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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KUNIHITO SAWAI and KAZUYUKI YAMAMOTO

Appeal 2018-007970
Application 14/572,884
Technology Center 2100

Before JASON V. MORGAN, IRVIN E. BRANCH, and
ADAM J. PYONIN, *Administrative Patent Judges*.

BRANCH, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE¹

Pursuant to 35 U.S.C. § 134(a), Appellant² appeals from the Examiner's decision to reject claims 1–5, 7–12, and 14–22, which are all of

¹ We refer to the Specification, filed December 17, 2014 (“Spec.”); Final Office Action, mailed June 1, 2017 (“Final Act.”); Appeal Brief, filed February 8, 2018 (“Appeal Br.”); Examiner’s Answer, mailed June 4, 2018 (“Ans.”); and Reply Brief, filed July 31, 2018 (“Reply Br.”).

² 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 Sony Corporation. Appeal Br. 2.

the pending claims. *See* Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

The claims are directed to operating a GUI (Graphical User Interface) control apparatus for controlling the GUI in accordance with information transmitted from the input apparatus, a control system including those apparatuses, an electronic apparatus, and a control method. Spec. 1.

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. An information processing apparatus comprising:
a processing unit and a memory containing instructions that, when executed by the processing unit, implement:
 - an input unit configured to receive a mode selection input from a user and to receive a movement input based on movement of the user in three-dimensional space;
 - a switching unit configured to switch between a pointing mode and a scroll mode based on the mode selection input; and
 - a scroll control unit configured to scroll in a scroll direction in the scroll mode, wherein the scroll direction is a horizontal direction based on horizontal hand movement of the user.

REFERENCES AND REJECTION

Claims 1–5, 7–12, and 14–22 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Wroblewski (US 2006/0250358 A1; Nov. 9, 2006) and Marks (US 2007/0139443 A1; June 21, 2007). Final Act. 2–6.

ANALYSIS³

We have reviewed the Examiner's rejections in light of Appellant's arguments. 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 deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

To the extent consistent with our analysis herein, we adopt as our own the findings and reasons set forth by the Examiner in (1) the action from which this appeal is taken (Final Act. 2–6) and (2) the Examiner's Answer in response to Appellant's Appeal Brief (Ans. 2–5)⁴ and concur with the conclusions reached by the Examiner. We highlight the following for emphasis.

35 U.S.C. § 103(a)

The Examiner finds Wroblewski teaches all limitations of claim 1, except that “Wroblewski does not teach: Wherein the scroll direction is a horizontal direction based on horizontal hand movement of the user.” Final Act. 3. The Examiner finds the missing limitation is taught by Marks, concluding “it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the teaching as seen in Marks'[s] content into Wroblewski's invention because it would allow user to use hand gesture to control content.” *Id.* at 4; *see id.* at 3 (citing Marks

³ Because Appellant argues all claims based on claim 1 (*see* Appeal Br. 13), we review claim 1, and, except for our ultimate Decision, do not mention the other claim.

⁴ Because the Examiner's Answer numbers all pages as “1,” we refer to the pages as if consecutively numbered. *See generally* Answer.

¶ 55 (“Marks [teaches] . . . scrolling in a horizontal direction in response to the movements of the user’s hand”)).

Appellant does not dispute that the cited references teach or suggest all elements of claim 1. *See generally* Appeal Br. and Reply Br. Rather, Appellant challenges the Examiner’s reasons for combining the references, arguing “the combination of Wroblewski and Marks is improper because the combination renders the Wroblewski system unsatisfactory for its intended purpose, contrary to MPEP §2143.01(V).” Appeal Br. 11; Reply Br. 2–3. Appellant contends as follows:

In particular, the Wroblewski system, as modified by Marks, would perform:

1. control of scrolling by operation of the scroll wheel per Wroblewski,
2. control of a cursor by hand movement of the pointing device per Wroblewski, and
3. control of scrolling by recognition of hand movement in an image of the user per Marks.

Appeal Br. 11.

Appellant contends the combination of Wroblewski and Marks is improper for the following reasons:

1. Wroblewski already provides a scroll function using the scroll wheel. Thus, the skilled person would not be motivated by Marks to provide scrolling by hand movement in the Wroblewski system, absent an advantage provided by the Marks scrolling method.
2. Use of the scroll function of Marks in the Wroblewski system would conflict with the pointer control function of Wroblewski. Both functions rely on hand movement of the user. Wroblewski differentiates between modes based on movement of the pointing device (pointing mode) or scroll wheel rotation (scroll mode) (Fig. 4 and paragraphs

- 0070, 0072 and 0074). In the modified Wroblewski device, the mode would be indeterminate based on user movement.
3. Use of the scroll function of Marks in the Wroblewski system would result in redundancy with the scroll wheel of Wroblewski. In particular, the modified Wroblewski system would have redundant scroll functions, in which scrolling would be provided both by hand movement of the user and by operation of the scroll wheel.
 4. Use of the scroll function of Marks in the Wroblewski pointing device would require addition to the Wroblewski system of a camera and image processing software to provide a scroll function, even though the scroll function is already present in the Wroblewski system.

Id. at 12 (emphasis omitted); *see* Reply Br. 2–3.

We are unpersuaded of error. Initially, Appellant’s description of the structure that would result from the combination of Wroblewski and Marks amounts to a “bodily incorporation” of Marks’s structure into Wroblewski. *See* Appeal Br. 11. This premise, however, undermines Appellant’s ensuing arguments because “[c]ombining the teachings of references does not involve an ability to combine their specific structures.” *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973) (emphasis omitted); *see In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (citations omitted) (“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art.”).

Beyond that, Appellant does not persuasively establish that “the combination of Wroblewski and Marks is improper because the combination renders the Wroblewski system unsatisfactory for its intended purpose.”

Appeal Br. 11. The argument that a proposed combination of references would render one of the references unsuitable for its intended purpose or would change its principle of operation is a teaching away argument. *See In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984). The Federal Circuit has held “[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006) (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)).⁵

Here, Appellant does not persuasively establish that either Wroblewski or Marks discourages, criticizes or otherwise discredits the path taken by Appellant such that the Examiner’s proposed combination would render Wroblewski unsuitable for its intended purpose.

Further, Appellant’s arguments do not persuasively challenge the Examiner’s proposed reasoning for combining the references. In the Final Office Action, as quoted above, the Examiner reasons that “it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the teaching as seen in Marks’[s] content into Wroblewski’s invention because it would allow user to use hand gesture to

⁵ “If references taken in combination would produce a ‘seemingly inoperative device,’ . . . such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness.” *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1354 (Fed. Cir. 2001) (citation omitted); *see also In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1382 (Fed. Cir. 2007) (“[A] reference teaches away from a combination when using it in that combination would produce an inoperative result,” but the obviousness analysis must account for “modifications that one skilled in the art would make to a device borrowed from the prior art”).

control content.” Final Act. 4. In the Answer, the Examiner adds that “it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Wroblewski’s teaching to allow user to use the left and right hand to display content horizontally.” Ans. 5. Rather than address the Examiner’s reasons for combining, Appellant reasserts the unpersuasive “bodily incorporation” argument. Reply Br. 2–3; *see infra*. Accordingly, we are unpersuaded of error in the Examiner’s rejection of claim 1.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	References	Affirmed	Reversed
1–5, 7–12, 14–22	103(a)	Wroblewski, Marks	1–5, 7–12, 14–22	

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