

Keywords: obviousness; secondary considerations; commercial success; unexpected results

General: The Board of Patent Appeals and Interferences holds that, in order to rely on secondary considerations in support of the non-obviousness of a claim, there must be a clear nexus between the evidence presented and the invention as claimed.

Ex Parte Jellá

90 U.S.P.Q.2d 1009 (B.P.A.I. 2008) (precedential)

Decided November 3, 2008

I. Facts

This case is reviewed under 25 U.S.C. §136 by the Board of Patent Appeals and Interferences. Claims 1, 6, 7, 12, 13 and 15 stand rejected under 35 U.S.C. §103(a). The Appellant's claimed invention relates to raised panel door sections for overhead garage doors. Specifically, Claim 1 generally recites a door section for an overhead garage with a sheet metal layer having a finished height of substantially 28 inches and support members coupled to the lateral edges of the sheet layer.

In rejecting claims 1, 6, 7, 12, 13 and 15, the Examiner relied on the Martin reference in view of the Dykes reference and/or Geoffrey reference. Martin discloses an overhead garage door with a section assembly including a sheet metal layer, and end support members couple to the lateral edges of the sheet metal layer. However, Martin does not disclose a sheet metal layer with a finished height of substantially 28 inches. Dykes relates to a panel cover system for resurfacing existing overhead garages and indicates that overhead door heights of seven feet are common. Dykes also discloses that overhead doors are commercially available with four, five and six panels, but could be manufactured with other numbers of panels, including single panels. Geoffrey includes a figure that illustrates a portion of a door that contains at least 3 panel sections. However, the uppermost and lowermost panel sections in this figure indicate that additional panel sections are positioned above or below the shown panel sections. Thus, Geoffrey does not disclose a three panel garage door.

On appeal, the Appellant offered several declarations containing objective evidence of non-obviousness. These documents include evidence of unexpected results, commercial success and long felt need in the art.

Several declarations submitted by the Appellant contained statements of those in the garage door industry who were skeptical of the claimed design's ability to operate on conventional door tracks. Specifically, these declarations stated that the 28 inch door panels were too large to smoothly travel through the radius of a conventional door track. However, declarations were also submitted by the Appellant with statements of those in the industry who believed that the claimed panel design looked uniquely different compared to other garage doors.

The Appellant also submitted evidence of unexpected results for the claimed invention. Specifically, the Appellant submitted his own declaration stating that 28 inch door section achieved unexpected results of enhanced aesthetic appearance, more cost effective installation and improved resistance to moisture.

Evidence of sales of steel garage doors with three 28 inch panels was also submitted in several declarations. More particularly, evidence of gross sales of such garage doors was presented.

Lastly, the Appellant submitted declarations asserting a long felt and growing need in the garage door industry for a garage door design that the three 28 inch panel design satisfied.

II. Issue

Is the subject matter claimed by the Appellant obvious in view of the prior art despite the Appellant's introduction of evidence suggesting non-obviousness?

III. Discussion

Yes. The question of obviousness is resolved on the basis of underlying factual determinations including 1) the scope and content of the prior art, 2) differences between the claimed subject matter and the prior art, 3) the level of ordinary skill in the art and 4) any secondary considerations or objective indicia of non-obviousness.

The relevant prior art includes the Martin, Dykes and Geoffrey references. As mentioned above, Martin discloses an overhead garage door and contains all the limitations of claim 1 of the Jellá application except for the height limitation. Dykes indicates that garage doors with heights of seven feet are common and are commercially available with four, five or six panel configurations. However, Dykes does suggest that the construction of a seven foot high garage door with three panels is possible but probably not standard. Lastly, Geoffrey discloses a four panel garage door but not a three panel garage door.

The level of skill in the art was not addressed by the Examiner or the Appellant. Therefore, the cited prior art is assumed to be representative of the level of ordinary skill in the art.

At this point, the Board agreed with the Examiner that a prima facie case of obviousness had been made. The Examiner determined, and the Board agreed, that the finished height of the door section claimed by the Appellant is a matter of design choice. This determination was substantiated by Dykes, which disclosed that garage doors can be made with any number of panels. Furthermore, the Board determined that the door section claimed by the Appellant was a predictable result stemming from the substitution of one element for another element known in the field. Specifically, the claimed design substitutes the three 28 inch door panel section suggested in Dykes for the four 21 inch door panel sections disclosed in Martin. The Board further found that the door section claimed by the Appellant was a predictable variation resulting from market pressure to create a new design trend to update the appearance of garage doors. Because the Appellant had not shown that it was outside the grasp of a person of ordinary skill to develop such a door, the Board determined that a door section with a 28 inch finished height was the product of ordinary skill and common sense rather than innovation.

The Board then turned to consider anew the evidence furnished by the Appellant in rebuttal of obviousness. Additionally, the Board noted that such evidence of secondary considerations may be entitled to more or less weight depending on its nature and its relationship with the merits of the claimed subject matter. Also, it is important to note that the Appellant has the burden of establishing a nexus between the evidence of secondary considerations and the claimed invention.

With respect to the declarations stating that those in the garage door field were skeptical that the claimed design would not work, the Board ruled that the evidence was not within the scope of the claims. Specifically, the declarations spoke to the relationship between the panels and the door tracks, whereas the claim does not recite a 28 inch panel with a conventional radius track.

The Board held that the declarations asserting that the claimed panel design was uniquely different from any other panel design was not sufficient to demonstrate commercial success. Such evidence of aesthetic appearance is too subjective. Rather, the Board stated that objective evidence that is tied to the functional aspects of the claims would be more persuasive. Moreover, commercial success must be tied to the nature of the claimed invention.

Additionally, the Board was not persuaded by the Appellant's evidence of unexpected results. The Appellants' declarations did not contain sufficient support to show that the results were

unexpected. To the contrary, the Board held that the results submitted by the Appellant were actually intuitive and reasonably expected (i.e., it is logical that a door made of fewer parts would cost less to manufacture and a door with fewer hinges would be more resistant to moisture). Moreover, the unexpected results were not commensurate with the scope of the claims. The unexpected results concerned a garage door with three panel sections, where as claim 1 recites a single door panel section.

Furthermore, the Board found the evidence of sales to be an insufficient showing of non-obviousness as well. The evidence submitted by the Appellant was merely gross sales numbers. The Board stated that more was necessary, such as evidence of market share or growth in market share. In response, the Appellant attempted to provide a narrow market definition by including only steel carriage house doors to inflate the Appellant's market share. However, the Board held that, because the claims were not limited to steel carriage house doors, the relevant comparison for determining the Appellant's market share was between the market for garage doors with 28 inch steel panels and the overall market for steel garage doors. Using this comparison, the Appellant's market share was a mere 1.24% and not enough to demonstrate the level of commercial success that would tend to show non-obviousness.

Lastly, the Appellant's assertion of long felt need in the art was almost entirely unsubstantiated. The Board stated that establishing long felt need requires objective evidence of an art-recognized problem that has existed for a long period of time without a solution. Additionally, the evidence may show that attempts to solve the problem were made by others in the industry. The Appellant failed to state how long the need existed and whether any attempts to meet this need were made. Consequently, the Board found that the Appellant did not establish a long felt need in the art.

IV. Conclusion

The Board upheld the Examiner's rejections of claims 1, 6, 7, 12, 13 and 15 under 35 U.S.C. §103(a) as obvious over Martin in view of Dykes and/or Geoffrey. The Appellant was unable to rebut the Examiner's prima facie case of obviousness with objective evidence primarily because the evidence provided by the Appellant was not commensurate with the scope of the Appellant's claims.