

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD W. GRIENCEWIC

Appeal No. 2003-0160
Application No. 08/971,320

ON BRIEF

Before JERRY SMITH, RUGGIERO, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 4, 5, 10, 11, and 13-15, which are all of the claims pending in this application.

We AFFIRM.

Appellant's invention relates to an illuminated pointing device for a computer. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A pointing device for a computer, wherein the pointing device is selected from the group consisting of a touchpad, a mouse, a point stick, a joystick and a trackball, the pointing device comprising:

a sensor to translate movement by a user of the computer to a signal representing a desired corresponding change in the position of a pointer on a display of the computer;

a communications link over which the signal is sent to the computer;

a housing having one or more illuminated exterior surfaces to render the device visible in a low-light or no-light environment; and

a user-operable button for providing a user input.

The prior art of record relied upon by the examiner in rejecting the appealed claims is as follows:

Guscott et al. (Guscott)	4,728,936	Mar. 1, 1988
Siefer et al. (Siefer)	5,153,386	Oct. 6, 1992
Stephan et al. (Stephan)	5,748,185	May 5, 1998 (filed Jul. 3, 1996)

Claims 1, 2, 4, 5, 10, 11, and 13-15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Stephan in view of Siefer.¹ Claims 1, 2, 4, 5, 10, 11, and 13-

¹ Here, we note that the examiner has not made a rejection under 35 USC § 112 with respect to dependent claims 5 and 11 which appear to improperly depend from cancelled claims(their dependency is left blank in the appendix to the brief.)

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15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Stephan in view of Guscott.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 29, mailed May 20, 2002) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 28, filed Apr. 16, 2002) and reply brief (Paper No. 30, filed May 25, 2002) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Initially, we note that appellant has elected at page 2 of the brief to group all the claims as standing or falling together. Therefore, we select independent claim 1 as the representative claim and will address appellant's arguments thereto

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to

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make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See **In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in art would

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lead that individual to combine the relevant teachings of the references.” **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). “Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact.” **Dembiczak**, 175 F.3d at 999, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) .

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. “[T]he name of the game is the claim.” **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations set forth in independent claim 1. We find that independent claim 1 recites the basic structure of the listed pointing devices and includes limitations to a “housing. . . having one or more illuminated exterior surfaces” and a “user-operable button.” From our review of the teachings of Stephan, we find that the teachings of Stephan teach the basic operational structure of a pointing device including a housing and a functional user-operable button. Additionally, we find that Siefer and Guscott teach and fairly suggest the use of illumination of at least one exterior surface of a pointing device. Therefore, we agree with the examiner’s combination and find that the

examiner has initially established a *prima facie* case of obviousness of independent claim 1.

Appellant argues that the combination of Stephan and Siefer teach a pointing device within which the working surface of the tablet is illuminated. Appellant argues that the housing as described in the present invention comprises an “actual housing with illuminated exterior surfaces that holds or contains the working components of the pointing device, the working components including elements such as switches on a mouse or a working surface of a touchpad.” (See brief at page 5.) Here, we note that it is the language of the claim that we address and not the invention described in the specification that we evaluate the examiner’s *prima facie* case of obviousness against. Appellant argues that the working surface of the touchpad of Siefer is not the same as a housing since the touchpad is held within a distinct and separate housing and is not itself a housing. We disagree with appellant and find that the language of independent claim 1 does not require a single unitary housing, does not require all of the components within the housing, nor that part of the housing may not be a functional part of the pointing device. The claim merely recites “a housing having one or more illuminated exterior surfaces to render the device visible in a low-light or no-light environment.” In our view, the teachings of Siefer would provide an illuminated exterior surface of the device and that illumination would render the device visible in a low-light

or no-light environment as recited in the language of independent claim 1. Therefore, this argument is not persuasive.

Appellant argues that the claimed invention recites “a user-operable button for providing a user input.” (See brief at page 5.) Appellant argues that the region 164 of Stephan is not a button so it is not structurally or functionally a button. We emphatically disagree with appellant. We find no structural or functional limitations recited in the language of independent claim 1 which would preclude region 164 from being a user operable button. Clearly, Stephan teaches that prior art pointing devices contained buttons for operation in column 1 and in column 10 that region 164 may operate as a button to allow a user to implement a desired command by tapping the region. We find that this teaches “a user-operable button for providing a user input” as recited in the language of independent claim 1. Therefore, this argument is not persuasive.

Appellant argues that there is no suggestion to combine the teachings of the two references so that the housing itself is visible so that the pointing device can be located in low-light or no-light environments. We find no limitation with respect to the locating of the device. The language of independent claim 1 merely requires that the housing surface be visible. Clearly, an illuminated device would render the device visible in a low-light or no-light environment. Therefore, this argument is not persuasive.

Appellant argues that the examiner has picked apart the two references and applied them in a piecemeal manner. (See brief at page 6.) We disagree and find no

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analysis by appellant as to support this contention. Rather, we find that appellant has set forth rather broad structural and functional limitations to cover a wide range of pointing devices and thereby allowing the prior art to suggest the invention as recited in the express language of independent claim 1. In the reply brief, appellant essentially reiterates the same arguments that we have not found persuasive above. Therefore, we will sustain the rejection of independent claim 1 and independent claims 4, 10, and 13-15 and their dependent claims which appellant has elected to group therewith over the combination of Stephan and Siefer.

With respect to the combination of Stephan and Guscott, the examiner applies Guscott in the same manner as Siefer, and appellant has made similar arguments as above which we have not found persuasive. In the reply brief, appellant essentially reiterates the same arguments that we have not found persuasive above. Therefore, we will sustain the rejection of independent claim 1 and independent claims 4, 10, and 13-15 and their dependent claims which appellant has elected to group therewith over the combination of Stephan and Guscott.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 4, 5, 10, 11, and 13-15 under 35 U.S.C. § 103 is affirmed.

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No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRM

JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOSEPH L. DIXON)	
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