

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte BRIAN M. MATTSON

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Appeal No. 2005-0121  
Application No. 10/074,154

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ON BRIEF

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Before FRANKFORT, MCQUADE, and NASE, Administrative Patent Judge.  
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Brian M. Mattson originally took this appeal from the final rejection of claims 1 through 7, all of the claims pending in the application. As the examiner has since withdrawn the only rejection of claim 2, the appeal as to this claim is hereby dismissed, leaving for review the standing rejections of claims 1 and 3 through 7. Presumably, claim 2 now stands objected to as depending from a rejected base claim.

### THE INVENTION

The invention relates to “a securable mousepad having a hidden writing surface as well as a method of using the same” (specification, page 1). Representative claims 1 and 5 read as follows:

1. An apparatus for storing information, the apparatus comprising:  
a mousepad having an opaque top layer;  
a surface on which the information is written wherein the surface is situated below the opaque top layer of the mousepad in a first position wherein the surface has a planar area substantially equal in size to a planar area of the opaque top layer; and  
a tray that slides to a second position to expose the surface on which the information is written from under the opaque top layer of the mousepad.

5. A method for using a mousepad and for storing information, the method comprising the steps of:  
providing a mousepad having an opaque top layer and a surface on which the information is written below the opaque top layer of the mousepad in a first position wherein the opaque top layer has a surface area substantially equal in size to a surface area of the surface on which the information is written; and  
providing a tray that slides between the first position and a second position wherein the second position exposes the surface on which the information is written from under the opaque top layer of the surface on which the information is written.

### THE REJECTIONS

Claims 1 and 3 through 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,692,815 to Murphy.

Claims 1 and 3 through 7 also stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1 through 10, 12 through 14 and 17 of

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co-pending Application No. 09/572,214 in view of Murphy.<sup>1</sup>

Attention is directed to the main and reply briefs (Paper Nos. 10 and 13) and the answer (Paper No. 12) for the respective positions of the appellant and the examiner regarding the merits of these rejections.<sup>2</sup>

### DISCUSSION

#### I. The 35 U.S.C. § 103(a) rejection of claims 1 and 3 through 7 as being unpatentable over Murphy

Murphy discloses a mouse pad and item holder 10 comprising a base 12 having a top surface which includes a mouse tracking area 20, a bottom surface 22, a plurality of sides 15, 16, 17 and 18, and a hollow interior 24. The hollow interior defines a plurality of compartments accessible through openings 28, 30, 32 and 34 in the sides. The compartments may hold any number of useful items either directly or via drawers. One such drawer embodies a slidable tray 38 for Post-it<sup>®</sup> notes or other types of paper 40.

As implicitly conceded by the examiner, Murphy does not meet the limitations in independent claims 1 and 5 requiring the surface on which information is written to have a planar or surface area substantially equal in size to the planar or surface area of the opaque top layer. Figures 1 and 3 show that Murphy's surface on which information is written (paper 40)

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<sup>1</sup> The record indicates that the instant application is a continuation-in-part of Application No. 09/572,214.

<sup>2</sup> Appended to the main brief as Exhibit B are copies of claims 1 through 10, 12 through 14 and 17 in Application No. 09/572,214. The examiner has not disputed the accuracy of these copies.

has a planar or surface area substantially smaller in size than the planar or surface area of Murphy's opaque top layer (mouse tracking area 20). The examiner nonetheless submits that

Murphy [suggests] the number of compartments could be **any** (therefore could be just one, see column 2 lines 60-61 and column 3 lines 33-36). Hence, it would have been obvious for one of ordinary skill in the art at the time of the invention to use only one tray with an area substantially equal to the area of the top surface when only [the] storage tray for the notepad is needed by the user so as to increase the storage area for the notepad or other paper, simplify the manufacturing process and therefore reduce the cost. It has been held to be within the general skill of a worker in the art to make plural parts unitary as a matter of obvious engineering choice [answer, page 6; also see page 7 in the answer].

Murphy, however, would not have suggested modifying the mouse pad and item holder disclosed therein so as to have only one compartment and tray. The portions of the Murphy disclosure cited by the examiner simply do not support a conclusion to the contrary. Instead, Murphy actually touts the benefits of a mouse pad and item holder having a plurality of compartments for holding a variety of different items. Moreover, even if the artisan would have found it obvious to provide the Murphy mouse pad and holder with only a single compartment and tray which holds paper, the reference provides no suggestion to size such tray and paper so as to result in a surface on which information is written having a planar or surface area substantially equal in size to the planar or surface area of the opaque top layer.

Hence, Murphy does not justify the examiner's conclusion that the differences between the subject matter recited in claims 1 and 5 and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

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skill in the art.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claims 1 and 5, and dependent claims 3, 4, 6 and 7, as being unpatentable over Murphy.

II. The provisional obviousness-type double patenting rejection of claims 1 and 3 through 7 over claims 1 through 10, 12 through 14 and 17 of co-pending Application No. 09/572,214 in view of Murphy

This rejection is unsound on its face due to the examiner's failure to analyze each of the rejected claims vis-a-vis individual ones of the co-pending claims of Application No. 09/572,214.

On a more substantive level, in explaining the rejection the examiner seems to have confused the subject matter recited in the rejected claims with that recited in the claims of Application No. 09/572,214 (see the sentence bridging pages 3 and 4 in the answer). Suffice to say, however, that none of the claims in Application No. 09/572,214 contains limitations corresponding to those in rejected independent claims 1 and 5 relating to the tray and to the substantially equal planar or surface area sizes. The examiner's reliance on Murphy to overcome these deficiencies is ill founded for the reasons discussed above in connection with the § 103(a) rejection.

Consequently, we also shall not sustain the standing provisional obviousness-type double patenting rejection of claims 1 and 3 through 7 over claims 1 through 10, 12 through 14 and 17 of co-pending Application No. 09/572,214 in view of Murphy.

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SUMMARY

The decision of the examiner to reject claims 1 and 3 through 7 is reversed.

REVERSED

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
	)	
	)	BOARD OF PATENT
JOHN P. MCQUADE	)	APPEAL AND
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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