

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FARID MATTA and JONAH HARLEY

Appeal 2007-2151
Application 10/902,909¹
Technology Center 2600

Decided: February 28, 2008

Before LEE E. BARRETT, JOSEPH L. DIXON, and SCOTT R. BOALICK,
Administrative Patent Judges.

BOALICK, *Administrative Patent Judge.*

¹ Application filed July 29, 2004. The real party in interest is Avago Technologies, LTD.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-9.² We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

STATEMENT OF THE CASE

Appellants' invention relates to a pointing device. Claim 1 is exemplary:

1. A pointing device, comprising:
 - first and second belt guides;
 - a first belt wrapped around said belt guides and having a slot therein having a first direction;
 - a movable puck engaged with said slot;
 - a spring system structured to return said puck to an equilibrium position when said puck is released from a position displaced from said equilibrium position; and
 - a sensor that measures the position of said puck.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Clark	US 4,692,756	Sep. 8, 1987
Sakamaki	US 6,839,050 B2	Jan. 4, 2005

² Claims 1-10 are pending, claim 10 has been allowed.

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being obvious over Clark and Sakamaki.

Claims 1-9 stand rejected under 35 U.S.C. § 103(a) as being obvious over Sakamaki.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details.

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue turns on whether Clark and Sakamaki, alone or in combination, teach or suggest "a first belt . . . having a slot therein," as claimed.

PRINCIPLES OF LAW

In the examination of a patent application, the Examiner bears the initial burden of showing a prima facie case of unpatentability. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). When that burden is met, the burden then shifts to the applicant to rebut. *Id.*; *see also In re Harris*, 409 F.3d 1339, 1343-44 (Fed. Cir. 2005) (finding rebuttal evidence unpersuasive). If the applicant produces rebuttal evidence of adequate weight, the prima facie case of unpatentability is dissipated. *In re Piasecki*, 745 F.2d at 1472. Thereafter, patentability is determined in view of the entire record. *Id.* However, on appeal to the Board it is an appellant's burden to establish that the Examiner did not sustain the necessary burden and to show that the Examiner erred. *See In re Kahn*, 441 F.3d 977, 985-86

(Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [for obviousness] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls."). The Court in *Graham* further noted that evidence of secondary considerations, such as commercial success, long felt but unsolved needs, failure of others, etc., "might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." 383 U.S. at 17-18.

ANALYSIS

Appellants contend that the Examiner erred in rejecting claims 1-9.
We agree.

Regarding claim 1, the Examiner found that Clark teaches a belt (flexible sleeve 11) having a slot (window area 18 or channel 15) therein. (Ans. 3, 9-10.) The Examiner also found that Sakamaki teaches a belt (rotary belt 60) having a slot (slot 52) therein. (Ans. 4-5, 13.) Appellants argue that the Examiner has misread Clark and Sakamaki, and that neither discloses or suggests a belt having a slot therein. (App. Br. 4-5, 7-8; Reply Br. 1-2.) We agree with Appellants.

The plain language of claim 1 requires a slot in the first belt. With respect to Clark, window area 18 is not a slot in the sleeve 11. Instead, window area 18 is a slot in plate 17, which corresponds to a panel 6 or 7 of the console 3. (Clark, col. 4, ll. 46-49; Figs. 1-3) As shown in Fig. 3 of Clark, sleeve 11 slides underneath the window area 18 of plate 17. Furthermore, channel 15 is not a slot in the sleeve 11. Instead, channel 15 is a slot in the block 12 over which sleeve 11 slides. (Clark, col. 4, ll. 8-14 and 23-29.) A spring-loaded bar 16 is provided in channel 15 to tension the sleeve 11. (Clark, col. 4, ll. 24-27.) The Examiner has not pointed to, nor do we find, any other teaching or suggestion in Clark of a slot in a belt. Therefore, Clark does not disclose or suggest a first belt having a slot therein, as claimed.

With respect to Sakamaki, the slot 52 is not a slot in the belt 60. Instead, slide control knob 53 slides along slot 52 and is attached to one end of a movable arm 54 that extends from the inside of the device casing. (Sakamaki, col. 8, ll. 18-22; Figs. 9, 11.) Inside the device casing, the arm 54 is connected to belt 60. (Sakamaki, col. 8, ll. 31-32; Fig. 11.) We note that Figures 9 and 11 both are directed to embodiment 5 of Sakamaki. (Sakamaki, col. 3, ll. 1-2 and 6-7.) Thus, slot 52 is a slot in the device

Appeal 2007-2151
Application 10/902,909

casing, not a slot in the belt 60. The Examiner has not pointed to, nor do we find, any other teaching or suggestion in Sakamaki of a slot in a belt. Therefore, Sakamaki does not disclose or suggest a first belt having a slot therein, as claimed.

Accordingly, we conclude that Appellants have shown that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a).

Claims 2-9 depend from claim 1, and we conclude that Appellants have shown that the Examiner erred in rejecting claims 2-9 for the same reasons as discussed with respect to claim 1.

CONCLUSION OF LAW

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1-9.

DECISION

The rejection of claim 1-9 for obviousness under 35 U.S.C. § 103 is reversed.

REVERSED

tdl/gw

Appeal 2007-2151
Application 10/902,909

KATHY MANKE
AVAGO TECHNOLOGIES LIMITED
4380 ZIEGLER ROAD
FORTCOLLINGS, CO 80525