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CORNING INCORPORATED
INTELLECTUAL PROPERTY DEPARTMENT, SP-TI-3-1
CORNING, NY 14831

EXAMINER

CHUNG TRANS, XUONG MY

ART UNIT PAPER NUMBER

2833

NOTIFICATION DATE DELIVERY MODE

12/19/2014

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usdocket@corning.com

PPC Exhibit 2006
Corning v. PPC
IPR2016-01573

The present application is being examined under the pre-AIA first to invent provisions.

Election/Restrictions

Applicant's election without traverse of species 1, claims 1-5, 7-17 and 19-30 in the reply filed on September 30, 2014 is acknowledged.

In the amendment filed on October 1, 2014, claim 14 has been amended. Therefore claims 1-30 are pending.

Claims 6 and 18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 30, 2014.

Information Disclosure Statement

The Examiner would like to note the latest Information Disclosure Statement (IDS) submittals are extremely long. The Examiner has considered all of the references submitted as part of the Information Disclosure Statements, but has not found any to be particularly relevant. If Applicant is aware of pertinent material in the references, s/he should so state in a response to this Office action. Applicant is reminded of section 2004, paragraph 13, of the MPEP:

It is desirable to avoid the submission of long lists of documents if it can be avoided. Eliminate clearly irrelevant and marginally pertinent cumulative information. If a long list is submitted, highlight those documents which have been specifically brought to applicant's attention and/or are known to be of most

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significance. See *Penn Yan Boats, Inc. v. Sea Lark Boats, Inc.*, 359 F. Supp. 948, 175 USPQ 260 (S.D. Fla. 1972), *aff'd*, 479 F.2d 1338, 178 USPQ 577 (5th Cir. 1973), *cert. denied*, 414 U.S. 874 (1974). But cf. *Molins PLC v. Textron Inc.*, 48 F.3d 1172, 33 USPQ2d 1823 (Fed. Cir. 1995).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory double patenting rejection is appropriate where the claims at issue are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the reference application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of

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activities undertaken within the scope of a joint research agreement. A terminal disclaimer must be signed in compliance with 37 CFR 1.321(b).

The USPTO internet Web site contains terminal disclaimer forms which may be used. Please visit <http://www.uspto.gov/forms/>. The filing date of the application will determine what form should be used. A web-based eTerminal Disclaimer may be filled out completely online using web-screens. An eTerminal Disclaimer that meets all requirements is auto-processed and approved immediately upon submission. For more information about eTerminal Disclaimers, refer to <http://www.uspto.gov/patents/process/file/efs/guidance/eTD-info-l.jsp>.

Claims 1-5, 7-17 and 19-30 are provisionally rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1- 24 of copending Application No. 13/833793. Although the claims at issue are not identical, they are not patentably distinct from each other because the claimed limitations recited in the present application are transparently found in the copending application 13/833793 with obvious wording variations. The slight differences are either encompassed by the '793 claims or are obvious variation especially in light of the '793 disclosure.

This is a provisional nonstatutory double patenting rejection because the patentably indistinct claims have not in fact been patented.

Claims 1-5, 7-17 and 19-30 are provisionally rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1-4, 15, 16 of

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