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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/479,697	04/05/2017	Rami Guirguis	893/2 UTIL	3298
115007	7590	03/13/2020	EXAMINER	
NK Patent Law 4917 Waters Edge Drive Suite 275 Raleigh, NC 27606			MORGAN, EMILY M	
			ART UNIT	PAPER NUMBER
			3677	
			NOTIFICATION DATE	DELIVERY MODE
			03/13/2020	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RAMI GUIRGUIS

Appeal 2019-005173
Application 15/479,697
Technology Center 3600

Before PHILLIP J. KAUFFMAN, TARA L. HUTCHINGS, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 6–8. Non-Final Act. 5–7. Claims 1–5 are withdrawn from consideration. Appeal Br. 22–23. Claims 9 and 10 are cancelled. Appeal Br. 24. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Tough Love Rings, LLC. Appeal Br. 3.

CLAIMED SUBJECT MATTER

Appellant's claimed invention relates to three band molded, silicone wedding rings. Spec. ¶ 1.

Claim 6 is independent. We reproduce claim 6 below.

6. A three-band silicone ring comprising:

a first outer band and a second outer band, each outer band having a curved outer edge and a channel in a circumferential inner edge,

wherein each outer band is tapered such that the curved outer edge is thinner than the circumferential inner edge, and

wherein an opening of the channel at the surface of the circumferential inner edge of each outer band is a widest part of the channel; and

a middle band having a first ridge portion and a second ridge portion on opposite circumferential inner edges of the middle band, each ridge portion extending from the circumferential inner edge such that each ridge portion is substantially the same shape as the channel in each of the outer bands;

wherein the first ridge portion of the middle band is fused to the channel in the first outer band at a first interface and the second ridge portion of the middle band is fused to the channel in the second outer band at a second interface, with each channel and each corresponding ridge portion providing additional surface area for contact for the fusing at each interface between the middle band and each outer band; and

wherein the first and second outer bands and the middle band are made of silicone.

REJECTION²

Claims 6–8 are rejected under 35 U.S.C. § 103 as unpatentable over Chen, West, and Baker.³ Non-Final Act. 5–7.

ANALYSIS

The dispositive issue in this case relates to the requirement of independent claim 6 that “an opening of the channel at the surface of the circumferential inner edge of each outer band is a widest part of the channel.”

The Examiner finds that Chen discloses a three band ring (ring 10) having first and second outer bands (hard metal elements 12) and a middle band (metal body 11).⁴ Non-Final Act. 5. Figure 2 of Chen follows.

² In the Non-Final Office Action, the Examiner also rejected claims 6–8 under 35 U.S.C. § 112(b) as indefinite. Non-Final Act. 4. The Examiner withdrew this rejection in the Answer. Ans. 3.

³ Chen (US 2009/0038339 A1, published Feb. 12, 2009); West (US 2004/0020242 A1, published Feb. 5, 2004); Baker et al. (US 2016/0345692 A1, published Dec. 1, 2016).

⁴ Parentheticals use Chen’s nomenclature for the corresponding claim structure.

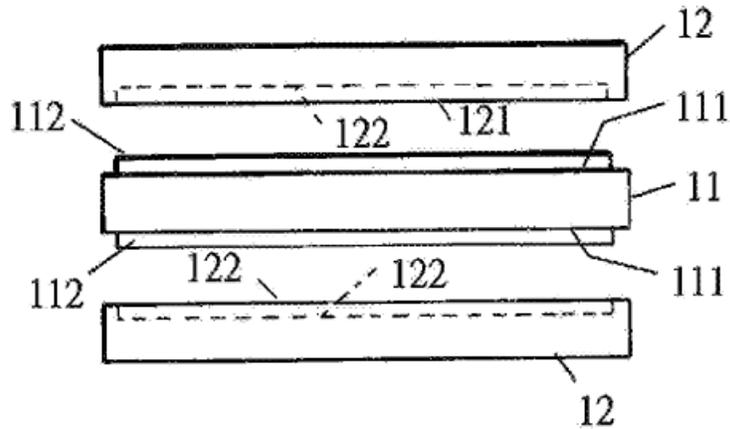


FIG2

Figure 2 of Chen is an exploded view of ring 10. Chen ¶ 9.

The Examiner finds that Chen's outer bands (hard metal elements 12) include a channel (latch trough 122) in a circumferential inner edge. Non-Final Act. 5. Figure 4 of Chen follows.

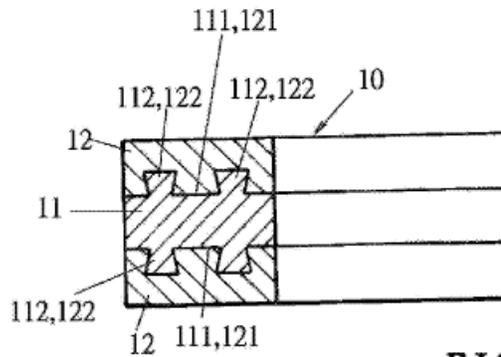


FIG4

Figure 4 of Chen is a cross sectional view of ring 10. Chen ¶ 11. Each outer band (hard metal body 12) has a channel (latch trough 122) formed in axially-facing coupling surface 121. *Id.* Chen's middle band (metal body

11) has first and second ridge portions (turtledove-tail shaped annular latch flanges 112) projecting from opposed, axially-facing coupling surfaces 111. Chen ¶ 14; Fig. 4. When the middle band (metal body 11) and the outer bands (hard metal elements 12) are aligned and pressed together, the first and second ridge portions (latch flanges 112) deform so as to fill the corresponding channel (latch trough 122) to secure the bodies together. Chen ¶ 15.

The Examiner acknowledges that the openings of Chen's channels (latch troughs 122) at the surface of the circumferential inner edge of each outer band (hard metal element 12) are the narrowest part of the channel, while in contrast claim 6 requires the openings to be the widest part of the channel. Non-Final Act. 5.

The Examiner concludes that it would have been obvious to modify Chen's channels (latch troughs 122) so that the openings at the surface of the circumferential inner edge of each outer band (hard metal element 12) are the widest part of the respective channel. Non-Final Act. 6. In support of this, the Examiner asserts that Chen discloses that the first and second ridge portions (latch flanges 112) may be shapes other than turtledove-tail shaped so long as the inner and outer bands (metal body 11 and hard metal elements 12) are made of alternating soft and hard material and provide a compression or friction fit. Non-Final Act. 6–7. The Examiner further reasons that: (1) a change in shape is a matter of design choice, and (2) other shapes are known equivalents used for the same purpose. Non-Final Act. 7 (citing MPEP §§ 2144.04(IV)(B), 2144.06(I), respectively).

The Examiner mischaracterizes the reference. Chen does not disclose that any shape that provides a friction fit will work. Rather, Chen discloses

that the first and second ridge portions (latch flanges 112) of the middle band (metal body 11) may have a shape other than a turtledove-tail shape, “such as a narrower front side and [a] wider rear side . . . as long as they can achieve the coupling effect.” Chen ¶ 17. Given that the shape of the first and second ridge portions (latch flanges 112) is the inverse of the channels (latch troughs 122), Chen’s disclosure means that the opening of the channels (latch troughs 122) must be widest at the rear side, that is, the end opposite the circumferential inner edge of each outer band (hard metal element 12). The C-shape of the channels (latch troughs 122) depicted in Figure 5 of Chen is consistent with a shape that is narrower at the opening of the channel at the surface of the circumferential inner edge of each outer band (hard metal element 12).

Further, the Examiner’s conclusion that the shape of the channels (latch troughs 122) is a matter of obvious design choice as a change in shape is not adequately supported. *See* Non-Final Act. 7. A change of shape is not a patentable distinction where the claimed shape is not of functional significance and accomplishes the same purpose as the prior art shape. *In re Dailey*, 357 F.2d at 672–73; MPEP § 2144.04(IV)(B). Such is not the case here. The shape of Chen’s channels (latch troughs 122) and ridge portions (latch flanges 112) is of functional significance because it bonds the inner and outer bands (metal body 11 and hard metal elements 12) together by a friction fit provided by the opening of the channel (latch trough 122) being narrower than the opposing end thereof. Chen ¶¶ 15, 17; *see also In re Gal*, 980 F.2d 717, 719 (Fed. Cir. 1992) (determination of obvious design choice precluded when claimed structure and the function it performs are different from the prior art). As detailed above, not any shape will work, the channel

(latch trough 122) must be widest at the end opposite the circumferential inner edge of each outer band (hard metal element 12). For similar reasons, the shape of Chen’s channel (latch trough 122) and the claimed channel are not known equivalents. *See* MPEP § 2144.06(I).

We agree with Appellant that the Examiner’s findings and reasoning are not persuasive because the Examiner has not shown that Chen, West, and Baker would have resulted in “wherein an opening of the channel at the surface of the circumferential inner edge of each outer band is a widest part of the channel,” as recited in claim 6. *See* Appeal Br. 15–16, 18; Reply Br. 4. We do not sustain the rejection of claims 6–8 under 35 U.S.C. § 103 as unpatentable over Chen, West, and Baker.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference/Basis	Affirmed	Reversed
6–8	103	Chen, West, Baker		6–8

REVERSED