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CUBIC DESIGN STUDIOS LLC  
3383 N FIVE MILE RD #261  
BOISE, ID 83713-3925

EXAMINER
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* WAI-LIN MAW

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Appeal 2018-007753  
Application 12/390,482  
Technology Center 2600

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Before KARA L. SZPONDOWSKI, SCOTT B. HOWARD, and  
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

SZPONDOWSKI, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> filed a Request for Rehearing under 37 C.F.R.  
§ 41.52(a)(1) (hereafter “Request”) on January 12, 2020 for reconsideration  
of our Decision mailed December 13, 2019 (hereafter “Decision”). We  
consider our Decision in light of Appellant’s Request, but we decline to  
change the Decision.

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<sup>1</sup> 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 Cubic  
Design Studios LLC. Request 3.

## ANALYSIS

A Request for Rehearing “must state with particularity the points believed to have been misapprehended or overlooked by the Board.” 37 C.F.R. § 41.52(a)(1). It may not rely upon new evidence or new arguments except as permitted by §§ 41.52(a)(2)–(4). *Id.* A Request for Rehearing is not an opportunity for the requesting party to reargue its case or merely to express disagreement with the Decision.

### *Claim 1*

Appellant contends the Board did not address Appellant’s arguments as to “why Zadesky’s teaching alone would have satisfied the [E]xaminer’s reason to combine ‘ . . . because it will permit the touchpad to be used as a mouse replacement device and also as an input device when the push buttons are actuated’ . . . [and] therefore would have been obvious not to combine the references.” Request 8. Specifically, Appellant argues “modifying Tiphane to include Zadesky’s touch functionality to serve as a mouse replacement pointing device changes the sequen[ce] of events and generation of signals for the same sequence of events (hover to depress key) . . . which would cause signal ambiguity without any measures to differentiate the true intent of the key press.” Request 9. Appellant also cites to an embodiment of Tiphane disclosing displaying the function of a key in a window, and argues that this, too, would render Tiphane inoperative due to signal ambiguity. Request 10.

Appellant is incorrect that the foregoing arguments were not addressed in the Decision. *See* Decision 4–8. As set forth in the Decision, Zadesky teaches a touch pad that provides a first type of input that tracks movement and a second type of input involving a pushbutton. Decision 6 (citing Zadesky col. 7, ll. 25–31; col. 8, ll. 25–46). Tiphane describes using

a proximity detector to indicate the function of a key on a keyboard without activating the function. Decision 7 (citing Tiphane, col. 1, ll. 58–67).

Tiphane teaches that a different proximity of the user’s finger to the key *or* pressure in the user’s touch on the key may activate different functions.

Decision 6 (citing Tiphane, col. 4, ll. 14–26). Tiphane does *not* require that the function is invoked at the touch of a key. *See* Tiphane, col. 1, ll. 63–66 (“This allows a user to determine what a particular key on a keyboard or other device will do by simply hovering the user’s finger near the top of the key, *or* lightly touching the key without depressing it.”) (emphasis added).

Appellant’s arguments involve various embodiments of Tiphane. *E.g.*, Request 9–10 (citing Tiphane, col. 2, ll. 3–5 (“*Alternately*, a small window on a computer display may be used.”) (emphasis added); col. 2, l. 66–col. 3, l. 2 (“*For example*, the event may be the indication of an e-mail message.”) (emphasis added)). However, as discussed in the Decision, and stated by the Examiner, “[t]he combination of the references was not used to show the combination of *all* of the functionalities taught by the references.” Decision 6 (citing Ans. 3 (alteration in original) (emphasis added)). The combination proposed by the Examiner permits use of Zadesky’s *touch functionality* to be used to track the user movement, rather than to invoke a function. *See* Ans. 3. Accordingly, for the reasons set forth in the Decision (Decision 4–8), Appellant’s arguments are not persuasive.

### *Claim 11*

Appellant takes issue with the statement in the Decision that “[a]lthough Tiphane mentions an embodiment where a ‘speaker of a computer can provide an audible indication of the key function, which would especially be useful for blind users,’ there is no further disclosure in

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Tiphane to support that its primary function or intended purpose is for the blind.” Request 11 (citing Decision 9).

Appellant argues “despite a number of references to ‘window’ and ‘display’ (Tiphane col. 2 line 3–5) there is no further disclosure in Tiphane to support that its primary function or intended purpose of the embodiment in Fig. 3 is for the sighted.” Request 11. According to Appellant, “[i]n absence [of] an express disclosure for either the sighted or the blind, if it can be deduced that the embodiment in Fig. 3 is for the sighted, then, it must also be the case that it can be deduced that the embodiment in Fig. 4 is for the blind.” Request 11. Appellant further argues “[h]aving derived and established that the embodiment in Fig. 4 is for the blind, it entails that the proposed modification (Dec. on Appeal 9) would make Tiphane inoperative, which would be analogous to replacing the Brail with a display screen for the blind.” Request 12.

Appellant further argues that “[t]he Board did not address the argument that the proposed modification would rather make the combination feel less like a regular keyboard instead.” Request 12. Appellant argues “[t]he proposed modification would not only make the primary reference inoperative, but also fail to serve the purpose as claimed by the office (more like a regular keyboard), refuting reasonable expectations for success for achieving the claimed invention.” Request 12.

Appellant also argues

The Board seemed to have suggested that obviousness of the prior art is not refuted when the meaningful advantages outweigh disadvantages “ . . . the mere existence of disadvantages resulting from a modification does not refute the obviousness of the modification when the prior art indicates the modification also offers an advantage.” (Dec. on Appeal 10, *Medichem, S.A. v. Rolabo, S.L* 437 F.3d 1157 (Fed. Cir. 2006)

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and *Winner Intern. Royalty Corp. v. Wang* 202 F.3d 1340 (Fed. Cir. 2000)).

Appellant submits that the reverse would also be true by the same rationale, refuting the obviousness of the prior art, rendering the prior art unobvious, when a feature that is distinctly advantageous is replaced with another feature that does not offer a meaningful advantage, i.e. replacing the air gap between keys with a display screen (Appeal Br. 15–16), since the disadvantages heavily outweigh meaningful advantages.

Request 12–13 (emphasis added).

Appellant is incorrect that these arguments were not addressed in the Decision. *See* Decision 4, 8–10. We note that in the Decision, we acknowledged that we have adopted as our own the Examiner’s findings and conclusions as set forth in the Examiner’s Answer and Final Action. Decision 4, 10. Therefore, to the extent Appellant is arguing that a point was overlooked because it was not explicitly addressed, we find that argument unavailing. Furthermore, Appellant appears to be rearguing its case and disagreeing with our findings, rather than addressing a point that was overlooked. We remain unpersuaded that the intended purpose or primary function of Tiphane’s Figure 4 is for the blind. *See* Decision 9. The only mention of use by the blind is in reference to the use of a speaker for an audible indication of the key function. Tiphane, col. 2, ll. 3–5. As stated in our Decision, there is no further disclosure in Tiphane to support that its primary function or intended purpose (for Figure 4 or otherwise) is for blind users. *See* Decision 9.

*Claims 18 and 21*

Appellant argues:

The Board did not address why the unscaled drawing (Miyajima Fig. 2 & 3) would serve as a basis for protrusions as claimed by the proposed combination of the office (Appeal Br. 18).

Nor did the Board explain how the paint markings or the display of the function on the key on a display screen (Dec. on Appeal 10) would provide recognizable tactile feedback like the protrusions that can be felt laterally.

Both the claimed invention and the rational underpinning of the office clearly claim a limitation for protrusions that can be felt laterally (Appeal Br. 17).

Wherein, the combined references (Miyajima et al. (6,518,958)) combination does not offer a clear and convincing basis for protrusions that can be felt laterally, which is a specific requirement of the claimed invention, there is no basis for a prima facie for obviousness. Since, the proposed combination lacks a key limitation, the proposed combination teaches away from the claimed invention.

Request 13–14. Appellant presents the same arguments for claim 21.

Request 14–15.

Appellant is incorrect that these arguments were not addressed in the Decision. *See* Decision 4, 11–13. Again, we note that in the Decision, we acknowledged that we have adopted as our own the Examiner’s findings and conclusions as set forth in the Examiner’s Answer and Final Action.

Decision 4, 12. Appellant appears to be rearguing its case and disagreeing with our findings, rather than addressing a point that was overlooked. For the reasons set forth in the Decision, we remain unpersuaded that Examiner erred in finding that the combination of Miyajima and Tiphane teaches or suggests the limitations in claims 18 and 21. Decision 11–13.

DECISION

The Request for Rehearing is denied.

Outcome of Decision on Rehearing:

<b>Claims</b>	<b>35 U.S.C §</b>	<b>Reference(s)/Basis</b>	<b>Denied</b>	<b>Granted</b>
1-10, 17	103(a)	Tiphane, Zadesky	1-10, 17	
11-16	103(a)	Tiphane, Takala, Nishikawa	11-16	
18-25	103(a)	Miyajima, Tiphane	18-25	
<b>Overall Outcome</b>			1-25	

Final Outcome of Appeal after Rehearing:

<b>Claims</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
17	112, first paragraph	Written Description	17	
1-10, 17	103(a)	Tiphane, Zadesky	1-10, 17	
11-16	103(a)	Tiphane, Takala, Nishikawa	11-16	
18-25	103(a)	Miyajima, Tiphane	18-25	
<b>Overall Outcome</b>			1-25	

DENIED