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**Diamond Innovations, LLC, A Limited Liability Company Of The United States Of America, Of 4 Creek Road, Great Neck, New York 11024, United States Of America Vs Controller Of Patents & Designs, Boudhik Sampada Bhawan, CP-2, Sector-V, Salt Lake, Bidhannagar, Kolkata - 70091, The Assistant Controller Of Patents & Designs, Boudhik Sampada Bhawan, CP-2, Sector-V, Salt Lake, Bidhannagar, Kolkata - 70091 And The Examiner Of Patents & Designs, Boudhik Sampada Bhawan, CP-2, Sector-V, Salt Lake, Bidhannagar, Kolkata “ 70091**

**M.P. No. 58/2010 In OA/19/2009/PT/KOL And OA/19/2009/PT/KOL**

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**Court:** Intellectual Property Appellate Board, Chennai

**Date of Decision:** Aug. 10, 2011

**Acts Referred:**

Patents Act, 1970 “ Section 2(1)(j), 2(1)(ja), 3(1), 117A Trade And Merchandise Marks Act, 1958 “ Section 2(1)(v)#Copyright Act, 1957 “ Section 2(c)#Indian Penal Code, 1860 “ Section 479

**Citation:** (2011) 3 MIPR 192

**Hon'ble Judges:** Prabha Sridevan, J; D.P.S. Parmar, Technical Member

**Bench:** Division Bench

**Final Decision:** Dismissed

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## **Judgement**

D.P.S. Parmar, Technical Member

1. This appeal is filed under Section 117 A of the Patents Act (hereinafter referred to as the Act) against the order dated 10.06.2009 passed by the

Assistant Controller of Patents & Designs for refusing the grant of patent Application No. 1474/KOLNP/2003 file by Diamond Innovations, LLC, for

invention titled “Faceted Mixed Cut Gemstone for Controlled Brilliance”.

2 . It is submitted by the Appellant that they have filed an application for patent bearing No. 1474/KOLNP/2003 on 12.11.2003 for their invention title

Faceted Mixed Cut Gemstone for Controlled Brilliance"" claiming priorities of the application filed both in USA 60/292,243 dated 18.5.2001 and

09/949,684 dated 10.09.2001. This application is based on the PCT application No. PCT/US02/01495 dated 18.01.2002.

3. The complete specification filed along with the application for the Patent consisted of 50 claims. The claims 1, 2 and 45 were filed as separate

independent claims. The claim 1 in the applicant's complete specification originally filed read as:

1. A mixed cut gemstone comprising:

A girdle in a girdle plane, a crown above said girdle and a pavilion below said girdle, said crown having a girdle break, a table break and a table, said

table break being cut with triangular shaped facets and said girdle break being cut with triangular and quadrilaterals shaped facets, said pavilion having

a width and a length formed by two pairs of opposing pavilion sides and four pavilion corners, said pavilion comprising four steps, including: a first step

adjacent to said girdle and to a first step facet junction, a second step adjacent to said first step facet junction and to a second step facet junction. A

third step adjacent to said second step facet junction and to a third step facet junction, and a fourth step adjacent to said third step facet junction and to

said culet.

The claims 3 to 13, 16 to 43 and 46 to 50 were dependent on claim 1.

The claim 2, an independent claim in the statement of claims in the applicant's complete specification originally filed read:

2. A mixed cut gemstone comprising:

A girdle, a crown above said girdle and a pavilion below said girdle, said crown having a girdle break, a table break and a table, said table break being

cut quadrilaterals shaped facets, said pavilion having a width and a length formed by two pairs of opposing pavilion sides and four pavilion corners, said

pavilion comprising at least two steps, including: a first step adjacent to said girdle and to a first step facet junction, and succeeding steps adjacent to

said first step facet junction and to a culet.

Claims 14, 15 and 44 were dependent on claim 2. Further, the claim 45 an independent claim, read as ""A mixed cut gemstone comprising, a brilliant cut

crown and a step cut pavilion having at least two steps.

4 . In the first statement of objections forwarded by the Respondent 2 to the applicant's agents on 27th February 2006, it was communicated that

The present application describes mixed cut gemstone, which relates to ornamental design of a substance as claimed in claims 1-50 and also does not

fall under the preview of Patents or the application is not fulfilling the criterion to be an invention, hence the instant application is not allowable under

Section 2(1)(j) of the Patents Act 1970.

5 . The agents re-submitted the documents along with there observations on 9th January 2007. In their observation the agent of the applicant submitted

that the claimed subject matter neither attracts Section 2(1)(j) nor Section 3(l) of the Indian Patents Act. Further the claims were revised, with some

voluntary amendments in the description, claims and also in the drawings, where new paragraphs in page 2 of the filed claims. The title was amended

to ""Mixed cut gem stone."" Totally 55 claims were submitted at this stage where the claims 1, 2, 45, 54 and 55 are five independent claims.

6. The revised claim 1 being the principal claim reading as:

A mixed cut gemstone comprising: a girdle in a girdle plane; a crown above said girdle; a pavilion below said girdle; and a culet, said crown having a

girdle break, a table break and a table, said table break being cut with triangular shaped facets and said girdle break being cut with triangular and

quadrilaterals shaped facets, said pavilion having a width and a length formed by two pairs of opposing pavilion sides and four pavilion corners, said

pavilion having; a first step adjacent to said girdle and to a first step facet junction, a second step adjacent to said first step facet junction and to a

second step facet junction, a third step adjacent to said second step facet junction and to a third step facet junction, and a fourth step adjacent to said

third step facet junction and to said culet. Wherein each of said first, second, third and fourth steps further comprise a plurality of facets, and wherein

said plurality of facets of said first step is greater than said plurality of facets of said second step by at least one facet.

The revised claim 2, an independent claim read as:

A mixed cut gemstone comprising: a girdle; a crown above said girdle, said crown having a girdle break, a table break and a table, said table break

being cut with triangular shaped facets and said girdle break being cut with triangular and quadrilaterals shaped facets, and a pavilion below said girdle,

said pavilion having a width and a length formed by two pairs of opposing pavilion sides and four pavilion corners, said pavilion having at least two

steps that comprise: a first of said at least two steps being adjacent to said girdle and to a first step facet junction, and a second or more of said at

least two steps being adjacent to said first step facet junction and to a culet, wherein each step of said at least two steps having a plurality of facets,

and wherein said plurality of facets of said first step is greater than said plurality of facets of said second or more of said at least two steps by at least

one facet."" The claims 14 and 15 are dependent on claim 2. The revised claim 45, another independent claim read as: ""A mixed cut gemstone

comprising: a brilliant cut crown; and a step cut pavilion, said step cut pavilion having at least two steps, said first step being closet to the crown and

having exclusively triangular shaped facets."" Further, the new independent claim 54 read as: ""A diamond comprising: a girdle cushioned in shape; a

crown being positioned adjacent the girdle; and a step cut pavilion being positioned adjacent the girdle opposite the crown, said pavilion having a first

step and a second step, the first step being adjacent the girdle, the first step having more facets than the second step, said first step having exclusively

triangular shaped facets.

The claim 3 to 13, 16 to 44 and 46 to 53 are dependent on claim 1. The new independent claim 55 read as:

A diamond comprising: a girdle; a crown being positioned adjacent the girdle; a step cut pavilion being positioned adjacent the girdle opposite the

crown, said pavilion having three or more steps, wherein the three or more steps have a first step being adjacent the girdle, the first step having at

least one triangular shaped facets, wherein the remaining steps have facets and the same depth, and wherein the first step has more facets than either

one of the remaining steps.

7 . The second statement of objections was communicated by the Respondent No. 2 on 5th February, 2007. In the second statement of objection, the

agents were informed that

the observations offered by them had been carefully considered, but the amended claims 1 to 55 fell within the purview of Section 3(l) of the Act. It

was further pointed out that the alleged invention relates to aesthetic creation, which can not be regarded as patentable subject matter.

8 . The agent of the applicants in their letter dated 26th February, 2007 re-filed the complete specification along with their observations and argued

that the various constructional features of the ""Mixed Cut Gemstone"" have been possible by adopting method or principle construction, hence it's a

patentable subject matter.

9. The Appellant was informed by Respondent 2 vide letter dated 27.4.2007 that the observations offered by them had been carefully considered, but

this Office is of the opinion that the same is not acceptable, therefore the same objections are still maintained under Section 2(1)(j) and Section 3(1) of

the Act, the applicants agent were by this Office letter offered an opportunity of being heard on the 29th May, 2007 on the objections communicated

to them.

10. The matter was heard by Respondent No. 2 and the patent was refused by order dated 10.6.2009. Aggrieved by the order, the Appellant filed this

appeal.

11. The matter came before this Board during the Circuit Bench Sitting at Kolkata on 20. 06.2011. Shri Samaresh Chakraborty appeared on behalf of

the counsel for the Appellant and none represented for the Respondent.

12. The Learned Counsel for the Appellant submitted that the Respondent No. 2 has erred in refusing the instant patent application under Section 2(1)

(j) and Section 3(l) of the Act. Counsel further submitted that the claimed invention pertains to mixed cut gem stone, the essential object whereof is to

provide a combination of brilliance, dispersion and scintillation, and, for such purpose, the Appellant has taken into consideration various aspects of

optics for achieving the resultant effect of reflection and refraction of light caused due to the luminosity functions discharged by the specific

constructional features as selected by the Appellant, for the mixed cut gemstone, defined in the principal claim 1, for ""patent"" protection of such a

unique and hitherto unknown ""Mixed Cut Gemstone"" according to the invention.

13. The Learned Counsel for the Appellant submitted that the Respondent No. 2 has failed to appreciate the fact that the luminosity functions

discharged by the various cuts, angles thereof, and other constructional aspects of the mixed cut gemstone according to the Appellant's invention, as

claimed, are aimed to achieve the unique technical effect of a controlled balance of brilliance, dispersion and scintillation by way of reflection/refraction of light, as and when cast on the said mixed cut gemstone, and such technical effect cannot and shall not be equated with

reflection/refraction of light on any object for visibility and/or mere look thereof, and, that being the case, said technical effect achieved from the

Appellant's claimed mixed cut gemstone cannot be deemed to be regarded as ""aesthetic creation"", as wrongly contended by the Respondent No. 2.

14. The Learned Counsel for the Appellant submitted that the Respondent No. 2 has failed to understand and/or perceive the technical contribution

made by the Appellant to the state of the art in providing various constructional features in the mixed cut gemstone, and which have been specifically

defined in the principal claim 1 of the finally revised set of claim. Such misunderstanding and wrongful contention of the Respondent lead him to

conclude that ""whatever is the constructional feature the end product is nothing but a diamond that gives an aesthetic pleasure to the buyer"", as

mentioned in paragraph 19(a) of the impugned decision.

15 . The Learned Counsel for the Appellant submitted that the Respondent No. 2 ought to have considered the ""mixed cut gemstone"" of the

Appellant's invention, as claimed, to be a patentable subject matter on proper interpretation/construction of the proposition of Law, laid down in I T S

Rubber Ltd's Application (1979) RPC 318, mentioned during the hearing, and referred to by him in paragraph 1.19 on page 18 of the impugned

decision, in as much as, because of the particular structural/constructional features provided in the ""Mixed Cut Gemstone"", as claimed, the resultant

light reflection/refraction effects, described as ""brilliance, dispersion, scintillation, depth"" etc. are maximized, whereby enhanced technical effect of the

claimed product has been possible, that being synonymous to the ""squash ball with blue color - which enhanced visibility (surprising) during play"", as

was allowed in the said case of ""ITS"", as a patentable subject matter, but not as an ""aesthetic creation"".

16. The main issue framed during the hearing was:

1 . The subject matter as claimed in the complete specification is not allowable under Section 2(1)(j) of the Act in so far as the product claimed lacks

any technical effect and

2 . The product claims fall within the excluded category, i.e., the product claims are aesthetic creations.

1 7 . The Appellant argued that in absence of any prior art citation, novelty and inventive step objection under Section 2(1)(j) cannot be raised.

According to him Section 2(1)(j) define the invention and required three criteria novelty, Inventive step and industrial application for qualifying as

invention. The Appellant contended that claimed invention is new and involve inventive step and has an industrial application. Therefore the objection

that the claims 1-50 for the mixed cut gem stones are not allowable under Section 2(1)(j) of the Patents Act, as the application relates to non

patentable invention which relates to ornamental design of a substance is not tenable.

18. The Appellant argued that Section 3(l) objection was raised as fresh objection by the respondent No. 2 stating that ""the alleged invention relates to

aesthetic creation which cannot be regarded as patentable subject matter and the description narrates the invention rather vaguely and in non-

technical manner i.e. the effects of the invention have to be perceived only by viewing the stone.'

19. The Appellant read section the Designs Act 2000 which define the 'designs' as follows

Design"" means only the features of shape, configuration, pattern, ornament o r composition of lines or colors applied to any article whether in two

dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined,

which in the finished article appeal to and are judge solely by the eye; but does not include any mode or principle of construction or anything which is

in substance a mere mechanical device, and does not include any trade mark as defined in Clause (v) of Sub-section (1) of Section 2 of the Trade and

Merchandise Marks Act, 1958 or property mark as defined in Section 479 of the Indian Penal Code or any artistic work as defined in clause (c) of

Section 2 of the Copyright Act, 1957.

The Learned Counsel submitted in (1964 (RPC) 183 in support where it was held that According to the established propositions on law of Designs,

which are also followed here, ""design"" aspects are to be judged solely by the eye, to ensure whether those appeal to the eye, when applied to the

concerned article, in its finished state. If the features of an article, which can be viewed by the eye, are considered to be dictated solely by the

function or functions which the article is to perform, such features cannot constitute the subject matter of a design. It is the established proposition that

a device, the advantage of which resides not in its appearance, but merely in the way it functions, if it is protectable at all, that can be the subject of a

patent, but not a design. According to the counsel it is also clear from the descriptive portion of the specification that, unlike conventional step cut

pavilions comprising three - pavilion steps, the claimed ""gemstone"" of the instant invention has four-pavilion steps that stretch from girdle to culet and

rounded pavilion corners. Moreover, four-pavilion steps are constructionally adopted so, within critical angle of the stone, with a view to maintain the

optical properties of brilliance, dispersion and scintillation. Because of the particular constructional features provided in the claimed gemstone, such

combined effect"" is possible and that is due to the ""functions"", discharged/dictated by such features, in combination, to yield the desire result.

The Appellant further submitted that US patent 7146827 has been granted for the same claims. In supporting his argument he cited two US design

patents and submitted that the present invention is definitely a patentable subject matter but is not meant for registration thereof as design. In view of

the above he argued that the impugned decision is bad in law as well fact and same should be set aside.

Here it is pertinent to note that the Appellant misguided the Respondent No. 2 as he did not inform that the Appellant had already obtained a US

Design Patent D 467,833 dated December 2002 for the same subject matter. It may also be noted that Fig 1-5 are same as in the patent application.

In the design application the Appellant claim read as

I claim the ornamental design for a mixed cut diamond, as shown and described

We do not find his argument correct that the subject matter of the present invention is not meant for registration of design when he himself obtained a

design patent for the same in US.

Further his argument that patent has been granted in US for same claims and hence Respondent No. 2 shall also grant patent is not convincing as

grant of patent is subjected to the national laws. Grant of patent in one country is not binding on the other country. All applications for patents are

examined on the basis of the law of that country. We agree with Respondent 2 in arriving at this conclusion.

20. Two questions which we have to examine in the present appeal are

1. Whether the subject matter as claimed in the complete specification is not allowable under Section 2(1)(j) of the Act in so far as the product

claimed lacks any technical effect and

2 . Whether the product claims fall within the excluded category, i.e., the product claims are aesthetic creations.

2 1 . The Appellant argued that in absence of any prior art citation, novelty and inventive step objection under Section 2(1)(j) cannot be raised does not

hold good in view of the definition of inventive step given in Section 2(1)(ja) reproduced below Inventive step means a feature of an invention that

involve technical advance as compared to existing knowledge ....in the Article

According to the specification the

the instant invention discloses a new coherent design that takes into consideration optical qualities and critical angles in order to create a unique and

valuable stone. let us see what that coherent design is ? According to the summary of invention ....the present invention describes a new diamond cut

that displays a controlled and limited brilliance that highlights the additional qualities of depth hardness and clarity....description further.... However the

present combination of a square or rectangular brilliant cut crown with a modified four -stepped pavilion is unique in the art. The product of this new

hybrid cut is a lively stone whose brilliance is sufficiently controlled so as to allow a view of internal facet structure by creating a window through

which the deep part may be viewed.

The specification further teaches that this invention contemplates a significant change in existing diamond designs that goes beyond addition of new

facets.

The present invention allows the viewer to explore the facets deep in the pavilion of the stone, creating unique viewing experience.

22. Plain reading of the specification suggests that the claimed invention is not technical in nature. It merely illustrates and describes a novel shape of

a diamond with functional features achieved by traditionally cutting the diamond to improve its appearance in beauty. We agree with the conclusion

arrived at by the Respondent No. 2 that it is only an aesthetic creation and hence not patentable under Section 3(l) of the Act.

23. Diamond cutting is the art and skill of changing a diamond from a rough stone into a faceted gem. The product of diamond cutting is a gemstone

that displays a pleasing balance of internal reflections of light known as brilliance, strong and colorful dispersion which is commonly referred to as

fire, " and brightly colored flashes of reflected light known as scintillation. Cut is the human contribution to a diamond's beauty. The argument put forth

by the Appellant that new hybrid cut provided by the invention represents the various constructional features of the diamond and thus qualify as the

technical advance over the existing hybrid cuts does not sound convincing in view of the fact that diamonds are not constructed by cutting. They are

rather improved in appearance by cutting. The basic purpose of cutting the diamonds is to enhance the effect of other three C's viz. carat, clarity and

color to increase its beauty for the viewer. There is no technical contribution in the diamonds claimed by the invention. Final product claimed by the

invention merely describes a novel shape for a diamond and illustrates the functional aspects of cut diamonds which can at best be called as aesthetic

creation which has been rightly disallowed by the Respondent No. 2 under Section 2(1)(j) as lacking technical advancement and non patentable under

Section 3(l) as being aesthetic creation.

24. In view of above analysis and considering all facts and arguments of the Appellant we do not find convincing reason to differ from the conclusion

arrived at by the Respondent No. 2. The appeal is dismissed.