

PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1
 Stylesheet Version v1.2

EPAS ID: PAT3998637

SUBMISSION TYPE:	NEW ASSIGNMENT	
NATURE OF CONVEYANCE:	ASSIGNMENT	
CONVEYING PARTY DATA		
	Name	Execution Date
	DR. DEEPAK VARSHNEYA	08/09/2016
RECEIVING PARTY DATA		
Name:	DR. DEEPAK VARSHNEYA	
Street Address:	6319 CAVALIER CORREDOR	
City:	FALLS CHURCH	
State/Country:	VIRGINIA	
Postal Code:	22044	
PROPERTY NUMBERS Total: 1		
	Property Type	Number
	Application Number:	14140163
CORRESPONDENCE DATA		
Fax Number:		
<i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.</i>		
Phone:	7035418439	
Email:	dvarshneya@xerowind.com	
Correspondent Name:	DR. DEEPAK VARSHNEYA	
Address Line 1:	6319 CAVALIER CORREDOR	
Address Line 4:	FALLS CHURCH, VIRGINIA 22044	
NAME OF SUBMITTER:	DEEPAK VARSHNEYA	
SIGNATURE:	/D. Varshneya/	
DATE SIGNED:	08/09/2016	
	This document serves as an Oath/Declaration (37 CFR 1.63).	
Total Attachments: 5		
source=9127911 Reassignment 2016-08-09#page1.tif		
source=9127911 Reassignment 2016-08-09#page2.tif		
source=9127911 Reassignment 2016-08-09#page3.tif		
source=9127911 Reassignment 2016-08-09#page4.tif		
source=9127911 Reassignment 2016-08-09#page5.tif		

**RECORDATION FORM COVER SHEET
PATENTS ONLY**

To the Director of the U.S. Patent and Trademark Office: Please record the attached documents or the new address(es) below.

1. Name of conveying party(ies)

Deepak Varshneya

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

2. Name and address of receiving party(ies)

Name: Deepak Varshneya

Internal Address: _____

Street Address: 6319 Cavalier Corridor

City: Falls Church

State: Virginia

Country: United States of America Zip: 22004

Additional name(s) & address(es) attached? ☐ Yes ☒ No

3. Nature of conveyance/Execution Date(s):

Execution Date(s) _____

☐ Assignment

☐ Merger

☐ Security Agreement

☐ Change of Name

☐ Joint Research Agreement

☐ Government Interest Assignment

☐ Executive Order 9424, Confirmatory License

☒ Other Correct error in previous assignment

4. Application or patent number(s):

☐ This document is being filed together with a new application.

A. Patent Application No.(s)

B. Patent No.(s)

14/140,163

US 9,127,911

Additional numbers attached? ☐ Yes ☒ No

5. Name and address to whom correspondence concerning document should be mailed:

Name: Deepak Varshneya

Internal Address: _____

Street Address: 6319 Cavalier Corridor

City: Falls Church

State: Virginia Zip: 22044

Phone Number: 703-541-8439

Docket Number: none

Email Address: dvarshneya@xetowind.com

6. Total number of applications and patents involved: two (2)

7. Total fee (37 CFR 1.21(h) & 3.41) \$0.00

☐ Authorized to be charged to deposit account

☐ Enclosed

☐ None required (government interest not affecting title)

8. Payment Information

Deposit Account Number none

Authorized User Name none

9. Signature:

D. Varshneya

Signature

8/9/2016

Date

Deepak Varshneya

Name of Person Signing

Total number of pages including cover sheet, attachments, and documents:

5

Documents to be recorded (including cover sheet) should be faxed to (571) 273-0140, or mailed to:
Mail Stop Assignment Recordation Services, Director of the USPTO, P.O.Box 1450, Alexandria, V.A. 22313-1450

DECLARATION OF DR. DEEPAK VARSHNEYA

Regarding the unconstitutional and erroneous assignment of U.S. Patent 9,157,701 and U.S. Patent 9,127,911 by the Defense Advanced Research Projects Agency ("DARPA") to itself in violation of legal and proper patent ownership rights of Dr. Deepak Varshneya to the entire rights, titles, and interests in the Patents.

I, Dr. Deepak Varshneya ("Dr. Varshneya"), hereby state the following to be true and correct based upon my personal knowledge:

1. I, Dr. Varshneya, am an inventor and owner and proper assignee of the entire right, title, and interest of U.S. Patent 9,157,701 and U.S. Patent 9,127,911 (the "Patents").
2. Without my knowledge or consent, the Defense Advanced Research Projects Agency ("DARPA"), in violation of my constitutional right to due process, and without justification or factual basis, wrongfully took my property, the Patents, by wrongfully filing assignments of the Patents to itself, DARPA.

Re: U.S. Patent 9,127,911:

3. The assignment to me, Dr. Varshneya, of the entire right, title, and interest of U.S. Patent 9,127,911 was recorded on July 18, 2014 at Reel/Frame: 33346 / 0305.
4. Without notice of its claim and without knowledge or approval by Dr. Varshneya, The Office of General Counsel of the Defense Advanced Research Projects Agency ("DARPA") filed and caused to be recorded a wrongful assignment of U.S. Patent 9,127,911 to DARPA, on May 23, 2016. The wrongful assignment is recorded at Reel/Frame: 038814 / 0532.
5. Pursuant to the guidance of the Manual of Patent Examination Procedure ("MPEP") § 323.01(c), I am filing this assignment to correct the improper assignment by DARPA.

Re: U.S. Patent 9,157,701:

6. The assignment to me, Dr. Varshneya, of the entire right, title, and interest of U.S. Patent 9,157,701 was recorded on August 4, 2014 at Reel/Frame: 033456 / 0909.
7. On December 22, 2015, Cubic Defense Applications, Inc. ("Cubic") filed and recorded a wrongful and unauthorized re-assignment of this patent by to itself, Frame/Reel 037371 / 0421. In order to correct the record, I, Dr. Varshneya, re-assigned the patent to myself on June 3, 2016, which re-assignment was recorded on June 20, 2016 at Reel/Frame: 038792 / 0324.
8. Without notice of its claim and without knowledge or approval by Dr. Varshneya, the Office of General Counsel of the Defense Advanced Research Projects Agency

("DARPA") filed and caused to be recorded a wrongful assignment of U.S. Patent 9,157,701 to DARPA, on May 24, 2016. The wrongful assignment is recorded at Reel/Frame: 038813 / 0774.

9. Pursuant to the guidance of the Manual of Patent Examination Procedure ("MPEP") § 323.01(c), I am filing this assignment to correct the improper assignment by DARPA.

Taking of Property without Constitutional Due Process:

10. At the time I filed the application for the 9,127,911 Patent, on December 24, 2013, I was an employee of DARPA, and not a government contractor or sub-contractor.
11. When I filed the application that issued as the 9,157,701 Patent on August 21, 2014, I was not an employee of DARPA although the application claims priority to the filing date of the 9,127,911 Patent.
12. 37 CFR Part 501 establishes the "Uniform Patent Policy for Rights in Inventions made by Government Employees."
13. Pursuant to Federal Regulations, the Government is limited in what patents it may claim rights, specifically limited to those inventions falling within specific limited factual circumstances, stated in the Regulation as follows:

(1) The Government shall obtain, except as herein otherwise provided, the entire right, title and interest in and to any invention made by any Government employee:

(i) During working hours, or

(ii) With a contribution by the Government of facilities, equipment, materials, funds or information, or of time and services of other Government employees on official duty, or

(iii) Which bears a direct relation to or is made in consequence of the official duties of the inventor.

37 CFR § 501.6(a)(1).

14. With regard to the Patents, none of the work done was done during my working hours. All work on the inventions in the Patents was done by me and the co-inventors on my own time, outside of work.
15. With regard to the Patents, there was no contribution by the Government of facilities, equipment, materials, funds, or information, or of time and services of other Government employees on official duty. All costs related to the Patents, including without limitation development, filing, prosecution, and maintenance and defense, have been paid by me.

All facilities, equipment, materials, funds, and information were provided by me. No other Government employee contributed anything of their services on official duty.

16. With regard to the Patents, the subject matter of the inventions bears no direct relation to or were made in consequence of my official duties. The inventions of the Patents are outside the scope of my official duties.
17. 37 CFR § 501.6(a)(3) establishes regulations to apply the provisions of 37 CFR § 501.6(a)(1) to facts where the inventor is employed to conduct or supervise research, act as a liaison, etc. for work within the provisions of § 501.6(a)(1).
18. The subject matter of the Patents was not within my supervisory and related duties as a Program Manager at the Adaptive Execution Office of DARPA.
19. Appropriate DARPA officials were placed on notice by me of my intention to file the 9,127,911 patent application and of the scope and content of the application. I did not discuss filing the 9,157,701 patent application with DARPA officials because I was not an employee of DARPA at that time.
20. Pursuant to 37 CFR §§ 501.7 and 501.8, prior to re-assigning the patents to itself, DARPA was required to have given me, as the inventor and proper holder of all right, title, and interest of the Patents, notice and an opportunity to be heard with regard to DARPA's claim of ownership of the patents.
21. As stated in the Regulations, the Government was required to give me specific written notice of its claim to my invention, as stated in the Regulation as follows:

(c) In the case of a determination [that the government is entitled to obtain title to the patents] under either paragraph (a) or (b) of this section, the agency shall promptly provide the employee with:

(1) A signed and dated statement of its determination and reasons therefore; and

(2) A copy of 37 CFR part 501.

37 CFR §§ 501.7(c).

22. As of the date of the signing of this Declaration, I have not received a notice from DARPA as required pursuant to 37 CFR §§ 501.7(c), nor have I received any notice whatsoever of the Government's claim to the Patents. I only discovered DARPA's wrongful assignment by accident when I was checking to see that my re-assignments to myself, resulting from the Cubic wrongful assignment, were in effect.
23. Further, as also stated in the Regulations, the Government was required to give me an opportunity to be heard on its claim to my inventions, as stated in the Regulation as

follows:

- (a) Any Government employee who is aggrieved by a Government agency determination pursuant to §§ 501.6(a)(1) or (a)(2) may obtain a review of any agency determination by filing, within 30 days (or such longer period as the Secretary may, for good cause shown in writing, fix in any case) after receiving notice of such determination.

37 CFR §§ 501.8(a), quoted in relevant part, emphasis added.

- 24. I never received notice of the Government's decision, denying me my Constitutional right to notice of the Government's intent to take my patent property rights, and I was denied my Constitutional right to be heard on the Government's claim, to appeal the determination, because, again, I was not given notice of that determination.
- 25. Upon my information and belief, the facts that I did not meet any of the criteria under 37 CFR § 501.6(a)(1), and the fact that I was not given notice or an opportunity to be heard with regards to the Government's claim to ownership of the Patents was known at the time the Government filed assignments of U.S. Patents 9,127,911 and 9,157,701, which unconstitutional and erroneous assignments are hereby reversed by the present assignments of the Patents from myself to myself.
- 26. The above statements are made upon oath, based on my personal knowledge, and subject to penalties of perjury.

Signed by me this 9 day of August, 2016.



Dr. Deepak Varghese