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Paper 25
Entered: April 6, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GLOBAL HEALTH SOLUTIONS LLC,
Petitioner Application 15/672,197,[1]
Petitioner,

v.

MARC SELNER,
Respondent Application 15/549,111,[2]
Respondent.

DER2017-00031

Before JAMESON LEE, JAMES T. MOORE, and
JONI Y. CHANG, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge.*

DECISION
Institution of Derivation Proceeding
35 U.S.C. § 135(a)

I. INTRODUCTION

A petition alleging derivation of invention was filed on August 11, 2017. Paper 3. Both parties' application claims changed during the course of examination. On January 28, 2022, with authorization from the Board,

[1] Bradley Burnham is the sole named inventor on Petitioner's Application.
[2] Marc Selner is the sole named inventor on Respondent's Application.

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and without objection from Respondent, Petitioner filed a "Supplemental Brief." Paper 19. The Supplemental Brief is a "Supplemental Petition" that replaces the initially filed petition in its entirety, such that the petition as originally filed need not be considered in any respect. Paper 18, 2. Hereinafter, we refer to Petitioner's Supplemental Brief/Supplemental Petition simply as "Petition" and cite to it as "Pet."[3]

The parties jointly filed a listing of both parties' pending claims. Paper 17. The list identifies claims 1–10 in Petitioner's Application 15/672,197. *Id.* at 2. It also identifies claims 24–38 in Respondent's Application 15/549, 111. *Id.* at 7–9. However, Respondent's claims 37 and 38 have been cancelled by the Examiner. Ex. 3001. Thus, Respondent has only claims 24–36.

35 U.S.C. § 135(a)(1) reads as follows:

> **(a) Institution of Proceeding.–**
>
> **(1) In General.–**An applicant for patent may file a petition with respect to an invention to institute a derivation proceeding in the Office. The petition shall set forth with particularity the basis for finding that an individual named in an earlier application as the inventor or joint inventor derived such invention from an individual named in the petitioner's application as the inventor or a joint inventor and, without authorization, the earlier application claiming such invention was filed. Whenever the Director determines that a petition filed under this subsection demonstrates that the standards for instituting a derivation proceeding are met, the Director may institute a derivation proceeding.

[3] Petitioner relies on three Declarations, one from inventor Bradley Burnham (Ex. 1011), one from attorney Todd M. Malynn (Ex. 1012), and one from Dr. Eric C. Luo (Ex. 1013).

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This panel has authority to institute a derivation proceeding on behalf of the Director. *See* 37 C.F.R. § 42.408(a). The threshold showing for institution of a derivation proceeding is whether the petition demonstrates substantial evidence that, if unrebutted, would support a determination of derivation. 37 C.F.R. § 42.405(c). For reasons that follow, we conclude that Petitioner has made a sufficient showing as to the requirements of 37 C.F.R. § 42.405(b) to warrant institution. Accordingly, pursuant to 35 U.S.C. § 135(a) and 37 C.F.R. § 42.408(a), we institute a derivation proceeding.

II. DISCUSSION

A. Principles of Law

Although a derivation proceeding is a creation of the Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112-29, § 3(i), 125 Stat. 284 (September 16, 2011),[4] the charge of derivation of invention as a basis for finally refusing application claims and cancelling patent claims had been adjudicated under 35 U.S.C § 135(a) as it existed prior to the enactment of AIA. On the substantive law of derivation of invention, the Board applies the jurisprudence which developed in that context, including the case law of the United States Court of Appeals for the Federal Circuit and the United States Court of Customs and Patent Appeals. *Catapult Innovations Pty Ltd. v. Adidas AG.*, DER2014-00002, Paper 19 at 3 (PTAB July 18, 2014).

[4] Leahy-Smith America Invents Technical Corrections Act, Pub. L. No. 112-274, § 1(e)(1), (k)(1), 126 Stat. 2456 (Jan. 14, 2013).

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The threshold showing for institution of a derivation proceeding is whether the petition demonstrates substantial evidence, which if unrebutted, would support the assertion of derivation.[5] 35 U.S.C. § 135(a); 37 C.F.R. § 42.405(c). For establishing derivation, a petitioner must show that the respondent, without authorization, filed an application claiming a derived invention. 35 U.S.C. § 135(a); 37 C.F.R. § 42.405(b)(2). The party asserting derivation must establish prior conception of an invention and communication of that conception to an inventor of the other party. *Cooper v. Goldfarb*, 154 F.3d 1321, 1332 (Fed. Cir. 1998); *Price v. Symsek*, 988 F.2d 1187, 1190 (Fed. Cir. 1993); *Hedgewick v. Akers*, 497 F.2d 905, 908 (CCPA 1974).

"Conception must be proved by corroborating evidence which shows that the inventor disclosed to others his completed thought expressed in such clear terms as to enable those skilled in the art to make the invention." *Coleman v. Dines*, 754 F.2d 353, 359 (Fed. Cir. 1985). A rule of reason applies to determining whether the inventor's testimony has been corroborated. *Price*, 988 F.2d at 1195. "The rule of reason, however, does not dispense with the requirement for some evidence of independent corroboration." *Coleman*, 754 F.2d at 360. Also, proof of conception must encompass all limitations of the invention. *See Singh v. Brake*, 222 F.3d 1362, 1367 (Fed. Cir. 2000); *Kridl v. McCormick*, 105 F.3d 1446, 1449

[5] Substantial evidence is defined as that which a reasonable person might accept as adequate to support a conclusion. *Falkner v. Inglis*, 448 F.3d 1357, 1363 (Fed. Cir. 2006); *see also In re Zurko*, 258 F.3d 1379, 1384 (Fed. Cir. 2001).

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(Fed. Cir. 1997); *Sewall v. Walter*, 21 F.3d 411, 415 (Fed. Cir. 1994); *Coleman*, 754 F.2d at 359; *Davis v. Reddy*, 620 F.2d 885, 889 (CCPA 1980).

Likewise, communication of the conception to an inventor of the other party must be corroborated. 37 C.F.R. § 42.405(c) ("The showing of communication must be corroborated."). The purpose of the requirement of corroboration is to prevent fraud. *Berry v. Webb*, 412 F.2d 261, 266 (CCPA 1969). An inventor "must provide independent corroborating evidence in addition to his own statements and documents." *Hahn v. Wong*, 892 F.2d 1028, 1032 (Fed. Cir. 1989); *Reese v. Hurst*, 661 F.2d 1222, 1225 (CCPA 1981).

Also applicable to derivation proceedings are regulations in Subpart E of Part 42 of Title 37, Code of Federal Regulations. 37 C.F.R. §§ 42.400–412. In particular, as noted above, under 37 C.F.R. § 42.405(b)(3), a petitioner has to show that each challenged claim is the same or substantially the same as the invention disclosed by petitioner to the respondent. And under 37 C.F.R. § 42.405(a)(2), a petitioner has to show that it has at least one claim that is (i) the same or substantially the same as the respondent's claimed invention, and (ii) the same or substantially the same as the invention disclosed to the respondent.

Assuming that corroborated conception and communication both are established, and that the regulatory requirements are met, a petitioner would be able to regard as a derived invention those challenged claims of the respondent which are shown by the petitioner to be "same or substantially the same" as petitioner's disclosed invention, i.e., that which was conceived

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