

PRECEDENTIAL OPINION

Pursuant to Board of Patent Appeals and Interferences Standard Operating Procedure 2, the opinion below has been designated a precedential opinion.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN F. JELLÁ

Appeal 2008-1619
Application 10/836,805
Technology Center 3600

Decided: November 3, 2008

Before MICHAEL R. FLEMING, *Chief Administrative Patent Judge*, and WILLIAM F. PATE, III, SALLY C. MEDLEY, LINDA E. HORNER, and JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL STATEMENT OF THE CASE

John F. Jellá (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1, 6, 7, 12, 13, and 15, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

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SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

The Appellant's claimed invention relates to raised panel door sections for overhead garage doors (Spec. 1:25-26). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A door section for an overhead garage door comprising:
 - a sheet metal layer having a finished height of substantially twenty-eight inches; and
 - and [*sic*] support members coupled to first and second lateral edges of said sheet metal layer.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Geoffrey	US 3,891,021	Jun. 24, 1975
Martin	US 4,284,119	Aug. 18, 1981
Dykes	US 5,598,667	Feb. 4, 1997

The Appellant seeks our review of the rejection of claims 1, 6, 7, 12, 13, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Martin in view of Dykes and/or Geoffrey.

ISSUE

The issue before us is whether the Appellant has shown the Examiner erred in determining that a door section having a finished height of substantially twenty-eight inches would have been obvious to one having ordinary skill in the art at the time of the invention in view of the prior art.

FINDINGS OF FACT

We find that the following enumerated findings 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).

1. Martin discloses an overhead garage door having a section assembly 10 including a sheet metal layer 12 and end support members 14 coupled to first and second lateral edges of the sheet metal layer (Martin, col. 4, ll. 14-17, 21-23, and 54-57; Figs. 1 & 2).
2. Martin does not disclose that the sheet metal layer has a finished height of substantially twenty-eight inches.
3. Dykes relates to a panel cover system for resurfacing existing overhead garage doors (Dykes, col. 2, ll. 11-14).
4. Dykes describes that overhead door heights of seven feet are fairly common (Dykes, col. 3, ll. 38-39).
5. Dykes discloses a door structure 4 having four panels 18a, 18b, 18c, and 18d (Dykes, col. 3, ll. 23-24).

6. Dykes further describes that “overhead doors are available with four, five and six panels, and could be manufactured with other numbers of panels. Moreover, overhead doors may comprise single panels” (Dykes, col. 3, ll. 42-45).
7. Thus, Dykes describes common, commercially-available door heights and panel numbers in the construction industry.
8. One having ordinary skill in the art would understand the disclosure in Dykes to mean that overhead doors having four, five or six panels are commercially available in the industry, but it is also possible to construct doors with other numbers of panels, including one or more panels.
9. One having ordinary skill in the art would not infer from the disclosure that three panel doors are not available because they would not work or that it is impossible to construct standard seven foot high garage doors having three panels.
10. At most, Dykes’ omission of a specific reference to three panel doors would be construed by one having ordinary skill in the art to mean that doors having three panel sections were not “standard” in the construction industry.
11. One having ordinary skill in the art would understand Dykes to suggest that it is possible to construct standard seven foot high garage doors with any number of panels desired, including three panels.

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12. Geoffrey illustrates in Figure 2 “a portion of the door of FIG. 1” which “includes at least three panel sections 24, 26 and 28” (Geoffrey, col. 4, ll. 6-7 and col. 5, ll. 33-35; Fig. 2).
13. Figure 1 of Geoffrey shows a door having four panel sections (Geoffrey, Fig. 1).
14. Further, the uppermost panel section 24 and the lowermost panel section 28 of Figure 2 are shown with indefinite borders indicating that additional panel sections are positioned above or below the panel sections 24 and 28, respectively (Geoffrey, Fig. 2).
15. Thus, Geoffrey does not disclose a three panel section garage door.

PRINCIPLES OF LAW

Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these

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questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

Secondary Considerations

To be given substantial weight in the determination of obviousness or non-obviousness, evidence of secondary considerations must be relevant to the subject matter as claimed, and therefore the examiner must determine whether there is a nexus between the merits of the claimed invention and the evidence of secondary considerations. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 305 n.42 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986). In particular, an applicant asserting secondary considerations to support its contention of non-obviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of secondary considerations. For example, in the case of evidence of commercial success, the Federal Circuit has acknowledged that the applicant bears the burden of establishing a nexus, stating:

In the *ex parte* process of examining a patent application, however, the PTO lacks the means or resources to gather evidence which supports or refutes the applicant’s assertion that the sale constitutes commercial success. *C.f. Ex parte Remark*, 15 USPQ2d 1498, 1503 (Bd. Pat. App. & Int. 1990)(evidentiary routine of shifting burdens in civil proceedings inappropriate in *ex parte* prosecution proceedings because examiner has no available means for adducing evidence). Consequently, the PTO must rely upon the applicant to provide hard evidence of commercial success.

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In re Huang, 100 F.3d 135, 139-40 (Fed. Cir. 1996). *See also In re GPAC*, 57 F.3d 1573, 1580 (Fed. Cir. 1995); *In re Paulsen*, 30 F.3d 1475, 1482 (Fed. Cir. 1994) (Evidence of commercial success of articles not covered by the claims subject to the obviousness rejection was not probative of non-obviousness).

Objective evidence of non-obviousness, including commercial success, must be commensurate in scope with the claims. *In re Tiffin*, 448 F.2d 791 (CCPA 1971) (evidence showing commercial success of thermoplastic foam “cups” used in vending machines was not commensurate in scope with claims directed to thermoplastic foam “containers” broadly). In order to be commensurate in scope with the claims, the commercial success must be due to claimed features, and not due to unclaimed features. *Joy Technologies Inc. v. Manbeck*, 751 F. Supp. 225, 229 (D.D.C. 1990), *aff’d*, 959 F.2d 226, 228 (Fed. Cir. 1992) (Features responsible for commercial success were recited only in allowed dependent claims, and therefore the evidence of commercial success was not commensurate in scope with the broad claims at issue.). An inventor’s opinion as to the purchaser’s reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention. *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996). Further, gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1026-27 (Fed. Cir. 1985), or as to the time period during which the product was sold, or as to what sales

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would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454, 1458 (BPAI 1988).

ANALYSIS

The Appellant states that “[t]he limitation as to the finished height of a panel, as recited in the original claims, was and remains the critical limitation” in the claims (App. Br. 4). Independent claim 1 recites “a sheet metal layer having a finished height of substantially twenty-eight inches.” The Appellant does not present arguments for the separate patentability of claims 1, 6, 7, 12, 13, and 15. Instead, the Appellant’s arguments are directed generally to “the claimed invention” (App. Br., *passim*; Reply Br., *passim*). Thus, we select claim 1 as the representative claim, and claims 6, 7, 12, 13, and 15 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

We now examine each of the *Graham* factors as they apply to claim 1.
Scope and Content of the Prior Art

The Examiner found that Martin discloses an overhead garage door having a section assembly including a sheet metal layer and end support members coupled to first and second lateral edges of the sheet metal layer (Ans. 3; Fact 1). The Appellant did not contest the Examiner’s findings as to the scope and content of Martin.

Dykes relates to a panel cover system for resurfacing *existing* overhead garage doors (Fact 3). Dykes describes that overhead door heights of seven feet are fairly common (Fact 4). Dykes discloses a door having

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four panels and further describes that commercially-available overhead doors in the construction industry include doors with panels having four, five, and six panels (Facts 5-7). Dykes further teaches that overhead doors “could be manufactured with other numbers of panels” including a door comprising a single panel (Fact 7). One having ordinary skill in the art would understand this disclosure in Dykes to mean that overhead doors having four, five or six panels are commercially-available in the industry, but it is also possible to construct doors with other numbers of panels, including one or more panels (Fact 8). One having ordinary skill in the art would not infer from this disclosure that three panel doors are not available because they would not work or that it is impossible to construct standard seven foot high garage doors having three panels (Fact 9). At most, Dykes’ omission of a specific reference to three panel doors would be construed to mean that they were not “standard” in the construction industry (Fact 10). Thus, one having ordinary skill in the art would understand Dykes to suggest that it is possible to construct standard seven foot high garage doors with any number of panels desired, including three panels (Fact 11).

The disclosure illustrated in Figure 2 of Geoffrey shows a portion of a four panel overhead garage door (Facts 12-14).

Differences between the Prior Art and the Claimed Invention

Martin does not disclose that the finished height of the sheet metal layer is substantially twenty-eight inches (Fact 2). Further, we disagree with the Examiner’s reading of Geoffrey and find that Geoffrey does not disclose a three panel section garage door (Fact 15). Although Dykes does not state

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that three panel section garage doors were commercially-available at the time of the invention, Dykes does suggest that it was possible to construct a standard seven foot high garage door with any number of panels desired, including three panels (Facts 8-11).

Level of Ordinary Skill in the Art

Neither the Examiner nor the Appellant has addressed the level of ordinary skill in the pertinent art.¹ “The person of ordinary skill in the art is a hypothetical person who is presumed to know the relevant prior art.” *In re GPAC*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (citing *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986)). We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Prima Facie Case of Obviousness

In view of the findings of fact above, we review the Examiner’s rejection of the claims under 35 U.S.C. § 103(a) as unpatentable over Martin and Dykes or Geoffrey.

¹ The Appellant characterizes the six Declarants as “having more than ordinary skill in the art” (Reply Br. 11). The Appellant does not, however, proffer a level of skill for one having ordinary skill in this art.

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As a preliminary matter, we find that Dykes substantiates the Examiner's taking of Official Notice that the specific height selected for the panel sections is a mere matter of design preference. The Appellant's argument that the Examiner erred in relying on official notice for a critical limitation is moot in view of our finding that Dykes substantiates the Official Notice.

Martin discloses all of the limitations of the door section of claim 1 except for the specified finished height of the sheet metal layer (Facts 1 & 2). Dykes teaches that standard seven foot high overhead garage doors can be made having any number of desired panels, including three panel sections (Facts 4-11). A seven foot high door made of three panel sections of equal height would result in each door section having a finished height of substantially twenty-eight inches. As such, we agree with the Examiner's determination that the claimed finished height of the door section is a matter of design choice and that the claimed finished height of twenty-eight inches would be a predictable result were one having ordinary skill in the art to modify a commercially-available, standard seven foot high, four panel section door to have three panel sections. In other words, the claimed finished door section height is no more than the result of the substitution of one element (three twenty-eight inch door panel sections) for another known in the field (four twenty-one inch door panel sections) to yield a predictable result (a door section with a finished height of substantially twenty-eight inches). *See KSR*, 127 S. Ct. at 1740 (“[W]hen a patent claims a structure already known in the prior art that is altered by the mere substitution of one

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element for another known in the field, the combination must do more than yield a predictable result.”).

We further find that market pressure existed in the garage door industry to create a new design trend by updating the look of garage doors to spur additional sales in the industry. In particular, the declarations submitted by the Appellant acknowledged that “[t]he appearance of a garage door is a matter of great concern to the customer. Architects, design specifiers, builders, and homeowners desire a garage door that looks different from the traditional garage doors that are currently being manufactured” (Declaration Under 37 C.F.R. § 1.132 of William C. Mohler, dated April 6, 2004 (“Mohler Decl.”), ¶5; Declaration Under 37 C.F.R. § 1.132 of Steven J. Folk, dated April 26, 2004 (“Folk Decl.”), ¶5; Declaration Under 37 C.F.R. § 1.132 of Gregory David Schults, dated March 31, 2004 (“Schults Decl.”), ¶5; Declaration Under 37 C.F.R. § 1.132 of Michael R. Matuszek, dated April 3, 2004 (“Matuszek Decl.”), ¶5; and Declaration Under 37 C.F.R. § 1.132 of James C. Clem, dated March 22, 2004 (“Clem Decl.”), ¶5). The Appellant himself acknowledged:

A garage door is a highly visible feature of a home. In many cases, the garage door comprises more than 60% of the homes [*sic*] front elevation. As such, its appearance is a matter of great concern for architects, developers, home designers, city planners, builders, and ultimately, the end user, for the entire life of the garage door. As steel overhead doors have flooded the industry, the need has arisen for a deviation from existing garage door designs. In other words, a garage door that

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looks different from the traditional raised panel steel garage doors that are currently inundating the market.

(Declaration Under 37 C.F.R. § 1.132 of John F. Jellá, dated April 5, 2004 (“First Jellá Decl.”), ¶5).

The Court in *KSR* noted that “[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* Changing a conventional seven foot high overhead garage door from a four panel section door to a three panel section door is nothing more than a predictable variation sparked by design incentives in the hope that a new look to the door would result in increased sales. In our minds, this is an example of market demand driving a design trend, and the Supreme Court in *KSR* warned against granting patent protection to advances such as this that would occur in the ordinary course without real innovation:

In many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends. Granting patent protection to advances that would occur in the ordinary course without real innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility.

KSR, 127 S. Ct. at 1741. The Supreme Court further noted:

When there is a design need or market pressure to solve a problem and there are a finite number of

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identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.

Id. at 1742. In this case, Dykes outlines a finite number of predictable solutions because it provides that doors having four, five, or six panels are conventional in the industry, and it provides that doors can be made with any other number of panels, including a single panel. Encompassed within a finite number of identified, predictable solutions in Dykes is to make a door with two or three panels, and the Appellant has not sufficiently shown that it was outside the technical grasp of a person of ordinary skill to pursue these options. Thus, the claimed door section with a twenty-eight inch finished height is not the product of innovation but of ordinary skill and common sense. As such, the Examiner has shown a prima facie case of obviousness of the claimed door section having a finished height of substantially twenty-eight inches in view of the prior art.

The Appellant argues that when viewing the references in combination “it would be obvious to *not try* to [make a three-panel seven-foot door]” (App. Br. 10). An “obvious to not try” argument is the same as an argument that one or more of the references teach away from the claimed invention. The Appellant argued that Dykes teaches away from making a three panel section garage door by virtue of its explicit omission of three panel sections from its listing of commercially-available panel section doors (App. Br. 7). Whether a reference teaches away from a claimed invention is

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a question of fact. *In re Harris*, 409 F.3d 1339, 1341 (Fed. Cir. 2005). “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, . . . would be led in a direction divergent from the path that was taken by the applicant.” *In re Haruna*, 249 F.3d 1327, 1335 (Fed. Cir. 2001) (quoting *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999)). We disagree with the Appellant’s reading of Dykes for the reasons provided *supra* (Facts 6-11). As such, we are not persuaded by the Appellant’s argument that it would be obvious to not try to make a three-panel seven-foot door.

Inasmuch as we have concluded that the subject matter of Appellant’s claims 1, 6, 7, 12, 13, and 15 is *prima facie* obvious, and because Appellant has furnished evidence in rebuttal of obviousness, we now turn to consider this evidence. When such evidence is presented, it is our duty to consider all evidence anew. *See, e.g., In re Eli Lilly and Co.*, 902 F.2d 943 (Fed. Cir. 1990). We are also mindful that objective evidence of non-obviousness in any given case may be entitled to more or less weight depending on its nature and its relationship with the merits of the invention. *See Stratoflex Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983).

Secondary Considerations

We recognize that evidence of secondary considerations, such as that presented by the Appellant, must be considered in route to a determination of obviousness/non-obviousness under 35 U.S.C. § 103. Accordingly, we consider anew the issue of obviousness under 35 U.S.C. § 103, carefully

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evaluating and weighing both the evidence relied upon by the Examiner and the objective evidence of non-obviousness provided by the Appellant.

The Appellant submitted declarations from those in the garage door industry who attested that they were skeptical that a steel garage door product with a twenty-eight inch section height would work satisfactorily because the size of the sections would be too big to move smoothly on the door tracks, and that they were surprised at how smoothly the door moved on the tracks when it was demonstrated to them (Mohler Decl. ¶¶8, 9; Folk Decl. ¶¶8, 9; Schults Decl. ¶¶8, 9; Matuszek Decl. ¶¶8, 9; and Clem Decl. ¶¶8, 9).

We must first examine whether the Appellant met its burden of establishing a nexus between the claimed invention and the evidence of secondary considerations. *In re Huang*, 100 F.3d at 139-40. The evidence of skepticism of others provided by the Appellant has no connection to the claimed invention. In particular, in each case the declarants' skepticism was based on "concerns that the size of the sections would be too great to move smoothly on the door tracks." As explained by the Appellant in the Appeal Brief, this skepticism was based on the belief in the industry that a twenty-eight inch panel section would not move smoothly as it travels through the radius of a *conventional door track* (App. Br. 20). The Appellant's first declaration further explains that "sectional overhead garage doors are typically engineered to operate in tracks that incorporate ten, twelve, and fifteen inch radius tracks" and that "conventional wisdom in the overhead garage door industry has dictated the use of smaller sections, i.e. twenty-one

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inches or less, with larger radius tracks when attempting to arrive at the best working solution for a garage door” (First Jellá Decl. ¶6). As such, the Appellant’s asserted discovery is based on a correlation between the radius of the tracks and the height of the panels such that “[t]he operational performance of a twenty eight inch steel raised panel door section for instance, is not adversely affected as it travels through the radius of a fifteen inch conventional door track” (App. Br. 20, First Jellá Decl. ¶7). Claim 1, however, is directed only to a door section and does not recite tracks of a specific radius or even recite tracks at all.² Thus, the evidence presented by the Appellant as to skepticism of others is not commensurate in scope with the claims. The declarants were not stating that they were skeptical that twenty-eight inch panel sections would work on any type of garage door, rather they were stating their skepticism as to whether the claimed door panel height would work for a door with conventional fifteen inch radius tracks. The claims do not, however, recite the twenty-eight inch panel door sections in combination with a specific radius track.

Each of the declarants further states that response to the raised panel garage door with three twenty-eight inch door sections has been “enthusiastic” with comments touting “how uniquely different the door looks from other garage doors” (Mohler Decl. ¶10; Folk Decl. ¶11; Schults Decl. ¶11; Matuszek Decl. ¶11; Clem Decl. ¶11). Evidence of commercial success for a claimed invention of a utility patent application cannot be shown, however, by industry reaction to the aesthetic appearance of the

² In fact, none of the claims on appeal recites tracks.

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claimed invention. Such evidence is too subjective to serve as reliable objective evidence of secondary considerations of non-obviousness. Further, the ornamental appearance of a product is the purview of the design patent law. Were we to allow secondary considerations of non-obviousness to be based on the industry's reaction to the ornamental appearance of the claimed invention, we would be blurring the distinction between design and utility patent protection. Objective evidence of secondary considerations of non-obviousness should be tied to the functional aspects of the claimed invention for a utility patent application. *See Cable Elec. Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1027 (Fed. Cir. 1985) (“[F]or commercial success of a product embodying a claimed invention to have true relevance to the issue of non-obviousness, that success must be shown to have in some way been due to the nature of the claimed invention, as opposed to other economic and commercial factors unrelated to the technical quality of the patented subject matter”) (citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983)).

The Appellant's own declaration further states that “the substantially twenty-eight inch finished height of the door section also achieves desired and unexpected results of enhanced aesthetic appearance, simpler and more cost effective installation, and improved resistance to moisture” (First Jellá Decl. ¶9). For the reasons provided above, we hold that unexpected results for the claimed invention of a utility patent application cannot be based on enhanced aesthetic appearance, which is a subjective factor and one more properly reserved for the confines of design patent protection.

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With respect to the other purported unexpected results, although the declaration goes on to explain why the installation is more cost effective than traditional doors and why the three twenty-eight inch panels door construction provides improved resistance to moisture, the declaration fails to sufficiently show that these results were at all unexpected. On the contrary, it seems to flow naturally that a door made of fewer parts would be less costly to manufacture and would provide fewer joints through which moisture could enter. Further, the unexpected results, which are based on a garage door having three twenty-eight inch panel sections, are not commensurate in scope with claim 1, which recites only a single door section having a finished height of twenty-eight inches and not a garage door having three such panel sections.

The Appellant also attests to the fact that he “*discovered* that a three panel, 28-inch section travels through standard radius tracks *in a different manner*, and surprisingly, does so smoothly” (App. Br. 20, citing First Jellá Decl. ¶7). The Appellant contends that “[t]his declaration clearly indicates surprising and unexpected results in the operation, and significant and objectively quantified improvement in production capabilities and reduced labor costs in a mature industry” (App. Br. 22). We find this evidence equally unpersuasive of unexpected results because the evidence lacks the necessary nexus to the claimed invention. The claims do not recite three twenty-eight inch panel door sections in combination with standard radius tracks.

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Some of the declarants also offered evidence of actual sales of steel raised panel and/or steel carriage garage doors with three twenty-eight inch door sections and estimates as to future sales (Folk Decl., ¶10³, Schults Decl., ¶10⁴, Matuszek Decl., ¶10⁵, and Clem Decl., ¶10⁶). Again, the evidence is not commensurate with the claimed invention. Claim 1 does not recite a steel garage door with three twenty-eight inch door sections. Rather, claim 1 recites a single door section with a finished height of substantially twenty-eight inches. Even if we were to find a sufficient nexus between this evidence of commercial success and the claimed invention, the third-party declarants have failed to provide persuasive evidence as to market share so as to put the evidence of gross sales figures into perspective in the context of the particular market at hand.

The Appellant himself also purported to show evidence of commercial success. In a first declaration, the Appellant attested that “since our first offers for sale of the three section raised panel garage door in July 2001,

³ Mr. Folk attests that sales by his company for the first two years have reached approximately \$120,000 annually with an estimate that sales could ultimately reach levels of \$600,000 per year.

⁴ Mr. Schults attests that sales by his companies for the first two years have reached approximately ten units per month with an estimate that sales could ultimately reach levels of two to three hundred units per year.

⁵ Mr. Matuszek attests that sales by his company for the first twenty months have reached approximately 75 units with an estimate that sales could ultimately reach levels of 250 per year.

⁶ Mr. Clem, who is the National Sales Manager for First United Door Technologies, L.L.C., the real party-in-interest, attests that sales by his company for the first two years have reached approximately \$2,000,000 with an estimate that sales could ultimately reach levels of \$50 Million per year.

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over four thousand doors have been sold” (First Jellá Decl. ¶11). The Appellant further stated that “[s]ales of the product are growing at a rate of more than 25% annually” (First Jellá Decl. ¶11). The Appellant attested that “[i]n Southern California for instance, eighteen of the top twenty builders will be using the products on one or more of their new home subdivisions” (First Jellá Decl. ¶11).

The Appellant submitted a second declaration which purported to show “significant increased margin of sale for the 28-inch panel door while showing static or declining sales of other doors sold by Applicant’s company” (App. Br. 22, citing Declaration Under 37 C.F.R. § 1.132 of John F. Jellá dated January 4, 2005 (“Second Jellá Decl.”)). This second declaration included a chart which compares sales of Appellant’s three panel section door to sales of Appellant’s other overhead garage doors having four or more panels section (Second Jellá Decl. ¶12).

The Appellant's evidence of gross sales as an indication of commercial success is weak, at best. The Appellant’s proof of unit sales does not indicate whether the numbers sold were a substantial quantity in the relevant market. *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996) (without evidence that the sales are a substantial quantity in the relevant market, “bare sales numbers” are a “weak showing” of commercial success, if any); *In re Baxter Travenol Labs.*, 952 F.2d 388, 392 (Fed. Cir. 1991) (“[I]nformation solely on numbers of units sold is insufficient to establish commercial success.”); *Kansas Jack, Inc. v. Kuhn*, 719 F.2d 1144, 1150-51 (Fed. Cir. 1983) (“The evidence of commercial success consisted solely of the number

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of units sold. There was no evidence of market share, of growth in market share, of replacing earlier units sold by others or of dollar amounts, and no evidence of a nexus between sales and the merits of the invention. Under such circumstances, consideration of the totality of the evidence, including that relating to commercial success, does not require a holding that the invention would have been nonobvious at the time it was made to one skilled in the art.”); *Sjolund v. Musland*, 847 F.2d 1573, 1582 (Fed. Cir. 1988) (“Nor could the jury, from the bare evidence of units sold and gross receipts, draw the inference that the popularity of the [sold units] was due to the merits of the invention.”) (citing *Cable Elec. Prods. v. Genmark, Inc.*, 770 F.2d 1015, 1026-27 (Fed. Cir. 1985) and *Kansas Jack, Inc.*, 719 F.2d at 1150-51).

The Appellant attempts to bolster his prior evidence of commercial success by providing a third declaration containing evidence of market share from sales of doors having twenty-eight inch panel sections (Declaration Under 37 C.F.R. § 1.132 of John F. Jellá dated July 7, 2005) (“Third Jellá Decl.”), ¶¶10, 11). The evidence purports to show that sales of doors comprising twenty-eight inch panel sections total \$20M as compared to overall sales in the North American Garage Door Market of roughly \$1.6B. This represents a market share of approximately 1.24%.

We note that FUDT’s market share for the steel carriage house market as compared with the remainder of the garage door industry is only 0.175%. The Appellant contends that the other sales of steel carriage house doors with twenty-eight inch panel sections in the market are due to “copyists”

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(Reply Br. 14). The Appellant states that he has “gained information from sources within the equipment community that a competitor to FUDT has now invested \$9,000,000.00 (\$6M for equipment and \$3M for building facility) for the manufacture of steel garage doors having 28” panels” and that “[b]ecause of the commercial success of the FUDT doors, competitors are attempting to duplicate FUDT’s efforts, regardless of the cost” (Third Jellá Decl. ¶9). The Appellant has proffered hearsay evidence of possible copying in the industry that we find to be of questionable reliability and not probative objective evidence of non-obviousness.⁷

Regardless of whether we consider 1.24% or 0.175% to be the relevant market share figure, either market share is sufficiently small compared to the entire garage door market that they fail to reasonably demonstrate commercial success of the claimed invention.

The Appellant attempts to more narrowly define the relevant market to encompass only steel carriage house garage doors so as to inflate the share of the market held by FUDT. We fail to see why the market should be defined so narrowly. FUDT’s sales of doors having twenty-eight inch door panel sections are not limited to steel carriage house garage door but also

⁷ Upon filing of the present application, the Appellant filed a Declaration Under 37 C.F.R. § 1.102(d) in support of a Petition to Make Special in which the Appellant states that there is an infringing device on the market. This declaration, however, fails to provide any further description of the specifics of the infringing device and provides only that in the Appellant’s opinion, at least some of the claims in the application as filed would be infringed by the manufacture, use or sale of the infringing device. Without more, we find that this evidence is insufficient to establish non-obviousness.

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include steel raised panel garage doors having three twenty-eight inch panel sections (Folk Decl. ¶10, Schults Decl. ¶10, Matuszek Decl. ¶10, and Clem Decl. ¶10). The Appellant, however, has not provided us with any sales information for steel raised panel garage doors that demonstrates the market share of such doors having three twenty-eight inch panel sections. Further, the relevant market is not limited to steel carriage house doors, because the claims are not limited to such carriage house doors. Rather, the claims cover any steel door section, whether raised panel, carriage house, or other door section. Since the Appellant has not provided us with the total market figures for all steel garage door sales, and further has not provided us with the total sales of steel garage doors having a twenty-eight inch panel section, we cannot determine the market share of the claimed invention in this relevant market.

The Appellant asserts that “FUDT has captured a huge segment of the market of 28” panel steel garage doors” (Third Jellá Decl. ¶11). Assuming that to be the case, this statement begs the question that if there were other garage doors on the market also comprising twenty-eight inch panel sections, what was it about FUDT’s doors that made them a success and where is the nexus between this success and the claimed invention? Could FUDT’s relatively high market share for the same door as offered by others in the market be due to other factors unrelated to the claimed invention, such as a better distribution network or a better sales force or industry reputation? It is not apparent from the evidence presented what reason should be attributed to FUDT’s market share for steel carriage house garage doors

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having three twenty-eight inch panel sections when compared to other companies selling the same door. Further, since both FUDT and these other companies in the market are all selling doors that fall within the scope of claim 1, it seems to us that a comparison of FUDT's market share to other companies is not the relevant inquiry. Rather, the relevant inquiry is to compare the market share of steel garage doors having twenty-eight inch panel sections to the overall market for steel garage doors.

If we were to treat the entire North American Garage Door Market as the relevant market segment, then, as set forth *supra*, garage doors having twenty-eight inch panel sections comprise an insignificant portion of this garage door market. Under this analysis, we find the Appellant's evidence of commercial success to be weak, and Appellant's showing of market share in the relevant market to demonstrate that Appellant's claimed invention does not hold a significant share of the garage door market.

The Appellant's third declaration also purported to show that "these 28-inch panel doors are 'deceivingly difficult to make'" (App. Br. 23, quoting Third Jellá Decl.). The declaration fails, however, to provide any explanation as to why three section doors were so difficult to manufacture. If the Appellant's invention lies in his discovery of the correlation between the twenty-eight inch height of the door sections and the conventional fifteen inch radius track, then it is not evident why such a door would be costly to develop. Without further explanation, this evidence is insufficient to show non-obviousness.

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The Appellant also asserts that the declarations submitted show a long-felt and growing need that the claimed twenty-eight inch panel filled (Reply Br. 8, 11). The declarations, however, fail to sufficiently evidence a long-felt need in the industry. Establishing long-felt need requires objective evidence that an art-recognized problem existed in the art for a long period of time without solution. 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 declarations submitted by the Appellant do not show that the need for a different looking door was a persistent one or that others tried to meet the need and failed. While the need for a new look to garage doors may have been a market pressure that existed at the time of the invention, the declarants fail to state how long the need existed in the industry and whether any attempts to meet the need were made by others in the industry. “[L]ong-felt need is analyzed as of the date of an articulated identified problem and evidence of efforts to solve that problem.” *Texas Instruments, Inc. v. ITC*, 988 F.2d 1165, 1178 (Fed. Cir. 1993). As such, we find that the Appellant has failed to set forth sufficient evidence to establish a long-felt need in the industry.

Obviousness Determination

Having now considered all the evidence presented by Appellant against obviousness and weighing all the evidence anew, it is our conclusion that the evidence for obviousness outweighs the evidence against obviousness. *See In re Fenton*, 451 F.2d 640, 643 (CCPA 1971) (the court balanced the Patent Office’s case against the strength of appellant’s objective

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evidence of non-obviousness.) Based on our review and consideration of all of the evidence before us, we conclude that the subject matter of claim 1 would have been obvious to one having ordinary skill in the art at the time the invention was made in view of the prior art. The Appellant fails to present separate arguments for patentability of claims 6, 7, 12, 13, and 15. Thus, these claims fall with claim 1. As such, we sustain the Examiner's rejection of claims 1, 6, 7, 12, 13, and 15 under 35 U.S.C. § 103(a) as unpatentable over Martin in view of Dykes and/or Geoffrey.

CONCLUSION

We conclude the Appellant has failed to show the Examiner erred in rejecting claims 1, 6, 7, 12, 13, and 15 under 35 U.S.C. § 103(a) as unpatentable over Martin in view of Dykes and/or Geoffrey.

DECISION

The decision of the Examiner to reject claims 1, 6, 7, 12, 13, and 15 is affirmed.

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) (2007).

AFFIRMED

vsh

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