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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/472,814	12/24/2003	Gordon Calundann	15588-00005-US	9746

23416 7590 10/15/2014
NOVAK DRUCE CONNOLLY BOVE + QUIGG LLP
(DE OFFICE)
1875 EYE STREET, N.W.
SUITE 1100
WASHINGTON, DC 20006

EXAMINER

FORTUNA, ANA M

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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10/15/2014

PAPER

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.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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In re Application of :
Calundann et al. :
Application No. 10/472814 : DECISION ON REQUEST
Filing or 371(c) Date: 12/24/2003 : UNDER 37CFR 5.25
Patent Number: 7,384,552 :
Issue Date: 06/10/2008 :
Attorney Docket Number: :
15588-00005-US :

Title of Invention: **PROTON-CONDUCTING MEMBRANE AND THE USE THEREOF**

This is a decision on the “Petition for Retroactive Foreign Filing License Under 37 C.F.R. § 5.25,” filed June 13, 2014.

This Petition is hereby **dismissed**.

Any further petition must be submitted within 60 DAYS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled “Request for Reconsideration of Petition under [insert the applicable code section]”.

The present petition

Petitioner files the present petition, along with the Declaration of Dr. Claus Kaliba, Senior Patent Counsel employed by BASF. Petitioner provides that Dr. Kaliba filed German Application No. 10117686.4 on April 9, 2001, and based upon this application, also caused further PCT and foreign national/regional phase applications identified in an appendix to the present petition, to be filed. Petitioner provides further that based upon a meeting in November 2013 between petitioner herein and employees of the BASF Biotechnology patent group, including Dr. Marcus Ebneht, a review of BASF’s patent applications was initiated to determine whether there were any applications with subject matter that may have been invented in the United States but filed abroad without the requisite foreign filing license. The present invention was identified in February, 2014 as potentially being at least partly invented in the United States. Dr. Kaliba provides that the subject matter of U.S. application 10/472814 was not under a secrecy order at the time it was filed abroad and is not currently under a secrecy order.

Dr. Kaliba provides further that he caused the above identified applications to be filed (including those listed in the appendix filed with the present petition), unaware of the requirement to obtain a foreign filing license for an invention made in the United States before filing patent applications directed to said inventions in countries outside of the United States. Dr. Kaliba states that the invention claimed in the present U.S. application was identified to him by Dr. Ebneht as potentially

Art Unit: OPET

having been at least partly invented in the United States, and petitioner indicates that Dr. Kaliba was made aware of this potential on or about March 14, 2014. No statement from Dr. Ebneith has been provided.

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, as in reissue practice. *See*, for example, cases like *Site Microsurgical Systems Inc., v. Surgin Surgical Instruments, Inc.* 32 USPQ2d 1161, 1171. (The mere conclusion that the error was made through oversight in drafting by the patent attorney, without more, falls short of what the regulation requires).

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

Art Unit: OPET

Petitioner and Declarant both provide that Dr. Kaliba filed the applications without first obtaining the requisite foreign filing license because he was unaware of the requirement to obtain a foreign filing license in this instance prior to the proscribed foreign filing(s). As noted above, statements of error must be supported by fact. They should not merely be conclusory but must include how and why the error occurred. In this regard, Dr. Kaliba's statement is analogous to the situation cited in *Site Microsurgical Systems Inc., supra* (The mere conclusion that the error was made through oversight in drafting by the patent attorney, without more, falls short of what the regulation requires). Here, petitioner and Declarant provide that as a result of a review of BASF's patent applications, initiated to determine whether there were any applications with subject matter that may have been invented in the United States but filed abroad without the requisite foreign filing license, the present invention was identified in February, 2014 as potentially being at least partly invented in the United States. However, statements of error must be supported by fact: They should not merely be conclusory but must include how and why the error occurred. Petitioner must explain how the error occurred. A showing of facts as to the nature of the error, by those persons having personal knowledge of the acts regarding filing in a foreign country, is required. Specifically, Petitioner is required to provide a statement of facts - by all those persons responsible for or having personal knowledge of the acts regarding filing in a foreign country - that includes an explanation of how the conclusion was reached that the present invention was potentially at least partly invented in the United States.

Moreover, while petitioner states that Dr. Kaliba filed the application, Dr. Kaliba states that he caused the application to be filed. Petitioner should clarify whether Dr. Kaliba filed the application. If Dr. Kaliba did not file the application, a statement from the person at BASF who filed the application, that the proscribed foreign filing was done through error, is required.

Further to this, as noted *supra*, the showing of facts as to the nature of the error should be accompanied by copies of any necessary supporting documents such as letters of transmittal or instructions for filing. In this instance, the subject matter of the above-identified application was filed in several countries identified in Appendix I, without first obtaining a foreign filing license. Copies of any letters of transmittal or instructions for filing are required.

Finally, a review of the Declaration confirms that Dr. Kaliba states that the subject matter of the above-identified U.S. application was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order. The applicable Rule, 37 CFR § 5.25(a)(3)(i), requires 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. Here, the subject matter in question is the subject matter of the German Application No. 10117686.4, filed on April 9, 2001, and the further PCT and foreign national/regional phase applications identified in an appendix to the present petition. A statement that the subject matter in question, i.e., subject matter of the proscribed filings, was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order, is required.

Conclusion

Art Unit: OPET

Accordingly, the provisions of 37 CFR 5.25 not having fully been met, the petition is DISMISSED. A response is due within 60 days of the mailing date of this decision. Extensions of time are available under 37 CFR 1.136(a).

A review of the petition reveals that the address appearing on the petition differs from the correspondence address of record. Applicant is advised that, in patented files: requests for changes of correspondence address should be addressed to: Mail Stop Post Issue, PO Box 1450 Alexandria, VA 22313-1450.

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.

/ Ramesh Krishnamurthy/

Ramesh Krishnamurthy
Petitions Examiner
Office of Petitions

CC: Brinks Gilson & Lione
 4721 Emperor Boulevard
 Suite 220
 Durham, NC 27703

Transmittal Communication on Petition	Application No. 10/472,814	Applicant/Patent Under Reexamination CALUNDANN ET AL.	
	Deciding Official DEREK WOODS	Office of Petitions OPET	

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

(ADDITIONAL PARTY'S CORRESPONDENCE ADDRESS)

Brinks Gilson & Lione
4721 Emperor Boulevard
Suite 220
Durham, NC 27703

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified Application/Patent.

Application No.

10472814



For US serial numbers: enter number only, no slashes or commas. Ex: 10123456

For PCT: enter "51+single digit of year of filing+last 5 numbers", Ex. for PCT/US05/12345, enter 51512345

Deciding Official:

Woods, Derek

Count (1) - Palm Credit

10/472,814

FINANCE WORK NEEDED

Decision: DISMISSED

Select Check Box for YES



Decision Type: 420 - Foreign Filing License Request

Notes:

Count (2)

Decision: n/a

FINANCE WORK NEEDED

Select Check Box for YES

Decision Type: NONE

Notes:

Count (3)

Decision: n/a

FINANCE WORK NEEDED

Select Check Box for YES

Decision Type: NONE

Notes:

Initials of Approving Official (if required)

If more than 3 decisions, attach 2nd count sheet & mark this box

