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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,160	08/09/2006	5853826	8302-021	8332

22859            7590            05/22/2007

INTELLECTUAL PROPERTY GROUP  
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MINNEAPOLIS, MN 55402

EXAMINER *aw*

*Stephen Stein*

ART UNIT            PAPER NUMBER

*3991*

*IFW*

DATE MAILED: 05/22/2007

Please find below and/or attached an Office communication concerning this application or proceeding.



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## **EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/008,160.

PATENT NO. 5853826.

ART UNIT 3991.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

**Notice of Intent to Issue  
Ex Parte Reexamination Certificate**

Control No.

90/008,160

Patent Under Reexamination

5853826

Examiner

Stephen J. Stein

Art Unit

3991

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

1.  Prosecution on the merits is (or remains) closed in this *ex parte* reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office or upon petition. Cf. 37 CFR 1.313(a). A Certificate will be issued in view of

- (a)  Patent owner's communication(s) filed: 02 April 2007 and 19 April 2007.
- (b)  Patent owner's late response filed: \_\_\_\_\_.
- (c)  Patent owner's failure to file an appropriate response to the Office action mailed: \_\_\_\_\_.
- (d)  Patent owner's failure to timely file an Appeal Brief (37 CFR 41.31).
- (e)  Other: \_\_\_\_\_.

Status of *Ex Parte* Reexamination:

- (f) Change in the Specification:  Yes  No
- (g) Change in the Drawing(s):  Yes  No
- (h) Status of the Claim(s):

- (1) Patent claim(s) confirmed: \_\_\_\_\_.
- (2) Patent claim(s) amended (including dependent on amended claim(s)): 1,4,5,8,9,12,13 and 16
- (3) Patent claim(s) cancelled: 2,3,6,7,10,11,14 and 15.
- (4) Newly presented claim(s) patentable: 17-35.
- (5) Newly presented cancelled claims: \_\_\_\_\_.

2.  Note the attached statement of reasons for patentability and/or confirmation. Any comments considered necessary by patent owner regarding reasons for patentability and/or confirmation must be submitted promptly to avoid processing delays. Such submission(s) should be labeled: "Comments On Statement of Reasons for Patentability and/or Confirmation."

3.  Note attached NOTICE OF REFERENCES CITED (PTO-892).

4.  Note attached LIST OF REFERENCES CITED (PTO/SB/08). (2 pages)

5.  The drawing correction request filed on \_\_\_\_\_ is:  approved  disapproved.

6.  Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).


- a)  All b)  Some\* c)  None of the certified copies have
  - been received.
  - not been received.
  - been filed in Application No. \_\_\_\_\_.
  - been filed in reexamination Control No. \_\_\_\_\_.
  - been received by the International Bureau in PCT Application No. \_\_\_\_\_.


\* Certified copies not received: \_\_\_\_\_.


7.  Note attached Examiner's Amendment.

8.  Note attached Interview Summary (PTO-474).

9.  Other: \_\_\_\_\_.

  
KILEY STONER  
CRU EXAMINER-AU 3991

  
DEBORAH D. JONES  
SPRE-AU 3991  
CENTRAL REEXAMINATION UNIT

  
Stephen J Stein  
Primary Examiner  
Art Unit: 3991

cc: Requester (if third party requester)

U.S. Patent and Trademark Office  
PTOL-469 (Rev.08-06)

Notice of Intent to Issue Ex Parte Reexamination Certificate

Part of Paper No 20070503

**REEXAMINATION**  
**REASONS FOR PATENTABILITY / CONFIRMATION**

Reexamination Control No. 90/008,160

Attachment to Paper No. 20070503.


Art Unit 3991.


  
STEPHEN J. STEIN  
CRU EXAMINER - AU 3991

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(Examiner's Signature)

PTOL-476 (Rev. 03-98)

  
DEBORAH D. JONES  
SPRE-AU 3991  
CENTRAL REEXAMINATION UNIT

  
KILEY STONER  
CRU EXAMINER-AU 3991

***Reexamination***

1. This is a Notice of Intent to Issues Ex parte Reexamination Certificate (NIRC) in the Reexamination proceeding of U.S. 5,853,826 issued on December 29, 1998 to Strareke et al. ('826 patent). The application on which the patent was granted was filed on April 29, 1996.

***Summary of the Proceeding***

August 9, 2006 - a request for ex parte reexamination of claims 1-16 of U.S. Patent 5,853,826 (Starcke et al.) was filed by the patent owner.

October 17, 2006 - an order granting reexamination was mailed.

January 25, 2007 - the patent owner filed an information disclosure statement.

January 31, 2007 - a first non-final office action was mailed.

February 22, 2007 - patent owner's representatives conducted an interview with the examiner.

April 2, 2007 - patent owner submitted a response the non-final office action and an amendment to the claims.

April 19, 2007 - patent owner submitted a supplemental information disclosure statement.

***Confirmation/Allowance of Claims***

2. Amended claims 1, 4, 5, 8, 9, 12, 13 and 16 and new claims 17-35 are patentable over the prior art of record.

**STATEMENT OF REASONS FOR PATENTABILITY AND/OR CONFIRMATION**

The following is an examiner's statement of reasons for patentability and/or confirmation of the claims found patentable in this reexamination proceeding:

The prior art of record fails to teach or suggest:

“A method for enhancing optical properties of a decorative object being composed primarily of a transparent or translucent substrate, the substrate being a gemstone, the gemstone having a pavilion and a top, the method comprising the step of selectively vapor-coating a part of the surface of the gemstone with a first layer of a first coating material at a low temperature, wherein said part that is vapor coated is the pavilion of the gemstone, wherein the color of light reflected from the gemstone to a viewer changes with an angle of observation, such that the gemstone has a body color, and the body color when viewed through the gemstone's top from one angle changes to another color when viewed through the gemstone's top from a different angle” as recited in independent claim 1.

The prior art of record further fails to teach or suggest:

“A decorative object comprising a transparent or translucent substrate, the substrate being a gemstone having a pavilion and a top, wherein a part of the surface of the gemstone is vapor-coated with a first layer of material, wherein said part that is vapor-coated is the pavilion of the gemstone, the gemstone's top being uncoated, wherein the color of light reflected from the gemstone to a viewer changes with an angle of observation, such that the gemstone has a body color, and the body color when viewed through the gemstone's top from one angle changes to another color when viewed through the gemstone's top from a different angle” as recited in independent claim 9.

The primary reasons for allowance are patent owner's arguments in conjunction with the amendments to independent claims 1 and 9 and in which patent owner amended the claims to recite the limitation that the transparent or translucent substrate is a “gemstone having a pavilion and a top” and the limitation that the “gemstone has a body color when viewed through the

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gemstone's top from one angle to change to another color when viewed through the gemstone's top from a different angle".

With regard to U.S. Patent 3,490,250 (Jones), Jones discloses a method of enhancing jewel stones by coating the jewel stone with a material of a greater refractory index in order to "provide pronounced polychromatic effects in response to variations in the angle of incidence of white light commonly known as the characteristic of 'fire'". However, the reference fails to teach or suggest that the gemstone has "a body color which when viewed through the gemstone's top from one angle changes to another color when viewed through the gemstone's top from a different angle" as recited in amended claims 1 and 9. Patent owner argued that the term "fire" is well known in the diamond industry and points to the '826 patent, as defining the term fire as being:

"'Fire' of a diamond caused by the amount of the amount of dispersed light which leaves the stone after reflection and refraction. Dispersion is the separating of the white light into the spectral colors. A ray of light passing through the sloped face of a prism will split up into the various spectral colors. When a ray of light is totally reflected from the base facets and strikes the table or ground facets at the greatest possible angle, dispersion is at its greatest. This is one reason why diamond viewing is so enjoyed. It is a visual light show, when the viewer's eye or the cut diamond is moved relative to one another." (See US Patent 5,657,646, column 2, lines 37-50).

Patent owner further argued that the property of "fire" is fundamentally different than the property of "body color" which is known in the gemstone industry as color throughout the body of the gemstone.<sup>1</sup> Consequently, patent owner's argument in conjunction with the amendment to

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<sup>1</sup> Patent owner additionally submitted a rule 1.132 affidavit to provide a meaning of the term "fire" and "body color" as used in conjunction with gemstones. This affidavit was deficient for failing to meet the formal requirements of 37 CFR 1.68, however, patent owner's arguments in conjunction with a reading of the prior art as to the meaning of the terms was deemed persuasive so as to distinguish the terms.

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independent claims 1 and 9 that Jones' teaching of varying thickness and selective character of the coating to produce polychromatic color effects characteristic of "fire" is not equivalent the claimed limitation of "a body color which when viewed through the gemstone's top from one angle changes to another color when viewed through the gemstone's top from a different angle" is deemed persuasive and the rejections over the Jones reference have been withdrawn.

With regard to EP 0248525 (Greenlees '525), the reference discloses a method of coating a decorative faceted transparent material by applying a dichroic material for use as bar and restaurant illuminated displays, such that the color will change vary with the angle of transmitted light. Greenlees '525 further provides an embodiment in which two faceted couplets are joined together to form a decorative object in the shape of a diamond, however, Greenlees '525 fails to disclose or suggest that the coated decorative object is an actual gemstone as recited in amended claims 1 and 9. Patent owner's arguments regarding a teaching away in Greenlees '525 of modifying it's teachings to coat the pavilion of an actual gemstone as claimed in amended claims 1 and 9 was deemed persuasive and the rejections over the Greenlees '525 reference have been withdrawn.

#### **NOTICE RE PATENT OWNER'S CORRESPONDENCE ADDRESS**

3. Effective May 16, 2007, 37 CFR 1.33(c) has been revised to provide that:

The patent owner's correspondence address for all communications in an *ex parte* reexamination or an *inter partes* reexamination is designated as the correspondence address of the patent.

*Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination, 72 FR 18892 (April 16, 2007)(Final Rule)*

**The correspondence address for any pending reexamination proceeding not having the same correspondence address as that of the patent is, by way of this revision to 37 CFR 1.33(c), automatically changed to that of the patent file as of the effective date.**



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This change is effective for any reexamination proceeding which is pending before the Office as of May 16, 2007, including the present reexamination proceeding, and to any reexamination proceeding which is filed after that date.

Parties are to take this change into account when filing papers, and direct communications accordingly.

In the event the patent owner's correspondence address listed in the papers (record) for the present proceeding is different from the correspondence address of the patent, it is strongly encouraged that the patent owner affirmatively file a Notification of Change of Correspondence Address in the reexamination proceeding and/or the patent (depending on which address patent owner desires), to conform the address of the proceeding with that of the patent and to clarify the record as to which address should be used for correspondence.

Telephone Numbers for reexamination inquiries:

Reexamination and Amendment Practice	(571) 272-7703
Central Reexam Unit (CRU)	(571) 272-7705
Reexamination Facsimile Transmission No.	(571) 273-9900

#### *Future Correspondence*

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Stein whose telephone number is 571-272-1544. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m. If the attempts to reach the examiner are unsuccessful, the examiner's supervisor, Deborah Jones can be reached by dialing 571-272-1535. The official fax number for the organization where this application is assigned is 571-273-9900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

All correspondence relating to this *ex parte* reexamination proceeding should be directed as follows:

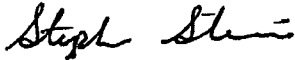
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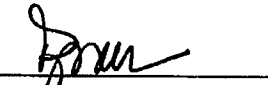
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May 7, 2007



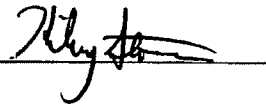
Stephen J. Stein  
Primary Examiner  
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Conferee



DEBORAH D. JONES  
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