

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MICHAEL J. URE

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Appeal No. 96-1347  
Application 08/207,469<sup>1</sup>

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ON BRIEF

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Before KRASS, LEE and CARMICHAEL, Administrative Patent Judges.

CARMICHAEL, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of Claims 4, 7-9, 12-14, and 16-19. The other claims remaining in the application are Claims 10, 11, and 15, which have been indicated as directed to patentable subject matter.

Claim 4 reads as follows:

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<sup>1</sup> Application for patent filed March 7, 1994.

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4. Using an input device having a touch-sensitive stationary member, a method of interacting with a computer having a display and displaying an icon, the method comprising the step of:

moving a fingertip across said member while a user's thumb is applied to said member; and

sensing said fingertip and said thumb by means of said touch-sensitive stationary member in order to drag said icon across said display.

The examiner's Answer cites the following prior art:

Bequaert et al. (Bequaert)	4,042,777	Aug. 16, 1977
Logan et al. (Logan)	5,327,161	Jul. 5, 1994
Savoy et al. (Savoy)	5,341,133	Aug. 23, 1994

#### **OPINION**

Claims 4 and 7 stand rejected under 35 U.S.C. § 103 as unpatentable over Logan. Claims 8, 9, 12-14, and 16 stand rejected under 35 U.S.C. § 102 as anticipated by Bequaert. Claim 17 stands rejected under 35 U.S.C. § 103 as unpatentable over Bequaert. Claims 18 and 19 stand rejected under 35 U.S.C. § 103 as unpatentable over Savoy in view of Bequaert.

We reverse.

**Claim 4**

Claim 4 requires "sensing said fingertip and said thumb." The examiner acknowledges that Logan does not teach sensing the thumb, but offers alternative theories for obviousness.

First, the examiner posits that a skilled artisan would have moved Logan's button to avoid accidental actuation. However, the examiner cites no basis in the prior art for such a suggestion. The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992). Finding no such suggestion in the prior art, we will not adopt the examiner's rationale.

Second, the examiner points to Logan's disclosure of using the opposite hand to hold down the device. The examiner states that this suggests sensing the thumb. While this may be a plausible interpretation of "sensing," it is inconsistent with the disclosure in this case, which describes sensing the thumb as distinct from sensing any other finger. Thus, we cannot sustain the examiner's rejection of Claim 4.

**Claim 7**

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Claim 7 recites varying the distance a cursor is moved in accordance with the number of fingertips moved across the device. The examiner dismisses that limitation as lacking in criticality. To the contrary, the invention as a whole includes the variable distance feature, which is not suggested by Logan. Thus, the rejection of Claim 7 is not sustained.

**Claims 8, 9, 12-14, 16, and 18-19**

The inventions of claims 8, 9, 12-14, 16, and 18-19 sense different numbers of fingers and/or combinations of fingers to input different characters into a computer. Bequaert senses different combinations of keys (or fixed positions in a touch sensor) to input different characters. The examiner finds no difference, whereas appellants argue that sensing fingers is different than sensing key positions.

Claims undergoing examination are given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims. ***In re Etter***, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (in banc). In the present case, the disclosure makes clear that sensing fingers is distinct from sensing the depression of keys or positions. As shown in

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Figure 3, it is the fingers themselves, not finger-actuated buttons, that are sensed by appellants' invention. In light of the disclosure, we agree with appellants. The rejection will not be sustained.

**Claim 17**

Claim 17 specifies that the touchpad is void of visual indications indicating distinct keys. According to the examiner, it would have been obvious to omit the labels on Bequaert's keys in order to reduce cost. This rationale is not found in the prior art as required by **Fritch**, and would seriously reduce the usefulness of Bequaert's system. Accordingly, the rejection will not be sustained.

**CONCLUSION**

The rejections are not sustained.

**REVERSED**

ERROL A. KRASS

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Administrative Patent Judge )  
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