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DISNEY ENTERPRISES, INC.  
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EXAMINER
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PHAM LU, NGAN T

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* CHRISTOPHER W. HEATHERLY, KENLIP ONG,  
ARMEN MKRTCHYAN, JONATHAN BACKER,  
and BRIAN WHITE<sup>1</sup>

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Appeal 2015-004723  
Application 12/806,986  
Technology Center 2600

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Before JASON V. MORGAN, JOSEPH P. LENTIVECH, and  
MICHAEL M. BARRY, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 35, 37, 38, 41, 43–45, 47, and 48, which constitute all pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> Appellants identify the real party in interest as Disney Enterprises, Inc., a wholly owned subsidiary of The Walt Disney Corporation. App. Br. 2.

*Introduction*

Appellants state “[t]he present invention relates generally to the field of gaming, and more particularly, to gaming using touch-sensitive surfaces.”

(Spec 1.) Claim 35 is representative:

35. A peripheral device for use with a touch-sensitive system having a touch surface, the peripheral device comprising:

a plurality of touch points configured to contact the touch surface of the touch-sensitive system, wherein the plurality of touch points are further configured to provide information to the touch-sensitive system for identifying the peripheral device;

a contact region configured to be grounded when touched by a person;

a first touch lead connected to the contact region, wherein when the contact region is grounded when touched by the person, the first touch lead is configured to provide a first grounding path from the contact region to at least two of the plurality of touch points for identifying the peripheral device, wherein the identifying distinguishes between the plurality of touch points of the peripheral device and a plurality of touch points of another peripheral device;

a touch switch configured to be grounded when touched by the person; and

a second touch lead connected to the touch switch, wherein when the touch switch is grounded when touched by the person, the second touch lead is configured to provide a second grounding path from the touch switch to at least one of the plurality of touch points different than the at least two of the plurality of touch points.

App. Br. 14 (Claims App’x).

*Rejections*

All pending claims stand rejected under 35 U.S.C. § 103(a) as obvious over Decre et al. (US 2008/0161086 A1; published July 3, 2008) and Zachut et al. (US 2009/0322352 A1; published Dec. 31, 2009). Final Act. 3–6.

## ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellants’ contentions of Examiner error. We disagree with Appellants’ conclusions. We adopt as our own the findings and reasons set forth by the Examiner in the action from which this appeal is taken and as set forth in the Answer. We concur with the Examiner’s conclusions. We highlight the following for emphasis.

The Examiner relies on Decre for teaching all requirements of claim 35 except for the limitation of “the first touch lead is configured to provide a first grounding path from the contact region to at least two of the plurality of touch points for identifying the peripheral device.” Final Act. 3–4 (also citing Decre Figs. 1a–b, 2, ¶¶ 12, 13, 34–36). For that limitation, the Examiner maps one of the claimed “at least two of the plurality of touch points for identifying the peripheral device” to Decre’s embodiment of Figs. 1a–b. *Id.* at 4 (identifying “triggerable sub-part 11” and citing ¶ 34). The Examiner finds Zachut, which relates to “detecting information about objects [including for example] detect[ing] position, identification and/or orientation” (Zachut ¶ 2), teaches a “touch lead [that] is coupled to at least two touch points,” thus teaching the remainder of that limitation. Final Act. 4 (citing Zachut Figs. 6A, 6D, 6E, ¶ 94).

Appellants argue the Examiner errs in finding that Decre teaches the recited requirement for a “second touch lead . . . ‘configured to provide a second grounding path . . . to at least one of the plurality of touch points different than the at least two of the plurality of touch points.’” App. Br. 10. Appellants further argue the Examiner’s mapping of Decre’s sub-part 11 to

the claimed first touch lead and sub-part 12 to the claimed second touch lead renders Decre's device inoperable, and that:

The Office Action completely ignores the fact that both sub-parts 11 and 12 in Decre are for identifying the pawn, and separates the two sub-parts, so that sub-part 12 can be used to satisfy the touch switch of claim 35. Then the Office Action introduces a non-existing touch point in Decre, from Zachut, for the purpose of combining it with electrode contact 11a for identifying the pawn. However, Decre already includes two sub-parts 11 and 12 with respective electrode contacts 11a and 12a for identifying the pawn. One of ordinary skill in the art would not be motivated by either Decre or Zachut to arrive at the Office Action's suggested combination, so as to use subpart 12 of Decre that is used for identifying the pawn as a touch switch, and then use an element from Zachut to perform the same function that subpart 12 is already performing in Decre.

App. Br. 11.

We disagree with Appellants. While certainly Decre describes an embodiment that uses sub-parts 11 and 12 together for device identification, Decre provides broad alternative teachings as well. For example, Decre states other embodiments of the example in Figures 1a–b “may comprise any number of triggerable sub parts” (¶ 35). Decre teaches that each sub-part can provide a “trigger signal” to provide various information, including device identification, in which case “only one electrode [touch point, in the vernacular of the claim] is required for communicating the trigger signal to the board” (¶ 36). Decre further describes a game piece that includes three touch points on the bottom of a game piece to enable determining the orientation of a game piece (Figs. 5a–c, ¶ 44). We note this described “orientation determination” functionality teaches or at least suggests a grounding path from a single contact region to all three touch points.

“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference . . . . Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art.” *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (citations omitted). The teachings of Decre described above fully support the Examiner’s finding that “Decre in view of Zachut disclose[s] a second touch lead . . . configured to provide a second grounding path . . . to at least one of the plurality of touch points” as recited. *See* Ans. 5–6, Final Act. 3–4. We agree with the Examiner that it in the combination of Decre with Zachut, “Decre performs the same function as it does separately of having two electrodes for the sub-parts” and “Zachut performs the same function as it does separately.” Ans. 6. Appellants have not provided persuasive evidence or argument to show combining Zachut’s multiple touch points for identifying devices with Decre’s embodiment of Figs. 1a–b was “uniquely challenging or difficult for one of ordinary skill in the art.” *See Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 419 (2007)); *see also id.* at 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”).

Appellants further argue the Examiner errs because “there is no suggestion, motivation or desire expressed or implied in the cited references to modify the function of subpart 12 in Decre, and then import elements from Zachut to perform the original function of subpart 12 in Decre.” Reply Br. 3. We find this unpersuasive. A reason to combine teachings from the prior art “may be found in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from

the nature of the problem to be solved.” *WMS Gaming Inc. v. Int’l Game Tech.*, 184 F.3d 1339, 1355 (Fed. Cir. 1999) (citing *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998)). “[A]n analysis of obviousness . . . may include recourse to logic, judgment, and common sense available to the person of ordinary skill in the art that do not necessarily require explication in any reference or expert opinion.” *Perfect Web Technologies, Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1329 (Fed. Cir. 2009). We agree with the Examiner that “[t]he results of the combination would have been predictable and resulted in modifying the invention of Decre to include more than one electrodes (tokens), as disclosed by Zachut, thereby [to] provide a broad range of identification possibilities for the object (peripheral device), as Zachut discusses at paragraph [0012].” Ans. 6.

We accordingly sustain the Examiner’s rejection of claim 35, and along with it the rejection of claims 37, 38, 41, 43–45, 47, and 48, for which Appellants provide no separate substantive arguments. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2014) and *In re Lovin*, 652 F.3d 1349, 1351 (Fed. Cir. 2011) (sustaining the requirement for appellants to articulate substantive arguments for individual claims to be treated separately).

#### DECISION

We affirm the Examiner’s rejection of claims 35, 37, 38, 41, 43–45, 47, and 48.

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)

AFFIRMED