

The opinion in support of the decision being entered today was *not* written for publication in a law journal and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ROBERT E. PAGE, JR.

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Appeal 2006-2601  
Application 10/364,286  
Technology Center 1700

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Decided: August 31, 2006

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Before KIMLIN, GARRIS, and FRANKLIN, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-41. Claims 1 and 5 are illustrative:

1. A synthetic gem comprising elements recovered from human remains.
5. A method of making a synthetic gem comprising elements recovered from human remains comprising the steps of: a) cremating human remains to produce carbon; b) filtering the carbon; c) purifying the carbon;

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d) graphitizing the carbon; and e) creating gems using crystal growth sublimation.

In addition to the admitted prior art found in Appellant's Specification, the Examiner relies upon the following references as evidence of obviousness:

Rieve	US 3,454,363	July 8, 1969
Sumiya	US 5,908,503	Jun. 1, 1999

Phyllis Gillespie, *If You Carat All: Pair Offer to Make Diamonds From Loved One's Ashes*, The Arizona Republic, Aug. 29, 1988 at B1.

Appellant's claimed invention is directed to a synthetic gem made of elements recovered from human remains by cremation.

Appealed claims 1-4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sumiya. Claims 5-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gillespie in view of the admitted prior art.

We have thoroughly reviewed each of Appellant's arguments for patentability. However, we find that the Examiner's rejections are well-founded and in accordance with current patent jurisprudence. Accordingly, we will sustain the Examiner's rejections for the reasons set forth in the Answer, which we incorporate herein, and we add the following for emphasis only.

Appellant submits at page 3 of the principal Brief that the following groups of claims stand or fall together: (I) claims 1 and 2, (II) claims 3 and 4, and (III) claims 5-41.

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We consider first the Examiner's § 102 rejection of claims 1-4 over Sumiya. We concur with the Examiner that the claimed synthetic gem that comprises elements recovered from human remains is described within the meaning of § 102 by Sumiya. Both the claimed synthetic gem and the synthetic diamond of Sumiya comprise elemental carbon and, as explained by the Examiner, there is no distinction whatsoever in elemental carbon recovered from human remains or derived from any other source. Simply put, carbon is carbon. While Appellant maintains that the principles for examining product-by-process claims do not apply to appealed claims 1-4 because they are not product-by-process claims, we do not agree. The claim recitation "recovered from human remains" is a process step which defines how the elements of the synthetic gem are derived. In any event, even if claims 1-4 on appeal are not classical product-by-process claims, it is well settled that when a claimed product reasonably appears to be substantially the same as a product disclosed by the prior art, the burden is on the Applicant to prove that the prior art product does not necessarily or inherently possess characteristics attributed to the claimed product. *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977); *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980). In the present case, it is incumbent upon Appellant to establish that there is, in fact, some difference in composition or structure between gems within the scope of claims 1-4 and gems reasonably described by Sumiya. However, as

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pointed out by the Examiner, Appellant has failed to point to any such difference, let alone establish such by way of evidence. Accordingly, Appellant has not rebutted the Examiner's prima facie case of anticipation of claims 1-4 by Sumiya.

Turning to the Examiner's § 103 rejection of claims 5-41 over Gillespie in view of the admitted prior art, Gillespie evidences that the concept of making synthetic gems from human remains was known in the art at the time of filing the present application. The admitted prior art establishes that the claimed process of cremation, including filtering, collecting, and purifying the remains, was known in the art. Also, it was admittedly known how to graphitize carbon and create gems using crystal growth sublimation. Accordingly, we agree with the Examiner that it would have been obvious for one of ordinary skill in the art to use any source of carbon, such as the cremated human remains discussed by Gillespie, in the known process of forming synthetic gems from carbon. We do not subscribe to Appellant's argument that Gillespie is non-enabling for the process of synthetically making gems from human remains. We are convinced that one of ordinary skill in the art of making synthetic gems from elemental carbon would have been enabled in the preparation of synthetic gems from the human remains discussed by Gillespie. Once it was known in the art to make synthetic gems from elemental carbon, one of ordinary skill in the art would be able to derive and recover carbon from any organic matter and make synthetic gems therefrom.

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As a final point, we note that Appellant bases no argument upon objective evidence of nonobviousness, such as unexpected results, which would serve to rebut the prima facie case of obviousness established by the Examiner.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

AFFIRMED

clj

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