

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JEAN-PHILIPPE FRICKER,  
MAURICE ALOU and BERNARD KASSER

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Appeal No. 2002-2334  
Application 09/097,235

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ON BRIEF

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Before THOMAS, BARRETT, and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 12-30 and 34. Claim 1-6 have been allowed and claims 7-11 have been canceled. Claims 31-33 are indicated by the Examiner to contain allowable subject matter but are objected to as being dependent on a rejected claim.

The disclosed invention relates to a touchpad digital system input device having the advantages of both resistive and capacitive type sensors. The touchpad structure has an integrated design with a substrate material disposed between the resistive sensor and the capacitance sensor, thereby providing electrical isolation between the resistive and capacitance sensors. The touchpad system distinguishes between different types of inputs, such as a pen or a finger, and can operate in different modes depending on the particular sensed input.

Representative claim 12 is reproduced as follows:

12. A method of detecting the position of a pointing element on an input device comprising the steps of:

providing a resistive sensor and a capacitive sensor, wherein the resistive sensor is electrically isolated from the capacitive sensor;

if the capacitive sensor detects a pointing element, then ignoring the resistive sensor; and

determining the position of the pointing element with the capacitive sensor; and

if the capacitive sensor does not detect a pointing element then determining the position of the pointing element with the resistive sensor.

The Examiner relies on the following prior art:

Stein et al. (Stein)	5,365,461	Nov. 15, 1994
Gough et al. (Gough)	5,603,053	Feb. 11, 1997

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Koolen	5,777,607	Jul. 07, 1998 (filed Feb. 20, 1996)
Yoshikawa	5,790,105	Aug. 04, 1998 (filed Apr. 10, 1997)
Lemke et al. (Lemke)	5,850,209	Dec. 15, 1998 (filed May 19, 1997)

Claims 12-15, 18, 20, 22-27, 30, and 34 stand finally rejected under 35 U.S.C. § 102(e) as being anticipated by Koolen. Claims 12-15, 18-20, 22-27, 30, and 34 stand finally rejected under 35 U.S.C. § 102(e) as being anticipated by Stein. Claims 16, 17, 19, 21, 28, and 29 stand finally rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers Koolen or Stein, in the alternative, in view of Yoshikawa with respect to claims 16, 17, and 19, adds Gough to Koolen or Stein with respect to claim 21, and adds Lemke to Koolen or Stein with respect to claims 28 and 29.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (Paper No. 25) and Answer (Paper No. 26) for the respective details.

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, and the evidence of

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anticipation and obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Brief along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the disclosure of Koolen fully meets the invention as recited in claims 12-15, 18, 20, 22-27, 30, and 34. We are also of the view that the Stein reference fully meets the invention as set forth in claims 12-15, 18-20, 22-27, 30, and 34. In addition, we are of the opinion that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention set forth in claims 16, 17, 19, 21, 28, and 29. Accordingly, we affirm.

We consider first the Examiner's 35 U.S.C. § 102(e) rejection of claims 12-15, 18, 20, 22-27, 30, and 34 based on Koolen. At the outset, we note that anticipation is established only when a single prior art reference discloses, expressly or

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under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Although Appellants nominally indicate (Brief, page 4) that the appealed claims do not stand or fall together, the sole argument presented by Appellants is the alleged lack of electrical isolation between Koolen's resistive and capacitive sensors, a feature common to each of the independent claims on appeal. Accordingly, with respect to the Examiner's 35 U.S.C. § 102(e) rejection of claims 12-15, 18, 20, 22-27, 30, and 34 based on Koolen, we will select claim 12 as the representative claim for all claims subject to this rejection and claims 13-15, 18, 20, 22-27, 30, and 34 will stand or fall with claim 12. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

With respect to representative claim 12, the Examiner indicates (Answer, pages 2 and 3) how the various limitations are read on the disclosure of Koolen. In particular, the Examiner points to the illustrations in Koolen's Figures 1 and 2 along with the accompanying description beginning at column 3, line 13 through column 4, line 19.

After reviewing the Examiner's analysis, it is our opinion that the stated position is sufficiently reasonable that we find that the Examiner has at least satisfied the burden of presenting a prima facie case of anticipation. The burden is, therefore, upon Appellants to come forward with evidence and/or arguments which persuasively rebut the Examiner's prima facie case. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Brief have not been considered [see 37 CFR § § 1.192(a)].

Appellants' arguments in response assert that the Examiner has not shown how each of the claimed elements is present in the disclosure of Koolen so as to establish a case of anticipation. In particular, Appellants contend (Brief, page 8) that ". . . the Koolen device's resistive and capacitive sensors cannot be

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electrically isolated since they share an electrically active component which is used as both a capacitive sensor and a resistive sensor at the same time.”

After careful review of the Koolen reference in light of the arguments of record, however, we are in general agreement with the Examiner’s position as stated in the Answer. Our interpretation of the disclosure of Koolen coincides with that of the Examiner, i.e., while the resistive and capacitive sensors share component 110, the resistive sensor is electrically isolated from the capacitive sensor since when the resistive sensor, i.e., DC driver 114, is active, the capacitive sensor, i.e., AC driver 112, is disabled.

We recognize that the above interpreted electrical isolation feature in Koolen is not the same as that disclosed by Appellants in which a substrate material disposed between the resistive and capacitive sensors provides the electrical isolation. It is the claimed invention, however, that is before us on appeal. In our view, Appellants’ arguments improperly attempt to narrow the scope of the claim by implicitly adding disclosed limitations

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which have no basis in the claim.<sup>1</sup> See In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

In view of the above discussion, since all of the claimed limitations are present in the disclosure of Koolen, the Examiner's 35 U.S.C. § 102(e) rejection of representative claim 12, as well as claims 13-15, 18, 20, 22-27, 30, and 34 which fall with claim 12, is sustained.

We also sustain the Examiner's 35 U.S.C. § 102(e) of claims 12-15, 18-20, 22-27, 30, and 34 based on Stein for essentially the same reasons as discussed above with respect to the Koolen reference. We agree with the Examiner that although, as with the Koolen reference, the resistive and capacitive sensors in Stein share a sensing surface 12, the resistive sensor is electrically isolated from the capacitive sensor since when the resistive sensor is active, i.e., switch 18 in the closed "b" position, the capacitive sensor is disabled, i.e., switch 18 in the open "a" position.

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<sup>1</sup>We make the observation that pending claims 1-6 and 31-33 which contain limitations directed to the physical substrate separation of the capacitive and resistor sensors have been indicated to be allowable by the Examiner.

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Lastly, we also sustain the Examiner's 35 U.S.C. § 103(a) rejection of claims 16, 17, 19, 21, 28, and 29. Appellants have made no separate arguments with respect to this rejection and instead have relied on the same electrical isolation argument asserted against representative claim 12, an argument we found to be unpersuasive for all of the reasons discussed supra.

In summary, we have sustained the Examiner's 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a) rejections of all of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 12-30 and 34 is affirmed.

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

AFFIRMED

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
LEE E. BARRETT	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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	)	
JOSEPH F. RUGGIERO	)	
Administrative Patent Judge	)	

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