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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte IAN GEORGE FLETCHER-PRICE

Appeal 2016-004253
Application 13/407,134¹
Technology Center 2600

Before CARLA M. KRIVAK, HUNG H. BUI, and DAVID J. CUTITTA II,
Administrative Patent Judges.

Opinion for the Board filed by *Administrative Patent Judge* HUNG H. BUI

Dissent by *Administrative Patent Judge* DAVID J. CUTITTA II.

DECISION ON APPEAL

Appellant seeks our review under 35 U.S.C. § 134(a) from the Examiner's Final Office Action rejecting claims 7–14, which are all claims pending on appeal. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.²

¹ According to Appellant, the real party in interest is Posturite Ltd. App. Br. 2.

² Our Decision refers to Appellant's Appeal Brief filed September 8, 2015 ("App. Br."); Reply Brief filed March 4, 2016 ("Reply Br."); Examiner's Answer mailed January 4, 2016 ("Ans."); Final Office Action mailed December 8, 2014 ("Final Act."); and original Specification filed February 28, 2012 ("Spec.").

STATEMENT OF THE CASE

Appellant’s invention relates to “a novel point and click device which operates much as a conventional mouse but which is of good ergonomic design and also ambidextrous design so that use can quickly and easily be switched from right to left or left to right hand.” Spec. 2; Fig. 1.

Appellant’s Figures 1 and 4 show Appellant’s “point and click” device for a computer work station, as reproduced below with additional markings for illustration.

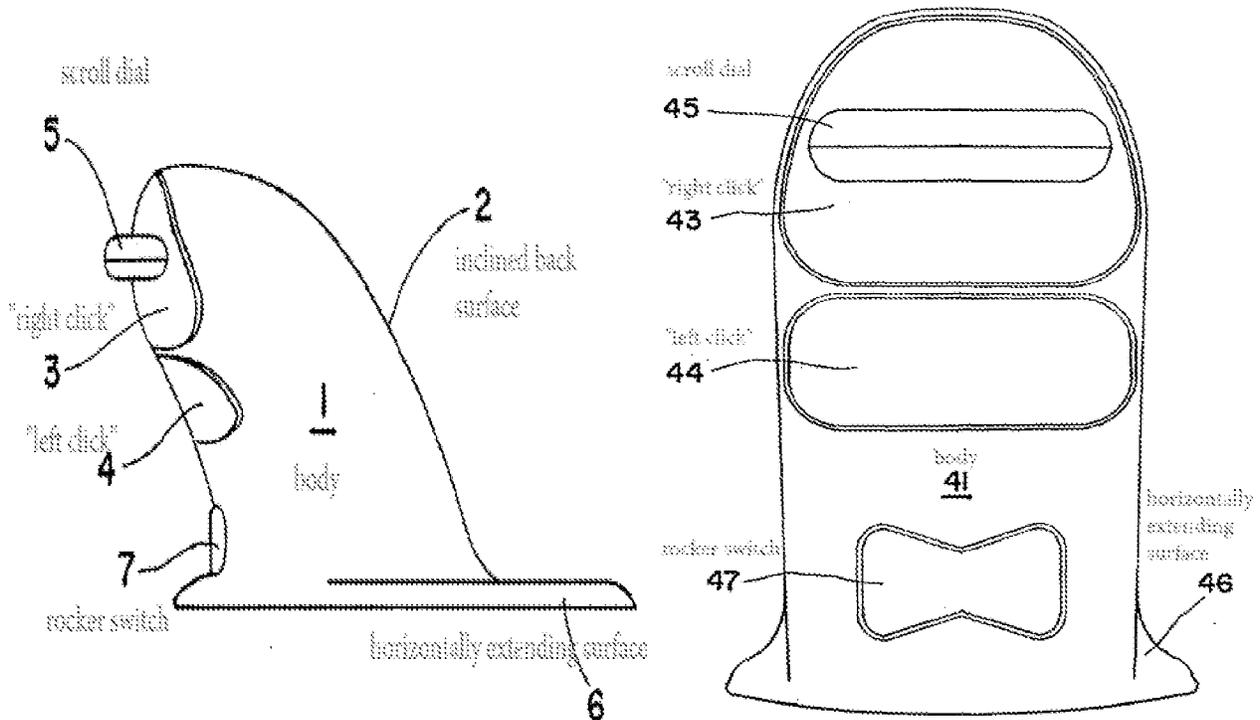


Figure 1 shows a side view

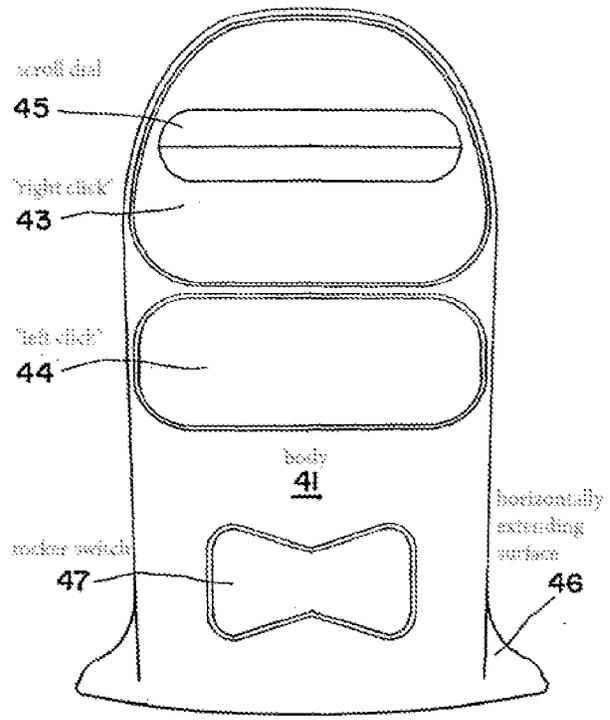


Figure 4 shows a front view

As shown in Appellant’s Figures 1 and 4, the “point and click device” comprises a body (1) having a forwardly-inclined back surface (2) configured for supporting the palm of a user’s hand and an upright front surface accessible by the fingers of a user’s hand when gripping the device; “right click” (3, 43) and “left click” (4, 44) buttons arranged one above the

other centrally on the upright front surface, a scroll dial (5, 45) arranged in alignment with the “right click” and “left click” buttons (3, 43) (4, 44), and a select button associated with the scroll dial (5, 45). Spec. 2; Abstract.

Claim 7 is the only independent claim on appeal and is illustrative of Appellant’s invention, shown in Figure 1, as reproduced below:

7. A point and click device for a computer work station, which provides for ambidextrous operation, comprising:

a body [1] having a forwardly-inclined back surface [2] configured for supporting the palm of a user's hand, a front surface accessible by the fingers of a user’s hand when gripping the device, and a base which, in use, contacts a fixed horizontal surface and includes a horizontally-extending surface [6] on which the heel of a user’s hand may be rested;

right-click and left-click buttons [3, 4] which are arranged one above the other centrally of the front surface;

a scroll dial [5] arranged on the front surface in alignment with the right-click and left-click buttons and rotatable in a horizontal plane about a vertical axis; and

a select button associated with the scroll dial.

App. Br. 20 (Claims App’x) (brackets added).

Examiner’s Rejections and References

(1) Claims 7–12 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tan (WO 2005/023374 A1; published Mar. 10, 2005) and Ram (US 2006/0007151 A1; published Jan. 12, 2006). Final Act. 6–10.

(2) Claims 7 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rodgers (US 6,545,665 B2; issued Apr. 8, 2003), Tan, and Ram. Final Act. 10–12.

ISSUES

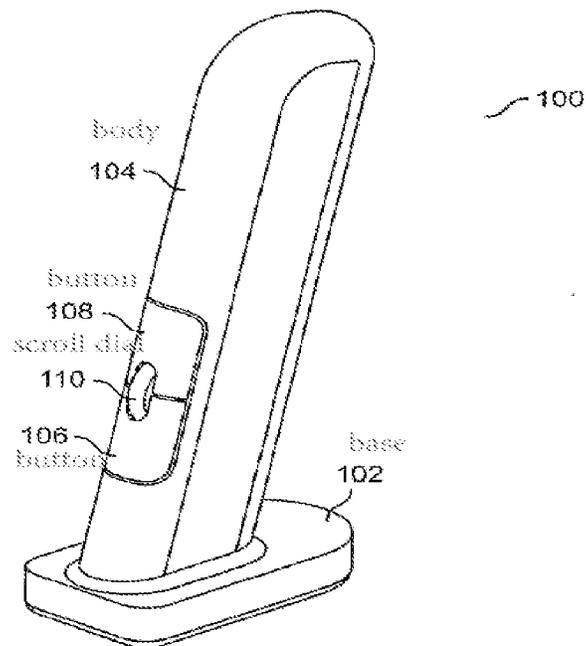
Based on Appellant's arguments, the dispositive issues presented on appeal are: (1) whether the combination of prior art references teaches or suggests several limitations of Appellant's claim 7; and (2) whether the Examiner has provided articulated reasoning with rational underpinning to support the conclusion of obviousness. App. Br. 3–18; Reply Br. 2–3.

ANALYSIS

35 U.S.C. § 103(b): Claims 7–12 and 14 based on Tan and Ram

With respect to independent claim 7, the Examiner finds Tan teaches Appellant's "point and click device [100] for a computer work station, which provides for ambidextrous operation" shown in Figure 1, equipped with all the claimed limitations including a body (104), "right-click" and left-click" buttons (106, 108), and a scroll dial (i.e., navigation wheel) (110) arranged on the front surface of body (104) in alignment with the "right-click" and left-click" buttons (106, 108). Final Act. 6–7 (citing Tan 4:3–9, 16–21, Fig. 1).

Tan's Figure 1 shows a point and click device (i.e., mouse), as reproduced below with additional markings.



Tan's Figure 1 shows a point and click device (100) including a body (104), "right-click" and left-click" buttons (106, 108), and a scroll dial (110).

The Examiner acknowledges Tan does not explicitly teach the recited functionality of the "scroll dial" 110, i.e., "the scroll dial [that] is rotatable in a horizontal plane about a vertical axis," but relies on Ram for teaching the recited functionality to support the conclusion of obviousness. Final Act. 7–8 (citing Ram, Fig. 22).

Appellant disputes the Examiner's factual findings regarding Tan and Ram. App. Br. 8–12; Reply Br. 2–3. For example, Appellant acknowledges Tan's "point and click device" is provided with a body (handle) (104) supported by a base (102), and the body (104) includes "right-click" and left-click" buttons (106, 108) shown in Figure 1. App. Br. 8. However, Appellant argues Tan does not disclose the claimed "body" (handle 104, shown in Tan, Fig. 1) as having (1) "a forwardly-inclined back surface configured for supporting the palm of a user's hand" and (2) "a horizontally-

extending surface on which the heel of a user's hand may be rested," as recited in claim 7. *Id.* In particular, Appellant argues: (1) "the backwards incline of the handle [body] 104 would prevent the hand from resting on the back surface of the handle [body] 104" and, as such, "a user's palm cannot be supported by the back surface of the handle [body] 104 in Tan"; and (2) Tan's base 102, shown in Figure 1, "is adapted to support the handle [body] 104," and "is not configured to support the palm of a user." *Id.* at 9 (emphasis added). In addition, Appellant argues Tan's

base 102 shown in Fig. 1 is not of a size on which the heel of the user's hand could be rested when the user's fingers are wrapped around the handle of the body 104 [because] if the heel of the user's hand were to be rested on the base 102 shown in Fig. 1, the user's hand would not be large enough to wrap fingers around the body 104 to access the buttons 106, 108.

Id. at 10.

Likewise, Appellant argues Ram does not teach "a scroll dial that is rotatable in a horizontal plane about a vertical axis" and, as such, does not cure the deficiency of Tan. *Id.* at 11. According to Appellant,

Both Tan and Ram teach a scroll dial rotatable in a vertical plane about a horizontal axis such that a normal forwards/backwards finger motion operates the dial.

Neither Tan nor Ram provide any motivation for arranging the scroll dial of Tan to be rotatable in a horizontal plane about a vertical axis. The objective of Tan is to provide a pen-like mouse by reducing the width and height of the mouse. Arranging the scroll dial of Tan to rotate in the horizontal plane about a vertical axis would require increasing the width of the Tan mouse, contrary to the disclosed objective in Tan.

Id. (emphasis added).

Lastly, Appellant argues “there is simply no motivation provided in Tan or in Ram for a combination of the references.” *Id.* Thus, Appellant asserts, because “Tan discloses a pen-like mouse” “there is conceivably no motivation for the skilled person to contemplate the application of features of a conventional palm mouse, such as disclosed by Ram” and “a skilled person would have no reason to look to Ram for improvements on the scroll dial arrangement of Tan.” *Id.* at 12.

We do not find Appellant’s arguments persuasive. Rather, we find the Examiner has provided a comprehensive response to Appellant’s arguments supported by a preponderance of evidence. Ans. 2–6. As such, we adopt the Examiner’s findings and explanations provided therein. *Id.*

For additional emphasis, we note claim terms are given their broadest reasonable interpretation consistent with the Specification. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004). Under the broadest reasonable interpretation, claim terms are accorded their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

In common parlance, the term “configured to” means “capable of” or “suitable for.” *See Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d 1335, 1349 (Fed. Cir. 2012); *In re Giannelli*, 739 F.3d 1375, 1379 (Fed. Cir. 2014). However, the word “may” in the phrase “where heel of a user’s hand may be rested” as recited in Appellant’s claim 7 is optional. As such, we agree with the Examiner that (1) the back surface of Tan’s “body” shown in Figure 1 is capable of supporting the palm of a user’s hand and (2) the

horizontally-extending surface of Tan's base can provide a rest spot where the heel of a user's hand may or may not be rested. Final Act. 6; Ans. 2–3.

Regarding the adjective “forwardly-inclined” used to describe the “back surface” of Appellant's claim 7, we observe that adjective is insufficient to distinguish over the back surface of Tan's “body” shown in Figure 1. This is because Appellant's claim 7 does not define (1) the specific structure of the “body” and (2) the relation between the back surface and the front surface, i.e., whether the back surface is inclined toward the front or the base of Appellant's claimed “body.” As such, we interpret the term “forwardly-inclined back surface” as encompassing the “back surface” of Tan's “body” shown in Figure 1 as Tan's “back surface” can also be seen as being “forwardly-inclined” toward the base.

Turning now to the “scroll dial” limitation, we also agree with the Examiner that:

“[i]f one were to take the orientation of the two buttons and scroll dial of Ram and superimpose them on orientation of the click buttons of Tan, the scroll dial would be oriented in the horizontal direction rotatable around the vertical axis. This would allow for the intuitive use of the scroll dial while maintaining the structural design of the device of Tan.

Ans. 5 (emphasis added).

In the Reply, Appellant alleges the Examiner's reliance on “common sense in lieu of any teaching or suggestion in the references” to rotate the scroll dial in a horizontal plane about a vertical axis. Reply Br. 3. However, Appellant's allegation is misplaced. Common sense, common wisdom, and common knowledge have “long been recognized to inform the analysis of obviousness if explained with sufficient reasoning.” *See Perfect Web*

Techs., Inc. v. InfoUSA, Inc., 587 F.3d 1324, 1328 (Fed. Cir. 2009). In particular, common sense or common knowledge can be invoked to provide a suggestion or motivation to combine or modify a prior art reference. See *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1361 (Fed. Cir. 2006). The “use of common sense does not require a ‘specific hint or suggestion in a particular reference,’ only a reasoned explanation that avoids conclusory generalizations.” *Perfect Web*, 587 F.3d at 1329 (quoting *DyStar*, 464 F.3d at 1366); see also *Plantronics, Inc. v. Aliph, Inc.*, 724 F.3d 1343, 1354 (Fed. Cir. 2013) (“the mere recitation of the words ‘common sense’ without any support adds nothing to the obviousness equation.”); *Ball Aerosol & Specialty Container, Inc. v. Ltd. Brands, Inc.*, 555 F.3d 984, 993 (Fed. Cir. 2009) (“the analysis that ‘should be made explicit’ refers not to the teachings in the prior art of a motivation to combine, but to the court’s analysis.”).

The test for obviousness is not whether the claimed invention is expressly suggested in the references, but whether the claimed subject matter would have been obvious to those of ordinary skill in the art in light of the *combined teachings* of those references. See *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). In an obviousness analysis, it is not necessary to find precise teachings directed to the specific subject matter claimed because inferences and creative steps that a person of ordinary skill in the art would employ can be taken into account. See *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). In this regard, “[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.” *Id.* at 421.

As correctly recognized by the Examiner, if the “scroll dial” and buttons as disclosed by Ram were to be incorporated into Tan’s “point and click” device, we agree with the Examiner that

it would have been obvious . . . to re-orient the scroll dial to be rotatable in a horizontal direction about a vertical axis [in the manner recited in Appellant’s claim 7] because it would allow for the intuitive use of the scroll dial while maintaining the structural design of the device of Tan.

Ans. 6 (emphasis added).

“Under 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*, 550 U.S. at 420 (emphasis added).

The Examiner has provided reasoning to combine Tan and Ram, i.e., it would have been obvious . . . that when designing an upright mouse, in the manner of Tan, to maintain the general orientation of the mouse buttons and scroll wheel, such as in the manner of Ram, to allow the user to maintain a similar hand position and movement as with a conventional mouse. By rotating the orientation of the buttons from a horizontal layout to a vertical layout of the same construction, similar to the configuration of the buttons of Tan, the buttons and scroll wheel can be oriented on the upright mouse such that the buttons are arranged one on top of the other, with the scroll wheel located between the two buttons in a horizontal orientation. This would provide the added benefit of being more user-friendly and intuitive than for a user to have to learn a new type of hand configuration and motion, and would still allow the upright mouse to be operated as intended.

See Final Act. 7–8.

In response, Appellant has not explained to us why the Examiner's rationale is erroneous or why a person of ordinary skill in the art *would not* have reached the conclusions reached by the Examiner. *See DyStar*, 464 F.3d at 1368. Accordingly, we are not persuaded by Appellant's arguments that the Examiner has failed to articulate a sufficient rationale for combining Tan and Ram.

We also note Appellant has 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 has Appellant 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, Inc.*, 725 F.3d 1341, 1352 (Fed. Cir. 2013).

For the foregoing reasons, Appellant has not demonstrated Examiner error. Accordingly, we sustain the Examiner's obviousness rejection of independent claim 7 based on Tan and Ram, and its dependent claims 8, 11, 12, which Appellant does not argue separately.

Claims 9 and 10

Claims 9 and 10 depend from claim 7, and further recite "a rocker switch in vertical alignment with the right-click and left-click buttons and being operable as a power switch" or "for use in panning horizontally across an on-screen image."

The Examiner finds Ram teaches the use of a rocker switch 222 in vertical alignment with the right-click and left-click buttons and being

operable as “a power switch” or “for use in panning horizontally across an on-screen image. Final Act. 8–9 (citing Ram ¶¶ 150–151, Figs. 5, 15).

Appellant argues Ram teaches a 5-way navigation button 222 including a center button 223 used to scroll and navigate content, and does not teach the use of a rocker switch as a power switch in vertical alignment with the right and left click buttons. App. Br. 12–13.

We disagree and adopt the Examiner’s explanation provided in the Examiner’s Answer, noting that “buttons 224, 226 and 222 all overlap (i.e. are vertically aligned) along the line separating buttons 224 and 226 (fig. 15).” Ans. 6.

For these reasons, we also sustain the Examiner’s obviousness rejection of claims 9 and 10 under 35 U.S.C. § 103(a) based on Tan and Ram.

35 U.S.C. § 103(a): Claims 7 and 13 based on Rodgers, Tan, and Ram

In support of the rejection of the same claim 7, the Examiner finds Rodgers teaches Appellant’s “point and click device” comprising

a body (10) having a forwardly-inclined back surface configured for supporting the palm of a user's hand, a front surface accessible by the fingers of a user's hand when gripping the device, and a base which, in use, contacts a fixed horizontal surface and includes a horizontally extending surface on which the heel of a user's hand may be rested

and “buttons which are arranged one above the other centrally on the front surface.” Final Act. 10 (citing Rodgers 5:6–31, Figs. 1, 22–23).

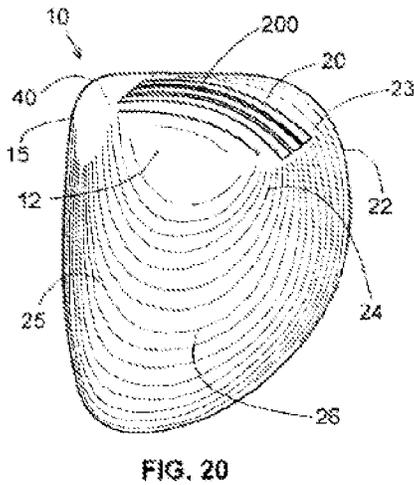


Fig. 20, Rodgers

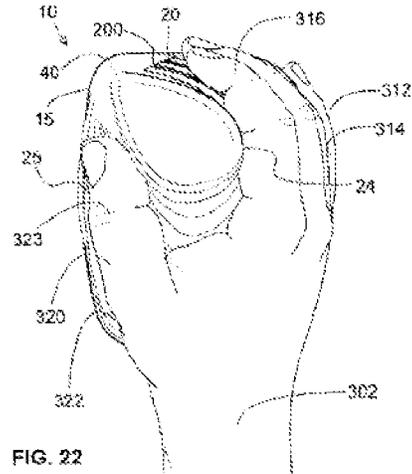


Fig. 22, Rodgers

Appellant also argue because Rodgers teaches a “conventional mouse that allows the palm of the hand to rest on the body” “there is conceivably no motivation for the skilled person to contemplate the application of the features of the pen-like mouse of Tan” for improvement. App. Br. 18.

The Examiner responds that “Rodgers does not explicitly teach that the device could not be used by the left hand of a user.” Ans. 7.

We acknowledge that the term “ambidextrous” recited in the preamble of claim 7 refers to Appellant’s claimed “point and click” device provided with “good ergonomic design and also ambidextrous design so that use can quickly and easily be switched from right to left or left to right hand.” Spec. 2:1–4). However, the recitation of such a term in the preamble does not limit the scope of Appellant’s claim 7 particularly, “when it merely states a purpose or intended use of the invention.” *In re Paulsen*, 30 F.3d 1475, 1479 (Fed. Cir. 1994). The term “ambidextrous” can only be limiting “if it recites essential structure or steps, or if it is ‘necessary to give life, meaning,

and vitality’ to the claim.” *American Medical Systems, Inc. v. Biolitec, Inc.*, 618 F.3d 1354, 1358–1359 (Fed. Cir. 2010)

In this situation, we find the term “ambidextrous” is not tied to the body of the claim and does not “give life, meaning, and vitality” to Appellant’s claim 7. As such, we are not persuaded by Appellant’s argument.

Nevertheless, we have reviewed the cited portion of Rodgers and see no evidence in the record to support the Examiner’s finding that Rodgers teaches

a body having a forwardly-inclined back surface configured for supporting the palm of a user’s hand, a front surface accessible by the fingers of a user’s hand when gripping the device, and a base which, in use, contacts a fixed horizontal surface and includes a horizontally-extending surface on which the heel of a user’s hand may be rested

as recited in Appellant’s claim 7.

For this reason, we do not sustain the Examiner’s obviousness rejection of claim 7 based on Rodgers, Tan, and Ram and its dependent claim 13.

CONCLUSION

On the record before us, we conclude Appellant has not demonstrated the Examiner erred in rejecting claims 7–12 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Tan and Ram. However, we also conclude Appellant has demonstrated the Examiner erred in rejecting claims 7 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Rodgers, Tan, and Ram.

DECISION

As such, we AFFIRM the Examiner's Final Rejection of claims 7–12 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Tan and Ram. However, we REVERSE the Examiner's Final Rejection of claims 7 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Rodgers, Tan, and Ram.

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-IN-PART

DISSENTING OPINION

CUTITTA, *Administrative Patent Judge*.

I disagree with the reasoning of the majority for the rejection of claims 7–12 and 14 based on the combination of Tan and Ram, because the majority’s construction of the “forwardly-inclined back surface” limitation is inconsistent with the plain language of independent claim 7 and Appellant’s Specification.

With reference to annotated Figure 1 of Tan (illustrated at page 2 above), independent claim 7 recites, in part, “a body [1] having a forwardly-inclined back surface [2] configured for supporting the palm of a user’s hand, a front surface accessible by the fingers of a user’s hand when gripping the device” and “right-click and left-click buttons [3, 4] which are arranged one above the other centrally of the front surface.” Accordingly, the claim specifically defines the front surface as the surface upon which right-click and left-click buttons [3, 4] are arranged. There is no other surface of body 1 recited in claim 7 that includes the right-click and left-click buttons [3, 4] and, as such, body 1 recites only a single front surface. In addition, claim 7 specifically recites the back surface [2] is forwardly-inclined. An ordinary and customary meaning of the term “forwardly” is “leading toward a position in front.” (“Forward.” def. 4a. Merriam-Webster.com. Merriam-Webster, n.d. Web. Dec. 15, 2016.) Because claim 7 recites a forwardly-inclined back surface [2], this limits the back surface to being inclined in the forward direction, i.e., in the direction of the front surface of body 1. Thus, in contrast with the majority, I believe the interpretation of “forwardly inclined” cannot be divorced from the rest of the claim which recites only a single front surface. In view of this, to be

forwardly inclined, the back surface [2] must be inclined toward the front surface of body 1 upon which right-click and left-click buttons [3, 4] are arranged. Furthermore, Appellant's Specification, as illustrated by Figure 1, confirms there is no other embodiment contemplated besides the embodiment having a "forwardly-inclined back surface." Therefore, the majority's construction of claim 7 indicating the back surface [2] is inclined toward the base of Appellant's claimed body (i.e., is backwardly inclined) is inconsistent with Appellant's Specification, as well as being inconsistent with the plain language of the claim.

Accordingly, I disagree with the finding of the majority that Appellant's claim 7 does not define "whether the back surface [2] is inclined toward the front or the base of Appellant's claimed 'body.'" To the contrary, I find that the forwardly-inclined back surface of claim 7 must be inclined in the direction of the front surface of body 1 on which the right-click and left-click buttons [3, 4] are arranged.

In contrast, with reference to annotated Figure 1 of Tan (illustrated at page 5 above), Tan's body 104 has a back surface [2] that is backwardly-inclined because it is inclined away from the front surface upon which buttons 106 and 108 are disposed. I therefore disagree with the finding by the majority that Tan suggests "a body having a forwardly-inclined back surface," as recited in independent claim 7.

For these reasons, I DISSENT from the majority decision affirming the rejection of claims 7–12 and 14 over Tan and Ram, which I would reverse. I CONCUR in the majority decision reversing the rejection of claims 7 and 13 over Rodgers, Tan, and Ram.