

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 41

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILLIAM R. MURRAY, JR.,  
STEWART R. CARL and ARTHUR H. ZARNOWITZ

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Appeal No. 96-4097  
Application 08/138,634<sup>1</sup>

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ON BRIEF

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Before CALVERT, MEISTER and McQUADE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 56 to 63, all of the claims remaining in the application.

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<sup>1</sup>Application for patent filed October 15, 1993. According to appellants, this application is a continuation-in-part of application 08/042,851, filed April 5, 1993, which is a continuation of application 07/824,964, filed January 24, 1992, and a continuation-in-part of application 08/006,311, filed January 19, 1993.

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The invention in issue concerns apparatus for inhibiting the theft of portable equipment, such as computers. The appealed claims are reproduced in the appendix to appellants' brief, except that claim 59 therein does not include the additions made by the amendment filed April 26, 1996 (Paper No. 24).

The references applied in rejecting the appealed claims are:<sup>2</sup>

Wilson	5,082,232	Jan. 21, 1992
Lalanne (French patent)	FR 2,636,686	Mar. 23, 1990
Rimanek (German Patent)	DE 3,824,393	Jul. 27, 1989

The claims on appeal stand rejected as follows:

(1) Claims 56 to 63, unpatentable over Wilson in view of Lalanne under 35 USC § 103;

(2) Claims 59, 61 and 62, anticipated by Rimanek, under 35 USC § 102(b).

Rejection (1)

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<sup>2</sup>Our understanding of the Lalanne and Rimanek references is derived from translations thereof prepared for the PTO, copies of which are forwarded herewith to appellants. References in this decision to pages and lines of Lalanne or Rimanek are to pages and lines of the translations.

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The examiner's position with regard to this rejection is, in essence, that it would have been obvious to modify the Wilson

apparatus to use a fastener as disclosed by Lalanne instead of Wilson's conventional fastener (screw) 20.

Appellants argue that Lalanne is not relevant, i.e., nonanalogous, prior art. It is unnecessary to resolve this question, however, for even if Lalanne is assumed to be analogous art, we do not consider that the claimed subject matter would have been obvious over the combination of Wilson and Lalanne.

If the fastener disclosed by Lalanne were substituted for the connector 20 of Wilson by one of ordinary skill in the art, the resulting structure would not, in our view, meet the limitations of the appealed claims. Looking first at the device disclosed by Wilson, the apertured members 16, 26, do not physically coact with the screw 20 to prevent it from being rotated, but simply block access to the screw head, so that the screw cannot be removed. Thus element 16 is fixed to the device (object) 14 by the screw 20, and element 26 is a

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cover which fits over 16 and along with blocker 24, prevents removal of the screw. This is unlike the claimed apparatus, in which the apertures are formed in the slot engagement member and in the housing carrying the pin, which also extends into the slot and

coacts with the slot engagement member to prevent its removal from the slot.

The fastener disclosed by Lalanne has a shaft 1 carrying at its end a bar 3 which is passed through slot 10 and is turned 90 degrees to prevent removal (Fig. 2). A member 5 is rotatably mounted on shaft 1 and has a pin 9 which fits the slot 10. If one of ordinary skill were to substitute Lalanne's fastener for Wilson's screw connector 20, the lower end of member 16 might be modified to include pin 9 of Lalanne. However, in accordance with Wilson's disclosure, the aperture alignable with the aperture in member 16 would still be the aperture in cover 26, there being no teaching or suggestion in either reference of providing an aperture in the connector *per se* which would be alignable with the aperture 22

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of Wilson to prevent rotation of the connector. While Lalanne does disclose an aperture 15 in the lug 14 by which the bar 3 is turned, the purpose of this aperture is not disclosed, and it is evidently simply a hole for attaching a device to be supported by the fastener (see page 6, last three lines). We find no suggestion in either reference of providing apertures in the slot engagement member and in the housing

carrying the pin, such that the apertures would be coaxial (claim 56) or aligned (claim 59) when the pin extends into the slot. The conceptual figures on page 5 of the examiner's answer appear to be based on impermissible hindsight gleaned from appellants' disclosure, rather than on the knowledge available in the prior art.

Accordingly, rejection (1) will not be sustained.

Rejection (2)

In order to anticipate a claim, "a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently". *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). In the

present case, the examiner explains on pages 7 and 8 of the supplemental answer how she considers that claim 59 reads on Rimanek, and we are generally in agreement with her analysis.

Appellants argue that Rimanek does not disclose all the elements recited in claim 59 because (supplemental reply brief, page 2):

Claim 59 requires the engagement of the inner surface of an external wall inhibits removal of the slot engaging member. By contrast, in Rimanek, it is clamp piece 4 that directly prevents locking element 5 from being removed rather than engagement to the inner surface of an external wall.

We do not agree. The engagement of the end 6 of Rimanek's slot engagement member 5 with the wall, as shown in Fig. 2, clearly inhibits its removal from the slot, as recited in claim 59; otherwise, the device could be removed from the slot even when pin 4 was in the Fig. 2 position.

Appellants further argue that element 4 of Rimanek does not correspond to the pin recited in claim 59 because it does not inhibit the slot engaging member from returning to its first position wherein it is aligned with the slot. This argument is not well taken. As shown in Rimanek's Fig. 3 and disclosed at page 3, lines 18 to 20, element 4 maintains the

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member 5 in its misaligned position engaged with the inner wall surface, inhibiting it from returning to its first position, shown in Fig. 1, where it is aligned with the slot. Element 4 of Rimanek therefore corresponds to the pin as defined in claim 59.

Since Rimanek discloses every limitation of claim 59, and appellants do not argue that claims 61 and 62 are separately patentable, rejection (2) will be sustained.

Conclusion

The examiner's decision to reject claims 56 to 63 under 35 USC § 103 is reversed, and to reject claims 59, 61 and 62 under 35 USC § 102(b) is affirmed.

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

AFFIRMED-IN-PART

IAN A. CALVERT )  
Administrative Patent Judge )  
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