

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

APR 11 1995 BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER WYSS

Appeal No. 94-1803
Application 07/832,342¹

ON BRIEF

Before THOMAS, KRASS and CARDILLO, Administrative Patent Judges.
THOMAS, Administrative Patent Judge.

ON REQUEST FOR RECONSIDERATION

In a paper filed on March 15, 1995, appellant requests
that we reconsider our decision dated February 23, 1995 wherein

¹ Application for patent filed February 7, 1992.

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we sustained the examiner's rejection of claims 1 to 3 and 9 under 35 U.S.C. § 103.

We have carefully reviewed our original opinion in light of appellant's request, but we find no point of law or fact which we overlooked or misapprehended in arriving at our decision. Even in light of appellant's current arguments set forth in the Request for Reconsideration, we find no error in the analysis or logic set forth in our original opinion.

In our earlier opinion, we dealt with every argument presented by appellant in the Brief and Reply Brief. At pages 4 and 5 of our original opinion, we discuss in detail the teachings and our view of the teachings and suggestions of Nippoldt. There, we emphasized the plain meaning of Nippoldt's use of the phrase "ball bearings" 78 in ring bearing 70. One of appellant's assertions in the principal Brief on appeal was that he construed Nippoldt's teachings of ball bearings as being like the spherical domes discussed at pages 1 and 2 of his specification. We directly address these points in the paragraph bridging pages 4 and 5 of the original opinion. Thus, it is clear from our original opinion that we do not agree with appellant's assertion as to these points and rely upon the plain and ordinary meaning of the phrase "ball bearings" 78 in ring bearing 70 in accordance

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with Nippoldt's teachings and showings. Note also the paragraph at the top of page 6 of our original opinion.

In our discussion at page 4 to the top of page 6 of our original opinion, we indicated clearly our disagreement with appellant's assertion that Figure 4 of Nippoldt clearly shows that the ball bearings therein are not placed in recesses. Our discussion in the latter half of page 6 to the middle of page 7 of our original opinion should have made that clear. There, we discussed in detail the various scopes of protection sought for the seating and the associated recesses of the claimed ball bearings as expressed in claims 1, 3, 4, 5, 6 and 7. There again we relied upon the plain meaning of what a ball bearing is as taught by Nippoldt. Implicit in our reasoning in our entire earlier opinion was a recognition that Nippoldt does not specifically teach or show the ball bearings being in any kind of recess. It was clearly stated that we relied upon the well-known construction of ball bearings, which was an expression of agreement to the examiner's basic position.

In contrast to appellant's assertions in the Request for Reconsideration, to us, Figure 4 of Nippoldt clearly suggests that bearings 78 are in the ring bearing 70. We do not agree with appellant's assertion that Nippoldt's Figure 4 clearly "shows" that the ball bearings in this reference are not in

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recesses. We see the ball bearings 78 in Nippoldt as being in the sloping surface 76. Column 3, lines 28-30, of Nippoldt states: "the sloping surface 76 carrying a plurality of ball bearings 78." The use of the word "carrying" does not convey to the reader in our view that the ball bearings in Figure 4 are on the top of the sloping surface 76. A simple question may be asked. How are the ball bearings 78 to be "carried" on a sloping surface without them being within the surface or within recesses in that surface? Figures 3 to 6 of Nippoldt clearly show the ball bearings 78 located in the middle portion of the sloping surface 76. To us, Figure 4 of Nippoldt clearly shows only the top half of the ball bearings 78 projecting from the overall ring bearing 70 (surface 76), thus indicating to us and to the artisan that the ball bearings necessarily would have been located in some sort of recess.

The paragraph bridging pages 6 and 7 of our original opinion also relies upon and somewhat amplifies the examiner's reliance upon the conventional construction of ball bearings being well known to the artisan. A reference may be properly considered within 35 U.S.C. § 103 not only for what it expressly teaches but also for what it fairly suggests. In re Burckel, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979). Not only the specific teachings of a reference but also reasonable inferences

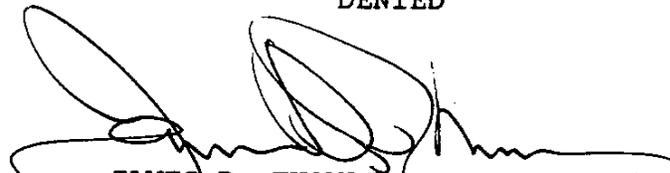
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which the artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. In re Preda, 401 F.2d 825, 159 USPQ 342 (CCPA 1968); In re Shepard, 319 F.2d 194, 138 USPQ 148 (CCPA 1963). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969).

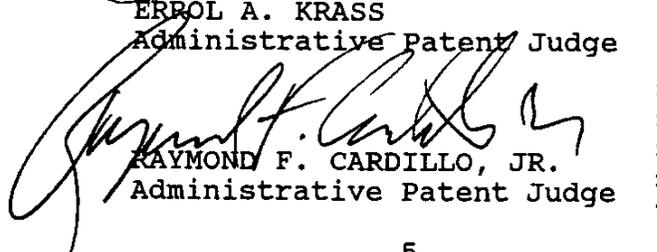
In view of the foregoing, appellant's request for reconsideration is granted to the extent that we have in fact reviewed our findings but is denied as to making any change therein.

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

DENIED


JAMES D. THOMAS
Administrative Patent Judge)


ERROL A. KRASS
Administrative Patent Judge)


RAYMOND F. CARDILLO, JR.
Administrative Patent Judge)

BOARD OF PATENT
APPEALS AND
INTERFERENCES

Appeal No. 94-1803
Application 07/832,342

B. Franklin Griffin, Jr.
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QUESTIONS AND ANSWERS
ABOUT
PETITIONS FOR REHEARING
AND
SUGGESTIONS FOR HEARING
OR REHEARING IN BANC
IN THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

Q. When is a petition for rehearing appropriate?

A. Petitions for rehearing are rarely considered meritorious. Consequently, it is easiest to first answer when a petition for rehearing is not appropriate. A petition for rehearing should not be used to reargue matters already briefed and orally argued. If you failed to persuade the court then, you do not get a second chance. This is especially so when the court has entered a judgment of affirmance without opinion under Fed. Cir. R. 36, as a disposition of this nature is used only when the appellant has utterly failed to raise any issues in the appeal that require an opinion to be written in support of the court's judgment of affirmance.

Thus, as a usual prerequisite, the court must have filed an opinion in support of its judgment for a petition for rehearing to be appropriate. In addition, counsel seeking rehearing by the panel must be able to identify in the court's opinion a material error of fact or law the correction of which would require a different judgment on appeal.

Q. When is a suggestion for for rehearing in banc appropriate?

A. In-banc decisions are extraordinary occurrences. Consequently, to answer this question, one must first understand the respective roles of a three-judge merits panel of the court and the court in banc. The responsibility of a merits panel is to decide individual appeals according to the law of the circuit as established in the court's precedential opinions. While each merits panel is empowered to enter precedential opinions, the ultimate responsibility of the court in banc is to set forth the law of the circuit which merits panels are obliged to follow.

Thus, as a usual prerequisite, a merits panel of the court must have en-

tered a precedential opinion in support of its judgment for a suggestion for rehearing in banc to be appropriate. In addition, the party seeking rehearing in banc must show that either the merits panel has failed to follow identifiable decisions of the Supreme Court of the United States or precedential opinions of the circuit or the merits panel has followed circuit precedent which the party seeks to have overruled by the court in banc.

Q. How frequently are petitions for rehearing granted by merits panels or suggestions for rehearing in banc accepted by the court in banc?

A. The data about petitions for rehearing since 1982 show that merits panels granted some relief in only 3 percent of the more than 1900 petitions filed. The relief granted usually involved only minor corrections of factual misstatements, rarely resulting in a change of outcome in the decision. In-banc suggestions were accepted less frequently, only 16 of more than 1100 times.

Historically, the court itself initiated in-banc review in more than half (21 of 37) of the very few appeals decided in banc since 1982. This sua sponte, in banc review is a by-product of the court's practice of circulating every precedential panel decision to all of the judges before it is published. No count is kept of sua sponte, in banc polls that fail to carry, but one of the reasons that virtually all of the more than 1100 suggestions made by the parties since 1982 have been declined is that the court itself has already impliedly "cleared" the precedential opinions before they are filed by merits panels.

Q. Is it necessary to have filed either a petition for rehearing or a suggestion for rehearing in banc before filing a petition for certiorari in the Supreme Court of the United States?

A. No. All that is needed is a final judgment in the court of appeals.

As a matter of interest, very few petitions for certiorari from Federal Circuit decisions are granted. Since 1982, the Supreme Court has granted certiorari in only 31 appeals heard in the Federal Circuit. Almost 1000 petitions for certiorari have been filed in that period.

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

INFORMATION SHEET

FILING A PETITION FOR WRIT OF CERTIORARI

Review on writ of certiorari is not a matter of right, but of judicial discretion, and will be granted only when there are special and important reasons. (See Rule 10 of the Rules of the Supreme Court.)

1. The petition must be filed in the Supreme Court of the United States within 90 days of the entry of judgment in this court. The judgment is entered on the day the court issues an opinion in an appeal. If a petition for rehearing is timely filed, the time runs from the date of the denial of that petition. The time does not run from the issuance of the mandate. Issuing the mandate in no way affects the right to petition to the Supreme Court.
2. The docket fee of \$300.00, or a motion for leave to proceed in forma pauperis with an affidavit in support thereof, must accompany the petition.
3. The petition must be filed by either a member of the Bar of the Supreme Court or the petitioner pro se.
4. The lower court opinion(s) and any order on rehearing must be included as the appendix to the petition.
5. Forty copies of a petition must be filed. The petition must not exceed 30 printed or 65 typed pages excluding the questions presented page, the subject, index, the table of authorities and the appendix. If the petitioner is proceeding in forma pauperis, one typewritten petition on 8 1/2 by 11 inch paper may be submitted. Supreme Court Rules 33 and 34 govern printing requirements and the form of typewritten papers. Proof of service must accompany the petition.
6. The record of proceedings in this court will be certified and transmitted only upon the request of the Clerk of the Supreme Court.
7. The current Rules of the Supreme Court of the United States, containing amendments to January 1, 1990, are contained in Title 28, United States Code Annotated.

FOR SPECIFIC INFORMATION WRITE TO:

Clerk
Supreme Court of the United States
1 First Street, N.E.
Washington, DC 20543
Telephone Number: (202) 479-3000

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

SOLICITOR

MAR 0 8 1996

NOTICE OF ENTRY OF
JUDGMENT WITHOUT OPINION U.S. PATENT & TRADEMARK OFFICE

JUDGMENT ENTERED: 03/06/96

The judgment of the court in your case was entered today pursuant to Rule 36. This Court affirmed the judgment or decision that was appealed. None of the relief sought in the appeal was granted. No opinion accompanied the judgment. The mandate will be issued in due course.

Information is also provided about petitions for rehearing and suggestions for rehearing in banc. The questions and answers are those frequently asked and answered by the Clerk's Office.

Exhibits and visual aids shall be promptly retrieved by the party that lodged them with this court.

FRANCIS X. GINDHART
Clerk

cc: F. PRINCE BUTLER
NANCY J. LINCK

IN RE WYSS, 95-1446
PTO BPAI-EP - 07/832,342

NOTE: Pursuant to Fed. Cir. R. 47.6, this disposition is not citable as precedent. It is a public record. The disposition will appear in tables published periodically.

United States Court of Appeals for the Federal Circuit

95-1446

APPEAL NO. 94-1803
THOMAS
KRASS
CARDILLO
AFFIRMED-FEB.23, 1995
RECON DENIED - APR. 11, 1995

IN RE PETER WYSS

Judgment

ON APPEAL from the UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES
in CASE NO(S). 07/832,342

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

Per Curiam (LOURIE, CLEVINGER, and BRYSON, Circuit Judges):

AFFIRMED. See Fed. Cir. R. 36.

DATED MAR 06 1996

ENTERED BY ORDER OF THE COURT

Francis X. Gindhart

Francis X. Gindhart, Clerk

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

MAR 06 1996

FRANCIS X. GINDHART
CLERK

MAILED

FEB 23 1995

PAT. & TM. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES
UNITED STATES PATENT AND TRADEMARK OFFICE

Paper No. 23

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Peter Wyss

Appeal No. 94-1803
Application 07/832,342¹

ON BRIEF

Before THOMAS, CARDILLO, and KRASS, Administrative Patent Judges.
THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 1 and 3 to 9, appellant having canceled claim 2 and the examiner having indicated the allowability of claims 10 to 13.

Representative claim 1 is reproduced below:

1. A control element constituting a mouse designed to be connected to a cursor visualization assembly and having:

a housing;

a mobile ball protruding outside said housing to be directly or indirectly actuated by a user;

¹ Application for patent filed February 7, 1992.

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a support device adapted to receive said mobile ball and having at least three bearings which are angularly offset and which comprise contact members of a material of low coefficient of friction on which said mobile ball rests, said contact members cooperating with said ball by a rolling friction and said contact members comprising ball-bearings each ball-bearing comprising a ball freely supported for rotation in all directions in a recess forming seating provided in said bearings.

The following references are relied upon by the examiner:

Kim	4,404,865	Sep. 20, 1983
Mazzone et al. (Mazzone)	4,951,034	Aug. 21, 1990
Nippoldt	4,952,919	Aug. 28, 1990
Duchon	5,008,528	Apr. 16, 1991

(filed July 14, 1989)

Claims 1 and 3 to 9 stand rejected under 35 U.S.C. § 103.

As evidence of obviousness, the examiner relies upon Mazzone in view of Duchon, further in view of Nippoldt and Kim.

Rather than repeat the positions of the appellant and the examiner, reference is made to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the positions advanced by the appellant and the examiner and we have conducted a thorough study of the references relied upon by the examiner to formulate the above noted art rejection. As a result of such review, we agree with the examiner that claims 1 and 3 to 9 are directed to subject matter which would have been obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103 based upon the evidence provided by the applied prior art. We are in full

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agreement with the examiner's reasoning set forth at pages 4 and 5 of the answer which focus upon the examiner's response to appellant's arguments in the brief.

At the outset, we note that the examiner properly initially relies upon Duchon for the teaching at column 1 that the basic structure of trackballs as evidenced in Duchon, Nippoldt and Kim were, and are, analogous in structure to control elements constituting a mouse as broadly indicated in the preamble of the independent claims on appeal. There is no dispute as to this aspect of the rejection in appellant's briefs.

Appellant's characterization that the examiner incorrectly indicates that Duchon uses a similar ball arrangement is misplaced. Although Duchon does employ engagement wheels 208 in representative figure 2a with which to engage the rotating ball 6, the purpose of the engagement wheels 208 is to provide a physical rotating linkage to the optomechanical encoders which permit the x and y axes to be determined from the rotation of the ball. What the examiner correctly points out, and apparently has not been appreciated by appellant, is the teaching at column 4, lines 5 to 11 of Duchon. Here, Duchon plainly teaches and makes reference to figure 2a that pressure rollers 240, 242, 244 are provided to ensure smooth operation of the ball 63. These

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rollers are stated to be of the "shaft-mounted ball bearing type" and provide an improved shock loading for the ball. The ball is said to rest on these rollers so as not to frictionally engage the opening in the skeleton 20. As would be appreciated by the artisan, these "shaft-mounted ball bearing type" rollers are clearly analogous to the "roller bearings" discussed in Kim.

Additionally, it also would have been readily apparent to the artisan that these "shaft-mounted ball bearing type" rollers of Duchon are functionally identical to the ball bearings and ring bearing discussed in Nippoldt. In contrast to appellant's position, we agree with the examiner's characterization that Nippoldt teaches a plurality of ball bearings 78 that can support a mobile ball 80 for rotation relative to the housing. Figures 3 to 6 show various views of the ring bearing 70 having a lower shoulder 74 to engage the printed circuit board 44 and also having ball bearings 78 shown to be located on and/or within the slopping/bevelled surface 76 of the ring bearing 70. Note the teachings at column 3, lines 20-32 and column 4, lines 4-6 and 59. It is this ring bearing 70 and the ball bearings 78 on top thereof which are stated to directly support the ball 80.

Appellant's extensive arguments at pages 6 to 8 of the Brief completely mischaracterize the plain reading of these teachings of Nippoldt. In contrast to appellant's discussion of prior art

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contact members which utilize spherical domes onto which the rotating ball rests, as discussed at pages 1 and 2 of appellant's specification as filed, the noted showings and teachings in Nippoldt clearly, in accordance with their plain meaning, would have taught or at least suggested to the artisan that well-known ball bearings were utilized as the claimed contact members allowing the ball 80 to be freely supported thereon for rotation in all directions in recesses forming seatings provided in the bearings as set forth at the end of representative claim 1 on appeal.

From the artisan's point of view, we have no difficulty concluding that Nippoldt's ring bearing 70 is clearly analogous to, if not identical to, appellant's bearing 8. Similarly, we find the artisan would have no difficulty concluding that the ball bearing contact members 22 of appellant's disclosed bearing 8 would be clearly analogous to the ball bearings 78 shown in Nippoldt's ring bearing 70. It is also clear that the function of appellant's roller bearing contact members 22 in bearings 8 is the same as Nippoldt's ball bearings 78 in ring bearing 70, which are in turn identical to the function of the earlier noted "shaft-mounted ball bearing type" rollers 240, 242, and 244 in Duchon and Kim's roller bearings 52 and support 60--to support the respective trackballs or mouse balls.

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There is no evidence that we can find in any of the four patents relied upon by the examiner as the basis of the rejection under 35 U.S.C. § 103 herein that the patentees therein used the noted terms for ball or roller bearings in any sense other than their ordinary and accustomed meaning. It is further noted that terms in claims are to be given their ordinary and accustomed meaning, unless it appears that the inventor used them differently. Lantech, Inc., v. Keip Machine Company, 32 F.3d 542, 31 USPQ2d 1666 (Fed. Cir. 1994); relying upon Envirotech Corp. v. Al George, Inc., 730 F.2d 753, 759, 221 USPQ 473, 477, (Fed. Cir. 1984). The phrase "spherical domes" is never used in any of the four references relied upon by the examiner to describe either the ball or roller bearings therein.

Claim 1 broadly recites the seating and associated recesses to support the claimed ball bearing contact members. Succeeding dependent claims 3, 4 and 7 from independent claim 1 as well as independent claim 5 and its dependent claim 6 successively attempt to define more particularly the nature of this seating and recess arrangement which is believed to be based upon appellant's disclosure thereof in figures 2 and 3.

The examiner's statements at pages 4 and 5 of the answer relating the above noted teachings of ball or roller bearings to a conventional or generic ball bearing are well-taken. It is

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well-known that such a ball bearings consists of a number of balls running in grooves and that the grooves are constructed in such a manner as to maintain the balls in the grooves or seats. Necessarily inherent is the need for some kind of lip-arrangement, as more particularly set forth in dependent claim 6, continuously around the periphery of the aperture or recess housing the respective balls of the ball bearings to keep the balls from falling out of their grooves or seats. Again, we agree with the examiner's observation that such lips would have some degree of resiliency as set forth in dependent claim 7 to permit the ball bearings to be placed into and retained by the overall bearing assembly. Appellant's arguments at page 2 of the reply brief as to these positions are not well-taken and appear to be a weak attempt to confront the weight of the evidence and arguments relied upon by the examiner.

As to the specific recitation of the bearings being made of corundum in dependent claim 8, the examiner's reliance of appellant's admission of the prior art at page 1 of the specification is persuasive. Although the examiner appears to mischaracterize appellant's prior art statements at page 1 of the specification by stating that corundum was a known material for ball-bearings, it is noted that appellant actually admits that

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the three known bearings in prior art mouses were contact members made of material having a low coefficient friction and which was in turn identified as corundum. This is a well-known material for use as bearings as noted in the Condensed Chemical Dictionary². There the definition of corundum refers in turn to the definition of sapphire which has a very well-recognized Moh hardness of 9.0, a low coefficient of friction of 0.05 microns and has known uses in the past for precision instrument bearings.

Finally, as to a particular recitation of the bearings being made of polyoxymethylene in dependent claim 9 on appeal, the examiner's reliance upon column 6, lines 25-28 of Kim is correct but incomplete. Lines 27 to 32 plainly indicate that certain significant portions of the mechanism of Kim's support roller 60 and the roller bearings 52 are made of DELRIN plastic. DELRIN is also the plastic of choice utilized to form the ball cage 130 in Mazzone as indicated at column 3, lines 32-35. The Kirk-Othmer Encyclopedia of Chemical Technology³ indicates that polyoxymethylenes are acetal resins which are considered to be engineering thermoplastics having broad use in traditional metal

² The Condensed Chemical Dictionary, Ninth Edition, Gessner Hawley, pages 234 and 765 (1977).

³ Kirk-Othmer, Encyclopedia Of Chemical Technology, Vol. 1, pages 112-114 and 121 (1978).

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applications. Trade names include DELRIN which was just identified as being the plastic of choice in Mazzone and Kim. DELRIN is said to have good abrasion resistance, a low coefficient of friction and, as such, was commonly used as bearings in appliances.

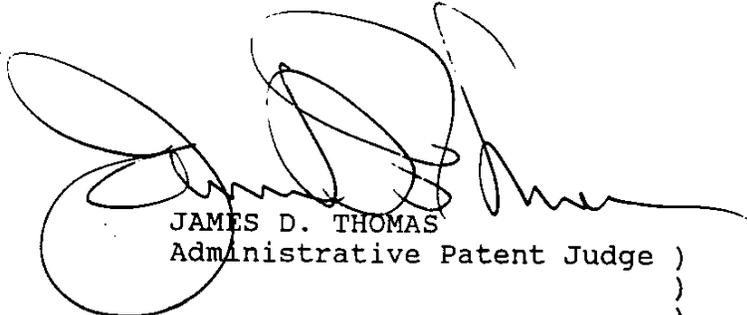
Our reference to the Chemical Dictionary and Chemical Encyclopedia are relied upon by us to substantiate facts in the evidentiary showing made by the examiner. As such, they are not considered to be a basis for a new ground of rejection. See In re Boon, 439 F.2d 724, 169 USPQ 231 (CCPA 1971). The obviousness of using the noted materials in dependent claims 8 and 9 would have been apparent to the artisan based upon knowledge well known in the art.

In view of the foregoing, the decision of the examiner rejecting claims 1 and 3 to 9 under 35 U.S.C. § 103 is affirmed.

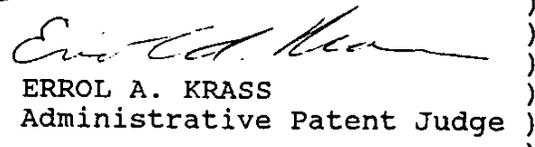
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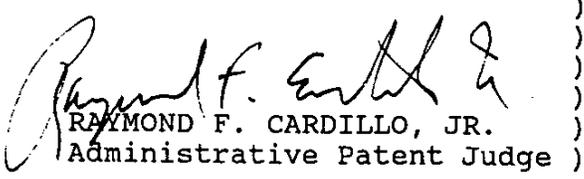
AFFIRMED



JAMES D. THOMAS
Administrative Patent Judge)



ERROL A. KRASS
Administrative Patent Judge)



RAYMOND F. CARDILLO, JR.
Administrative Patent Judge)

BOARD OF PATENT
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