



**Let Your Assets Shine:  
Diamonds, Jewelry, Patents,  
Trademarks™, and  
Copyrights ©**

**By: Neil B. Friedman & Charles Rauch**



# Trademarks are Valuable

- Trademarks are highly valuable assets. According to the 2015 Interbrand® survey, Apple® is the most valuable brand in the world. Among fashion and jewelry brands:
  - LOUIS VUITTON is No. 20,
  - GUCCI is No. 50
  - CARTIER is No. 57
  - TIFFANY & CO. is No. 66.
- In one recent estimate, trademarks account for, on average, one-third of corporate value. Developing and protecting trademarks is not a mere "cost of doing business," but rather an investment in customer goodwill, leading to greater customer satisfaction and higher sales.

# What is a Trademark?

- A trademark is a designation of source of origin that distinguishes the goods of one manufacturer or seller from those of another.
- Practically anything is capable of functioning as a trademark, including.....

## A Word or Words

*Cartier*

Reg. No. 4178047

Registrant: Cartier International AG



Reg. No. 2738380

Registrant: Sterling Jewelers Inc.

## A phrase

“Every Kiss Begins With Kay®”

Registration Number: 2602439

Registrant: Sterling Jewelers Inc.

“ONE DIAMOND FOR YOUR BEST FRIEND. ONE  
DIAMOND FOR YOUR TRUE LOVE.”

Serial No. 86784460

Applicant: Sterling Jewelers Inc.

## A letter or group of letters

- MARK: GIA
- Registration Number  
2809656
- Registrant:  
Gemological Institute  
of America, Inc.

- MARK - 
- Registration Number  
2797645
- Registrant: Tiffany  
(NJ) LLC

## A number or series of numbers

- Mark: **No.7**
- Registrant: Henri Bendel, Inc.
- Reg. No. 4526186



Registrant: ROUSH  
FENWAY RACING, LLC  
Reg. No. 2662012

# Product Configuration Trademark



The mark consists of an open twisted-cable bracelet design with faceted stones at each end. The portions of the bracelet shown in broken lines are intended solely to indicate the positioning of the mark and are not part of the mark. Color is not claimed as a feature of the mark

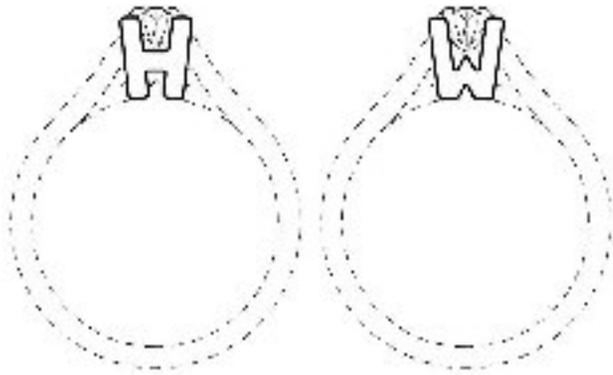
David Yurman IP, LLC  
Reg. NO. 4655095



PENDING APPLICATION – David Yurman IP, LLC

The mark consists of an open twisted-cable bracelet design. At each end is a neck with a diamond-shaped element on the top and oval-shaped elements on the sides. In between the diamond-shaped and oval-shaped elements are two raised beads positioned in an axis parallel to that of the longer axis of the oval. The neck is bordered on each side by two thin circular bands. The portions of the bracelet shown in broken lines are intended solely to indicate the positioning of the mark and are not part of the mark. Further, the materials from which the design is made are not a feature of the mark.

# Product Configuration



The mark consists of three-dimensional configurations of the letters "H" and "W", which respectively are placed on opposite sides of a three-dimensional ring; only the letters "H" and "W", depicted in solid lines, constitute the mark; the rest of the ring, depicted in broken lines, is not part of the mark and serves only to show the position of the mark.

Reg. No. 4252983

Registrant: HARRY WINSTON, INC.

## Color & Packaging



The drawing is lined for the color blue, and color is a feature of the mark. The drawing of the box is outlined in dotted lines.

Reg. No. 2184128

Tiffany (NJ) LLC



The mark consists of a shade of blue often referred to as robin's-egg blue which is used on bags. The matter shown in broken lines represents bags of various sizes and serves to show positioning of the mark. No claim is made to shape of the bags. The drawing is lined for the color blue, and color is a feature of the mark.

Reg. No. 2416795

Registrant: Tiffany (NJ) LLC

# Packaging Trademarks



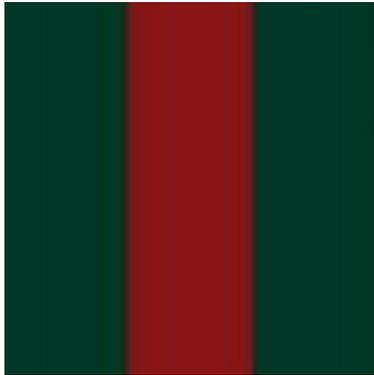
Reg. No. 4197020

Registrant: Cartier International A.G.

The color(s) red and gold is/are claimed as a feature of the mark.

The mark consists of three-dimensional product packaging composed of an 8-sided box and lid in the color red with gold markings. The four corners of the box are chamfered. The top horizontal side of the lid is imprinted with a series of equally-spaced garlands in the color gold, abutting a gold line around the perimeter of the lid. The vertical sides of the packaging feature a gold horizontal chain-like pattern, positioned on the upper sides of the lid and the lower sides of the box. The vertical sides of the packaging also feature a line of gold dots on the lower sides of the lid and the upper sides of the box. The colors red and gold are claimed as features of the mark. The proportional relationship between the width, height, and depth is not a feature of the mark, and the proportional relationship between the height of the lid and height of the box is not a feature of the mark. The proportional relationships are shown in broken or dotted lines, which indicate that they are not a part of the mark.

# Color/Stripes as a Trademark



The color(s) GREEN and RED is/are claimed as a feature of the mark. The mark consists of a stripe containing three distinct bands of color with a red band in the middle of two green bands.

Reg. No. 4567112

Registrant: Gucci America, Inc.

# Steps to Acquire Trademark

1. Select name, logo, mark, etc.
2. Have a competent search undertaken to be sure the selected mark is available and can be used.
3. Prepare and file for trademark protection.
4. Have someone monitor your trademark in the USPTO and potential infringers.
5. Properly maintain your trademark by renewing it at proper intervals. Failure to renew will result in abandonment.

## ® or TM

- ® can only be used when a mark is registered in the USPTO, and only on goods covered by the registration.
- TM has no legal significance.
- **IMPORTANT:** the failure to use ® on goods for which there is a registration may result in the inability to collect damages in the event of an infringement

# Common Trademark Misconceptions

1. Registering a corporate name with the Secretary of State does not confirm trademark rights.
2. Registering a domain name does not confirm trademark rights.

# Remedies for trademark infringement

- **15 USC § 1116**
- Injunctive Relief
  
- **15 USC § 1117**
- (a) Profits; damages and costs; attorney fees
- (b) Treble damages for use of counterfeit mark
- (c) Statutory damages for use of counterfeit marks
  - OR, The plaintiff may elect an award of statutory damages of:
    - (1) not less than \$1,000 or more than \$200,000 per counterfeit mark per type of goods or services sold, offered for sale, or distributed, as the court considers just;
    - or (2) if the court finds that the use of the counterfeit mark was willful, not more than \$2,000,000 per counterfeit mark per type of goods or services sold, offered for sale, or distributed, as the court considers just.

## Top reasons why you should trademark your brand or company name

1. When you register your brand as a trademark it is immediately noticed within the registry of the United States Patent and Trademark Office. When identified it will discourage third parties from adopting or using a trademark that is similar to yours.
2. If someone files for a trademark that is confusingly similar to your trademark, the USPTO attorney examiner will identify your trademark and refuse registration to the confusingly mark. This may result in preventing infringement and there would be no expense to you for the service provided by the USPTO.

## Top reasons why you should trademark your brand or company name

3. A trademark registration is prima facie evidence of validity of the registration, the registrant's ownership of the mark and the registrant's exclusive right to use the mark in commerce.
4. When a trademark registration reaches its 5th year anniversary it becomes incontestable (provided that it was in continuous use). This precludes an attack by third parties on the basis of functionality or descriptiveness. This is extremely helpful when enforcing your trademark rights against would-be infringers.
5. A trademark registration is typically national in scope effective as of the date of your application. This is extremely important because the United States is a first to file vs. first to use jurisdiction. Without a registration, your rights may be limited to your geographic trade area.

## Top reasons why you should trademark your brand or company name

6. The trademark registration owner has the right to use the ® device which puts consumers and your competitors on notice regarding your trademark rights.
7. The trademark registration grants the holder the right to sue in Federal Court regardless of diversity of citizenship and the amount in dispute.
8. A trademark registration provides statutory damages, mandatory treble damages and other penalties in criminal cases (e.g. criminal seizures) without the need to show actual damages.

## Top reasons why you should trademark your brand or company name

9. A registration can be recorded with the U.S. Department of Homeland Security to bar the importation of goods bearing infringement of your trademark.
  
10. A U.S. trademark registration can serve as the basis for filing an International Registration to expand the protection of your trademark into countries where you manufacture and distribute your goods.

# Copyrights

- Copyright (international symbol: ©) is a form of protection provided to authors of “original works of authorship”. It consists of a set of exclusive rights regarding the use of a particular expression of an idea or information.
- In short, it is literally "the right to copy" an original creation. It is also the least expensive form of protection that can be acquired by authors of “original works of authorship.”

## Copyrights – Original works of Authorship include

- Movies;
- Drawings, paintings, works of art;
- Books;
- Music and lyrics;
- Textile and jewelry designs;
- Photographs;
- Computer programs; and
- Architectural works, including blue prints and maps

# Copyrights

- Examples of available Copyrights as it may pertain to the jewelry industry:
  - Jewelry Designs;
  - Product packaging (text, graphics, images, photographs, artwork); and
  - Websites (underlying website code, text, graphics, images, photographs, artwork).

LeVian Corp.

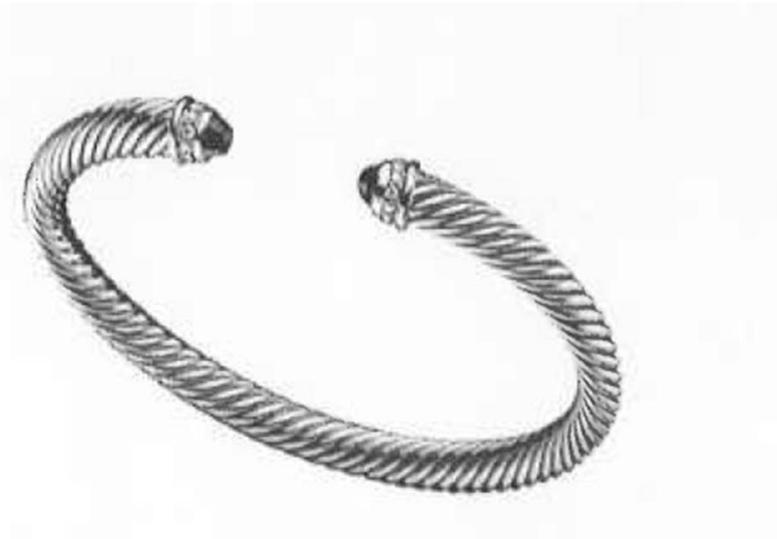


## FANCY TRUFFLE DIAMONDS™

“Princess Alexandra uniquely displays my creative side, embellished with my signature style and artistically realized in Fancy Truffle Diamonds™ designs. As diamonds symbolize eternity and love, so do the styles featured in this grouping.”

# Copyrights

- David Yurman Enterprises LLC
- Example from David Yurman 1993 Collection Reg. No. VAu405-161



# Copyrights

- To establish copyright infringement, a plaintiff must show (1) ownership of a valid copyright and (2) copying by the defendant. Because direct proof of copying is difficult to find, a plaintiff may satisfy the copying element of infringement by showing that the defendant had access to the plaintiff's registered work and **THAT THE DEFENDANT'S WORK IS "SUBSTANTIALLY SIMILAR" TO PLAINTIFF'S.**

# Copyrights

- And what is meant by “substantial similarity”?
- The test for “substantial similarity” is the so-called “ordinary observer test.” That is, whether “an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.

# Copyrights

- The proper form for Notice of Copyright is the symbol ©, or the word “Copyright”, or the abbreviation “Copr.”, followed by the year of first publication of the work, followed by the name of the owner of copyright in the work.
- For example: “© 2013, Walt Disney Corp.”
- The notice should appear on your website, labels, tags, packaging, etc.
- While Copyright Notice is not a requirement to copyright protection, the failure to place Copyright Notice on a work can affect your ability to obtain damages in the event of infringement by a third party.

# Copyright Infringement Remedies

**Provided that you have obtained a copyright registration prior to the infringement, these are some of the remedies available in the event of an infringement.**

1. 17 USC § 502 - Injunction
2. 17 USC § 503 - Impounding and Disposition of Infringing Articles
3. 17 USC § 504 – Damages and Profits or, Statutory Damages; and
4. 17 USC § 505 - Costs and Attorney's Fees

## 17 USC § 504 - DAMAGES AND PROFITS

- **(a) In General.**— Except as otherwise provided by this title, an infringer of copyright is liable for either—
  - **(1)** the copyright owner's actual damages and any additional profits of the infringer, as provided by subsection (b); or
  - **(2)** statutory damages, as provided by subsection (c).
  
- **(c) Statutory Damages.**—
  - **(1)** ...[a]t any time before final judgment is rendered ... instead of actual damages and profits, an award of statutory damages for all infringements involved in the action ... in a sum of not less than \$750 or more than \$30,000 as the court considers just...
  - **(2)** In a case where the copyright owner sustains the burden of proving, and the court finds, that infringement was committed willfully, the court in its discretion may increase the award of statutory damages to a sum of not more than \$150,000. In a case where the infringer sustains the burden of proving, and the court finds, that such infringer was not aware and had no reason to believe that his or her acts constituted an infringement of copyright, the court in its discretion may reduce the award of statutory damages to a sum of not less than \$200...

# The Design Patent “Renaissance”

- Fast, cheap, and “easy” to obtain.
- Difficult to invalidate.
- Scope of protection broader than figures.
- Potential for large damages.

# What is a Design Patent?

- Protect the ornamental aspects of articles—their design, which may consist of three-dimensional features, such as the shape of an article, or of two-dimensional features, such as patterns, lines, or colors. Surface ornamentation is considered a design element.
  - Recognition of design by consumers and/or customer confusion not relevant.
  - Quality of article not relevant.
  - Functional articles can be protected.

# Examples



(12) **United States Design Patent** (10) **Patent No.:** **US D738,777 S**  
**Modi** (45) **Date of Patent:** **\*\* Sep. 15, 2015**

(54) **JEWELRY DESIGN**  
 (71) Applicant: **Nirav Modi, Mumbai (IN)**  
 (72) Inventor: **Nirav Modi, Mumbai (IN)**  
 (\*\*) Term: **15 Years**  
 (21) Appl. No.: **29/526,976**  
 (22) Filed: **May 14, 2015**  
 (51) **LOC (10) Cl.** ..... **11-01**  
 (52) **U.S. Cl.**  
 USPC ..... **D11/89**  
 (58) **Field of Classification Search**  
 USPC ..... D11/1-2, 26-29, 89-92; 63/26-28, 32  
 CPC ..... A44C 17/00  
 See application file for complete search history.

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 U.S. Appl. No. 29/437,759, filed Nov. 20, 2012, Akbari.

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*Primary Examiner* — Ralf Seifert  
 (74) *Attorney, Agent, or Firm* — Andrew F. Young, Esq.;  
 Lackenbach Siegel, LLP

(57) **CLAIM**  
 The ornamental design for a jewelry design, as shown and described.

**DESCRIPTION**

FIG. 1 is a front top perspective view of the present invention.  
 FIG. 2 is a top plan view of FIG. 1.  
 FIG. 3 is a front elevation view of FIG. 1.  
 FIG. 4 is a left side elevation view of FIG. 1.  
 FIG. 5 is a right side elevation view of FIG. 1.  
 FIG. 6 is a rear elevation view of FIG. 1; and  
 FIG. 7 is a bottom elevation view of FIG. 1.  
 The surfaces are lightly lined for contour only.

**1 Claim, 4 Drawing Sheets**

U.S. Patent Sep. 15, 2015 Sheet 2 of 4 US D738,777 S

FIG. 2

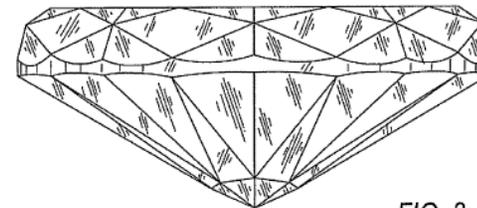
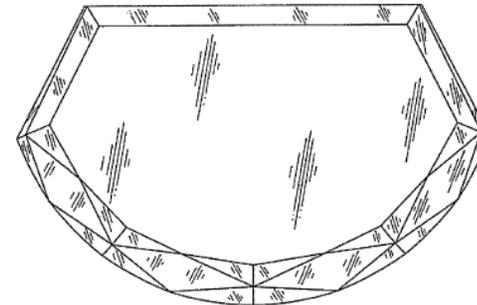
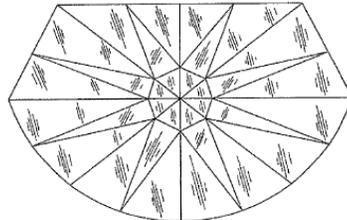
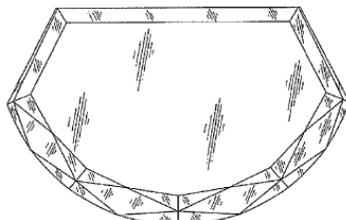


FIG. 3



# Examples



US00D619030S

(12) **United States Design Patent** (10) **Patent No.:** **US D619,030 S**  
**Papadimitriou** (45) **Date of Patent:** **\*\* Jul. 6, 2010**

(54) **EARRING**

(75) Inventor: **Costantino Papadimitriou**, Milan (IT)

(73) Assignee: **De Beers Centenary AG**, Lucerne (CH)

(\*\*) Term: **14 Years**

(21) Appl. No.: **29/341,225**

(22) Filed: **Jul. 31, 2009**

(30) **Foreign Application Priority Data**

Feb. 3, 2009 (EM) ..... 001080881

(51) **LOC (9) CL.** ..... **11-02**

(52) **U.S. CL.** ..... **D11/43**

(58) **Field of Classification Search** ..... D11/1-48;  
 63/12, 13, 14.1-14.8

See application file for complete search history.

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 D157,454 S \* 2/1950 Wheeler ..... D11/26  
 D161,042 S \* 11/1950 Phillippe ..... D11/45  
 D161,747 S \* 1/1951 Grant ..... D11/26  
 D164,165 S \* 8/1951 Grant ..... D11/26  
 D465,173 S \* 11/2002 Gordon ..... D11/26  
 D470,307 S \* 2/2003 McCormack ..... D3/219  
 D491,090 S \* 6/2004 Osinga ..... D11/26  
 D491,091 S \* 6/2004 Osinga ..... D11/26  
 D491,832 S \* 6/2004 Gordon ..... D11/26  
 D567,132 S \* 4/2008 Bulgari ..... D11/43  
 D590,291 S \* 4/2009 Brescia ..... D11/26  
 D595,178 S \* 6/2009 Colombani ..... D11/79  
 D601,913 S \* 10/2009 Cappellieri ..... D11/26  
 D602,799 S \* 10/2009 Colombani ..... D11/3  
 D605,968 S \* 12/2009 Colombani ..... D11/40  
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 Accessed Feb. 24, 2010.\*

(Continued)

*Primary Examiner*—Cathron C Brooks  
*Assistant Examiner*—Melanie Levy  
 (74) *Attorney, Agent, or Firm*—Sonnenschein Nath & Rosenthal LLP; Brian R. McGinley

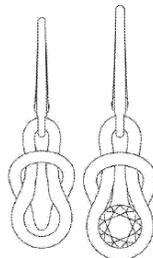
(57) **CLAIM**

The ornamental design for an earring, as shown and described.

**DESCRIPTION**

FIG. 1 is a front view of the earring;  
 FIG. 2 is a rear view of the earring illustrated in FIG. 1;  
 FIG. 3 is a bottom view of the earring illustrated in FIG. 1;  
 FIG. 4 is a top view of the earring illustrated in FIG. 1;  
 FIG. 5 is a right elevational view of the earring illustrated in FIG. 1;  
 FIG. 6 is a left elevational view of the earring illustrated in FIG. 1;  
 FIG. 7 is a front view of an earring illustrating an additional embodiment of the new design;  
 FIG. 8 is a rear view of the earring illustrated in FIG. 7;  
 FIG. 9 is a bottom view of the earring illustrated in FIG. 7;  
 FIG. 10 is a top view of the earring illustrated in FIG. 7;  
 FIG. 11 is a right elevational view of the earring illustrated in FIG. 7; and,  
 FIG. 12 is a left elevational view of the earring illustrated in FIG. 7.

**1 Claim, 4 Drawing Sheets**



US00D627251S

(12) **United States Design Patent** (10) **Patent No.:** **US D627,251 S**  
**Papadimitriou** (45) **Date of Patent:** **\*\* Nov. 16, 2010**

(54) **PAVÉ RING**

(75) Inventor: **Costantino Papadimitriou**, Milan (IT)

(73) Assignee: **De Beers Centenary AG**, Lucerne (CH)

(\*\*) Term: **14 Years**

(21) Appl. No.: **29/342,013**

(22) Filed: **Aug. 17, 2009**

(30) **Foreign Application Priority Data**

Feb. 18, 2009 (EM) ..... 001090377-02

(51) **LOC (9) CL.** ..... **11-01**

(52) **U.S. CL.** ..... **D11/34**

(58) **Field of Classification Search** ..... D11/1-48;  
 63/12, 13, 14.1-14.8, 15, 15.1, 15.2, 15.3,  
 63/15.4, 15.45, 15.5, 15.6, 15.7, 26-28

(56) **References Cited**

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 D20,739 S \* 5/1891 Beach ..... D11/26  
 D20,742 S \* 5/1891 Beach ..... D11/26  
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 D157,454 S \* 2/1950 Wheeler ..... D11/26  
 D161,747 S \* 1/1951 Grant ..... D11/26

D164,165 S \* 8/1951 Grant ..... D11/26  
 D465,173 S \* 11/2002 Gordon ..... D11/26  
 D470,307 S \* 2/2003 McCormack ..... D3/219  
 D491,090 S \* 6/2004 Osinga ..... D11/26  
 D491,091 S \* 6/2004 Osinga ..... D11/26  
 D491,832 S \* 6/2004 Gordon ..... D11/26  
 D590,291 S \* 4/2009 Brescia ..... D11/26  
 D601,913 S \* 10/2009 Cappellieri ..... D11/26  
 D602,799 S \* 10/2009 Colombani ..... D11/3

\* cited by examiner

*Primary Examiner*—Cathron C Brooks  
*Assistant Examiner*—Melanie Levy  
 (74) *Attorney, Agent, or Firm*—SNR Denton US LLC; Brian R. McGinley

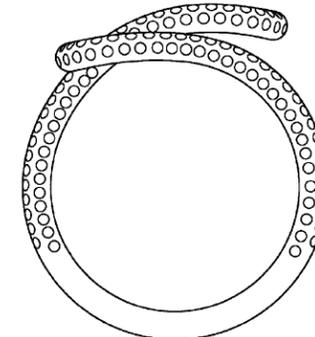
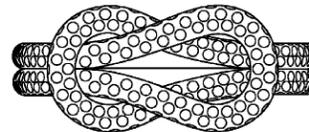
(57) **CLAIM**

The ornamental design for pavé ring, as shown and described.

**DESCRIPTION**

FIG. 1 is a top view of the pavé ring;  
 FIG. 2 is a front view of the pavé ring illustrated in FIG. 1;  
 FIG. 3 is a rear view of the pavé ring illustrated in FIG. 1;  
 FIG. 4 is a bottom view of the pavé ring illustrated in FIG. 1;  
 FIG. 5 is a right elevational view of the pavé ring illustrated in FIG. 1; and,  
 FIG. 6 is a left elevational view of the pavé ring illustrated in FIG. 1.

**1 Claim, 3 Drawing Sheets**



# “Fast and Cheap”

- Application is short
  - Description of Figures
  - Single claim: “1. The ornamental design of [title of application], as shown and described.”
  - Drawings
  
- Pendency
  - Average pendency between filing and issuance of application: ~15 months.
  - If expedited, average pendency drops to ~5 months.
  
- USPTO Fees
  - Filing fees \$760 (\$380 for small entity)
  - Issue Fee \$560 (\$280 for small entity)
  
- Term
  - Term is 15 years from the issue date
  - NO maintenance fees

## “Easy to Obtain”

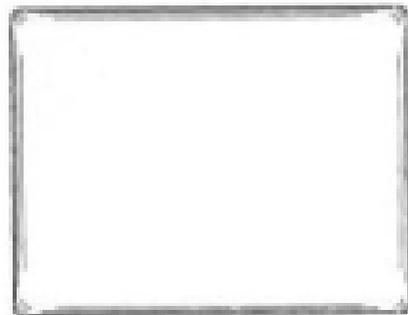
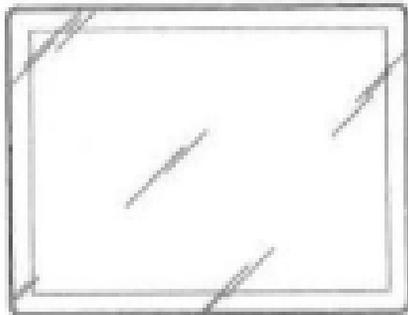
- Overall allowance rate of design applications: ~90%
  - Utility Patent Applications are under 50%
- Applications issued without rejection: ~80%
  - Only 1.2% are rejected over preexisting designs.
    - Examiners are strict with drawing formalities.
- In order to be patentable, the design must be:
  - New
  - Nonobvious
  - Ornamental

# Obviousness – Two Part Inquiry

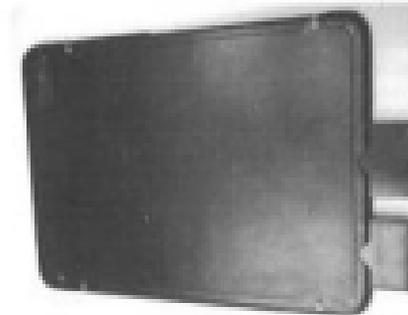
- Start with a “primary” prior art design that has design characteristics that are “basically the same” as the claimed design.
  - Called “Rosen” reference. VERY difficult standard.
- Modify primary reference with secondary reference(s) to arrive at a design that has the same overall visual appearance as the claimed design.
  - Art must be analogous (e.g. in the same field).
  - “[T]he teachings of prior art designs may be combined only when the designs are ‘so related that the appearance of certain ornamental features in one [design] would suggest the application of those features to the other.’”

# Not a Primary “Rosen” Reference

D504,889



1994 Fidler



Apple v. Samsung (2012)

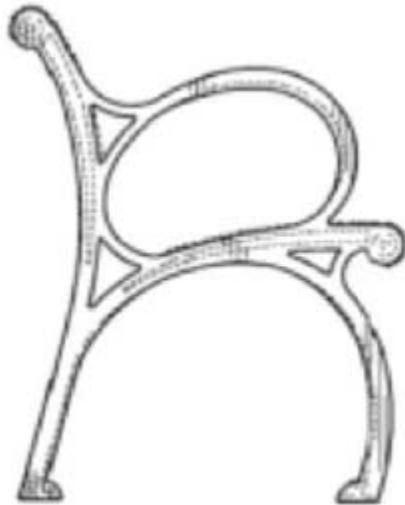
1994 Fidler tablet disqualified as a primary reference: (1) Fidler was not symmetrical like D'889; (2) Fidler frame “broke” in depth between the frame and screen, whereas D'889 showed a seamless frame/screen; (3) Fidler had no thin bezel surrounding the front side edge as in D'889; and (4) Fidler included a frame corner with multiple perforations and had two card-like projections unlike the D'889 design.

# Infringement

- If...“in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.” Gorham Co. v. White (1871)
- Modern “three-way” test:
  - Court will determine whether the alleged infringer’s design is closer to the patented design (for infringement) or closer to the prior art (non-infringement).

# Three-Way Test

Prior Art



Patented Design



Alleged Infringer



Court found infringement

# Three-Way Test

Prior Art



Patented Design



Alleged Infringer



In finding no infringement, the court noted that the claimed design and the alleged infringing product differ at the very feature that distinguished the claimed design from the prior art: the base of each coffee maker.

# Damages

- Reasonable Royalty (35 U.S.C. § 284)
- Lost profits (35 U.S.C. § 284)
- **Infringer's total profits (35 U.S.C. § 289)**
  - Only available for design patent infringement

# Apportionment Issue

## Apple v. Samsung

- Samsung's expert: \$290 to \$399 million in damages (2-2.75% royalty per device).
- Apple's expert: Samsung's infringing smartphones and tablets generated \$2.24 billion in total profit.
- Jury: over \$1 billion (mainly lost profits).

# Prestige Jewelry Int'l v. BK Jewellery HK



(12) **United States Design Patent** (10) **Patent No.:** **US D618,132 S**  
**Wong et al.** (45) **Date of Patent:** **\*\* Jun. 22, 2010**

(54) **DIAMOND JEWELLERY**  
 (75) Inventors: **Tse-Kok Wong, Kowloon (CN); Lok-Sung Wong, Kowloon (CN)**  
 (73) Assignee: **Wing Yee Gems & Jewellery Limited, Kowloon, Hong Kong (CN)**  
 (\*\*) Term: **14 Years**  
 (21) Appl. No.: **29/313,783**  
 (22) Filed: **Feb. 11, 2009**  
 (30) **Foreign Application Priority Data**  
 Aug. 12, 2008 (HK) ..... 0802018  
 (51) **LOC (9) Cl.** ..... **11-01**  
 (52) **U.S. Cl.** ..... **D11/91**  
 (58) **Field of Classification Search** ..... **D11/89-93, D11/1, 2, 6-12, 16, 24-28, 34-43, 79, 70, D11/222, 47, 75; 63/1.11-14.1, 15-15.4, 63/20, 22, 23, 26-33**  
 See application file for complete search history.  
 (56) **References Cited**  
**U.S. PATENT DOCUMENTS**  
 D466,828 S \* 12/2002 Pinto ..... D11/91  
 D485,509 S \* 1/2004 Shagalov ..... D11/91  
 D508,867 S \* 8/2005 Shum ..... D11/91

D509,163 S \* 9/2005 Pinto et al. .... D11/91  
 D515,451 S \* 2/2006 Pinto et al. .... D11/91  
 D516,940 S \* 3/2006 Friedmann ..... D11/90  
 D526,593 S \* 8/2006 Zaicik ..... D11/90  
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 D574,746 S \* 8/2008 Nolan ..... D11/41  
 D577,307 S \* 9/2008 Gurlinkel ..... D11/91  
 D584,184 S \* 1/2009 Dholakya ..... D11/91

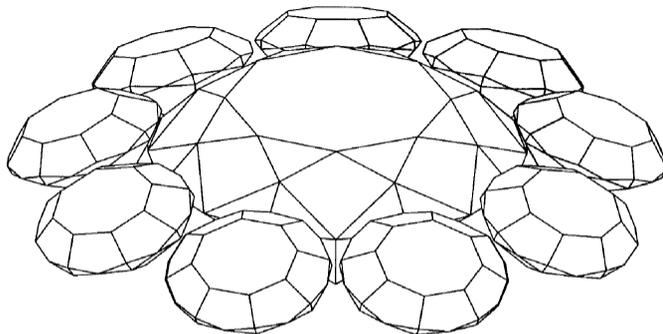
\* cited by examiner  
 Primary Examiner—T. Chase Nelson  
 Assistant Examiner—David G Müller  
 (74) Attorney, Agent, or Firm—Alix, Yale & Ristas, LLP

(57) **CLAIM**  
 The ornamental design for a diamond jewellery, as shown and described.

**DESCRIPTION**  
 FIG. 1 is a front perspective view of a diamond jewellery showing our new design; and,  
 FIG. 2 is a side elevation view thereof, the left side and opposite side views being identical.  
 The left side, right side and opposite side views are identical to the side elevation view of FIG. 2.

**1 Claim, 1 Drawing Sheet**

## Accused "Unity" designs:

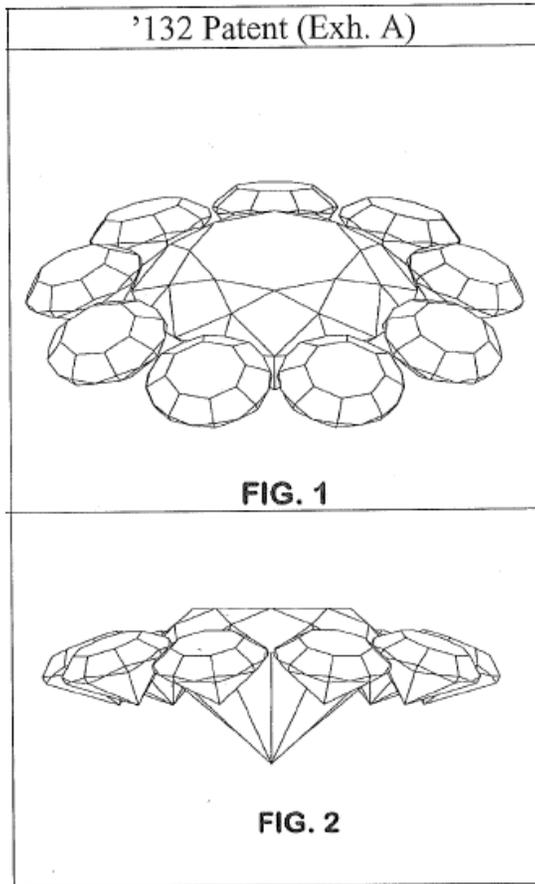


# Prestige's First Defense: Functionality

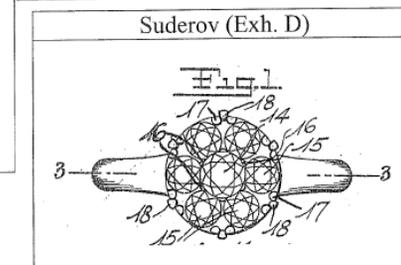
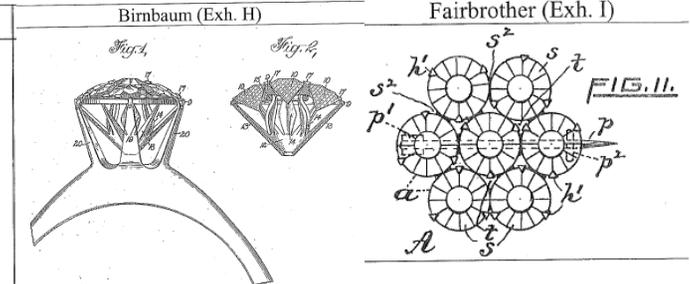
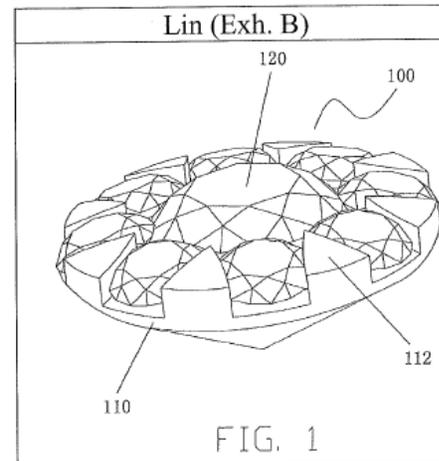
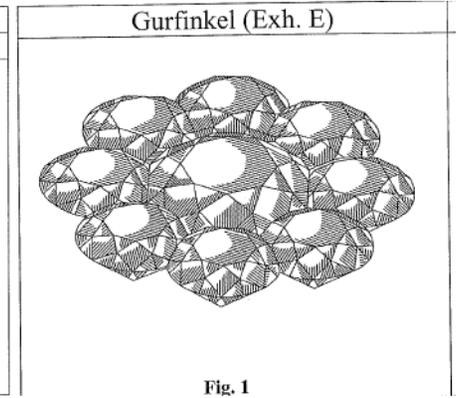
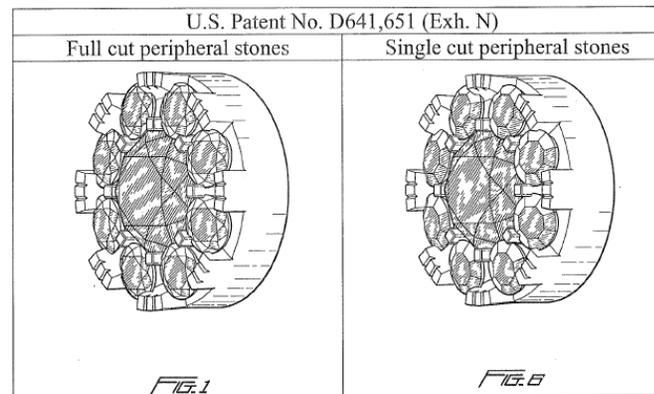
- Prestige: design is invalid for being “functional”
  - Inventor’s testimony that he tested his design using test equipment, and that he concluded that the design with the one full-cut stone surrounded by nine single-cut stones “performed the best.”
- Court: NO
  - The ultimate purpose of the '132 Patent design is to have a pleasing appearance—a quintessentially ornamental purpose.
  - Experimenting with designs to determine the “best” does not mean the resulting design is functional.
- Takeaways:
  - All industrial design have some “function”
  - Functionality depends on whether the article of manufacture has a utilitarian function, and whether the design claimed in the patent is ***dictated by that utilitarian function.***

# Prestige's Second Defense: Obviousness

Design is not new or is obvious:



**VS**



# Prestige's Second Defense: Obviousness

- Patent Office:
  - No reference shows a full-cut center stone with single cut peripheral stones.
    - “[W]hile it is true that “single-cut” cut style is well known . . . the inventors have chosen to use it to a new effect.”
  - Patent owner offered evidence that the difference between the cut-styles of the peripheral stones was discernible to the “average observer.”

“I have not seen this type of full-cut/single-cut gemstone arrangement in my twenty years of experience, anywhere (except relative to the parties in this dispute).” See Kent Hoole declaration, *supra*, Page 1, Item 5.

“People often express surprise by the unexpected use of single cut stones, the use of which in expensive jewelry is counterintuitive.” See declaration of Avi Matatov, para. 23, filed 11-02-2012 by Patent Owner.

## Prestige's Third Defense: Non-Infringement

- Prestige: Our allegedly infringing products are finished pieces of jewelry. The patent figures only show diamonds (not an earring, ring, etc.)
  - Court: NO. A patent can claim a portion of an article of manufacture and need not claim a design for a complete article.
- Prestige: Our jewelry has 8 or 10 peripheral diamonds, not 9.
  - Court: MAYBE. Record suggested 8 and 10 peripheral stones could be confused with a 9 stone arrangement, including statements made by Prestige's counsel that issue was a "close call." Jury should decide the issue.

## Current Status of Case

- Prestige dissolved.
- Patentee brought new case against additional entities that are allegedly related to Prestige.

# Contact Information



Neil B. Friedman  
Partner  
646.218.7605

[nfriedma@hodgsonruss.com](mailto:nfriedma@hodgsonruss.com)



Charles S. Rauch  
Senior Associate  
716.848.1675

[crauch@hodgsonruss.com](mailto:crauch@hodgsonruss.com)

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Corporate Trust Defaults	Investment Management & Compliance	Special Education
Design Protection & Design Patents	Labor & Employment	State & Local Tax
E-Discovery	Land Use & Economic Development	Tax Credits
Education	Life Sciences	Tax Dispute Resolution
Emerging Companies	Manufacturing	Tax Investigations & Defense
Employee Benefits	Matrimonial Law & Wealth Preservation	Technology
Employment Litigation	Mergers & Acquisitions	Technology Licensing & Agreements
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Europe	Nonprofit	Trademark Oppositions
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## OFFICES

**ALBANY** 677 Broadway, Suite 301 ▶ Albany, NY 12207 ▶ 518.465.2333

**BUFFALO** The Guaranty Building ▶ 140 Pearl Street, Suite 100 ▶ Buffalo, NY 14202 ▶ 716.856.4000

**NEW YORK** 1540 Broadway, 24th Floor ▶ New York, NY 10036 ▶ 212.751.4300

**PALM BEACH** 440 Royal Palm Way, Suite 202 ▶ Palm Beach, FL 33480 ▶ 561.656.8608

**SARATOGA SPRINGS** 60 Railroad Place, Suite 300 ▶ Saratoga Springs, NY 12866 ▶ 518.736.2900

**TORONTO** 150 King Street West, Suite 2309, P.O. Box 30 ▶ Toronto, ON M5H 1J9 Canada ▶ 416.595.5100

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## CONTACT

**Ranjana Kadle, Ph.D.**

716.848.1628

rkadle@hodgsonruss.com

## PROFESSIONALS

### ATTORNEYS

Alfonzo Cutaia

Daniel Dovi

Anne Downey

Ranjana Kadle, Ph.D.

Robert Lane, Jr.

John Lopinski, Ph.D.

Nathaniel Lucek

Daniel Oliverio

Charles Rauch

R. Kent Roberts

Paul Roman, Jr., Ph.D.

Gary Schober

George Snyder

Jordan Walbesser

### PARALEGALS

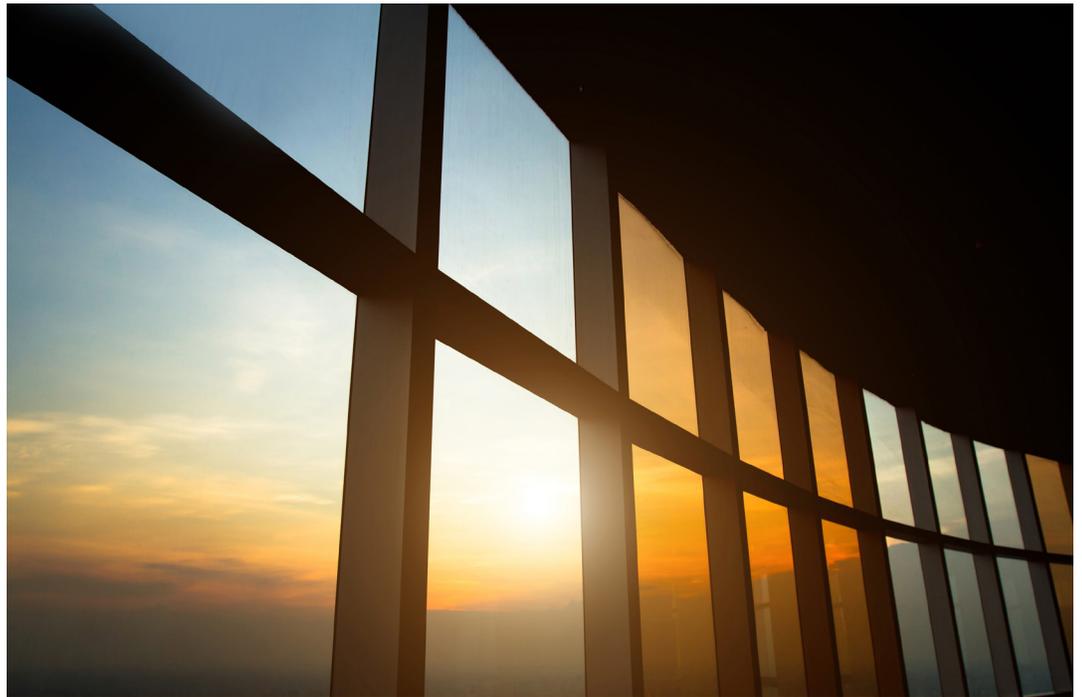
Michelle Voytovich

### REGISTERED PATENT AGENT

Rachel Watt

### SCIENTIFIC ADVISOR

Robert Furlani



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**NEW YORK** > 1540 Broadway, 24th Floor > New York, NY 10036 > 212.751.4300

**PALM BEACH** > 440 Royal Palm Way, Suite 202 > Palm Beach, FL 33480 > 561.656.8608

**SARATOGA SPRINGS** > 60 Railroad Place, Suite 300 > Saratoga Springs, NY 12866 > 518.736.2900

**TORONTO** > 150 King Street West, Suite 2309, P.O. Box 30 > Toronto, ON M5H 1J9 Canada > 416.595.5100

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From emerging visionaries to market-leading corporations, clients count on Hodgson Russ to support and defend the ideas, designs, and processes that are the bedrock of their business.

## CONTACT

**Jodyann Galvin**

716.848.1520

[jgalvin@hodgsonruss.com](mailto:jgalvin@hodgsonruss.com)

## PROFESSIONALS

### ATTORNEYS

Jessica Copeland

Robert Fluskey, Jr.

Jodyann Galvin

Stephen Kelkenberg

Robert Lane, Jr.

Cynthia Ludwig

Sarah Miller

Daniel Oliverio

Paul Perlman

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- ▶ Bringing and defending challenges to domain names (ICANN and federal court proceedings)

- ▶ Bringing and defending trademark opposition and cancellation proceedings before the Trademark Trial and Appeal Board (TTAB)
- ▶ Conducting jury and bench trials of patent, trademark, and misappropriation claims in state and federal courts
- ▶ Obtaining preliminary injunctions
- ▶ Working with patent prosecutors on re-examination proceedings before the U.S. Patent and Trademark Office

Whether counseling on protection strategies in the conference room or defending our clients' interests in the courtroom, the Hodgson Russ intellectual property litigation team provides sophisticated and cost-effective legal services focused on helping clients achieve their business objectives. Without the high price tag that generally comes with firms headquartered in larger cities, our attorneys have the breadth and depth of knowledge and experience necessary to help our clients protect their intellectual property rights and strengthen their competitiveness.

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**NEW YORK** ▶ 1540 Broadway, 24th Floor ▶ New York, NY 10036 ▶ 212.751.4300

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**TORONTO** ▶ 150 King Street West, Suite 2309, P.O. Box 30 ▶ Toronto, ON M5H 1J9 Canada ▶ 416.595.5100

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Our attorneys handle legal issues relating to compensation, business formation,

shareholder agreements, commercial contracts, corporate finance, regulatory compliance, labor and employment issues, and taxation, among numerous others.

The hallmarks of our practice are our ability to become immersed in our clients' business; to quickly and thoroughly understand its operations, environment, and unique culture; and to develop an efficient plan to achieve its business goals.

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**NEW YORK** > 1540 Broadway, 24th Floor > New York, NY 10036 > 212.751.4300

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**SARATOGA SPRINGS** > 60 Railroad Place, Suite 300 > Saratoga Springs, NY 12866 > 518.736.2900

**TORONTO** > 150 King Street West, Suite 2309, P.O. Box 30 > Toronto, ON M5H 1J9 Canada > 416.595.5100  
*Practice restricted to U.S. law*

## CONTACT

**Kenneth Friedman**  
716.848.1279  
kfriedma@hodgsonruss.com

**Paul Vallone**  
716.848.1228  
pvallone@hodgsonruss.com

## PROFESSIONALS

### ATTORNEYS

Ronald Battaglia, Jr.  
Brad Birmingham  
Jennifer Boll  
Christine Bonaguide  
Richard Campbell  
Thomas Collura  
Pierre Cournot  
John Drenning  
George Eydtt  
Craig Fischer  
Robert Fleming, Jr.  
Paul Frank  
Kenneth Friedman  
Janet Gabel  
Timothy Ho  
Nicholas Hoffman  
Jonathan Jasinski  
Christopher Milne  
Cristin Murray  
Robert Olivieri  
Mario Papa  
David Reed  
Patricia Sandison  
Matthew Scherer  
Gary Schober  
David Stark  
Valerie Stevens  
Kevin Talbot  
Paul Vallone  
John Zak  
Eleanor Zimmerman

### OF COUNSEL

Pamela Heilman

### PARALEGALS

Deborah Kalstek  
Betsy Mills  
Courtney Scanlon  
Imrije (Mima) Zylfijaj

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- ▶ Leadership transition and succession
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- ▶ Non-active family owners
- ▶ Regulatory compliance
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- ▶ Sale of business interests to non-family members
- ▶ Sale of business to employees
- ▶ Shareholder agreements
- ▶ Shareholder liquidity

Hodgson Russ has guided hundreds of families through successful business transitions.



## CONTACT

### Kenneth Friedman

716.848.1279

kfriedma@hodgsonruss.com

### Paul Vallone

716.848.1228

pvallone@hodgsonruss.com

## PROFESSIONALS

### ATTORNEYS

Ronald Battaglia, Jr.

Jennifer Boll

Christine Bonaguide

Thomas Collura

Pierre Cournot

George Eydt

Robert Fleming, Jr.

Kenneth Friedman

Janet Gabel

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Eleanor Zimmerman

Our goal is to help ensure the ongoing strength of the family as well as the continued viability of the business enterprise.

Our attorneys identify the most efficient means to transfer ownership, ascertain appropriate successors, determine the optimal timing of the transition, and review strategies to minimize the income and estate tax consequences of the transfer.



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## NEIL B. FRIEDMAN

Partner

[nfriedma@hodgsonruss.com](mailto:nfriedma@hodgsonruss.com) 646.218.7605

Neil has extensive experience in intellectual property law. His practice concentration includes trademark prosecution, trademark management of international portfolios, trademark enforcement and anti-counterfeiting, licensing and transactional agreements, and intellectual property litigation before U.S. federal courts and the Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office.

Neil regularly counsels clients and businesses regarding the adoption of their trademarks, branding techniques and strategies, advertising, and social media issues. When disputes arise, Neil's experience, knowledge base, and hands-on and attentive approach render him well positioned to obtain cost-effective results for his clients.

Prior to joining Hodgson Russ, Neil was partner at an intellectual property law firm with offices in New York City and New Jersey. There, he was responsible for the management of the trademark portfolios for a variety of companies, both domestically and internationally. Neil also served for five years as a senior assistant district attorney in Suffolk County, New York, where he was responsible for the investigation and prosecution of trademark counterfeiting, computer crimes, and other white collar crimes.

### Honors

- Notes and comments editor, *Touro International Law Review*
- American Jurisprudence Award for Academic Excellence in Contracts II
- West Publishing Corpus Juris Secundum Award for Excellence in Contracts II

1540 Broadway  
24th Floor  
New York City, NY 10036

### Areas of Practice

Business Litigation  
Copyrights  
Intellectual Property & Technology  
Intellectual Property Portfolio Management  
Trademark & Domain Name Registration  
Trademark Oppositions

### Admissions

New York  
New Jersey  
U.S. District Courts for the Southern, Eastern, and Western Districts of New York  
U.S. District Court for the District of New Jersey  
U.S. Courts of Appeals for the Federal, Second, and Third Circuits

### Education

B.A., Queens College, City University of New York  
J.D., cum laude, Touro College Jacob D. Fuchsberg Law Center

NEIL B. FRIEDMAN

## **Publications**

Back to the Future – The DeLorean Trademark Saga Continues  
*Intellectual Property & Technology Alert*, October 15, 2015

## **Professional Affiliations**

- International Trademark Association



## CHARLES S. RAUCH

Senior Associate

[crauch@hodgsonruss.com](mailto:crauch@hodgsonruss.com) 716.848.1675

Charlie's practice covers all aspects of patent, trademark, and design law, with a particular focus on U.S. and international patent prosecution and enforcement, transactional intellectual property diligence and licensing, patent validity and infringement opinions, and competitive analysis.

Charlie represents a variety of domestic and international clients in the mechanical, electromechanical, and electrical arts. He has particular experience in the following fields:

- Medical devices
- Optics
- Semiconductors
- Consumer products and appliances
- Sensors
- "Green" technologies
- Heat-transfer devices
- Visual displays
- Conveyor belts
- Protective clothing
- Superconductors

Prior to joining Hodgson Russ, Charlie worked in the Federal Communications Commission's Office of Strategic Planning and Policy Analysis and the U.S. District Court for the District of New Hampshire. Before attending law school, he worked as an engineer in IBM's 300mm semiconductor fabrication facility and an engineering and environmental consulting firm.

The Guaranty Building  
140 Pearl Street  
Suite 100  
Buffalo, NY 14202

### Areas of Practice

Design Protection & Design Patents  
Intellectual Property & Technology  
Intellectual Property Portfolio  
Management  
Patent Prosecution

### Admissions

New York  
Massachusetts  
U.S. Patent and Trademark Office  
U.S. District Court for the Western  
District of New York

### Education

B.S., interdisciplinary engineering  
and management, with distinction,  
Clarkson University  
J.D., cum laude, Franklin Pierce Law  
Center  
LL.M., with highest honors, George  
Washington University Law School

CHARLES S. RAUCH

## Honors

At Franklin Pierce Law Center, Charlie competed in the Giles Sutherland Rich Competition, coached the Franklin Pierce Moot Court patent team, and was a member of the Franklin Pierce Moot Court Board.

## Experience

Charlie has prevailed in numerous appeals before the Patent Trial and Appeal Board; drafted patentability, non-infringement, and freedom-to-operate opinions; conducted studies of competitor's patents and provided design-around advice; and is routinely involved in due diligence investigations for acquisitions and divestitures of IP portfolios.

Developed International IP Strategy for Consumer Product Startup

IP Portfolio Management for Startup Acquired by Fortune 100 Company

## News

Peak Resorts Completes Acquisition Of Hunter Mountain For \$36.8 Million  
*The Street*, January 7, 2016

Hodgson Russ Announces Five Newly Elected Partners  
*Press Release*, December 30, 2014

Lawyers Weigh in on High Court's Induced Infringement Ruling  
*Law360*, June 2, 2014

Hodgson Russ Attorney Charles S. Rauch Admitted to NYS Bar  
August 3, 2011

## Publications

Hague to Break It to You: International Design Applications Are Not a Silver Bullet for Multijurisdictional Protection  
*Intellectual Property & Technology Alert*, May 13, 2015

Patent and Trademark Office Proposes Revised Duty-to-Disclose Standard  
*Intellectual Property & Technology Alert*, August 26, 2011

## Professional Affiliations

- American Intellectual Property Law Association
- Bar Association of Erie County

CHARLES S. RAUCH

### **Community & Pro Bono**

- Secretary, Friends of Reinstein Woods board of directors
- Pro bono attorney, Buffalo Housing Court Attorney-of-the-Morning Program