

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SCOTT A. NELSON, JAMES C. LEE
and MICHAEL A. HELGESON

Appeal No. 2002-1995
Application No. 09/071,488

ON BRIEF

Before KRASS, FLEMING and RUGGIERO, Administrative Patent Judges.
KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-9, 14-18, and 21-24. Claim 19 stands withdrawn and forms no part of this appeal.

The invention is directed to a handheld apparatus that is part of a computer processing unit, able to receive information from the processing unit. In particular, the device incorporates

navigational input tools that comprise a mouse including a force actuated pointer integrated within the housing of the device such that a user may grasp the housing while simultaneously operating the navigational input tools.

Representative independent claim 1 is reproduced as follows:

1. A computer apparatus comprising:

a computer processing unit, the computer processing unit including a processor device for operating upon data and providing data for display; and

a handheld input/output display unit, the display unit comprising:

a housing sized to be grasped by a user's single hand, wherein the housing includes an upper surface, a lower surface, and an eyepiece,

a computer display located within the housing at a position to allow the user to view the computer display through the eyepiece,

a display driver for presenting data from the processing unit on the computer display, and

navigational input tools for navigating in computer program applications integrated with the computer display in the housing and operatively connected to provide user input to the processing unit, wherein the navigational input tools comprise a mouse including a force actuated pointer integrated within the housing for operation at the upper surface thereof, and further wherein the navigational input tools including the mouse are positioned for operation by one or more fingers of the user's single hand such that the user's single hand can simultaneously grasp the housing and operate the navigational input tools.

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The examiner relies on the following references:

Matthews	5,432,510	Jul. 11, 1995
Michel et al. (Michel)	5,579,165	Nov. 26, 1996
Durrett	5,964,830	Oct. 12, 1999

(filed Aug. 20, 1996)

Claims 1-9, 14-18, and 21-24 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner cites Michel with regard to claims 1-9, 15-18, and 21-23, adding Durrett with regard to claims 2, 14, 16, and 24. The examiner further offers Michel and Matthews with regard to claims 7-9, and 21-23.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

At the outset, we note that the invention of the instant application is similar to the invention which was the subject matter of our earlier decision in Application Serial No. 09/071,489 (Appeal No. 2003-0167). That decision was rendered on Nov. 26, 2003.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth

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in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden 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 Id.; In re Hedges, 783 F.2d 1038, 1040, 228 USPQ 685, 687 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472,

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223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 146-147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR 1.192 (a)].

We have reviewed the evidence in the case, including the arguments of appellants and the examiner and we conclude that, unlike our decision in Application Serial No. 09/071,489, the examiner in the instant case has *not* established a prima facie case of obviousness with regard to the instant claimed subject matter.

Similar to the issues in the previous case, appellants and the examiner argue the "single hand" limitation.

While appellants argue that the device in Michel is not operable with a single hand wherein a user simultaneously grasps and operates a user input interface, the examiner urges that Michel shows a user grasping the housing of the device in his right hand in Figure 8 (see answer-page 3). While Figure 8 of Michel appears to show a user employing both hands, this would also entail the use of a single hand.

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It is appellants' position that the examiner is arguing that there is a missing element in Michel "(a handheld apparatus that can be grasped by a single hand of a user, that has navigational input tools integrated within the housing with the computer display, and that has navigational input tools which are positioned for operation by one or more fingers of the user's single hand such that the user's single hand can simultaneously grasp the housing and operate the navigational input tools to navigate in computer program applications)" (principal brief-page 6) but since the reference does not prohibit this missing element, it essentially shows the missing element. Appellants state that "To assert that a reference shows a missing element by indicating that the reference does not prohibit this element from being carried out goes directly against the reason for having the required teaching or suggestion requirement in the first place" (principal brief-page 6).

We disagree. Figure 8 of Michel may show two hands holding the device but artisans would have understood that one hand may hold the device 32 of Figure 5b and simultaneously operate the buttons on one side of the device, much like using two hands on a steering wheel to steer a vehicle even though one hand on the steering wheel is sufficient.

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The examiner is not suggesting that the lack of teaching of the use of a single hand to hold the device in Michel actually provides such a teaching. Rather, the examiner is urging, and we agree, that the artisan viewing the teachings of Michel would have found it obvious to hold device 32 in one hand and simultaneously operate buttons on one side of the device with that single hand.

Appellants argue that Michel is silent as to whether an individual can grasp and navigate the prior art device with a single hand (principal brief-page 7), but it is our opinion that Michel clearly implies, from the drawing in Figure 5b, that the device may be operated with one hand if only the buttons on one side of device 32 are to be operated.

Appellants allege that Michel actually "teaches away" from the claimed invention (principal brief-page 7). We disagree. Michel discloses nowhere that only two hands *must* be used and that a single hand could not hold and operate the device. If the reference did have such a disclosure, this might be construed as a *teaching away*. However, Michel contains no such disclosure.

Appellants argue that operating the device of Michel with a single hand would change the principle of operation of the device (principal brief-page 7). We disagree. It is not understood how

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operating the device with a single hand would change any operation of the buttons, especially the buttons on one side of the device still being operated by the single hand. While appellants indicate that a single hand grasping Michel's device could not simultaneously grasp the device and operate the buttons to navigate in computer program applications, it appears to us that a user can grasp the binocular device in Michel's Figure 5b with a single hand with fingers on the buttons on one side of the device.

Thus, for the same reasons we enunciated in the prior decision of November 26, 2003, in Application Serial No. 09/071,489 (Appeal No. 2003-0167), we are not persuaded by appellants' arguments regarding the "single hand" limitation.

However, we are persuaded by appellants' argument, at page 8 et seq. of the principal brief, regarding the "mouse" limitation.

Each of the instant independent claims 1 and 15, and hence each claim on appeal, requires that the navigational input tools comprise a "mouse including a force actuated pointer" integrated within the housing.

Clearly, Michel discloses no such mouse, but the examiner asserts that Michel "inherently includes...the claimed navigational tools...including the claimed mouse (a user input

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device comprising buttons 44 and 45, see fig. 5b), which includes the claimed force actuated pointer (a movement cursor button 44, col. 8, line 54)" (answer-page 3).

The examiner further explains that the disclosed mouse is not like the well-known mouse which has a rotatable ball and buttons and moves in contact with a working surface in order to navigate computer program applications. Accordingly, the examiner takes the position that "any user input interface, which includes an equivalent pointer actuator and an equivalent single-button actuator, for navigating in computer program applications, is considered to be a mouse of this pending application" (answer-page 10).

In our view, the examiner takes an unreasonable position regarding the claimed "mouse" in view of the instant disclosure. It is clear from page 14, lines 14-16, and page 16, lines 19-21, of the instant specification, that, contrary to the examiner's position, the "mouse" envisioned for use in the instant invention is, indeed, a "well-known" mouse, i.e., it has the "look-and-feel" similar to the conventional graphical user interfaces. The instant specification even gives a specific embodiment, with the citation of a Hula Point Hall effect mouse pointing device. Moreover, Figure 7 shows the mouse at element 59. With such

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evidence in the instant disclosure buttressing the meaning of the claimed "mouse including a force actuated pointer," it is simply unreasonable for the examiner to take the position that "any user input interface, which includes an equivalent pointer actuator and an equivalent single-button actuator, for navigating in computer program applications, is considered to be a mouse of this pending application."

Still further, the examiner asserted that Michel "inherently" includes the claimed mouse. Inherency may not be established by probabilities or possibilities. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). Inherency requires that a thing *must*, necessarily occur or exist. There is no reason that a mouse must necessarily exist in Michel. Accordingly, the examiner's reliance on inherency is misplaced.

Since Michel clearly fails to disclose or suggest the claimed mouse including a force actuated pointer, and neither Durrett nor Matthews is of any help in this regard, we will not sustain the rejection of any of claims 1-9, 14-18, and 21-24 under 35 U.S.C. § 103.

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The examiner's decision is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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MICHAEL R. FLEMING)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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