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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/012,308	05/24/2012	7479949	P4313USREX3/120730-001US	7441

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MORRISON & FOERSTER LLP  
425 MARKET STREET  
SAN FRANCISCO, CA 94105-2482

EXAMINER
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ENGLAND, DAVID E

ART UNIT	PAPER NUMBER
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3992

MAIL DATE	DELIVERY MODE
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08/23/2013

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/012,308.

PATENT NO. 7479949.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

**Notice of Intent to Issue  
Ex Parte Reexamination Certificate**

<b>Control No.</b> 90/012,308	<b>Patent Under Reexamination</b> 7479949
<b>Examiner</b> DAVID ENGLAND	<b>Art Unit</b> 3992

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

1.  Prosecution on the merits is (or remains) closed in this *ex parte* reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office or upon petition. Cf. 37 CFR 1.313(a). A Certificate will be issued in view of
  - (a)  Patent owner's communication(s) filed: 04 March 2013.
  - (b)  Patent owner's failure to file an appropriate timely response to the Office action mailed: \_\_\_\_\_.
  - (c)  Patent owner's failure to timely file an Appeal Brief (37 CFR 41.31).
  - (d)  The decision on appeal by the  Board of Patent Appeals and Interferences  Court dated \_\_\_\_\_
  - (e)  Other: \_\_\_\_\_.
2. The Reexamination Certificate will indicate the following:
  - (a) Change in the Specification:  Yes  No
  - (b) Change in the Drawing(s):  Yes  No
  - (c) Status of the Claim(s):
    - (1) Patent claim(s) confirmed: 1-20.
    - (2) Patent claim(s) amended (including dependent on amended claim(s)): \_\_\_\_\_
    - (3) Patent claim(s) canceled: \_\_\_\_\_.
    - (4) Newly presented claim(s) patentable: \_\_\_\_\_.
    - (5) Newly presented canceled claims: \_\_\_\_\_.
    - (6) Patent claim(s)  previously  currently disclaimed: \_\_\_\_\_
    - (7) Patent claim(s) not subject to reexamination: \_\_\_\_\_.
3.  Note the attached statement of reasons for patentability and/or confirmation. Any comments considered necessary by patent owner regarding reasons for patentability and/or confirmation must be submitted promptly to avoid processing delays. Such submission(s) should be labeled: "Comments On Statement of Reasons for Patentability and/or Confirmation."
4.  Note attached NOTICE OF REFERENCES CITED (PTO-892).
5.  Note attached LIST OF REFERENCES CITED (PTO/SB/08 or PTO/SB/08 substitute).
6.  The drawing correction request filed on \_\_\_\_\_ is:  approved  disapproved.
7.  Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All
  - b)  Some\*
  - c)  Noneof the certified copies have
  - been received.
  - not been received.
  - been filed in Application No. \_\_\_\_\_.
  - been filed in reexamination Control No. \_\_\_\_\_.
  - been received by the International Bureau in PCT Application No. \_\_\_\_\_.

\* Certified copies not received: \_\_\_\_\_.
8.  Note attached Examiner's Amendment.
9.  Note attached Interview Summary (PTO-474).
10.  Other: \_\_\_\_\_.

**All correspondence** relating to this reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

/David E. England/  
Primary Examiner, Art Unit 3992

cc: Requester (if third party requester)

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## **STATEMENT OF REASONS FOR PATENTABILITY AND/OR CONFIRMATION**

The Patent Owner's response to the Non-Final Office Action dated 12/03/2012 has been considered by the Examiner and is persuasive in overcoming the rejections as stated in said Non-Final Office Action.

The following is an examiner's statement of reasons for patentability and/or confirmation of the claims found patentable in this reexamination proceeding:

The specific proposed Substantial New Question, (SNQ), of patentability was whether or not the prior art of Wakai, Geaghan, Pallakoff and Hashimoto '354 raised an SNQ on the limitations of:

“wherein the one or more heuristics comprise:

a vertical screen scrolling heuristic for determining that the one or more finger contacts correspond to a one-dimensional vertical screen scrolling command rather than a two-dimensional screen translation command based on an angle of initial movement of a finger contact with respect to the touch screen display;

a two-dimensional screen translation heuristic for determining that the one or more finger contacts correspond to the two-dimensional screen translation command rather than the one-dimensional vertical screen scrolling command based on the angle of the initial movement of the finger contact with respect to the touch screen”.

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It was stated in the Order dated 07/13/2013 that the Prior art of Geaghan, Pallakoff and Hashimoto '354 did not raise an SNQ with the specific reasons why they did not disclose specific features described in the SNQ. Wakai was said to raise an SNQ and was utilized in the rejection of claims 1 - 20 in the Non-Final Office Action dated 12/03/2012. More specifically, Wakai was utilized in a 102(b) rejection and disclosed the limitations that were part of the SNQ.

Patent Owner's Response states that the prior art of Wakai does not specifically teach the claim limitations of:

“wherein the one or more heuristics comprise:

a vertical screen scrolling heuristic for determining that the one or more finger contacts correspond to a one-dimensional vertical screen scrolling command rather than a two-dimensional screen translation command based on an angle of initial movement of a finger contact with respect to the touch screen display;

a two-dimensional screen translation heuristic for determining that the one or more finger contacts correspond to the two-dimensional screen translation command rather than the one-dimensional vertical screen scrolling command based on the angle of the initial movement of the finger contact with respect to the touch screen;

a next item heuristic for determining that the one or more finger contacts correspond to a command to transition from displaying a respective item in a set of items to display a next item in the set of items”.

Patent Owner, hereinafter “PO”, states Wakai does not disclose a device having heuristics for distinguishing between one-dimensional vertical screen scrolling command and a two-

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dimensional screen translation command based on an initial angle of movement. Furthermore, the different embodiments of Wakai that are used in the rejection are not usable together and would not make Wakai operational since certain finger gestures can invoke multiple different heuristics that would cause confusion in the system and the system would not be able to determine which command was to be performed and therefore no single embodiment teaches both scrolling and translation commands as stated in the claim, see PO Response pages 8-10 for the analysis of Wakai's embodiments. It is noted that the interpretation of the claim language, "one or more heuristics comprise" is understood to be interpreted as including all of the limitations that follow this limitation, i.e., there can be one heuristic that has all three heuristic limitations connected to two-dimensional screen translation, one-dimensional vertical screen scrolling and the command that transitions from displaying a respective item in a set of items to displaying a next item in the set OR more than 4 heuristics that perform the mentioned commands, as stated in the PO's Interview Summary stated in the PO's response to Non-Final dated 03/04/2013, Declaration of Scott Klemmer, Ph.D. dated 03/04/2013, and the Request dated 05/24/2012, pages 12-17.

The Examiner has reviewed the PO's arguments and has found them persuasive.

As pointed out in the prior art of Wakai, the first embodiment teaches a translation command as seen in paragraphs 0173-0193, but the translation command does not include the determination of such a command based on an angle of initial movement of the finger contact with respect to the touch screen display. It bases the determination of the command on the

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distance between two points and a time factor. The other sections of Wakai do not teach a two-dimensional screen translation heuristic or command. One example is seen in ¶ 0302 which teaches a screen shift leftward in a "lateral direction only". This is interpreted as moving the screen in the X direction only of an XY co-ordinate grid and not both in the X and Y direction in a two-dimensional space, as is needed in the claim. Other similar embodiments of Wakai such as the fourth, eleventh and eighteenth embodiments teach a type of movement heuristic but do not disclose utilizing on an angle of initial movement of the finger contact with respect to the touch screen display to determine the difference between a two-dimensional screen translation command and a one-dimensional vertical screen scrolling command. Examiner further agrees with the PO on the point that the embodiments may not work at the same time and the command may be misinterpreted by the system, see PO's Response pages 11 – 15. Though one may attempt to modify such embodiments so they are usable together, no such modification is stated in Wakai or the cited prior art. Therefore, the Examiner agrees with the PO's remarks and Wakai does not anticipate the claims of the '949 Patent as stated in the Non-Final Office Action. The Examiner further agrees with the PO in that the prior art of Geaghan and Pallakoff do not teach the limitations stated above as was also stated in the Order.

Therefore, the references of Wakai, Geaghan and Pallakoff, alone or in combination with each other, would not teach or make obvious the claimed invention as stated in the '949 Patent for the reasons stated above.

Any comments considered necessary by PATENT OWNER regarding the above statement must be submitted promptly to avoid processing delays. Such submission by the

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patent owner should be labeled: "Comments on Statement of Reasons for Patentability and/or Confirmation" and will be placed in the reexamination file.

### **Service of Papers**

All correspondence related to this ExParte reexamination proceeding should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at

<https://efs.uspto.gov/efile/myportal/efs-registered>

By Mail to: Mail Stop Ex Parte Reexam

Central Reexamination Unit

Commissioner for Patents

United States Patent & Trademark Office

P.O. Box 1450

Alexandria, VA 22313-1450

By FAX to: (571) 273-9900

Central Reexamination Unit

By hand: Customer Service Window

Randolph Building

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Alexandria, VA 22314



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Telephone numbers for reexamination inquiries:

Reexamination and Amendment practice: (571) 272-7703

Central Reexamination Unit (CRU): (571) 272-7705

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

/David E. England/  
Primary Examiner, Art Unit 3992

Conferees:

/Ovidio Escalante/

/Sudhanshu C Pathak/

Supervisory Patent Examiner, Art Unit 3992