

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ANDREW JOHN WARD and DAVID CHARLES HURST

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Appeal No. 2002-0346  
Application No. 08/952,673

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ON BRIEF

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Before ABRAMS, STAAB, and NASE, Administrative Patent Judges.  
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3, 9-13 and 20. Claims 7 and 19 have been allowed and claims 4-6, 8 and 14-18 have been indicated as containing allowable subject matter but objected to for depending from a rejected claim (Paper No. 16, page 4).

We REVERSE.

### BACKGROUND

The appellants' invention relates to a braking system for a road vehicle. An understanding of the invention can be derived from a reading of exemplary claim 1, which reads as follows:

A braking system for a road vehicle, comprising:

a primary electronic braking circuit;

a back-up braking circuit having a source of back-up braking pressure which varies in accordance with braking demand as initiated by a driver;

a braking actuator for braking a wheel on a vehicle axle;

a changeover valve which is biased to a back-up position in which the back-up braking circuit is connected to the braking actuator and is actuable to a normal braking position during correct operation of the braking system to apply the primary electronic braking circuit to the braking actuator; and

a regulating valve located in the back-up braking circuit between the source of back-up braking pressure and the changeover valve and being operable as a function of axle loading and back-up braking pressure to regulate the supply of back-up braking pressure to the changeover valve.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Hommen et al. (Hommen)

5,147,114

Sep. 15, 1992

Claims 1, 3, 9-13 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hommen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the Answer (Paper No. 21) for the examiner's complete reasoning in support of the rejection, and to the Brief (Paper No. 20) and Reply Brief (Paper No. 22) for the appellants' arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

It is the examiner's position that the subject matter recited in claim 1, the sole independent claim before us, would have been obvious<sup>1</sup> in view of the teachings of Hommen. The appellants argue in rebuttal that Hommen fails to disclose or teach a back-up braking circuit which provides a pressure that varies in accordance with braking demand as initiated by a driver, and therefore does not render claim 1 obvious.

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<sup>1</sup>The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellants' disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

Among the requirements recited in claim 1 is that the back-up braking system have a source of back-up braking pressure “which varies in accordance with braking demand as initiated by a driver” (emphasis added). The purpose of this is to allow the driver to intervene to control the amount of back-up braking applied in the event of failure of the primary braking system, subject to the regulating valve that senses axle load and back-up braking pressure. While the Hommen braking system has some features in common with the system of the appellants’ invention, the concept of a driver-initiated input to the back-up braking system simply is not present therein,<sup>2</sup> a fact which is admitted by the examiner on page 4 of the Answer. However, the examiner nevertheless takes the position that “[t]he use of foot actuated brake elements in vehicle braking systems is well known in the art . . . and to have provided the driver with a device that would have been capable of providing a varied braking request signal, so as to provide the operator the ability to decelerate the vehicle at a desired rate in accordance with the situation in hand” in the Hommen system would have been obvious to one of ordinary skill in the art (Answer, page 4). We do not agree with this conclusion.

The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In

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<sup>2</sup>See, for example, column 1, lines 42-48; column 2, lines 47-50; column 3, lines 35-38, lines 44-51; column 5, lines 20-26.

re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). We fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to modify the Hommen braking system in the manner proposed by the examiner. In fact, we agree with the appellants for the reasons expressed in the Briefs that Hommen teaches away from such a feature, in that the specification indicates that the objective is always to apply the full emergency braking power, subject only to mitigation by the load sensing device.<sup>3</sup> This being the case, it appears to us that the only suggestion to make the proposed modification is found in the luxury of the hindsight afforded one who first viewed the appellants' disclosure. This, of course, is not a proper basis for a rejection under 35 U.S.C. § 103. In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

#### CONCLUSION

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<sup>3</sup>See, for example, column 3, lines 44-51.

The rejection is not sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS  
Administrative Patent Judge

LAWRENCE J. STAAB  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

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