

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROLAND J. AUBER and
JOSEPH M. MOSLEY

Appeal No. 95-3158
Application 08/038,424¹

ON BRIEF

Before THOMAS, JERRY SMITH and LEE, Administrative Patent Judges.
LEE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 and 4-7. No claim has been allowed. Claims 1 and 6 are independent claims. Claim 4 depends from claim 1. Claim 5 depends from claim 4. Claim 7 depends from claim 6.

Reference Relied on by the Examiner

Aoki

U.S. Patent No. 5,078,019

Jan. 7, 1992

Application for patent filed March 29, 1993.

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Haskins U.S. Patent No. 4,718,085 Jan. 5, 1988

Kirchgessner U.S. Patent No. 4,927,987 May 22, 1990

The Rejection on Appeal

Claims 1 and 4-7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Aoki, Haskins and Kirchgessner.

The Invention

The invention is directed to a handheld trackball pointing device for use with a data processing apparatus. It includes structure which permits a user to readily change the cable position to reduce cable interference with user manipulation of the device.

Claim 1 is representative and reads as follows:

1. A hand-held, finger-operated trackball pointing device comprising:

 a housing for housing electrical components of said device, said housing being box shaped and having a top wall, a bottom wall, and side walls extending between said top wall and said bottom wall, said housing being of a size adapted to be held in a user's hand and having cursor controls mounted thereon which are adapted to be manipulated by a user while said housing is being held in the user's hand;

 said cursor controls comprising a trackball mounted in said housing and having a portion projecting upwardly from said top wall, for manipulation by a user's finger;

 said cursor controls further comprising selectively actuated button means mounted said top wall

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adjacent to said trackball, for actuation by a user's finger;

a cable for attaching said pointing device to a computer, said cable passing downwardly through said bottom wall of said housing;

said bottom wall having two recessed channels extending orthogonally relative to each other between said sides of said housing, said channels intersecting where said cable passes through said bottom wall, each of said channels having a U-shaped cross section opening downwardly from said bottom wall, each channel having a depth at least as great as the thickness of said cable so that said cable can be positioned vertically within said channel and lie wholly within said channel without projecting downwardly beyond said bottom wall;

said cable being flexible allowing a user to selectively position said cable in any one of said channels so as to direct said cable away from said housing in a direction selected by the user and minimize interference between the cable and the user's hand during operation of said pointing device; and

tab means located in said channels for frictionally holding said cable in place in the one of said channels where said cable is positioned by the user.

Opinion

We do not sustain the rejection of claims 1 and 4-7 under 35 U.S.C. § 103 as being unpatentable over Aoki, Haskins and Kirchgessner.

The claimed invention is directed to a handheld trackball pointing device for use with a computer. A cable is included for

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attaching the pointing device to the computer. Aoki discloses a trackball pointing device. Kirchgessner discloses a handheld pointing device. Haskins is a reference specifically identified in the background portion of the appellants' specification

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wherein the appellants assert their belief that Haskins belongs to the category of non-analogous art. Haskins discloses a groove and cord retaining means for a desk or wall mounted telephone.

The appellants argue that Haskins is outside the field of applicable prior art for trackball pointing devices, and that even if it is assumed to be analogous art, the teachings from Aoki, Haskins and Kirchgessner [do] would not have reasonably suggested the appellants' claimed invention. On both of these points, we agree with the appellants.

Given two useful devices of whatever type, if one can broaden or generalize the inventive field to whatever extent subjectively desired, at some point the two devices will inevitably be in the same field of endeavor no matter how different they originally may be. If that happens, the inquiry of whether two devices are within the same field of endeavor becomes meaningless. Certainly, a rule of reason must apply.

The examiner defines the relevant field of endeavor as anything concerning the "cable of an input device" (answer at 8). In our view, that is unduly broad. The claimed invention specifically concerns a hand-held trackball-type pointing device having cursor controls for use with a computer. Defining the field of the inventors' endeavor as any input device with a cable

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is unreasonably broad. Haskins discloses a desk or wall mounted telephone. Moreover, to the extent that Haskins' telephone is an input device, it provides input to a telephone network or exchange, not a computer or anything which provides a controllable cursor through the input.

In our view, Haskins is also not reasonably pertinent to the particular problem with which the appellants were involved. It should be noted that the problem with which the appellants were involved concerns the position of the cable extending from the housing of the device. A plurality of user selectable positions are provided so that the user may place the cable in a position most suitable for him or her and minimize the resulting interference with user manipulation of the hand-held device. See the appellants' specification at pages 3-4. The examiner has not pointed to anything which indicates or otherwise explained why a desk or wall mounted telephone suffers or experiences a problem in which the position of the line cord connection would interfere with one's usage of the telephone. It is true that Haskins' Figure 1 shows a telephone with two line cord grooves (one for desk mounting and one for wall mounting), but they are intended for accommodating different length line cords (column 1, lines 15-23). The appellants' problem concerns reorienting the

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same cable to different selectable positions. In Haskins' telephone, each cable has only one fixed position.

Because Haskins is not within the appellants' field of endeavor or reasonably pertinent to the problem with which the appellants were involved, it constitutes non-analogous art and thus is not applicable in a rejection under 35 U.S.C. § 103. However, even assuming that Haskins is analogous art and therefore is applicable against the appellants' claims, the appellants are correct that the combination of Aoki, Haskins, and Kirchgessner would not have reasonably suggested the appellants' claimed invention. The following discussion assumes that Haskins constitutes analogous art.

Neither Aoki nor Kirchgessner discloses recessed channels on the wall of the housing through which the cable passes. There is no need for such recessed channels in Aoki and Kirchgessner because in both Aoki and Kirchgessner the cable does not extend through the bottom housing of the device. However, we find that the basic skill intrinsically possessed by one with ordinary skill in the art encompasses the knowledge that the cable can be made to pass through any wall of the housing, including the bottom wall, albeit with associated disadvantages. But even if Aoki and Kirchgessner's cable were to extend through the bottom

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of the housing, in our view there would have been insufficient motivation for one with ordinary skill in the art to use Haskins' multiple recessed grooves in either Aoki or Kirchgessner.

In Haskins, the multiple grooves are designed for alternative line cords. A long line cord for desk mounting would go into the long groove, and a short line cord for wall mounting would go into the shorter groove (column 1, lines 15-23). Where the same cable is used as in the pointing devices of Aoki and Kirchgessner, one with ordinary skill in the art would not have been led to use Haskins' multiple grooves.

Even assuming that Haskins' multiple grooves for the line cord (not the handset cord) would have been reasonably suggested for use with the cable of Aoki or Kirchgessner, Haskins would not have reasonably suggested the specific arrangement of the multiple channels as required by the claimed invention. According to claim 1, the recessed channels must (1) extend orthogonally relative to each other, and (2) intersect where the cable passes through the bottom wall of the housing.

In Haskins' Figure 3 embodiment, the optional groove for wall mounting is not shown and thus to say that the channels would meet the requirements of claim 1 amounts to mere speculation and is improper. In Haskins' Figure 1 illustration

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of the prior art, the long groove 15 and the short groove 19 do not intersect at where the cable or line cord is connected or attached to the housing. To dismiss these differences as being routine design choices for one with ordinary skill in the art would be arbitrary, without support on this record, and tantamount to ignoring the features of the claimed invention. Accordingly, we conclude that orthogonal channels intersecting at where the cable passes through a wall of the housing would not have been suggested by Haskins or any combination of Haskins, Aoki and Kirchgessner.

The features of claim 1 as discussed above are also included in independent claim 6. Claim 6 additionally requires two more recessed channels and all four channels would intersect at where the cable emerges from the housing. For similar reasons as those discussed above, the four channel version also would not have been reasonably suggested by the prior art. The appellants are correct that the mere fact that the prior art may be modified in the manner as 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, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

For the foregoing reasons, the rejection of claims 1 and 4-7

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under 35 U.S.C. § 103 as being unpatentable over Aoki, Haskins
and Kirchgessner cannot be sustained.

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Conclusion

The rejection of claims 1 and 4-7 under 35 U.S.C. § 103 as being unpatentable over Aoki, Haskins and Kirchgessner is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
)	
)	
JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JAMESON LEE)	
Administrative Patent Judge)	

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