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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROLAND MANDLER

Appeal 2019-004461
Application 14/511,367
Technology Center 1700

Before BEVERLY A. FRANKLIN, JEFFREY R. SNAY, and LILAN REN, *Administrative Patent Judges*.

SNAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant[1] appeals from the Examiner's decision rejecting claims 1, 2, and 4–9. A hearing was conducted September 17, 2020, a transcript of which will be made of record. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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[1] We use the word Appellant to refer to "applicant" as defined in 37 C.F.R. § 1.42. Appellant identifies OptoTech Optikmaschinen GmbH as the real party in interest. Appeal Br. 3.

BACKGROUND

The invention relates to a lens retaining device for use in lens processing, such as milling, grinding, and cutting. Spec. 1. Claim 1 is the only independent claim on appeal and reads:

> 1. A lens retaining device (1) for retaining a raw lens (100) in a processing machine,
>
> - with a tool mount (10) for immobilizing the lens retaining device (1) in a processing machine, and
> - with a workpiece mount (20) for receiving a raw lens (100) to be processed,
> - wherein the workpiece mount (20) has a curved surface (21) and is connected to the tool mount (10), and
> - wherein an air channel (22) extends from the tool mount (10) to the curved surface (21) of the workpiece mount (20),
>
> characterized in that,
>
> - the workpiece mount (20) includes an adhesion element (23) as a part thereof, the adhesion element at least to some extent forms the curved surface (21),
> - wherein the adhesion element (23) has adhesive properties on the curved surface (21) and comprises an adhesive material based on polyvinyl chloride, polyethylene, silicone, or poly(organo)siloxanes, and
> - further wherein the air channel (22) is configured to generate a suction force between the curved surface, that at least to some extent is formed by the adhesion element (23), and a raw lens.

Appeal Br. 31 (Claims Appendix).

REJECTION

Claims 1, 2, and 4–9[2] stand rejected under 35 U.S.C. § 103 as unpatentable over Felten,[3] Soper,[4] and Cole.[5]

OPINION

Appellant directs the submitted arguments solely to claim 1. *See* Appeal Br. 10–29. Each of claims 2 and 4–9 stands or falls with claim 1.

Relevant to Appellant's arguments on appeal, the Examiner finds Felten discloses a lens held to a mount by an adhesion element. Final Act. 2–3. The Examiner finds Soper discloses a lens held to a mount by suction applied through an apertured disc. *Id.* at 3; Ans. 3. The Examiner further finds Cole discloses a lens held to a mount by a silicone adhesive-coated blocking pad. Final Act. 3, 5–6. In light of these findings, the Examiner determines one of ordinary skill would have had a reason to replace Felten's adhesion element with Soper's aperture disc, and to provide the disc with a silicone adhesive coating, to hold a lens to a mount for processing. *Id.* 3, 5–6; Ans. 3–4.

Appellant argues Felten's adhesion element is adhered to the lens and, therefore, is not part of the workpiece mount as recited in claim 1. Appeal Br. 11–17. Appellant also argues Felten discloses an air channel that does not extend through the adhesion element to the lens surface. *Id.* at 17–18. There appears to be no dispute on either point. *See* Final Act. 3 ("Felten

[2] The Examiner withdrew claims 10–12 from consideration. Final Act. 1.
[3] US 2011/031637 A1, published February 10, 2011 ("Felten").
[4] US 4,089,102, issued May 16, 1978 ("Soper").
[5] US 7,935,402 B2, issued May 3, 2011 ("Cole").

does not appear to explicitly disclose the adhesion element is part of the workpiece mount and that the air channel communicates with the curved surface between the adhesion element and the raw lens."). Because the Examiner's rejection of claim 1 is not premised on a finding that Felten's adhesion element is part of the mount, or that Felten provides the recited air channel, Appellant's arguments against such findings are not persuasive of error.

Turning to the combined teachings of Felten and Soper, Appellant argues "there is simply no motivation given in Felten to apply features of a suction holder (as Soper discloses) to the blocking[6] procedure of Felten, because Felten does not disclose suction forces." Appeal Br. 17. According to Appellant, "The protecting tape 13 of Felten and the disc 22 of Soper are different parts in a lens blocking device and cannot be reasonably said to be substitutes for each other as is alleged in the rejection." *Id.* at 19. Appellant contends Felten's adhesion element is used to protect a lens and bond the lens to a mounting block, whereas Soper's apertured disc is used to allow suction to hold the lens in place on a mounting block. *Id.* at 20. Appellant argues Felten's protecting tape and Soper's disc "are not similar in the least." *Id.* *See also* Reply Br. 1–6.

Having considered Appellant's arguments together with the evidence presented, we are not persuaded of reversible error. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex*

[6] Blocking, in this case, refers to forming a solid connection between a lens and a mount. Spec. 2 ("The process of producing such solid connections between a raw lens and a lens retaining device is also called blocking.").

Inc., 550 U.S. 398, 416 (2007). The prior art need not present an express suggestion to substitute one equivalent for another. *In re Fout*, 675 F.2d 297, 301 (CCPA 1982). Here, Appellant's arguments identify the differences between adhesion, such as in Felten, and suction, as in Soper, but do not challenge the Examiner's finding that both are techniques known for the same purpose of retaining a lens to a mount for processing. To the contrary, the Specification identifies these techniques as known alternatives. Spec. 2 ("An alternative to the blocking methods are vacuum holders.").

Lastly, Appellant argues there would have been no reason to use Cole's adhesive with Soper's disc, and the Examiner's contrary finding is based in impermissible hindsight. Appeal Br. 26–27. We disagree. Although Soper discloses retaining a lens to the apertured disc by suction, Soper also teaches securing the disc to the mount using an adhesive. Soper 4:9–11. Thus, Soper's disc already includes an adhesive positioned between the disc and the mount's surface to which the disc is secured. The Examiner finds, and Appellant does not dispute, that Cole teaches using silicone adhesives for securing a lens blocking pad to a mount. Final Act. 3. To the extent Appellant contends claim 1 requires an adhesive positioned on the surface to which a lens is adhered, Cole teaches providing the disclosed adhesive to both sides of a blocking pad for that purpose. Cole 6:1–9.

Appellant argues the claimed invention provides a combination of adhesion and suction to retain a lens. Appeal Br. 28–29. This argument is not persuasive. As noted, Soper also provides a combination of suction and adhesion in the process of retaining a lens. Moreover, Appellant does not present credible evidence that the combination of adhesion and suction yields more than their expected cumulative effects. *See In re Kerkhoven*,

626 F.2d 846, 850 (CCPA 1980) (stating it is prima facie obvious to combine two different materials useful for the same purpose to form a third material which is to be used for that purpose).

For the foregoing reasons, Appellant has not persuasively demonstrated reversible error in the Examiner's obviousness determination with regard to claim 1. Appellant does not separately argue any other claim. Accordingly, the Examiner's rejection under 35 U.S.C. § 103 is sustained.

CONCLUSION

The Examiner's decision rejecting claims 1, 2, and 4–9 is affirmed.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 2, 4–9	103	Felten, Soper, Cole	1, 2, 4–9	

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED