

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 43

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROBERT C. KLINGER and TROY E. BERGSTROM

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Appeal No. 1998-2490  
Application 08/434,263

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HEARD: May 4, 2000

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Before JERRY SMITH, RUGGIERO and LALL, Administrative Patent Judges.

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection<sup>1</sup> of all the pending claims, 22 to 25<sup>2</sup> and

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<sup>1</sup> An amendment after the final rejection was filed as paper no. 25 and entry approved [paper no. 31]. However, the amendment made no changes to the claims.

<sup>2</sup> Claim 26 has been indicated as allowable if rewritten in independent form.

27 to 28.

The invention relates to a novel device for controlling the movement of a computer mouse cord of a computer mouse operating on a computer mouse pad. The device comprises a shackle for attachment to a mouse cord. The shackle is comprised of a partially cylindrical body in the form of an elongated clamp having an opening with flared lips. A mounting means is attached to the shackle for mounting the device on a stationary object. The invention is further illustrated by the following claim.

22. In a device for controlling the movement of a computer mouse cord of a computer mouse operated on a computer mouse pad, the combination of which comprises:

a shackle for controlling movement of said computer mouse cord, said shackle comprising an elongated clamp having an opening along its length which is capable of holding said computer mouse cord at a point along its length, to limit movement of said computer mouse cord to a portion of said computer mouse cord between said clamp and said computer mouse, and

a mounting means attached to said shackle for mounting said shackle on said computer mouse pad, said mounting means comprising:

a support member attached to said shackle,

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a top plate attached to said support member,  
a base member attached to said support member,

whereby said top plate and said base member are capable  
of removably engaging said computer mouse pad.

The Examiner relies on the following references:

McCormick	D206,783	Jan. 31, 1967
Yiin	5,022,124	Jun. 11, 1991

Claim 22 stands rejected under 35 U.S.C. § 102 over  
McCormick. Claims 23 to 25 and 27 to 28 stand rejected under  
35 U.S.C. § 103 over McCormick in view of Yiin.

Rather than repeat the positions and the arguments of  
Appellants and the Examiner, we make reference to the brief  
and the answer for their respective positions.

#### OPINION

We have considered the rejections advanced by the  
Examiner. We have, likewise, reviewed Appellants' arguments  
against the rejections as set forth in the brief.

It is our view, after consideration of the record before  
us, that the rejections under 35 U.S.C. § 102 and under 35  
U.S.C. § 103 are not proper. Accordingly, we reverse.

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We now consider the various rejections.

Rejection under 35 U.S.C. § 102

The Examiner has rejected claim 22 as being anticipated by McCormick.

We note that a prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)).

After considering Appellants' arguments [brief, pages 3 to 10] and Examiner's position [answer, pages 3 to 5], we are persuaded by Appellants that McCormick does not show the limitations recited in claim 22. For example, McCormick does not show the claimed limitation of "said shackle comprising an elongated clamp ... which is capable of holding said mouse cord ... , to limit movement of said computer mouse cord ... between said clamp and said computer mouse." Not only does McCormick not show any structure capable of doing these

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functions, McCormick does not even deal with a computer mouse and the problem associated with a loose computer mouse cord which Appellants are trying to solve. We find that the Examiner is misplaced in ignoring the claimed limitations. Therefore, we do not sustain the anticipation rejection of claim 22 over McCormick.

Rejections under 35 U.S.C. § 103

Claims 23 to 25 and 27 to 28 are rejected as being obvious over McCormick and Yiin.

As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re

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Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

With respect to the rejection of these claims, i.e., dependent claims 23 to 25, 27, and independent claim 28, the Examiner has added Yiin to McCormick. However, Yiin relates to a "clip device" and has nothing to do with arresting the movement of a computer mouse cord. We find that Yiin, even if properly combinable with McCormick, does not cure the deficiency noted above in McCormick in regard to claim 22. All these claims each at least contain the limitations of claim 22. Therefore, we do not sustain the obviousness rejection of claims 23 to 25, 27 and 28 over McCormick and Yiin.

In conclusion, we reverse the Examiner's final rejection of claim 22 under 35 U.S.C. § 102 over McCormick. Further, we reverse the rejection under 35 U.S.C. § 103 of claims 23 to 25, 27 and 28 over McCormick and Yiin.

REVERSED

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JERRY SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
JOSEPH F. RUGGIERO	)	
Administrative Patent Judge	)	APPEALS AND
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PARSHOTAM S. LALL	)	
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