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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
17/919,497	10/17/2022	NORIKO TSUCHIYA	SYP334689US01	4724
108359	7590	12/19/2024	EXAMINER	
CHIP LAW GROUP			FOX, BRANDON C	
505 N. LAKE SHORE DRIVE			ART UNIT	
SUITE 250			PAPER NUMBER	
CHICAGO, IL 60611			2818	
			NOTIFICATION DATE	DELIVERY MODE
			12/19/2024	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):

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Office Action Summary	Application No. 17/919,497	Applicant(s) TSUCHIYA et al.	
	Examiner BRANDON C FOX	Art Unit 2818	AIA (FITF) Status Yes

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/17/2022.
☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims*

- 5) ☒ Claim(s) 1-14 is/are pending in the application.
5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1-6 and 9-13 is/are rejected.
- 8) ☒ Claim(s) 7-8 and 14 is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☒ The drawing(s) filed on 04/14/2021 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

- a) ☒ All b) ☐ Some** c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

** See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b)
Paper No(s)/Mail Date 10/17/2022
- 3) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 4) ☐ Other: ____.

Notice of Pre-AIA or AIA Status

The present application, filed on or after March 16, 2013, is being examined under the first inventor to file provisions of the AIA.

This is a Non-Final office action based on application 17/919,497 filed October 17, 2022. Claims 1-14 are currently pending and have been considered below.

Claim Rejections - 35 USC § 112

The following is a quotation of 35 U.S.C. 112(b):

(b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

The following is a quotation of 35 U.S.C. 112 (pre-AIA), second paragraph:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor (or for applications subject to pre-AIA 35 U.S.C. 112, the applicant), regards as the invention.

Claim 5 is rejected because it unclear how the second casing is further inserted into the substrate. It is unclear if the first casing is meant to further insert into the substrate along with the second casing.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a)(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.

Claim(s) 1, 4-5, 9-10 & 12 is/are rejected under 35 U.S.C. 102(a)(1) as being anticipated by Utsumi (Pre-Grant Publication 2019/0207051).

Regarding claim 1, Utsumi discloses an optical module comprising:

- a substrate (Fig. 53, 1);
- a light emitting element (43) that is disposed on the substrate;
- a light receiving element (41) that is disposed on the substrate at a predetermined interval from the light emitting element;
- a first casing (621/63) that is disposed on the substrate and surrounds a periphery of the light emitting element;
- a second casing (621/63) that is disposed on the substrate and surrounds a periphery of the light receiving element;
- a light emitting lens (511) that is housed in the first casing and is disposed on an optical axis of the light emitting element; and
- a light receiving lens (521) that is housed in the second casing and is disposed on an optical axis of the light receiving element,
- wherein a first diameter of one lens out of the light emitting lens and the light receiving lens in a first direction toward an optical axis of another lens with reference to an optical axis of the one lens is shorter than a second diameter of the one lens in a second direction that is orthogonal to the first direction (See Fig. 44 & 52).

Regarding claim 4 & 5, Utsumi further discloses:

- The casing (621/63) is inserted into the substrate (1) by grooves (15).

Regarding claim 9, Utsumi further discloses:

- The optical axis of the one lens is biased in the first direction from a center of the one lens (Fig. 44 & 52).

Regarding claim 10, Utsumi further discloses:

- the one lens has a D-cut shape that has a linear shape on a side on which the one lens is adjacent to the another lens (Fig. 52).

Regarding claim 12, Utsumi further discloses:

- the one lens can have an I-cut shape (Fig. 1, 511) that has linear shapes on a side on which the one lens is adjacent to the another lens and a side opposite to the side on which the one lens is adjacent to the another lens.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

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