

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PREMIER GEM CORPORATION and JAY GEMS INC.,
Petitioners,

v.

WING YEE GEMS & JEWELLERY LIMITED,
Patent Owner

Case IPR2016-00434
Patent D618,132 S

Before KEN B. BARRETT, JENNIFER S. BISK, and
BENJAMIN D. M. WOOD, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

A. Background

Premier Gem Corp. and Jay Gems Inc. (collectively “Petitioner”), seeks review of the sole claim of US Patent D618,132 (Ex. 1001, “the ’132 patent”). See Paper 4 (“Pet.”). Patent Owner, Wing Yee Gems & Jewellery Limited (“Wing Yee Gems”), contends that Petitioner’s request should be denied. See Paper 8 (“Prelim. Resp.”). As detailed in the following opinion, Petitioner has not established a reasonable likelihood of prevailing on the claim challenged. Consequently, we do not institute *inter partes* review.

B. Related Proceedings

The parties identify two pending cases in the United States District Court for the Southern District of New York concerning the ’132 patent. Pet. 4–5; Paper 7, 2. The first is a pending declaratory judgment action filed April 29, 2011 and styled *Prestige Jewelry International, Inc. v. Wing Yee Gems & Jewellery Limited, et al.*, Civil Action No. 1:11- cv-02930 (LAP) (SDNY) (“The Prestige Action”). The second is a pending patent infringement action filed March 27, 2015 and styled *BK Jewellery, Wing Yee Gems & Jewellery Limited and A.V. Jewelry Export-Import, Ltd. v. Kiran Gems Pvt. Ltd., et al.*, Civil Action No. 1:15- cv-02333 (LAP)(DCF) (SDNY).

C. The ’132 Patent and Claim

In an *inter partes* review, “[a] claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.” 37 C.F.R. § 42.100(b); see *Cuozzo Speed*

Techs., LLC v. Lee, No. 15–446, slip op. at 12–20 (U.S. June 20, 2016) (holding that 37 C.F.R. § 42.100(b) “represents a reasonable exercise of the rulemaking authority that Congress delegated to the . . . Office”). With regard to design patents, it is well-settled that a design is represented better by an illustration than a description. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (en banc) (citing *Dobson v. Dornan*, 118 U.S. 10, 14 (1886)). Although preferably a design patent claim is not construed by providing a detailed verbal description, it may be “helpful to point out . . . various features of the claimed design as they relate to the . . . prior art.” *Egyptian Goddess*, 543 F.3d at 679–80; cf. *High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1314–15 (Fed. Cir. 2013) (remanding to district court, in part, for a “verbal description of the claimed design to evoke a visual image consonant with that design”).

The '132 patent (Ex. 1001) is titled “Diamond Jewellery” and the claim recites, “[t]he ornamental design for a diamond jewellery, as shown and described.” Ex. 1001 (57). The '132 patent includes two figures, reproduced below.

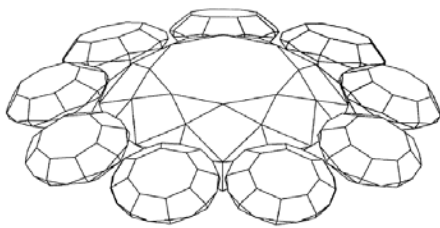


FIG. 1

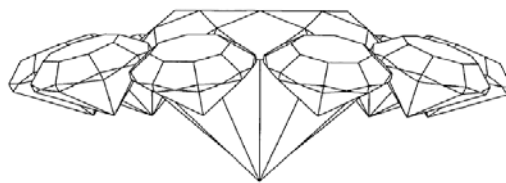


FIG. 2

Figure 1 is a “front prospective view of a diamond jewellery [sic] showing our new design[.]” Ex. 1001. Figure 2 is a “side elevation view” of the

design, “the left side, right side and opposite side views being identical” to the side shown in Figure 2. *Id.*

Petitioner emphasizes that design patents “should be preferably and ordinarily be construed as depicted in its claimed drawings, with no written or verbal construction necessary.” Pet. 19 (citing *Egyptian Goddess*, 543 F.3d at 679–80). Moreover, Petitioner asserts that “[d]esign intent is irrelevant” to the invention. *Id.* at 20 (citing *Cordis Corp. v. Boston Sci. Corp.*, 561 F.3d 1319, 1338 (Fed. Cir. 2009)). And Petitioner argues that we should disregard any attempt by Patent Owner “to argue[, as part of claim construction,] that the inventor’s subjective intent . . . was to simulate the appearance of a solitaire diamond (i.e., that the central large round diamond and the surrounding smaller round stones were provided to simulate a single, larger and round stone).” Pet. 19–20.

Patent Owner does not disagree that, in this case, the figures alone provide a complete construction, but notes that “[t]he Board may find it helpful to describe verbally certain features of the claim.” Prelim. Resp. 37. Further, Patent Owner discusses the Prestige Action, in which the district court issued an opinion granting Patent Owner’s motion for partial summary judgment and dismissing Prestige’s claim of invalidity of the ’132 patent. *Id.* at 37–38 (citing Ex. 1005). In that opinion, the Court declined to construe the ’132 patent claim in words, but stated the following:

The parties agree that these figures “show a diamond arrangement, with one center, comparatively larger ‘full-cut’ diamond, surrounded by nine smaller ‘single-cut’ diamonds that are canted relative to the center diamond and slightly overlap it.” Full-cut diamonds have more facets than single-cut diamonds and typically produce a greater sparkling effect. The diamond arrangement depicted in the ’132 Patent is designed to

look like a large diamond solitaire from a distance. When viewed up close, however, it is obvious that the arrangement is composed of several smaller diamonds. Arrangements of smaller diamonds grouped together to mimic a larger diamond are often called “cluster tops.”

Ex. 1005, 4–5 (internal citations omitted).

We, like the District Court (*id.* at 30–31), determine that there is no need to provide at this time a verbal description of the claimed design. The parties’ description may be helpful in analyzing some aspects of the ’132 patent. However, the description is not a complete construction of the ’132 patent’s claim. The description focuses on only a portion of the design shown in Figures 1 and 2. *Id.* For example, there is no discussion of height of the stones relative to each other, as shown in Figure 2 of the ’132 patent. *Id.* In addition, as a construction, this description would improperly focus on the design concept of the ’132 patent rather than the overall visual appearance. *See Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 104 (Fed. Cir. 1996).

For purposes of this Decision, we conclude that it is unnecessary to construe the claim of the ’132 patent in words and instead rely on the drawings shown in Figures 1 and 2 for our analysis below.

D. Asserted Grounds of Unpatentability

Petitioner asserts, as prior art, a specific jewelry design, “the Lotus Carat” appearing in three separate references: The “Lin Publication,”¹ the

¹ People’s Republic of China Patent Application No. 200710076738.6, published under Publication No. CN 101112263A on January 30, 2008. Ex. 1011. Page 2 of Exhibit 1011 is an English translation of Page 1. Pet. iii.

“Lin Article,”² and the “Lin Magazine.”³ Pet. 10–11 n.6. Petitioner contends that the ’132 patent’s claim is unpatentable under 35 U.S.C. § 103 based on the Lotus Carat as depicted in each of the Lin Publication, Lin Article, and Lin Magazine, combined with the teachings of one or more designs disclosed in “Auction House Catalogs”⁴ as follows (Pet. 10–16):

References
Lin Publication’s Lotus Carat Design combined with one or more of: • Heritage Art Deco Diamond Ring⁵ • Heritage Diamond Ring⁶ • Christie’s Diamond Ring⁷

² Shenzhen Jewelry Net Article, published October 16, 2007. Ex. 1013. Page 4 of Exhibit 1013 is an English translation of pages 1–3 and page 5 is an unsigned translation certification.

³ Selected pages from Volume 11 of the Shenzhen Jewelry magazine published in January 2008. Ex. 1014.

⁴ Petitioner refers to the following references, collectively, as the “Auction House Catalogs”: Heritage 2007 Catalog—the Heritage Auction Galleries’ catalog for an auction purportedly taking place on May 21, 2007 (Ex. 1015); Christie’s September 2005 Catalog—Christie’s catalog for an auction purportedly taking place on September 20, 2005 (Ex. 1016); Christie’s March 2005 Catalog—Christie’s catalog for an auction purportedly taking place on March 20, 2005 (Ex. 1017); Sotheby’s February 2003 Catalog—Sotheby’s catalog for an auction purportedly taking place on February 4, 2003 (Ex. 1018); and the Sotheby’s April 2005 Catalog—Sotheby’s catalog for an auction purportedly taking place on April 20, 2005 (Ex. 1019). Pet. 12–13, 16.

⁵ The Heritage Art Deco Diamond Ring refers to the Art Deco Diamond, Platinum Ring, Item No. 39432 shown in Exhibit 1015.

⁶ The Heritage Diamond Ring refers to the Diamond, Platinum Ring, Item No. 39433 shown in Exhibit 1015.

⁷ Christie’s Diamond Ring refers to the Diamond Ring, Item No. 169 shown

- Christie’s Diamond Cluster Ring⁸
- Sotheby’s Ring⁹
- Sotheby’s Necklace¹⁰

Lin Article’s Lotus Carat Design combined with one or more of:

- Heritage Art Deco Diamond Ring
- Heritage Diamond Ring
- Christie’s Diamond Ring
- Christie’s Diamond Cluster Ring
- Sotheby’s Ring
- Sotheby’s Necklace

Lin Magazine’s Lotus Carat Design combined with one or more of:

- Heritage Art Deco Diamond Ring
- Heritage Diamond Ring
- Christie’s Diamond Ring
- Christie’s Diamond Cluster Ring
- Sotheby’s Ring
- Sotheby’s Necklace

II. ANALYSIS

A. Principles of Law

“In addressing a claim of obviousness in a design patent, the ultimate inquiry is whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved.” *Apple, Inc. v.*

in Exhibit 1016.

⁸ Christie’s Diamond Cluster Ring refers to the Diamond Ring, Item No. 227 shown in Exhibit 1017.

⁹ Sotheby’s Ring refers to the Diamond Ring, Item No. 15 shown in Exhibit 1018.

¹⁰ Sotheby’s Necklace refers to the Diamond Necklace, Circa 1890, Item No. 225 shown in Exhibit 1019.

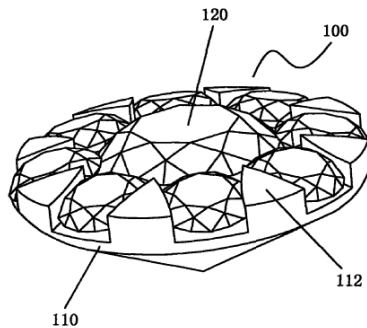
Samsung Elec. Co., 678 F.3d 1314, 1329 (Fed. Cir. 2012) (internal quotation and citations omitted). This obviousness analysis generally involves two steps: first, “one must find a single reference, a something in existence, the design characteristics of which are basically the same as the claimed design”; second, “once this primary reference is found, other references may be used to modify it to create a design that has the same overall visual appearance as the claimed design.” *High Point Design, LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1311 (Fed. Cir. 2013) (internal quotation and citations omitted).

In performing the first step, we must “(1) discern the correct visual impression created by the patented design as a whole; and (2) determine whether there is a single reference that creates basically the same visual impression.” *Id.* at 1312 (internal quotation and citations omitted). In the second step, the primary reference may be modified by secondary references “to create a design that has the same overall visual appearance as the claimed design.” *Id.* at 1311 (internal quotation and citations omitted). However, the “secondary references may only be used to modify the primary reference if they are ‘so related [to the primary reference] that the appearance of certain ornamental features in one would suggest the application of those features to the other.’” *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996) (quoting *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996)).

B. Primary Reference

For all of its asserted grounds, Petitioner proposes references disclosing versions of the Lotus Carat as the primary reference shown in the

Lin Publication, the Lin Article, and the Lin Magazine. Pet. 33–38, 11 n.7.
The figure from the Lin Publication is reproduced below.¹¹



The Figure, above, from the Lin Publication shows eight “peripheral setting diamonds” that “abut against the central diamond with inner edges thereof.” Ex. 1011, 2.

Petitioner asserts that “it is clear that the Lotus Carat is ‘basically the same’ as the ’132 Patent’s claimed design” because both “depict a larger, round, central, full-cut (also called brilliant-cut) diamond surrounded by a plurality of smaller, canted or angled, round diamonds.” Pet. 33–34. According to Petitioner, “the only relevant, ‘salient’ difference between the prior art Lotus Carat design and the ’132 Patent’s claimed design is that the ’132 Patent teaches smaller diamonds at the periphery that are *single-cut*, while the Lotus Carat teaches smaller, *full-cut* diamonds at the periphery.”

¹¹ Our analysis focuses on the Lin Publication. Petitioner’s contentions in the grounds relying on the Lin Article and the Lin Magazine are similar (*see* Pet. 48–49) and suffer from the same problems as those in the Lin Publication ground. In addition, we note that Petitioner proffers no evidence that either the Lin Article or the Lin Magazine were, in fact, sufficiently accessible to the public interested in the art at the relevant time. *See, e.g.* Pet. 14–15.

Id. at 35. In fact, Petitioner asserts that Patent Owner concedes that all features “*other than* the mixing or combination of smaller, round peripheral diamonds of one cut (e.g., single cut) around a central larger and round diamond of a different cut (e.g., full cut)—are known in the field and/or obvious.” *Id.* Petitioner relies, for this alleged concession, on Patent Owner’s statement in the *ex parte* reexamination that “the crucial and most salient teaching in the ’132 patent is to provide [] single cut diamonds only at the periphery” *Id.* (quoting Ex. 1010, 4) (emphasis omitted).

Patent Owner does not contest, explicitly, that the Lotus Carat qualifies as a primary reference. *See* Prelim. Resp. Patent Owner does point out, however, that “the protrusions 112 are mentioned [in Exhibit 1008, the U.S. Patent claiming the Lotus Patent Design] as being triangular and the smaller diamonds have some of their peripheral edges obscured by the pizza-shaped protrusions 112.” Prelim. Resp. 21–22 (citing Ex. 1008, 2:13–17).

We disagree with Petitioner’s assertion that the only relevant difference, for purposes of obviousness analysis, between the Lotus Carat and the ’132 patent’s claimed design is the mixing of diamonds with different cuts. Even a cursory examination of the the patented design with the Lotus Carat shows other features that contribute to each design’s overall visual appearance, including the protrusions 112 incorporated into the design of the Lotus Carat. For purposes of this Decision, however, we need not decide whether the Lotus Carat qualifies as a primary reference because, as discussed below, even assuming it does, we are not persuaded that the modifications proposed by Petitioner would result in “the same overall visual appearance as the claimed design.” *High Point Design*, 730 F.3d at 1311.

C. Secondary References

Petitioner asserts as secondary references six pieces of jewelry described and photographed in five catalogs allegedly published prior to auctions taking place on specified dates. Pet. 11–13. Collectively, Petitioner refers to the five catalogs, Exhibits 1015–1019, as the “Auction House Catalogs.” *Id.* The photographs and descriptions for each of the six pieces of jewelry relied upon by the Petitioner are summarized below.

The photo of the Heritage Art Deco Diamond Ring is reproduced below.



Ex. 1015, 4. The Heritage Art Deco Diamond Ring is “center[ed] a round [sic] brilliant-cut diamond measuring 8.20 x 4.30 mm . . . enhanced by single-cut diamonds, set in platinum.” *Id.*

The photo of the Heritage Diamond Ring is reproduced below.



Ex. 1015, 5. The Heritage Diamond Ring is described as a “ring set” with “one ring highlighted by a round brilliant-cut diamond measuring 8.09 – 8.22 x 4.68 mm . . . enhanced by single-cut diamonds, set in platinum.” *Id.*

The photo of the Christie's Diamond Ring is reproduced below.



Ex. 1016, 4. Christie's Diamond Ring is described as “the central old-brilliant-cut diamond to pierced gallery and shoulders set with single-cut diamonds.” *Id.* at 5.

The photo of Christie's Diamond Cluster Ring is reproduced below.



Ex. 1017, 4. Christie's Diamond Cluster Ring is described as “of pieced bombé design, the collet-set brilliant-cut diamond single stone centre with old and single-cut diamond gallery and shoulders.” *Id.* at 5.

The photo of Sotheby's Ring is reproduced below.



Ex. 1018, 4. Sotheby's Ring is described as “a cluster set with brilliant-, circular- and single-cut diamonds.” *Id.*

The partial photo of the Sotheby's Necklace is reproduced below.



Ex. 1019, 6. Sotheby's Necklace is described as “[c]omposed of a graduated series of flowerhead clusters set throughout with brilliant- and circular-cut diamonds, interspersed with similarly set trefoil clusters, to a diamond collet back chain[.]” *Id.* at 5.

D. Obviousness

Petitioner asserts that the relevant designer of ordinary skill is “someone with a background and training in diamond jewelry design and who is presumed to have knowledge of the prior art relevant to jewelry designs featuring one or more diamonds or gems.” Pet. 31 (citations omitted). Patent Owner does not appear to dispute this description. *See, e.g.*, Prelim. Resp. 5–6 (discussing what the figures depicted in the ’132 patent convey to a “jewelry designer”), 7 (same with respect to Exhibit 1017), 12 (same with respect to the asserted combinations), 39 (“A jewelry designer instantly discerns in the ’132 Patent drawings its usage of a central, large diamond and the 9 single cut surrounding and canted diamonds Regardless, the ordinary jewelry designer would not modify the primary Lin reference in a manner that would detract from its overall objective of obtaining ‘the effect of a bigger diamond with low cost.’”).

Petitioner uses this definition of an ordinary designer to assert that “[e]ach jewelry design depicted in the Auction House Catalogs . . . would be thought of by a designer in the field to modify the Lotus Carat design to

create a design having the same overall visual appearance as the '132 Patent's claimed design." Pet. 38. According to Petitioner, each of the secondary reference designs shows and teaches "the concept of mixing a large, central, round full-cut diamond with smaller, round and peripheral single-cut diamonds" and that "such mixing . . . makes sense because (a) the prior art teaches it and (b) the cost of making single-cut diamonds is ordinarily less (due to labor savings) than the cost to manufacture full-cut diamonds." *Id.* at 38–39. For each of the six secondary references, Petitioner then concludes that "[a] jewelry designer having ordinary skill in the art would have been motivated to use the" secondary reference's "teachings (mixing of smaller, round, single-cut diamonds to surround a larger, round and full-cut diamond) to modify the Lotus Carat[.]" which would be "a cost savings" and, therefore, the "combination of these two references is obvious[.]" *Id.* at 40 (Heritage Art Deco Diamond Ring); *see also* 42 (similar conclusion for the Heritage Diamond Ring), 43 (similar conclusion for Christie's Diamond Ring), 44–45 (similar conclusion for Christie's Diamond Ring Cluster), 46 (similar conclusion for Sotheby's Ring), 47–48 (similar conclusion for Sotheby's Necklace). Petitioner does not point to other evidence supporting these conclusions. *Id.*

Patent Owner requests that we deny this Petition. *See* Prelim. Resp. According to Patent Owner, the "looks" of the Lotus Carat and the secondary references are "dramatically different" (*id.* at 13), none of the proposed combinations would result in the patented design (*id.* at 12), and Petitioner has ignored the knowledge of a designer of ordinary skill in the art (*id.* at 13).

We agree with Patent Owner that Petitioner has not shown sufficiently

that its proposed secondary references properly “bridge the gap” between the Lotus Carat and the claimed design. *Apple*, 678 F.3d at 1331 (holding that a tablet with a screen area surrounded by a gray area and a wide rounded-over metallic rim is not similar enough to the primary reference to be a secondary reference in an obviousness analysis of a patented design with a screen covering essentially the entire front face of the patented design without any breaks or interruptions). “[T]he teachings of prior art designs may be combined only when the designs are so related that the appearance of certain ornamental features in one [design] would suggest the application of those features to the other.” *Id.* (internal citations omitted). Here, the details of the secondary reference designs are not clearly discernable based on the evidence in the record. For example, it is not clear, just by viewing the proffered photos, how each stone in a particular secondary reference design is cut (i.e., single vs. full cut), what the shape of each stone is, how the stones are angled and set in relation to one another, and what height the stones are in relation to one another. *See* Exs. 1015, 1016, 1017, 1018, 1019. All of these features, at least, contribute to the overall appearance of the patented design. Without supporting evidence, we are left to guess at what is shown in the photos of the secondary references.

The very brief descriptions accompanying the photos do not solve this problem. At most, the descriptions merely confirm that each piece of jewelry proposed as a secondary reference contains diamonds of more than one cut. According to Petitioner, this is enough to show obviousness because “[t]he Lin Publication teaches all the other elements of the ’132 Patent’s claimed design[.]” Pet. 40. First, as noted above, we do not agree that the Lin Publication differs from the patented design in only this respect.

Second, Petitioner, here, improperly focuses on design concepts rather than overall visual appearance. Pet. 39–48. Petitioner categorizes both the patented design and the Lotus Carat as “a larger, round, central, full-cut . . . diamond surrounded by a plurality of smaller, canted or angled, round diamonds,” (*id.* at 34), a general design concept that is at too high a level of abstraction to be useful in this obviousness analysis. Petitioner then attempts to import into the Lotus Carat another high-level general concept—mixing stones of different cuts—from other jewelry designs. Instead, Petitioner should have focused on the distinctive “visual appearances” of the references and the claimed design. *See Apple*, 678 F.3d at 1332.

In addition, Petitioner has not shown sufficiently that, even if properly considered secondary references, a designer of ordinary skill in the art would have used these references to modify the Lotus Carat such that the result would be the patented design. Prelim. Resp. 10–13. Petitioner appears to have selectively chosen certain design features of the secondary references (the mixing of stones of different cuts) while deliberately ignoring other design features of those references just so the claimed design would result. For example, Petitioner does not explain the other clear differences between the Heritage Art Deco Ring, which appears to have a square center stone sitting at a higher plane than the surrounding peripheral stones, and the patented design. *See Ex. 1015*, 4. This selective use of the design characteristics of the prior art suggests that it is driven by a hindsight reconstruction of the invention rather than the objective teachings of the references. There is nothing on this record to suggest that an ordinary jewelry designer would have considered the use of single-cut periphery stones without the corresponding change in height difference and shape

relative to the center stone. Moreover, Petitioner does not address any of the other differences between the Lotus Carat and the patented design, as discussed above.

In summary, we agree with Patent Owner that there is no evidence, aside from Petitioner's conclusory attorney argument, that the selective combination of design features of the applied references is driven by the teachings of the references, as opposed to an effort to reconstruct the claimed invention using the '132 patent's own disclosure.

On this record, Petitioner has not shown a reasonable likelihood of prevailing with regard to any of the proposed grounds of unpatentability.

III. CONCLUSION

Upon consideration of the Petition and Preliminary Response, we are not persuaded that there is a reasonable likelihood that Petitioner would prevail on at least one alleged ground of unpatentability with respect to the claim of the '132 patent.

IV. ORDER

It is

ORDERED that the Petition is denied and no trial is instituted.

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