

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID GOLDBERG, KENNETH P. FISHKIN,
ANUJ UDAY GUJAR, ELIZABETH D. MYNATT and ROY WANT

Appeal No. 2005-1687
Application 09/682,333

ON BRIEF

Before KRASS, BLANKENSHIP, and MACDONALD, **Administrative Patent Judges**.

MACDONALD, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-11.

Invention

In various exemplary embodiments, the systems and methods of this invention allow an individual user (i.e. "the user") to control one or more processes or functions in one or more first physical devices, such as, for example, one or more computers, by changing the location or placement of one or more second "reified" physical devices relative to the first physical device, such as, for example, the placement of a second physical device on the computer case.

The manipulative user interface (MUI) according to this invention includes at least two devices, in which a device uses a manipulative user interface to control its interaction with another device when the first is brought next to, or taken away from, the other device, which may or may not itself have a manipulative user interface. Appellants' specification at page 2, paragraphs 0007 and 0008.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A method of transferring information about a user of a responsive object to that responsive object, comprising:

storing information about the user in a physically manipulatable device;

providing a manipulative user interface between the responsive device and the physically manipulative device;

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placing an object relative to the physically manipulatable device;

wherein relatively placing the object and the physically manipulatable device and/or physically manipulating the object communicates at least some of the stored information about the user to the responsive device.

References

The references relied on by the Examiner are as follows:

Woolston	5,845,265	Dec. 1, 1998
Shintani	6,137,480	Oct. 24, 2000
Gershon	6,257,984	Jul. 10, 2001

Rejections At Issue

Claims 1-3 and 5-7 stand rejected under 35 U.S.C. § 102 as being anticipated by Shintani.

Claims 4 and 8-10 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Shintani and Woolston.

Claim 11 stands rejected under 35 U.S.C. § 103 as being obvious over the combination of Shintani and Gershon.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.¹

¹Appellants filed an appeal brief on May 17, 2004. Appellants filed a reply brief on August 23, 2004. The Examiner mailed an Examiner's Answer on July 21, 2004.

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated infra, we reverse the Examiner's rejection of claims 1-3 and 5-7 under 35 U.S.C. § 102, and we reverse the Examiner's rejection of claims 4 and 8-11 under 35 U.S.C. § 103.

We also use our authority under 37 CFR § 41.50(b) to enter a new grounds of rejection of claims 1-11. The basis for this is set forth in detail below.

Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

Appellants have indicated that for purposes of this appeal the claims stand or fall together in three groupings. See page 5 of the brief. However, Appellants fail to argue each group of claims separately and explain why the claims of each group are believed to be separately patentable. See pages 5-14 of the brief and pages 1-5 of the reply brief. Rather, Appellants' arguments correspond to the three rejections noted above. See

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pages 8, 12, and 13 of the brief. Therefore, as to the groups proposed by Appellants, Appellants have not met the requirements of 37 CFR § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellants' filing of the brief. 37 CFR § 1.192 (c)(7) states:

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider Appellants' claims as standing or falling together in three groups corresponding to the three rejections noted above, and we will treat:

Claim 1 as a representative claim of Group I;
Claim 4 as a representative claim of Group II; and
Claim 11 as a representative claim of Group III.

If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal

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of that rejection based solely on the selected representative claim. **In re McDaniel**, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). **See also In re Watts**, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

I. Whether the Rejection of Claims 1-3 and 5-7 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Shintani does not fully meet the invention as recited in claims 1-3 and 5-7. Accordingly, we reverse.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. **See In re King**, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and **Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.**, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

With respect to independent claim 1, Appellants argue at page 8 of the brief, "Shintani fails to teach 'storing information about the user in a physically manipulatable device,' as recited in claim 1." Notwithstanding the Examiner's attempt to argue around this failing of Shintani (answer at page 5), we

must

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agree with Appellants. This panel recognizes that it is old and well known to buffer data in a keyboard (physically manipulatable device) such as Shintani's. However, we also recognize that buffering not absolutely required and is therefore not inherent to Shintani. The examiner's position is valid only if such buffering is inherent. This gap in the record before us can only be overcome by providing keyboard-buffering references in a rejection under 35 U.S.C. § 103. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 102.

We also note Appellants' argument at page 10 of the brief, that "the keyboard 3 is not a reified device." We find this argument has no merit as the term "reified" is descriptive of the information (nonfunctional descriptive material) rather than to the physical structure or function of the device. That is, it is a "reified" device because it stores "reified" information. Such a distinction cannot serve to distinguish over the prior art where the information does not change the structure or function. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. **In re Ngai**, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). Cf. **In re Gulack**, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir.

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1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

II. Whether the Rejection of Claims 4 and 8-10 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 4 and 8-10. Accordingly, we reverse.

With respect to dependent claims 4 and 8-10, we note that the Examiner has relied on the Woolston reference solely to teach "an asset of a user" [answer, page 4]. The Woolston reference in combination with the Shintani fails to cure the deficiencies of Shintani noted above with respect to claims 1-3 and 5-7.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above.

III. Whether the Rejection of Claim 11 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claim 11. Accordingly, we reverse.

With respect to dependent claim 11, we note that the Examiner has relied on the Gershon reference solely to teach "a hat" [answer, page 4]. The Gershon reference in combination with the Shintani reference fails to cure the deficiencies of Shintani noted above with respect to claim 1. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above.

We also note that Appellants argue at page 14 of the brief and page 5 of the reply brief that mounting the card on a hat does not make the card a hat. We find this unpersuasive. We do not adopt Appellants' perspective of the Gershon invention. Rather, we choose to look at this from the perspective of the hat. We find that an unadorned hat remains a hat even after the card is attached. Further, the attached card becomes an integral part of the hat to which it is attached. Therefore, we find the Examiner's position on this point to be well founded.

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IV. Rejection of Claims 1-11 Under 37 CFR § 41.50(b).

We make the following new grounds of rejection using our authority under 37 CFR § 41.50(b).

Claims 1-11 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

All of the claims recite that the object is physically manipulated or physically manipulating the object. Nothing in the specification as originally filed even hints at such a feature. Rather, the object (e.g., a hat in claim 11) is static and is placed relative to the physically manipulatable device.

Also we note that claim 1 has a typographical error in line 5 in that "physically manipulative device" should read "physically manipulatable device".

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Conclusion

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 102 of claims 1-3 and 5-7; we have not sustained the rejection under 35 U.S.C. § 103 of claims 4 and 8-11; and we have entered a new grounds of rejection against claims 1-11 under 37 CFR § 41.50(b).

As indicated supra, this decision contains a new grounds of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, by final rule notice, 69 Fed. Reg 49960, 50008 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21, 61 (September 7, 2004)). 37 CFR § 41.50(b) provides that, "[a] new grounds of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 CFR § 1.197 (b) (amended effective September 13, 2004)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . .

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(2) Request that the proceeding be reheard under 37 CFR
§ 41.52 by the Board upon the same record . . .

REVERSED
37 CFR § 41.50(b)

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
HOWARD B. BLANKENSHIP)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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ALLEN R. MACDONALD)	
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