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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
12/620,911 11/18/2009 Robert S. TARTZ 091895 1483

23696 7590 11/17/2016
QUALCOMM INCORPORATED
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EXAMINER

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ART UNIT PAPER NUMBER

2145

NOTIFICATION DATE DELIVERY MODE

11/17/2016

ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT S. TARTZ

Appeal 2015-005598
Application 12/620,911
Technology Center 2100

Before ST. JOHN COURTENAY III, LARRY J. HUME, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner’s Final Rejection of claims 1–8, 10–18, 20–28, 30–38, and 40–53. Claims 9, 19, 29, and 39 are cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Invention

The disclosed and claimed invention on appeal relates to “method of haptic communication at a wireless device is disclosed. The method may include receiving an input gesture and generating an input gesture message from the input gesture. The input gesture message may be operable for transmission to a receiving wireless device.” (Abstract).

Representative Claim

1. A method of haptic communication at a wireless device, the method comprising:

[L1] *receiving a telephone number that was input by a user;*

[L2] *identifying a stored input gesture message associated with the received telephone number, wherein the input gesture message is identified as a result of receiving the telephone number and the input gesture message is indicative of an input gesture; and*

[L3] *transmitting the input gesture message to a receiving wireless device having the telephone number and configured to produce a haptic output at the receiving wireless device based on the input gesture.*

(Contested limitations L1, L2, and L3 are emphasized).

Rejections

A. Claims 1, 2, 7, 8, 11, 12, 17, 18, 21, 22, 27, 28, 31, 32, 37, 38, and 53 are rejected under 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of Birnbaum et al ("Birnbaum", US 2010/0045619 A1; Feb. 25, 2010) in view of Melideo (US 2004/0234049 A1; Nov. 25, 2004), and further in view of (Schwarzer et al ("Schwarzer", US 5,644,628; July 1, 1997).

B. Claims 3–6, 13–16, 23–26, and 33–36 are rejected under 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of Birnbaum, Melideo, Schwarzer, and Grant et al ("Grant", US 2008/0287147 A1; Nov. 20, 2008).

- C. Claims 10, 20, 30, and 40 are rejected under 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of Birnbaum, Melideo, Schwarzer, Grant, and Lindsay (US 2010/0188230 A1; July 29, 2010).
- D. Claims 49–52 are rejected under 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of Birnbaum, Melideo, Schwarzer, Lindsay, and Iwami (US 2008/0049730 A1; Feb. 28, 2008).
- E. Claims 41, 43, 45, and 47 are rejected under 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of Birnbaum, Melideo, Schwarzer, Lindsay, and Iwami, and Grant.
- F. Claims 42, 44, 46, and 48 are rejected under 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of Birnbaum, Melideo, Schwarzer, Lindsay, and Iwami, and Farley (US 2006/0018293 A1; Jan. 26, 2006).

Grouping of Claims

Based on Appellant's arguments in the principal Brief, we decide the appeal of all claims rejected under rejection A on the basis of independent claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv). To the extent Appellant has not advanced separate, substantive arguments for the remaining claims on appeal, such arguments are considered waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

ANALYSIS

We have considered all of Appellant's arguments and any evidence presented. We disagree with Appellant's arguments, and we adopt as our own: (1) the findings and legal conclusions set forth by the Examiner in the action from which this appeal is taken, and (2) the findings, legal conclusions, and explanations set forth in the Answer in response to Appellant's arguments. (Ans. 3–7). However, we highlight and address specific findings and arguments for emphasis in our analysis below.

Rejection of Independent Claim 1 under 35 U.S.C. § 103(a)

Appellant contests limitations L1, L2, and L3 of claim 1,¹ and additionally contends the Examiner has relied on impermissible hindsight:

given that claim 1 is focused on a specific concept (telephone number -> stored input gesture message), the use of such generalizations in the Final Office Action to reject the claims *logically appears to be based solely on impermissible hindsight reconstruction of the claims*. In particular, absent the Appellant[']s specification, there is no basis to combine these *disparate references* as alleged in the Final Office Action in the precise way to form the features of independent claim 1. For example, due to the absence in the cited art of "identifying a stored input gesture message associated with the received telephone number" and transmitting that message "to a receiving wireless device having the telephone number", and given that these features are only present on the record in Appellant[']s specification, *it logically follows that the cited generalizations were improperly gleaned from Appellant[']s own specification and that the combination of the cited*

¹ Appellant contends, inter alia (App. Br. 23): "A. The cited references do not disclose, teach, or suggest identifying a stored input gesture message associated with the received telephone number and transmitting the input gesture message."

references is an exercise of impermissible hindsight.

(App. Brief 29) (Emphasis added).

At the outset, we are not persuaded by Appellant’s contentions the Examiner has improperly combined the cited references under § 103 by relying on impermissible hindsight. (*Id.*) To the extent Appellant grounds this argument on the premise there is an “absence in the cited art of [L2] ‘identifying a stored input gesture message associated with the received telephone number’ and [L3] transmitting that message ‘to a receiving wireless device having the telephone number’” (*id.*), we disagree, and find limitations L1–L3 are taught or suggested by the cited references for the reasons discussed *infra*. Thus, we do not agree with Appellant’s assertion “that these features are only present on the record in Appellant’s specification.” (*Id.*)

Regarding Appellant’s hindsight argument, we are cognizant that our reviewing courts have not established a bright-line test for hindsight. In *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007), the U.S. Supreme Court guides that “[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon *ex post* reasoning.” *KSR*, 550 U.S. at 421 (citing *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 36 (1966)). Nevertheless, the Supreme Court qualified the issue of hindsight by stating, “[r]igid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it.” *Id.*

Here, we see the post-*KSR* hindsight question before us as a *balancing test*: We decide whether the Examiner’s proffered combination of references is merely: (1) “the predictable use of prior art elements according

to their established functions” (*KSR*, 550 U.S. at 417), consistent with *common sense*; or, (2) would an artisan *reasonably* have combined the cited references in the manner proffered by the Examiner *but for* having the benefit of Appellant’s claims and Specification to use as a guide? ²

After reviewing the respective teachings and suggestions of the references (as cited by the Examiner, Final Act. 4–6), we find the weight of the evidence more strongly supports the first prong of the balancing test. In reviewing the record, we find the Examiner provided sufficient articulated reasoning with some rational underpinning to establish why an artisan would have been motivated to combine the secondary Melideo and Schwarzer references with the primary Birnbaum reference. (Final Act. 5–6.) ^{3 4}

² See *In re Cree, Inc.*, 818 F.3d 694, 702, n.3 (Fed. Cir. 2016)(where the Board applied the hindsight balancing test) (“Cree argues that the Board’s rejection was based on ‘impermissible hindsight.’ That argument, however, is essentially a repackaging of the argument that there was insufficient evidence of a motivation to combine the references. It is fully answered by the Board’s observation that ‘the weight of the evidence shows that the proffered combination is merely a predictable use of prior art elements according to their established functions.’”). See also *Ex Parte Cree, Inc. Patent Owner & Appellant*, APPEAL 2014-007890, 2014 WL 6664878, at *17 (PTAB, Nov. 21, 2014).

³ The Examiner finds an artisan would have been motivated “to modify the teaching of Birnbaum with the teaching of Melideo to verify the telephone number’s associated data and make sure the specified called party is intended.” (Final Act. 5).

⁴ The Examiner finds an artisan would have been motivated “to modify the modified Birnbaum’s teachings with Schwarzer’s teaching to specify any gesture data can be associated with a telephone number.” (Final Act. 5).

Moreover, Appellant has not demonstrated the Examiner’s proffered combination of 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 has Appellant provided any 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, Inc.*, 725 F.3d 1341, 1352 (Fed. Cir. 2013).⁵

In summary, we find combining the respective reference teachings in the manner proffered by the Examiner would have merely resulted in “the predictable use of prior art elements according to their established functions,” *KSR*, 550 U.S. at 417, consistent with *common sense*. (*See* Ans. 4–8). We find the Examiner provided sufficient articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *See KSR* 550 U.S. at 418; *see also* Final Act. 3–6. We are further mindful that the 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.” *KSR* 550 U.S. at 420–21.

This reasoning is applicable here. Accordingly, on this record we are not persuaded the Examiner erred by improperly combining the cited references under §103.

⁵ *See* Evidence Appendix (App. Br. 42) (“None”).

Turning to the contested limitations, the Examiner finds (Ans. 3)

Birnbaum:

teaches the main feature of the invention is generating an input gesture message and transmitting the generated input gesture message to recipient device and produce the haptic output based on the generated input gesture message at the recipient device ("Birnbaum", Figs 4, 9, [0029, 0095, 0097]. Steps 914 and 918).

We note paragraph 29 of Birnbaum teaches, in pertinent part:

when a virtual message object is *sent from one mobile device to another*, the virtual message object *displays the same characteristics in the recipient device as it displayed in the sending device*. The characteristics which are maintained may comprise the virtual message object's size, shape, color, and any *haptic effect* associated with the virtual message object.

(Emphasis added.)

Melideo (¶ 59) teaches associating identified *data* with a telephone number: i.e., “[a] list or other data structure of identified telephone numbers and any associated data . . . [where] [t]he associated data may include names (people, companies, schools, and others), email addresses, street addresses, mailing addresses, birthdays, and other information.”

Schwarzer (col. 3, ll. 2–5) teaches an association between an arbitrary gesture and a telephone number: “inputs, *arbitrary gestures* designed by the user and trained in the software for handwriting recognition can be stored in the memory as abbreviations of call numbers, and thus used for selection” (emphasis added).

Given these teachings, we find replacing Melideo’s associated data and “other information” (¶ 59) with a gesture (as taught by Schwarzer,

col. 3, l. 2) would have merely realized a predictable result. *See KSR*, 550 U.S. at 417.

In the Answer (4) the Examiner finds that “Birnbaum also teaches the concept of *storing* the input gesture message (*haptic effects*) associated with the each contact of the contact list 1704 (“Birnbaum”, Fig. 17, [0138])” (emphasis added).

We reproduce Birnbaum (¶ 138) below, which we find teaches contested limitation L3 (“transmitting the input gesture message to a receiving wireless device having the telephone number and configured to produce a haptic output at the receiving wireless device based on the input gesture.”):

In other embodiment of the present invention, a user may form a real-time link to *transmit information in a format other than a message*. FIG. 17 is an illustration of transmitting haptic messages according to one embodiment of the present invention. As shown in FIG. 17, a mobile device 1700 comprises a display 1702. Display 1702 comprises a haptic contact list 1704. Each contact comprises a name and a haptic status shown in a haptic window. In one embodiment, when a user of mobile device 1700 touches the haptic status window of a contact, the user may feel a haptic effect corresponding to the status of the person listed in the haptic contact list. *In a further embodiment, the mobile device may transmit a signal to the mobile device of the person listed in the haptic contact list. The signal may comprise a haptic signal to alert the person in the haptic contact list that someone is interested in their status.* For example, while a first user swipes their finger across a second user's contact entry, the first user feels the second user's status. *At the same time, the swipe gesture by the first user is transmitted to the second user's device, which may generate a haptic effect perceptually equivalent or similar to the duration and intensity of the finger swipe.* In another embodiment, the first user may tap repeatedly on the second user's contact list

entry, mimicking knocking on a door or window, which translates a haptic, audio, and visual knocking effect to the second user, serving as an invitation to initiate a communication session.

Birnbaum (§ 138) (emphasis added).

In response to the Examiner's citation to paragraph 138 (*id.*) in the Answer (4), Appellant urges in the Reply Brief (4) that Birnbaum (§ 138) teaches two embodiments (i.e., "scenarios"), both of which do "not involve *'identifying a stored input gesture message associated with the received telephone number'* and *'transmitting the input gesture message to a receiving wireless device having the telephone number'* as claimed.

We do not find this argument persuasive, because the Examiner relies on the *combined* teachings and suggestions of, Melideo and Schwarzer to teach or suggest the claimed "identifying." (Claim 1; *see* Final Act. 5). Further, we find Birnbaum (§ 138) teaches or suggests at least temporary storing or buffering, as required for transmitting and receiving data, wherein data is read from a memory prior to transmitting and stored to a memory or buffer subsequent to reception. Moreover, Birnbaum teaches "[v]irtual message objects may also represent various forms of non-verbal communication, such as *gestures . . .*" (§ 57), where a "virtual message object may comprise *a data store* defining characteristics of the virtual message object" (§ 58) (emphasis added). Thus, we find Birnbaum expressly teaches that gestures are stored. (*Id.*)

For at least these reasons, on this record we are not persuaded the Examiner erred in finding that the cited combination of Birnbaum, Melideo, and Schwarzer would have taught or suggested contested limitations:

L1, "receiving a telephone number that was input by a user," as

claimed (Schwarzer, Fig. 1C, col. 2 lines (56–61; Final Act. 5), and

L2, “identifying a stored input gesture message associated with the received telephone,” as claimed (Melideo", Fig. 4, ¶59; Final Act. 5), and

L3, “transmitting the input gesture message to a receiving wireless device,” as claimed (Birnbaum ¶ 138), as discussed above (Claim 1).

For at least the aforementioned reasons, on this record, and based upon a preponderance of the evidence, we are not persuaded by Appellant’s arguments alleging the Examiner improperly combined the cited references under § 103, or that the proffered combination of Birnbaum, Melideo, and Schwarzer does not teach or suggest contested limitations L1, L2, and L3, within the meaning of representative claim 1 (App. Br. 27, 28; *see also* Reply Br. 7).

Therefore, on this record, we find a preponderance of the evidence supports the Examiner’s underlying factual findings and ultimate legal conclusion of obviousness regarding representative claim 1. The remaining claims also rejected under rejection A fall with claim 1. *See* Grouping of Claims, *supra*.

Remaining Claims rejected under Rejections B–F

Appellant advances no separate, substantive arguments regarding the remaining claims which are rejected under rejections B–F. Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). Therefore, we sustain the Examiner’s rejections B–F of the remaining claims on appeal.

Reply Brief

To the extent Appellant advances new arguments in the Reply Brief not in response to a shift in the Examiner's position in the Answer, we note arguments raised in a Reply Brief that were not raised in the Appeal Brief or are not responsive to arguments raised in the Examiner's Answer will not be considered except for good cause. *See* 37 C.F.R. § 41.41(b)(2).

DECISION

We affirm the Examiner's rejections of claims 1–8, 10–18, 20–28, 30–38, and 40–53 under 35 U.S.C. § 103(a).

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 41.50(f).

AFFIRMED