

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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte VICTOR CHRIST-JANER

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Appeal No. 2002-1972  
Application No. 09/394,722

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ON BRIEF

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Before ABRAMS, FRANKFORT, and STAAB, Administrative Patent Judges.  
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-5, which are all of the claims pending in this application.

We REVERSE.

### BACKGROUND

The appellant's invention relates to a yang-yin emblem. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's Brief.

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

Bruzas <u>et al.</u> (Bruzas)	5, 203,564	Apr. 20, 1993
Philippe	Des. 155,319	Sep. 20, 1949

Claims 1-5 stand rejected under 35 U.S.C. § 101 on the basis that the claimed invention lacks patentable utility.

Claims 1-5 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one of ordinary skill in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1, 3, 4 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Philippe.

Claim 2 stands rejected under 35 U.S.C. § 103 as being unpatentable over Philippe in view of Bruzas.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer

(Paper No. 15) and the final rejection (Paper No. 11) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 14) for the appellant's arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

#### *The Rejection Under Section 101*

The appellant's invention is an emblem in the form of a disc having a number of features including elevated and depressed sections. It is described as being constructed so as to represent the polarity principles of Chinese intuition as residing in the yang and the yin. The examiner has rejected all of the claims under Section 101 on the basis that the features recited therein "do not appear to perform functions sufficient to give rise to patentability, and appear to be the product of a design choice" (Paper No. 11, page 2). The examiner further explains on page 4 of the Answer that "[w]hile the medallion itself is a tangible object, the result of using the object is not a concrete or tangible result as required." The appellant has responded by pointing out on pages 6-9 of the Brief several reasons why the examiner's decision on this matter is defective, with which we find ourselves generally to be in agreement.

The appellant's claims are directed to an emblem comprising a disc having obverse and reverse faces, each of which is divided by a sigmoid line into substantially equal adjoining forms having a major portion and a minor portion. The major portion of each form is displaced with respect to the other in order to shape the emblem into a pair of oppositely oriented elevated sections, each of which has a depressed portion on its opposite side. Thus, the claims describe an emblem having a particular structure. The appellant has explained the concept of yang and yin on pages 1-5 of the specification, and then goes on to state on page 5 that the emblem "allows for visual apprehension of the [Tao] law of polarity, of black and white, and of something masculine in the feminine, and something of the feminine in the masculine," and "provides a three-dimensional representation of the yang-yin principle whereby the principle may be experienced through sight as well as touch . . . [which] serves as a constant reminder of the bipolar nature of cosmic energy, facilitates meditation of intuitive realization of being one with the Tao, sensing large and small manifestations of oneness with the Tao, and harmonizing the yang-yin energies in the body."

The appellant's claims clearly recite an object having specifically defined structural features. In the above-noted portions of the appellant's specification the appellant has asserted that the object described in the claims has utility in that it provides a three-dimensional representation of the Tao which can be seen and touched. While the examiner has taken the position that this does not constitute "utility"

under Section 101, the examiner has not, in our view, provided a detailed explanation or evidence that one who is skilled in the art would consider the appellant's position regarding the utility of the emblem not to be credible, as is required by MPEP § 2107(C). We do not regard the examiner's unsupported conclusion that "[t]he connection between the object and the apprehension of the Tao is simply too abstract to satisfy the requirements of 35 U.S.C. 101" as being sufficient to cause the burden of proving utility to be shifted to the appellant. We also agree with the appellant that the examiner's reliance on State Street Bank and other similar cases that dealt with mathematical algorithms to support the conclusion that utility is lacking in the present situation is misplaced.

The rejection under Section 101 is not sustained.

*The Rejection Under The First Paragraph Of Section 112*

The examiner asserts in this rejection that the specification does not describe the invention in such a manner as to enable one of ordinary skill in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention because the invention does not produce a concrete or tangible result and thus cannot operate as intended without undue experimentation (Paper No. 11, page 2).

This rejection is not sustained on the basis of the same reasoning set forth above with regard to the Section 101 rejection. That is, the examiner has not, in our opinion, adduced evidence or provided persuasive explanation that one of ordinary skill in the art would not be enabled by the specification to perceive a tangible result from the use of the invention and/or would have been caused to conduct an undue amount of experimentation in order to do so.

*The Rejections Under Section 103*

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

The first of the rejections under Section 103 is that claims 1 and 3-5 are unpatentable over Philippe. This design patent discloses an earring which has a three-

dimensional design on the obverse side while the reverse side is flat and is provided with a clip by which the earring is attached to the wearer's ear. The examiner has concluded, without evidence or explanation, that the earring is "in the shape of a three dimensional yin-yang symbol" (Paper No. 11, page 3), apparently because it is circular and its ornamentation includes a sigmoid line. The examiner admits that the Philippe earring "does not disclose that the reverse side has a depressed section," but takes the position that this feature is "a design choice that would have been obvious to one of ordinary skill in the art of sculptures for the purpose of providing a similar appearance to both sides of the structure, such [that] a viewer may see the same structure when looking at either side" (Paper No. 11, page 3).

The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See, In re Gordon, 733 F.2d 900, 902, USPQ 1125, 1127 (Fed. Cir. 1984). All of the appellant's claims require that there be elevated and depressed sections on both faces of the emblem, and that the elevated section on each of the faces have directly underneath the depressed sections of the other face. Considering that the reverse side of the Philippe earring appears not to be intended to be visible when worn, we fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to modify the earring in the manner proposed by the examiner, that is, to provide the elevated and depressed sections on both faces. Moreover, merely

duplicating the structure appearing on the obverse face of the earring would not, in our view, result in the orientation of the elevated and depressed sections on the reverse face being in accordance with the claims without the application of the hindsight afforded one who first viewed the appellant's disclosure.

It therefore is our opinion that the teachings of Philippe fail to establish a prima facie case of obviousness with regard to the subject matter recited in claims 1, 3, 4 and 5, and we will not sustain the Section 103 rejection.

Claim 2, which depends from claim 1, stands rejected as being unpatentable over Philippe in view of Bruzas, the latter being cited for teaching the claimed circle in each portion of the faces. Be that as it may, Bruzas fails to overcome the deficiencies in Philippe pointed out above with regard to the rejection of claim 1. This being the case, the rejection of claim 2 also is not sustained.

#### CONCLUSION

None of the rejections are sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS  
Administrative Patent Judge

CHARLES E. FRANKFORT  
Administrative Patent Judge

LAWRENCE J. STAAB  
Administrative Patent Judge

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