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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte VIKRAM MALHOTRA and ALEXANDER SCHOENEN

Appeal 2019-000152
Application 14/724,534
Technology Center 2600

Before DEBRA K. STEPHENS, CARL W. WHITEHEAD JR., and
ADAM J. PYONIN, *Administrative Patent Judges*.

PYONIN, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the
Examiner's rejection. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm and enter a new ground of rejection pursuant to 37 C.F.R.
§ 41.50(b).

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 NIKE, Inc.
Appeal Brief 2.

STATEMENT OF THE CASE

Introduction

The Application is directed to “display and user touch interfaces for wearable mobile computing devices.” Specification ¶ 1. Claims 1–25 are pending; claims 1, 18, and 22 are independent. Appeal Brief 17–21. Claim 1 is reproduced below for reference (emphasis added):

1. A wearable computing device comprising:
 - a printed circuit board (PCB);
 - a housing configured to be attached to a user, enclosed over the PCB, and including a display surface;
 - a plurality of electronic components disposed on the PCB and including a plurality of display components to generate display data visible through the display surface of the housing;
 - and
 - a user input touch interface at least partially overlapping the display surface of the housing, the user input touch interface comprising:
 - an array of capacitive touch-sensitive electrode elements disposed on the PCB, *wherein at least some of the electrode elements are interspersed on the PCB between and at least partially coplanar with two or more of the display components;*
 - and
 - sensing circuitry configured to detect changes in the array of capacitive touch-sensitive electrode elements.

References and Rejections

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

Park	US 2013/0044074 A1	Feb. 21, 2013
Bezinge	US 2014/0253487 A1	Sept. 11, 2014
Weast	US 2014/0379106 A1	Dec. 25, 2014

Claims 1–6, 11–18, and 21–24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Weast and Park. Final Action 4.

Claims 7–10, 19, 20, and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Weast, Park, and Bezing. *Id.* at 16.

ANALYSIS

We have reviewed the Examiner’s rejection in light of Appellant’s arguments. Arguments Appellant could have made but chose not to make are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). We are not persuaded the Examiner’s rejection is in error; we adopt the Examiner’s findings and conclusions as our own, to the extent consistent with our analysis herein.

Appellant argues the cited references do not teach or suggest the “claim 1 recit[ation] that the plurality of electronic components and the capacitive touch-sensitive electrode elements are disposed on the same PCB and that the . . . electrode elements are at least partially coplanar with two or more of the display components.” Appeal Brief 9. Particularly, Appellant contends that, unlike the claimed components, Park’s “touch components, in whatever manner they are equated to an array of capacitive touch-sensitive electrode elements[,] are not coplanar with . . . the display components” and “are not disposed on the same PCB as the display components.” *Id.* at 11 (emphasis and item numbering omitted).

Appellant’s arguments are unpersuasive of error for failing to address the Examiner’s findings. Appellant explicitly disregards the teachings of Weast², whereas the Examiner relies on both Weast and Park for teaching

² *See, e.g.*, Reply Brief 2 (“[T]he disclosure of Weast is not relevant to

the disputed limitations: the Examiner finds one of ordinary skill would modify Weast's "PCB member [that] has various regions or sections to support [] various components" including display components (Answer 2–3; *see also* Final Action 5; Weast, Figure 14, ¶ 122) to include Park's teaching of an "in-cell/on-cell touch sensor" of a display (Answer 3–4; *see also* Final Action 5–7; Park, Figures 1, 9, ¶¶ 51–55); *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) ("Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.").

Appellant does not challenge the Examiner's combination of Weast and Park. Thus, Appellant does not show the Examiner errs in finding an artisan of ordinary skill would use Weast's flexible printed circuit board (PCB) with both display and touch sensor elements as taught by Park, in the manner claimed. *See* Final Action 7; Answer 4; Weast, Figures 14–15; Park, Figures 7, 9. Nor does Appellant provide persuasive technical reasoning or argument showing the Examiner errs in finding the claim contains "no limitation on the orientation of the plane," so that any arrangement of the components will be "at least partially coplanar" as claimed. Answer 4.³ For at least these reasons, we are not persuaded of error.

Applicants' case for patentability.").

³ Appellant cites to the Specification and figures in the instant application but does not explain how this refutes the Examiner's particular claim construction. *See* Reply Brief 4. Nor does Appellant otherwise provide an explanation of why the Examiner's reasoning is faulty. *See id.*; *cf.* *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1320 (Fed. Cir. 2006) ("[M]ere statements of disagreement . . . do not amount to a developed argument."). We note the Specification is silent in regard to a *coplanar* relationship of the claimed components. *See* Appeal Brief 4 (*citing* Specification ¶¶ 23–25).

Further we agree with the Examiner that Park teaches or suggests at least some of the electrode elements between and at least partially coplanar with two or more display components, as Park discloses “[v]arious touch sensor components, such as touch sense and/or touch drive electrodes[,] may be located within display pixel cells of the display 18” and “may be formed from a gate line of the display, a pixel electrode of the display, a common electrode of the display, a source line of the display, or a drain line of the display, or some combination of these elements.” Park ¶ 29; Final Action 3; *see also* Park, Figure 9 (depicting a touch sense electrode 80 between a red pixel 102a and a green pixel 102b), ¶¶ 54–55.

Accordingly, we are not persuaded the Examiner errs in finding the limitations of claim 1 to be taught or suggested by the combination of Weast and Park. *See* Final Action 5–7. We sustain the Examiner’s obviousness rejection of independent claim 1, as well as the rejections of the remaining claims which were not separately argued with particularity. *See* Appeal Brief 14–16.

NEW GROUND OF REJECTION

Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter a new ground of rejection and separately reject independent claim 1 under 35 U.S.C. § 112(a), as lacking written description support.

Claim 1 recites: “at least some of the electrode elements are interspersed on the PCB between and at least partially *coplanar* with two or more of the display components” (emphasis added). For support of this limitation, Appellant points to paragraphs 23–25 of the Specification. *See* Appeal Brief 4; *see also* Reply Brief 3. These portions of the Specification

do not mention the term *coplanar*, or any discussion of planes or planarity. The remainder of the Application as filed is similarly deficient.

Appellant’s cited portion of the Specification discloses that, “[i]n some embodiments, the electrode array and the array of illuminable components are disposed on a same surface (e.g., top surface) of the flexible circuit member.” Specification ¶ 24. The Specification does not state, however, that any devices on the “same surface” of the flexible member are coplanar, let alone that electrode elements are partially coplanar with two or more display components, as claimed. *Id.* We find Appellant’s disclosure—lacking any indication of coplanar elements—would not lead one of ordinary skill to understand the invention included the recited electrode elements that are partially coplanar with two or more display components, as claimed. *See, e.g., Specification* ¶¶ 17, 20, 40.

Based on the foregoing, we find that the present application does not reasonably convey to those skilled in the art the inventor had possession of the subject matter as now claimed, specifically the “coplanar” term recited by independent claim 1. Accordingly, we reject independent claim 1 under 35 U.S.C. § 112(a). We note the Patent Trial and Appeal Board is a review body, rather than a place of initial examination. We have rejected independent claim 1 based on our authority under 37 C.F.R. § 41.50(b). We have not, however, reviewed remaining claims 2–25 to the extent necessary to determine whether those claims are similarly unpatentable. We leave it to the Examiner to ascertain whether these claims should be rejected on similar grounds to those set forth herein.

DECISION

The Examiner's decision rejecting claims 1–25 under 35 U.S.C. § 103 is affirmed.

We enter a new ground of rejection of claim 1 under 35 U.S.C. § 112(a).

This Decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b), which provides that “[a] new ground of rejection . . . shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner.
- (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record.

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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED
37 C.F.R. § 41.50(b)