



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/846,132	08/28/2007	Richard M. Lavelle	1013/IUS	9873
68553	7590	11/02/2016	EXAMINER	
TREGO, HINES & LADENHEIM, PLLC 9300 HARRIS CORNERS PARKWAY SUITE 210 CHARLOTTE, NC 28269-3797			POON, ROBERT	
			ART UNIT	PAPER NUMBER
			3788	
			NOTIFICATION DATE	DELIVERY MODE
			11/02/2016	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JMH@THLIP.COM
PATENTS@THLIP.COM
BCT@THLIP.COM

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RICHARD M. LAVELLE

Appeal 2015-001905
Application 11/846,132
Technology Center 3700

Before JOHN C. KERINS, STEFAN STAICOVICI, and LEE L. STEPINA,
Administrative Patent Judges.

KERINS, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Richard M. Lavelle (Appellant) appeals under 35 U.S.C. § 134(a) from the Examiner's final decision rejecting claims 1, 3, 8, 9, 14, 15, 19, and 21–24.¹ We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

We REVERSE.

¹ Claims 2, 4–7, 10–13, 16–18, and 20 are canceled. Br. 5 (filed June 3, 2014).

THE INVENTION

Appellant's invention relates to corner protectors for use with surgical trays. Claims 1, 14, 23, and 24 are independent. Claims 1 and 14 are illustrative of the claimed invention and read as follows:

1. A corner protector, comprising

(a) a base having a front end and an opposed back end, the back end having first and second edges defining a V-shape; and

(b) first and second sides, each of the sides having spaced-apart, parallel top and bottom edges extending between a proximal end and a distal end, the sides being connected at the proximal ends to form a corner;

(c) wherein a first portion of the bottom edge of the first side adjacent the proximal end of the first side is joined to the first edge of the base and a second portion of the bottom edge of the first side extends beyond the base such that the distal end of the first side is free to flex independently from the base;

(d) wherein a first portion of the bottom edge of the second side adjacent the proximal end of the second side is joined to the second edge of the base and a second portion of the bottom edge of the second side extends beyond the base such that the distal end of the second side is free to flex independently from the base;

(e) wherein the top edges define an open area there between free of reinforcement structures to permit a portion of the top edges to move relative to the base.

14. A corner protector adapted to receive a corner of a surgical tray therein, such that the corner protector provides a barrier between a sterile wrap and the corner to prevent tearing of the wrap, the corner protector comprising:

(a) a base;

(b) first and second sides extending upwardly from a top of the base, each of the sides having a bottom edge, wherein a first portion of each bottom edge is connected to the base and a second portion of each bottom edge extends beyond the base such that a distal end of each side is disposed beyond the base;

(c) wherein proximal ends of the first and second sides are joined to each other so as to define a corner, the first and second sides cooperate with the base to define three mutually perpendicular planes that define an open area configured to receive a corner of a surgical tray having a side wall with a height substantially greater than the first and second sides of the corner protector therein.

THE REJECTIONS

The Examiner has rejected:

(i) claims 1, 3, 8, 9, 21, and 23 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement;

(ii) claims 14, 15, and 19 under 35 U.S.C. § 102(b) as being anticipated by Driscoll (US 5,226,626, issued July 13, 1993);

(iii) claims 1, 3, 9, and 23 under 35 U.S.C. § 103(a) as being unpatentable over Driscoll and Burchell (US 2007/0039848 A1, published Feb. 22, 2007);

(iv) claims 8 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Driscoll, Burchell, and Curnow (WO 2007/019233 A2, published Feb. 15, 2007);

(v) claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Driscoll and Curnow; and

(vi) claim 24 under 35 U.S.C. § 103(a) as being unpatentable over Driscoll and Curnow.

ANALYSIS

Claims 1, 3, 8, 9, 21, and 23--35 U.S.C. § 112, para. 1--Written Description

Independent claim 1 requires, *inter alia*, that “the top edges define an open area there between free of reinforcement structures to permit a portion of the top edges to move relative to the base.” Br. 19 (Claims App.).

Independent claim 23 requires, *inter alia*, that “the top edges define an open area free of protrusions there between for receiving an object such that the object rests upon the base and the first and second sides reside along a side of the object.” *Id.* at 21–22.

The Examiner’s position is that “[t]hese limitations were not previously described in the specification and are thus treated as new matter,” and that “any negative limitation or exclusionary proviso must have basis in the original disclosure.” Final Act. 2.

Appellant asserts that “all claim amendments are supported in Figure 18 and the specification,” because, from Figure 18, “it is clear that there are no reinforcement structures or protrusions in the area defined by the top edges.” Br. 12.

The Examiner responds that “the area pointed out by the appellant to be located between the top edges is clearly not open due to the presence of protrusions (233),” and “thus, examiner fails to see where there is support for the claimed limitation.” Ans. 9.

An application satisfies the written description requirement when the essence of the original disclosure conveys the necessary information—regardless of how it conveys such information, and regardless of whether the disclosure’s words [a]re open to different interpretation. *In re Wright*, 866 F.2d 422, 424–25 (Fed. Cir. 1989) (citation and internal quotation marks omitted). This includes the case where “appellants are merely excising the invention of another, to which they are not entitled, and are not ... claiming ‘new matter.’” *In re Johnson*, 558 F.2d 1008, 1019 (CCPA 1977). Here, the claim language in dispute attempts to distinguish over corner support 15 of Driscoll that includes support top wall 18 connected to top edges of side walls 16 and 17. *See* Driscoll, col. 3, ll. 33–40; Fig. 3. Like corner support 15 of Driscoll, the bottom edges of the recited corner protector are joined to the base, and thus, would be considered as being supported or reinforced by the base. In contrast, the top edges of the recited corner protector lack such reinforcement structures and claims 1 and 23 exclude such reinforcement structures in order to receive a surgical tray in the open area. *See* Spec. Fig. 3.

Although the Examiner contends that Appellant does not define the top edges (*see* Ans. 9), claim 1 requires that the top edges are the part of the sides that are spaced from the bottom edges and are parallel to the bottom edges. As such, the top edges are sufficiently defined, and Appellant’s annotated Figure 18 not only accurately denotes the top edges, but also accurately depicts the area between top edges as free of reinforcement structures. *See* Br. 13. In view of this, we agree with Appellant that one of ordinary skill in the art would understand where the top edges are, that there

are no reinforcement structures in the area defined by the top edges, and that the original disclosure conveys this information.

Similar to claim 1, claim 23 defines the top edges as the part of the sides that are spaced from the bottom edges and are parallel to the bottom edges. Thus, as noted above, Appellant's annotated Figure 18 accurately denotes the top edges and accurately depicts that the top edges define an open area free of protrusions. *See* Br. 13. Moreover, Appellant supports this exclusion because a reason to exclude "is provided, for instance, by properly describing alternative features of the patented invention." *Inphi Corp. v. Netlist*, 805 F.3d at 1356. Here, the Specification discloses that studs (protrusions) may be used so that the corner protector is not flush against the tray in order to create channels for sterilizing agent, and also describes embodiments that do not include protrusions. *See* Spec. para. 44; Figs. 18–24; *cf. Id.* Figs. 3–17. Thus, Appellant has adequately described alternative embodiments with and without protrusions, and therefore, has provided a reason to exclude the protrusions not only from the top edges, but also from the entirety of the sides. In view of this, we agree with Appellant that one of ordinary skill in the art would understand that there are no protrusions in the area defined by the top edges, and that this is supported by the original disclosure.

Accordingly, we do not sustain the rejection of claims 1, 3, 8, 9, 21, and 23 under 35 USC § 112, first paragraph, as failing to meet the written description requirement.

Claims 14, 15, and 19—Anticipation—Driscoll

Claim 14 recites, in part, that “the first and second sides cooperate with the base to define three mutually perpendicular planes that define an open area configured to receive a corner of a surgical tray having a side wall with a height substantially greater than the first and second sides of the corner protector therein.” Br. 20 (Claims App.).

Appellant asserts that “Driscoll not only has the base 19 but also has the fan 20 and top wall 18 opposing the base 19,” and that “[t]he open area that the Examiner refers to is between the base 19 and top wall 18 which prevent a surgical tray having a side wall greater than the side walls 16 and 17 from being received.” *Id.* at 14.

The Examiner responds that because Appellant does not explicitly claim a surgical tray, “Appellant appears to incorrectly assume that 1) a surgical tray must have all equal side wall heights and 2) the corner formed by the substantially greater height side walls must be placed within the open area of the Driscoll protector.” Ans. 10–11. The Examiner takes the position that these assumptions do not apply to claim 14 because “the claim only requires that the protector functions to receive a corner of a surgical tray,” and thus,

the Driscoll protector can function with a surgical tray with the following properties: a surgical tray having different side wall heights, wherein the side walls that are substantially greater than the first and second sides of the Driscoll protector lie outside the protector while the side walls less than the first and second sides are received within the open area of the Driscoll protector.

Id. at 11.

Although we appreciate that the claim does not positively recite the surgical tray, we do not agree with the Examiner that the corner of the tray

having a substantially higher side wall does not need to be able to be placed within the open area of the Driscoll protector. The Examiner's interpretation of claim 14 effectively renders meaningless the limitation "having a side wall with a height substantially greater than the first and second sides of the corner protector." See *Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 93 F.3d 1572, 1578 (Fed. Cir. 1996) (rejecting an interpretation that renders a limitation meaninglessly empty). Consistent with requiring that the side wall of the surgical tray having a height substantially greater than the first and second sides is the portion placed within the open area of the corner protector, the Specification only describes and depicts that corner 23 of a surgical tray 11, having a side wall with a height substantially greater than the first and second sides of the corner protector 10, is within the corner protector, as required by claim 14. See Spec. ¶ 34; Fig. 3. As a result, we agree with Appellant that the fan 20 and top wall 18 opposing the base 19 of Driscoll prevent a surgical tray having a side wall greater than the side walls 16 and 17 from being received therein. See Driscoll, col. 3, ll. 33–46, Figs. 1–4, 9. Therefore, we do not sustain the Examiner's anticipation rejection of claims 14, 15, and 19 based on Driscoll.

Claims 1, 3, 9, and 23--§ 103(a)—Driscoll/Burchell

Claim 1 requires that each of the first and second sides "extends beyond the base such that the distal end of the first side (and the second side) is free to flex independently from the base." Br. 19 (Claims App.). Independent claim 23 similarly recites, in part, that "a distal end of each side is free to flex independently from the base." *Id.* at 21.

The Examiner provides annotated copies of Figures 1–4 of Driscoll, and based on these figures finds that Driscoll discloses “wherein the top edges define an open area (0) therebetween free of reinforcement structures.” Final Act. 5–6. The Examiner relies on Burchell as disclosing “a corner protector made of flexible material” and concludes that it would have been obvious “to make the Driscoll corner protector out of flexible material as suggested by Burchell in order to be capable of being bent to embrace the edge of an object at required positions.” *Id.* at 6–7 (citing Burchell, para. 40; Fig. 11). The Examiner states that “constructing the Driscoll corner protector out of flexible material would have allowed the distal end of the side to flex independently from the base since the sides were already independent from the base and constructing the sides out of flexible material would have allowed them to flex.” *Id.* at 7.

Appellant asserts that in Driscoll, “[t]he entire side (16) is connected to the reinforcing legs (20),” and thus, “the structure of the reinforcing legs (20) would prevent the side (16) from flexing inwardly or outwardly,” and “would resist any movement of the side (16).” Br. 15.

The Examiner responds that “[t]he side wall portion that extends past the base . . . has a distal end (DE) that would flex independent from the base since it is free from connection to the base.” Ans. 12. The Examiner takes the position that it is unclear “how the presence of reinforcing legs 20 would prevent (SP1, SP2) from flexing inwards and outwards of the protector if the protector was to be made of flexible material.” *Id.*

Driscoll discloses corner support 15 having first and second side walls 16, 17 and supporting top and bottom walls 18, 19, with projecting

reinforcing legs 20 contiguous with and extending beyond the top wall 18. Driscoll, col. 3, ll. 33–45; Figs. 1–4. Figures 1 and 2 of Driscoll depict reinforcing legs 20 extending to the distal end of side walls 16, 17. Reinforcing legs 20 by their nature restrict the flexibility of Driscoll's side walls 16, 17. Specifically, a reinforced structure is not free to flex. Although making side walls 16, 17 of Driscoll out of flexible material might impart some flexibility, the existence of the reinforcing legs restricts flexibility so that the side walls are not free to flex in an unrestrained manner. As such, we do not agree with the Examiner that constructing the sides of Driscoll out of flexible material would have made the distal ends free to flex. Accordingly, the rejection of claims 1, 3, 9, and 23 as being unpatentable over Driscoll in view of Burchell is not sustained.

Claims 8 and 21--§ 103(a)--Driscoll/Burchell/Curnow

Claims 8 and 21 depend from claim 1. The Examiner does not rely on Curnow in any manner that remedies the deficiency in the rejection of claim 1 based on Driscoll and Burchell. For the same reasons discussed above, the rejection of claims 8 and 21 as being unpatentable over Driscoll, Burchell, and Curnow is not sustained.

Claim 22--§ 103(a)--Driscoll/Curnow

Claim 22 depends from claim 14. The Examiner does not rely on Curnow in any manner that remedies the deficiency in the rejection of claim 14 based on Driscoll. For the same reasons discussed above, the rejection of claim 22 as being unpatentable over Driscoll and Curnow is not sustained.

Claim 24--§ 103(a)--Driscoll/Curnow

Independent claim 24 recites, in part, that “a second portion of each bottom edge extends beyond the base such that a distal end of each side is free to flex independently from the base.” Br. 22 (Claims Appx.).

As with claim 1, the Examiner points to the annotated copies of Figures 1–4 of Driscoll and based on these figures finds that Driscoll discloses that “a second portion . . . of each bottom edge extends beyond the base.” Final Act. 9. The Examiner relies on Curnow as disclosing “a corner protector (Fig. 1) made of medical grade non-moisture silicone material. *Id.* (citing Curnow, 5, ll. 3–10). The Examiner concludes that “manufacturing the Driscoll protector out of silicone as taught by Curnow would have resulted in the distal end of each side free to flex independently from the base since they extend past the base and (are) manufactured of flexible material.” *Id.* at 9–10.

Appellant reiterates that “Driscoll does not disclose a distal end of each side that is free to flex” and asserts that “Curnow does not cure this defect.” Br. 18.

As discussed above with respect to claim 1, although making side walls 16, 17 of Driscoll out of flexible material might impart some flexibility, the existence of reinforcing legs 20 restricts flexibility so that the side walls are not free to flex. In view of this, the rejection of claim 24 as being unpatentable over Driscoll in view of Curnow is not sustained.

DECISION

The rejection of claims 1, 3, 8, 9, 21, and 23 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is reversed.

The rejection of claims 14, 15, and 19 under 35 U.S.C. § 102(b) as being anticipated by Driscoll is reversed.

The rejection of claims 1, 3, 9, and 23 under 35 U.S.C. § 103(a) as being unpatentable over Driscoll and Burchell is reversed.

The rejection of claims 8 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Driscoll, Burchell, and Curnow is reversed.

The rejection of claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Driscoll and Curnow is reversed.

The rejection of claim 24 under 35 U.S.C. § 103(a) as being unpatentable over Driscoll and Curnow is reversed.

REVERSED