

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2001-1482
Application 08/879,392

ON BRIEF

Before COHEN, FRANKFORT, and McQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 2 through 11, 13 through 15 and 18 through 22, which are all of the claims remaining in this application. Claims 1, 12, 16 and 17 have been canceled. On page 1 of the supplemental appeal brief (Paper No. 20) appellant has expressly withdrawn the appeal as to claim 11. Accordingly, the appeal as to claim 11 is dismissed and thus only claims 2 through 10, 13 through 15 and 18 through 22 remain for our consideration on appeal.

Appellant's invention relates to a jewelry assembly in which the appearance of an

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air space (19) between one or more diamonds or other jewelry stones (17 or 61) and the supporting jewelry article is achieved. As noted, for example, in the paragraph bridging pages 4 and 5 of the specification, the above noted mounting arrangement makes the stone (17) appear to be “floating” within the window defined by border (15) and produces the illusion that stone (17) is larger than its actual size. A copy of representative independent claims 18, 19 and 20 on appeal can be found in the Appendix to appellant’s supplemental brief.

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

Hexter	1,056,414	Mar. 18, 1913
Sudarov	1,276,132	Aug. 20, 1918
Itzkowitz	5,649,434	Jul. 22, 1997
Boucher (British Patent Specification)	121,899	Jan. 9, 1919
Van Cleef et al. (Van Cleef) (British Patent Specification)	432,074	Jul. 19, 1935

Claims 2 through 5, 13 and 18 through 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hexter.

Claims 2 through 4, 13 and 18 through 22 stand rejected under 35 U.S.C.

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§ 102(b) as being anticipated by Boucher.¹

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hexter in view of Suderov.

Claims 6 through 10 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hexter in view of Itzkowitz.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Boucher.

Claims 6 through 10, 14 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Boucher in view of Van Cleef.

Rather than reiterate the examiner's full explanation of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the examiner's answer (Paper No. 22, mailed August 29, 2000) for the examiner's reasoning in support of the rejections and to appellant's supplemental brief (Paper No. 20, filed June 7, 2000) and reply brief (Paper No. 24, filed October 12, 2000) for the arguments thereagainst.

OPINION

¹ In both this rejection and the one based on Hexter, it appears the examiner has mistakenly included claims 16 and 17 in the ground of rejection set forth on pages 4 and 5 of the answer (Paper No. 22), because those claims were canceled in Paper No. 13, filed August 18, 1999).

In reaching our decision in this appeal, this panel of the Board has given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we find that we must reverse all of the examiner's rejections of the claims before us on appeal because we are unable to clearly understand the claimed subject matter due to language which renders the claims indefinite. Our reasons for this determination follow.

Before addressing an examiner's rejections based on prior art, it is an essential prerequisite that the claimed subject matter be fully understood. Accordingly, we initially direct our attention to appellant's independent claims 18, 19 and 20 to derive an understanding of the scope and content thereof.

Claim 20 is the broader of the claims on appeal and reads as follows:

20. A jewelry assembly comprising:

a jewelry article having a front surface defining a window, said front surface being substantially flat and continuous around and in the vicinity of said window, and an internal frame disposed in said window; and

a jewelry stone set within said window by said frame, said jewelry stone and said window being sized and arranged to define an empty space around said jewelry stone, said empty space being visible when the article is worn and having a width defined between said stone and said surface, said width being arranged and sized to give a viewer the illusion that said stone is larger than the actual size of said stone.

Claims 18 and 19 are generally similar to claim 20 but each sets forth the

additional limitations that the front surface of the jewelry article has “surface dimensions” and that the width of the empty space between the jewelry stone and said surface is “smaller than said surface dimensions.” Claims 18, 19 and 20 in their current form were added to the application in the amendment filed August 18, 1999 (Paper No. 13).

Our problem with appellant's independent claims 18, 19 and 20 centers on the recitations in those claims regarding the “width” of the empty space between the jewelry stone and the front surface of the jewelry article. We find nothing in appellant's originally filed specification that would have reasonably conveyed to one of ordinary skill in the art at the time of filing of the application that the “width” of the space (19) or the relative dimension of the “width” of the space (19) compared to the “surface dimensions” of the jewelry article or front surface thereof were of any importance. On the contrary, appellant's specification conveys the clear impression that any space around the jewelry stone would be adequate to achieve the desired visual impression or aesthetic appearance.

On page 2 of the specification, it is indicated to be an object of the invention “to provide a jewelry design assembly which creates the appearance of a space between one or more stones and the surrounding supporting jewelry article.” In the paragraph bridging pages 4-5 of the specification, it is noted that the mounting arrangement including the space makes the stone (17) appear to be “floating” within the window

defined by border (15) and produces the illusion that stone (17) is larger than its actual size. At no time did appellant indicate that the “width” of the space was in any way critical to achieving the desired visual impression, or that the relationship between the “width” or size of the space and the “surface dimensions” of the front surface of the jewelry article was of any significance. Indeed, language relating to “width” of the space and “surface dimensions” of the front face appears nowhere in the originally filed specification. As for the drawings in the present application, we do not see that such drawings can be relied upon in any way to establish criticality of the width of the space.

Moreover, we consider that the standard set forth in the claims on appeal regarding the width or space being “arranged and sized to give a viewer the illusion that said stone is larger than the actual size of said stone,” is too subjective. No specific width or range of widths for the space are provided by appellant and thus one is left to divine what size of space would create the illusion desired in the mind of a hypothetical viewer. However, the impression created in the mind of one viewer might be quite different than that created in the mind of another viewer. Thus, how does one reasonably determine the scope of the subject matter set forth in the claims on appeal?

For the above reasons, when the claim recitations relating to size or width of the space are viewed in the context of appellant's specification, we find that such recitations render the scope and content of claims 18, 19 and 20 unclear and indefinite. Since claims 2 through 10, 13 through 15, 21 and 22 on appeal depend from one or other of

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the independent claims, they too suffer from the same indefiniteness.

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection against appellant's claims:

Claims 2 through 11, 13 through 15 and 18 through 22 are rejected under 35 U.S.C. § 112, second paragraph, for the reasons explained above, as being indefinite for failing to particularly point out and distinctly claim that which appellant regards as the invention.

Claims 2 through 11, 13 through 15 and 18 through 22 are also rejected under 35 U.S.C. § 112, first paragraph, for the reasons explained above, since the specification, as originally filed, fails to provide written descriptive support for the invention as now claimed (i.e., the significance of the "width" of the space (19) to the illusion created or vis-a-vis the "surface dimensions" of the jewelry article or front surface thereof). As stated in In re Bowen, 492 F.2d 859, 181 USPQ 48 (CCPA 1974), the description requirement of 35 U.S.C. § 112, first paragraph, "is that the invention claimed be described in the specification as filed." It is not necessary that the claimed subject matter be described identically, but the disclosure originally filed must convey to those skilled in the art that the applicant had invented the subject matter later claimed. See In re Wilder, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984).

Turning to the examiner's rejections of the appealed claims under 35 U.S.C.

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§ 102(b) and § 103, we emphasize again that these claims contain unclear language which renders the subject matter thereof indefinite for reasons stated supra as part of our new ground of rejection under 35 U.S.C. § 112, second paragraph. Accordingly, we find that it is not possible to apply the prior art relied upon by the examiner to these claims in deciding the question of either anticipation under 35 U.S.C. § 102(b) or obviousness under 35 U.S.C. § 103 without resorting to considerable speculation and conjecture as to the meaning of the questioned limitations in the claims. This being the case, we are therefore constrained to reverse the examiner's rejections of the claims on appeal both under 35 U.S.C. § 102(b) and 35 U.S.C. § 103 in light of the holding in In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962). We hasten to add that this reversal of the examiner's rejections is not based on the merits of the rejections, but only on grounds relating to the indefiniteness of the appealed claims.

In summary, the examiner's rejections of the appealed claims under both 35 U.S.C. § 102(b) and 35 U.S.C. § 103 have been reversed for technical reasons. New rejections of claims 2 through 11, 13 through 15 and 18 through 22 under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 112, first paragraph, have been added pursuant to 37 CFR § 1.196(b).

The decision of the examiner, accordingly, is reversed.

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b).

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37 CFR § 1.196(b) provides that “[a] new ground of rejection shall not be considered final for purposes of judicial review.”

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
- (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal

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may be extended under 37 CFR § 1.136(a).

REVERSED, 37 CFR § 1.196(b)

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Administrative Patent Judge)	
)	
CHARLES E. FRANKFORT)	BOARD OF PATENT
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