

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EVAN F. WIES, DEAN C. CHANG, LOUIS B. ROSENBERG,
SIAN W. TAN, and JEFFREY R. MALLETT

Appeal 2008-2155
Application 10/092,158¹
Technology Center 2400

Decided: November 28, 2008

Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and
JEAN R. HOMERE, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 79 through 105. Claims 1 through 78 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

¹ Filed on March 05, 2002. The real party in interest is Immersion Corp.

The Invention

According to Appellants, the invention relates generally to a human/computer interface with force feedback that can operate over a network. (Spec. 1.)

Representative Claim

Independent claim 79 further illustrates the invention. It reads as follows:

79. A method comprising:
- receiving an input signal from a network, the input signal comprising an embedded force feedback command;
 - extracting the force feedback command from the input signal; and
 - generating an output signal associated with the force feedback command.

Rejection on Appeal

- The Examiner rejects the claims on appeal as follows:
1. Claims 79 through 105 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.
 2. Claims 79 through 105 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to distinctly claim the subject matter, which Appellants regard as their invention.

Appellants' Contentions

Appellants argue that the limitation of receiving an input signal comprising a feedback force command, as recited in independent claim 79, is definite, and is enabled in the Specification. Particularly, Appellants argue that one of ordinary skill would have understood the disclosure of a received webpage defining an authored force effect for a plug-in or associated with a generic force effect implies an input signal embodied in a webpage that defines an embedded force command. (App. Br. 7-12, Reply Br. 4-10.) Accordingly, Appellants submits that the Examiner improperly rejected these claims as not being enabled and definite. (*Id.*)

Examiner's Findings

In response, the Examiner finds that while the webpage disclosed in Appellants' Specification can be construed as including a signal, there is no indication that the disclosed signal is an input signal as claimed. (Ans. 4.) Further, the Examiner finds that the force feedback information for authored effect disclosed in Appellants' Specification cannot be construed as a force feedback command. (*Id.*) Therefore, the Examiner finds that the claimed limitation of receiving an input signal comprising a feedback force command is indefinite, and is not enabled in the Specification.

II. Issue

The pivotal issue before us is whether Appellants have shown that the Examiner erred in concluding that one of ordinary skill would have found

the limitation of receiving an input signal comprising a feedback force command is indefinite and not enabled in Appellants' Specification. We answer this inquiry in the affirmative.

III. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Appellants' Written Description

1. A first client machine (14) communicates with another client machine (16) by sending force feedback commands to each other over the Internet. Particularly, the first client machine can send force feedback commands to the URL of the second client machine. Similarly, the server machine (18) communicates with the other client machines by sending force feedback commands to them. (Spec. 10, ll. 4-13.)

2. As depicted in Figure 3, a force feedback human computer interface (50) is used to send to a user a force feedback (60) representing physical feel or force sensations. (Spec. 11, ll. 7-13.)

IV. PRINCIPLES OF LAW

ENABLEMENT

The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question:

Is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). Therefore, the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463 (Fed. Cir. 1984). The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 504 (CCPA 1976). There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is “undue.” These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;

(E) The level of predictability in the art;
(F) The amount of direction provided by the inventor;
(G) The existence of working examples; and
(H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure. *In re Wands*, 858 F.2d at 737.

A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557,1562 (Fed. Cir. 1993).

V. ANALYSIS

As set forth in the Principles of Law section above, the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosure in the patent coupled with information known in the art without undue experimentation. The determination that “undue experimentation” would have been needed to make and use the claimed invention is not a single, simple factual determination. Rather, it is a conclusion reached by weighing all the above-noted factual considerations. *In re Wands*, 858 F.2d at 737. We find that the Examiner’s enablement rejection fails to weigh these factors to show that the ordinarily skilled artisan would not be able to make or use the claimed input signal including a

feedback force command based on Appellants' Specification without undue experimentation. Further, as set forth in the Findings of Fact section, Appellants' Specification discloses that client machines and server machines on the network communicate with one another by exchanging force feedback commands. (FF. 1-2) We therefore conclude that the ordinarily skilled artisan would readily ascertain from the originally filed disclosure that for a second machine to communicate with a first machine on the network, it must first receive a signal including a force feedback command from the first machine. Therefore, Appellants' disclosure reasonably supports that a signal sent by the first computer is an input signal (to the second machine) that comprises a force feedback command. It follows that Appellants have shown that the Examiner erred in finding that Appellants' Specification does not enable the claimed limitation of receiving an input signal comprising a feedback force command. Therefore, we cannot sustain the Examiner's rejection under 35 U.S.C. § 112, first paragraph.

Since the Examiner's indefiniteness rejection of the cited claims relies upon the same asserted deficiencies from the lack of enablement rejection, we similarly cannot sustain these rejections for the same reasons articulated above.

New ground of rejection

We enter a new ground of rejection pursuant to our authority under 37 C.F.R. § 41.50(b). We reject claims 95 through 102 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 95 through 102 are directed to a “computer-readable medium.” Appellants’ Specification (at 11) defines such a medium as including, at the least, “signal propagated by a carrier wave.” Our reviewing court has found that transitory, propagating signals such as carrier waves are not within any of the four statutory categories (process, machine, manufacture or composition of matter.) Therefore, a claim directed to computer instructions embodied in a signal is not statutory under 35 U.S.C. § 101. *In re Nuijten*, 500 F.3d 1346, 1354 (Fed. Cir. 2007).

VI. CONCLUSIONS OF LAW

1. Appellants have shown that the Examiner erred in concluding that claims 79 through 105 fail to comply with the enablement requirement under 35 U.S.C. § 112, first paragraph.
2. Appellants have shown that the Examiner erred in concluding that claims 79 through 105 are indefinite for failing to distinctly claim the subject matter, which Appellants regard as their invention under 35 U.S.C. § 112, second paragraph.
3. We have entered a new ground of rejection against claims 95 through 105 as being directed to non-statutory subject matter.

4. Because of the new ground of rejection, our decision is not a final agency action.

DECISION

1. We reverse the Examiner's decision rejecting claims 79 through 105.
2. We reject claims 95 through 105.

37 C.F.R. § 41.50(b) provides that, “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, *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 C.F.R. § 1.197 (b)) as to the rejected claims:

- (1) *Reopen prosecution*. 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 ...
- (2) *Request rehearing*. Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record ...

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

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REVERSED

37 C.F.R. § 41.50(b)

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