

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID B. STEINBRING

Appeal 2008-3718
Application 11/247,679
Technology Center 3600

Decided: September 25, 2008

Before JAMESON LEE, MICHAEL P. TIERNEY, and JAMES T. MOORE, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

DECISION ON APPEAL

A. Statement of the Case

This is a decision on appeal by an Appellant under 35 U.S.C. § 134(a) from a final rejection of claims 1-8. We have jurisdiction under 35 U.S.C. § 6(b).

References Relied on by the Examiner

MacMullen	US 2,100,970	Nov. 30, 1937
Pinkston	US 7,059,690	Jun. 13, 2006

The Rejection on Appeal

The Examiner rejected claims 1-8 under 35 U.S.C. § 103(a) as being unpatentable over Pinkston and MacMullen.

B. Findings of Fact

1. The invention relates to a safety indicator for parking brake systems which indicates to the driver of a commercial truck that the parking brake is not engaged. (Spec. 1:4-6.)

2. Claim 1 is representative and is reproduced below (App. Br., Claims App'x.).

1. A parking brake engagement indicator for a parking brake system on a commercial truck, the indicator comprising:

a bar mounted on the commercial truck, wherein the bar is movable between a position of impediment between an occupant's outside lower leg portion and an occupant's side exit doorframe of said truck, and a position of non-impediment;

the bar being connected to the parking brake system whereby said bar is manipulated by said brake system to the position of impediment when said parking brake is disengaged and said bar is manipulated by said brake system to the position of non-impediment when said parking brake is engaged.

3. Pinkston discloses a visual air brake notification device for notifying an individual whether a vehicle's brake system is active or inactive. (Pinkston Abstract.)

4. Pinkston teaches that a pneumatically controlled and adjustably mounted flag 20 moves between two positions by the operation of a vehicle's air brake system 75 in order to alert workers at the rear of the vehicle as to the status of the brakes. (Pinkston 3:54 to 4:2.)

5. MacMullen discloses an invention for automatically locking the wheels of a vehicle against slipping or rotation. (MacMullen 1:6-12.)

6. MacMullen teaches that it is desirable for a bar 26 to be positioned adjacent the driver side door in order to form a physical impediment to inhibit the driver from exiting the vehicle until the vehicle's parking brakes are engaged (MacMullen 1:22-33).

7. In MacMullen, the purpose of providing the physical impediment is to reduce the number of accidents caused by the roll-away of unattended vehicles that are improperly braked. (*Id.* at 1:41-46.)

8. The Appellant submitted a Declaration under 37 C.F.R. § 1.132 filed December 20, 2007 as evidence of non-obviousness based on the secondary considerations of commercial success and satisfaction of a long-felt but unsolved need.

9. The Declaration includes seven exhibits labeled A through F.

10. Exhibit A is a published article about inventor, David Steinberg, and his device for reminding vehicle operators to set the vehicle's parking brake.

11. Exhibit B is a letter from Jill D. Edwards, Executive Director of the Ben Franklin Venture Investment Forum, notifying Mr. Steinberg that his company has been declared the winner of the \$25,000 Big Idea Contest.

12. Exhibits C, D, and E are published articles about the inventor being awarded a \$25,000 prize as the winner of the Big \$25,000 Idea Business Plan Contest.

13. Exhibit F is a letter from the Assistant Chief, Jason Ober, on behalf on the Richland Township Fire Department describing that, in his opinion, the Appellant's invention will reduce accidents and injuries and stating that the fire department intends to outfit its current and future vehicles with the invention.

14. The Declaration evidence does not show that any device according to the invention has been sold or that there has been any license agreement to license the technology.

15. The Appellant admits that as of the date of the Declaration, regular production of the invention had not been finalized and only a prototype had been produced. (Declaration 2:10-11.)

16. The Appellant alleges that a long-felt need is a solution to the problem of truck roll-aways through the use of a physical reminder to the driver of the vehicle to set the parking brake. (Declaration 2:15 to 3:16.)

17. The Declaration evidence attributes the benefit of the Appellant's invention to providing a physical reminder to set the parking park as opposed to a visual or audible reminder. (Exhibits A, C, D, E.)

18. The Appellant's specification indicates the claim feature of a brake system acting to position the impeding bar is an important aspect of the invention. (Spec. 3:5-13; 4:14 to 5:4.)

19. None of articles or letters commends that important aspect of the invention, i.e. using the brake system to position the impeding bar.

C. Analysis

The Appellant must show error in the Examiner's rejection of claims 1-8. Claims 1-8 are argued collectively. Claim 1 is representative.

The Appellant disputes that the Examiner has established a prima facie case of obviousness in rejecting claim 1 based on the combination of Pinkston and MacMullen. In the alternative, the Appellant submitted evidence of secondary consideration to be considered together with the prior art evidence cited by the Examiner.

Evidence of Obviousness

The Examiner found that Pinkston discloses all the elements of claim 1 with the exception of the bar being located to serve as a position of impediment between the occupant's leg and his side door exit. To remedy the deficiency, the Examiner turned to MacMullen and found that (Ans. 4:16-19):

MacMullen teaches another commonly required safety equipment on commercial trucks wherein the bar 26 is located between the driver and the door frame to ensure that the brake is engaged before the driver can leave the truck.

The Examiner explained (Ans. 7:16 to 8:7):

...both of the flag 20 of Pinkston and the bar 26 of MacMullen are well known required safety features for commercial trucks. It would have been obvious to install the flag onto the back of MacMullen's truck and it would also be obvious to install the bar onto Pinkston's door frame. By having the bar at the door frame, the bar serves as a reminder to the driver to actuate the parking brake. By actuating the parking brake, the flag is raised to indicate to other workers around the truck that it is safe to move about the truck. The bar is a reminder for the driver and the flag is an indicator for other workers. Having both bar and flag on the truck of Pinkston or having both bar and flag on the truck of MacMullen would have been an obvious combination

for one of ordinary skill in the art in order to increase safety for all operating and working around commercial trucks. Hence, it is not hindsight, it is an obvious combination of well known safety devices to produce the predictable results of increasing safety for all workers.

The Appellant argues that the combination does not satisfy the claimed invention as it only suggests that (Br. 7:5-9)¹:

...when the mechanical actuated brake of McMullen [sic, MacMullen] was in fact actuated, it would also, through the parking brake system, actuate a flag indicator positioned at the rear of the truck to indicate to those at the rear of the vehicle who may be loading or unloading the vehicle that the parking brake for the trucks is safely engaged. It is respectfully submitted that to conclude otherwise, as done by the Examiner, is an improper conclusion made by hindsight.

The Appellant further argues that (Br. 8:4-6):

...Appellant's invention as claimed clearly points out that the brake system operates indicator bar 13. not the truck operator. What a combination of the references teach is that one must move the indicator bar to operate a warning flag at the rear of the truck.

Thus, according to the Appellant, the Pinkston and MacMullen combination only teaches that the manual operation of MacMullen's bar 26 would actuate a flag at the rear of the vehicle. The Appellant concludes that the combination does not satisfy all the limitations of the Appellant's claim 1, in particular, those limitations relating to the brake system manipulating a bar that is adjacent a doorframe to move the bar in-between a position of impediment and non-impediment.

We do not agree that the combined teachings of the references would be so limited as to suggest only the Appellant's proposed way of combining

¹ "Br." refers to the Appellant's second amended appeal brief filed December 20, 2007.

the teaching of those references. Each of Pinkston and MacMullen described safety devices related to the braking system of a vehicle. Pinkston teaches that a pneumatically controlled and adjustably mounted flag 20 moves between two positions by the operation of a vehicle's air brake system 75 in order to alert workers at the rear of the vehicle as to the status of the brakes. (Pinkston 3:54 to 4:2.) MacMullen teaches that it is desirable for a bar 26 to be positioned adjacent the driver side door in order to form a physical impediment that inhibits the driver from exiting the vehicle until the vehicle's parking brake is engaged (MacMullen 2:22-33). The Appellant's limited view of what the combination of the references teaches focuses on MacMullen to the deficit of the teaching value of Pinkston.

The Examiner reasoned that a person of ordinary skill in the art would understand the Pinkston and MacMullen combination as teaching both the safety features of an indicator flag at the rear vehicle and a bar located between the driver and the driver's side door. The Examiner further reasoned that because Pinkston discloses the use of the vehicle's air brake system 75 to operate pneumatically the rear indicator flag 20, a person of ordinary skill in the art would reasonably recognize that the air brake system could also operate the bar near the driver's door. The Examiner's way of combining the reference teachings correctly takes into account the teaching value of both references in view of the knowledge of one of ordinary skill in the art. If the vehicle's air brake system could operate the rear safety flag, there is no reason why it could not also be used to operate the safety bar between the driver and the driver side door. A person of ordinary skill in the art is a person of ordinary creativity, not an automaton. *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742 (2007). Each prior art reference

must be considered for everything it teaches by way of technology and is not limited to the particular invention it is describing and attempting to protect. *EWP Corp. v. Reliance Universal Inc.*, 755 F.2d 898, 907 (Fed. Cir.), *cert. denied*, 474 U.S. 843 (1985).

The Appellant has not shown error in the Examiner's determination that a prima facie case of obviousness of the Appellant's claims has been established based on the combination of Pinkston and MacMullen.

Secondary Considerations

Once the Examiner has established a prima facie case of obviousness, the burden shifts to the Appellant to show evidence of non-obviousness that would overcome that prima facie case. *In re Huang*, 100 F.3d 135, 139 (Fed. Cir. 1996). Factors that are relevant to meeting that burden include evidence of commercial success, long felt but unsolved needs, failure of others, etc. *Graham v. John Deere Company of Kansas City et al.*, 383 U.S. 1, 18 (1966).

The Appellant submitted a Declaration under 37 C.F.R. § 1.132 on December 20, 2007 that is alleged to provide evidence of non-obviousness based on the secondary considerations of the invention's commercial success and its satisfaction of a long-felt but unsolved need.

Commercial Success

To support the Appellant's claim of commercial success, the Appellant relies on seven exhibits labeled A through F. Exhibit A is a published article about inventor David Steinberg and his device for reminding vehicle operators to set the vehicle's parking brake. Exhibits C, D, and E are four published articles and Exhibit B is a letter from Jill D.

Edwards, Executive Director of the Ben Franklin Venture Investment Forum, all of which describe that the inventor was awarded a \$25,000 prize for the entry of his invention in a contest. Exhibit F is a letter from Assistant Chief Jason Ober on behalf on the Richland Township Fire Department describing that, in his opinion, the Appellant's invention will reduce accidents and injuries and stating that the fire department intends to outfit its current and future vehicles with the invention.

That evidence does not show that any device according to the invention has been sold or that anyone has licensed the technology from the Appellant. That a single firehouse intends to use the Appellant's invention does not establish meaningful commercial success. The Appellant himself admits that as of the date of the Declaration, regular production of the invention had not been finalized and only a prototype had been produced. (Declaration 2:10-11.) The evidence indicates only that there is a potential for commercial success but not actual commercial success. On this record, no one has purchased a single device embodying the Appellant's invention. A primary consideration in demonstrating actual commercial success is if sales of the claimed invention have produced a substantial share of the marketplace. *See In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996). On this record, the Appellant has not shown what percentage of the market he has acquired.

Moreover, even if the evidence proffered sufficiently demonstrates commercial success, that success is only relevant in the obviousness context if there is proof that the success results from the unique characteristics of the claimed invention--as opposed to other economic and commercial factors

unrelated to the quality of the claimed invention. *In re Huang*, 100 F.3d at 140.

Here, the Appellant points to evidence that he was the recipient of a \$25,000 prize for his entry in a contest. (Exhibits B-E.) The Appellant relies on that evidence to prove the commercial success of his claimed invention. However, the evidence does not indicate the criteria used to determine the contest winner. What factors were considered in evaluating the entries and what was the relative weight of each factor in determining the contest outcome? Some of the exhibits refer to the contest as a “Business Plan Contest.” (Exhibits C, D, E.) The reference to “Business Plan” suggests that factors may have been taken into account that are unrelated to the quality of the claimed invention, such as marketing or advertising strategies. In the absence of evidence of the evaluation criteria for the contest, we cannot determine to what extent the characteristics of the claimed invention influenced the contest outcome. We reject the Appellant’s argument that the contest evidence before us shows meaningful commercial success of the claimed invention.

Furthermore, the evidence is also not persuasive in showing commercial success of the claimed invention because it does not differentiate between that invention and the prior art already in existence, such as MacMullen. The Appellant’s claim 1 calls for a bar that is connected to the brake system of a vehicle and is moved into and out of a position of impediment by the brake system. The Appellant’s specification indicates the claim feature of a brake system acting to position the impeding bar is an important aspect of the invention. (Spec. 3:5-13; 4:14 to 5:4.) However, none of the articles or letters submitted in the Declaration praises

that important aspect of the invention. Instead, the evidence attributes the benefit of the Appellant's invention to simply providing a physical reminder to a driver to set a vehicle's parking brake. (Exhibits A, C, D, E.) That, of course, is already disclosed by MacMullen.

A nexus is required between the merits of the claimed invention and any objective evidence of nonobviousness offered, if that evidence is to be given substantial weight enroute to a conclusion on obviousness. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1539 (Fed. Cir. 1983). Here, the evidence praising the physical reminder aspect of the Appellant's invention seems equally applicable to the physical impediment provided by MacMullen's bar 26. That bar also provides a physical reminder to set a parking brake in a vehicle. It would seem that the articles and letters would have been equally impressed by MacMullen. The evidence is insufficient to establish a nexus between the words of praise and the Appellant's claimed invention.

Long-Felt but Unsolved Need

The Appellant also asserts that his invention "satisfies a long-felt need which was recognized, persistent and not solved by other in the industry." (Declaration 2:15-16.) The alleged long-felt need is a solution to the problem of truck roll-always through use of a reminder to the driver of the vehicle to set the parking brake. (Declaration 2:15 to 3:16.)

Establishing a long-felt need requires objective evidence that the invention has provided a long-awaited, widely accepted, and promptly adopted solution to a problem extant in the art, or that others had tried but failed to solve that problem. *In re Mixon*, 470 F.2d 1374, 1377 (CCPA 1973). In particular, the evidence must show that the need was a persistent

one that was recognized by those of ordinary skill in the art. *In re Gershon*, 372 F.2d 535, 539 (CCPA 1967).

The Appellant's evidence, however, does not indicate that there has been a substantial problem caused by drivers' failure to set parking brakes. A general reference to "130,000 trucking accidents per year" of which some portion of those accidents are due to truck roll-aways when the operator fails to set the parking brake (Exhibit C) does not indicate how many accidents are of that type. References to statements from the inventor that numerous accidents were caused by a failure to set the parking brakes of trucks and other heavy vehicles (Exhibits A, E) are based only on the inventors own assertion. No objective record substantiates the assertion. The letter from the assistant fire chief Jason Ober suggests that the invention would reduce vehicle accidents but does not indicate the extent of the reduction (Exhibit F). The view of the fire chief is also prospective in nature and is not based on actual data. The evidence does not establish that a vehicle operator's failing to set a parking brake has been a persistent problem in need of a solution.

Even assuming that there is a long-felt need, that need must not already have been solved by another before the invention by the Appellant. *Newell Companies v. Kenny Mfg. Co.*, 864 F.2d 757, 768 (Fed. Cir. 1988). Here, the alleged long-felt need is a solution to the problem of truck roll-aways through use of a physical reminder to the driver of the vehicle to set the parking brake. As previously noted, MacMullen's bar 26 serves as physical reminder that requires the vehicle operator to set the parking brake, prior to exiting the vehicle. (*Id.* at 1:41-46.) Thus, MacMullen, which

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issued as a patent well before the Appellant's invention, evidently already solved the truck roll-away problem identified by the Appellant.

We have considered the evidence of alleged commercial success and long-felt need. However, for the reasons discussed above, the Appellant's of nonobviousness is weak and the Examiner's evidence of obviousness is strong. On balance, the evidence of obviousness outweighs the evidence of nonobviousness.

For all the foregoing reasons, we sustain the Examiner's rejection of claims 1-8 under 35 U.S.C. § 103(a) as being unpatentable over Pinkston and MacMullen.

D. Conclusion

The rejection of claims 1-8 under 35 U.S.C. § 103(a) as being unpatentable over Pinkston and MacMullen is **affirmed**.

Further, no time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a).

AFFIRMED

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