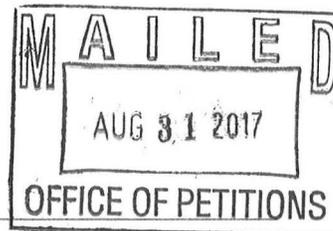




UNITED STATES PATENT AND TRADEMARK OFFICE



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Applicant: :  
Chalenko :  
Application No. 29/550050 : DECISION ON REQUEST  
Filing or 371(c) Date: 12/30/2015 : UNDER 37CFR 5.25  
Attorney Docket Number: :  
BEAG-100-D :

Title of Invention: **UNIVERSAL LENS ADAPTER**

This is a decision on the “Petition for Retroactive Foreign Filing License Under 35 U.S.C. § 184 and 37 CFR § 5.25 and § 5.14(a),” filed February 11, 2016.

The petition is **DENIED**.

The February 11, 2016 petition

Petitioner filed a petition and Declaration on February 11, 2016, wherein petitioner provided, in relevant part, that on January 4, 2016 he sent an email instructing the filing of the subject matter of the present application prior to January 9, 2015. Petitioner and Declarant further provided that at the time the email was sent, he had not received a foreign filing license, and did not know whether the foreign filing license would be received prior to January 9, 2015, but that he made the decision that if the proscribed foreign filing was delayed until the foreign filing license was received, and it was received after January 9, 2016, the granting of a valid Canadian design patent might not be available to the inventor. Based upon this judgment, petitioner and Declarant herein instructed the proscribed foreign filing at the earliest possible date prior to January 9, 2016. Petitioner and Declarant herein stated that he was aware of the availability of a petition for a retroactive foreign filing license and anticipated that this petition might be necessary under the circumstances set forth herein, and acted according to his best judgment. Petitioner and Declarant herein averred that the error was an error in judgment. Specifically, petitioner and Declarant herein averred that the error was in not seeking an expedited issuance of the 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

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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. (Emphasis added).

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.

In the Decision on the petition mailed on October 25, 2016, the Office provided the following:

As is made clear by 35 U.S.C. § 1.84(a) cited above, the USPTO has only the authority to grant a petition under 37 CFR 5.25 where petitioner establishes that the proscribed application filing was filed through error. Here, petitioner provides that at the time the email was sent, he had not received a foreign filing license, and did not know whether the foreign filing license would be received prior to January 9, 2015, but that he made the decision that if the proscribed foreign filing was delayed until the foreign filing license was received, and it was received after January 9, 2016, the granting of a valid Canadian design patent might not be available to the inventor.

Further to this, Petitioner and Declarant herein states that he was aware of the availability of a petition for a retroactive foreign filing license and anticipated that this petition might be necessary under the circumstances set forth herein, and acted according to his best judgment.

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As noted above, the showing required to obtain a retroactive foreign filing license is that the proscribed foreign filings were done through error. Here, the record implies an intentional act; the filing of the application in a foreign country with the knowledge that no foreign filing license had been obtained; knowing that the failure to receive a foreign filing license prior to January 9, 2016 could result in the loss of patent rights in Canada, and with the knowledge that a retroactive foreign filing license was available where the proscribed foreign filing was made through error.

Petitioner instructed the proscribed foreign filing knowing that the filing of the subject matter of the above-identified application required a foreign filing license prior to filing; knowing that no foreign filing license had been granted; knowing that the subject matter of the application was up against a filing deadline, and knowing that where a filing is shown to have been in error, a retroactive foreign filing license is available. The conclusion is that petitioner intentionally instructed the filing of the subject matter of the application on January 4, 2016, to be filed *at the earliest date prior to January 9, 2016*, without the requisite foreign filing license knowing that a retroactive foreign filing license was available. *Declaration* at p.3. *Emphasis added*. The email request was accompanied by a copy of the application. The application could therefore have been filed on January 4, 2016, or January 5, 2016, and was in fact filed on January 6, 2016. Petitioner asks this Office to accept the intentional act as an error in judgment. Specifically, petitioner and Declarant herein avers that the error was in not seeking an expedited issuance of the foreign filing license. However, petitioner and Declarants actions indicate a disregard for the laws of the U.S. when juxtaposed against the potential loss of patent rights in Canada. Petitioner instructed the proscribed foreign filing knowing no license had been obtained, and knowing that a retroactive foreign filing license was available where the proscribed foreign filing was through error, and asks this Office to believe that petitioner and Declarant's apparent disregard for 35 U.S.C. 184, which states that "[e]xcept when authorized by a license obtained from the Commissioner of Patents a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country, was an error in judgment because the license was not received prior to the proscribed foreign filing. (Emphasis added). However, petitioner and Declarant herein knew the license was not received prior to giving the instruction to file the application. Petitioner and Declarant, in contravention of the statute, caused or authorized to be filed in a foreign country an invention made in this country without a foreign filing license. Petitioner is required to explain why the instruction to file the application without the foreign filing license was an error.

### Conclusion

Accordingly, the provisions of 37 CFR 5.25 not having fully been met, the petition is DISMISSED, and in the absence of any response within 60 days of the mailing date of

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this decision, such dismissal will be made final and a final action under 35 U.S.C. 185 will be taken. Extensions of time are available under 37 CFR 1.136(a).

Decision

Petitioner has not filed a timely response to the decision on petition mailed October 25, 2016. Pursuant to 37 CFR 5.25(c), the petition under 37 CFR 5.25 is **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.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                    Director for Patents  
                                 PO Box 1450  
                                 Alexandria, VA 22313-1450

By FAX:                    (571) 273-8300  
                                 Attn: Office of Petitions

By hand:                   Customer Service Window  
                                 Randolph Building  
                                 401 Dulany Street  
                                 Alexandria, VA 22314

Registered users of EFS-Web may alternatively submit their response to this decision via EFS-Web.

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

CC:    Rockman, Videbeck & O'Connor  
         1 S. 376 Summit Avenue  
         Court C  
         Oakbrook Terrace, IL 60181  
         Attn: Mercedes O'Connor