

Commissioner’s Decision # 1275  
Décision du Commissaire # 1275

TOPIC: O  
SUJET: O

Application No.: 2,132,059  
Demande No.: 2,132,059

COMMISSIONER'S DECISION SUMMARY

C.D. 1275      App'n 2,132,059

Obviousness

The Examiner rejected the application on the basis that the claims were obvious in view of a French patent and a United States patent.

The Board found that the applicant was claiming an invention which was not obvious in view of the cited art.

The application was returned to the examiner for further prosecution.

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application 2,132,059 having been rejected under Rule 30(4) of the Patent Rules, the Applicant asked that the Final Action of the Examiner be reviewed. The rejection has consequently been considered by the Patent Appeal Board and by the Commissioner of Patents. The findings of the Board and the ruling of the Commissioner are as follows:

Agent for Applicant

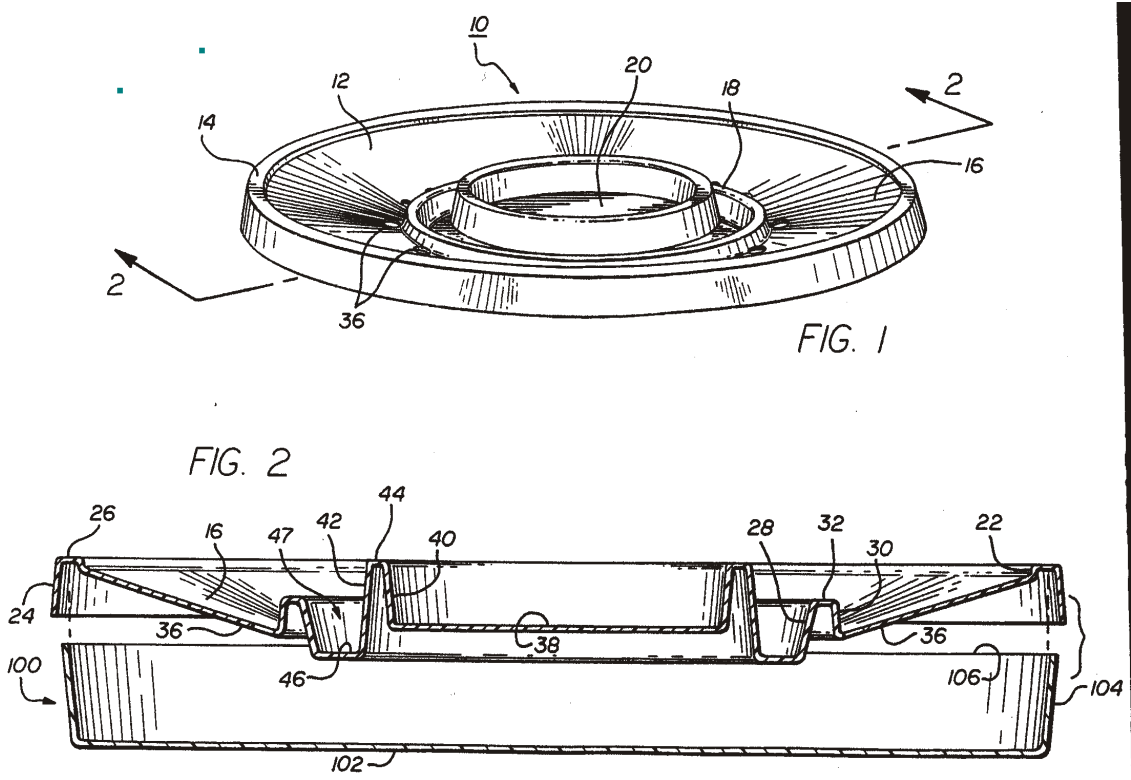
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This decision deals with the Applicant's request for a review by the Commissioner of Patents of the Examiner's Final Action dated March 12, 2003, on application 2,132,059, filed 14 September 1994 and entitled "SERVING TRAY WITH SHRIMP". The Applicant is Contessa Food Products, Inc., assignee of John Z. Blazeovich.

A hearing before the Patent Appeal Board was held on December 15, 2004. Appearing at the hearing were Mr Gregory Morrow, General Counsel for the Applicant, Contessa Foods, and Mr Konrad Sechley, Mr Anthony Creber and Ms Xiang Lu, patent agents from Gowlings. Representing the Patent Office was Mr Peter Ebsen, the examiner in charge of the application.

The application relates to a serving tray which is used to serve shrimp, along with a plurality of shrimp.

Figure 1 of the application shows a perspective view of one embodiment of the tray and Figure 2 a cross sectional view of the same embodiment.



The tray is made from a sheet of plastic material which is molded to form a raised circular outer rim 14, an inclined annular surface 16 and an annular wall 30 which is joined to the inner edge of the annular surface. Cooked, peeled and deveined shrimp are placed with their sides resting on the annular surface, their foreward ends toward the annular wall and their tails arranged toward the outer rim.

There are 46 claims in the application, with claims 1, 11, 20 and 33 being independent claims. Claim 1 of the application reads as follows:

A shrimp serving tray, comprising:  
an annular surface having an inner periphery and an outer periphery, the inner periphery radially inward of the outer periphery;  
an outer rim raised above and disposed around the outer periphery of the annular surface;  
an annular wall projecting upwardly from the inner periphery of the annular surface, wherein the annular surface extends from the annular wall to the outer rim; and  
a plurality of shrimp that have been cooked, peeled and deveined tail-on, each one of the said plurality of shrimp having a side, a forward end, and a tail;  
wherein the plurality of shrimp are circumferentially nested relative to each other, with their sides resting on the annular surface, their forward ends arranged toward the annular wall, and their tails arranged toward the outer rim;  
wherein each one of the plurality of shrimp is entirely radially outward of the annular wall and prevented from moving radially inward of the inner periphery of the annular surface by the annular wall;  
wherein the width of the annular surface measured radially corresponds to the length of the purality of the shrimp on the tray such that the forward ends rest proximate to the annular wall and the tails rest proximate to the outer rim such that the shrimp may be easily removed from the tray by grasping the tails; and  
wherein the annular surface is sloped toward the inner perphery from the oputer periphery and has a lower portion for receiving water from the plurality of shrimp.

The other independent claims recite similar combinations of elements. In claims 20 and 33, the annular surface has a lower portion and in claim 20 the lower portion is defined as a groove.

In the Final Action, the Examiner cited the following references to reject all of the claims, as well as the application itself:

French patent  
397,802                      March 8, 1909                      Rammer

United States Patent  
1,949,285                      February 27, 1934                      Porter

The French patent shows a plate or tray which is shown in various shapes. In the round embodiment of figure 1 of the patent, there is a central, circular, flat area surrounded by an inclined wall which separates the flat area from a second annular area. A first type of food can be placed in the central area and a second type of food can be placed in the annular area, with the inclined wall separating the types. In some embodiments, the annular area has a flat bottom. There is a rim at the outside edge of the plate which prevents food from falling off the plate.

United States patent shows a tray which is used for serving beverages. It comprises a central, circular, flat bottomed well in which food can be placed. A flat annular area surrounds the well and is separated from it by an upstanding annular wall. The flat annular area is of a sufficient size to accommodate bottles or glasses of the beverages which are to be served. This flat annular area is surrounded by a raised peripheral rim at its outer edge to prevent bottles or glasses from falling off the tray and it also has a groove which can serve as a drainage channel for condensation from the bottles or glasses.

In his Final Action, the Examiner stated, in part:

Porter shows all of the elements of the serving tray of claim 1 except for the slope of the annular surface. Sloping of surfaces for better water drainage is a well known expedient and do [sic] not amount to an inventive step. Porter does show drainage grooves. When the drainage is insufficient because the tray is not being carried or is placed perfectly horizontally on a surface, it is obvious that a slopping surface would improve drainage. Rammer also shows sloping surfaces in his food serving tray.

The claims on file do not comply with Section 28.3 of the Patent Act. The subject matter of these claims would have been obvious on the claim date having regard to Porter and common knowledge of sloping surfaces for better drainage. The subject matter of these claims is further obvious having regard to the serving tray of Porter and the knowledge that surfaces can be sloped in serving trays as shown by Rammer.

Claims 2 to 46 define further elements on the serving tray such as drain holes in the tray and a supporting drip pan for catching water from the drain holes and to support the tray. These further elements are common expedients and do not show the scintilla of inventiveness. Claims 2 to 46 are similarly obvious having regard to Porter and common knowledge such as sloping surfaces and holes for water drainage.

In its reply of September 12, 2003 to the Final Action, the Applicant stated, in part:

The present application comprises 46 claims of which claims 1, 11, 20 and 33 are independent applicant notes that in each of these independent claims a *combination* of a serving tray, along with a plurality of shrimp, is defined.

Examiner provides a table on page 2 of the Final Action that compares the subject matter of claim 1 with that of U.S. 1,949,285 (Porter) and FR 397,802 (Rammer). Applicant notes that only selective portions of the subject matter of claim 1 have been introduced into this table for comparison with the prior art, and that the Examiner has compared one element (the tray) of the combination of elements defined in claim 1 with that of the prior art. Furthermore, in section 3) of the Final Action Examiner states that "...the shrimp are the food lying on the tray but do not form a part of the tray." Applicant submits that this is not a representative evaluation of the subject matter of claims of the present application.

Examiner has not indicated any authority, either case law of the Patent Act, that has been relied upon to permit the separation of the elements of the claimed combination for the analysis provided in the Table on page 2 of the Final Action. Rather, it is submitted that the case law in Canada emphasizes the need to ensure that if an invention is directed to a combination of elements, as in the case with the present set of claims, that the combination of elements be evaluated, and not the separate elements.

.....

The separation of a combination of elements into its component parts and comparing one of the elements of the combination against that of the prior art does not take into consideration the combination of elements being claimed. An examination of the tray against the prior art does not take into account that claim 1, or the remaining independent claims of the present application, each clearly define a combination of elements comprising the tray and a plurality of shrimp.

.....

Applicant submits that there is no disclosure or suggestion in Porter or Rammer, either alone or in together (sic), of a combination comprising a tray and a plurality of shrimp, as defined in the claims of the present invention. Furthermore, one of skill in the art, upon reading the cited prior art, would not have been lead to the tray-shrimp combination as defined in claims 1, 11, 20 and 33. As the remaining claims each depend from claims 1, 11, 20 and 33, they include the limitations of the independent claims.

The only question for the Board concerns the rejection of the claims and the application as being obvious over Porter in view of the teachings of Rammer and common general knowledge.

The requirement that an invention not be obvious is set out in Subsection 28.3 of the *Patent Act* which reads as follows:

The subject-matter defined by a claim in an application for a patent in Canada must be subject-matter that would not have been obvious on the claim date to a person skilled in the art or science to which it pertains, having regard to

- (a) information disclosed more than one year before the filing date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant in such a manner that the information became available to the public in Canada or elsewhere ; and
- (b) information disclosed before the claim date by a person not mentioned in paragraph (a) in such a manner that the information became available to the public in Canada or elsewhere.

In assessing the question of obviousness, the Board must determine exactly what the inventor has invented. During the hearing, Mr Morrow gave a detailed description of the traditional method of shrimp packaging, what problems were associated with this method and how the inventor overcame these problems.

In the past, shrimp have been placed on a tray with the tail end toward the centre of the tray, the spine facing up and the edible end at the outside of the tray. In order to choose a shrimp, a consumer had to reach to the inner area of the tray to lift a shrimp by the inedible tail. Because the shrimp are closely spaced there is a good possibility that when removing the first shrimp, several others will be dislodged and the consumer might also contact the edible part of a number of shrimp with his or her fingers, possibly causing contamination.

To solve these problems, the inventor re-oriented the shrimp so that the inedible tail portion is located at the outside where it is more easily accessible to fingers. Also, the the side of each shrimp is in contact with the annular surface, making it easier to remove the first few shrimp

without displacing others and touching the edible parts.

Having devised a new way of orienting the shrimp, the inventor then designed a new tray to accomodate the reoriented shrimp. This combination of reorientated shrimp and the redesigned tray which cooperates with the shrimp to support them, is set out in the claims.

The Examiner has cited two references, each of which shows most of the elements of the tray. There is a rim, an annular surface to support items such as “finger foods” or bottles and glasses, walls to separate different areas of the tray and drainage grooves. Neither of these trays is specifically directed to being a shrimp tray and neither of them claims any type of food, let alone shrimp, in combination with the tray itself. Neither of these trays could be used to support shrimp in the claimed orientation without being significantly redesigned

A test for obviousness was also set out by the Court in *Beloit Canada Ltd. v. Valmet OY*, 8 C.P.R. (3d), 289 at 294:

The test for obviousness is not to ask what competent inventors did or would have done to solve the problem. Inventors are by definition inventive. The classic touchstone for obviousness is the technician skilled in the art but having no scintilla of inventiveness or imagination; a paragon of deduction and dexterity, wholly devoid of intuition; a triumph of the left hemisphere over the right. The question to be asked is whether this mythical creature (the man in the Clapham omnibus of patent law) would, in the light of the state of the art and of common general knowledge as at the claimed date of invention, have come directly and without difficulty to the solution taught by the patent. It is a very difficult test to satisfy.

The claimed invention is the combination of the shrimp and the tray. The Examiner has cited prior art related to a variety of trays which show most of the elements of the tray of the instant application but lacking the Applicant’s specific design features. Because of the lack of any mention of shrimp or cooperation between shrimp and tray in the prior art, the Board concludes that the invention claimed in the instant application would not have been obvious to a worker skilled in this field of technology at the date of the invention

The Board therefore recommends that the Examiner’s rejection of the application be reversed and that the application be returned to the Examiner for further prosecution consistent with these recommendations.

Michael Gillen	John Cavar	M. Wilson
Chairman	Member	Member

I concur with the findings and the recommendation of the Patent Appeal Board that the Examiner’s rejection of the application be reversed. Accordingly, I am returning the application to the Examiner for further prosecution consistent with the Board’s recommendation.

David Tobin  
Commissioner of Patents

Dated at Gatineau, Quebec  
this 8th day of March, 2007

