

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

---

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte FREDERICK D. TAFT

---

Appeal No. 96-1918  
Application 08/196,931<sup>1</sup>

---

ON BRIEF

---

Before HAIRSTON, BARRETT, and GROSS, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

---

<sup>1</sup> Application for patent filed February 14, 1994, entitled "Input Device With Handle."

Appeal No. 96-1918  
Application 08/196,931

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1-10.

We affirm.

BACKGROUND

The disclosed invention is directed to an input device, such as a mouse, having an upright handle to accommodate the finger of a human hand curled about it.

Claim 1 is reproduced below.

1. An input device, comprising:

a base unit movable in an x direction and a y direction;

a position detection mechanism for detecting movement of said base unit in said x direction and said y direction; and

a handle attached to the top of said base unit, said handle having sufficient length and width to accommodate at least three fingers of a human hand curled about it when the wrist of said human hand is positioned perpendicularly to said base unit.

The examiner cites the following prior art as relied upon in the rejections of the claims:

Vanderheiden et al. (Vanderheiden)	3,854,131	December 10, 1974
Loffelholz	4,234,202	November 18, 1980
King et al. (King)	4,759,431	July 26, 1988

Appeal No. 96-1918  
Application 08/196,931

Swinney <sup>2</sup> 1988	4,769,517	September 6,
Selker 1988	4,780,707	October 25,
Gart 1989	4,862,165	August 29,
McGonigal et al. <sup>3</sup> 1991	5,012,048	April 30,
Clark 1992	5,132,672	July 21,
Burger et al. (Burger) 1994	5,311,208	May 10,
		(filed October 3,
1991)		
Nishiwaki et al. (Nishiwaki <sup>4</sup> ) 6, 1985 (Japanese Kokai)	60-126727	July

Claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over Nishiwaki and Clark. In the Examiner's Answer the examiner entered a new ground of rejection of claim 1 under § 103 over Clark alone.

Claims 2 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nishiwaki, Clark, and Burger.

---

<sup>2</sup> Swinney is cited but has not been applied in any ground of rejection in the Final Rejection or the Examiner's Answer.

<sup>3</sup> McGonigal is cited but has not been applied in any ground of rejection in the Final Rejection or the Examiner's Answer.

<sup>4</sup> Our understanding of Nishiwaki is based upon a translation prepared by the Patent and Trademark Office, a copy of which accompanies this decision.

Appeal No. 96-1918  
Application 08/196,931

Claim 3 stands rejected under 35 U.S.C. § 103 as being unpatentable over Nishiwaki, Clark, and Loffelholz.

Claims 4-7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nishiwaki, Clark, and King.

Claims 8 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nishiwaki, Clark, Vanderheiden, and Gart.

We refer to the Final Rejection (Paper No. 6) and the Examiner's Answer (Paper No. 13) (pages referred to as "EA\_\_") for a statement of the examiner's position and to the Brief (Paper No. 12) (pages referred to as "Br\_\_") and the Reply Brief (Paper No. 14) (pages referred to as "RBr\_\_") for a statement of appellant's position.

#### OPINION

Appellant argues claims 1-10 to rise or fall together as a single group (Br3). Therefore, the claims stand or fall together with independent claim 1.

We find that the structure of Nishiwaki and Clark meets the structural limitations of claim 1. The claim limitation of "a handle attached to the top of said base unit, said handle having sufficient length and width to accommodate at

Appeal No. 96-1918  
Application 08/196,931

least three fingers of a human hand curled about it when the wrist of said human hand is positioned perpendicularly to said base unit" defines an intended use for (i.e., a handle), or a structure inherent in, the devices of Nishiwaki and Clark. Statements of intended use do not serve to distinguish structure over the prior art.

In re Pearson, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974); In re Yanush, 477 F.2d 958, 959, 177 USPQ 705, 706 (CCPA 1973); In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967). Thus, because the devices of Nishiwaki and Clark are capable of being used as broadly claimed, claim 1 does not define over these references. There is no need to modify the structure of Nishiwaki or Clark to meet the limitations of claim 1. Cf. In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) ("While Mathis' apparatus may be capable of being modified to run the way Mills' apparatus is claimed, there must be a suggestion or motivation in the reference to do so."). A "new use of a known process, machine, manufacture, composition of matter, or material" must be claimed as a process. 35 U.S.C. § 100(b).

Appeal No. 96-1918  
Application 08/196,931

Clark discloses a housing 12, which detects translational movement in an x direction and a y direction like a mouse. A tower 62 is mounted on the housing 12 and has a finger operated conveyor belt 64 with finger holes 74 for controlling the translation motion of an object on the display of a computer with respect to a third translational axis. Although it is difficult to judge scale, there are five finger holes 74 illustrated in the conveyor belt 64, which suggests that the tower 62 is "at least three fingers of a human hand" in height. Since the tower 62 is upright, the fingers may be curled around the tower when the "hand is positioned perpendicularly to said base unit." The tower 62 could be used as a handle with three fingers wrapped around it with the hand perpendicular to the base. Use limitations do not impart structural features. Therefore, claim 1 does not define structurally over Clark.

Nishiwaki, figure 6, discloses a grip case 35 attached to a base plate 34 which contains a pickup coil 31 to sense the coordinate position. The grip case 35 is described as having a suitable width from 10 mm to 25 mm and a height greater than its width to provide sufficient contact area

Appeal No. 96-1918  
Application 08/196,931

between the fingers of the hand and the lateral surfaces of the grip case 35, thus reducing the force needed for grasping (translation, page 8). The grip case 35 illustrated in figure 6 appears to have "sufficient length and width to accommodate at least three fingers of a human hand curled about it when the wrist of said human hand is positioned perpendicularly to said base unit" as recited in claim 1. The grip case 35 could be used as a handle with the fingers wrapped around it with the hand perpendicular to the base. Use limitations do not impart structural features. Therefore, claim 1 does not define structurally over Nishiwaki.

Appellant argues that "Clark does not teach or suggest that his tower be used as a handle, where a user wraps at least three fingers of his/her hand around it with his/her wrist positioned perpendicularly to the housing, as applicant is claiming" (Br4). It is true that Clark (and Nishiwaki) do not teach that the tower 62 (or grip case 35 in Nishiwaki) were intended to be gripped with the fingers as claimed. However, the "handle" limitation merely defines an intended use for structure inherent in the devices of

Appeal No. 96-1918  
Application 08/196,931

Nishiwaki and Clark. Statements of intended use do not serve to distinguish structure over the prior art when the prior art structure can be used as claimed. Appellant does not argue that the tower 62 of Clark and the grip case 35 of Nishiwaki fail to meet the structural limitations of "having sufficient length and width to accommodate at least three fingers of a human hand curled about it when the wrist of said human hand is positioned perpendicularly to said base unit" or that the tower and grip case could not be used as a handle as claimed. It is noted that claim 1 does not recite: (1) any details of the shape of the handle; (2) the amount of contact between the fingers and the handle; (3) the placement of switches to be actuated by the fingers; or (4) that gripping the handle with the wrist perpendicular is the only way of gripping the device.

Appellant argues that the examiner erred in reasoning that it would have been obvious to one of ordinary skill in the art to use Clark's device "any way he want[s] such as grab[b]ing the tower with his right hand and insert[ing] the index finger into the finger hole for controlling the movement of the belt" (Advisory Action, Paper No. 8,

Appeal No. 96-1918  
Application 08/196,931

page 2). Appellant argues that the use of Clark's device in this manner is physically impossible and "[a] physically impossible use of a patented device, whether used alone or in combination with another patented device (such as Nishawaki [sic]), cannot properly be considered to be an 'obvious' use of a patented device" (Br5). We do not agree with the examiner's reasoning, but this does not affect our decision because the reasoning was unnecessary. Claim 1 does not require being able to manipulate the conveyor belt or being able to operate switches. The tower 62 of Clark and the grip case 35 of Nishiwaki are capable of being used as handles with the fingers wrapped around them as claimed, which is all that is required by claim 1.

Appellant argues (RBr2):

It is quite clear that Clark does not disclose, teach, or suggest the use of tower 62 as a "handle", as Appellant is claiming in claim 1. In fact, Clark actually teaches away from such an interpretation, as quoted above, since the user could only operate the Clark device if his hand were parallel to base 12, and could not therefore curl his fingers around tower 62. If tower 62 were used as a "handle", as Appellant is claiming in claim 1, the intended function of the Clark device would be destroyed, as the user would be unable to move the cursor in the third degree of freedom, and would be unable to operate switch 52. Since the intended function of the Clark device would be destroyed with such a use, there is no technical

Appeal No. 96-1918  
Application 08/196,931

motivation for such a use, and a case of prima facie obviousness cannot be made.

Claim 1 says nothing about operating the device or operating a switch while the fingers are curled around the handle. As long as the operator can use the tower 62 of Clark or the grip case 35 of Nishiwaki as a handle, claim 1 is satisfied.

Appellant has not persuaded us of any error in the examiner's rejection of claim 1. Accordingly, the rejection of claims 1-10 is sustained.

Appeal No. 96-1918  
Application 08/196,931

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

	KENNETH W. HAIRSTON	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	BOARD OF
PATENT		)	APPEALS
	LEE E. BARRETT	)	AND
	Administrative Patent Judge	)	INTERFERENCES
		)	
		)	
		)	
	ANITA PELLMAN GROSS	)	
	Administrative Patent Judge	)	

Appeal No. 96-1918  
Application 08/196,931

Records Manager  
Legal Department, 20B0  
HEWLETT-PACKARD COMPANY  
P.O. Box 10301  
Palo Alto, CA 94303-0890