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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* GARY T. DANE and JON D. SHOEMAKER

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Appeal 2013-006130  
Application 12/828,657<sup>1</sup>  
Technology Center 1700

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Before CHARLES F. WARREN, MICHAEL P. COLAIANNI, and  
SHEILA F. McSHANE, *Administrative Patent Judges*.

McSHANE, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellants seek our review under 35 U.S.C. § 134(a) of the decision of the Examiner to reject claims 1–13, 20, and 21. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

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<sup>1</sup> According to Appellants, the real party in interest is Symmetry Medical Manufacturing, Inc. (Appeal Brief filed December 21, 2012, hereafter “App. Br.” 5).

## BACKGROUND

The invention relates to a tray formed from a sheet of metal, with pockets formed in the tray, with a cover (Abstract; Specification (hereafter “Spec.”) 3:4–6). The tray may be used for sterilizing medical instruments (*id.* at 3:14–15).

Claim 1 is reproduced from page 30 of the Appeal Brief (Claims App’x) as follows, with emphasis added to relevant claim limitations:<sup>2</sup>

1. A sterilization apparatus, comprising:
  - a metal tray formed from *a unitary sheet of metal*;
  - a plurality of pockets formed in the metal tray, wherein the *plurality of pockets is formed from manipulating the unitary sheet of metal*; and
  - a cover formed over the metal tray.*

In the Final Action, the Examiner rejected claims 8 and 9 under 35 U.S.C. § 112, second paragraph; claims 20 and 21 under 35 U.S.C. §102(b) as anticipated by Fisher;<sup>3</sup> and claims 1–13 and 20 under 35 U.S.C. § 103(a) as obvious under Hurson,<sup>4</sup> either alone or with Gray.<sup>5</sup> In the Answer, the Examiner withdrew the 35 U.S.C. § 112, second paragraph rejections of claims 8 and 9, and the 35 U.S.C. § 103(a) rejection of claims 1–13, 20, and 21<sup>6</sup> based upon Hurson alone, but maintained the rejection based upon the combination of Hurson and Gray, and also

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<sup>2</sup> Other claims, or relevant portions of the claims, necessary for an understanding of certain issues are reproduced in the “DISCUSSION” section below.

<sup>3</sup> US Patent 2,674,536, issued April 6, 1954.

<sup>4</sup> US Patent 5,525,314, issued June 11, 1996.

<sup>5</sup> US Patent 3,494,723, issued February 10, 1970.

<sup>6</sup> Although the Final Rejection noted the rejection of claim 21 under 35 U.S.C. § 103(a) for “reasons of the record,” Appellants did not address this claim on the obviousness rejection (Final Act. 7). Given its commonality with another issue addressed by the Appellants, we assume that this was an inadvertent oversight, so we will address this claim on the common issue.

entered new grounds of rejection for claims 1–3, 5, 6, 8–11, and 13 under 35 U.S.C. §102(b) as anticipated by Fisher (Final Action mailed November 30, 2012, hereafter “Final Act.,” 2–7; Examiner’s Answer mailed February 14, 2013, hereinafter “Ans.,” 3–20). Appellants opted to proceed under 37 C.F.R § 41.41, addressing all new grounds of rejection in the Reply Brief and Response (Reply Brief filed April 5, 2013, hereafter “Reply Br.” and Response to New Grounds of Rejection Within Examiner’s Answer, hereafter “Resp.”).

The rejections, therefore, that are the subject of this Appeal are the 35 U.S.C. § 102(b) rejections of claims 1–3, 5, 6, 8–11, 13, 20, and 21 as anticipated by Fisher, and the rejections of claims 1–13, 20, and 21 under 35 U.S.C. § 103(a) as obvious over Hurson and Gray. *See* Rep. Br. at 2–3.

#### DISCUSSION

We address the 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) rejections as follows:

#### ***35 U.S.C. § 102(b)***

Claims 1, 8, 9, 20, and 21. As to claims 1, 8, 9, 20, and 21, Appellants contended that Fisher does not teach the elements of the claims, respectively, where pockets are formed from “manipulating” the sheet of metal per claims 1 and 20, or “thermoforming” and “hydroforming” the sheet of metal to make “thermoformed” or “hydroformed” pockets per claims 8, 9, and 21 (App. Br. 17–19; Resp. 10–11). The Examiner found that “Fischer is structurally indistinguishable from the instant claims and any remarks directed to the method of making the pockets are not commensurate in scope with the pending apparatus claims (e.g. the instant claims are directed to the apparatus and not the method of making the apparatus),” and further stated that the method of making the apparatus is “of no patentable moment” to the pending apparatus claims (Ans. 10–11).

Under a broadest reasonable interpretation of the term “manipulation” in manufacture, absent any specific teachings in a specification, its meaning would extend to any manner of manufacture in the view of one of ordinary skill in the art. Here, we note that Appellants have not provided any details on the method of manipulation for the claimed apparatus in the Specification. Absent any detailed disclosures, the term is therefore of no moment, thus supporting the Examiner’s view that the prior art is indistinguishable. Additionally, once a product appearing to be substantially identical is found and a 35 U.S.C. § 102 rejection is made, the burden shifts to the applicant to show an unobvious difference. *See In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990) (“[W]hen the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.”). Here, the Examiner found the structure of Fisher and the claimed apparatus are indistinguishable, which stands unrebutted, therefore, we sustain the rejections of claims 1, 8, 9, 20, and 21 under 35 U.S.C. § 102(b).

Claims 3 and 5. Claim 3 depends from claim 1, which further claims a base removably fastened to a cover. Claim 5 depends from claim 3, further claiming properties of the base. The Appellants contended that Fisher does not disclose or identify a base (Resp. 11–12). The Examiner read the base onto the “tray” disclosed in Fisher (Ans. 8). We find that the terms “tray” and “base” are two separate and distinct elements in the claims, with the distinction maintained in the Specification, therefore the terms have different meanings. *See CAE Screenplates Inc. v. Heinrich Fiedler GmbH & Co. KG*, 224 F.3d 1308, 1317 (Fed. Cir. 2000) (“In the absence of any evidence to the contrary, we must presume that the use of these different terms in the claims connotes different meanings.”). Specifically, Appellants’ Figure 4 is described as having a base 120 into which a tray 112 nests

(Spec. 10). Mapping the same prior art element onto these separate terms is impermissible, therefore we reverse the Examiner's rejections of claims 3 and 5 under 35 U.S.C. § 102(b).

Claim 11. Claim 11, depending from claim 1, includes the limitation "wherein the plurality of pockets formed in the metal tray are sized to provide a friction fit to a medical instrument." Appellants argued that Fisher fails to teach that the compartments within "the tray are sized to 'friction fit' any structure, let alone a medical instrument." (Resp. 12). Appellants further contended that the Examiner ignored the required element of the "friction fit of a medical instrument." (*Id.* at 11–12).

The Examiner found that there was no positive structure claimed to accomplish the claimed "frictional fit to a medical instrument," so the interpretation of the limitation was taken to be a pocket in the tray that is capable of supporting a medical instrument. (Ans. 9). The Examiner therefore found that the compartments taught by Fisher read on this limitation (*id.*).

We agree with the Examiner's findings and conclusion. We note that no particular size of the medical instrument is claimed, so there is no specific limitation set for the size of the medical instrument to be frictionally held by the cavity. In this light, we find that Examiner has established that the pocket of Fisher is capable of holding (and friction fitting) a suitably sized medical instrument, which is all the claim requires.

Claim 2, 6, and 10. Appellants do not present any separate arguments disputing the anticipation rejections of dependent claims 2, 6, and 10, relying only upon the issues presented for claim 1 that they depend from. Any arguments not included in the Appeal Brief are deemed waived, and we therefore affirm the rejection of these claims. 37 C.F.R. § 41.37(c)(1)(iv) (2012).

**35 U.S.C. § 103(a)**

Claims 1 and 21. Appellants disputed the obviousness rejection of claim 1 on the basis that neither Hurson nor Gray discloses the element of “a metal tray formed from a unitary sheet of metal.” (App. Br. 23). Claim 21 includes a similar term. More specifically, Appellants contended that there is no teaching of a unitary sheet in either reference and Examiner’s definition of “unitary sheet” as “at least one sheet” is contrary to the well-understood meaning of term (*id.* at 23–24). Appellants further contended that Hurson has perpendicular corners and will not “provide the benefits” of the invention (with rounded corners so no bacterial accumulation) (*id.* at 24–25).

In response, the Examiner maintained that the term “unitary sheet” is sufficiently broad to properly read on the complete structure of Hurson that is a singular, unitary structure (Ans. 12).

Although the Specification does not provide a definition of the term “unitary sheet,” its use therein generally refers to the metal sheet that the tray is manufactured from. Further, as used in the context of the claim, we find that the term is intended to refer to a single sheet of metal that the tray is manufactured from, not a single tray that is formed (post-manufacture) as the Examiner suggests. The Examiner has not directed us to where Hurson teaches that the tray is formed from a single, unitary sheet. We further determine that the conclusory statement as to the basis of obviousness lacks evidentiary support for the disclosure of a unitary sheet, therefore we reverse the rejections of claims 1 and 21 under 35 U.S.C. § 103(a). With this, the obviousness rejections of claims 2–13 depending from claim 1 would likewise be reversed because the prior art does not teach or suggest all their claim limitations. *See In re Royka*, 490 F.2d 981, 985 (CCPA 1974) (To

establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art).

Claim 20. Independent claim 20 includes the limitation “a cover formed over the metal tray; and a fastening device connected between the metal tray and the cover, wherein the fastening device removably secures the cover directly to the metal tray.” Appellants argued that Hurson and Gray do not disclose “a fastening device connected between the metal tray and the cover.” (App. Br. 29). More specifically, Appellants contended that although claim 20 requires that the cover be removably fastened directly to the metal tray, the relied-upon Hurson reference only discloses a container where the lid is fastened to a base (*id.* at 26).

In response, the Examiner referred to the teachings of Hurson concerning the lid contacting and covering the tray (Ans. 12). The Examiner conclusorily determined that Hurson’s tray 16 could be made integral with the bottom 14 so that bottom 14 becomes part of the tray 16 as an obvious design choice (Ans. 6). Presumably, the Examiner finds that once the tray 16 and bottom are made integral the fastening device would removably secure the cover directly to the metal tray. *Id.* The Examiner’s analysis lacks the requisite basis for making the proposed modification of Hurson. The Examiner has not established where Hurson would have taught or suggested a fastening device between tray 16 and cover 12 so that the fastening device removably secures the cover directly to the metal tray. Therefore we cannot sustain the rejection of this claim as obvious.

#### SUMMARY

The rejection of claims 1, 2, 6, 8–11, 20, and 21 under 35 U.S.C. § 102(b) as anticipated by Fisher is affirmed.



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The rejection of claims 3 and 5 under 35 U.S.C. § 102(b) as anticipated by Fisher is reversed.

The rejection of claims 1–13, 20, and 21 under 35 U.S.C. § 103(b) as obvious under Hurson and Gray is reversed.

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).

AFFIRMED-IN-PART

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