

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 DAAN LINDHOUT, TIMOTHY MICHAEL MUSS, STEVEN N. BATHICHE,
STEVEN W. FISHER, and KENNETH P. HINCKLEY

Appeal No. 2006-2255
Application No. 10/183,994

ON BRIEF

Before RUGGIERO, BLANKENSHIP, and MACDONALD, Administrative Patent Judges.
BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-36, which are all the claims in the application.

We reverse.

BACKGROUND

The invention relates to a scrolling apparatus for moving an image in multiple directions relative to a display screen. The apparatus may be incorporated into an input device for a computer. Representative claim 1 is reproduced below.

1. An apparatus for scrolling an image in multiple directions relative to a display screen, said apparatus comprising:

a housing having at least one aperture therein;

a tracking assembly at least partially located within the housing for detecting movement of the housing relative to a support surface;

a rotatable member at least partially located within the housing, a portion of the rotatable member protruding outward through the aperture;

at least one depressible actuator extending around the rotatable member and positioned immediately adjacent to the rotatable member; and

a directional switch located within the housing for detecting depressions of the actuator.

The examiner relies on the following references:

Schein et al. (Schein)	US 6,075,575	Jun. 13, 2000
Suzuki	US 6,097,372	Aug. 1, 2000
Armstrong	US 6,198,473 B1	Mar. 6, 2001

Claims 1-32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Schein and Appellants' Admitted Prior Art (APA) in the instant specification.

Claims 1-36 stand rejected under 35 U.S.C. § 103 as being unpatentable over Schein and Armstrong.

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Claims 3, 8, 11, 17, and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Schein, APA, and Suzuki or over Schein, Armstrong, and Suzuki.

We refer to the Final Rejection (mailed Feb. 7, 2005) and the Examiner's Answer (mailed Jan. 24, 2006) for a statement of the examiner's position and to the Brief (filed Sep. 19, 2005) and the Reply Brief (filed Mar. 24, 2006) for appellants' position with respect to the claims which stand rejected.

OPINION

Schein describes a remote control device 2 (Fig. 1) that is particularly suited for controlling a visual interface in a television schedule information system. According to the reference, the casing will usually resemble the generally rectangular shape of typical television remote control devices, but may also be similar to other conventional input devices such as a mouse, joystick, or computer keyboard. Col. 4, ll. 25-32. The controller may comprise a trackball, cursor controller, or a pointing device. In the preferred embodiment, the controller comprises a scrolling mechanism for displacing a movable cursor through a matrix of cells or windows on the screen. Id. at ll. 35-41.

The vertical scroll mechanism is preferably a rolling cylinder 24 (Fig. 2) rotatably mounted to casing 4. Rotation of cylinder 24 moves the cursor vertically through the window or menu of the display screen. Col. 5, ll. 14-18. A horizontal scroll mechanism preferably includes buttons 32, 34 located on either side of rolling cylinder 24. The

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cursor control mechanism also includes global controller 22 comprising a screen navigation ring 40 having a plurality of direction buttons 42. Id. at II. 56-64.

In the rejection of claims 1-32 under 35 U.S.C. § 103 as being unpatentable over Schein and APA, the examiner finds that Schein fails to disclose a tracking assembly for detecting movement of the housing relative to a support surface. However, such tracking assemblies were known in the prior art (e.g., APA). According to the rejection, it would have been obvious to include the tracking assembly in the Schein apparatus in view of APA and a teaching at column 7 of Schein.

In another embodiment, computer system 62 [Fig. 3] may be combined with television system 60 to form a PCTV. In this embodiment, the computer will usually include a processor that may be used solely to run the program guide and associated software, or the processor may be configured to run other applications, such as word processing, graphics, or the like. The computer will usually be incorporated into the television set so that the television display can be used as both a television screen and a computer monitor. Usually, the PCTV will include a number of input devices, such as a keyboard, a mouse and a remote control device, similar to the one described above. *However, these input devices may be combined into a single device that inputs commands with keys, a trackball, pointing device, scrolling mechanism, voice activation or a combination thereof.*

Schein col. 7, ll. 12-26 (emphasis added).

Appellants, for their part, argue that the proposed combination would not have been obvious because the addition of a prior art tracking assembly to the Schein device would constitute redundancy. According to appellants, Schein already provides a complete system for controlling movement of a cursor. (Brief at 6.)

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We agree with appellants that the applied prior art fails to support the combination proposed by the rejection. The above-quoted column 7 section of Schein is a teaching that does support, to some degree, the combination that is contemplated. Schein suggests that a keyboard, a mouse, and a remote control device as described in the reference could be combined into a single device. However, Schein discloses, expressly, how one might combine the three devices: with keys, a trackball, pointing device, scrolling mechanism, voice activation, or a combination thereof. On this record, a trackball (e.g., Suzuki Fig. 1) serves to move a cursor vertically and horizontally, but does not serve to detect movement of the housing relative to a support surface, as does a tracking assembly contained within a mouse as known in the prior art. We do not find suggestion for combining a tracking assembly and the scroll mechanisms described by Schein in a common housing. In view of the evidence provided, we conclude that such combination could only arise from an improper hindsight reconstruction of appellants' invention.

We therefore do not sustain the rejection of claims 1-26 under 35 U.S.C. § 103 as being unpatentable over Schein and APA, as independent claims 1, 9, 13, 18, and 23 are drawn to combinations that include members and actuators that may read on corresponding elements of Schein, but each claimed combination includes a tracking assembly for detecting movement of the housing relative to a support surface. Nor do we sustain the rejection of claims 1-26 under 35 U.S.C. § 103 as being unpatentable over Schein and Armstrong, because Armstrong's teachings (e.g., col. 1, ll. 31-45) with

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respect to a tracking assembly in a computer mouse are no more helpful than the teachings of a tracking assembly in APA. Further, we do not sustain the rejection of dependent claims 3, 8, 11, 17, and 25, since Suzuki does not remedy the deficiencies in the rejections applied against the base claims.

As for independent claim 27, APA is deemed to teach a scrolling signal for scrolling the image on a display independent of movement of a cursor (Answer at 4) and Armstrong is relied upon for a similar teaching (*id.* at 5.) As appellants note (Brief at 9), however, the “scrolling” described by Schein refers to movement of a cursor on a screen, rather than movement of an image independent of movement of a cursor. We agree with appellants to the extent that we find insufficient evidence on this record for a suggestion to combine the method described by Schein with the type of scrolling required by instant claim 27 so as to meet the terms of the claim. We thus do not sustain the rejection of claim 27 or of claims 28-32, each incorporating the limitations of claim 27.

Independent claim 33 is rejected under 35 U.S.C. § 103 over the combination of Schein and Armstrong. The claim requires, *inter alia*, that the rotatable member and the actuator scroll the image independent of movement of a cursor or a pointer rendered on the display screen. As we are not persuaded that the structures described by Schein may be properly modified in view of the prior art teachings relating to scrolling an image independent of the cursor in such a way to meet the terms of the claim, we do not sustain the rejection of claim 33, nor of claims 34-36 depending therefrom.

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CONCLUSION

Since we have not sustained the rejection of any claim on appeal, the rejection of claims 1-36 under 35 U.S.C. § 103 is reversed.

REVERSED

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