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HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 8910
RESTON VA 20195

In re Application of	:	
Ovsiannikov et al.	:	
Application No. 13/297797	:	DECISION ON REQUEST
Filing or 371(c) Date: 11/16/2011	:	UNDER 37CFR 5.25
Attorney Docket Number:	:	
6668-000144/US	:	

Title of Invention: **DEPTH SENSOR, METHOD OF REDUCING NOISE IN THE SAME, AND SIGNAL PROCESSING SYSTEM INCLUDING THE SAME**

This is a decision on the "Request for Reconsideration of Petition Under 37 C.F.R. § 5.25 for Retroactive License," filed November 15, 2016.

The petition is **DENIED**.

BACKGROUND

The May 30, 2014 petition

Petitioner files a petition on May 30, 2014, including a Declaration of Sang-Jun JEON and Min-Ho KIM, IP staff of the assignee. Sang-Jun JEON and Min-Ho KIM both declared that they are responsible for and handle filings of patent applications, and that the subject matter was decided to be filed in Korea and in the U.S., but was first filed in Korea on November 26, 2010 without the requisite foreign filing license. Sang-Jun JEON and Min-Ho KIM provided that the subject matter of the proscribed foreign filing was first filed in Korea because they were not aware of the requirement under 35 U.S.C. 185. Sang-Jun JEON and Min-Ho KIM provided further that after discovery of the proscribed foreign filing they, along with Prime Intellectual Property Law Firm, have been diligent in seeking a retroactive foreign filing license.

A review of the declaration of Sang-Jun JEON and Min-Ho KIM revealed that the declaration was executed on May 23, 2014. In support of the petition, petitioner included, *inter alia*, an Exhibit E. A review of Exhibit E filed with the petition revealed that the email contained communications between petitioner herein and Prime Patents discussing the filing of the inventions and asserting that the inventions were filed in Korea in advance, without knowledge of 35 U.S.C. 185.... The communication was apparently from Jaeseok Yoon/Prime Intellectual Property Law Firm, to Gary D. Yacura at Harness, Dickey, & Pierce, P.L.C., petitioner herein. A

further review of the communication revealed that the communication was sent to Mr. Yacura via facsimile on June 20, 2011. Exhibit E also contained a separate email communication from Mr. Yacura to "prime", and copying Mr. Yoon, explaining that a retroactive foreign filing license may be applied for by meeting the requirements of 37 CFR 5.25. The email was dated June 21, 2011. Finally, also included in exhibit E, was a copy of an email reminder to Mr. Yacura dated November 15, 2013, to send evidence for obtaining the retroactive foreign filing licenses in these cases.

The petition was dismissed in a decision mailed October 17, 2014. The decision noted as an initial matter, that Jaeseok Yoon was aware of the requirement to obtain a foreign filing license for the subject matter of the present application in June, 2011. Also apparent was that Mr. Yoon was associated with prime patents, however, no information regarding Prime Patents or Mr. Yoon's connection with the subject matter of the present application was provided, save the conclusion by both Sang-Jun JEON and Min-Ho KIM that they along with Prime Patents were diligent in seeking the retroactive license, and copies of the email communications provided in Exhibit E. The decision required an explanation as to Prime Patents, and its relationship to the subject matter of the present application and the proscribed foreign filing, along with a declaration from Mr. Yoon regarding his relationship to the proscribed foreign filing.

The decision also noted that while both Sang-Jun JEON and Min-Ho KIM declared that they were responsible for and handle filings of patent applications, and that the subject matter was decided to be filed in Korea and in the U.S., but was first filed in Korea on November 26, 2011 without the requisite foreign filing license, neither Sang-Jun JEON and Min-Ho KIM stated that they were responsible for the filing of the subject matter of the present application without the requisite foreign filing license. Sang-Jun JEON and Min-Ho KIM were required to clarify whether they filed the application, and if not, a statement from the person who filed the application, that the proscribed foreign filing was done through error, was required.

As to Mr. Jaewoo Park of Samsung IP Law Group, the Decision noted that in a communication to Mr. Yacura from Prime IP Law Firm that Mr. Park was aware of the proscribed foreign filing and referenced email communication from Mr. Yacura dated June 21, 2011. A statement from Mr. Park of Samsung IP Law Group as to his relationship with Sang-Jun JEON and Min-Ho KIM, also employed by Samsung, and his connection with the proscribed foreign filings, was required.

Regarding diligence, the record demonstrated an awareness, at least by Mr. Yoon of Prime Patents, of the filing error in June 2011. However, the present petition was filed on May 30, 2014. An explanation was required as to how the filing of a petition in May, 2014 after discovery of the requirement to have obtained a foreign filing license prior to the proscribed foreign filing in June 2011 may be considered diligence, was required.

Further as to diligence, no explanation from declarants Sang-Jun JEON and Min-Ho KIM as to when they discovered the error had been provided. As such, whether Sang-Jun JEON and Min-

Ho KIM acted with diligence could not be determined. Sang-Jun JEON and Min-Ho KIM were required to provide when they became aware of the filing error.

The December 22, 2014 renewed petition

On December 22, 2014, petitioner filed a renewed petition and joint Declaration of Sang-Jun JEON and Min-Ho KIM; a Declaration from Jae Woo Park, and a Declaration from Jaeseok Yoon. Also filed with the petition were copies of letters and email communications from petitioner herein to Mr. Yoon in 2011, 2012, 2013 and 2014 regarding the filing of a petition for a retroactive foreign filing license for the subject matter of the present application.

Sang-Jun JEON and Min-Ho KIM, in relevant part, reiterated that they were responsible for and handle filings of patent applications, and that the subject matter in question was decided to be filed in Korea on November 26, 2010 without the requisite foreign filing license. Neither Sang-Jun JEON and Min-Ho KIM provided when they became aware of the error.

Jae Woo Park provided that in June or July 2011, Sang-Jun JEON and Min-Ho KIM notified Mr. Park that the subject matter in question was filed in Korea without the requisite foreign filing license because they were not aware of the license requirement. Mr. Park provided further that after learning of the proscribed foreign filing, he sent instructions to U.S. counsel and Mr. Jaeseok Yoon of Prime Patents to file a petition for a retroactive foreign filing license.

Mr. Jaeseok Yoon provided, in relevant part, that because of his difficulty with English language, he was frozen in his ability to provide the necessary evidence to prepare a petition for a retroactive foreign filing license. Even though he requested and received information regarding the petition for a retroactive foreign filing license, and even though he received several reminders to provide evidence to prepare a petition for a retroactive foreign filing license, his difficulty in understanding the English explanation left him unable to respond. Mr. Yoon declared that it was not until a Korean speaking representative visited his Office and explained the requirements and evidence to prepare a petition for a retroactive foreign filing license that he was able to act on this matter. Mr, Yoon did not provide when the Korean speaking representative visited his Office and explained the requirements and evidence to prepare a petition for a retroactive foreign filing license. *Yoon Declaration* at item 30.

A review of the petition confirmed that a person identified as Jaeseok Yoon, provides a statement of accurate translation[1] wherein Jaeseok Yoon declares that he is familiar with the Korean and English language and that he is the translator of the document(s) and certified that the translation is, to the best of his knowledge and belief a true and correct translation.

The renewed petition was dismissed in a Decision mailed April 8, 2015. The Decision dismissing the petition noted, as to the joint declaration of Sang-Jun JEON and Min-Ho KIM, that they

[1] The Joint Declaration of Sang-Jun JEON and Min-Ho KIM, item 1, describes the statement as a "statement of accurate translation."

reiterated that they were responsible for and handle filings of patent applications, and that the subject matter in question was decided to be filed in Korea on November 26, 2010 without the requisite foreign filing license. The decision reiterated that Sang-Jun JEON and Min-Ho KIM are required to clarify whether they filed this application, and if not, a statement from the person who filed the application, that the proscribed foreign filing was done through error, was required. Further as to Sang-Jun JEON and Min-Ho KIM, neither Sang-Jun JEON nor Min-Ho KIM had provided when they became aware of the error. Sang-Jun JEON and Min-Ho KIM were required to provide when they became aware of the filing error.

As to the Declaration of Mr. Jaeseok Yoon, the decision noted that Mr. Yoon provided, in relevant part, that because of his difficulty with English language, he was frozen in his ability to provide the necessary evidence to prepare a petition for a retroactive foreign filing license because of his difficulty in understanding the English explanation, which left him unable to respond. However, a review of the petition confirmed that a Jaeseok Yoon provided a statement of accurate translation, wherein Jaeseok Yoon declared that he is familiar with the Korean and English language and that he is the translator of the document(s) and certified that the translation is, to the best of his knowledge and belief a true and correct translation. Petitioner was required to clarify whether the Jaeseok Yoon who declared that he is familiar with the Korean and English language and that he is the translator of the document(s), and certified that the translation is, to the best of his knowledge and belief a true and correct translation, is the same Jaeseok Yoon who declared that that because of his difficulty with English language, he was frozen in his ability to provide the necessary evidence to prepare a petition for a retroactive foreign filing license because of his difficulty in understanding the English explanation, which left him unable to respond. If this is the same person, an explanation of the apparent disparity was required. If this was not the same person, petitioner was required to so state.

Finally, Mr. Yoon was required to provide when the Korean speaking representative visited his Office and explained the requirements and evidence to prepare a petition for a retroactive foreign filing license.

The July 2, 2015 renewed petition

Petitioner filed a renewed petition on July 2, 2015, along with declarations of Sang-Jung JEON and Min-Ho Kim, and Jaeseok Yoon. Mssrs. Jeon and Yoon provided that they instructed the Prime Intellectual Property Law Firm to prepare and file a Korean application on the subject matter in question, and that sometime in June or July 2011 they discovered that because the subject matter in question was made in the U.S., a license requirement under 35 U.S.C. 185 should have been satisfied before filing of an application of the subject matter in Korea. Messrs. Jeon and Yoon provided further that they then notified Mr. Jae Woo Park[2], the U.S. attorney employed by Samsung.

[2] Jae Woo Park of Samsung IP Law Group provided in a Declaration filed December 22, 2014, that in June or July 2011, Sang-Jun JEON and Min-Ho KIM notified Mr. Park that the subject matter in question was filed in Korea without the requisite foreign filing license because they were not aware of the license requirement. Mr. Park

Mr. Yoon provided further that on April 14, 2014, Mr. Sung Pil Kim visited his offices in Korea, and in the Korean language explained to Mr. Yoon the required evidence to prepare a petition for a retroactive foreign filing license. Mr. Yoon reiterates that because of his difficulty with understanding the content of the English language communications from Harness, Dickey and Pierce P.L.C. ("HDP"), regarding the evidence required to prepare a petition for a retroactive foreign filing license, he was frozen in his ability to provide the necessary evidence to prepare a petition for a retroactive foreign filing license, despite having requested and receiving several reminders to provide evidence to support the filing of a petition for a retroactive foreign filing license; his difficulty in understanding the content of the English explanations left him unable to respond.

The petition was dismissed in a decision mailed September 23, 2015. The decision dismissing the petition noted that, as to diligence, the Office finds that petitioner failed to demonstrate that the license has been diligently sought after discovery of the proscribed foreign filing. The record makes clear that Jaeseok Yoon, President of Prime Intellectual Property Law Firm responsible for handling filings of applications for Samsung Electronics Co., Ltd., was aware of the proscribed foreign filing and the requirement to obtain a retroactive foreign filing license based upon email communication(s) on June 21, 2011. The records further confirms that Mr. Yoon received letters and email communications from petitioner herein in 2011, 2012, 2013 and 2014 regarding the filing of a petition for a retroactive foreign filing license for the subject matter of the present application. The record is also clear that a petition for a retroactive foreign filing license was first filed in this application on May 30, 2014.

Mr. Yoon stated that he was frozen in his ability to provide the necessary evidence to prepare a petition for a retroactive foreign filing license, despite having requested and receiving several reminders to provide evidence to support the filing of a petition for a retroactive foreign filing license in 2011, 2012, 2013 and 2014, because of his difficulty in understanding the content of the English explanations, which left him unable to respond. However, the record is also clear that on September 30, 2014 Mr. Yoon declared that he is familiar with the Korean and English language.

Petitioner provided that the ability to translate between the two languages and the ability to understand the content of what is translated are distinctly different, and Mr. Yoon reiterated that it was his difficulty in understanding the content of the English explanations that left him unable to respond.

The decision stated that in this instance, the requirement under 37 CFR 5.25 is a showing that the license has been diligently sought after discovery of the proscribed foreign filing. Here, Mr. Yoon was made aware of the proscribed foreign filing in June 2011, and requested and received information regarding the petition for a retroactive foreign filing license, which included several

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provided further that after learning of the proscribed foreign filing, he sent instructions to U.S. counsel and Mr. Jaeseok Yoon of Prime Patents to file a petition for a retroactive foreign filing license.

reminders to provide evidence to prepare a petition for a retroactive foreign filing license in 2011, 2012, 2013 and 2014; however, instead of acting with diligence to seek the retroactive foreign filing license, Mr. Yoon was frozen to inaction for nearly three (3) years. Petitioner had therefore failed to demonstrate that the license has been diligently sought after discovery of the proscribed foreign filing.

The November 20, 2015 renewed petition

Petitioner files a third renewed petition on November 20, 2015 and averred that diligence is not an objective inquiry, but one viewed through the eyes of the declarant. Petitioner also admitted that "Mr. Yoon was frozen in his ability to provide the necessary evidence to prepare a petition for a retroactive filing license." *Renewed petition* at p.3. Petitioner asserted that there is a difference in the ability to translate between Korean and English and the ability to understand the content of what is translated are distinctly different, and conclude that diligence has been shown.

Petitioner alternatively requested waiver of 37 CFR 5.25(a)(3)(ii), which requires "[a] showing that the license has been diligently sought after discovery of the proscribed foreign filing." Petitioner notes that the failure to grant the petition would result in an unenforceable patent. Petitioner asserts that this is a distinctly identified extraordinary situation which would result in an unenforceable patent if not waived, and justice requires waiving or suspending the diligence requirement.

The third renewed petition was dismissed in a decision mailed September 23, 2016. The decision dismissing the third renewed petition again noted that the record makes clear that Jaeseok Yoon, President of Prime Intellectual Property Law Firm responsible for handling filings of applications for Samsung Electronics Co., Ltd., was aware of the proscribed foreign filing and the requirement to obtain a retroactive foreign filing license based upon email communication(s) on June 21, 2011. The records further confirms that Mr. Yoon received letters and email communications from petitioner herein in 2011, 2012, 2013 and 2014 regarding the filing of a petition for a retroactive foreign filing license for the subject matter of the present application. The record is also clear that a petition for a retroactive foreign filing license was first filed in this application on May 30, 2014.

The decision further noted that the record is also clear that on September 30, 2014 Mr. Yoon declared that he is familiar with the Korean and English language. Petitioner also admits that "Mr. Yoon was frozen in his ability to provide the necessary evidence to prepare a petition for a retroactive filing license." *Id.*

The decision reiterated that the requirement under 37 CFR 5.25 is a showing that the license has been diligently sought after discovery of the proscribed foreign filing. Here, Mr. Yoon was made aware of the proscribed foreign filing in June 2011, and requested and received information regarding the petition for a retroactive foreign filing license, which included several reminders to provide evidence to prepare a petition for a retroactive foreign filing license in 2011, 2012, 2013 and 2014; however, instead of acting with diligence to seek the retroactive foreign filing license,

Mr. Yoon failed to take action for nearly three (3) years. Petitioner has therefore failed to demonstrate that the license has been diligently sought after discovery of the proscribed foreign filing.

Waiver

Regarding waiver, petitioner noted that the failure to grant the petition would result in an unenforceable patent. Petitioner asserted that this is a distinctly identified extraordinary situation which would result in an unenforceable patent if not waived, and justice requires waiving or suspending the diligence requirement.

The decision dismissed the request for waiver. The decision informed petitioner that petitioner had failed to demonstrate that this is an extraordinary situation, where justice requires waiver of the rules. Here, Mr. Yoon was made aware of the proscribed foreign filing in June 2011, and requested and received information regarding the petition for a retroactive foreign filing license, which included several reminders to provide evidence to prepare a petition for a retroactive foreign filing license in 2011, 2012, 2013 and 2014; however, instead of acting with diligence to seek the retroactive foreign filing license, Mr. Yoon failed to take action for nearly three (3) years. Petitioner had therefore failed to demonstrate that the license has been diligently sought after discovery of the proscribed foreign filing. Petitioner was advised that circumstances are not extraordinary, and do not require waiver of the rules when a party makes an avoidable mistake in filing or not filing papers. Circumstances resulting from petitioner's failure to exercise due care, or lack of knowledge of , or failure to properly apply, the patent statutes or rules are not, in any event, extraordinary circumstances where the interest of justice require the granting of relief. *See, In re Tetrafluor Inc.*, 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990).

Moreover, a party's inadvertent failure to comply with the requirements of a rule is not deemed to be an extraordinary situation that would warrant waiver of a rule under 37 CFR 1.183, 2.146(a)(5) or 2.148. *See, Honigsbaum v. Lehman*, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995) (Commissioner did not abuse his discretion in refusing to waive requirements of 37 CFR 1.10(c) in order to grant filing date to patent application, where applicant failed to produce "Express Mail" customer receipt or any other evidence that application was actually deposited with USPS as "Express Mail."), aff'd without opinion, 95 F.3d 1166 (Fed. Cir. 1996); *Gustafson v. Strange*, 227 USPQ 174 (Comm'r Pat. 1985) (counsel's unawareness of 37 CFR 1.8 not extraordinary situation warranting waiver of a rule); *In re Chicago Historical Antique Automobile Museum, Inc.*, 197 USPQ 289 (Comm'r Pat. 1978) (since certificate of mailing procedure under 37 CFR 1.8 was available to petitioner, lateness due to mail delay not deemed to be extraordinary situation).

Finally the decision noted that assuming, *arguendo*, that the failure to follow 37 CFR 5.25(a)(3)(ii) was inadvertent based upon petitioner's assertion that the ability to translate between Korean and English and the ability to understand the content of what is translated are distinctly different, as noted *infra*, a party's inadvertent failure to comply with the requirements of a rule is not deemed to be an extraordinary situation that would warrant waiver of a rule.

THE PRESENT RENEWED PETITION

The present renewed petition for a retroactive foreign filing license

Petitioner files the present renewed petition for a retroactive foreign filing license, and incorporates the prior petitions by reference. Petitioner submits that Mr. Yoon was frozen in his ability to provide the necessary evidence to prepare a petition for a retroactive foreign filing license, and that after a visit from Mr. Sung Pil Kim from Harness, Dickey & Pierce, P.L.C., in Mr. Yoon's office in Korea, Mr. Yoon became active in providing the necessary evidence to prepare a petition for a retroactive foreign filing license.

Applicable Law and Rules

35 U.S.C. 185, Patent barred for filing without license. (Sept. 16, 2012), states:

> Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in section 184, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives shall be invalid, unless the failure to procure such license was through error, and the patent does not disclose subject matter within the scope of section 181.

37 CFR § 5.25 requires the following:

> (a)
> 1. A listing of each foreign country in which the unlicensed patent application material was filed.
> 2. The dates on which the material was filed in each country,
> 3. A verified statement (oath or declaration) containing:
>   i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order.
>   ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
>   iii. An explanation of why the material was filed abroad through error without the required license under § 5.11 first having been obtained, and
> 4. The required fee (§ 1.17(g)).
>
> (b) The explanation in paragraph (a) of this section must include a showing of facts rather than a mere allegation of action through error. The showing of facts as to the nature of the error should

include statements by those persons having personal knowledge of the acts regarding filing in a foreign country and should be accompanied by copies of any necessary supporting documents such as letters of transmittal or instructions for filing. The acts which are alleged to constitute error without deceptive intent should cover the period leading up to and including each of the proscribed foreign filings.

The present renewed petition to waive or suspend the diligence requirement

Petitioner files the present renewed request to waive or suspend the diligence requirement. In support of the renewed request, petitioner asserts that the failure to grant the request would exalt form over substance. Petitioner avers that but for the procedural requirement of the regulation, applicants would qualify for a retroactive foreign filing license, and denial of a retroactive foreign filing license would result in penalizing applicants who are candid and willing to correct the failure to comply with the diligence requirement of 37 CFR 5.25(a)(3)(ii).

Petitioner reiterates that Mr. Yoon was frozen to inaction until Mr. Kim visited Mr. Yoon's office. Petitioner avers that Mr. Yoon had difficulty in understanding the contents and meaning of the regulatory requirements, and was frozen to inaction. Petitioner acknowledges that Mr. Yoon procrastinated his action to a later date.

Applicable Law, Rules and/or MPEP

37 CFR § 1.183 provides that in an extraordinary situation, when justice requires, any requirement of the regulations which is not a requirement of the statutes may be suspended or waived by the Commissioner. In order for grant of a petition under 37 CFR § 1.183, petitioners must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. *In re Sivertz*, 227 U.S.P.Q. 255,256 (Comm'r Pat. 1985).

Discussion

Petitioner has failed to demonstrate that this is an extraordinary situation, where justice requires waiver of the rules. Here, 37 CFR 5.25(a)(3)(ii) requires a showing that the license has been diligently sought after discovery of the proscribed foreign filing. As noted in the prior decision, dismissing the third renewed petition, Mr. Yoon was made aware of the proscribed foreign filing in June 2011, and requested and received information regarding the petition for a retroactive foreign filing license, which included several reminders to provide evidence to prepare a petition for a retroactive foreign filing license in 2011, 2012, 2013 and 2014; however, instead of acting with diligence to seek the retroactive foreign filing license, Mr. Yoon failed to take action for nearly three (3) years. Petitioner has therefore failed to demonstrate that the license has been diligently sought after discovery of the proscribed foreign filing. Petitioner is again advised that circumstances are not extraordinary, and do not require waiver of the rules when a party makes an avoidable mistake in filing or not filing papers. Circumstances resulting from petitioner's failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules are not, in any event, extraordinary circumstances where the interest of justice

require the granting of relief. *See In re Tetrafluor Inc.*, 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990).

Further to this, regarding petitioner's assertion that Mr. Yoon had difficulty in understanding the contents and meaning of the regulatory requirements, and was frozen to inaction, this decision reiterates that filed with the original petition on May 30, 2014, is a statement signed by Mr. Yoon wherein Mr. Yoon states:

> I, Jaeseok Yoon, an employee of 7F, 159, Yeoksam0ro, Gangnam-gu, Seoul, 135-925, Republic of Korea, hereby declare that I am familiar with the Korean and English language and that I am the translator of the document and certify that the following is to the best of my knowledge and belief a true and correct translation.

In addition, the Office notes that Mr. Yoon was not operating in a vacuum in this matter. As noted *infra*, Mr. Yoon was, during the relevant period, President of Prime Intellectual Property Law Firm, a Korean law firm responsible for and handling filings of patent applications (domestic and abroad) for Samsung Electronics Co., Ltd. Mr. Yoon had previously requested advice regarding the proscribed foreign filing from Harness, Dickey & Pierce, a U.S. law firm handling filing of patent applications (domestic and abroad) for Samsung Electronics Co., Ltd., on June 20, 2011. *Yoon Declaration filed December 22, 2014*, para. 5. The following day Mr. Yoon received a letter from Mr. Yacura explaining that a petition for a retroactive foreign filing license would have to be filed. *Yoon Declaration filed December 22, 2014*, para. 6.

In this instance, petitioner would ask this Office to accept that the President of Prime Intellectual Property Law Firm, a Korean law firm responsible for and handling filings of patent applications (domestic and abroad) for Samsung Electronics Co., Ltd., and the person who declared that he is familiar with the Korean and English language, was frozen to inaction because of his difficulty in understanding the contents and meaning of the diligence requirement of 37 CFR 5.25(a)(3)(ii).

Petitioner further asks this Office to accept that even after receiving letters and email communications from petitioner herein in 2011, 2012, 2013 and 2014 regarding the filing of a petition for a retroactive foreign filing license for the subject matter of the present application, Mr. Yoon was frozen to inaction because of his difficulty in understanding the contents and meaning of the diligence requirement of 37 CFR 5.25(a)(3)(ii), despite having myriad IP professionals who were responsible for and handled filings of patent applications (domestic and abroad, including the U.S.) for Samsung Electronics Co., Ltd., at his disposal.

Petitioner argues that denying a petition based upon applicant's mistaken non-compliance would do great injustice to applicants; however, as noted in the prior decision, a party's inadvertent failure to comply with the requirements of a rule is not deemed to be an extraordinary situation that would warrant waiver of a rule under 37 CFR 1.183, 2.146(a)(5) or 2.148. *See Honigsbaum v. Lehman*, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995) (Commissioner did not abuse his discretion in refusing to waive requirements of 37 CFR 1.10(c) in order to grant filing date to patent application, where applicant failed to produce "Express Mail" customer receipt or any

other evidence that application was actually deposited with USPS as "Express Mail."), aff'd without opinion, 95 F.3d 1166 (Fed. Cir. 1996); *Gustafson v. Strange*, 227 USPQ 174 (Comm'r Pat. 1985) (counsel's unawareness of 37 CFR 1.8 not extraordinary situation warranting waiver of a rule); *In re Chicago Historical Antique Automobile Museum, Inc.*, 197 USPQ 289 (Comm'r Pat. 1978) (since certificate of mailing procedure under 37 CFR 1.8 was available to petitioner, lateness due to mail delay not deemed to be extraordinary situation).

As noted *infra*, in order for grant of a petition under 37 CFR § 1.183, petitioners must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. Petitioner has not shown that either condition exists in this case.

The fee for the petition under 37 CFR 1.183 has been charged to petitioner's deposit account as authorized in the fourth renewed petition.

Conclusion

Pursuant to 37 CFR §§1.183 and 5.25(c), the petitions are **denied**. Petitioner may file a petition under 37 CFR 1.181 within two months from the mailing date of this decision. The two-month period is not extendable. See 37 CFR 1.181(f). If no petition under 37 CFR 1.181 is timely filed, the denial of petition under 37 CFR 5.25 will stand and a final rejection of the application under 35 U.S.C. 185 will be made.

Telephone inquiries concerning this matter should be directed to Attorney Advisor Derek Woods at (571) 272-3232.

/ROBERT CLARKE/
Robert A. Clarke
Patent Attorney
Office of the Deputy Commissioner
for Patent Examination Policy