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CORNING INCORPORATED			GAITONDE, MEGHA MEHTA	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL
AND APPEAL BOARD

Ex parte DANIEL WARREN HAWTOF¹

Appeal 2019-001311
Application 14/621,881
Technology Center 1700

Before BEVERLY A. FRANKLIN, JEFFREY B. ROBERTSON, and
MONTÉ T. SQUIRE, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Appellant identifies the real party in interest as Corning Incorporated.

Appellant requests our review under 35 U.S.C. § 134(a) of the Examiner's decision rejecting claims 16–20 and 37–40.² We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

Claim 16 is illustrative of Appellant's subject matter on appeal and is set forth below:

16. A silica-containing sheet comprising:
 - a first major surface, the first major surface having a variable surface topography;
 - a second major surface opposite the first major surface;
 - at least 50 mole % silica;
 - an average thickness between the first major surface and the second major surface of less than 5 mm;
 - a length of at least 1 cm and a width of at least 1 cm;
 - wherein the variable surface topography of the first major surface varies having at least two layers that are not coplanar with each other such that:
 - a first surface profile along a first x-axis is different than a second surface profile along a second x-axis; and
 - a third surface profile along a first y-axis is different than a fourth surface profile along a second y-axis.

² It is noted that Appellant has withdrawn the appeal with respect to the Examiner's rejection of claims 21 and 22. Claim 24 depends upon claim 21 and claim 25 depends upon claim 24. Reply Br. 3. As a result, claims 21, 22, 23, 24, and 25 are not appealed by Appellant. These claims are not included here.

The Examiner relies on the following prior art references as evidence of unpatentability:

Bhagavatula et al. (“Bhagavatula”)	US 4,494,968	January 22, 1985
Hawtof et al. (“Hawtof”)	US 2010/0291346 A1	November 18, 2010

THE REJECTIONS³

1. Claim 40 is rejected under 35 U.S.C. § 112(a) or 35 U.S.C. § 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement.
2. Claims 16–18, 20, and 37–39 are rejected under 35 U.S.C. § 102(a)(1) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Hawtof.
3. Claim 19 is rejected under 35 U.S.C. § 103 as being unpatentable over Hawtof as applied to claim 16 above and further in view of Bhagavatula.
4. Claim 40 is rejected under 35 U.S.C. § 103 as being unpatentable over Hawtof in view of Applicant’s Admitted Prior Art (AAPA).

ANALYSIS

Upon consideration of the evidence and each of the respective positions set forth in the record, we find that the preponderance of evidence supports Appellant’s position in the record. We thus reverse the Examiner’s decision for the reasons provided by Appellant in the record, and add the following for emphasis.

³ As noted in footnote 2, *supra*, Appellant has withdrawn the appeal with respect to the Examiner’s rejection of claims 21 and 22. Reply Br. 3. As a result, claims 21, 22, 23, 24, and 25 are not appealed by Appellant and therefore the rejections listed here involve only the appealed claims.

Rejection 1

It is the Examiner's position that the phrase "a coiled section turning about a minor surface of the sheet" is unsupported by the Specification. Final Act. 2–3. It is the Examiner's position that while this phrase covers the intuitive coiling shown in Figure 9 and described in paragraph [0059] of the Specification, it also covers an alternative hypothetical scenario where the sheet somehow coils about a horizontal axis that extends lengthwise along the center of the edge of the sheet. Ans. 3–4. We agree with Appellant that this alternative hypothetical is not within the scope of claim 40 for the reasons provided by Appellant on pages 4–5 of the Appeal Brief and on pages 1–2 of the Reply Brief. Claim 40 as properly construed is supported by the original Specification. We note that in order to satisfy the written description requirement of § 112, the Specification – including the drawings and the originally filed claims – must allow a person of ordinary skill in the art to recognize that the inventor invented what is claimed. *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989). The specification must reasonably convey to a person of ordinary skill in the art that the inventor had possession as of the filing date of the claimed subject matter. *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985); *see also, Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991).

We thus reverse Rejection 1.

Rejections 2–4

Our determinations with respect to Rejection 2 are dispositive for Rejections 3–5 because each of the art rejections involve the primary reference of Hawtof which is outcome determinative in this case.

It is the Examiner's position that because Hawtof teaches that the soot-receiving device can oscillate, that this oscillation would create layers that are not coplanar with each other as required by the claim phrase "wherein the variable

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surface topography of the first major surface varies having at least two layers that are not coplanar with each other”. Ans. 4. However, for the reasons stated by Appellant in the record, we agree that this position is unsupported by the record and is speculative. Appeal Br. 6–7. Reply Br. 2–3. We thus reverse Rejections 2–4.

In view of the above, we reverse Rejections 2–4.

DECISION

Each rejection is reversed.

ORDER

REVERSED