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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MIKKO NURMI

Appeal 2016-002245
Application 12/732,816¹
Technology Center 2600

Before ST. JOHN COURTENAY III, THU A. DANG, and
LARRY J. HUME, *Administrative Patent Judges*.

HUME, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the final rejection of claims 1–12, 14–17, 20, and 21. Appellant has previously canceled claims 13, 18, and 19. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ According to Appellant, the real party in interest is Nokia Technologies Oy. App. Br. 2.

STATEMENT OF THE CASE²

The Invention

Appellant's disclosed and claimed inventions "relate to an apparatus and a method for detecting proximity based input." Spec. 1, ll. 3–4.

Exemplary Claim

Claim 1, reproduced below, is representative of the subject matter on appeal (*emphasis* added to contested limitation):

1. An apparatus, comprising: at least one processor; and at least one memory including computer program code, the at least one memory and the computer program code configured to, with the at least one processor, cause the apparatus at least to perform:

receive an indication of presence of a first object in close proximity to an input surface in a single-input mode, wherein a first action performed by the processor is associated with an input by the first object in the single-input mode,

receive an indication of simultaneous presence of the first object and a second object in close proximity to the input surface, and

in response to the receiving the indications of simultaneous presence of the first object and the second object, *deactivate the single-input mode and activate a multi-input mode in which the first action performed by the processor and associated with the input by the first object in the single-input mode is not available*, a second action performed by the processor is associated with the input by the first object in the multi-input mode, and a third action performed by the processor

² Our decision relies upon Appellant's Appeal Brief ("App. Br.," filed July 22, 2015); Reply Brief ("Reply Br.," filed Dec. 15, 2015); Examiner's Answer ("Ans.," mailed Oct. 16, 2015); Final Office Action ("Final Act.," mailed Dec. 24, 2014); and the original Specification ("Spec.," filed March 26, 2010).

is associated with an input by the second object, wherein the second action is different from the first action.

Prior Art

The Examiner relies upon the following prior art as evidence in rejecting the claims on appeal:

Esenther et al. ("Esenther")	US 2007/0257891 A1	Nov. 8, 2007
Hotelling et al. ("Hotelling")	US 2008/0158172 A1	July 3, 2008
Christie	US 2008/0165141 A1	July 10, 2008
De la Torre Baltierra et al. ("Baltierra")	US 2009/0284478 A1	Nov. 19, 2009

Rejections on Appeal

R1. Claims 1–3, 5, 7–8, 10–12, 14, 16, 20 and 21 stand rejected under 35 U.S.C. §§ 102(a) and 102(e) as anticipated by Baltierra.

R2. Claims 4 and 15 stand rejected under 35 U.S.C. § 103(a) as obvious over the combination of Baltierra and Christie.

R3. Claims 6 and 17 stand rejected under 35 U.S.C. § 103(a) as obvious over the combination of Baltierra and Esenther.

R4. Claims 9 stands rejected under 35 U.S.C. § 103(a) as obvious over the combination of Baltierra and Hotelling.

CLAIM GROUPING

Based on Appellant's arguments (App. Br. 10–13), we decide the appeal of anticipation Rejection R1 of claims 1–3, 5, 7–8, 10–12, 14, 16, 20 and 21 on the basis of representative claim 1. Remaining claims 4, 6, 9, 15

and 17 in rejections R2 through R4, not argued separately, stand or fall with the respective independent claim from which they depend.³

ISSUES AND ANALYSIS

In reaching this decision, we consider all evidence presented and all arguments actually made by Appellant. We do not consider arguments which Appellant could have made but chose not to make in the Briefs so that we deem any such arguments as waived. 37 C.F.R. § 41.37(c)(1)(iv).

We disagree with Appellant's arguments with respect to claim 1, and we incorporate herein and adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken, and (2) the reasons and rebuttals set forth in the Examiner's Answer in response to Appellant's arguments. We incorporate such findings, reasons, and rebuttals herein by reference unless otherwise noted. However, we highlight and address specific findings and arguments regarding claim 1 for emphasis as follows.

1. §§ 102(b) and 102(e) Rejection R1 of Claims 1–3, 5, 7, 8, 10–12, 14, 16, 20, and 21

Issue

Appellant argues (App. Br.10–13; Reply Br. 1–4) the Examiner's rejection of claim 1 under 35 U.S.C. §§ 102(b) and 102(e) as anticipated by Baltierra is in error. These contentions present us with the following issue:

³ "Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately." 37 C.F.R. § 41.37(c)(1)(iv).

Did the Examiner err in finding the cited prior art discloses an apparatus that includes a processor, a memory, and computer program code stored therein which, when executed, causes the apparatus to carry out the negative limitation of "deactivate the single-input mode and activate a multi-input mode in which the first action performed by the processor and associated with the input by the first object in the single-input mode *is not available*," as recited in claim 1 (emphasis added)?

Analysis

Appellant contends:

[W]hen multi-input mode is enabled, a touch or flick is disabled while a pinch gesture is enabled. In other words, the Examiner has found that when a pinch gesture is being input with two fingers, a simultaneous flick gesture cannot be input." Appellant asserts that this assumption is contradicted both by the Examiner's own comments and by the disclosure of Baltierra.

App. Br. 11. Appellant further contends:

Appellant asserts that regardless of whether "a touch or flick is disabled" as alleged by the Final Office Action, this fails to teach or suggest that "**a first action performed by the processor** and associated with the input by the first object in the single-input mode **is not available**," as required by [c]laim 1.

App. Br. 12.

We are not persuaded by Appellant's arguments because Appellant does not directly and fully address the specific findings of the Examiner in the sections of Baltierra recited by the Examiner. Instead Appellant chooses to argue non-cited sections from the reference. *See* App. Br. 11–13.

Claim terms are to be given their broadest reasonable interpretation, as understood by those of ordinary skill in the art and taking into account whatever enlightenment may be had from the Specification. *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

As a matter of claim construction, Appellant's claimed apparatus comprises: (1) "at least one processor;" and (2) "at least one memory including "computer program code configured to [perform functions]." See claim 1. However, Appellant relies upon the recited "computer program code" that is "configured to" perform the contested functions as providing the purported distinction over the structure in the cited prior art. Claim 1.

However, our reviewing court guides that the patentability of an apparatus claim "depends on the claimed structure, not on the use or purpose of that structure." *Catalina Marketing Int'l. Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002); see also *Superior Industries v. Masaba, Inc.*, 553 F. App'x 986, 991 (Fed. Cir. 2014) (Rader, J., concurring) ("[A] system claim generally covers what the system is, not what the system does."); see also *Roberts v. Ryer*, 91 U.S. 150, 157 (1875) ("The inventor of a machine is entitled to the benefit of all the uses to which it can be put, no matter whether he had conceived the idea of the use or not."). Thus, it is usually improper to construe non-functional claim terms in system claims in a way that makes infringement or validity turn on their function. *Paragon Solutions, LLC v. Timex Corp.*, 566 F.3d 1075, 1091 (Fed. Cir. 2009).

Further, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477–78 (Fed. Cir. 1997) (The absence of a

disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); *see also In re Swinehart*, 439 F.2d 210, 212–13 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847 (CCPA 1959). "[A]pparatus claims cover what a device *is*, not what a device *does*." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990).

In this case, Appellant has not distinguished the apparatus by its claimed structure, but instead focuses on purported differences in function. App. Br. 10–12.

As an additional matter of claim construction, we find Appellant's citations to the Specification for support of the disputed claim limitation (App. Br. 4–5) do not provide supporting disclosure relating to any specialized structure or *reason to exclude* in support of the disputed negative limitation "activate a multi-input mode in which the first action performed by the processor and associated with the input by the first object in the single-input mode is not available." Claim 1. *See Santarus, Inc. v. Par Pharm., Inc.*, 694 F.3d 1344, 1351 (Fed. Cir. 2012) ("Negative claim limitations are adequately supported when the specification describes a reason to exclude the relevant limitation. Such written description support need not rise to the level of disclaimer. In fact, it is possible for the patentee to support both the inclusion and exclusion of the same material."). *See also* Manual of Patent Examining Procedure (MPEP) § 2173.05(i) (9th Ed., Mar. 2014) ("Any negative limitation or exclusionary proviso must have basis in the original disclosure The mere absence of a positive recitation is not basis for an exclusion").

This reasoning is applicable here. Therefore, as a second matter of claim construction, we do not accord this contested, but unsupported, negative limitation of claim 1 (i.e., "activate a multi-input mode in which the first action performed by the processor and associated with the input by the first object in the single-input mode is not available") patentable weight.

Accordingly, Appellant has not provided sufficient evidence or argument to persuade us of any reversible error in the Examiner's reading of the contested limitations on the cited prior art. Therefore, we sustain the Examiner's anticipation rejection of independent claim 1 and claims 2, 3, 5, 7, 8, 10–12, 14, 16, 20, and 21, which fall therewith. *See Claim Grouping, supra.*

2. § 103(a) Rejections R2–R4 of Claims 4, 6, 9, 15 and 17

In view of the lack of any substantive or separate arguments directed to obviousness Rejections R2 through R4 of claims 4, 6, 9, 15 and 17 under § 103 (*see App. Br. 13*), we sustain the Examiner's rejections of these claims, as they fall with their respective independent claims. Arguments not made are waived.

REPLY BRIEF

To the extent Appellant may advance new arguments in the Reply Brief (Reply Br. 1–5) 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).*

CONCLUSIONS

(1) The Examiner did not err with respect to anticipation Rejection R1 of claims 1–3, 5, 7–8, 10–12, 14, 16, 20 and 21 under 35 U.S.C. §§ 102(b) and 102(e) over the cited prior art of record, and we sustain the rejections.

(2) The Examiner did not err with respect to obviousness rejections R2–R4 of claims 4, 6, 9, 15 and 17 under 35 U.S.C. § 103(a) over the cited prior art combinations of record, and we sustain the rejections.

DECISION

We affirm the Examiner's decision rejecting claims 1–12, 14–17, 20 and 21.

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