

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES KEITH HOPE

Appeal No. 2000-1612
Application 08/938,844

ON BRIEF

Before CALVERT, FRANKFORT, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

Appellant appeals from the examiner's non-final Office action mailed August 16, 1999 (Paper No. 10), the fourth set of rejections entered by the examiner during the prosecution of this application. Subsequent to the examiner's rejections in Paper No. 10, appellant filed his brief (Paper No. 11) and an amendment (Paper No. 12) on September 20, 1999. Appellant

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had previously filed his Notice of Appeal (Paper No. 6, December 28, 1998) in response to an earlier final rejection. Claims 2, 3, 5 and 7 remain in the application. Of those claims, claims 2, 3 and 7 stand rejected on prior art and are before us for consideration on appeal. Claim 5 has no prior art rejection against it and is presumed to be allowable if rewritten in independent form. The rejection of claims 2, 3 and 5 in Paper No. 10 under 35 U.S.C. § 112, second paragraph, was apparently overcome by appellant's amendment filed September 20, 1999, since this rejection was not repeated in the examiner's answer.¹ Claims 1, 4 and 6 have been canceled.

Appellant's invention is directed to a combination chair (15), support platform (1, 3) and computer mouse (19). As noted more particularly on page 3 of the specification, appellant indicates that the invention

¹Although the examiner has approved the amendment filed on September 20, 1999 for entry and it appears on the face of that paper to have been entered, it has NOT been properly entered with regard to independent claim 7. Correction of this oversight is necessary.

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relates to a removable support platform for a chair's armrest on which a mouse and its pad may be placed. To attached [sic] the platform to the armrest, the platform extension oriented parallel to the armrest has one or two spaced straps that can encircle the chairs arm and be fixed thereon. The strap or straps each may have hook and loop (VELCO TM) ends or the like. Screws or other strap retainers extend into the strap through the platform's extension member to fix the members together.

Independent claim 7 is representative of the subject matter on appeal and a copy of that claim, as it appears in the Appendix to appellant's brief, is attached to this decision.

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

Thompson et al. (Thompson)	5,474,272	Dec. 12,
1995		
Bourassa	5,848,773	Dec.
15, 1998		
	(filed Apr. 17,	
1997)		

Claim 7 is said by the examiner to stand rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative,

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under 35 U.S.C. § 103(a) as obvious over Bourassa in view of Thompson.

Claims 2 and 3 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bourassa in view of Thompson.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding the rejections, we make reference to the examiner's answer (November 3, 1999) for the reasoning in support of the rejections, and to appellant's brief (September 20, 1999) for the arguments thereagainst.

OPINION

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

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consequence of our review, we have made the determinations which follow.

With regard to the rejection of claim 7 relying on Bourassa under 35 U.S.C. § 102(e), we have reviewed the applied patent and, like appellant, find no teaching or disclosure therein of a "removable strap fastener means" as required in claim 7 on appeal. We share appellant's view as expressed in the brief (pages 6-7) that the examiner's attempt to read the "removable strap fastener means" of claim 7 on the plate (21) of Bourassa is entirely untenable. One of ordinary skill in the art would not reasonably view the plate (21) of Bourassa as being a strap or "removable strap fastener means" as that term would be understood from appellant's specification. Before the USPTO, when evaluating claim language during examination of the application, the examiner is required to give the terminology of the claims its broadest reasonable interpretation consistent with the specification, and to remember that the claim language cannot be read in a vacuum, but instead must be read in light of the specification

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as it would be interpreted by one of ordinary skill in the pertinent art. See In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) and In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

In light of the foregoing, we will not sustain the examiner's rejection of claim 7 under 35 U.S.C. § 102(e) as being anticipated by Bourassa.

As for the examiner's rejection of claims 2, 3 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Bourassa in view of Thompson, we find ourselves in agreement with the examiner's position that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to substitute a known alternative form of fastening means, like the strap arrangement in Thompson (2, 26, 28, 29), for the clamping arrangement (21-25) of Bourassa.

In response to appellant's arguments concerning the

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combination of the references relied upon by the examiner, we observe that where the issue is one of obviousness under 35 U.S.C. § 103, the proper inquiry should not be limited to the specific structure shown by a reference, but should be into the concepts fairly contained therein, with the overriding question to be determined being whether those concepts would have suggested to one skilled in the art the modification called for by the claims. See In re Bascom, 230 F.2d 612, 614, 109 USPQ 98, 100 (CCPA 1956). Furthermore, under 35 U.S.C. § 103, a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests (In re Burckel, 592 F.2d 1175, 1179, 201 USPQ 67, 70 (CCPA 1979); In re Lamberti, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976)), as well as the reasonable inferences which the artisan would logically draw from the reference. See In re Shepard, 219 F.2d 194, 197, 138 USPQ 148, 150 (CCPA 1963). As stated by the Court in In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into

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the structure of the primary reference, nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

In addition, while there clearly must be some teaching or suggestion to combine existing elements in the prior art to arrive at the claimed invention, we note that it is not necessary that such teaching or suggestion be found only within the four corners of the applied references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See In re Boezk, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). This is because we presume skill on the part of the artisan, rather than the converse. See In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir 1985).

For the above reasons, we will sustain the examiner's rejection of independent claim 7 under 35 U.S.C. § 103(a) as being obvious over Bourassa in view of Thompson. Since appellant indicated on page 5 of the brief that claims 2, 3

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and 7 "stand or fall together," it follows that the examiner's rejection of claims 2 and 3 under 35 U.S.C. § 103(a) will also be sustained.

To summarize, we have refused to sustain the examiner's rejection of claim 7 under 35 U.S.C. § 102(e) based on Bourassa, but have sustained the rejection of claims 2, 3 and 7 under 35 U.S.C. § 103(a) based on the collective teachings of Bourassa and Thompson. Since one rejection of each of the claims before us on appeal has been sustained, the examiner's decision is affirmed.

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

AFFIRMED

IAN A. CALVERT)
Administrative Patent Judge)
)
) BOARD OF PATENT
CHARLES E. FRANKFORT)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
JEFFREY V. NASE)
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APPENDIX

7. A combined chair, support platform and computer mouse comprising:

a chair having a right side armrest and an opposite left side armrest;

a substantially flat support platform removably attached to one of said chair's armrests, said platform having a main portion and an arm extension portion extending from the main portion;

removable strap fastener means mounted on the arm extension portion of said platform for fastening the platform to one of the chair's armrests; and

a computer mouse mounted on the platform's main portion and adapted to be connected to a computer.