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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte OLIVER ZEGULA

Appeal 2010-000937
Application 11/270,493
Technology Center 2800

Before DEBRA K. STEPHENS, HUNG H. BUI, and GEORGIANA W. BRADEN, *Administrative Patent Judges*.

BUI, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ seeks our review under 35 U.S.C. § 134(a) of the Examiner's final rejections of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.²

¹ Real Party in Interest is PREH GmbH.

² Our decision refers to Appellant's Appeal Brief filed July 22, 2008 ("App. Br."); Reply Brief filed November 3, 2008 ("Reply Br."); Examiner's Answer mailed September 3, 2008 ("Ans."); Supplemental Examiner's Answer mailed May 29, 2009 ("Supp. Ans."); Final Office Action mailed December 26, 2007 ("FOA"); and the original Specification filed November 10, 2005 ("Spec").

STATEMENT OF THE CASE

Appellant's Invention

Appellant's invention relates to a control element, shown in FIG. 1 as reproduced below, for control devices for motor vehicles with an improved surface feel and simple construction. Spec. ¶0007.

FIG. 1 of Appellant's disclosure is reproduced below.

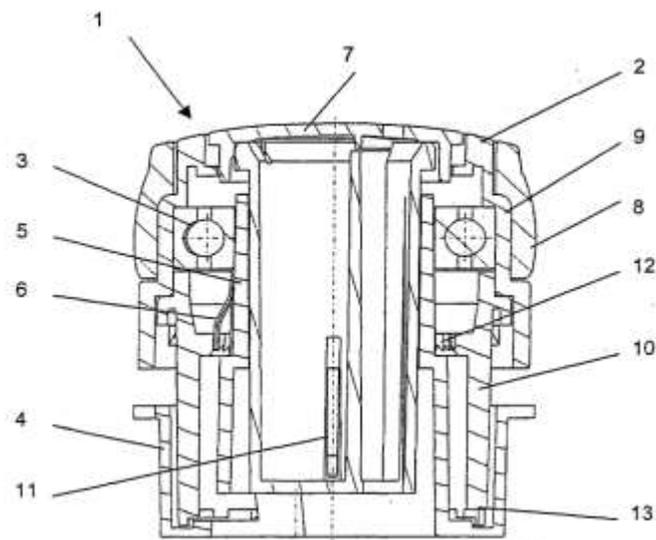


FIG. 1 shows a control element including a rotary actuator.

As shown in FIG. 1, the control element 1 comprises a rotary actuator 2; a stationary key 7 arranged inside the rotary actuator 2; a click-stop arrangement 6, 12 to provide audible and/or tactile response upon rotation of the rotary actuator 2; an axis structure 5 to support the stationary key 7; a bearing 3 provided between the rotary actuator 2 and the axis structure 5 to facilitate rotation of the rotary actuator 2 about a circumference of the axis structure 5. *Id.*, ¶0013 and Abstract.

Claims on Appeal

Claims 1 and 18 are independent. Claim 1 is representative of the invention, as reproduced below with disputed limitations emphasized:

1. A control element for control devices in motor vehicles, the control element comprising:

a rotary actuator;

a stationary key being arranged in an interior of the rotary actuator;

a click-stop arrangement for providing audible and/or tactile response upon rotation of the rotary actuator;

an axis structure for supporting the stationary key; and

a bearing being provided between the rotary actuator and the axis structure for facilitating rotation of the rotary actuator about a circumference of the axis structure, ***wherein the bearing is fixed relative to the axis structure.***

Evidence Considered

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

Tauchenitz	US 4,859,922	Aug. 22, 1989
Schuberth	U.S. 6,667,446 B1	Dec. 23, 2003
Hayashi	U.S. 2004/0154910 A1	Aug. 12, 2004
Oster	U.S. 6,903,291 B2	Jun. 7, 2005

Examiner's Rejections

(1) Claims 1-4, 7-11, and 14-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayashi and Tauchenitz. Supp. Ans. 3-6.

(2) Claim 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayashi, Tauchenitz, and Oster. Supp. Ans. 6-7.

(3) Claims 6, 12, and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayashi, Tauchenitz, and Schuberth. Supp. Ans. 7.

ISSUE

Based on Appellant's arguments, the dispositive issue on appeal is whether the Examiner has erred in rejecting claims 1-20 under 35 U.S.C. § 103(a). In particular, the issue turns on:

(1) Whether Hayashi could be modified to incorporate the teachings of Tauchenitz in order to arrive at Appellant's independent claim 1 without changing the principle of operation of Hayashi or without rendering Hayashi inoperable for its intended purpose (App. Br. 4-5; Reply Br. 1-3); and

(2) Whether the combination of Hayashi and Tauchenitz discloses or suggests "a click-stop device ... comprises a stop spring operatively engaging a plurality of snap-in grooves," as recited in Appellant's independent claim 18 (App. Br. 5-6).

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellant's arguments that the Examiner has erred.

We disagree with Appellant's conclusions as to all rejections. We adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner's Answer in response to Appellant's Appeal

Brief. We also concur with the conclusions reached by the Examiner. We further highlight and address specific findings and arguments for emphasis as follows.

With respect to independent claim 1, Appellant contends that the modification of Hayashi to incorporate the feature of Tauchenitz as suggested by the Examiner would impermissibly change the principle of operation of Hayashi or render Hayashi unsatisfactory for its intended purpose. App. Br. 4-5; Reply Br. 1-3. In particular, Appellant argues:

Hayashi teaches that element 28d must slide axially relative to element 31 to allow Hayashi's actuator to move axially and have a push button function (paragraph 0047). Placing a bearing, such as bearing 10 of Tauchenitz between elements 28d and 31 of Hayashi would prevent this movement from occurring.

...The modification proposed in the Office Action would impermissibly 1) change the principle of operation of Hayashi and 2) render Hayashi unsatisfactory for its intended purpose. The modification would change the principle of operation of Hayashi by preventing Hayashi from carrying out the push-button functionality described in that application. The modification would thus render Hayashi unsatisfactory for its intended purpose, namely to function as a "rotary push switch device" as stated in the title.

App. Br. 4-5.

We do not find Appellant's arguments persuasive. As correctly found by the Examiner, Hayashi discloses bearings 25 provided between a rotary actuator 28d and an axis structure 31, shown in FIGS. 1-2. Supp. Ans. 4. As a secondary reference, Tauchenitz also discloses bearings 10, 11 provided between a rotary component 1, 5 and a stationary component 2, 4 and one of the rings of bearings 10, 11 is stationary with respect to the

stationary component 2, 4. Supp. Ans. 4. We agree with the Examiner's findings that Hayashi's bearings 25 provided between the rotary actuator 28d and the axis structure 31, shown in FIGS. 1-2 of Hayashi could be replaced or substituted with bearings 10, 11 that are fixed to an axis structure as described in connection with FIGS. 1-2 of Tauchenitz. Supp. Ans. 4. We also agree with the Examiner's findings that an outer ring of bearings 10, 11 of Tauchenitz is pressed into bore of armature plate 2 and attachment sleeve 4, and an inner ring of bearings 10, 11 is in sliding contact with shaft 5, so that the shaft 5 can rotate and translate. Supp. Ans. 9. Therefore, if Hayashi were to be modified to incorporate the arrangement of Tauchenitz, the modification would still allow the bearings to rotate and translate, *albeit* with some restrictions; nevertheless, such a modification would not change the principle of operation of Hayashi or render Hayashi unsatisfactory for its intended purpose. Supp. Ans. 9.

Separately, we also accord Appellant's claim term "fixed" its broadest reasonable interpretation. *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000). According to the Webster's New World Dictionary, 3rd College Edition, the term "fix" is simply defined as "to make firm, stable, or secure;" or "to fasten or attach firmly". Likewise, the term "fixed" is defined as "firmly placed or attached." In view of its "broadest reasonable interpretation" consistent with the specification, the limitation "the bearing [is] fixed relative to the axis structure" as recited in Appellant's independent claim 1 can also encompass the bearings 25 provided between the rotary push knob 21 (i.e., an rotary actuator) and the supporting shaft 31 (i.e., an axis

structure), shown in FIG. 1 of Hayashi.³ This is because when the rotary push switch device of Hayashi is in a non-operating state, that is, not being pushed up/down in an axial direction of the supporting shaft 31 (i.e., an axis structure) or rotated in a rotary direction by a user, the bearings 25 are **fixed** or set firmly in position relative to the supporting shaft 31 (i.e., an axis structure) by way of spring 26.

With respect to independent claim 18, Appellant contends that the combination of Hayashi and Tauchenitz does not disclose or suggest “a click-stop device ... comprises a stop spring operatively engaging a plurality of snap-in grooves.” App. Br. 5-6. In particular, Appellant argues that Hayashi’s spring 26 is spaced from grooves 28c by ball 25, and does not engage grooves 28c. App. Br. 6.

We disagree. As correctly found by the Examiner, Appellant’s claim 18 only requires the spring to be “operatively engaged” with the grooves (i.e., recess of the cam 28c) and does not require direct engagement. Supp. Ans. 9. Therefore, contrary to Appellant’s contention, Hayashi teaches a stop spring 26 operatively engaging with grooves (i.e., recess of the cam 28c), as shown in FIGS. 2-3 of Hayashi.

For the reasons set forth above, we do not find any error in the Examiner’s position and, therefore, sustain the Examiner’s rejection of independent claims 1 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Hayashi and Tauchenitz.

³ See *In re Meyer*, 599 F.2d 1026, 1031, 202 USPQ 175, 179 (CCPA 1979) ([A] rejection for obviousness under § 103 can be based on a reference which happens to anticipate the claimed subject matter.)

With respect to dependent claims 5, 6, 12, and 13, we agree with the Examiner's discussion of Hayashi, Tauchenitz, Oster and Schuberth and the Examiner's response to Appellant's arguments. Ans. 9-10. We agree with the Examiner's findings and conclusions and adopt them as our own. Therefore, we sustain the Examiner's rejection of claims 5, 6, 12, and 13 under 35 U.S.C. § 103(a).

With respect to dependent claims 2-4, 7-11, 14-17, and 19-20, Appellant presents no arguments for patentability of these claims separately from claims 1 and 18. App. Br. 5. As such, claims 2-4, 7-11, 14-17, and 19-20 stand or fall together with independent claims 1 and 18. *See* 37 C.F.R. § 41.37(c)(1)(vii) (stating that "the failure of Appellant to separately argue claims which Appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately"). Therefore, we also sustain the Examiner's rejection of claims 2-4, 7-11, 14-17, and 19-20 under 35 U.S.C. § 103(a).

CONCLUSION

On the record before us, we conclude that the Examiner has not erred in rejecting claims 1-20 under 35 U.S.C. § 103(a).

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DECISION

As such, we affirm the Examiner's final rejection of claims 1-20.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2011).

AFFIRMED

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