

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTONIO CARLOS FERNANDES,
MAURICIO DA JUSTA ALBANO DE ARATANHA
and
SYLVIO HENRIQUE SA CORREA DA SILVA

Appeal No. 2001-1702
Application 09/186,429

HEARD: OCTOBER 23, 2001

Before FRANKFORT, STAAB and McQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1, 3, 4, 6 through 10 and 12 through 19 as amended subsequent to the final rejection in papers filed on June 29, 2000 (Paper No. 8) and September 21, 2000 (Paper No. 12). Claims 1, 3, 4, 6 through 10 and 12 through 19 are all

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of the claims remaining in this application. Claims 2, 5 and 11 have been canceled.

Appellants' invention relates to a vessel used in floating hydrocarbon fuel production systems and, more particularly, to a vessel having a turret mechanism which enables the vessel to rotate about a vertical axis relative to risers linked to underwater oil wells and also to the ship's turret mechanism. The essence of appellants' invention addresses a passive stabilizer body projecting from a lower part of the hull of the vessel for increasing the vessel's directional stability in relation to environmental conditions when the vessel is tethered by the turret mechanism and risers to the subsea wells. Independent claims 1, 7 and 13 are representative of the subject matter before us on appeal and a copy of those claims may be found in the Appendix to appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Pangalila	3,757,723	Sept. 11, 1973
Carlsen	4,266,496	May 12, 1981
Berne	4,273,063	June 16, 1981
Borseth	5,701,835	Dec. 30, 1997

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Claims 1, 4, 7, 8, 10, 13, 14 and 16 through 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Borseth in view of Berne and Carlsen.

Claims 3, 6, 9, 12 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Borseth in view of Berne and Carlsen as applied above, and further in view of Pangalila.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we make reference to the final rejection (Paper No. 7, mailed March 17, 2000) and the examiner's answer (Paper No. 15, mailed November 6, 2000) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 13, filed September 21, 2000) and reply brief (Paper No. 16, filed January 3, 2000) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to

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the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

We turn first to the examiner's rejection of claims 1, 4, 7, 8, 10, 13, 14 and 16 through 19 under 35 U.S.C. § 103(a) as being unpatentable over Borseth in view of Berne and Carlsen. Although we might agree with the examiner that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to provide the vessel of Borseth with stabilizers like those of Berne so as to further enhance the vessel's roll stability in heavy seas when underway or when on site and tethered by its turret mechanism (500) to risers from subsea wells, we must agree with appellants' assessment in the brief and reply brief with regard to the examiner's further attempted use of Carlsen to somehow modify the resulting vessel and stabilizer arrangement arrived at by combining Borseth and Berne. Like appellants, we see the examiner as merely picking and choosing from the prior art only to the extent it might support his determination of obviousness, while ignoring aspects of the prior art that provide a full appreciation of what the prior art actually would have suggested to one of ordinary skill

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in the art. In this regard, we share appellants' position that the examiner has engaged in the use of impermissible hindsight in attempting to modify the stabilizer arrangement resulting from the combination of Borseth and Berne by relying on the entirely different stabilizer system of Carlsen. The sheer size, positioning, and manner of operation of the horizontal stabilizers in Carlsen belie the examiner's assertion (answer, pages 5-6) that it would have been obvious to one of ordinary skill in the art following the teachings of Carlsen to provide end plates or horizontal stabilizers on the fins/stabilizers of Borseth as modified by Berne.

In light of the foregoing, we must refuse to sustain the examiner's rejection of claims 1, 4, 7, 8, 10, 13, 14 and 16 through 19 under 35 U.S.C. § 103(a) as being unpatentable over Borseth in view of Berne and Carlsen.

As for the examiner's rejection of claims 3, 6, 9, 12 and 15 under § 103(a) as being unpatentable over Borseth in view of Berne, Carlsen and Pangalila, we have reviewed the Pangalila patent, but find ourselves in agreement with appellants' position as set forth on pages 9 and 10 of the brief and in the reply

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brief (page 4). Accordingly, we will not sustain the examiner's rejection of dependent claims 3, 6, 9, 12 and 15 under 35 U.S.C. § 103(a).

As should be apparent from the foregoing, the decision of the examiner rejecting claims 1, 3, 4, 6 through 10 and 12 through 19 of the present application is, accordingly, reversed.

In addition to the foregoing, we find it necessary to REMAND this application back to the examiner for consideration of the following issue:

During any further prosecution of this application, we urge the examiner to consider the propriety of a rejection of claims 1, 4, 7, 8, 13, 14, 16, 17 and 19 under 35 U.S.C. § 103(a) based on the combined teachings of a vessel like that described in appellants' discussion of the prior art (specification, pages 1-3 and Figure 1) and the stabilizer system as set forth in Carlsen. Carlsen notes (col. 1, lines 11-19) that the stabilizer system therein was "developed especially for use with surface vessels used for work in the offshore sector" and more specifically, for ships used in the investigation and production

of oil and other mineral resources at and beneath the sea bed while operating under varying weather loads. Carlsen also mentions that other operations at sea require a stable platform, or platform having predictable and controllable movement characteristics (e.g., like the prior art oil production operations discussed by appellants on pages 1-3 of their specification). We also direct attention to the broad teachings found in column 1, lines 36-59, of Carlsen and the fact that the reference recognizes that the area and longitudinal positioning of the stabilizer bodies must be selected in accordance with the operations that the vessel is to perform.

While appellants have urged (brief, page 9) that the support structures (S) or columns (4) and (8) of the horizontal stabilizers seen in Carlsen do not constitute vertical stabilizers or, more appropriately, vertical stabilizer bodies, we are of the view that one of ordinary skill in the art would have readily understood that those support structures are in fact passive stabilizer bodies, even though the reference does not expressly describe them as such, because they will provide some passive stabilizing force to the vessel tending to dampen both

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roll and yaw forces imposed on the vessel by wave action and wind.

This application, by virtue of its "special" status, requires an immediate action, MPEP § 708.01(d).

REVERSED AND REMANDED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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LAWRENCE J. STAAB)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

CEF:psb

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Michelle N. Lester, Esq.
Nixon & Vanderhye, P.C.
1100 North Glebe Road
8th Floor
Arlington, VA 22201-4714