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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* JEAN BRAUD, JEAN-PIERRE BENOIT, CECILE MELIS, and  
CHRISTIAN BAUDUIN

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Appeal 2018-006450  
Application 12/993,642  
Technology Center 3600

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Before MICHAEL C. ASTORINO, PHILIP J. HOFFMANN, and  
TARA L. HUTCHINGS, *Administrative Patent Judges*.

ASTORINO, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the  
Examiner's decision to reject claims 1–19. We have jurisdiction under  
35 U.S.C. § 6(b).

We AFFIRM IN PART.

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<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in  
37 C.F.R. § 1.42. The Appellant identifies the real party in interest as “the  
assignee, Single Buoy Moorings Inc., of Marly, Switzerland.” Appeal Br. 1.

STATEMENT OF THE CASE

*Claimed Subject Matter*

Claims 1, 9, and 14 are the independent claims on appeal. Claim 14, reproduced below, is illustrative of the claimed subject matter.

14. A mooring buoy having a body defining a central passageway (44), a cable (17) that extends through the passageway (44) to a weight (16) that is suspended from the cable (17), the mooring buoy carrying mooring lines (10) that are connected to a sea bed (19), the mooring buoy (11) further carrying at least twenty risers (12), the buoy being movable relative to the cable (17) in a length direction of the cable, wherein the weight (16) is located on the cable at or below the buoy, a stopper (21) being provided on the cable for engaging with the buoy and for blocking relative movement of the buoy and the cable, the stopper being fixed to the cable near an upper or a lower end of the buoy, wherein the relative weights and buoyancies of the cable (17), weight (16), the body of buoy (11), the mooring lines (10) and risers (12) are such that the stopper (21) engages with the body of buoy (11) and exerts a force on the buoy in a downward direction when no lifting force is exerted on the cable (17), whereas the buoy (11) moves upwardly via its own buoyancy when the cable (17) and weight (16) are lifted by a lifting device of a vessel.

Appeal Br. 11–12, Claims App.

*Rejections<sup>2</sup>*

Claims 1–8 and 11–13 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.<sup>3</sup>

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<sup>2</sup> The Examiner withdraws rejections under 35 U.S.C. § 112, first paragraph, and second paragraph. Ans. 3–4.

<sup>3</sup> The Examiner rejects claims 1–19 under 35 U.S.C. § 112 and determines that “[c]laim 1 is directed towards [n]ew [m]atter.” Final Act. 2; *see* Ans. 4.

Claims 9, 10, and 14–19 are rejected on the ground of nonstatutory double patenting as unpatentable over claims 1–18 of Braud et al. (US 8,397,655 B2, iss. Mar. 19, 2013) (hereinafter “’655 Patent”) in view of Boatman et al. (US 5,823,131, iss. Oct. 20, 1998) (hereinafter “Boatman”).

Claims 9, 10, 14, and 15 are rejected under 35 U.S.C. § 103(a) as unpatentable over Børseth (US 5,651,708, iss. July 29, 1997) in view of Boatman.

Claim 19 is rejected under 35 U.S.C. § 103(a) as unpatentable over Børseth in view of Boatman and Isnard et al. (US 5,941,746, iss. Aug. 24, 1999) (hereinafter “Isnard”).

## ANALYSIS

### *Written Description*

The Examiner rejects claim 1 as failing to comply with the written description requirement. *See* Final Act. 2. The Examiner determines that the Specification fails to disclose, and therefore support, “the lifting device . . . having a capacity insufficient to lift the mooring buoy and its attached mooring lines.” *See id.*; Ans. 4–5 (citing Spec. 11:11–14, 12:23–25). The

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The Appellant argues that specific passages in the Specification “provide ample written description support for the relationship recited by the concluding lines of claim 1.” Reply Br. 2. Accordingly, the Appellant correctly understands the basis for the rejection is a failure to comply with the written description requirement. Further, we note that the Examiner maintains the rejection of claims 9, 10, and 14–19 under this ground (Ans. 4), which appears to be a minor oversight. As the Appellant correctly points out, the rejection does not apply to claims 9, 10, and 14–19 because these claims do not depend from claim 1 or contain the language in question. Appeal Br. 3; Reply Br. 1.

Appellant correctly understands this rejection as concerning claim 1's recitation that "the lifting device is of a capacity sufficient to lift the weight (16) and cable (17) but insufficient to lift the mooring buoy (11) with its attached mooring lines (10) and risers (12)." Appeal Br. 2.

The Appellant cites the Specification at page 2, lines 5–8, page 4, lines 26–28, page 8, lines 8–11 and 15–17, page 15, lines 28–33, and page 16, lines 18–22 and argues that when the passages are considered together, the Specification provides ample written description support for the disputed recitation of claim 1. *See id.* at 2–3; Reply Br. 1–2. The Appellant submits that the Specification "teaches that conventional winches do not have sufficient capacity to *lift large buoys with large connected weights*, yet the mooring system of the invention allows just such a buoy to be connected to a vessel using just such a winch." Appeal Br. 3 (italics added). The Appellant's argument is not persuasive of Examiner error.

Of the portions of the Specification cited by the Appellant, the portion at page 2, lines 5–8, stands out among the others. This portion of the Specification, which is part of the Background of the Invention section, describes, "[a]lso hook-up of both the riser buoy and the weight together is only possible for relatively small buoys and weights and not for *large buoys with large connected weights*, as this would require a winch capacity that is *larger than the capacity of presently available winches*." Spec. 2:5–8 (italics added). This portion of the Specification instructs one of ordinary skill in the art that at the time the present application was filed winches lacked the capacity to hook-up large buoys with large connected weights. Claim 1, however, is directed to a "lifting device," which is not necessarily a winch. The difference in terminology is noteworthy because the

Specification does not discuss the lifting capacity of the “lifting device.” Also, we note that claim 1 does not necessarily require that the “mooring buoy” is “large.” For the purposes of this appeal only, even if we were to assume that the claimed “mooring buoy” was “large,” claim 1 only requires the “mooring buoy” be attached to “weights,” and not “large” weights. In view of the foregoing, we determine that the differences in terminology between claim 1 and the Specification is significant. *See* Ans. 4 (the Examiner identifies relative terms in the Specification, such as “large buoys,” “large connected weights,” “modest size winches,” etc., being distinct from the invention as currently claimed).

Additionally, we agree with the Examiner that claim 1 recites a negative limitation (Ans. 4), i.e., “the lifting device is of a capacity . . . insufficient to lift the mooring buoy (11) with its attached mooring lines (10) and risers (12).” Here, the claim focuses on the lifting device’s lack of capacity to lift the mooring buoy 11 with its attached mooring lines 10 and risers 12. The focus of the Specification’s disclosure is primarily on a mooring buoy that does not need to be lifted by a winch. *See* Final Act. 2. A lifting device that does not need to lift mooring buoy 11, with its attached mooring lines 10 and risers 12, is distinct from a lifting device that lacks the capacity to do so. *See id.*

As for the remaining portions of the Specification cited by the Appellant, for similar reasons as those discussed above, we are not persuaded that the Specification supports the negative claim limitation of claim 1. Accordingly, we determine that the Specification fails to convey with reasonable clarity to those skilled in the art that, as of the filing date

sought, applicant was in possession of the invention as now claimed. *See, e.g., Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991).

Thus, we sustain the Examiner’s rejection of independent claim 1 and claims 2–8 and 11–13, which depend therefrom.

*Nonstatutory Double Patenting, ’655 Patent in view of Boatman*

Independent claim 14 recites, “buoy (11) moves upwardly via its own buoyancy when the cable (17) and weight (16) are lifted by a lifting device of a vessel.” Appeal Br. 12, Claims App. Independent claim 9 includes a similar recitation. *Id.* at 10–11.

The Examiner finds ’655 Patent fails to teach, but Boatman teaches, the foregoing recitation of claim 14, and the similar recitation of independent claim 9. *See* Final Act. 5 (citing Boatman Figs. 6, 7). The Appellant disputes this finding primarily on the basis that Boatman describes, “the buoy 36 moves upwardly only after it is contacted by the weight 58.” Appeal Br. 6 (citing Boatman col. 4, ll. 43–46).

The Examiner supports the finding that Boatman discloses the disputed recitations of claims 9 and 14 by pointing to Figures 6 and 7 and deducing that Boatman’s buoy “ha[s] sufficient buoyancy to rise on its own as the weight **58** is lifted by the winch.” Final Act. 5. The Examiner finds: Figure 7 shows weight 58 resting on sea bed/floor 14 with buoy 36 suspended above weight 58 due to its buoyancy, and prevented from rising further due to stopper 64; and Figure 6 shows weight 58 and anchor chain 44 being lowered while stopper 64 is in contact with the upper surface of buoy 36. *See id.*; *see also* Boatman col. 3, ll. 10–21.

Boatman describes what occurs during docking, “[f]or docking riser buoy 36, retrieval line 60 is pulled upwardly over pulley 61 by winch 62 along with weight 58 and anchor chain 44 until weight 58 contacts buoy 36. *Then, buoy 36 and weight 58 move upwardly together.*” Boatman col. 4, ll. 43–46 (italics added). As described, the buoy is lifted by the lifting device and is not lifted by its own buoyancy. The Specification, in the Background of the Invention section, supports this notion by describing Boatman’s invention. *See, e.g.,* Spec. 1:17 – 2:5. The Specification states, among other things, “[a]nother aspect of the known riser buoy is that in order to dock this riser buoy, a retrieval line is pulled upwardly via a winch until the weight contacts the buoy.” *Id.* at 1:30–32. However, the Examiner explains that the disclosure in Boatman’s column 4, lines 43–46 is specific to docking, i.e., “the final stage of raising and connecting the buoy within the turret.” Ans. 6–7.

The Specification also describes with regard to Boatman, “[f]urther as the mooring legs are directly connected to the turret, the riser buoy has *only* sufficient buoyancy to support the risers.” Spec. 1:28–30 (emphasis added); *see* Boatman Fig. 7. Here, the Specification does not suggest that buoy 36, which is connected to risers 19, would be able to move upwardly via its own buoyancy when the cable and weight are lifted by a lifting device of a vessel.

As for Boatman’s Figure 6, this figure shows buoy 36 being lowered from turret 20 toward sea bed/floor 14. Boatman col. 3, ll. 10–16. Figure 6 shows how stopper 64 via weight 58 applies a downward force on buoy 36 when winch 62 lowers weight 58. Figure 6 does not necessarily show the effect of buoy 36’s buoyancy on the buoy relative to weight 58 and anchor chain 44 when weight 58 and anchor chain 44 are being lifted by winch 62

but before weight 58 contacts buoy 36 during docking. *See id.* at Fig. 3. The Examiner’s contrary position appears to be based on speculation. *See, e.g.,* Ans. 6–7.

Further, the Examiner appears to rely on the Appellant’s disclosure of their invention to support the finding that Boatman teaches the disputed limitation of claims 9 and 14. *See id.* at 7. However, it is speculative to assume that because the Appellant’s invention works in a particular manner that Boatman’s device works in that same manner.

We determine that the Examiner fails to adequately support the finding that Boatman teaches “buoy (11) moves upwardly via its own buoyancy when the cable (17) and weight (16) are lifted by a lifting device of a vessel,” as recited in claim 14, and the similar recitation of independent claim 9.

Thus, we do not sustain the Examiner’s rejection of independent claim 9 and claim 10, which depend therefrom, and independent claim 14 and claims 15–19, which depend therefrom.

#### *Børseth in view of Boatman*

The Examiner’s rejection of independent claims 9 and 14 based on Børseth in view of Boatman includes the same inadequately supported finding based on Boatman as discussed above. Final Act. 6–7. The Examiner fails to rely on Børseth in any manner that would remedy the deficiency. Thus, we do not sustain the Examiner’s rejection of claims 9, 10, 14, and 15.

*Børseth in view of Boatman and Isnard*

The Examiner's rejection of claim 19, which depends from claim 14, based on *Børseth in view of Boatman and Isnard*, relies on the same inadequately-supported finding based on *Boatman* as discussed above. *See* Final Act. 9. The Examiner fails to rely on *Isnard* in any manner that would remedy the deficiency. Thus, we do not sustain the Examiner's rejection of claim 19.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-8, 11-13	112, first paragraph	Written Description	1-8, 11-13	
9, 10, 14-19		'655 Patent, <i>Boatman</i>		9, 10, 14-19
9, 10, 14, 15	103(a)	<i>Børseth</i> , <i>Boatman</i>		9, 10, 14, 15
19	103(a)	<i>Børseth</i> , <i>Boatman</i> , <i>Isnard</i>		19
<b>Overall Outcome</b>			1-8, 11-13	9, 10, 14-19

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 IN PART