the clamps. Therefore, claim 10 encompasses a mechanical lock that locks a clamp against movement as in Motes-Conners.

Claim 11 as unpatentable over Motes-Conners, Horne, Rose, and van Voskuilen

Appellants do not present arguments for the rejection of claim 11. *See* Appeal Br. 13–33. Therefore, we summarily sustain this rejection.

Claims 14 and 18 as unpatentable over Motes-Conners alone or with Lawler

The Examiner found that Motes-Conners discloses a submerged pipe preparation device as recited in independent claim 14, having a plurality of machines 92, 102 and a mechanical lock for locking the moveable jaw of the clamp against movement in the event of loss of hydraulic pressure from the source of hydraulic fluid. Final Act. 14. The Examiner found that the lock is latched and unlatched by hydraulic means, and manually by handles 38, 39, and determined it would have been obvious to latch and unlatch the lock mechanically because providing a mechanical or automatic means involves routine skill in the art to achieve the same result. *Id.* at 14–15; Ans. 24–26.

The Examiner also found that Lawler discloses a machine (Figure 4) that retains a second tool for rotation about an axis generally perpendicular to the longitudinal axis of a submerge pipe as recited in claims 14 and 18, which depends from claim 14. Final Act. 10–11. The Examiner determined it would have been obvious to add Lawler’s machine to Motes-Conners to increase the utility of Motes-Conners’s device to perform more preparation tasks for submerged pipes. *Id.* at 11.

Appellants argue that Motes-Conners does not teach another machine as the Examiner admits for claim 1. Appeal Br. 27. This argument is not persuasive because claim 14 does not require the plurality of machines to have a rotatable perpendicular axis, as does claim 1 for the first and second machines. Thus, cutting machine 102 of Motes-Conners is another machine.

The Examiner’s reliance on Lawler to teach a third machine with a rotatable perpendicular axis, as recited in dependent claim 18, does not alter or detract from the fact that Motes-Conners teaches two machines that move radially and include rotatable tools. Thus, Motes-Conners satisfies claim 14, which recites a plurality of machines that perform a different preparation step to a surface of the submerged pipe, by teaching milling machine 92 with cutting tool 95 that works on weld seam 90, and cutting machine 102 that moves around a circumference of pipe 18 with cutting blade 106. Motes-Conners, 4:39–68, Fig. 4. Appellants’ conclusory arguments that Motes-Conners does not disclose “another machine” do not persuade us of error in the Examiner’s supported findings that Motes-Conners does disclose another machine, as recited in claim 14. Appeal Br. 27.

Appellants’ arguments that Motes-Conners does not disclose a mechanical lock and Lawler does not remedy this deficiency (Appeal Br. 28–32) are not persuasive for the reasons discussed above for claim 10.

Thus, we sustain the rejection of claims 14 and 18.

Claims 16 and 19 as unpatentable over Motes-Conners, Lawler, Rose, and van Voskuilen

Appellants do not present arguments for the rejection of claims 16 and 19. See Appeal Br. 13–33. Therefore, we summarily sustain this rejection.

Claims 15 and 20 as unpatentable over Motes-Conners, Lawler, and Tucker

Claim 20 recites “[t]he device of claim 14 and further comprising a mechanical device operable from an independent submersible for rotating the frame in the event of loss of hydraulic power.” The Examiner relied on Tucker to teach this feature as submersible subsea vehicle 18 with its robotic arm 19 used to operate undersea manifold 12. Final Act. 13–14.

Appellants argue that claim 20 requires the device of claim 14 further to include a mechanical device, and does not recite a separate submersible as the Examiner interpreted claim 20 to require an independent submersible such as Tucker. Appeal Br. 32–33. We agree with the Examiner that a plain meaning and the broadest reasonable interpretation of claim 14 recites a separate mechanical device in addition to the device of claim 14. Claim 14 does not recite “the device of claim 14 further comprising” or “wherein the device of claim 14 further comprises,” such that the mechanical device is claimed as a part of the device of claim 14. Ans. 27. Instead, claim 20 recites the device of claim 14 “and further comprising a mechanical device,” so that the broadest reasonable interpretation includes the device of claim 14 and another mechanical device in addition to the device of claim 14.

Thus, we sustain the rejection of claim 20. Because Appellants do not present arguments for claim 15, we also sustain the rejection of that claim.

DECISION

We affirm the rejections of claims 1–20.

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