The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MACK (NMI) ROSE

Appeal No. 2004-1046
Application No. 09/354,203

ON BRIEF

Before PAK, DELMENDO, and JEFFREY T. SMITH, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 (2003) from the examiner's rejection of claims 1 through 3 and 7 through 9 in the above-identified application. (Non-final Office action mailed Mar. 23, 2001, paper 12.) Claims 4 through 6 and 10, the only other pending claims, have been allowed. (Id.)

The subject matter on appeal relates to a "drywall bench

[on which a step is attached] so as to provide an intermediate platform that one may utilize to reach the top platform provided by the bench." (Specification, page 1, lines 4-7.) According to the appellant, "[t]he step of the present invention also provides a safety feature that substantially lessens the likelihood that the drywall bench will collapse when supporting a load." (Id. at page 1, lines 7-9.) Further details of this appealed subject matter are recited below in representative claim 7, which is drafted in Jepson format:

> 7. In a drywall bench having a bench platform, folding legs pivotally connected to the bench platform, support rails connected between the folding legs and including brackets having rollers rotatably received thereon, step rails receiving the rollers and thereby connecting between the support rails such that the folding legs connected to the support rails may be pivoted between operative and storage positions, the rollers being capable of moving within a track provided by the step rails such that the associated support rails and folding legs remain connected as the folding legs are pivoted, locking braces connected between the bench platform and the support rails to selectively lock the folding legs into the operative position, and telescoping legs selectively received by the folding legs, the improvement comprising:
>
> a support member selectively received by at least a portion of one of the step rails; a spacer member extending downwardly from said support member; and a step member extending from said spacer member such that said step member lies substantially parallel to the bench platform.[1]

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[1] Because the claim is drafted in Jepson format, the preamble recitations are "impliedly admitted to be old in the art." Cf. In re Ehrreich, 590 F.2d 902, 909-10, 200 USPQ 504,

In addition to the appellant's admitted prior art (Figure 1; specification, page 1, line 12 to page 3, line 27), the examiner relies on the following prior art references as evidence of unpatentability:

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| Valentino | 4,222,136 | Sep. 16, 1980 |
| Hays | 4,782,916 | Nov. 08, 1988 |
| Acea (published FR application)[2] | FR 2,407,330 | May 25, 1979 |

Claims 1 through 3 and 7 through 9 on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of the admitted prior art (Figure 1) and Acea, Valentino, or Hays. (Examiner's answer mailed Jun. 14, 2002, paper 18, pages 2-3.)

We affirm.[3] Because we are in complete agreement with the examiner's analysis, we incorporate the reasons set forth in the answer as our own and add the following comments for emphasis.

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510 (CCPA 1979); see also 37 CFR § 1.75(e) (2003)(effective Jan. 31, 1978).

[2] We attach to this decision an English language translation of this reference, which the examiner obtained but did not formally introduce into the record.

[3] The appellant states that although the claims vary in scope, "for purposes of expediency, they will be treated [i.e., argued] together." (Appeal brief filed Nov. 23, 2004, paper 23, p. 5.) We therefore select claim 7 from the group of rejected

The appellant does not dispute the examiner's determination that there is some motivation, suggestion, or teaching in the applied prior art that would have led one of ordinary skill in the art to combine the admitted prior art with Acea, Valentino, or Hays, thus arriving at a drywall bench encompassed by appealed claim 7. Rather, the appellant argues that "[i]f the present invention were obvious, [] it would already be in use in the industry inasmuch as there is no practical reason, such as cost or difficulty of manufacture that would explain its absence" and that "the claimed combination is not obvious inasmuch as there has been a long felt need in the art for Applicant's invention, and, further, Applicant has enjoyed outstanding commercial success with his invention." (Appeal brief filed Nov. 24, 2003, page 9; reply brief filed Aug. 19, 2002, paper 19, page 2.)[4]

The appellant's position lacks merit. The appellant does not cite, and we are unaware of, any legal authority supporting the notion that an examiner must show that a claimed invention

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claims and decide this appeal on the basis of this claim alone. 37 CFR § 1.192(c)(7) (2003)(effective Apr. 21, 1995).

[4] The appellant submits that "the argument [] focuses on 'objective indicia of unobviousness'" and that "the present appeal can essentially be reduced to an issue of 'secondary considerations'" (appeal brief, pages 5 and 9), thus conceding

has already been used in the industry to establish a prima facie case of obviousness under 35 U.S.C. § 103(a). Indeed, the appellant's argument runs directly counter to the obviousness statute itself and confuses the provisions of 35 U.S.C. § 102 with those of 35 U.S.C. § 103.

We next consider the appellant's arguments based on (1) long felt need and failure of others and (2) commercial success, both of which, if proven, are indicia of nonobviousness. It is well settled that once a prima facie case of obviousness is established, the burden of going forward shifts to the applicant. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); In re Mayne, 104 F.3d 1339, 1343, 41 USPQ2d 1451, 1455 (Fed. Cir. 1997).

To overcome the examiner's prima facie case of obviousness based on a long-felt need and failure of others, the appellant must provide sufficient "tangible evidence to support a contention that [the claimed] invention actually has provided a long-awaited, widely-accepted, and promptly-adopted solution to the problem extant in the art, or that others [] had tried but failed to solve that problem." In re Mixon, 470 F.2d 1374, 1377, 176 USPQ 296, 299 (CCPA 1973).

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that the examiner has established a prima facie case of obviousness within the meaning of 35 U.S.C. § 103.

We are not persuaded that the appellant has met his burden of proving long-felt need and failure of others. As evidence, the appellant relies on the following:

1. declaration of Mack Rose filed Aug. 22, 2000, to which were attached: (a) a letter from Don Martine of Martine Drywall of Jan. 21, 2000 (Exhibit A); (b) Nick Moretti, A Step in the Right Direction, WALLS & CEILINGS (2000) (Exhibit B); (c) E-mail from John Friley to "Mack" at mack@macksstep.com (June 29, 2000)(Exhibit C); (d) a letter from Pat Carrasco of Rocker Chronicles to Mack's Step Inc. (Exhibit D); a draft article authored by Pat Carrasco (Exhibit E); (f) E-mail from Joe Wheeler of The Construction Zone to "Mack" at mack@macksstep.com (June 17, 2000)(Exhibit F); and (g) Mack's Step Inc. "Sales by Item Detail" (Jan. 1 through Aug.10, 2000)(Exhibit G);
2. declaration of Ralph J. Adkins filed Aug. 22, 2000;
3. declaration of Maxx Belton filed Aug. 22, 2000; and
4. supplemental declaration of Mack Rose filed Dec. 26, 2000, to which was attached a letter from Gary Bowman of Bowman Master Craftsmen to Mack's Step (Exhibit H).

There can be no question that the appellant's relied upon evidence suggests that certain individuals considered a specific

commercial product, which according to the appellant falls within the scope of the claimed invention, to be meritorious (Exhibits A through F and H). Nevertheless, the appellant has not identified "tangible evidence" indicating that the claimed invention provides "a long-awaited, widely-accepted, and promptly-adopted solution to the problem extant in the art."[5] While Exhibit G shows that the sales for a specific bench step totaled over 400 units, these sales do not necessarily indicate that the claimed drywall bench was widely-accepted as a solution to the problem extant in the art. Even if the only utility for the sold bench step is in a drywall bench, we are not told that a sale of about 400 units over about 8 months constitutes a significant portion of total sales of drywall benches during the same period, i.e., that the claimed invention was in fact widely-accepted.

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[5] Nor has the appellant proffered any evidence to indicate that one of ordinary skill in the art would have considered the advantages of the claimed invention to be truly unexpected. In re D'Ancicco, 439 F.2d 1244, 1248, 169 USPQ 303, 306 (CCPA 1971) (holding that the appellants failed to rebut a prima facie case of obviousness where the asserted differences between the claimed foams and prior art foams were not shown to be significant); In re Freeman, 474 F.2d 1318, 1324, 177 USPQ 139, 143 (CCPA 1973) (explaining that in order for a showing of unexpected results to be probative evidence of nonobviousness, an applicant must establish (1) that there actually is a difference between the results obtained through the claimed invention and those of the prior art and (2) that the difference

Moreover, the appellant does not identify tangible evidence establishing that the actual structure(s) of the sold units are reasonably commensurate with the "support member" as broadly recited in appealed claim 7. In this regard, we observe that appealed claim 7 does not necessarily require the support member, as broadly recited, to provide any of the advantages discussed in the declarations or in the specification. Accordingly, it cannot be said that the appellant has presented "tangible evidence to support a contention that [the claimed] invention actually has provided a long-awaited, widely-accepted, and promptly-adopted solution to the problem extant in the art."

The appellant has also failed to prove failure of others. Although the appellant states that "buckets are commonly employed to aid a drywaller in stepping up onto the bench platform" and to the appellant's knowledge "<u>no satisfactory alternative</u> to the use of a bucket was introduced to the drywall industry prior to" (emphasis added) the claimed invention (Aug. 22, 2000 declaration, page 1), we are not told that all drywall benches suffer from the problems described in the specification. Nor are we told that the use of buckets (or other similar objects) was the <u>only</u> alternative solution. If other

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actually obtained would not have been expected by one skilled in the art at the time of invention).

alternatives exist, there is no explanation on what these alternatives might be and why they are considered unsatisfactory.

As to the appellant's argument based on commercial success, the appellant must prove that the claimed invention is commercially successful and that its sales directly resulted from the merits of the claimed invention. In re Huang, 100 F.3d 135, 139-40, 40 USPQ2d 1685, 1689-90 (Fed. Cir. 1996). Not only must the appellant provide evidence of the number of units sold but also evidence of the actual share in a given market. Id.

As we discussed above, the appellant has not established that the sales of a particular bench step necessarily correlate to the sales of the claimed invention, which is directed to a drywall bench including the recited support member. Also, the appellant has not provided any information on actual market share, i.e., the number of units sold versus the total numbers of drywall benches sold during the period in question. As appreciated by the appellant (appeal brief filed Nov. 24, 2003, page 13)("400 sales may not be typically appreciated as evidencing 'commercial success'"), information regarding the sales of 400 units, by itself, does not prove commercial success for the claimed drywall bench. Further, the appellant has not established that the relied upon sales were a direct result of

the unique characteristics (i.e., merits) of the claimed invention and not other economic and commercial factors unrelated to the merits of the claimed invention, such as advertising. Id. Indeed, we note the appellant's admission that the sales of the bench step elements were fueled by "word-of-mouth" and Internet advertising. (Aug. 22, 2000 declaration, page 4.) Accordingly, the appellant has not met his burden of proving commercial success.

For these reasons and those set forth in the answer, we affirm the examiner's rejection under 35 U.S.C. § 103(a) of appealed claims 1 through 3 and 7 through 9 as unpatentable over the combined teachings of the admitted prior art and Acea, Valentino, or Hays.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

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| Chung K. Pak<br>Administrative Patent Judge | ) | |
| Romulo H. Delmendo<br>Administrative Patent Judge | ) | BOARD OF PATENT APPEALS AND INTERFERENCES |
| Jeffrey T. Smith<br>Administrative Patent Judge | ) | |

RHD/jlb

RAY L WEBER
RENNER KENNER GREIVE BOBAK TAYLOR
& WEBER
1610 FIRST NATIONAL TOWER
AKRON OH 44308