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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* BERNARD L. DICK

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Appeal 2010-011432  
Application 11/619,642  
Technology Center 3600

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Before BIBHU R. MOHANTY, MICHAEL W. KIM, and JAMES A.  
TARTAL, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE<sup>1</sup>

Bernard L. Dick (Appellant) seeks our review under 35 U.S.C § 134 of the Examiner's final decision rejecting claims 1-6 and 21-34. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

Appellant's claimed invention relates to a gooseneck trailer hitch mechanism that allows a user to store the hitch ball in an inverted position. Spec., para. [0003].

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A gooseneck trailer hitch mechanism comprising:

a frame;

a housing coupled with the frame, the housing having an opening therein;

a hitch member having a portion thereof which is selectively slidably received within the opening in the housing in an upright position and an inverted position, and wherein the portion of the hitch member is cylindrical and includes an annular groove in an outer surface thereof which entirely circumscribes the portion; and

a pin member coupled with the housing for selectively retaining the hitch member in the housing, wherein the pin member is selectively movable between a first position, where a portion of the pin member extends into the opening, and a second position, where the pin does not extend into the opening.

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<sup>1</sup> Our decision will make reference to Appellant's Appeal Brief ("App. Br.," filed Jul. 14, 2008) and Reply Brief ("Reply Br.," filed Jun. 1, 2010), and the Examiner's Answer ("Ans.," mailed Mar. 30, 2010).

The Examiner relies upon the following evidence:

Morris	US 4,889,356	Dec. 26, 1989
Allen	US 5,104,138	Apr. 14, 1992
Marcy	US 5,472,222	Dec. 5, 1995
Roberts	US 6,695,338 B1	Feb. 24, 2004

Claims 1-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Allen and Roberts.

Claims 1-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Allen and Marcy.

Claims 21-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Allen, Marcy, and Morris.

#### FINDINGS OF FACT

We find that the findings of fact which appear in the Analysis below are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

#### ANALYSIS

##### *Obviousness over Allen and Roberts*

##### *Claims 1-6*

We are not persuaded by Appellant's argument that neither Allen nor Roberts discloses the use of a selectively movable pin member. *See App. Br. 9*. Allen teaches a selectively movable pin 36 with a handle 50 for manual positioning by a user between engaged and disengaged positions. *See Ans. 6-7*.

Appellant further contends that Allen teaches away from inverting the hitch assembly by utilizing a plug when the hitch assembly is removed (App. Br. 9) and that Roberts teaches away from making a hitch rotatable (Reply Br. 9). We find Appellant's argument unconvincing because Appellant has not shown that either Allen or Roberts criticizes, discredits, or otherwise discourages the solution claimed in the application. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). ("The prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed in the ... application."). The mere disclosure of the use of a plug or non-rotatable hitch would not give the ordinary artisan the impression that a rotatable, invertible hitch could not be formulated.

We also find unconvincing Appellant's assertion that the Examiner's combination of Allen and Roberts reflects impermissible hindsight. App. Br. 10. The combination of the removable hitch of Allen with the invertible hitch of Roberts yields precisely what would be predicted. *See KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007) ("The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.") Appellant's contention that the references are not combinable because Allen does not disclose an invertible hitch and Roberts does not disclose a rotatable hitch is not persuasive. Appellant has not addressed the combination of prior art references as a whole but simply argues the merits of Allen and Roberts individually. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981)

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

Appellant has not overcome the Examiner's determination that one of ordinary skill in the art would be motivated to combine features of Allen and Roberts to arrive at the claimed invention to produce a hitch that may be stored when not in use. *See* Ans. 3.

*Obviousness over Allen and Marcy*

*Claims 1-6*

With respect to the asserted combination of Allen and Marcy, Appellant raises essentially the same issues addressed above with respect to the asserted combination of Allen and Roberts. Allen teaches a selectively movable pin member, and Appellant has not shown that Marcy teaches away from making a hitch rotatable. Accordingly, we conclude that Appellant has not overcome the Examiner's determination that claims 1-6 are unpatentable over Allen and Marcy for the same reasons discussed above with respect to the combination of Allen and Roberts.

*Obviousness over Allen, Marcy, and Morris*

*Claims 21-30*

In addition to the issues raised with respect to Allen and Marcy, addressed above, Appellant further argues that Morris does not disclose a selectively movable pin member as claimed. As discussed above, Allen

teaches a selectively movable pin. The Examiner also relies on Morris for the disclosure of a pin (retainer screw 31) that extends radially relative to the housing opening, as set forth in claim 21. Ans. 4.

We are also not persuaded by Appellant's contention that the retainer screw 31 of Morris functions differently than the present invention by securing a ball to a post, and not securing an entire trailer hitch assembly within a bed of a truck. *See Reply Br. 13.* Morris is not cited for this aspect; a combination of Allen and Tracy are. Appellant has therefore not overcome the Examiner's determination that one of ordinary skill in the art would be motivated to combine features of Allen, Marcy, and Morris to arrive at the claimed invention to produce a hitch that may be stored when not in use and to simplify the locking mechanism. *See Ans. 3-5.*

*Claims 31-34*

We are not persuaded by Appellant's argument that the Examiner has not identified the claimed element of a groove with a generally uniform depth and width that is positioned generally equidistant from upper and lower surfaces of the base portion of the hitch in the cited prior art. App. Br. 17. Allen Figures 2 and 5 disclose a groove having a generally uniform depth and width. While the groove of Allen is concave, the depth remains generally uniform, which is all that is required by the language of the claim. Marcy Figures 5 and 6 further disclose an invertible hitch with a groove positioned generally equidistant from upper and lower surfaces of the base portion of the hitch. Accordingly, we find Appellant has not overcome the Examiner's determination that the claimed elements are disclosed in combination by Allen, Marcy, and Morris.

*Secondary Considerations*

We recognize that evidence of secondary considerations, such as that presented by Appellant, must be considered en route to a determination of obviousness or non-obviousness under 35 U.S.C. § 103. Accordingly, we consider anew the issue of obviousness under 35 U.S.C. § 103, carefully evaluating and weighing the evidence relied upon by the Examiner, any other evidence of obviousness, and the objective evidence of non-obviousness provided by Appellant. *See In re Eli Lilly & Co.*, 902 F.2d 943, 945 (Fed. Cir. 1990) (holding that “[a]fter a *prima facie* case of obviousness has been made and rebuttal evidence submitted, all the evidence must be considered anew.”)

Appellant provided the following evidence of secondary considerations in rebuttal to the *prima facie* case of obviousness: (1) Declaration of Bernard L. Dick discussing certain sales information, and (2) copies of correspondence from Dennis Webster, Doreen and John Powers, Jeff Gibson, and John Ruffalo touting the benefits of the claimed invertible hitch.

Appellant provided figures comparing the percentage of sales by Pop Up Industries of trailer hitches with and without the invertible feature of the present application. The figures indicate that between March, 2003 and April, 2005, the number of invertible hitches sold per month ranged from 11.68% to 201.90% of the number of all other hitches sold during that month. Further, the correspondence provided by Appellant indicates that customers have identified the rotatable feature of the hitch as a functional benefit.

The Examiner found that the declaration and correspondence was insufficient to show commercial success because there was no indication of the overall number of hitches sold with respect to the percentage of increased sales for Pop Up Industries, and no information was provided on sales relative to the overall market. Ans. 9. The Examiner further noted that for sales figure provided, there was no linear progression in sales of the invertible hitch, and no information on peripheral factors that may have influenced the sales numbers, such as promotions and advertising. Ans. 9-10. Based on the limited sales information from a single company and correspondence provided by Appellant, we conclude that Appellant has not demonstrated the commercial success of the claimed invention.

Moreover, asserting that what makes an invention commercially successful is a claimed feature that is well known in the art fails to establish a nexus because “the asserted commercial success of the product must be due to the merits of the claimed invention beyond what was readily available in the prior art.” *J.T. Eaton & Co., Inc. v. Atl. Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed. Cir. 1997) *citing to Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1580 (Fed. Cir. 1983) (claims held obvious despite purported showing of commercial success when patentee failed to show that “such commercial success as its marketed system enjoyed was due to anything disclosed in the patent in suit which was not readily available in the prior art.”) Since Allen and Morris both described a rotatable hitch, we find that the declaration and correspondence provide little probative evidence that any commercial success was directly attributed to the claimed invention.

Thus, we find that after reviewing all of the evidence before us, it is our conclusion that, on balance, the evidence of non-obviousness fails to

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outweigh the evidence of obviousness and, accordingly, the subject matter of independent claims 1, 21, and 31 would have been obvious to one of ordinary skill in the art, within the meaning of 35 U.S.C. § 103, at the time Appellant's invention was made.

#### CONCLUSIONS OF LAW

We conclude that Appellant has not overcome the Examiner's rejection of claims 1-6 under 35 U.S.C. § 103(a) as unpatentable over Allen and Roberts.

We further conclude that Appellant has not overcome the Examiner's rejection of claims 1-6 under 35 U.S.C. § 103(a) as unpatentable over Allen and Marcy.

We further conclude that Appellant has not overcome the Examiner's rejection of claims 21-34 under 35 U.S.C. § 103(a) as unpatentable over Allen, Marcy, and Morris.

#### DECISION

We AFFIRM the decision of the Examiner to reject claims 1-6 and 21-34.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2011).

AFFIRMED

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