

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DAVID D. MURESAN and DAVID MURESAN

Appeal No. 2004-1621
Application No. 08/653,425

HEARD: February 10, 2005

Before BARRETT, BARRY, and LEVY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claim 1. The appellants appeal therefrom under 35 U.S.C. § 134(a). We reverse.

BACKGROUND

The invention at issue on appeal is a mouse for moving a cursor on the display of a computer. In a conventional mouse, as shown in Figure 1¹ of the appellant's specification, a wheel presses a rubber ball against X- and Y-coordinate shafts. As the

¹Because it only shows technology that was known, Figure 1 should be "designated by a legend such as 'Prior Art.'" M.P.E.P. § 608.02(g).

mouse is moved on a surface, the ball rotates the shafts. Because of friction between the ball and the wheel, assert the appellants, the mouse often sticks, and the wheel requires cleaning. (Substitute Spec. at 2.)

In contrast, the appellants' mouse employs a magnet and a ball having a magnetically sensitive core. As shown in Figure 2 of their specification, the magnet creates a force that pulls the ball against X- and Y-coordinate shafts of the mouse. Because the magnet does not touch the ball, no friction is created therebetween. (*Id.* at 3.)

A further understanding of the invention can be achieved by reading the only claim, which follows:

1. A computer mouse characterized by using a magnet, to pull the rubber magnetic core ball against the coordinates X and Y shafts² only; and

there is no third, or any other contact between the ball and any other part of the mouse, especially no third contact between the ball and another wheel (Fig. 2).

² We cannot help but notice the claim's lack of antecedent basis for the limitations of "the rubber magnetic core ball" (emphasis added) and "the coordinates X and Y shafts" (emphasis added). See M.P.E.P. § 2173.05(e). The examiner and the appellants may wish to assess the definiteness of the claim in view of these problems.

Claim 1 stands rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 5,696,537 ("Solhjell").

OPINION

Rather than reiterate the positions of the examiner or the appellants *in toto*, we focus on the point of contention therebetween. Finding that "Solhjell discloses a computer mouse having a magnetic care [sic, core] ball (64 in Fig. 11)," (Examiner's Answer at 3 (quoting Final Rej.)), the examiner concludes, "[a] third contact (the free rolling 18 as shown in Fig. 5) is replaced with a magnet (66 in fig. 11), therefore, there is no third contact between the ball and another wheel as claimed." (*Id.*) The appellants argue, "there is no explicit mention of the removal of the free roller," (Appeal Br. at 4), and "there is no implicit argument of the removal of the free roller. . . ." (*Id.* at 4-5.)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the claim at issue to determine its scope. Second, we determine whether the construed claim is anticipated.

1. CLAIM CONSTRUCTION

"Analysis begins with a key legal question — *what is the invention claimed?*" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed.

Cir. 1987). In answering the question, "[t]he Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1021, 1034 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983)).

Here, claim 1 recites in pertinent part the following negative limitations: "there is no third, or any other contact between the ball and any other part of the mouse, especially no third contact between the ball and another wheel. . . ." Considering these limitations, claim 1 excludes contact between the ball of a mouse and any wheel besides X- and Y-coordinate shafts.

2. ANTICIPATION DETERMINATION

"Having construed the claim limitations at issue, we now compare the claims to the prior art to determine if the prior art anticipates those claims." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (citing *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 715, 223 USPQ 1264, 1270 (Fed. Cir. 1984); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220

USPQ 193, 198 (Fed. Cir. 1983); *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983)). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (quoting *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)) "Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (citing *Hansgirk v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (Cust. & Pat.App. 1939)).

Here, Solhjell "relates to a mouse used for data entry into a computer system." Col. 1, ll. 7-8. A "ball is mounted on the bottom side of the mouse housing." *Id.* at ll. 25-26. "[T]he ball is touching three or four rollers, where one or two such as 18 in FIG. 5 are freerolling and the other two such as 16, 17 in FIG. 5 are connected to systems for detecting the direction of the revolution of the roller and the length of rolling. One of these detection rollers is referred to as the x-axis controller 16 and the other one (90 degrees off the x-axis roller) is referred to as the y-axis controller 17 (see FIG. 5)." Col. 2, ll. 24-31.

Figure 11 of the reference, on which the examiner relies, "shows [an] embodiment for controlling the force required to move the ball 64. The basic principle is shown in the Figure. The mouse ball 64 contains internally a core 65 (another ball) made of iron or similar magnetic sensitive material. A magnet 66 is placed in the mouse housing outside the ball 64. The magnet will attract the iron core 65 of the ball 64." Col. 4, ll. 61-66. "The distance between the magnet 66 and the ball 64 is adjustable with a screw 67 mounted on a support 68 or similar means. . . ." *Id.* at ll. 66 - col. 5, l. 1. "A force is required to rotate the ball, the force increasing as the magnet is moved closer to the ball." Col. 5, ll. 2-4.

Although Figure 11 shows a magnet 66, we are unpersuaded that Solhjell replaces the free roller 18 shown in Figure 5 with that magnet. To the contrary, we agree with the appellants that "there is no explicit discussion of the replacement of the free [roller] in the description of Fig. 11." (Appeal Br. at 4.) We also agree with them

that, because "[t]he rolling force and the third wheel are not mutually exclusive," (Appeal Br. at 4), "controlling the rolling force does not mean that the third wheel is replaced." (*Id.*) To control the force required to move the mouse's ball, the magnet could easily be added to the assembly shown in Figure 5.

The absence of evidence showing that Solhjell replaces the free roller 18 shown in Figure 5 with the magnet 66 shown in Figure 11 "negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986). Therefore, we reverse the anticipation rejection of claim 1.

CONCLUSION

In summary, the rejection of claim 1 under § 102(e) is reversed.

REVERSED

LEE E. BARRETT
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

STUART S. LEVY
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)

Appeal No. 2004-1621
Application No. 08/653,425

Page 9

DAVID MURESAN
18204 30TH AVE NE
SEATTLE, WA 98155