

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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte THOMAS D. SYKES

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Appeal No. 1999-1045  
Application No. 08/651,759

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ON BRIEF<sup>1</sup>

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Before COHEN, FRANKFORT, and STAAB, Administrative Patent Judges.  
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 3, 10, 20, and 40 through 55, all of the claims remaining in the application. Entry of an after final amendment to claim 1 (Paper No. 11) was approved by the examiner (Paper No. 12). On page 2 of the examiner's answer (Paper No. 18), the examiner indicated that the rejections of claims 3, 10, 42, 43, 45, 47 through 51, 53, and 55 have been withdrawn, with claims 10 and 47 through 49

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<sup>1</sup> An oral hearing set for December 7, 1999 was waived by appellant (Paper No. 24).

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now being allowed and claims 3, 42, 43, 45, 50, 51, 53, and 55 now being objected to as dependent upon a rejected base claim but allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Appellant's invention pertains to a platform for a hand-controllable data input device used with a microprocessor and an operator's extremity associated with controlling the data input device, and to a platform for a hand-operated pointing device used with a microprocessor and an operator's appendage associated with controlling the pointing device. A basic understanding of the invention can be derived from a reading of exemplary claims 1 and 44, copies of which appear in the APPENDIX to the brief (Paper No. 17).

As evidence of obviousness, the examiner has applied the documents listed below:<sup>2</sup>

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<sup>2</sup> The examiner has listed five references on pages 3 and 4 of the answer (Paper No. 18), however, we have only included herein those documents applied by the examiner in the rejections now before us.

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Brewer	5,355,811	Oct. 18, 1994
Montague	5,562,270	Oct. 8, 1996

The following rejections are before us for review.

Claims 1, 20, 40, 41, 44, and 46 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Brewer.

Claims 52 and 54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brewer in view of Montague.

The full text of the examiner's rejections and response to the argument presented by appellant appears in the answer (Paper No. 18), while the complete statement of appellant's argument can be found in the brief (Paper No. 17).

#### OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellant's specification and claims, the applied teachings,<sup>3</sup> and

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<sup>3</sup> In our evaluation of the applied prior art, we have  
(continued...)

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the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We do not sustain the respective rejections of appellant's claims. Our reasons appear below.

Initially, we note that appellant's underlying specification (page 6) addresses an advantage of "a means whereby the platform can be made more stable by selectively engaging it with an associated desk or other structure." On page 31 of the specification, a pair of forward stems 468 are disclosed, each of which terminate in a mushroom-shaped forward head 469. It is further indicated on page 31 that "[t]his may be covered by a rubber cap if desired." The following passages from the

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<sup>3</sup>(...continued)  
considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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specification (page 31), read in light of the Figure 35 showing, further reveal the disclosed invention,

The forward head 469 can cooperate with, and be stabilized by, a desk or other conventional work surface. More specifically, each forward head 470 is meant to contact a bottom surface 476 of the desk and be wedged behind, for example, a desk drawer 478 or a slide-out keyboard tray such as is known in the art. In this way, the platform K provides an additional work surface that is rigidly positioned in relation to a large work surface.

At this point, we note that an insert 70 (Fig. 2A) of a suitable thermoplastic material provides "friction properties" so as to retard a sliding movement of the base on the thigh of a user. In the embodiment depicted in Figure 36, one or more knobs 508 provide a means for "frictionally" retarding longitudinal movement of a base 498 on a user's thigh.<sup>4</sup>

Independent claim 1 is drawn to a platform for a hand-controllable data input device used with a microprocessor and an

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<sup>4</sup> The specification does not expressly address frictional properties or characteristics with respect to the mushroom-shaped forward head 468, with or without an optional rubber cap thereon. This matter is raised in a "REMAND TO THE EXAMINER" below, relative to the claimed contact surface material being "selected to promote friction".

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operator's extremity associated with controlling the data input device, with the platform comprising, inter alia, a protrusion extending upwards, with a top surface of the protrusion comprising a head having a contact surface adapted for selective positioning against an associated inanimate structure, the contact surface comprising a material selected to promote friction with the associated inanimate structure. Independent claim 20 sets forth a platform for a hand-controllable data input device used with a microprocessor and an operator's extremity associated with controlling the data input device, with the platform comprising, inter alia, a first protrusion extending upward, with a top surface of the first protrusion comprising a head having a contact surface adapted for selective positioning against an associated inanimate structure, the contact surface comprising a layer of material selected to promote friction with the associated inanimate structure. Independent claim 44 is drawn to a platform for a hand-operated pointing device used with a microprocessor and an operator's appendage associated with controlling the pointing device, with the platform comprising, inter alia, two protrusions, the protrusions being adapted for selective positioning against an associated inanimate structure, with a first of the protrusions being located on one side of a

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longitudinal centerline of a support assembly top surface and a second of the protrusions being located on another side of the centerline, each protrusion comprising a head having a top surface comprising a material selected to promote friction with the associated inanimate structure when in contact therewith.

The examiner views the above independent claims as anticipated by the Brewer patent.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. See In re Schrieber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). It must be kept in mind, however, that an anticipation rejection cannot be based upon an ambiguous reference where there is speculation as to what the reference may or may not teach. See In re Turlay, 304 F.2d 893, 899, 134 USPQ 355, 360 (CCPA 1962).

In the present case, a reading of the overall disclosure of Brewer reveals to us that one skilled in the art would not have been taught, with any degree of certainty, as to the material or

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material characteristics of the optional raised edge 18. Basically, all that we know is that the raised edge is manufactured on the top surface of the mouse pad 12 (column 5, lines 36 through 39), with the pad 12 being made of plastic or reinforced foam material (column 5, lines 9 through 12). Thus, it is fair to say that this disclosure does not instruct one skilled in the art as to the material or material characteristics of the raised edge. Since for this reason the evidence before us is deficient, the rejection of claims 1, 20, 40, 41, 44, and 46 under 35 U.S.C. § 102(b) cannot be sustained.

We also cannot sustain the rejection of dependent claims 52 and 54 under 35 U.S.C. § 103(a), for the following reasons. The Montague patent was not applied by the examiner to address the material or characteristics of a platform edge wall. Additionally, we find that its teaching does not, in fact, overcome the particular deficiency of the Brewer patent, as discussed, supra.

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REMAND TO THE EXAMINER

1. The examiner should consider assessing whether the underlying specification provides a sound descriptive basis under 35 U.S.C. § 112, first paragraph, for claim language of, for example, independent claims 1, 20, and 44, i.e., whether the disclosure of this application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter of a head having a contact surface comprising a material selected to promote friction with an associated inanimate structure, rather than the presence or absence of literal support in the specification for the claim language.

2. The examiner should additionally consider evaluating the patentability of, for example, claims 1, 20, and 44 under 35 U.S.C. § 103(a), based upon the mouse pad disclosure of Brewer in light of any known prior art teaching of the material of a peripheral raised edge on a mouse pad (platform) wherein the edge prevents a mouse from falling off the mouse pad.

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In summary, this panel of the board has not sustained each of the examiner's rejections on appeal. Additionally, we have remanded the application to the examiner to consider the matters discussed above.

The decision of the examiner is reversed.

REVERSED AND REMANDED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	

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