



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
13/251,150 09/30/2011 Christopher Blumenberg P5040USC5/63266-5581US 8877

61725 7590 10/31/2016
Morgan, Lewis & Bockius LLP / AI
1400 Page Mill Road
Palo Alto, CA 94304-1124

Table with 1 column: EXAMINER

DAO, TUAN C.

Table with 2 columns: ART UNIT, PAPER NUMBER

2193

Table with 2 columns: NOTIFICATION DATE, DELIVERY MODE

10/31/2016

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

padocketingdepartment@morganlewis.com
vskliba@morganlewis.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* CHRISTOPHER BLUMENBERG

---

Appeal 2014-008900<sup>1</sup>  
Application 13/251,150<sup>2</sup>  
Technology Center 2100

---

Before MAHSHID D. SAADAT, CHARLES J. BOUDREAU, and  
ADAM J. PYONIN, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Final Rejection of claims 1–8, 10–12, 14–20, and 22–29, all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

---

<sup>1</sup> An oral hearing was held in this appeal on August 8, 2016. A transcript from the oral hearing was entered into the file on September 16, 2016.

<sup>2</sup> Appellant identifies Apple Inc. as the real party in interest. App. Br. 4.

STATEMENT OF THE CASE<sup>3</sup>

Appellant’s disclosure is directed to “application programming interfaces that provide gesture operations.” Spec. ¶ 2.

Claims 1 and 22, reproduced below, are illustrative of the subject matter on appeal (*italics added*):

1. A machine readable non-transitory medium storing executable program instructions, which, when executed, cause an electronic device with a display to perform a method comprising:

receiving a user input that comprises a plurality of input points touching the display, wherein the user input generates a gesture event;

*transferring a gesture start event function call* between user interface software and a software application based on the user input, wherein the gesture start event function call includes a first list of two or more input points touching the display at a first time; and

*transferring a gesture changed event function call* between the user interface software and the software application based on the user input, wherein the gesture changed event function call includes a second list of two or more input points touching the display at a second time.

22. A device comprising:

an input panel which is configured to receive user inputs;

a display device integrated with the input panel;

one or more processors coupled to the input panel; and

---

<sup>3</sup> We note the Appeal Brief does not identify any related appeals and interferences. *See* App. Br. 5; *see also* 37 CFR 41.37(c)(1).

a memory storing one or more programs configured to be executed by the one or more processors, the one or more programs including:

instructions for receiving a user input that comprises a plurality of input points touching the input panel;

instructions for generating an event object in response to the user input;

instructions for *transferring a gesture changed event function call* between user interface software and a software application in response to a change in the user input; and

instructions for *transferring a gesture end function call* between the user interface software and the software application when at least one input point, of the plurality of input points, associated with the user input is removed from the input panel.

#### REJECTIONS ON APPEAL

Claims 22–24 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Hillis (US 2006/0031786 A1, published Feb. 9, 2006). *See* Final Act. 3–5.

Claims 1–4, 6, 8, 10–12, 15–18, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hillis and Zotov (US 2007/0262964 A1, published Nov. 15, 2007 (filed May 12, 2006)). *See* Final Act. 6–22, 28.

Claims 5 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hillis, Hotelling (US 2006/0161871 A1, published July 20, 2006), and Zotov. *See* Final Act. 22–24.

Claims 7 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hillis, Westerman (US 2002/0015024 A1, published Feb. 7, 2002), and Zotov. *See* Final Act. 24–25.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hillis, Hotelling, Westerman, and Zotov. *See* Final Act. 26–27.

Claims 26, 28, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hillis, Kela (US 2005/0210419 A1, published Sept. 22, 2005), and Zotov. *See* Final Act. 28–32.

Claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hillis and Kela. *See* Final Act. 33–34.

#### ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellant’s arguments that the Examiner has erred. We concur with Appellant’s conclusion that the Examiner erred.

With respect to the Examiner’s rejection of claims 22–24 as anticipated by Hillis, we agree with Appellant that “Hillis does not disclose a function call as required in claim 22” (App. Br. 15), let alone “instructions for transferring a gesture changed event function call between user interface software and a software application” and “instructions for transferring a gesture end function call between the user interface software and the software application” (*id.* at 20–23). As explained by Appellant (App. Br. 15–16), the Examiner’s rejection appears to be based on these limitations being inherent in Hillis. To establish inherency, the evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *Cont’l Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991).

Although the “executable operations” of Hillis pointed to by the Examiner (Final Act. 3–5 (citing Hillis ¶¶ 24–27, 43); Ans. 4–5 (citing Hillis ¶¶ 24–27, 43)) *might* involve transferring function calls for gesture change and gesture end events, “[i]nherency . . . may not be established by probabilities or possibilities.” *Cont’l Can*, 948 F.2d at 1269 (quoting *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981)). Here, the Examiner has not established that instructions for transfer of function calls are *necessarily present in* the operations described by Hillis, notwithstanding the Examiner’s explanation that Appellant’s specification supports a broad interpretation of “transferring” a function call. *See* Ans. 6–11 (citing Spec. ¶ 59; Hillis ¶¶ 24–26, 50). Accordingly, we do not sustain the Examiner’s rejection of claim 22 and its dependent claims 23 and 24 as anticipated by Hillis. For the same reason, we also do not sustain the Examiner’s rejections of claim 25 for obviousness over Hillis and Zotov and claim 27 for obviousness over Hillis and Kela, in both of which rejections the Examiner relies solely on the same disclosures of Hillis as in the rejection of claims 22–24 addressed above. *See* Final Act. 28, 33–34; Ans. 41–46.

For similar reasons, we also do not sustain the Examiner’s rejections of claims 1–8, 10–12, 14–20, 26, 28, and 29. In the rejection of claims 1–4, 6, 8, 10–12, and 15–18 over Zotov and Hillis, the Examiner relies upon Zotov as disclosing “transferring a gesture start event function call based on . . . user input” and “transferring a gesture changed event function call based on the user input” (Final Act. 6–8, 12–14, 17–19 (citing Zotov ¶¶ 20, 21, 27–29, 33–44, Figs. 3–5) (emphasis omitted); Ans. 21–24, 26–28, 31–35) and on Hillis as disclosing that those function calls are transferred “between

user interface software and a software application” (Final Act. 9–10, 15–16, 19–20 (citing Hillis ¶¶ 24–26, 43) (emphasis omitted); Ans. 29–30, 35–36), as recited in each of independent claims 1, 10, and 15. The Examiner relies on the same disclosures of Zotov and Hillis as disclosing those limitations in the rejections of claims 5, 7, 14, 19, 20, 26, 28, and 29, citing Hotelling, Westerman, and Kela only for other limitations of those dependent claims. Final Act. 22–32; Ans. 37–41. We agree with Appellant that neither Zotov nor Hillis expressly discloses function calls, however, let alone transferring gesture start event and gesture changed event function calls between user interface software and a software application; we also agree that the Examiner has not established that those limitations are inherently disclosed by either reference. App. Br. 24. Accordingly, we reverse the Examiner’s rejections of those claims.

#### DECISION

The Examiner’s rejections of claims 1–8, 10–12, 14–20, and 22–29 are REVERSED.

REVERSED