

The opinion in support of the decision being entered today  
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* SHERRE S. MCMAHON

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Appeal 2007-2227  
Application 10/778,963  
Technology Center 3600

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Decided: August 27, 2007

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Before DEMETRA J. MILLS, LORA M. GREEN, and RICHARD M. LEBOVITZ, *Administrative Patent Judges*.

MILLS, *Administrative Patent Judge*.

**DECISION ON APPEAL**

The Appellant appeals the Examiner's final rejection of claims 1-13 for obviousness. We have jurisdiction under 35 U.S.C. § 6(b) (2006). Claims 1 and 11 are representative and read as follows:

1. An extension for use with a necklace comprising:  
(a) said extension being of an unitary construction and including a body with a center region with a pair of opposed, side by side and reversed mirrored spiral regions extending from opposite ends of said center region; each of said spiral

regions spiraling inwardly with a continuously decreasing radius for greater than one full revolution; each of said spiral regions being sufficiently large and being sized and shaped so as to be adapted to join with either spiral region of another extension such that both of said extensions lay relatively flat with respect to each other.

11. A method of extending a necklace comprising the steps of:
  - (a) providing a necklace with connectors at opposite ends thereof;
  - (b) providing first and second discretely interconnectable extensions of generally equal size and shape with relatively large connecting spirals of generally equal size on each end thereof ;
  - (c) joining a first end of said necklace;
  - (d) joining a second end of said first extension to a first end of said second extension;
  - (e) joining a second end of said second extension with said necklace second connector.

Cited References:

Cayton	US 5,669,242	Sept. 23, 1997
Cloud	US 5,184,482	Feb. 9, 1993

Grounds of Rejection

Claims 1-13 stand rejected under 35 U.S.C. § 103(a) as obvious over Cayton in view of Cloud.

DISCUSSION

Claims 1-13 stand rejected under 35 U.S.C. § 103(a) as obvious over Cayton in view of Cloud. As Appellant did not argue the dependent claims separately, they stand or fall with the independent claim on which they depend. We thus focus our analysis on independent claims 1 and 11. 37 CFR § 41.37(c)(1)(vii) (2006).

The Examiner finds “that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains”. (Answer 3.)

With respect to claim 1, the Examiner finds

Cayton teaches of an extension (22,24) for use with a necklace (12,20) comprising: said extension (22) being of an unitary construction and including a body with a center region (26) with a pair of opposed, side by side spiral regions (30, 38) extending from opposite ends of said center region (26); each of said spiral regions (30, 38) spiraling inwardly with a continuously decreasing radius; each of said spiral regions (30, 38) being sufficiently large and being sized and shaped so as to [be adapted] to join with either spiral region (32,40) of another extension (24).

((*Id.*) (modification in original).)

The Examiner recognizes

[t]he difference between the claim and Cayton is that Cayton does not expressly disclose that the side by side spiral regions (30, 38) are reverse mirrored spiral regions; that said spiral regions (30,38) have a decreasing radius for greater than one full revolution; and that both of said extensions (22) will lay flat with respect to each other when they are joined together.

(*Id.* at 4.)

The Examiner relies on Cloud for its disclosure of

(Figs. 32-34) various spiral regions (162,164,168,170,174,176), the structures of which allow interlocking between said spiral regions to help fasten free ends of an ornamental loop. In addition, Cloud discloses that said spiral regions (162,164) have a decreasing radius for greater than one full revolution; and that both of said extensions will lay flat with respect to each other when they are joined together (Figs. 32-34). At the time of invention, it would have been obvious to one having ordinary skill in the art, having the disclosures of Cayton and Cloud before him at the time the invention was made, to modify

the shape or pattern of the spiral regions (30,38) of Cayton for the spiral region (162) as shown by Cloud in Figs. 32-34. One would be motivated to make such a combination because one would want to achieve that exact shape or design of spiral region as shown by Cloud in addition to the ability of said shape of said spiral region being able to be interconnect with another of said spiral region as shown by Cloud in Figs. 32-34 creating that exact type of fastening relationship between said spiral regions.

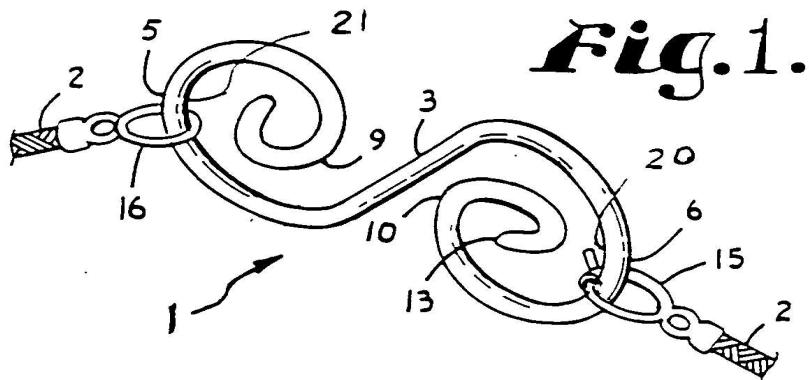
(*Id.*)

The Examiner concludes

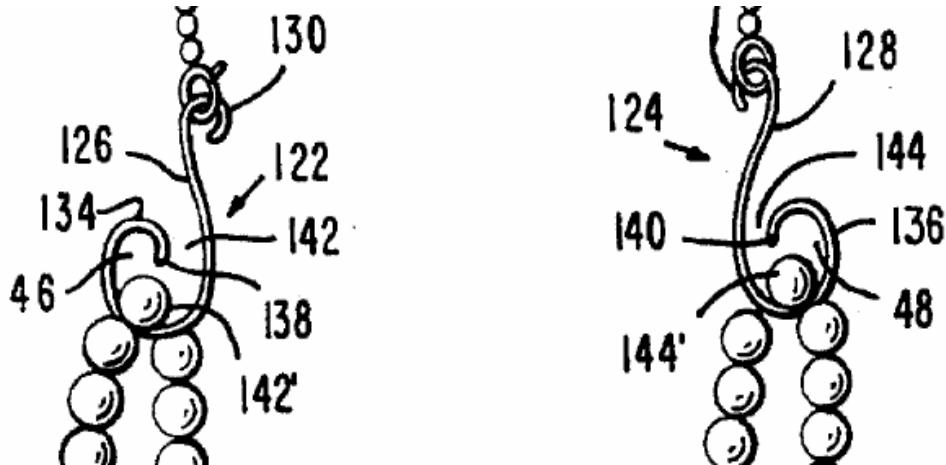
one only needs to modify the structure of both the spiral regions (30,38) of Cayton to emulate the spiral region (162) of Cloud to have a structure that discloses side by side reverse mirrored spiral regions having a decreasing radius for greater than one full revolution, with said extension being adapted to join another extension and lay flat with respect to each other when joined.

(*Id.*)

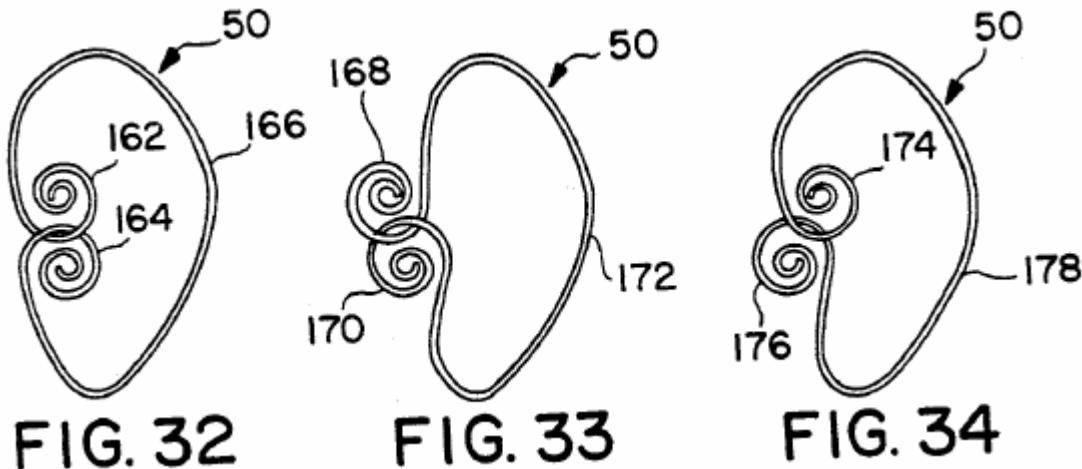
Appellant argues neither Cayton nor Cloud teach a pair of reverse image and side by side spirals that are joined at a center and extend outwardly from opposite sides of the center. (Br. 9.)



Appellant's Fig. 1, which shows a fragmentary perspective view of a necklace extension in the shape of the letter "S" which represents an embodiment of the claimed invention (Specification 6), appears above.



A portion of Fig. 2 of Cayton, which depicts a necklace extension in the shape of the letter "S" where the top of the "S" is smaller than the bottom of the "S," appears above.



Figures 32 to 34 of Cloud, depicting ear ornaments showing mirror image spirals, appear above.

More specifically, Appellant argues that "[t]he Cayton hooks have a large spiral on one side and a small tight loop (connectors 30 and 32) on the other side," thus "[i]t is clear from the disclosure that the hooks and chain construction of

Cayton are designed to be used together as a single extension of a fixed length."

(Br. 8.) Appellant also urges:

The Cloud references teaches ear art in Figs. 32 to 34. In Fig. 32, the Cloud ear art includes a long wire in a loop 166 joining two hooks 162 and 164 that have large spirals and are joined together to form a loop 50. In Cloud there are spirals, but the spirals are not side by side joined at a center and extending in opposite directions therefrom. On the contrary, in Cloud the loops are greatly spaced from one another along the connecting wire and do not extend in opposite directions, but rather toward each other. In Cloud the spirals are joined with each other, . . . and not with any other structure nor is such suggested. It is especially noted that the Cloud devices are of a fixed length, are not intended to be used as an extension for anything else and teach spirals that are joined to each other on a single device rather than being joined to another device or another structure such as a necklace.

(Br. 8-9).

The ultimate determination of whether an invention would have been obvious is a legal conclusion based on the totality of the evidence.

*Richardson-Vicks Inc. v. Upjohn Co.*, 122 F.3d 1476, 1483, 44 USPQ2d 1181, 1187 (Fed. Cir. 1997). The underlying factual inquiries to an obviousness determination include: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *See Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); *In re Dembicza*k, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999). “[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious” the relevant question is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *KSR Int’l Co. v. Teleflex Inc.*, 127 Ct. 1727, 82 USPQ2d 1385 (2007). Moreover, in *Gardner v. TEC Sys., Inc.*, 725 F.2d 1338, 1345, 220 USPQ 777, 783 (Fed. Cir. 1984), the

Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. Upon review of the spiral shaped necklace extension of Cayton, it would reasonably appear that the claimed spiral shaped necklace extension is merely a predictable use of a prior art element according to its established function for extending a necklace length.

In the present case, we find that the necklace extension device of Cayton is similar to that of the claimed invention except the “top” spiral (as shown in Figure 2, reproduced above) is shorter and of a smaller size than the “bottom” spiral and thus not a mirror image of the top bottom spiral. In Figure 2 of Cayton, as is clear from the drawing, the top, smaller spiral is open and can accommodate additional necklace chains. We further find that it would have been obvious to one of ordinary skill in the art to extend the length (size) of the top, small spiral of Cayton to the length and shape of the bottom, large spiral of Cayton to form a mirror image of the bottom spiral to further accommodate multiple necklace chains, as an alternative design available and known in the prior art. In addition, Cloud, although an earring jewelry piece, also reflects that a larger spiral is a known design available to the ordinary designer in the jewelry art.

At best, we find that Appellant has merely extended the size of the smaller, top spiral of Cayton and that this change in size does not perform differently than the opposing larger spiral disclosed in Cayton. Both spirals perform equivalently in Cayton. The larger spiral at the bottom of the necklace extension of Cayton is a design known to one of ordinary skill in the necklace extension art. The larger and smaller spirals function equivalently in Cayton as attaching means to the necklace.

Moreover, Cayton specifically states that the “‘hook means,’ as used herein, is to be construed to include all structures described” and useable as equivalents. Col. 7, line 32-36. Further, Cayton stated that the hook means may be defined by alternative structures able to releaseably ensnare respective portions of a base necklace, thus providing an express suggestion that alternative structures could be used. Col. 7, ll. 20-26.

In view of the above, Appellant's argument that Cayton and Cloud do not disclose mirror image spirals in claim 1 is not persuasive, and we affirm the rejection of claim 1.

### Claim 11

Claim 11 requires joining multiple extensions essentially of the size and shape presented in claim 1. See claim 11, *supra*.

Appellant argues that “[n]either reference teaches the use of multiple discrete extensions.” (Br. 10-11.)

As pointed out by the Examiner, Cayton “does indeed teach of using multiple discrete extensions . . . he, however, does not expressly teach that said extensions . . . can be directly attached to one another” (Answer 12). This is shown in Fig. 3 of Cayton (*see* Cayton, col. 7, ll. 1-18). In our opinion, the skilled worker would have recognized that other arrangements, in addition to that shown in Fig. 3, could be utilized to achieve the same purpose in extending the length of the necklace (Cayton, at col. 1, ll. 10-15), including arrangements where the extensions are directly connected as required by claim 11. Furthermore, “[i]t is well settled that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced.” *In re Harza*, 274 F.2d 669, 671, 124 USPQ 378, 380 (CCPA 1960). In the present case, the duplication of the necklace

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extension merely provides a further performance of the known original function of a single necklace extension. Thus, we find that the mere duplication of the necklace extension part provides no new and unexpected result. Furthermore, the aesthetic quality conveyed of duplication of the necklace extension is found in Cloud, disclosing the use of multiple spirals in the jewelry art is well known aesthetic choice to the ordinary designer. In view of the above, the rejection of claim 11 over Cayton and Cloud is affirmed.

#### CONCLUSION

The obviousness rejection of claims 1-13 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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