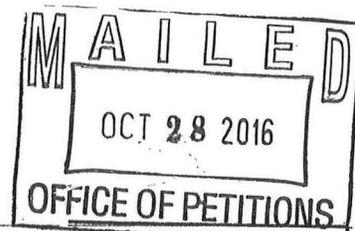




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In re Application of  
Euipil KWON :  
Application No. 13/750,387 : DECISION ON REQUEST  
Filing Date: January 25, 2013 : UNDER 37 CFR 5.25  
Attorney Docket Number: 2354.1003 :

**Title of Invention: NONVOLATILE MEMORY DEVICE AND METHOD OF FABRICATING THE SAME**

This is a decision following the mailing of the decision on February 21, 2013 on the petition pursuant to 37 C.F.R. § 5.25, seeking a retroactive license for foreign filing under 35 U.S.C. § 184.

The petition is **DENIED**.

The fees for the previously filed petition on February 15, 2013 were inadvertently charged at the undiscounted rate. However, the fees should have been charged at the small entity rate as the applicant remains a small entity. Petitioner can request a refund of the \$300 excess amount charged by filing a written request. A copy of this decision should be included with such a request.

Applicable Law, Rules and MPEP

37 CFR § 5.25 provides:

- (a) A petition for retroactive license under 35 U.S.C. 184 shall be presented in accordance with § 5.13 or § 5.14(a), and shall include:
  - (1) A listing of each of the foreign countries 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 and without deceptive intent without the required license under § 5.11 first having been obtained, and
- (4) The required fee (§ 1.17(g) of this chapter).

(b) The explanation in paragraph (a) of this section must include a showing of facts rather than a mere allegation of action through error and without deceptive intent. 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.

Statements of error must be supported by fact. They should not merely be conclusory but must include how and why the error occurred.

In addition, the above explanation (37 CFR 5.25(a)(3)(iii)) must include a showing of facts rather than a mere allegation of action through error and without deceptive intent. The showing of facts as to the nature of the error should include statements by all those persons responsible for or 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.

### Analysis

As noted in the decision mailed February 21, 2013, the petition filed February 15, 2013 complies with requirements 37 C.F.R. § 5.25(a)(3)(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,<sup>1</sup> and complies with 37 C.F.R. § 5.25(a)(4) as it includes the required \$200 petition fee. It also satisfies the requirement of 37 C.F.R. § 5.25(a)(3)(iii). Petitioner has also complied with the requirements of 37 C.F.R. § 5.25(a)(1) as the petition lists the foreign country in which the unlicensed patent application material was filed.

The petition does not comply with requirements (2) and (3)(ii) of 37 C.F.R. §§ 5.25 (a). A discussion follows.

As to 37 CFR 5.25(a)(2), the listing of the date(s) on which the unlicensed patent application material was filed in another country, as stated by the petitioner, appears to be incomplete when compared to the verified statement by inventor Kwon.<sup>2</sup>

As to 37 C.F.R. § 5.25 (a)(3)(ii), the petition does not contain a showing that the license has been diligently sought after discovery of the proscribed foreign filing. Petitioner states<sup>3</sup> that he

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<sup>1</sup> Verified statement from Youngsu Jeong.

<sup>2</sup> Korean Patent application 10-2011-0085734 filed August 26, 2011 and the Korean Patent Application 10-2012-0025607 filed March 27, 2012 have not been listed by the petitioner.

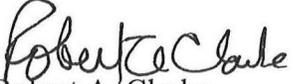
advised the inventor the need for a foreign filing license on or about June 28, 2012. However, this petition was not filed until nearly six months later.

### Conclusion

Petitioner has not filed a timely response to the above noted decision on petition mailed February 21, 2013. Pursuant to 37 C.F.R. § 5.25(c), the petition under 37 C.F.R. § 5.25 is denied. Petitioner may file a petition under 37 C.F.R. § 1.181 within two months from the mailing date of this decision. The two-month period is not extendable. See 37 C.F.R. § 1.181(f). If no petition under 37 C.F.R. § 1.181 is timely filed, the denial of petition under 37 C.F.R. § 5.25 will stand and a final rejection of the application under 35 U.S.C. § 185 will be made.

The renewed petition may be submitted by mail,<sup>4</sup> hand-delivery,<sup>5</sup> facsimile,<sup>6</sup> or via EFS-Web. The reconsideration request should include a cover letter entitled "Request for Reconsideration of Petition under [insert the applicable code section]". This is not a final agency action within the meaning of 5 U.S.C § 704.

Telephone inquiries concerning this matter should be directed to Ramesh Krishnamurthy at (571) 272-4914.

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

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<sup>3</sup> Verified statement from Sang Chul Kwon.

<sup>4</sup> Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

<sup>5</sup> Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

<sup>6</sup> (571) 273-8300: please note this is a central facsimile number.