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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEFANO SONZOGNI

Appeal 2020-000148
Application 15/027,833
Technology Center 3700

Before JOSEPH A. FISCHETTI, BIBHU R. MOHANTY, and KENNETH G. SCHOPFER, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–4, 7–9, and 12. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We REVERSE.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as MEI S.r.l.. Appeal Br. 1.

CLAIMED SUBJECT MATTER

The Appellant's claimed invention relates to a process for machining a lens (Spec., page 1, lines 2, 3). Claim 1, reproduced below is representative of the subject matter on appeal.

1. A process for machining a lens, the process comprising the steps of:
 - holding a semi-finished product through a suction holding force which is active during an entire surface machining cycle of the semi-finished product, wherein said semi-finished product comprises a convex front surface, a concave rear surface to be machined opposite to the front surface and a perimeter surface, wherein the suction holding force acts on the front surface;
 - carrying out the surface machining cycle only on said rear surface to be machined of the semifinished product by a machine tool; and
 - activating a pressure holding force depending on a magnitude of mechanical stresses exerted on the rear surface of the semi-finished product during the surface machining cycle on said rear surface, the pressure holding force acting on said rear surface,
 - wherein the surface machining cycle on said rear surface comprises a first step in which the semi-finished product is held by the application of both the suction holding force on said front surface and the pressure holding force on said rear surface and the machine tool machines the rear surface of the semi-finished product moving from the outer edge of the rear surface towards the central portion of the rear surface, and a subsequent step in which the semi-finished product is held by application of just the suction holding force on said front surface and the machine tool has reached the central portion of the rear surface.

THE REJECTIONS

The following rejections are before us for review:

1. Claims 1–4, 7, 8, and 12 are rejected under 35 U.S.C. § 103 as unpatentable over Gerber (US 5,720,649; iss. Feb. 24, 1998), Abbey (GB

583,202; iss. Dec. 11, 1946), and Monnoyeur (US 2011/0256806 A1; pat. pub. Oct. 20, 2011).

2. Claim 9 is rejected under 35 U.S.C. § 103(a) as unpatentable over Gerber, Abbey, Monnoyeur, and Cook (US 5,567,198; iss. Oct. 22, 1996).

FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence².

ANALYSIS

The Appellant argues that the rejection of record of claim 1 is improper because the cited combination of references would not have been obvious (App. Br. 11–14). The Appellant argues the prior art fails to disclose or suggest a pressure holding force on a rear surface while the machine tool machines the rear surface of the product moving from the outer edge to the central portion (App. Br. 12).

In contrast, the Examiner has determined that the rejection of record is proper (Final Action 2–4; Ans. 3–5).

We agree with the Appellant. In *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) the Supreme Court at 418 noted that in an obviousness analysis that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

reasoning with some rational underpinning to support the legal conclusion of obviousness”.

Here, even assuming all the elements of the cited prior art are present in the cited prior art, we determine that the cited proposed combination would not have been obvious. For example, we agree that Gerber teaches holding the semi-finished product “by the application ...[of] the pressure holding force on said rear surface [while] the *machine tool machines the rear surface of the semi-finished product moving from the outer edge of the rear surface towards the central portion of the rear surface*” at Fig. 1 and column 5, lines 25–35. We also agree that Monnoyeur at paragraph 59 discloses using suction to hold a lens blank. Figure 3 of Abbey discloses the spindle 12 rotatably supported while surface is machined. Abbey at Figure 4 does disclose axial forces holding the lens, but this is done while machining the edge of the lens only, and not the rear surface of the lens. While Abbey at Figure 5 does disclose a pressure holding force on the rear surface, this is done while “drilling” the lens, not machining the surface from the outer edge to the rear surface towards the central portion as claimed.

Here, the cited prior art fails to provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness for the modification of the elements to include “the pressure holding force on said rear surface [while] the machine tool machines the rear surface of the semi-finished product moving from the outer edge of the rear surface towards the central portion of the rear surface” without impermissible hindsight in the cited rejection. Accordingly, the rejection of claim 1 and its dependent claims is not sustained.

CONCLUSIONS OF LAW

We conclude that Appellant has shown that the Examiner erred in rejecting claims 1–4, 7, 8, and 12 under 35 U.S.C. § 103 as unpatentable over Gerber, Abbey, and Monnoyeur.

We conclude that Appellant has shown that the Examiner erred in rejecting claim 9 under 35 U.S.C. § 103(a) as unpatentable over Gerber, Abbey, Monnoyeur, and Cook.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–4, 7, 8, and 12	103	Gerber, Abbey, and Monnoyeur		1–4, 7, 8, and 12
9	103	Gerber, Abbey, Monnoyeur, and Cook		9
Overall Outcome				1–4, 7-9, and 12

TIME PERIOD FOR RESPONSE

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

REVERSED