

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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CARLOS GABAS

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Appeal No. 2004-0623  
Application No. 09/293,923

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HEARD: May 4, 2004

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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 1-8 and 11-13, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

The appellant's invention is directed to an electric parking brake for a vehicle. An understanding of the invention can be derived from a reading of exemplary claims 7 and 12, which appear in the appendix to the appellant's Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Denman <u>et al.</u> (Denman)	5,100,106	Mar. 31, 1992
Schmitz <u>et al.</u> (Schmitz)	6,172,430 B1	Jan. 9, 2001 (filed Dec. 16, 1998)
Karagiannis (German Patent) <sup>1</sup>	31 13 362 A1	Oct. 7, 1982
Bailieux (EPO Application) <sup>1</sup>	19970122 A1	Jan. 22, 1997

Claims 7 and 8 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.<sup>2</sup>

Claim 7 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Karagiannis.

Claims 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bailieux.

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<sup>1</sup>Our understanding of these foreign language documents was obtained from PTO translations, copies of which are enclosed.

<sup>2</sup>A rejection of claims 7, 8 and 10 under 35 U.S.C. § 112, first paragraph, on the basis of lack of enablement, was withdrawn on page 4 of the Answer.

Claims 1-6 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bailieux in view of Denman.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Karagiannis in view of Schmitz.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 21) and the final rejection (Paper No. 15) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 20) and Reply Brief (Paper No. 22) for the appellant's arguments thereagainst.

#### OPINION

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

#### *The Rejection Under The First Paragraph Of Section 112*

Claim 7 recites a security system for a vehicle comprising an electronic engine immobilizer, and an electric parking brake, wherein the brake is applied together with engagement of the immobilizer and is disengaged "by the operation of a manually actuated switch after the electronic engine immobilizer has been disengaged." It is the examiner's position that a "manually" actuated switch, which the appellant contends

should be interpreted as being limited to a switch operated by a person, was not disclosed in the application as filed, and therefore this claim runs afoul of 35 U.S.C. § 112, first paragraph. The appellant responds by urging that one of ordinary skill in the art would understand from the statement on page 7 of the specification that the switch for disengaging the brake is “pushed,” that it is manually actuated by the operator of the vehicle, and is not by other means, such as automatically by another device. We do not agree with this interpretation of the specification.

While it is true that the disclosure establishes that the brake switch is not to be released prior to disengagement of the electronic engine immobilizer, the extent of the explanation in the specification is merely that such is accomplished by the switch being “pushed,” which in our view instructs one of ordinary skill in this art only that some means must be provided to “push” the switch at the appropriate time, and not that the “push” must be accomplished by a person. For example, from our perspective, the explanation of this aspect of the invention provided in the appellant’s disclosure is broad enough to encompass pushing the switch by means of a solenoid device automatically triggered by the disengagement of the engine immobilizer.

Thus, we are not persuaded by the appellant’s arguments that this rejection is improper, and we will sustain it.

*The Rejection Under Section 102(b)*

Claim 7 stands rejected as being anticipated<sup>3</sup> by Karagiannis, which is directed to a system incorporating an engine immobilizer with an electric brake system. It is the examiner's position in the final rejection that "the electric parking brake is disengaged by the operation of a switch 17 which is 'manually actuated' after the electronic engine immobilizer has been disengaged" (Paper No. 15, sentence bridging pages 4 and 5). However, after the appellant pointed out in the Brief that switch 17 is engaged after the brake already has been released and thus does not disengage the brake, as is required by the claim, in the Answer the examiner departed from the original position to the extent of stating that "[i]t is clear . . . that a switch is actuated or pushed, consequently releases [sic, releasing] the brakes" (page 5, emphasis added).

On page 2 of the translation, Karagiannis explains that "at the time the vehicle motor is switched on, the switch or an additional switch is actuated that activates the brake actuation mechanism to release the brake." Further detail is provided on page 3 of the translation, where it is explained in line 20 et seq. that when the ignition key is operated to start the vehicle engine, switch 2 causes contacts to close and power to be applied to electric motor 7, which allows cable 13a to be payed out under the action of spring 15 to release the brakes until power to motor 7 is interrupted by rod 12 causing switch 17 to close, which occurs after the brakes are disengaged.

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<sup>3</sup>Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of the claimed invention. See, for example, RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

It therefore is clear from the description of the operation of the invention that in the Karagiannis system switch 2 is activated concurrently with the operation of the ignition switch, and switch 17 is operated subsequent to the disengagement of the brake. Thus, neither of these switches disengages the parking brake after the electronic engine immobilizer has been disengaged, and neither meets the limitations of claim 7. Nor, from our perspective, is there any other switch in the Karagiannis system that does so. This being the case, the subject matter recited in claim 7 is not anticipated by Karagiannis, and the rejection cannot be sustained.

*The Rejections Under Section 103(a)*

In the first of these rejections, the examiner has found the subject matter of claims 12 and 13 to be obvious<sup>4</sup> in view of Bailieux. Independent claim 12 is directed to the details of the structure of an electric parking brake, which includes a winch, an electric motor having a rotary shaft for driving the winch, two braking cables attached to the winch, and a gear driven by the electric motor engaged with the winch along a diameter “centrally disposed between the opposite sides of the winch to which the

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<sup>4</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 appellant's 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).

braking cables are fixed” when the winch is in the position in which the braking cables are disengaged, with the rotary shaft driving the winch being “substantially orthogonal with respect to the braking cables.” It is the examiner’s position that the embodiment of the braking system that is shown in Bailieux’ Figure 3F discloses all of the subject matter recited in claim 12 except for the rotary shaft being orthogonal with respect to the braking cables. However, the examiner goes on to find that such an arrangement is present in the embodiment in Bailieux’ Figure 4C, and concludes it would have been obvious to one of ordinary skill in the art to modify the Figure 3F system by orienting the motor drive shaft orthogonally with respect to the braking cables “to accommodate a certain space requirement as taught by Bailieux’s Figure 4C.” See Paper No. 15, pages 5 and 6.

We agree with the appellant that this rejection is defective. While Bailieux states that the arrangement in Figure 4C is “adapted to that space available in the vehicle” (translation, page 15), the examiner has not explained why the Figure 4C arrangement would be an improvement over that of Figure 3F, which from the drawings appears to occupy no more space than that of Figure 4C. Also, the Figure 4C embodiment is directed to an entirely different concept for operating the brakes, in which a separate cable winding drum is utilized for each the two cables rather than the single drum present in Figure 3F. Finally, the examiner incorrectly has found (Paper No. 15, page 5) that the driving gear in Bailieux’ Figure 3F is centrally disposed between the attachment

points of the cables on the winch drum in the initial position when the brakes are disengaged, as is required by claim 12 when, in fact, the drawings show that clearly not to be the case.

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 re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In the present case, based upon the evidence adduced by the examiner, we fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to modify the Figure 3F embodiment of Bailieux in such a manner as to meet the terms of claim 12. This being the case, it is our conclusion that the Bailieux fails to establish a prima facie case of obviousness with respect to the subject matter disclosed in claim 12 or, it follows, of dependent claim 13, and we will not sustain this rejection.

Claims 1-6 and 11 stand rejected as being unpatentable over Bailieux in view of Denman. In this rejection the examiner finds Bailieux' Figure 3F to lack only the tapered sides on the housing to guide the brake cables, and concludes that such a feature would have been an obvious addition to the Bailieux system in view of the teachings of Denman's Figures 11 and 12 "to better guide the brake cables' (Paper No. 15, page 6). Be that as it may, claims 1-6 and 11 depend from claim 12, which the examiner rejected as being unpatentable over Bailieux alone. We did not sustain the rejection of claim 12 because Bailieux fails to establish a prima facie case of obviousness with regard

thereto. Even if Denman were applied in the manner proposed by the examiner, it is our opinion that it fails to overcome Bailieux' shortcomings with regard to the limitations set forth in claim 12. On this basis the rejection of claims 1-6 and 11 is not sustained.

We reach the same conclusion with regard to claim 8, which stands rejected as being unpatentable over Karagiannis in view of Schmitz. Claim 8 depends from claim 7, and adds central locking to the security system of the parent claim. We concluded above that Karagiannis failed to anticipate claim 7 because it lacked a switch that disengaged the parking brake after the electronic engine immobilizer was disengaged. Considering Karagiannis under Section 103 does not cause us to alter this conclusion, nor does further consideration of Schmitz, which is directed to a device for locking and unlocking the doors of a motor vehicle. The rejection of claim 8 therefore is not sustained.

#### CONCLUSION

The standing rejection of claims 7 and 8 under 35 U.S.C. § 112, first paragraph, is sustained.

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The standing rejections of claim 7 under 35 U.S.C. § 102(b) and claims 1-6, 8 and 11-13 under 35 U.S.C. § 103(a) are not sustained.

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
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	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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