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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/191,152	07/27/2005	Mikko Nurmi	846A.0040.U1 (US)	3548

10948 7590 01/22/2013

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ART UNIT	PAPER NUMBER
2699	

MAIL DATE	DELIVERY MODE
01/22/2013	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MIKKO NURMI

Appeal 2010-009130
Application 11/191,152
Technology Center 2600

Before CARL W. WHITEHEAD, JR., ERIC S. FRAHM, and ANDREW J. DILLON, *Administrative Patent Judges.*

FRAHM, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

Introduction

This is a decision on appeal under 35 U.S.C. § 134(a) of the final rejection of claims 1-18. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

Invention

The invention is a method, device, and computer program product for controlling software functions in a portable electronic device using a control wheel having selection areas associated with individual software functions (Spec. ¶¶ [0001], [0004]-[0009], and [0015]; Abs.; Fig. 2A and Fig. 2B). More specifically, the disclosed and claimed invention pertains to a method of controlling software functions of an electronic device using a control wheel that has a turning function, includes selection areas that are associated with software functions that are performed "on the basis of from which given selection area the turning function is detected to start" (claim 1).

Claim 1 is representative of the invention and is reproduced below with (emphasis added):

> 1. A method of controlling software functions of an electronic device, the method comprising:
>
> determining more than one selection area on *a control wheel*;
>
> associating the selection areas with given software functions;
>
> detecting from which selection area the turning function starts when a turning function of the control wheel is detected; and

> performing predetermined software functions on the basis of from which given selection area the turning function is detected to start.

Examiner's Rejection

The Examiner rejected claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over Reed (US 7,254,785 B2, filed May 22, 2003) and Berg (US Pat. App. Pub. No.: 2006/0155441 A1, filed Sept. 30, 2005). Ans. 3-4.

Examiner's Findings and Conclusions

The Examiner admits that "Reed does not disclose selection areas on the control wheel" (Ans. 3), and relies upon Berg as disclosing a control wheel (the steering wheel 10 and/or the controller 28 shown in Figures 1 and 2 and described in paragraphs [0026] and [0028]) having selection areas represented by buttons 38, 40, 42, and 44 (Ans. 3-5). The Examiner relies upon Berg's steering wheel 10 and controller 28, and not scroll wheel 34, as teaching or suggesting the control wheel of claims 1-18 (Ans. 5). The Examiner finds that "[b]oth Reed and Berg teach that a dial/wheel is used to scroll through a selected category after a category is selected using push buttons (414a-k in Reed and 38-44 in Berg) not located on the dial/wheel" (Ans. 5).

Appellant's Contentions

(1) Appellant contends (App. Br. 9-10; Reply Br. 3-5) that the Examiner erred in rejecting independent claims 1, 6, 13, 15, and 17 under § 103(a) for numerous reasons, including:

(a) neither Reed nor Berg teach determining more than one selection area on a control wheel, as recited in each of the independent claims 1, 6, 13, 15, and 17 (App. Br. 9);

(b) items 414a-k of Reed are toggle push buttons that are not located on a control wheel (App. Br. 9);

(c) Berg's selector buttons 38, 40, 42, and 44 are also not located on a control wheel, because the wheel in Berg that acts like a control wheel is scroll wheel 34 and the selector buttons are supported in a housing 30 that is *adjacent* the scroll wheel 34 as set forth in Berg's paragraph [0026] (App. Br. 9);

(d) Berg's scroll wheel 34 has only one button, and thus fails to disclose more than one selection area as claimed (App. Br. 9);

(e) Berg's item 10 in Figure 1 described in paragraph [0023] cannot be a control wheel as recited in the claims on appeal, and only Berg's scroll wheel 34 can correspond to the claimed control wheel because:

(i) controller 28 is Berg's control wheel (i.e., that causes software functions to be selected); and

(ii) Berg's element 10 is a steering wheel of a vehicle that turns the vehicle and not the software functions (Reply Br. 3-4); and

(f) neither Reed nor Berg teach or suggest detecting a selection area on a control wheel from which a turning function starts and performing a predetermined software function on the basis of such a selection area, as recited in independent claims 1, 6, 13, 15, and 17 (Reply Br. 5).

(2) Appellant contends (App. Br. 11) that the Examiner erred in rejecting dependent claims 2, 7, 9, 14, and 18 under § 103(a) because:

(a) Berg's buttons are separate from the display 26 which is on a dashboard; and

(b) none of Berg's selector buttons indicate software functions associated with a selection area of a control wheel (i.e., Berg's scroll wheel 34).

(3) Appellant contends (App. Br. 12) that the Examiner erred in rejecting dependent claims 4, 5, 11, and 12 under § 103(a) because:

(a) the portions of Berg cited by the Examiner fail to teach a touch screen; and

(b) element 50 in Berg's Figure 4 is just a highlighted portion on the display 26 which is activated when a button on the controller 28 is hit, as opposed to when a touch screen is touched.

ISSUE[1]

Based on Appellant's arguments enumerated above, the principal and dispositive issue presented on appeal is:

Did the Examiner err in rejecting claims 1-18 because the combination of Reed and Berg fails to teach or suggest the control wheel with a turning function and selections areas associated with given software functions, as recited in representative claim 1, and as similarly recited in independent claims 6, 13, 15, and 17?

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[1] We recognize that Appellant's arguments present additional issues. Some of the arguments presented by the additional issues are not persuasive; nonetheless we were persuaded of error by the issue stated above and as such we do not reach the additional issues as the issue stated above is dispositive of the appeal.

ANALYSIS

We have reviewed the Examiner's rejection in light of Appellant's arguments in the Appeal Brief (App. Br. 9-13) and the Reply Brief (Reply Br. 3-5) that the Examiner has erred. We agree with all of Appellant's specifically enumerated contentions above relating to the claims on appeal, and highlight and address specific findings regarding Berg for emphasis as follows.

Berg and the Recited "Control Wheel"

Claims 1, 6, 13, 15, and 17 each require a "control wheel" (*see* input device 104 in Figure 2A) having "more than one selection area" and a "turning function" (*see* description of the turning function at Spec. ¶ [0022]) for selecting/controlling a given software function to be performed when the turning function of the control wheel is detected to start (*see* claims 1, 6, 13, 15, and 17). Berg, on the other hand, merely discloses a scroll wheel 34 with a turning function and only one selection area to select a software function, a steering wheel 10 for steering a vehicle, and a controller 28 having category selector buttons 38, 40, 42, and 44 for selecting categories of modes of operation (Berg, ¶ [0026]). Berg's scroll wheel 34 that selects the software functions using a turning function does not have more than one selection area.

In view of the foregoing, we are persuaded by Appellant's arguments that the Examiner has not shown that Reed or Berg teaches a control wheel, as recited in claim 1, and as similarly recited in claims 6, 13, 15, and 17. Accordingly, we will not sustain the Examiner's rejection of independent claims 1, 6, 13, 15, and 17, and claims 2-5, 7-12, 14, 16, and 18, depending respectively therefrom.

Examiner's Reliance on Berg's Priority Date of March 4, 2004

A claim is entitled to priority from the filing date of an earlier filed application, but only if the earlier filed application describes the subject matter of the claim as required by § 112. 35 U.S.C. § 120. Section 112 requires a patent specification to contain a "written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same." 35 U.S.C. § 112. Thus, if the later filed application's claims are not set forth in the earlier filed application with the specificity that § 112 requires, the later filed application cannot claim the earlier filing date for those claims. 35 U.S.C. § 120.

Compliance with the written description requirement is a question of fact. *See Ariad Pharms., Inc.* v. *Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (*en banc*). To satisfy the written description requirement, a patent's specification must reasonably convey to a person having ordinary skill in the art that the inventor had possession of the later-claimed subject matter as of the earlier filing date. *Id.* While the earlier filed application need not describe the later filed claims verbatim, a description that merely renders the later filed invention obvious is insufficient. *Id.* at 1352.

> A continuation-in-part application may include matter not disclosed in the prior-filed application. *See* MPEP § 201.08. *Only the claims of the continuation-in-part application that are disclosed in the manner provided by the first paragraph of 35 U.S.C. 112 in the prior-filed application are entitled to the benefit of the filing date of the prior-filed application*. If there is a continuous chain of copending nonprovisional applications,

> each copending application must disclose the claimed invention of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112, in order for the later-filed application to be entitled to the benefit of the earliest filing date.

(MPEP § 201.11(I)(B), *Claiming the Benefit of Nonprovisional Applications*) (emphasis added).

Berg (US 2006/0155441 A1) was filed on September 30, 2005, and was published on July 13, 2006. In order to be prior art to the instant application on appeal which has a filing date of July 22, 2005, prior to Berg's filing date of September 30, 2005, Berg must have priority back to the March 4, 2004 filing date of its parent application from which Berg is a continuation-in-part. The Examiner does not present findings or reasoning showing that the cited portions of the U.S. Patent Publication No. 2006/0155441 A1 to Berg (Berg, ¶¶ [0026] and [0028]),[2] are supported by the requisite written description support in the Berg parent application having the priority filing date of March 4, 2004 (Application No. 10/793,193). We find that Berg's paragraphs [0026] and [0028] (found in the continuation-in-part application US 2006/0155441 A1, and relied on by the Examiner in rejecting claims 1-18 on appeal), were not part of the originally filed parent application (U.S. Patent Application No. 10/793,193), and therefore do not have written description support and are not deserving of the priority date of March 4, 2004. Therefore, Berg is not prior art to

[2] U.S. Patent Publication No. 2006/0155441 A1 to Berg was filed September 30, 2005, published July 13, 2006, and is a continuation-in-part application of U.S. Patent Application No. 10/793,193 filed March 4, 2004.

Appellant's claims 1-18 and the Examiner erred in relying on Berg as evidence for the obviousness rejection.

Accordingly, for this additional reason, we will not sustain the Examiner's 35 U.S.C. § 103(a) rejection of claims 1-18 which relies on Berg.

CONCLUSIONS

The combination of Reed and Berg fails to teach or suggest the control wheel with a turning function and selections areas associated with given software functions, as recited in representative claim 1, and as similarly recited in independent claims 6, 13, 15, and 17. Appellant has persuaded us of error in the Examiner's decision to reject claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over Reed and Berg.

ORDER

The decision of the Examiner to reject claims 1-18 is reversed.

REVERSED

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