

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DARRELL A. IGELMUND

Appeal No. 1999-0653
Application No. 08/226,564

ON BRIEF

Before STAAB, NASE, and BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1, 2, 6, 7, 9, 13 and 15. Claims 3, 4, 8 and 18 stand withdrawn from further consideration under 37 CFR § 1.142(b) as being directed to a non-elected invention. Claims 5, 10-12, 14, 16 and 17 stand objected to as being dependent on rejected base claims.¹

¹ According to the examiner's answer (Paper No. 12, pages 5, 12 and 13), all rejections of claims 10, 11 and 14 set forth in the final rejection (Paper No. 8) have been withdrawn. However, a new ground of rejection of
(continued...)

BACKGROUND

The appellant's invention relates to security devices for portable equipment and, more specifically, to devices used to prevent theft of computers and other office equipment (specification, page 1) as well as a method of using such devices (claims 15-17). Further understanding of the invention can be derived from a reading of exemplary claims 1 and 9, which appear in the appendix to the appellant's brief, and claim 15, a copy of which is attached to this decision.

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

Schou	1,470,937	Oct. 16, 1923
Murray, Jr. et al. (Murray)	5,502,989	Apr. 2, 1996 ²

The following rejections are before us for review.³

Claim 13 stands rejected under 35 U.S.C. § 112, first paragraph, on the basis that the specification fails to adequately teach how to make and/or use the invention.

¹(...continued)
claims 1, 2 and 15 was added in the answer.

² This patent, which issued on application No. 08/307,113, filed September 16, 1994, is a division of application No. 08/138,634, filed October 15, 1993, which issued as U.S. Patent No. 6,000,251 on December 14, 1999.

³ The rejections of claim 7 under 35 U.S.C. § 112, second paragraph, claims 1, 6, 9 and 14 under 35 U.S.C. § 102(e) and claims 10 and 11 under 35 U.S.C. § 102(e) or 103 set forth in the final rejection have been withdrawn (answer, pages 4, 5, 10, 12 and 13). 35

Claims 1, 2, 6, 7, 9 and 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Schou.

Claims 1, 2 and 15 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Murray.⁴

Reference is made to the main brief and reply brief (Paper Nos. 11 and 13), the first request to strike ("REQUEST TO STRIKE SUPPLEMENTAL EXAMINER'S ANSWER" filed May 30, 1997, Paper No. 15) and the second request to strike ("APPLICANT'S REQUEST TO STRIKE EXAMINER'S RESPONSE" filed October 23, Paper No.18) for the position of the appellant and to the final rejection, answer and supplemental answer (Paper Nos. 8, 12 and 14) for the position of the examiner with regard to the merits of these rejections.

The appellant's remarks (main brief, page 11) with regard to the propriety of the examiner's restriction are directed to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review this issue.

Similarly, the appellant's request to strike the examiner's supplemental answer "as beyond the scope of procedure as set forth in the Code of Federal Regulations relating to appeals before this Board" (first request to strike, page 2) is directed to a petitionable matter and not an appealable matter. We note, however, that, while the Code of Federal Regulations

⁴ This rejection was entered as a new ground of rejection in the examiner's answer (page 6).

then in effect did not expressly provide for a supplemental examiner's answer, MPEP

§ 1208.04 (Sixth Edition, Revision 3, July 1997) specifically provided that

[i]f the reply brief is filed in response to a new ground of rejection in the examiner's answer, the examiner must issue a supplemental answer indicating whether the new ground of rejection has been overcome, and, if it has not, explaining why not [emphasis added].

As the appellant's reply brief was filed in response to the new ground of rejection of claims 1, 2 and 15 in the examiner's answer and as the examiner's supplemental answer provided an explanation as to why the new ground of rejection was not overcome by the argument and evidence submitted with the appellant's reply brief, the examiner's supplemental answer appears to us to have been an appropriate execution of this instruction of the MPEP.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims⁵, to the applied prior art references, and to the respective

⁵ While this issue is not before us in this appeal, we note several inconsistencies between the limitations of dependent claims and the underlying disclosure of the elected embodiments of Figures 1-5, 9 and 10. For example, the recitation of a "unitary main body" defining a head locking aperture in claim 1 appears to read only on the embodiment of Figure 10, since the head locking aperture in the devices of Figures 1-5 and 9 is on the head support 80 or 80', which is not part of the main body 16 or 16'. However, the further limitations of some of the dependent claims, such as claim 2, appear to be directed only to Figures 1-5 and 9. Additionally, the further limitations of claim 7 appear to be directed to Figure 6a, which is a non-elected embodiment, and not to Figures 1-5, 9 and 10. We also note that claims 1 and 9 recite the "securing means," which appears to us to read on the anchoring holes and anchoring tether, as an element distinct from the attachment means and anchoring tether. The examiner should review the claim limitations in light of the appellant's underlying disclosure to determine whether they accurately describe the invention. Further, on October 19, 1995 (Paper No. 7), the appellant filed a request for a drawing change to Figure 9 to add the reference numeral 20' and a renewed request for this drawing change on September 12, 1996. It appears from our review of the application file that the examiner has not responded to that request on the record. We leave this issue to be addressed in the event of further prosecution before the examiner.

positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The enablement rejection

The test for enablement is whether one skilled in the art could make or use the claimed invention from the disclosure of the application coupled with information known in the art without undue experimentation. See United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989).

Claim 13, which depends from claim 12, is directed to the embodiment of the invention illustrated in Figure 9 and includes the limitation "wherein the mounting end is made of a compressible material to accommodate different side wall thicknesses among security slots." As discussed on page 15 of the appellant's specification, the body 16' of the Figure 9 embodiment is freely rotatable about the central axis 18 with respect to the head support 80'. Further, the head support 80', while captured within a cavity 82' of the body 16' defined between a head support retaining rim 111 and a transverse retaining wall 84, is free to move axially within the cavity relative to the body 16'. The head support 80' is provided with a collar 112 having a length which is greater than the length of a collar opening 113 defined by the retaining wall so that the head 58 of a head locking screw 26 seats on a screw locking rim 116 of the collar and not on the retaining wall 84 of the body 16' (specification, page 16). The screw 26 is threaded through a threaded head locking aperture 25' in the collar. The mounting end 20' of the body

is made of a compressible material "to accommodate different side wall thicknesses among security slots" (claim 13 and specification, page 16).

In rejecting claim 13 under the first paragraph of 35 U.S.C. § 112, the examiner's position (answer, pages 7 and 8), in essence, is that, since the head support is freely movable within the cavity 82', the head 28, 29 is also freely axially movable relative to the mounting end 20' of the body, thereby resulting in a loose fit of the device against the side wall 120 of the computer equipment. In light of this axial looseness, the examiner questions why a compressible mounting end would be required to accommodate different side wall thicknesses and how a compressible mounting end would be used to do so. Therefore, the examiner has rejected claim 13 under the first paragraph of 35 U.S.C. § 112 on the basis that the specification fails to adequately teach how to make and/or use the claimed invention (lack of enablement).

While we do not agree with the appellant's statement (main brief, page 6) that "[i]t is abundantly clear that the compressible collar 20' contracts as the screw 58 is tightened against the internal threads of the adjustable head support 80'," we do note that, even with the head support 80' positioned toward the mounting end of the body such that it abuts against the retaining rim 111, the axial spacing between the transverse limb 28 of the head and the end face of the mounting end 20' may still not be sufficient to accommodate a particularly thick computer side wall. From our perspective, one of ordinary skill in the art would understand

that the provision of a mounting end 20' made of compressible material would permit a user to exert sufficient axial pressure on the device to force the transverse limb of the head through the slot away from the mounting end 20' and past such a side wall falling within an appropriate thickness range, so that the head can be rotated into the locking position.

For the foregoing reasons, we shall not sustain the examiner's rejection of claim 13 under 35 U.S.C. § 112, first paragraph.

The anticipation rejections

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Turning first to the rejection of claims 1, 2, 6, 7, 9 and 13 as being anticipated by Schou, we note that, although the appellant has stated that each of the claims is "independently patentable" (main brief, page 5), the appellant has not argued separately the patentability of claims 2, 6, 7, 9 and 13 apart from claim 1. Therefore, claims 2, 6, 7, 9 and 13 shall stand or fall with representative claim 1 (see In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978)).

In rejecting claims 1, 2, 6, 7, 9 and 13, the examiner (answer, page 4) finds that Schou discloses a "unitary main body" (sleeve 26) having a "head locking aperture" (the opening in the end of the sleeve 26 as shown in Figure 8); a "slot-mating head" (rod 10 and lug 13); an "elongated head locking member" (lug 19); "securing means" (follower 20) and an "attachment means" (apertures 25, 28).

The device of Schou, which is disclosed for use as a key hole guard, comprises a rod 10 threaded throughout a portion of its length at 11 and provided with a key way 12. A lug is secured to the end of the rod which enters the key hole and extends radially from the rod. A key hole closure 15 provided with a lug 19 and a key 18 slides over the rod 10, with the key adapted to fit into the key way 12. As discussed by Schou (page 1, line 81, to page 2, line 43), the rod 10 and lug 13 are thrust into the key hole, with the lug aligned with the hole, and then given a quarter turn so that the lug 19 is brought into alignment with the key hole. The key hole guard is then pushed forward until it is flush with the door casing, at which point the

lug extends into the key hole and blocks the path of rotation of the lug 13. A threaded follower 20 is then screwed tight against the key hole guard 15. In the construction shown in Figures 5-8, a sleeve 26 is placed over the key hole guard 15 and rod 10 with apertures 28 of the sleeve aligned with apertures 25 of the key hole guard, as illustrated in Figures 5 and 6, and the hasp of a padlock is passed through the aligned apertures to prevent access to the key hole guard 15 and removal of the lug 19 from the slot.

The appellant argues that Schou does not anticipate claim 1 because Schou is directed to a key hole device and not to a security device "for securing portable computing equipment" as set forth in the claim (main brief, page 9). While we appreciate that the Schou device is disclosed for use as a key hole guard, the Schou device appears to us to be fully capable, without modification, of being used for securing portable computing equipment provided with an appropriately sized security slot opening in a chassis thereof. Accordingly, the recited use for the security device does not patentably distinguish the appellant's claimed device from the Schou device.⁶

The appellant's argument (main brief, page 9) that the lug 19 and separate follower 20 are not a "unitary" body does not persuade us that the examiner's rejection is improper, as sleeve 26, which the examiner finds reads on the "unitary main body," is a unitary body as required by the claim.

⁶ It is well settled that the recitation of an intended use for an old product does not make a claim to that old product patentable. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

With regard to the appellant's suggestion (main brief, page 9) that the lug 13, which is attached to a threaded rod 10, is movable with respect to the combination of parts 16 and 20 of Schou and thus is not "attached to the mounting end" of the main body as required by claim 1, we note initially that, in proceedings before the Patent and Trademark Office, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). From our perspective, the term "attached, " when given its broadest reasonable interpretation, does not require rigid fixation of the attached elements.⁷ This interpretation is consistent with the use of the term "attached" to describe the relationship of the shaft 29 and mounting end 20 of Figure 1 in the appellant's specification (page 9, line 4). As illustrated in Figure 1 and discussed on pages 10-14 of the appellant's specification, the shaft 29 is supported on a head support 80, which is axially movable relative to the mounting end 20 of the main body 16. Therefore, the term "attached" as used in the appellant's specification cannot preclude relative axial movement. Moreover, we note that the lug 13 and rod 10 are locked in position relative to the key hole guard 15 when the follower 20 is screwed down tight against the key hole guard and that the guard is locked in position relative to the sleeve 26 once the padlock hasp is passed through the aligned

⁷ The term "attached" is generally understood to mean fastened or joined by sticking, tying, etc. Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988)

apertures 25, 28. Therefore, we conclude that the lug 13 supported on the rod 10 is attached to the mounting end of the sleeve as required by claim 1.

As the appellant's arguments have not persuaded us that the examiner's rejection of claim 1 as being anticipated by Schou is improper, we shall sustain this rejection of claim 1 and of claims 2, 6, 7, 9 and 13 which depend therefrom.

Turning next to the examiner's rejection of claims 1, 2 and 15 under 35 U.S.C. § 102(e) as being anticipated by Murray, the appellant has not contested the examiner's determination that Murray fully discloses the subject matter of these claims and we find no error in the examiner's findings in this regard. Rather, the appellant asserts that Murray does not claim the same patentable invention, as defined in 37 CFR § 1.601(n), as the appellant and that the declarations of the appellant (inventor Darrell A. Igelmund) and his patent attorney Michael J. Folise submitted with the reply brief are sufficient to overcome the patent to Murray under 37 CFR § 1.131. The appellant also submitted a supplemental declaration of Mr. Igelmund (attachment to first request to strike, Paper No. 15) in further support of the appellant's contention that the appellant's invention was conceived prior to the effective filing date of the application on which the Murray patent was issued. However, as the examiner (Paper No. 16, page 3) has refused to enter this supplemental declaration, we shall not consider it in rendering our decision.

37 CFR § 1.131 provides:

(a)(1) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 102 (a) or (e), or 35 U.S.C. 103 based on a U.S. patent to another or others which is prior art under 35 U.S.C. 102 (a) or (e) and which substantially shows or describes but does not claim the same patentable invention, as defined in § 1.601(n), or on reference to a foreign patent or to a printed publication, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to overcome the patent or publication. The oath or declaration must include facts showing a completion of the invention in this country or in a NAFTA or WTO member country before the filing date of the application on which the U.S. patent issued, or before the date of the foreign patent, or before the date of the printed publication. When an appropriate oath or declaration is made, the patent or publication cited shall not bar the grant of a patent to the inventor or the confirmation of the patentability of the claims of the patent, unless the date of such patent or printed publication is more than one year prior to the date on which the inventor's or patent owner's application was filed in this country.

(2) A date of completion of the invention may not be established under this section before December 8, 1993, in a NAFTA country, or before January 1, 1996, in a WTO member country other than a NAFTA country.

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or **conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application**. Original exhibits or drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained [emphasis added].

The appellant (reply brief, page 2) concedes that the effective date of the Murray patent as prior art under 35 U.S.C. § 102(e) is October 15, 1993 and asserts that the Folise and Igelmund declarations establish that the appellant's invention was conceived at least as early as August 1993 (prior to the effective date) and that the appellant was diligent in reducing the invention to practice in the

form of a prototype. In particular, the Folise declaration states that the declarant was contacted by the appellant regarding a computer security slot security device involving a "T" type part that is inserted and turned in the slot and refers to a facsimile transmission received on August 19, 1993 regarding that invention. The attached facsimile transmission includes a short handwritten message (Exhibit A1) regarding a patent effort involving a "T" type part that is inserted in a slot and a "unique" method to keep it engaged in the slot and a drawing (Exhibit A2). The Folise declaration further states that further discussions with the appellant ensued in November and December 1993, including an office conference on December 1, 1993. At that conference, the appellant showed Mr. Folise a prototype of the invention, which was photo imaged on a photocopy machine. A copy of that photocopy is attached to the Folise declaration as Exhibit B. The Igelmund declaration confirms that Exhibits A1 and A2 are accurate copies of the facsimile transmission sent to Mr. Folise on August 19, 1993 and that Exhibit B is an accurate copy of the reproduction of the prototype which he brought to Mr. Folise's office on December 1, 1993. The declaration of Mr. Igelmund further states that he conceived of the invention shown in Exhibit B at least as early as June 1993 and that he worked diligently with Mr. Folise's office in preparing a patent application thereon.

Even accepting the appellant's argument (reply brief, page 2) that the Folise and Igelmund declarations are sufficient to establish that the appellant conceived of the claimed invention at least as early as August 19, 1993, the date of the above-mentioned facsimile transmission to Mr. Folise, and

that Exhibit B evidences reduction of the invention to practice in the form of a prototype at least as early as December 1, 1993 (after the effective date), 37 CFR § 1.131(b) requires that the showing of facts be such, in character and weight, as to establish conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Thus, in the instant situation, the appellant's showing of facts must establish due diligence from prior to October 15, 1993 to December 1, 1993.

To satisfy the due diligence showing requirement of 37 CFR § 1.131(b), the appellant must present proof of diligence, no matter how short the period to be covered. In re Mulder, 716 F.2d 1542, 219 USPQ 189, 193 (Fed. Cir. 1983) (Even a two-day hiatus in the evidence of due diligence rendered the inventors' showing of facts ineffective to overcome the applied reference). Moreover, to establish diligence, the inventor must provide specific details as to what was done and when it was done during the critical period. See Gould v. Schawlow, 363 F.2d 908, 918, 150 USPQ 634, 643 (CCPA 1966).

The Folise and Igelmund declarations provide absolutely no explanation of the appellant's activities with regard to the invention set forth in claims 1, 2 and 15 to support the appellant's assertion of diligence. In particular, the statement in paragraph 4 of the Igelmund declaration that the declarant "worked diligently with Mr. Folise's office in preparing a patent application on the invention" is merely conclusory in nature and fails to indicate (1) the actions that were taken by the declarant toward

either reducing the invention to practice in the form of a prototype or preparing a patent application and (2) the dates on which those actions were taken. The statement on page 2 of the reply brief to the effect that the appellant was diligent in both reducing the invention to practice in the form of a prototype and in filing the subject patent application is fraught with the same deficiencies as the above-noted statement in the Igelmund declaration and, furthermore, being unsworn and not in declaration form, can be taken merely as argument and not to establish facts.⁸ See In re Mehta, 347 F.2d 859, 866, 146 USPQ 284, 289 (CCPA 1965).

For the foregoing reasons, even accepting the appellant's argument that the Folise and Igelmund declarations are sufficient to establish conception of the invention as early as August 19, 1993 and reduction to practice as early as December 1, 1993, they fail to establish due diligence from prior to the effective date of the reference (October 15, 1993) until reduction to practice of the invention or filing of the application as required by 37 CFR § 1.131. Accordingly, we conclude that the declarations submitted with the reply brief are ineffective to overcome the Murray patent as prior art.

While, as discussed above, we have not considered the supplemental declaration of Mr. Igelmund submitted with the first request to strike in reaching our decision, because it was refused entry by the examiner, we do wish to point out that this supplemental declaration was submitted "[i]n further support of the appellant's contention that it conceived of the claimed invention well prior to the effective

⁸ 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).

filing date of October 15, 1993 [of the Murray patent]" (first request to strike, page 3) and contains no evidence of facts which overcome the above-noted deficiencies of the Folise and Igelmund declarations in establishing due diligence as required by 37 CFR § 1.131(b).

Accordingly, we shall sustain the examiner's rejection of claims 1, 2 and 15 under 35 U.S.C. § 102(e) as being anticipated by Murray.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 6, 7, 9 and 13 under 35 U.S.C. § 102(b) and claims 1, 2 and 15 under 35 U.S.C. § 102(e) is affirmed, but the examiner's decision to reject claim 13 under 35 U.S.C. § 112, first paragraph, is reversed.

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

AFFIRMED

LAWRENCE J. STAAB)
Administrative Patent Judge)
)
)
) BOARD OF PATENT
JEFFREY V. NASE) APPEALS
Administrative Patent Judge) AND

) INTERFERENCES
)
)
)
)
)

JENNIFER D. BAHR
Administrative Patent Judge

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15. A method for securing portable computing equipment having an elongated security slot opening in a chassis of the equipment from theft, comprising:

providing a computing equipment security device having a slot-mating head and an axially movable head locking member attached to a mounting end of the device, the head having a transverse limb and the head being sized for insertion into the security slot opening;

inserting the head into the security slot;

rotating the mounting end to rotate the head relative to a longitudinal axis of the slot opening and to align the head locking member with the slot opening;

axially advancing the head locking member into the slot opening to prevent rotation of the mounting end and removal of the head from the slot;

securing the head locking member to prevent its withdrawal from the slot; and

attaching an anchoring tether to the security fitting and to a stationary object to secure the portable equipment from theft.