

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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte PAUL N. OLIVER

---

Appeal No. 2001-0271  
Application No. 08/855,474

---

ON BRIEF

---

Before McQUADE, NASE and BAHR, Administrative Patent Judges.  
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-21, which are all of the claims pending in this application.

BACKGROUND

The appellant's invention relates to mouse pads and to storage for computer disks (specification, p. 1). An object of appellant's invention is to provide a single unit that acts

as a computer disk holder and a mouse pad (specification, p. 2). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

Zielinski	4,002,892	Jan. 11, 1977
House	5,022,170	Jun. 11, 1991
Spector	5,600,628	Feb. 4, 1997
		(filed Sep. 16, 1992)
Murphy	5,696,536	Dec. 9, 1997
		(filed Dec. 22, 1995)

(1) Claims 8-10 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

(2) Claims 1-9 and 12-14<sup>1</sup> stand rejected under 35 U.S.C. § 103(a) as being unpatentable over House in view of Zielinski.

(3) Claims 15-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over House in view of Zielinski and Spector.

(4) Claims 10 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over House in view of Zielinski and Murphy.

(5) Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Spector.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 13) for the examiner's complete reasoning in support of the rejections and to the brief (Paper No. 12) for the appellant's arguments thereagainst.

---

<sup>1</sup> In the final rejection, claims 15-21 were rejected as unpatentable over House in view of Zielinski and as unpatentable over House in view of Zielinski and Spector. The examiner eliminated this redundancy in the answer.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

***The indefiniteness rejection***

The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. See In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

In rejecting claims 8-10 as indefinite, the examiner contends that there is an inconsistency between the language in the preamble in claim 5<sup>2</sup> and certain portions in the body of the claims, thereby making the scope of the claims unclear. In particular, the examiner finds the recitation in each of claims 8-10 of the middle layer(s) having the thickness of the

---

<sup>2</sup> We presume that the examiner's specific reference to the language of the preamble of claim 1 was an inadvertent error, as claims 8-10 depend from claim 5, not from claim 1. We presume that the examiner intended to refer to the preamble of claim 5.

computer disk to be a positive recitation of the computer disk in combination with the pad, thereby conflicting with the preambular language, which indicates that the claim is directed to a pad only (answer, pp. 3-4).

We do not share the examiner's view that the recitations of claims 8-10 constitute positive recitations of the computer disk. Like appellant (brief, p. 5), we view the recitations at issue in claims 8-10 to be merely recitations of the thickness of the middle layer(s) as being that of a computer disk. We see nothing in this which indicates that a disk is a required element of the claims and, thus, see no inconsistency between the limitations at issue and the preamble of the claims. Claims 8-10 are directed to the subcombination of the pad.

For the foregoing reasons, the examiner's indefiniteness rejection of claims 8-10 is not sustained.

***The obviousness rejections***

With regard to rejection (2), as appellant has chosen to argue the patentability of the claims without regard to any particular claim, we shall consider each of the appellant's arguments based on representative claim 12, with claims 1-9,

13 and 14 standing or falling therewith. See In re Wiseman, 596 F.2d 1019, 1021-1022, 201 USPQ 658, 660 (CCPA 1979); In re Burckel, 592 F.2d 1175, 1178-1179, 201 USPQ 67, 70 (CCPA 1979); In re Hellsund, 474 F.2d 1307, 1309-1310, 177 USPQ 170, 172 (CCPA 1973).

Claim 12 reads as follows:

12. A pad for supporting a computer mouse, the pad comprising a body having a top surface and a bottom surface joined by an edge of a selected thickness, the body having an aperture therein of dimensions sufficient to receive a computer disk.

House discloses a mouse pad or information pad having a cover 108 which affords a desirable mouse operating or writing surface and a base layer 112 formed of neoprene closed cell sponge rubber or other suitable material provided with a gripping surface 116 on the side opposite the cover 108. The cover 108 is secured to the base layer 112 at an attachment site 142 located along three of the peripheral edges 144A, 144B and 144C thereof so as to form a pouch 138 between the cover and the layer 112, such that sheet material 140 can be inserted into the pouch 138 through an opening at the peripheral edge 144D of the base layer 112 where the cover

layer 108 is not attached thereto (col. 6, lines 29-36). The pouch 138 is expandable, due to the fact that all of the materials (cover 108 and base layer 112) of which it is formed are flexible (col. 6, lines 41-43).

Appellant's argument (brief, p. 6) that House does not disclose a pocket or an aperture is not well taken. The opening at the peripheral edge 144D at which the cover and base layer are not attached, which provides access into the pouch 138, is an aperture as recited in claim 12. Claim 12 does not recite a pocket, but, in any event, the pouch 138 is a pocket as that term is conventionally understood.<sup>3</sup>

Appellant also argues that various types of computer disks, such as, for instance, ZIP disks, would badly deform the mouse pad of the House reference (brief, p. 6). Initially, we note that appellant has not provided any evidence to support this assertion.<sup>4</sup> Moreover, even if appellant is correct that insertion of a disk ZIP drive would

---

<sup>3</sup> A "pocket" is a receptacle or container (Webster's New Collegiate Dictionary (Merriam-Webster 1977)).

<sup>4</sup> An attorney's arguments in a brief cannot take the place of evidence. In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

badly deform the mouse pad of House, we perceive in this no distinction over the subject matter of claim 15, as claim 15 does not require that the aperture be dimensioned to permit the insertion of a ZIP disk without deforming the mouse pad.<sup>5</sup> Appellant has not alleged, much less established by evidence, that the opening and pouch of House are not sufficient to receive a computer disk, such as a compact disk, as the examiner contends on page 9 of the answer.

For the foregoing reasons, we find that the subject matter of claim 12 is anticipated by House. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). Stated differently, House evidences that the subject matter of claim 12 would have been obvious to one skilled in

---

<sup>5</sup> It is well established that limitations not appearing in the claims cannot be relied upon for patentability. In re Self, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982).

the art at the time of appellant's invention even without the additional teachings of Zielinski. Accordingly, we shall sustain the examiner's rejection of representative claim 12, as well as claims 1-9, 13 and 14 which fall therewith, under 35 U.S.C. § 103.

As appellant has not separately argued the patentability of claims 10 and 11 apart from claims 1-9 and 12-14, we shall sustain the examiner's rejection of these claims as being unpatentable over House in view of Zielinski and Murphy as well.

Turning next to the examiner's rejection of claim 15 as being unpatentable over Spector, we note that Spector discloses an album for a compact disc constituted by a rectangular cover panel 15 which is hinged to a rectangular cover panel 16. These panels may be formed from a single blank of cardboard or other flexible material, which is transversely scored to form parallel fold lines 17 creating a hinge which forms the spine of the album. Laminated to the inner surface of the rear cover panel 16 is a face panel 18 of the same dimensions as the rear cover panel and formed of the same or similar material. The thickness of the face panel 18

matches the thickness of a compact disk 10. The compact disk 10 is snugly nested in a circular opening 19 die cut in the face panel 18 to create a well (col. 3, lines 47-64).

As we see it, Spector meets the limitations of claim 15 as follows. Either of the panels 15, 16 provides a continuously flat surface for supporting a computer mouse and the circular opening 19 is an aperture for receiving a computer disk therewithin, the aperture having a height substantially equal to the thickness of the computer disk, by virtue of the thickness of the face panel 18 matching the thickness of the compact disk 10. Moreover, Spector's cardboard album is a "pad"<sup>6</sup> as broadly recited in claim 15.

Turning finally to the examiner's rejection of claims 15-21 as being unpatentable over House in view of Zielinski and Spector, the examiner acknowledges that neither House nor Zielinski teaches or suggests the provision of a compact disk in the mouse pad of House (answer, p. 6). Unlike the examiner, we find no suggestion in Spector's compact disk

---

<sup>6</sup> A "pad" is a thin flat mat or cushion (Webster's New Collegiate Dictionary (Merriam-Webster 1977)).

album to have provided a compact disk in the mouse pad of House. Accordingly, we shall not sustain rejection (3).

CONCLUSION

To summarize, the rejections of claims 8-10 under 35 U.S.C. § 112, second paragraph, and claims 15-21 under 35 U.S.C. § 103 as being unpatentable over House in view of Zielinski and Spector are reversed. The examiner's rejections of claims 1-9 and 12-14 as being unpatentable over House in view of Zielinski, claims 10 and 11 as being unpatentable over House in view of Zielinski and Murphy and claim 15 as being unpatentable over Spector are sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

JOHN P. McQUADE	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

Appeal No. 2001-0271  
Application No. 08/855,474

Page 13

MILLEN WHITE ZELANO & BRANIGAN  
2200 CLARENDON BOULEVARD  
SUITE 1400  
ARLINGTON, VA 22201

JDB:caw