UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/292,159	05/30/2014	RAINER BRODERSEN	P7777USC1/63266-7372-US	1009

61725 7590 10/09/2020

Morgan, Lewis & Bockius LLP (PA)(Apple)
1400 Page Mill Road
Palo Alto, CA 94304-1124

EXAMINER
AFRIFA-KYEI, ANTHONY D

ART UNIT	PAPER NUMBER
2685	

NOTIFICATION DATE	DELIVERY MODE
10/09/2020	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

padocketingdepartment@morganlewis.com
vskliba@morganlewis.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RAINER BRODERSEN, ALAN CANNISTRARO, JEFFREY L. ROBBIN, and GREGORY CHARLES LINDLEY

Appeal 2019-002982
Application 14/292,159
Technology Center 2600

Before LARRY J. HUME, JUSTIN BUSCH, and BETH Z. SHAW, *Administrative Patent Judges.*

SHAW, *Administrative Patent Judge.*

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant[1] appeals from the Examiner's decision to reject claims 2–24. *See* Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

---

[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. 4.

CLAIMED SUBJECT MATTER

The claims are directed to a directional touch remote. Claim 2, reproduced below, is illustrative of the claimed subject matter:

> 2. A method, comprising:
>
> at a first device with a touch-sensitive surface including an unstructured area having no individually selectable items:
>
> while the first device is in a gesture entry mode of operation, receiving a touch input at a location on the unstructured area having no individually selectable items that includes movement with a respective velocity; and
>
> transmitting information about the touch input, including information about the respective velocity of the movement of the touch input, to a remotely controlled device;
>
> at the remotely controlled device, remotely controlled by the first device:
>
> in response to receiving information about the touch input, including information about the respective velocity of the movement of the touch input, at the first device:
>
> in accordance with a determination that an interface of the remotely controlled device is in a first context, performing a first action at the remotely controlled device in response to the touch input that was received on the touch-sensitive surface of the first device; and
>
> in accordance with a determination that the interface of the remotely controlled device is in a second context, different from the first context, performing a second action at the remotely controlled device, different than the first action, in response to the touch input that was received on the touch-sensitive surface of the first device.

REFERENCES

The prior art relied upon by the Examiner as evidence is:

Name	Reference	Date
Wells	US 2009/0143141 A1	June 4, 2009
Hope	US 2009/0153289 A1	June 18, 2009
Park	US 2009/0199119 A1	Aug. 6, 2009
Negron	US 2009/0239587 A1	Sept. 24, 2009
Migos	US 2010/0164745 A1	July 1, 2010

REJECTIONS

Claims 2, 3, 5, 8–10, 12, 15–17, and 21–24 are rejected under pre–AIA 35 U.S.C. § 103(a) as being unpatentable over Migos, Negron, and Wells. Final Act. 2.

Claims 4, 7, 11, 14, and 18–20 are rejected under pre–AIA 35 U.S.C. § 103(a) as being unpatentable over Migos, Negron, Wells, and Hope. Final Act. 9.

Claim 6 and 13 are rejected under pre–AIA 35 U.S.C. § 103(a) as being unpatentable over Migos, Negron, Wells, and Park. Final Act. 10.

OPINION

The Final Office Action states, "[i]t would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Migos with Negron in order to have a method to effectiv[ly] input an array of different commands for different devices/appliances." Final Act. 4.

Appellant argues, in part, that the Final Office Action fails to explain why a person of ordinary skill in the art would modify Migos to do away with Negron's selection icons 306, which enable Negron's smartphone device 102 to interface with multiple appliances. Appeal Br. 17. Appellant

argues that the Office Action also lacks a clear or sufficient explanation of why one skilled in the art would combine Migos and Negron, or Migos, Negron, and Wells, in the manner claimed. *Id.* In the Answer, the Examiner does not address or respond to these arguments. *See* Ans. 4–6.

"[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *KSR Int'l Co. v. Teleflex Inc*., 550 U.S. 398, 418–19 (2007). Even if a person of ordinary skill in the art would have recognized that the combination of Migos and Negron would have conveyed the concept of touch sensitive commands for different devices, on this record, the Examiner does not provide sufficient explanation or evidence as to why one ordinarily skilled in the art would have combined Migos's unstructured area with Negron's selection icons. *See* Appeal Br. 17.

Thus, the record falls short of providing articulated reasoning with rational underpinning to support a legal conclusion that the subject matter of claim 2 would have been obvious to one of ordinary skill in the art in view of what Migos, Negron, and Wells would have conveyed about touch sensitive user interfaces to a person of ordinary skill in the art. *KSR*, 550 U.S. at 418 ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.") (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Thus, constrained as we are by the record before us, we do not sustain the

rejection of claim 2. For the same reasons, we do not sustain the rejections of the remaining pending claims.

CONCLUSION

We reverse the Examiner's rejections.

DECISION SUMMARY

Claims Rejected	**35 U.S.C. §**	**Reference(s)/Basis**	**Affirmed**	**Reversed**
2, 3, 5, 8–10, 12, 15–17, 21–24	103	Migos, Negron, Wells		2, 3, 5, 8–10, 12, 15–17, 21–24
4, 7, 11, 14, 18–20	103	Migos, Negron, Wells, Hope		4, 7, 11, 14, 18–20
6, 13	103	Migos, Negron, Wells, Park		6, 13
Overall Outcome:				2–24

REVERSED