

[2016 Pat. App. LEXIS 1627](#)

Patent Trial and Appeal Board

February 01, 2016, Decided

Appeal 2014-000203; Application 12/696,900 Technology Center 2600

Reporter

2016 Pat. App. LEXIS 1627

Ex parte JUAN MANUEL CRUZ-HERNANDEZ and DANNY A. GRANT

Notice:

[*1]

ROUTINE OPINION. Pursuant to the Patent Trial and Appeal Board Standard Operating Procedure 2, the opinion below has been designated a routine opinion.

Core Terms

coefficient of friction, vibrate, patent, haptic, surface, double patenting, frequency, touch, amplitude, actuator, obviousness-type, co-pending, disclosure, output, rejected claim, invent, configure, signal, nonstatutory, anticipate, prima facie case, prior art, apparatus, recite

Panel: Before CAROLYN D. THOMAS, JEFFREY S. SMITH, and JASON V. MORGAN, Administrative Patent Judges.

Opinion By: JEFFREY S. SMITH

Opinion

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants seek our review under [35 U.S.C. § 134\(a\)](#) of the Examiner finally rejecting claims 1-11 and 13-23, all the pending claims in the present application. Claim 12 is canceled. We have jurisdiction over the appeal under [35 U.S.C. § 6\(b\)](#). An Oral Hearing was held on January 14, 2016.

We AFFIRM.

The present invention relates generally to providing haptic effects in response to a touch occurring in a touch area of a touch surface. A first haptic signal can be sent to cause an actuator to vary a coefficient of friction of

Claim 1 is illustrative:

1. A system comprising:

a sensor configured to detect a touch in a touch area when an object contacts a touch surface;

a first actuator in communication with the processor and coupled to the touch surface, the first actuator configured [*2] to provide a first haptic output, in response to a first haptic signal, the first haptic output configured to vary a coefficient of friction of the touch surface;

a second actuator in communication with the processor and coupled to the touch surface, the second actuator configured to provide a second haptic output, in response to a second haptic signal, the second haptic output different from the first haptic output; and

a processor in communication with the first actuator, the second actuator, and the sensor, the processor configured to:

select a composite haptic effect to generate on the touch surface, and

transmit the first haptic signal to the first actuator, the first haptic signal associated with the composite haptic effect; and

transmit the second haptic signal to the second actuator, the second haptic signal associated with the composite haptic effect, the first haptic signal and the second haptic signal configured to cause the first actuator and the second actuator to generate the composite haptic effect on the touch surface.

App. Br. 18 (Claims App'x)

Appellants appeal the following rejections:

R1. Claim 1 is rejected on the grounds of nonstatutory obviousness-type [*3] double patenting as being unpatentable over Cruz-Hernandez (U.S. 7,667, 687 B2; Feb. 23, 2010), Grant (U.S. 7,890, 863 B2; Feb. 15, 2011), Heubel (U.S. 8,098, 235 B2; Jan. 17, 2012), Grant (U.S. 8,157, 650 B2; Apr. 17, 2012), Grant (U.S. 8,232, 969 B2; July 31, 2012), and Grant (U.S. 8,264, 465 B2; Sept. 11, 2012) (see Final Act. 3-10; Ans. 3--4);

R2. Claim 1 is provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over various co-pending applications (see Final Act. 10-49; Ans. 4-5)¹; and

¹ The Examiner withdrew the provisional rejection of claim 1 on the ground of nonstatutory obviousness-type double patenting over claim 10 of co-pending Application No. 12/269,084, claim 8 of co-pending Application No. 12/538,575, claim 24 of co-pending Application No. 12/947,321, claim 9 of co-pending Application No. 13/605,589, and claim 20 of co-pending

[*4]

R3. Claims 1-11 and 13-23 are rejected under [35 U.S.C. § 102\(b\)](#) as being anticipated by Shahoian (US 2005/0017947 A1; Jan. 27, 2005) (see Final Act. 49-54; Ans. 3).

RELATED DECISIONS

Appeal No. 2014-000206 (Application No. 12/696,908), mailed January 29, 2016 (Examiner Affirmed).

Appeal No. 2014-000209 (Application No. 12/697,010), mailed January 29, 2016 (Examiner Affirmed).

Appeal No. 2014-000210 (Application No. 12/697,037), mailed January 29, 2016 (Examiner Affirmed).

Appeal No. 2014-000211 (Application No. 12/697,042), mailed January 29, 2016 (Examiner Affirmed).

Appellants direct our attention to essentially the same or similar evidence relied upon in each of the above-noted related cases. Therefore, we adopt and incorporate herein by reference the Board's related decisions to the extent they apply to the similar arguments and evidence made herein.

ANALYSIS

Issue 1: Does the preponderance of evidence relied upon by the Examiner support a conclusion of obviousness-type double patenting?

Obviousness-Type Double Patenting Rejection of claim 1 over U.S. Patent 7,667,687; U.S. Patent 7,890,863 [*5] ; U.S. Patent 8,098,235; and over each of the provisionally rejected co-pending Applications

We highlight that Appellants state that "[i]f the Examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness" (App. Br. 13) and "[d]ue to space and time constraints, Appellant[s] cannot herein address each of the double patenting rejections" (*id.*). Instead, Appellants broadly note that "each of Tables . . . state at least once that a vibration discloses adjusting a coefficient of friction . . . this does not *anticipate* claim 1" (*id.*) (emphasis added).

Appellants correctly note that the one who bears the initial burden of presenting a prima facie case of unpatentability is the Examiner. [In re Oetiker, 977 F.2d 1443, 1445 \(Fed. Cir. 1992\)](#). However, a prima facie case is established when the party with the burden of proof points to evidence that is sufficient, if uncontroverted, to entitle it to prevail as a matter of law. See [Saab Cars USA, Inc. v. U. S., 434 F.3d 1359, 1369 \(Fed. Cir. 2006\)](#). In particular, regarding the Patent [*6] Examiner's burden of production:

[A]ll that is required of the office to meet its prima facie burden of production is to set forth the statutory basis of the rejection and the reference or references relied upon in a sufficiently articulate and informative manner as

to meet the notice requirement of [[35 U.S.C.\] § 132](#). As the statute itself instructs, the examiner must "notify the applicant," "stating the reasons for such rejection," "together with such information and references as may be useful in judging the propriety of continuing prosecution of his application." [35 U.S.C. § 132](#).

[In re Jung, 637 F.3d 1356, 1363 \(Fed. Cir. 2011\)](#). Here, we find that the Examiner has indeed notified Appellants of the basis of the rejection, i.e., nonstatutory obviousness-type double patenting, together with sufficient information and reference citations, i.e., Tables 1.1, 1.2, 2.1, 2.2, 3.1-3.10 (see Final Act. 4-49) that are helpful in judging the propriety of continuing prosecution of this application. For example, in the Tables the Examiner has indicated which limitations are explicitly shown, which are implied [*7] (and why they are implied), and which fall under official notice (and why the Examiner takes official notice) (*id.*). Because we find such information is useful in judging the propriety of continuing prosecution of this application, and provides sufficient evidence for purposes of reviewing the Examiner's rejection, the Examiner has met the initial burden of presenting a prima facie case. As such, the burden is now shifted to Appellants for coming forward with rebuttal or argument. [In re Rijckaert, 9 F.3d 1531, 1532 \(Fed. Cir. 1993\)](#).

Appellants, however, have not provided persuasive reasoning or rebuttal evidence, by affidavit or otherwise, to overcome the Examiner's prima facie case. Moreover, arguments not made are waived. See [37 C.F.R. § 41.37\(c\)\(1\)\(iv\) \(2012\)](#). Cf. [In re Baxter Travenol Labs., 952 F.2d 388, 391 \(Fed. Cir. 1991\)](#) ("It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art.")

Furthermore, we note that Appellants' statement "this does not *anticipate* claim [*8] 1" (see App. Br. 13 (emphasis added)) misses the mark concerning addressing the obviousness-type double patenting rejection. The key question in any obviousness double patenting analysis is: "Does any claim in the application define merely an obvious variation of an invention claimed in the patent asserted as supporting double patenting?" [General Foods Corp. v. Studiengesellschaft Kahle mb H, 972 F.2d 1272, 1278 \(Fed. Cir. 1992\)](#) (discussing [In re Vogel, 422 F.2d 438 \(CCPA 1970\)](#)). Here, Appellants inappropriately reference "anticipating" the claims. This is a misplaced response.

Therefore, we *pro forma* affirm the Examiner's nonstatutory obviousness-type double patenting rejection of claim 1 over U.S. Patent 7,667,687; U.S. Patent 7,890,863; U.S. Patent 8,098,235; and each of the provisionally rejected co-pending Applications² (see Ans. 3-5).

[*9]

Double Patenting Rejection of claim 1 over U.S. 8,157, 650; U.S. 8,232, 969; and U.S. 8,264, 465

Unlike above, regarding the rejection of claim 1 over U.S. 8, 157, 650; U.S. 8,232, 969; and U.S. 8,264, 465, here Appellants provide rebuttals to the Examiner's prima facie case. Specifically, Appellants contend that "the disclosure of a vibration alone does not disclose a perceptible adjustment in the coefficient of friction" (App. Br. 13). Appellants further contend that "with regard to claim 15 of U.S. Patent 8,157,650 . . . a low frequency vibration is particularly unlikely to generate a perceptible adjustment in the coefficient of friction" (*id.*). Appellants

² We leave it to the Examiner to ascertain whether any of the cited thirty-nine co-pending Applications are no longer co-pending, i.e., have been abandoned, or whether the claims of the co-pending Applications have been substantively modified to

also contend that "with respect to claim 24 of U.S. Patent 8,232,969 and claim 1 of U.S. Patent 8,264,465, neither of these claims even recites a vibration" (*id.*).

As stated by our reviewing court in [In re Braat, 937 F.2d 589, 592-93 \(Fed. Cir. 1991\)](#) [*10] (citation omitted):

Obviousness-type double patenting is a judicially created doctrine intended to prevent *improper* timewise extension of the patent right by prohibiting the issuance of claims in a second patent which are not "patentably distinct" from the claims of a first patent.

An analysis analogous to an obviousness analysis under [35 U.S.C. § 103\(a\)](#) comes into play during the step of determining the obviousness of the "difference" between the claimed invention and the patented invention. See [Studiengesellschaft Kahle mb H v. N. Petrochemical Co., 784 F.2d 351, 355 \(Fed. Cir. 1986\)](#); [In re Longi, 759 F.2d 887, 892-93 \(Fed. Cir. 1985\)](#). However, the disclosure of a patent cited in support of a double patenting rejection cannot be used as though it was prior art, even where the disclosure is found in the claims. [Braat, 937 F.2d at 594 n.5](#). "It is the claims, not the specification, that define an invention. . . . And it is the claims that are compared when assessing double patenting." [Ortho Pharmaceutical Corp. v. Smith, 959 F.2d 936, 943 \(Fed. Cir. 1992\)](#). [*11] However, the disclosure of a patent may be used to learn the meaning of terms and in "interpreting the coverage of [a] claim." [Vogel, 422 F.2d at 441](#).

Here, the Examiner responds that "one of ordinary skill in the art of vibration apparatuses reasonably would infer that an apparatus *disclosed by a reference*, which includes the components and structure of the presently claimed invention, is capable of varying a coefficient of friction of a touch surface" (Ans. 31) (emphasis added). In other words, the Examiner appears to look to the *disclosures* of the cited patents. Although the Examiner provides several Tables that indicate which claims/limitations in the Patents are being compared to claim 1 in the present application in assessing the double patenting rejection (see Final Act. 4-49), the Examiner fails to address specifics arguments made by Appellants concerning entries in such Tables. Interestingly, the Examiner even fails to address Appellants' contention that "neither of these claims even recites a vibration" as proffered by the Examiner (i.e., referencing claim 24 of U.S. Patent 8,232,969 and claim 1 of U.S. Patent 8,264 [*12] . 465) as indicated in the Examiner's Table 1.2 (see App. Br. 13; see also Ans. 8).

It is critical during the analysis that no part of the patent be used as "prior art" against the claims under review. In a double patenting rejection, the prior patent does not qualify as prior art, and therefore, the patented disclosure may not be used as prior art. See [Vogel, 422 F.2d at 441](#); see also [In re Sarett, 327 F.2d 1005, 1013 \(CCPA 1964\)](#) ("We are not here concerned with what one skilled in the art would be aware [of] from reading the claims but with what inventions the claims define.").

Here, the Examiner's focus on the disclosed vibration apparatuses in the disclosures misses the mark (see Ans. 31). The focus should be on the claims, not the disclosures. Also, the disclosures of the cited patents are not before us in evaluating the obviousness-type double patenting rejection, only the claims thereof.

In view of the above discussion, we do *not* sustain the nonstatutory obviousness-type double patenting rejection of claim 1 over U.S. 8,157, 650; U.S. 8,232, 969 [*13] ; and U.S. 8,264, 465.

[35 U.S.C. § 102\(b\)](#) Rejection

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