

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(2) is not binding precedent of the Board.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. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHILIPPE GAULTIER,
PATRICK VOUILLON and
MARIE-HELENE DEBRUS

Appeal No. 1996-3362
Application 08/258,601¹

HEARD: September 14, 1999

Before BARRETT, FLEMING, and HECKER, **Administrative Patent
Judges.**

FLEMING, **Administrative Patent Judge.**

¹Application for patent filed June 10, 1994. According to Applicants, the application is a continuation of Application 08/005,136, filed January 15, 1993.

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DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 3 through 6, all of the claims pending in the present application. Claims 1 and 2 have been cancelled.

The invention relates to a device and method for controlling cursor motion on a display screen of a computer. In particular, the invention provides two modes of cursor operation, an absolute mode and a relative mode. In the absolute mode, the cursor position on the display screen is determined by the operator's finger position on the touch screen. In the relative mode, the cursor position on the display screen is determined relative to the operator's finger touch screen position. The selection between these two modes is done by the operator pressing against the screen by a force that exceeds a threshold.

Independent claim 5 is reproduced as follows:

5. Method for positioning without discontinuity a cursor on a desired location of a screen of a display device, using a control source consisting in a touch-sensitive work board comprising a touch-sensitive surface producing electrical signals indicating X-Y position coordinates of an operator's finger in contact therewith and a force exerted by said finger thereon, said signals being transmitted to a processor comprising means for positioning the cursor on the display screen according to an absolute pointing mode wherein each

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point of the touch-sensitive surface corresponds isomorphically to a point of the display screen, and to a relative pointing mode wherein a displacement of the cursor on the display screen is controlled by a homothetic movement of the finger close to said surface, and switching means for selecting said absolute pointing mode if said force rises above a predetermined threshold, and said relative mode if said force remains below said threshold, said method comprising successively:

a first step during which the finger is applied with a force exceeding said threshold on a first location of the touch-sensitive surface so as to coarsely position the cursor on a first location on the display screen near said desired location,

a second step during which the force exerted by said finger on said touch-sensitive surface is reduced to a value below said threshold so as to select the relative pointing mode, said finger staying on said first location of the touch-sensitive surface while the cursor stays on said first location on the display screen, and

a third step during which said finger exerts on said surface a force which remains below said threshold and is moved so as to accurately move the cursor from said first location on the display screen to said desired location.

The Examiner relies on the following references:

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|------------|-----------|---------------|
| Faulkerson | 4,804,949 | Feb. 14, 1989 |
| Levine | 4,954,817 | Sep. 4, 1990 |

Claims 3 through 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Levine in view of Faulkerson.

Rather than reiterate the arguments of Appellants and the

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Examiner, reference is made to the briefs² and the answer for the respective details thereof.

OPINION

We will not sustain the rejection of claims 3 through 6 under 35 U.S.C. § 103.

The Examiner has failed to set forth a **prima facie** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. **In re Sernacker**, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." **Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.**, 73 F.2d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), **cert. denied**, 519 U.S. 822 (1996), **citing W. L. Gore &**

²Appellants filed an appeal brief on October 4, 1995. Appellants filed a reply brief on March 1, 1996. The examiner mailed a communication on April 23, 1996 stating that the reply brief has been entered and considered, but no further response by the examiner is deemed necessary.

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Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1548, 220 USPQ
303, 309 (Fed. Cir. 1983), **cert. denied**, 469 U.S. 851
(1984).

On pages 6 through 8, Appellants argue that Levine does not teach or suggest use of a pressure switch to select the two cursor modes, absolute and relative. Appellants further argue on pages 8 and 9 of the brief, that Faulkerson fails to teach or suggest using a pressure switch to select between an absolute mode and a relative mode.

In the Examiner's answer on page 3, the Examiner states that the rejection is set forth in prior office action, Paper No. 16. Turning to this office action, the Examiner states that Levine does not teach the selection of different modes by the use of a pressure activated switch. The Examiner argues that Faulkerson teaches a multi-mode cursor control device which provides a switch means for selecting cursor control position mode or an optical scanner mode. The Examiner argues that it would have been obvious to modify the pressure activated switch of Levine to have the switching means of Faulkerson, so that switching between different operation

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modes can be achieved.

Appellants' claim 1 recites a first step during which the finger is applied with a force exceeding such threshold on a first location of the touch-sensitive surface so as to coarsely position the cursor on a first location of the display screen near said desired location and a second step during which the force exerted by said finger on said touch sensor is reduced to a value below said force so as to select the relative pointing mode. Appellants' claim 6 recites a first means for positioning the cursor on the display screen according to an absolute pointing mode and a second means for positioning the cursor on the display screen according to a relative mode, a means for comparing the force with a predetermined threshold, means for selecting said first cursor positioning means if the force rises above said predetermined threshold and means for selecting said second cursor positioning means if the force remains below said threshold.

Upon our careful review of Levine, we find that Levine teaches an absolute pointing mode and a relative pointing mode for the cursor control in column 7, line 50, through column 8, line 13. Furthermore, we find that Levine teaches the

selection between these two modes is done by pressing a key on the keyboard and not a pressure-activated switch on the displaying mean. See column 7, lines 45 through 49. We also find that Levine teaches a pressure-activated switch, 22e, disclosed in column 6, lines 31 through 68. However, the pressure-activated switch is disclosed to emulate the functions of a one button mouse as found on the Apple MacIntosh Computer which is used not to select between modes for the cursor but instead used in the normal mouse click function. Thus, we find that Levine fails to teach using a pressure sensitive switch to select between the relative pointing mode and the absolute pointing mode of the cursor.

Turning to Faulkerson, we fail to find that Faulkerson teaches using a pressure switch, in which a predetermined threshold is determined, to select between two modes. In particular Faulkerson merely has a plurality of switches 26a through 26e shown in Figure 1 which are used to operate either the optical scanner or the computer mouse. We fail to find that Faulkerson teaches selecting between two modes by comparing a force with a predetermined threshold.

On pages 9 through 12, Appellants argue that the

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motivation for the proposed combination is lacking. In particular, Appellants argue that neither Levine nor Faulkerson provide motivation for providing a pressure switch for selecting between the absolute pointing mode or the relative pointing mode.

The Federal Circuit states that "[t]he 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), **citing In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Furthermore, the Federal Circuit reasons in **Para-Ordnance Mfg. Inc. v. SGS Importers Int'l Inc.**, 73 F.3d 1085, 1088-89, 37 USPQ2d 1237, 1239-40 (Fed. Cir. 1995), **cert. denied**, 519 U.S. 822 (1996), that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art, would have been reasonably expected to use the solution that is claimed by the Appellants.

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Turning to Levine, we fail to find that Levine provides any teaching or suggestion to use a pressure sensitive switch 22e to select between the cursor modes. In particular, Levine teaches away from using a pressure-sensitive switch 22e instead teaches the use of a key on the keyboard as we have previously shown above. Faulkerson, on the other hand, does not teach using a pressure-sensitive switch to select between either modes. Faulkerson certainly does not suggest modifying Levine's use of a keyboard switch for selecting between the modes of the cursor to the use of a pressure-sensitive switch such as 22e to provide the selection of the cursor modes. Therefore, we fail to find that the prior art suggests desirability of the modification as suggested by the Examiner.

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We have not sustained the rejection of claims 3 through 6 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

REVERSED

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|-----------------------------|---|-----------------|
| LEE E. BARRETT |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| MICHAEL R. FLEMING |) | APPEALS AND |
| Administrative Patent Judge |) | INTERFERENCES |
| |) | |
| |) | |
| STUART N. HECKER |) | |
| Administrative Patent Judge |) | |

MRF:svt

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