

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JAMES M. PAYNE

Appeal No. 2000-1487
Application No. 08/786,373

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, ABRAMS and BAHR,
Administrative Patent Judges.

BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-13,
which are all of the claims pending in this application.

BACKGROUND

The appellant's invention relates to a trailer step which facilitates access to the load being carried on the trailer, and which includes a lamp. Representative claim 1 reads as follows:

1. In a trailer adapted for connection to a towing vehicle and having a front, a side, and a step for facilitating access to the trailer or a load being carried by the trailer, the step having an upper horizontal surface and a vertical skirt portion facing outwardly from the trailer, the improvement comprising:
means forming indicia to be displayed carried by said outwardly facing skirt portion of said step for visual observation of said means forming indicia from the side and front of said trailer, and
a lamp positioned behind said means forming indicia to backlight said means forming indicia carried by said outwardly facing skirt portion of said step to project light outwardly from the front and the sides¹ of said trailer through said means forming indicia to enable observation of said trailer step and means forming indicia from the towing vehicle when said trailer is parked and in motion being towed behind the towing vehicle.

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

Rubin	3,935,654	Feb. 3, 1976
Koch	5,154,564	Oct. 13, 1992
Chudzik	5,157,591	Oct. 20, 1992
Barry	5,615,940	Apr. 1, 1997
Lamparter	5,634,287	Jun. 3, 1997

¹ It appears that "sides" should be "side," as the light associated with the sole step and associated skirt portion and lamp recited in claim 1 is projected outwardly only from the front and one side of the trailer, not from both sides of the trailer.

Godbersen

Des. 314,735

Feb. 19, 1991

The following rejections are before us for review.

Claims 1, 2, 6-9 and 11-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Koch in view of Barry.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Koch in view of Barry and Lamparter.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Koch in view of Barry and Chudzik.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Koch in view of Barry and Godbersen.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Koch in view of Barry and Rubin.

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. 19) for the examiner's complete reasoning in support of the rejections and to the brief and reply brief (Paper Nos. 18 and 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.

Claim 1 requires means forming indicia carried by the outwardly facing skirt portion of the step for visual observation of the means forming indicia from the side and front of the trailer and a lamp positioned behind the means forming indicia. As acknowledged by the examiner (answer, page 3), Koch, the primary reference relied upon in rejecting claim 1, lacks these features. The examiner looks to the teachings of Barry to supply the missing lamp and means forming indicia.

As stated by our reviewing court in In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000):

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant [citations omitted].

In this instance, Barry does disclose means forming indicia (panels 24, 26 with openings 25, 27 therein) and a lamp (illumination means 42, 48) positioned behind the means forming indicia of the type called for in claim 1. From our perspective, however, one skilled in the art would have found no suggestion whatsoever in Barry's teaching of an

illuminated motorcycle gas tank or shell, formed by removable panels 24, 26 having openings 25, 27 of a desired design therein and illumination means 42, 48 disposed behind the openings, to provide means forming indicia carried by the vertical skirt portion of the step of Koch's trailer and a lamp positioned behind the means forming indicia. Barry's invention "relates generally to motorcycles and more particularly to installing illumination means within the gasoline tank area of a motorcycle" (column 1, lines 10-12). Barry provides no teaching or suggestion to apply the illumination means disclosed therein to other types of vehicles, such as trailers, much less to the particular location on the trailer called for in claim 1. In our view, the only suggestion for putting the selected pieces from the references together in the manner proposed by the examiner is found in the luxury of hindsight accorded one who first viewed the appellant's disclosure. This, of course, is not a proper basis for a rejection. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Accordingly, we shall not sustain the examiner's rejection of claim 1 or claims 2, 6-9 and 11-13 which depend from claim 1 as being unpatentable over Koch in view of Barry.

The additional references relied upon by the examiner to support the obviousness rejections of the dependent claims also do not cure the above-noted deficiencies of the Koch-Barry combination. Godbersen discloses a boat trailer fender design which appears to include non-slip steps projecting from the front and rear thereof, but provides no teaching or suggestion to provide any indicia or lamp on the trailer. Lamparter discloses

an illuminated sign housing assembly particularly for a school bus; Chudzik discloses a removable auxiliary taillight assembly for use on trailers or on vehicles equipped with racks or carriers for various objects, such as bicycles, skis, etc. which can obstruct the taillights of the vehicle; and Rubin discloses an illuminated vehicle sign adapted for mounting on the sides of a vehicle, such as a panel truck or a truck trailer. None of Lamparter, Chudzik and Rubin provides any teaching or suggestion to provide an illuminated sign or lights on a trailer in the particular location called for in claim 1. Accordingly, we shall not sustain the examiner's rejections of claim 3 as being unpatentable over Koch in view of Barry and Lamparter, claim 4 as being unpatentable over Koch in view of Barry and Chudzik, claim 5 as being unpatentable over Koch in view of Barry and Godbersen and claim 10 as being unpatentable over Koch in view of Barry and Rubin.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-13 under 35 U.S.C. § 103 is reversed.

REVERSED

HARRISON E. McCANDLISH
Senior Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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August E. Roehrig Jr.
Hancock & Estabrook, LLP
1500 Mony Tower 1
P.O. Box 4976
Syracuse, NY 13221-4976