

**TERMINAL DISCLAIMER TO OBTAIN A DOUBLE PATENTING
REJECTION OVER A "PRIOR" PATENT**

Docket Number (Optional)
309-0011USDIVCIP2

In re Application of: Shih-Yuan WANG

Application No.: 17/707,429

Filed: March 29, 2022

For: MICROSTRUCTURE ENHANCED ABSORPTION PHOTSENSITIVE DEVICES

The applicant, W&WSENS DEVICES, INC., owner of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of **prior patent** No. 9,525,084 as the term of said **prior patent** is presently shortened by any terminal disclaimer. The applicant hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the **prior patent** are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the applicant does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term of the **prior patent**, "as the term of said **prior patent** is presently shortened by any terminal disclaimer," in the event that said **prior patent** later:

- expires for failure to pay a maintenance fee;
- is held unenforceable;
- is found invalid by a court of competent jurisdiction;
- is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
- has all claims canceled by a reexamination certificate;
- is reissued; or
- is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ The undersigned is the applicant. If the applicant is an assignee, the undersigned is authorized to act on behalf of the assignee.

I hereby acknowledge that any willful false statements made are punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

2. ☒ The undersigned is an attorney or agent of record. Reg. No. 25,161

Signature Date
/Ivan S. Kavrukov/ March 29, 2022

Typed or printed name
Ivan S. Kavrukov

Title Telephone Number
Attorney of Record 917-945-0121

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) included.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
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5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
17/707,429	03/29/2022	Shih-Yuan WANG	309-0011USDIVCIP2	1214
139982	7590	05/26/2022	EXAMINER	
Wissing Miller LLP			CENTRAL, DOCKET	
Industrious at Hudson Yards				
31 Hudson Yards, 11th Floor				
New York, NY 10001				
			ART UNIT	PAPER NUMBER
			OPAP	
			NOTIFICATION DATE	DELIVERY MODE
			05/26/2022	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.

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WMDocket@wissingmiller.com



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In re Application of :
Wang, et al. :
Application No. 17/707,429 :
Filed: 29 Mar 2022 : **DECISION ON PETITION**
For: MICROSTRUCTURE ENHANCED :
ABSORPTION PHOTSENSITIVE :
DEVICES :

This is a decision on the petition under 37 CFR 1.102(c)(1), filed March 29, 2022, to make the above-identified application special based on applicant's age as set forth in MPEP § 708.02, Section II.

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102(c)(1) and MPEP § 708.02, Section II: Applicant's Age, must be accompanied by evidence showing that the applicant is 65 years of age, or more, such as applicant's statement or a statement from a registered practitioner that he or she has evidence that the applicant is 65 years of age or older. No fee is required.

The instant petition includes a statement from a registered practitioner that he or she has evidence that an inventor is 65 years of age or older. Accordingly, the above-identified application has been accorded "special" status.

All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

Telephone inquiries concerning this decision should be directed to Paralegal Specialist Selena Hamilton at 571-272-8825.

/LIANA S WALSH/
Lead Paralegal Specialist, OPET

Application Number * 17/707,429 *	Application/Control No. 17/707,429	Applicant(s)/Patent under Reexamination WANG et al.	
	Examiner HO, HOANG QUAN TRAN	Art Unit 2818	
Document Code - DISQ		Internal Document - DO NOT MAIL	

TERMINAL DISCLAIMER	☒ APPROVED	☐ DISAPPROVED
Date Filed: <u>29 March 2022</u>	This patent is subject to a Terminal Disclaimer	

Approved/Disapproved by:
11/Tds all approved. /LAWANA R HIXON/ Technology Center: <u>OPLC</u> Telephone: <u>(571)272-6074</u>

Receipt date: 08/16/2022

Doc code: IDS

Doc description: Information Disclosure Statement (IDS) Filed

PTO/SB/08a (02-18)

Approved for use through 11/30/2020. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number		17707429	
	Filing Date		2022-03-29	
	First Named Inventor	Shih-Yuan WANG		
	Art Unit	2818		
	Examiner Name	Tran Quan Hoang Ho		
	Attorney Docket Number	309-0011USDIVCIP2		

U.S.PATENTS								
Examiner Initial*	Cite No	Patent Number	Kind Code ¹	Issue Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear		
	1							
If you wish to add additional U.S. Patent citation information please click the Add button.								
U.S.PATENT APPLICATION PUBLICATIONS								
Examiner Initial*	Cite No	Publication Number	Kind Code ¹	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear		
	1							
If you wish to add additional U.S. Published Application citation information please click the Add button.								
FOREIGN PATENT DOCUMENTS								
Examiner Initial*	Cite No	Foreign Document Number ³	Country Code ²	Kind Code ⁴	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear	T ⁵
	1	2002314116	JP		2002-10-25	Seiko Epson Corp.		☐
If you wish to add additional Foreign Patent Document citation information please click the Add button								
NON-PATENT LITERATURE DOCUMENTS								
Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.						T ⁵

Receipt date: 08/16/2022

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number		17707429
	Filing Date		2022-03-29
	First Named Inventor	Shih-Yuan WANG	
	Art Unit	2818	
	Examiner Name	Tran Quan Hoang Ho	
	Attorney Docket Number	309-0011USDIVCIP2	

	1		☐
If you wish to add additional non-patent literature document citation information please click the Add button			
EXAMINER SIGNATURE			
Examiner Signature	/Hoang-Quan Ho/		Date Considered 10/14/2022
*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.			
¹ See Kind Codes of USPTO Patent Documents at www.USPTO.GOV or MPEP 901.04. ² Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). ³ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁴ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁵ Applicant is to place a check mark here if English language translation is attached.			



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139982	7590	11/18/2022	EXAMINER	
Wissing Miller LLP			HO, HOANG QUAN TRAN	
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31 Hudson Yards, 11th Floor			PAPER NUMBER	
New York, NY 10001			2818	
			NOTIFICATION DATE	
			DELIVERY MODE	
			11/18/2022	
			ELECTRONIC	

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

WMDocket@wissingmiller.com

Supplemental Notice of Allowability	Application No. 17/707,429	Applicant(s) WANG et al.	
	Examiner Hoang-Quan Ho	Art Unit 2818	AIA (FITF) Status Yes

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

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to IDS filed on 10/24/2022.

☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

2. ☐ 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.

3. ☐ The allowed claim(s) is/are _____. As a result of the allowed claim(s), 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.

4. ☐ 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)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.

☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892) 2. ☒ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date <u>10/24/2022</u> . 3. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material _____. 4. ☐ Interview Summary (PTO-413), Paper No./Mail Date. _____.	5. ☒ Examiner's Amendment/Comment 6. ☐ Examiner's Statement of Reasons for Allowance 7. ☒ Other <u>Detailed Action</u> .
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/Hoang-Quan Ho/ Primary Examiner, Art Unit 2818	
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DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on October 24, 2022 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in an interview with Ivan Kavrukov on November 15, 2022.

The application has been amended as follows:

Claim 31: At line 10, replace "material);" with --material;--.

Claim 35: At line 1, replace "in which in which" with --in which-- and at line 2, replace "the range" with --a range--.

Claim 44: At line 1, replace "in which in which" with --in which-- and at line 2, replace "the range" with --a range--.

Claim 49: At lines 2 and 3, replace "the 100-2,000 nm range" with --a range of 100-2,000 nm--.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Quan Ho whose telephone number is (571)272-8711. The examiner can normally be reached Monday - Friday, 10 AM - 6 PM.

Examiner interviews are available via telephone, in-person, and video conferencing using a USPTO supplied web-based collaboration tool. To schedule an interview, applicant is encouraged to use the USPTO Automated Interview Request (AIR) at <http://www.uspto.gov/interviewpractice>.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Loke can be reached on 571-272-1657. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of published or unpublished applications may be obtained from Patent Center. Unpublished application information in Patent Center is available to registered users. To file and manage patent submissions in Patent Center, visit: <https://patentcenter.uspto.gov>. Visit <https://www.uspto.gov/patents/apply/patent-center> for more information about Patent Center and <https://www.uspto.gov/patents/docx> for information about filing in DOCX format. For additional questions, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hoang-Quan Ho
Primary Patent Examiner
Art Unit 2818

/Hoang-Quan Ho/
Primary Examiner, Art Unit 2818