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Egbert Law Offices, PLLC 1001 Texas Ave., Suite 1250 Houston, TX 77002			TOLEDO-DURAN, EDWIN J	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARIO R. LUGO

Appeal 2018-000383
Application 13/160,032
Technology Center 3600

Before ROBERT L. KINDER, KENNETH G. SCHOPFER, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner’s decision rejecting claims 1–4, 6–16, and 18–20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies “[t]he Assignee, TRENDSETTER ENGINEERING, INC.” as the real party in interest. Appeal Br. 5.

ILLUSTRATIVE CLAIM

1. A diverter system for a subsea well comprising:

a blowout preventer having an interior passageway with an inlet at a bottom thereof and an outlet at a top thereof, said interior passageway passing hydrocarbons therethrough; and

a diverter affixed to said outlet of said blowout preventer, said diverter having a flow passageway extending therethrough and communicating with said interior passageway of said blowout preventer, said flow passageway being a pipe that extends vertically between said blowout preventer and a location above said diverter, said flow passageway being axially aligned with said interior passageway of said blowout preventer, said flow passageway of said diverter receiving a flow of the hydrocarbons from said interior passageway of said blowout preventer, said diverter having a first valve in said flow passageway so as to change a flow rate of the hydrocarbons flowing through said flow passageway, said diverter having at least one channel in communication with said flow passageway, the channel having a second valve thereon, said second valve movable between an open position and a closed position, said open position allowing the hydrocarbons from said flow passageway to pass outwardly of said diverter through the channel, said closed position of said second valve blocking the hydrocarbons from passing through the channel; and

at least one flow line connected to said flow passageway, said at least one flow line having a third valve thereon, said third valve movable between an open position and a closed position, said open position of said third valve passing a chemical into the hydrocarbons within said flow passageway, the chemical selected from the group consisting of methane hydrates, glycol and dispersants, said closed position of said valve blocking the passing of the chemical into said flow passageway.

REFERENCES

Name	Reference	Date
Roche	US 4,546,828	Oct. 15, 1985
Bourgoyne et al. ("Bourgoyne")	US 6,470,975 B1	Oct. 29, 2002
Donald ("Donald '941")	US 6,823,941 B2	Nov. 30, 2004
Donald et al. ("Donald '067")	US 8,066,067 B2	Nov. 29, 2011
Adams	US 2012/0055573 A1	Mar. 8, 2012
Cargol, Jr. et al. ("Cargol")	US 2012/0125623 A1	May 24, 2012

REJECTIONS

- I. Claims 1–4, 7, 10, 11, 13, 14, and 20 are rejected under 35 U.S.C. § 103(a) as unpatentable over Cargol and Roche.
- II. Claims 6, 7, 12, 15, and 16 are rejected under 35 U.S.C. § 103(a) as unpatentable over Cargol, Roche, and Donald '067.
- III. Claim 8 is rejected under 35 U.S.C. § 103(a) as unpatentable over Cargol, Roche, and Bourgoyne.
- IV. Claims 9 and 19 is rejected under 35 U.S.C. § 103(a) as unpatentable over Cargol, Roche, and Donald '941.
- V. Claim 18 is rejected under 35 U.S.C. § 103(a) as unpatentable over Cargol, Roche, and Adams.

FINDINGS OF FACT

The findings of fact relied upon, which are supported by a preponderance of the evidence, appear in the following Analysis.

ANALYSIS

The Appellant argues independent claims 1, 10, and 14 as a group. Appeal Br. 20. No claim is argued separately. Claim 1 is selected for analysis herein. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Appellant contends that the cited Cargol and Roche references lack various claim limitations. Appeal Br. 20–25. The Examiner addresses each of the points raised by the Appellant. *See* Answer 11–16.

As to the Appellant’s position that Cargol lacks the claimed “flow passageway” and “pipe” (Appeal Br. 21–22, 24–25), the Examiner explains that Cargol’s housing and chimney together provide such features (*see* Answer 11–13, 15–16; *see also* Final Action 4).

Relatedly, the Appellant argues that Cargol fails to teach the recited “channel” and “flow line” connected to the “flow passageway,” because the Appellant does not regard Cargol as teaching the “flow passageway.” *See* Appeal Br. 21–22. The Examiner’s determination that Cargol’s housing and chimney together teaching the “flow passageway” resolves this issue, as well. *See* Answer 12–13.

Although the Appellant argues that Roche lacks the claimed “flow passageway” is not in “a location above said diverter” (Appeal Br. 21–22, 24), the Examiner points out that Cargol (not Roche) is relied upon for this claimed feature. Answer 15.

The Appellant concedes that Roche teaches a “valve,” but contends that Roche’s “valve” is not in the “diverter,” per claim 1. *See* Appeal Br. 22–24. Yet, the Examiner explains that elements 20 (“blowout preventer”) and 30 (“diverter spool”) of Roche (*see* Roche col. 6, ll. 19–20) are together regarded as the claimed “*diverter*,” such that Roche satisfies this limitation. Answer 14.

Claim 10 is the only independent claim reciting a “ram.” The Specification states: “the valve can includes a ram that extends in transverse relationship to the flow passageway. The ram can be actuatable so as to

change the flow rate and, ultimate, to block the flow of fluid through the flow passageway.” Spec. ¶ 25. The Appellant argues that Cargol lacks a “ram” valve (notwithstanding that Roche, not Cargol, is cited as teaching the “valve,” as noted above). *See* Appeal Br. 21. Yet, the Examiner states that Roche’s valve is of a “ram” type. Answer 12 (citing Roche col. 8, ll. 11–15, Figs. 1, 2 (element 22)). Indeed, Roche discloses the use of a piston to drive element 22 (a “packing unit”) transversely, within a flowpath, so as to obstruct fluid flow. *See* Roche col. 7, ll. 62–65 (“Providing a source of pressurized hydraulic fluid beneath the piston 24 causes it to move upwardly operably directing the annular packing unit 22 radially inwardly until it completely closes off the vertical flow path 12.”)

The Appellant’s arguments, discussed above, do not persuade us that the cited prior art references lack any of the claim limitations identified. Yet, the obviousness analysis also considers the role of any objective factors (often called “secondary” factors or considerations) in reaching a conclusion. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). In this instance, the Appellant argues that such factors (specifically, commercial success, industry praise, and long-felt need) require a conclusion that the claims are not obviousness. Appeal Br. 25 (citing Lugo Decl. of Feb. 18, 2014). However, no such evidence may be sufficient, unless a nexus is shown to exist, whereby the asserted benefits would be associated with the subject matter of the claims. *See In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996). In the present case, notwithstanding any assessment of the sufficiency of the evidence provided, the Appellant does not adequately establish that the cited Lugo Declaration relates to subject matter presently claimed. *See* Answer 16. The Appellant has not documented a relationship

between the products discussed in the Lugo Declaration and the claims in this Appeal. For instance, the claims had been amended twice (September 24, 2014 and June 29, 2015) after the Lugo Declaration was signed (February 18, 2014). Appeal Br. 16. The Appellant has not shown that the statements in the earlier Lugo Declaration relate to these subsequently amended claims.

In view of the foregoing analysis, the Appellant does not persuade us of error in the rejection of claim 1, such that we sustain the rejections of claims 1–4, 6–16, and 18–20 under 35 U.S.C. § 103(a).

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–4, 7, 10, 11, 13, 14, 20	103(a)	Cargol, Roche	1–4, 7, 10, 11, 13, 14, 20	
6, 7, 12, 15, 16	103(a)	Cargol, Roche, Donald '067	6, 7, 12, 15, 16	
8	103(a)	Cargol, Roche, Bourgoyne	8	
9, 19	103(a)	Cargol, Roche, Donald '941	9, 19	
18	103(a)	Cargol, Roche, Adams	18	
Overall Outcome			1–4, 6–16, 18–20	

Appeal 2018-000383
Application 13/160,032

TIME PERIOD FOR RESPONSE

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

AFFIRMED