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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEPHEN HAYDEN COTTERILL

Appeal 2018-001661
Application 13/077,670
Technology Center 2100

Before MAHSHID D. SAADAT, NORMAN H. BEAMER, and
JOYCE CRAIG, *Administrative Patent Judges*.

CRAIG, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–17. *See* Non-Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Apple Inc. Appeal Br. 3.

CLAIMED SUBJECT MATTER

The claims are directed to a device, method, and graphical user interface for switching between two user interfaces. Spec. Title. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1 An electronic device, comprising:

- a display;
- a touch-sensitive surface;
- one or more processors;
- memory; and

- one or more programs, wherein the one or more programs are stored in the memory and configured to be executed by the one or more processors, the one or more programs including instructions for:

- displaying a first user interface on the display;

- displaying a graphical object at a first location on the display;

- while displaying the graphical object at the first location on the display, detecting a first gesture by a user on the touch-sensitive surface, the first gesture starting at a location on the touch-sensitive surface that corresponds to the first location of the graphical object on the display;

- in response to detecting the first gesture, transitioning to a second user interface, the transitioning comprising:

- moving the graphical object across the display;

- displaying a second user interface on the display, distinct from the first user interface;

- detecting a termination of the first gesture; and

- in response to detecting the termination of the first gesture, continuing to move the graphical object to a second location on the display, distinct from the first location;

- while displaying the graphical object at the second location on the display, detecting a second gesture by the user on the touch-sensitive surface, the second gesture starting at a location on the touch-sensitive surface that corresponds to the second location of the graphical object on the display;

- and,

in response to detecting the second gesture, transitioning to the first user interface, the transitioning comprising:
moving the graphical object across the display;
displaying the first user interface on the display;
detecting a termination of the second gesture; and
in response to detecting the termination of the second gesture, continuing to move the graphical object to the first location on the display.

REJECTIONS

Claims 1–8, 11, 12, and 14–17 stand rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Kim (US 2008/0158189 A1, published July 3, 2008) in view of Ording (US 2010/0235794 A1, published Sept. 16, 2010). Non-Final Act. 2.

Claims 9 and 10 stand rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over the combination of Kim, Ording, and Chaudhri et al. (US 2009/0064055A1, published March 5, 2009) (“Chaudhri”). Non-Final Act. 7.

Claim 13 stands rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over the combination of Kim, Ording, and Garside et al. (US 2006/0209040 A1, published Sept. 21, 2006) (“Garside”). Non-Final Act. 9.

ANALYSIS

Rejection of Claims Under 35 U.S.C. § 103(a)

We have reviewed the rejections of claims 1–17 in light of Appellant’s arguments that the Examiner erred. We have considered in this decision only those arguments Appellant actually raised in the Briefs. Any other arguments Appellant could have made, but chose not to make, in the Briefs are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Appellant's arguments are not persuasive of error. We agree with and adopt as our own the Examiner's findings of facts and conclusions as set forth in the Answer and in the Action from which this appeal was taken. We provide the following explanation for emphasis.

Claims 1–8, 11, 12, and 14–17 (Group A)

Appellant argues claims 1–8, 11, 12, and 14–17 as a group. Appeal Br. 14. We select independent claim 1 as representative of the group of claims pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(iv).

With respect to representative claim 1, Appellant contends that the Examiner erred because the cited portions of Kim and Ording do not teach or suggest a detection of the first gesture and a detection of the termination of the same first gesture. Appeal Br. 15. Appellant further argues that the cited portions of the prior art do not teach or suggest that, in response to the detection of a gesture that starts at a location corresponding to the location of a graphical object, the graphical object moves across the display (as part of transitioning to a second user interface). *Id.* Appellant also argues that the cited prior art does not teach or suggest that, in response to detection of the termination of the gesture, the graphical object continues to move across the display to a second location. *Id.*

We are not persuaded that the Examiner erred. The Examiner found that the display regions in Kim are separated by a movable menu bar (“graphical object”), and that the user performs a drag operation (“gesture”) on the menu bar to transition from one display region to the other. Ans. 3 (citing Kim Fig. 3B). The Examiner further found that Ording teaches scrolling a display screen using a swipe gesture, which moves the screen from a first position to a second position. The Examiner also found that

Ording teaches that, after the user's finger is lifted off the screen (“termination of first gesture”), the scrolling continues until the end of the screen is reached. *Id.* (citing Ording ¶ 152).

Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). The test for obviousness is not whether the claimed invention is expressly suggested in any one or all of 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).

Here, Appellant attacks the prior art references individually, even though the Examiner relied on the combined teachings of Kim and Ording in rejecting claim 1. Appellant, for example, argues that Kim teaches a draggable menu bar that stops moving when the termination of a drag gesture is detected. Appeal Br. 15–19. The Examiner, however, relied on Ording in combination with Kim as teaching the limitation “in response to detecting the termination of the first gesture, continuing to move the graphical object to a second location on the display, distinct from the first location.” Non-Final Act. 4 (citing Ording ¶ 152). Similarly, Appellant argues that “Ording is not directed to methods for moving individual graphic objects[.]” Appeal Br. 26. The Examiner, however, relied on Kim for the recited “graphical object” and the recited limitations “in response to detecting the first gesture, transitioning to a second user interface, the transitioning comprising: moving the graphical object across the display[.]” Non-Final Act. 4.

Because Appellant’s arguments are not commensurate in scope with the Examiner’s rejection, which was based on the combined teachings of Kim and Ording, we are not persuaded that the Examiner erred in finding that the combination of Kim and Ording teaches or suggests the disputed limitations of claim 1.

Appellant next contends that the Examiner relied on impermissible hindsight reasoning in rejecting claim 1. Appeal Br. 27. In particular, Appellant argues that “[t]he Examiner’s two-sentence ‘articulation of the reason’ [to combine the references] is not sufficient to establish a *prima facie* case of obviousness.” *Id.*

We disagree with Appellant. The Examiner has set forth articulated reasoning with rational underpinnings for the combination. Non-Final Act. 5. Appellant has not identified any knowledge relied upon by the Examiner that was gleaned only from Appellant’s disclosure and that was not otherwise within the level of ordinary skill in the art at the time of invention. *See In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971). Nor has Appellant provided objective evidence of secondary considerations, which “operates as a beneficial check on hindsight.” *Cheese Sys., Inc. v. Tetra Pak Cheese and Powder Sys., Inc.*, 725 F.3d 1341, 1352 (Fed. Cir. 2013).

For these reasons, we are not persuaded that the Examiner erred by engaging in hindsight.

Appellant next contends that the Examiner failed to consider that Kim “teaches away” from continuing to move the moveable menu bar after the gesture terminates. Appeal Br. 31–32 (citing Kim ¶¶ 45, 49).

Appellant’s “teaching away” argument is not persuasive because Appellant has not identified where Kim actually criticizes, discredits, or

otherwise discourages “in response to detecting the termination of the first gesture, continuing to move the graphical object to a second location on the display, distinct from the first location.” *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004); *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1327 (Fed. Cir. 2009) (“A reference does not teach away, however, if it merely expresses a general preference for an alternative invention but does not ‘criticize, discredit, or otherwise discourage’ investigation into the invention claimed”) (citing *Fulton*). Appellant has not persuaded us that the cited paragraphs 45 and 49 of Kim criticize, discredit, or otherwise discourage the disputed limitation.

Appellant’s argument that combining Kim and Ording would “require a significant change to Kim’s principle of operation and render Kim unsatisfactory for its intended purpose” also fails. Appeal Br. 32. Appellant argues that “[m]odifying Kim such that the menu bar continues to move *after* the drag gesture ends would mean that the user would no longer be able to specify the desired relative sizes of the two display regions.” *Id.*

It is well settled that “a determination of obviousness based on teachings from multiple references does not require an actual, physical substitution of elements.” *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012) (citations omitted). Nor is the test for obviousness whether a secondary reference’s features can be bodily incorporated into the structure of the primary reference. *See Keller*, 642 F.2d at 425. The Supreme Court has held that “analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

For these reasons, we are not persuaded that the Examiner erred in combining the cited teachings of Kim and Ordning.

Accordingly, we sustain the Examiner's § 103(a) rejection of independent claim 1, as well as the Examiner's § 103(a) rejection of independent claims 15, 16, and 17, argued in the group with claim 1. We also sustain the Examiner's § 103(a) rejection of dependent claims 2–8, 11, 12, and 14, argued as a group with claim 1.

Claims 9 and 10 (Group B)

Appellant argues that the § 103(a) rejection of dependent claims 9 and 10 should be reversed for the reasons discussed above for claim 1, because Chaudhri does not cure the alleged deficiencies of Kim and Ordning. Appeal Br. 33–34.

For the reasons discussed above with regard to claim 1, we are not persuaded that the Examiner erred in rejecting claims 9 and 10. Accordingly, we sustain the Examiner's § 103(a) rejection of claims 9 and 10.

Claim 13 (Group C)

In addition to the arguments discussed above for claim 1, Appellant contends that the rejection of dependent claim 13 should be reversed because the combination of Kim, Ordning, and Garside does not teach or suggest the limitation “wherein the first gesture is a tap gesture and the second gesture is a tap gesture,” as recited in claim 13. Appeal Br. 34. Appellant argues that it would not be possible to substitute Garside's tap gesture for Kim's draggable menu bar. *Id.* at 35–37. Appellant further argues that “it is not possible for the graphical object to *continue* to move in response to detecting the termination of a tap gesture, because the graphical object would not have started moving *before* Garside detected the termination of a

tap gesture.” *Id.* at 37. Moreover, Appellant argues that the Examiner used hindsight reconstruction to “cherry-pick one feature from Garside (tapping an activation target to scroll a keyboard) *without* due consideration of either the claim language or how Garside’s feature would be applied to Kim according to Kim’s and Garside’s teachings.” *Id.* at 34–35.

We are not persuaded that the Examiner erred. As we explained above with regard to independent claim 1, from which claim 13 depends, nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See Merck*, 800 F.2d at 1097. The test for obviousness is not whether the claimed invention is expressly suggested in any one or all of 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 Keller*, 642 F.2d at 425.

Here, Appellant has not persuaded us that the claimed subject matter would not have been obvious to those of ordinary skill in the art in light of the combined teachings of the cited references. The Examiner found that although Kim does not expressly disclose the first gesture is a tap gesture and the second gesture is a tap gesture, Garside teaches tap gestures. Non-Final Act. 5 (citing Garside Figs. 5D–5F, ¶ 63). “[A] determination of obviousness based on teachings from multiple references does not require an actual, physical substitution of elements.” *Mouffet*, 686 F.3d at 1332 (citations omitted). Nor is the test for obviousness whether a secondary reference’s features can be bodily incorporated into the structure of the primary reference. *See Keller*, 642 F.2d at 425.

Appellant’s “hindsight” argument is not persuasive because the Examiner has set forth articulated reasoning with rational underpinnings for the combination. Non-Final Act. 9. Appellant has not identified any knowledge relied upon by the Examiner that was gleaned only from Appellant’s disclosure and that was not otherwise within the level of ordinary skill in the art at the time of invention. *See McLaughlin*, 443 F.2d at 1395. Nor has Appellant provided objective evidence of secondary considerations, which “operates as a beneficial check on hindsight.” *Cheese Sys.*, 725 F.3d at 1352.

For these reasons, we sustain the Examiner’s § 103(a) rejection of claim 13.

DECISION

We affirm the decision of the Examiner rejecting claims 1–17.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–8, 11, 12, 14–17	103(a)	Kim, Ording	1–8, 11, 12, 14–17	
9, 10	103(a)	Kim, Ording, Chaudhri	9, 10	
13	103(a)	Kim, Ording, Garside	13	
Overall Outcome:			1–17	

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED