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EXAMINER
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MAYO-PINNOCK, TARA LEIGH

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* STEFANO BIANCHI, KIMON TULLIO ARDAVANIS,  
MICHEL PIERRE ARMAND BAYLOT, and YANN HAJERI

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Appeal 2017-006911  
Application 13/978,911  
Technology Center 3600

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Before JOHN C. KERINS, KEVIN F. TURNER, and  
SEAN P. O'HANLON, *Administrative Patent Judges*.

O'HANLON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Stefano Bianchi et al. (“Appellants”)<sup>1</sup> appeal under 35 U.S.C.  
§ 134(a) from the Examiner’s decision, as set forth in the Final Office  
Action dated April 11, 2016 (“Final Act.”), rejecting claims 3, 15–17, 19,

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<sup>1</sup> The Appeal Brief identifies Saipem S.p.A. as the real party in interest.  
Appeal Br. 1.

22, 31–33, 38–40, and 48. We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

#### SUMMARY OF THE DECISION

We AFFIRM-IN-PART and enter a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

#### SUMMARY OF THE INVENTION

Appellants' claimed invention relates to pipe-laying vessels and to methods of laying a pipeline. Spec. 1:5–6. Claims 3 and 31 are independent. Claim 3, reproduced below from page 11 (Claims Appendix) of the Appeal Brief, is illustrative of the claimed subject matter:

3. A pipe-laying vessel including a pipe-laying tower extending upwardly from a main deck of the vessel, the tower comprising:
  - a lower section and an upper section,
  - the lower section extending upwardly from a proximal end to a distal end above the main deck of the vessel, and
  - the upper section movably mounted on the lower section, the tower having a first pipe-laying configuration for laying pipeline in which the upper section is positioned above the lower section and pipe is passed from the upper section to the lower section when, in use, it is being laid, and a second stowed configuration in which the upper section is moved relative to the lower section and the overall height of the tower is reduced; and
  - means for pivoting the upper section in relation to the lower section such that an end of the upper section is pivoted down to be supported on a deck of the vessel when in the second stowed configuration.

## REFERENCES

The Examiner relies on the following prior art references in rejecting the claims on appeal:

Ashton	US 3,011,318	Dec. 5, 1961
Bursaux	US 2007/0258772 A1	Nov. 8, 2007
Lucas	US 2010/0176079 A1	July 15, 2010
Seguin	GB 2 336 191 A	Oct. 13, 1999

## REJECTIONS

- I. Claims 3, 39, and 40 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lucas.
- II. Claims 3, 39, and 40 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ashton.
- III. Claims 31–33, 38, and 48 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bursaux.
- IV. Claims 3, 15–17, 19, 22, 39, and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Seguin in view of Lucas or Ashton.

## ANALYSIS

### *Rejection I*

The Examiner finds that Lucas discloses all of the elements of independent claim 3. Final Act. 3. Regarding the recited “means for pivoting,” the Examiner relies on Lucas’s pivot apparatus 64: “means for pivoting (64) the upper section in relation to the lower section such that an end of the upper section is pivoted down to be supported on a deck (67) of the vessel when in the second stowed configuration (para. 0066).” *Id.* The Examiner notes that “[c]laim 3 recites ‘a main deck of the vessel’ in the

preamble[,] which main deck is separate and distinct from the later recited ‘a deck of the vessel.’” Ans. 4. Continuing, the Examiner finds that “[t]hus, the prior art deck (67), which is on the vessel, is one of at least two decks on the vessel.” *Id.*

Appellants argue, *inter alia*, that Lucas’s “support 67 is part of the derrick itself” and “cannot be considered to be a deck of the vessel.” Appeal Br. 5; *see also* Reply Br. 3.

A claim under examination is given its broadest reasonable interpretation consistent with the underlying specification. *See In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). In the absence of an express definition of a claim term in the specification or a clear disclaimer of scope, the claim term is interpreted as broadly as the ordinary usage of the term by one of ordinary skill in the art would permit. *See In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007); *see also In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

The term *deck* has a particular meaning in marine applications. *See, e.g.*, <http://www.oed.com/view/Entry/48229> (last visited Oct. 31, 2018) (“*Nautical*. A platform extending from side to side of a ship or part of a ship, covering in the space below, and also itself serving as a floor; formed of planks, or (in iron ships) of iron plating usually covered with planks.”). Both the Specification and claim 3 use the term consistent with this meaning, referring to “deck of the vessel.” *See, e.g.*, Spec. 44:26–27. Lucas also uses “deck” in this manner. *See, e.g.*, Lucas ¶ 56, Fig. 2.

As correctly noted by Appellants, Lucas’s platform 67 is part of the derrick itself and does not form a part of the “floor” of the vessel. *See id.* ¶ 66, Figs. 6A–6C. Notably, Lucas does not refer to support 67 as a “deck.”

The Examiner's interpretation of support 67 as being a "deck of the vessel" as required by claim 3 is overly broad and inconsistent with how "deck" would be interpreted by one of ordinary skill in the art.

As the Examiner has not set forth adequately how Lucas discloses the recited means for pivoting, we do not sustain the rejection of claim 3, or its dependent claims 39 and 40, as being anticipated by Lucas. *Verdegaal Bros., Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.").

#### *Rejection II*

The Examiner finds that Ashton discloses all of the elements of independent claim 3, relying on Ashton's barge 10 to correspond to the recited pipe-laying vessel. Final Act. 4; *see also id.* at 11.

Appellants traverse, first arguing that "*Ashton* relates to equipment for the offshore drilling of wells" and "*Ashton* is not a pipe-laying vessel, it is only a 'delivery' vessel." Appeal Br. 6. Appellants further argue that, although Ashton discloses a derrick, "*Ashton* does not mention pipes or pipe-laying at all" and Ashton's "mast M is not capable of being raised or moved while on the barge 10." *Id.* Appellants also argue that "[t]he barge 10 and supporting structure S of *Ashton* simply cannot be used to lay pipes." Reply Br. 5.

We agree that Ashton "relates to equipment for the offshore drilling of wells" and discloses barge 10 as being used to carry derrick D to supporting structure S. Ashton 1:9–10, 2:19–28. However, Appellants' arguments that

Ashton's barge cannot also be used as a pipe-laying vessel are presented in conclusory fashion with no supporting evidence or persuasive technical reasoning. We note that Ashton's barge 10 includes notch 12 and the derrick is positioned such that its base B overlies the notch. *Id.* at 2:21–23; *see also id.* at Fig. 7 (illustrating notch 12 in barge 10). Thus, Ashton's notch 12 would allow pipes to be deployed from the barge in a similar manner as Appellants' moonpool. Additionally, although Ashton's preferred use is that the derrick mast remains in the reclining position while the derrick is being positioned on the supporting structure (*id.* at 2:24–28), Appellants do not set forth, nor does our review reveal, any disclosure in Ashton or reasoning why the mast would be precluded from being moved to the extended, operational position while the derrick is on the barge. Furthermore, one of ordinary skill in the art would understand that a derrick used in well drilling operations is capable of deploying pipe. *See Lucas* ¶ 8 (addressing known drill ships and noting that pipes are used with drilling derricks).

Appellants also argue that “as can be seen from Figure 1 of *Ashton*, an[] end of the mast M is not supported on the deck of the vessel. Instead, it is a side portion of the mast M that rests on support structure 22.” Appeal Br. 7.

Ashton's discloses that “[t]he reclining mast is supported by a transverse roller **21** supported by a structure **22** which extends upwardly from the deck of the barge **10**.” Ashton 2:37–39. Thus, Ashton supports the Examiner's finding that Ashton's mast is supported by the deck while in the stowed configuration. To the extent that Appellants argue that “an *end* of the upper section,” as recited in claim 3, requires that the terminal tip of the

mast must contact the deck, Appellants do not support such a contention with any citation to the Specification imparting such a limited definition, and, thus, fail to apprise us of error in the Examiner's interpretation. Additionally, we note that Appellants' tower abutment portion 114, which contacts vessel abutment portion 107 in the stowed configuration, appears to extend from the side of the mast. *See* Spec. Figs. 14a–14c, 44:25–45:4.

Accordingly, for the foregoing reasons, we sustain the rejection of claim 3 and its dependent claims 39 and 40, for which Appellants do not provide separate arguments, as being anticipated by Ashton.

### *Rejection III*

Independent claim 31 recites:

31. A pipe-laying vessel including  
pipe-laying apparatus configured to S-lay a pipeline from  
the vessel along an S-lay pipe-laying path,  
wherein, at a same time that the pipe-laying vessel  
includes pipe-laying apparatus that is configured to S-lay a  
pipeline from the vessel, the vessel further includes a pipe-  
laying tower configured to J-lay a pipeline from the vessel,  
the pipe-laying tower being positioned partway along a  
length of the vessel between the upstream and downstream  
portions of the S-lay pipe-laying path.

Appeal Br. 12 (Claims App.).

The Examiner finds that Bursaux discloses all of the elements of independent claim 31. Final Act. 5. The Examiner relies on Bursaux's lower tower 1060 to correspond to the recited J-laying tower. *Id.*; *see also* Ans. 8. The Examiner cites paragraphs 277–83 as disclosing equipment “which can be used in both S-lay and J-lay operations.” Ans. 8. The

Examiner further finds that “pipelay ramp 1250 [is] capable of being positioned for S-lay or J-lay operations.” *Id.* (citing Bursaux ¶ 382).

Appellants argue, *inter alia*, that Bursaux provides “no teaching of having both apparatus for S-laying and J-laying *at the same time*.” Appeal Br. 10.

We agree with Appellants that the Examiner has not identified with requisite clarity how Bursaux discloses a vessel including both S-laying apparatus and a J-laying tower. Paragraphs 277–83, the paragraphs relied on by the Examiner, disclose equipment accommodated by the J-laying tower, but do not disclose S-laying. The Examiner’s conclusory statement that the J-laying equipment can be used in an S-laying operation is unsupported by any technical reasoning, and neglects to set forth how J-laying equipment and S-laying equipment are configured for operation at the same time. The same shortcomings apply to the Examiner’s reliance on pipelay ramp 1250 as being capable of being positioned for S-lay or J-lay operations.

As the Examiner has not set forth adequately how Bursaux discloses S-laying apparatus and a J-laying tower configured for operation at the same time, we do not sustain the rejection of claim 31, or its dependent claims 32, 33, 38, and 48, as being anticipated by Bursaux.

#### *Rejection IV*

The Examiner finds that Seguin discloses a pipe-laying vessel including a tower substantially as recited in claim 3, but relies on Lucas or Ashton to teach an upper tower section movably mounted on a lower tower section. Final Act. 7, 8–10. The Examiner reasons that it would have been obvious to one of ordinary skill in the art “to modify the tower of [Seguin]

such that the upper section would be movably mounted on the lower section . . . to lower the center of gravity of the vessel thereby enhancing its stability.” *Id.* at 9, 10.

Appellants argue that because “*Lucas* discloses a drilling rig . . . , one of ordinary skill in the art seeking to improve a J-laying vessel, such as that disclosed in [*Seguin*], would not be motivated to look to *Lucas*.” Appeal Br. 7. Appellants similarly argue that a skilled artisan would not rely on Ashton to teach a modification to *Seguin*. *Id.* at 8.

We are not persuaded by Appellants’ arguments, which are presented in conclusory fashion with no supporting evidence or persuasive technical reasoning. Furthermore, as explained above, Ashton discloses a derrick that is configured to lay pipes. Lucas’s derrick is similarly configured to lay pipes. *See, e.g.*, Lucas ¶ 8. Appellants’ contentions, therefore, fail to apprise us of error in the Examiner’s reliance on these teaching references.

Appellants also argue that “removing the J-laying tower of [*Seguin*] and replacing it with a drilling tower (of *Lucas*) would render the vessel of [*Seguin*] unsatisfactory for J-laying.” Appeal Br. 8. Appellants make the same argument regarding Ashton. *Id.* at 9.

Contrary to Appellants’ assertions, the Examiner’s rejection does not *replace* *Seguin*’s tower with Lucas’s or Ashton’s tower; rather, the Examiner’s rejection *modifies* *Seguin*’s tower to include a means for pivoting the upper section relative to the lower section. Final Act. 8–10; *see also* Ans. 6–7. As Appellants have failed to address the rejection as articulated by the Examiner, Appellants fail to apprise us of error.

Accordingly, for the foregoing reasons, we sustain the rejection of claim 3 and its dependent claims 15–17, 19, 22, 39, and 40, for which

Appellants do not provide separate arguments, as being unpatentable over Seguin and Ashton. Because the Examiner's reliance on Lucas suffers from the same shortcomings as explained above with respect to Rejection I, we do not sustain the rejection of claim 3, or its dependent claims 15–17, 19, 22, 39, and 40, as being unpatentable over Seguin and Lucas.

*New Ground of Rejection*

Pursuant to 37 C.F.R. § 41.50(b), we enter a new ground of rejection of claim 31 under 35 U.S.C. § 102(b) as anticipated by Bursaux for the reasons provided below. Although we decline to reject every claim under our discretionary authority, we emphasize that our decision does not mean the remaining claims are patentable. Rather, we leave the patentability determination of these claims to the Examiner. *See* MPEP § 1213.02.

Regarding claim 31, Bursaux discloses side-mounted stinger 110 on pipe-laying vessel 80. Bursaux ¶ 200, Figs. 3a, 3b. “Product up to ~45 cm (18") diameter can also be deployed . . . using the stinger **110** configured to the side of the ship.” *Id.* ¶ 206. “It is possible . . . to deploy rigid pipes using Steep ‘S’ lay. The associated stinger may also be used to deploy flexible flowlines and umbilicals. Steep ‘S’ has the advantage of lower weight and centre of gravity of the deployment equipment and structures (*Tower versus Stinger*).” *Id.* ¶ 287 (emphasis added). Thus, Bursaux's stinger 110 corresponds to the recited “pipe-laying apparatus configured to S-lay a pipeline from the vessel.” Figure 12 shows the S-lay pipe-laying path extending from carousel 104 to stinger 110. *See also id.* ¶ 169 (“FIG. **12** is an isometric view of the pipe train of said vessel, configured for the

carousel . . . deployment of pre-welded rigid product via a side-mounted stinger.”).

Bursaux further discloses tower 106, including lower tower 1060 and upper tower 1062, that is configured to J-lay a pipeline. *Id.* ¶¶ 200, 204. The tower is in operational configuration at the same time that the stinger is in operational configuration, and the tower is positioned partway along a length of the vessel between the upstream and downstream portions of the S-lay pipe-laying path. *Id.* at Figs. 3a, 3b.

#### DECISION

The Examiner’s decision to reject claims 3, 39, and 40 as being anticipated by Lucas is reversed.

The Examiner’s decision to reject claims 3, 39, and 40 as being anticipated by Ashton is affirmed.

The Examiner’s decision to reject claims 31–33, 38, and 48 as being anticipated by Bursaux is reversed.

The Examiner’s decision to reject claims 3, 15–17, 19, 22, 39, and 40 under 35 U.S.C. § 103(a) as being unpatentable over Seguin and Lucas is reversed.

The Examiner’s decision to reject claims 3, 15–17, 19, 22, 39, and 40 under 35 U.S.C. § 103(a) as being unpatentable over Seguin and Ashton is affirmed.

We enter a new ground of rejection of claim 31 under 35 U.S.C. § 102(b) as being anticipated by Bursaux.

### FINALITY OF DECISION

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
- (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

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-IN-PART; 37 C.F.R. § 41.50(B)