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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID BAUM and REED QUINN

Appeal 2015-005432
Application 13/600,091¹
Technology Center 2600

Before HUNG H. BUI, JOHN F. HORVATH, and
JOSEPH P. LENTIVECH, *Administrative Patent Judges*.

BUI, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner’s Final Office Action rejecting claims 1–4 and 6–20, which are all of the claims pending on appeal. Claim 5 is cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.²

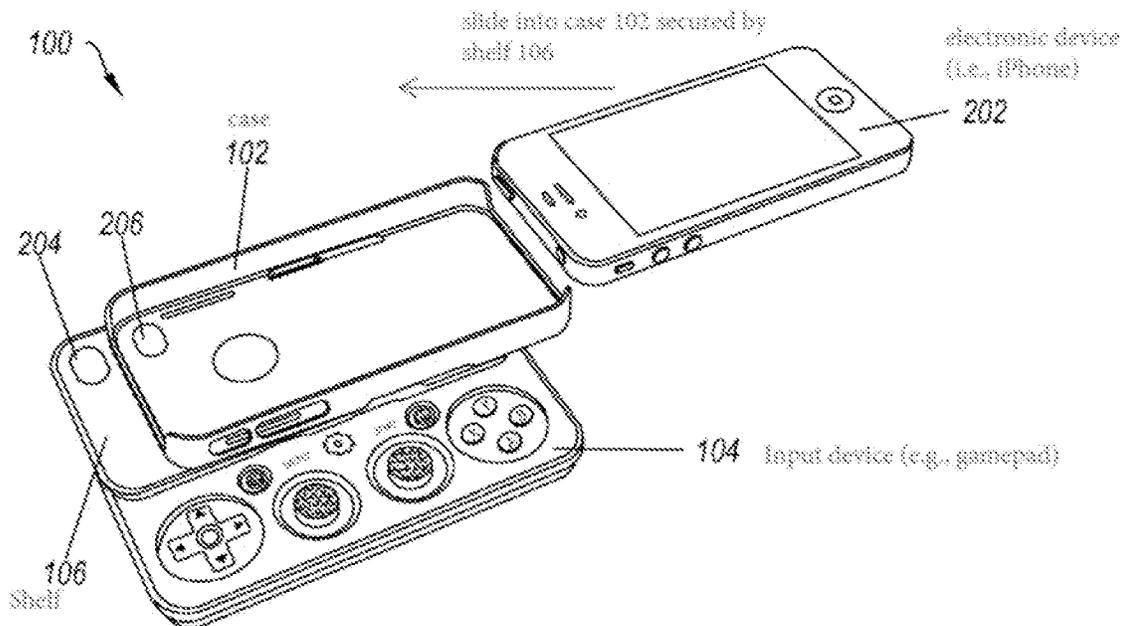
¹ According to Appellants, the real party in interest is Bladepad, LLC. App. Br. 3.

² Our Decision refers to Appellants’ Appeal Brief filed October 28, 2014 (“App. Br.”); Reply Brief filed April 24, 2015 (“Reply Br.”); Examiner’s Answer mailed March 10, 2015 (“Ans.”); Final Office Action mailed May 23, 2014 (“Final Act.”); and original Specification filed August 30, 2012 (“Spec.”).

STATEMENT OF THE CASE

Appellants' invention relates to "a method for connecting an electronic device [i.e., mobile device] to [an input device such as] a gamepad." Spec. ¶ 12, Fig. 2; Abstract. According to Appellants, "the input device 104 can include any device which allows a user to input a command for an electronic device," including, for example: "a gamepad" or "a keyboard, a touchpad, a touch screen, a mouse, a scroll wheel, a headset (e.g., a Bluetooth headset), connections for external devices, such as controllers or joysticks, motion detectors, any other desired input or any combination thereof." Spec. ¶ 30.

Appellants' Figure 2 is reproduced below with additional markings for illustration:



Appellants' Figure 2 shows an electronic device gaming system 100 including: (1) shelf 106 sized to cover input device 104 (gamepad) and (2) electronic device 202 (e.g., iPhone) detachably secured to shelf 106, via case 102, to establish wireless communication with input device 104 (gamepad).

Claims 1, 11, and 16 are independent. Claim 1 is illustrative of Appellants' invention, as reproduced with disputed limitations emphasized below:

1. A method for connecting an electronic device to a gamepad, the method comprising:
 - providing a gamepad including one or more controls;
 - providing a shelf sized to cover the one or more controls, *the gamepad being slidably mounted to the shelf* such that the gamepad is slidable from a closed position where the shelf covers the one or more controls and an active position where the shelf does not cover the one or more controls;
 - providing *an electronic device detachably secured to the shelf opposite the gamepad*;
 - detecting a Bluetooth protocol;
 - detecting an electronic device; and
 - connecting the gamepad to the electronic device wirelessly using the Bluetooth protocol.

App. Br. 18 (Claims App.).

Examiner's Rejections and References

(1) Claims 1–4, 6, 7, 11, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jones et al., (US 2011/0230178 A1; published Sept. 22, 2011; “Jones”) and Lee et al., (US 2008/0096620 A1; published Apr. 24, 2008; “Lee”). Final Act. 2–8; Ans. 3–8.

(2) Claims 8–10 and 12–15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jones, Lee, and Ealey et al., (US 2010/0203971 A1; published Aug. 12, 2010; “Ealey”). Final Act. 8–10; Ans. 9–10.

(3) Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Jones, Lee, and Cho et al., (US 2008/0274776 A1; published Nov. 6, 2008; “Cho”). Final Act. 11–12; Ans. 11–12.

(4) Claims 17–20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jones, Lee, Cho, and Ealey. Final Act. 12–14; Ans. 12–14.

ISSUE

Based on Appellants’ arguments, the dispositive issues presented on appeal are: (1) whether the cited prior art teaches or suggests the disputed limitations: (a) “the gamepad being slidably mounted to the shelf” and (b) “an electronic device detachably secured to the shelf opposite the gamepad” as recited in independent claim 1, and similarly recited in independent claims 11 and 16; and (2) whether the Examiner has provided “articulated reasoning with underpinning” to support the conclusion of obviousness. App. Br. 7–14; Reply Br. 4–10.

ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellants’ arguments the Examiner erred. App. Br. 7–14; Reply Br. 4–10. We are unpersuaded by Appellants’ contentions and we adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken (Final Act. 2–14) and (2) the reasons set forth by the Examiner in the Examiner’s Answer in response to Appellants’ Appeal Brief. (Ans. 14–20.) However, we highlight and address specific arguments and findings for emphasis as follows.

Claims 1–4, 6, 7, 11, and 16 based on Jones and Lee

Appellants contend the Examiner erred in rejecting independent claims 1, 11, and 16 because the cited prior art, including Jones and Lee,

fails to teach or suggest the disputed limitations: (1) “the gamepad being slidably mounted to the shelf” and (2) “an electronic device detachably secured to the shelf opposite the gamepad.” App. Br. 9–14; Reply Br. 4–10.

According to Appellants,

if *Jones et al.* fails to teach “providing a shelf” how can it be alleged that *Jones et al.* teaches “the gamepad ... being slidably mounted to [the shelf] such that the gamepad ... is slidable”? I.e., it is impossible for *Jones et al.* to both fail to teach the shelf and simultaneously teach that the shelf is slidably attached to the gamepad. Likewise, the configuration of the shelf, which the Examiner concedes is not taught by *Jones et al.*, relative to the gamepad, in either an active or closed position, cannot be taught by *Jones et al.* since *Jones et al.* doesn’t teach a shelf.

App. Br. 10 (emphasis added).

Similarly, Appellants argue Lee does not teach a “gamepad” and “an electronic device detachably secured to the shelf opposite to the gamepad,” as recited in claim 1, because: (1) Lee’s “manipulating unit 240,” as shown Lee’s Figures 2A–2E and 4A–4C, which Appellants consider as the claimed “gamepad,” is not slidably attached to the “first body 210” (i.e., Appellants’ claimed “shelf”), and (2) Lee’s “manipulating unit 240” “is not mounted ‘opposite’ the mobile terminal but is instead folded over and covered by the mobile terminal.” *Id.* at 12–13.

Appellants also contend: (1) the Examiner’s reason to combine is conclusory; (2) there is no “articulated reasoning” with underpinning to support the conclusion of obviousness; and (3) in the absence of an articulated reasoning, the Examiner’s attempt to combine Jones and Lee constitutes an impermissible hindsight reconstruction of Appellants’ disclosure. App. Br. 7–9; Reply Br. 4–7. According to Appellants, the

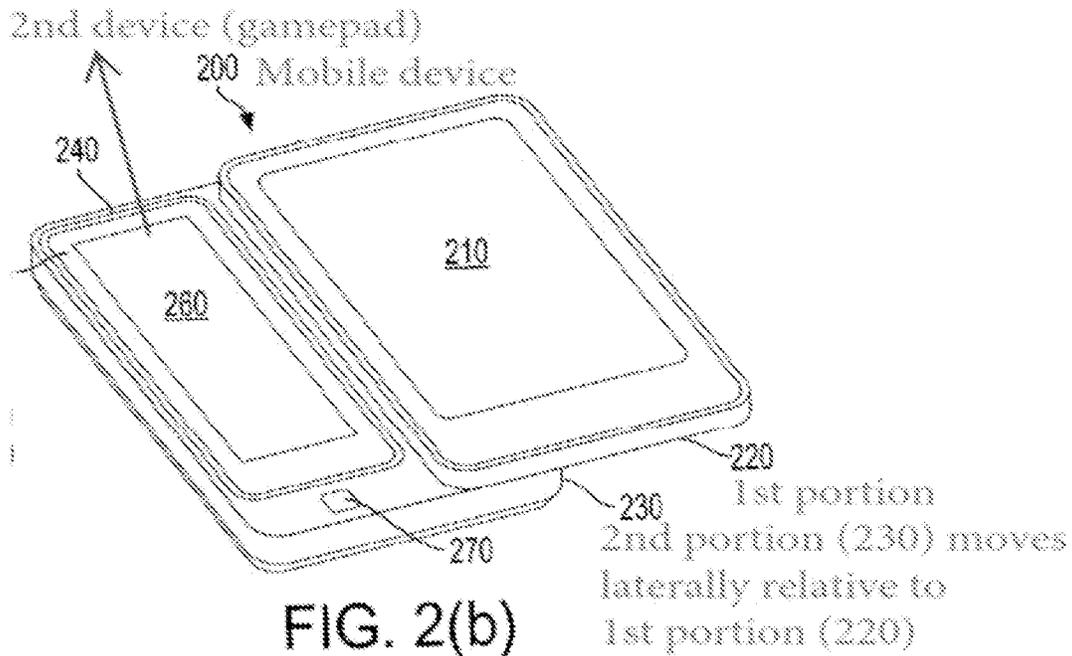
Examiner's reason to combine, i.e., "to provide a mobile terminal capable of sufficiently obtaining a region or space of a user input unit (or manipulating unit) for inputting data and/or controlling an operation of the mobile terminal, and a region or size of a displaying unit" (Final Act. 4–5; Ans. 5; Lee, ¶ 12) "is wholly unrelated to the claimed invention." App. Br. 7–8. Likewise, "there is no articulated reasoning for combining the 'shelf' of Lee et al. with the gamepad of Jones et al." Reply Br. 4. According to Appellants,

there is no configuration of *Jones et al.* which allows the "gamepad 1930" to be covered without the "a first device 1910" or "multiple, interchangeable second devices 1920, 1930, 1940 and 1950." Likewise, there is no configuration of *Lee et al.* which allows the "manipulating unit 240" to be covered by the "first body 210" since when folded over the "manipulating unit 240" is covered by the attached electronic device. Therefore, neither *Jones et al.* nor *Lee et al.*, nor any combination thereof, disclose "a closed position where the shelf covers the one or more controls and an active position where the shelf does not cover the one or more controls" or any desire to do so. Therefore, the only reasoning which can lead to such a conclusion is improper hindsight reasoning based on Appellant's specification.

Reply Br. 6–7 (emphasis added).

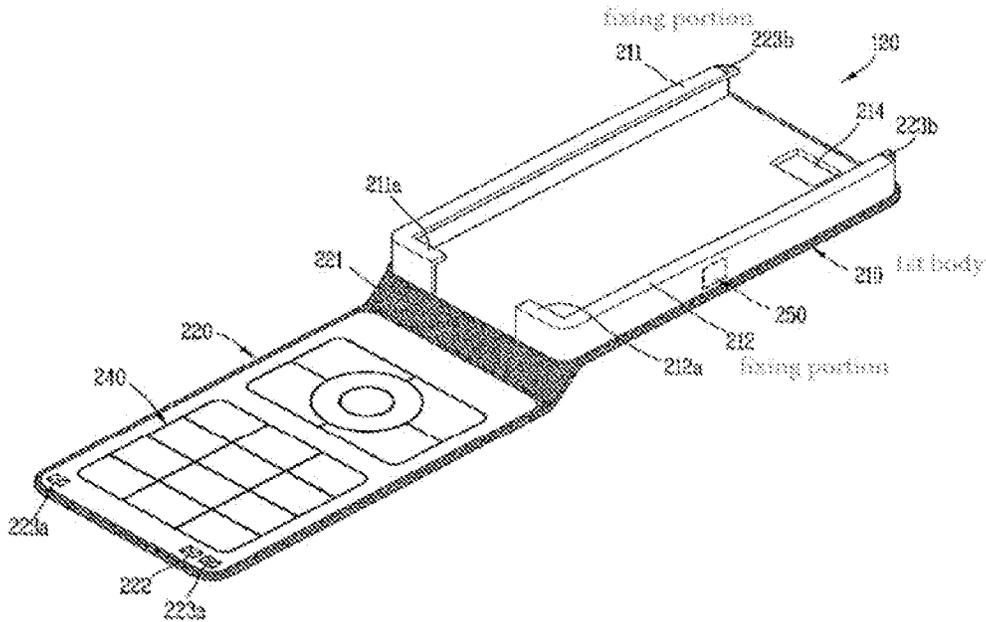
We are not persuaded the Examiner erred. Contrary to Appellants' arguments, we agree with the Examiner that Jones teaches "the gamepad being slidably mounted to the shelf" in the context of (1) a removable second device 250 ("gamepad"), shown in Jones' Figure 2(b), that is mounted to a flat board part of a first portion 220, and (2) a flat board part of a first body 210, shown in Lee's Figure 2C. Ans. 17–18 (citing Jones' Fig. 2(b); Lee's Figure 2C).

Jones' Figure 2(b) is reproduced with additional markings for illustration.



As shown in Jones' Fig. 2(b), the mobile device 200 includes a first portion 220 arranged on top of a second portion 230 and movable in an open or closed configuration. Jones ¶ 46. According to Jones, the second portion 230 can be removed and "replaced with various other components such as a game controller [Appellants' claimed "gamepad"], battery or physical keyboard." Jones ¶ 49.

Likewise, Lee's Figure 2C is reproduced with additional markings for illustration.



As shown in Lee’s Figure 2C, Lee explicitly teaches “the concept of providing a shelf” in the form of a first body 210, and fixing portions 211, 212 to receive insertion of an electronic device (i.e., mobile device). Ans. 4, 17–19 (citing Lee ¶¶ 74, 77, Fig. 2C and Fig. 6A).

We recognize that the Examiner must articulate “reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). However, “[u]nder the correct [obviousness] analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 420 (2007). The Examiner has provided reasoning to modify Jones’ device to incorporate the use of a shelf as disclosed by Lee in order to “provide a mobile terminal capable of sufficiently obtaining a region or space of a user input unit . . . for inputting data and/or controlling an operation of the mobile terminal, and a region or size of a displaying unit.”

See Final Act. 4–5; Ans. 5. Although the Examiner’s reasoning is not a model of clarity, we find the Examiner’s “path may reasonably be discerned.” *In re Applied Materials, Inc.*, 692 F.3d 1289, 1295 (Fed. Cir. 2012). Jones and Lee are both directed to a mobile device having a case and multiple interchangeable second devices, and any effort to incorporate the shelf disclosed by Lee as part of Jones’ device would have been obvious to those skilled in the art because this well-known feature performs the same known function and yields no more than what one would expect otherwise. See *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). A skilled artisan would “be able to fit the teachings of multiple patents together like pieces of a puzzle” since the skilled artisan is “a person of ordinary creativity, not an automaton.” *Id.* at 420–21.

Consequently, we are not persuaded that the Examiner failed to articulate a sufficient rationale for combining Jones and Lee. Nor are we persuaded by Appellants’ impermissible hindsight argument. See *In re Cree*, 818 F.3d 694, 702, n.3 (Fed. Cir. 2016) (Appellants’ hindsight argument is of no moment where the Examiner provides a sufficient, non-hindsight reason to combine the references).

Additionally, we note Appellants have not demonstrated the Examiner’s proffered combination of references would have been “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*, 550 U.S. at 418). Nor have Appellants provided objective evidence of secondary considerations which our reviewing court guides “operates as a beneficial check on hindsight.” *Cheese Systems, Inc. v. Tetra Pak Cheese and Powder Systems*, 725 F.3d 1341, 1352 (Fed. Cir. 2013).

For the reasons set forth above, Appellants have not demonstrated Examiner error. As such, we sustain the Examiner's obviousness rejection of independent claims 1, 11, and 16 and their respective dependent claims 2–4, 6–10, 12–15, and 17–20, which Appellants do not argue separately. App. Br. 14–16.

CONCLUSION

On the record before us, we conclude Appellants have not demonstrated the Examiner erred in rejecting claims 1–4 and 6–20 under 35 U.S.C. § 103(a).

DECISION

As such, we AFFIRM the Examiner's final rejection of claims 1–4 and 6–20.

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).

AFFIRMED