Trials@uspto.gov
Tel: 571-272-7822

Paper 8
Entered: April 1, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OREN TECHNOLOGIES, LLC,
Petitioner Application No. 14/882,973,
Petitioner

v.

KENNETH EIDEN, III, BRIAN ANDREW HUNTER,
MATHEW CARLEY, TIMOTHY STEFAN,
MARK D'AGOSTINO, and SCOTT D'AGOSTINO,
Respondent Patent No. 9,758,082 B2,
Respondent.

DER2016-00001

Before SALLY C. MEDLEY, JONI Y. CHANG, and JOSIAH C. COCKS, *Administrative Patent Judges.*

CHANG, *Administrative Patent Judge*.

ORDER TO SHOW CAUSE
WHY PETITION SHOULD NOT BE DISMISSED
37 C.F.R. § 42.71

On October 15, 2015, Petitioner filed a petition (Paper 1) based upon Application No. 14/882,973 ("Petitioner's '973 application") to institute a derivation proceeding under 35 U.S.C. § 135, with respect to Application No. 14/249,420 ("Respondent's '420 application"), which has been published as Patent Application Publication No. 2014/0305769 A1 (Respondent's '769 publication), and issued as Patent No. 9,758,082 ("Respondent's '082 patent").

35 U.S.C. § 135 (a)(1) (2012) provides, in pertinent part, that "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." This statute uses language similar to that which was used granting the Director discretion to institute interference proceedings, as found in the prior version of 35 U.S.C. § 135(a) (2011), which provides that "Whenever an application is made for a patent which, in the opinion of the Director, would interfere with any pending application, or with any unexpired patent, an interference may be declared . . . ." It has long been determined that a party does not have a right to have the Director declare an interference. *United States ex rel. Troy Laundry Machinery Co. v. Robertson*, 6 F.2d 714, 715 (D.C. Cir. 1925). The Director has stated pertaining to derivation proceedings that:

> Prior to instituting a proceeding that is both costly and time consuming to the parties and the Office, a determination will be made to ensure that each party is claiming subject matter that is actually patentable but for the potential derivation issue. While ordinarily a derivation will not be instituted when none of petitioner's claims are in condition for allowance, the rule does not preclude institution in such a situation, and each situation will

> be evaluated on its particular facts. *See* 35 U.S.C. 135(a), as amended.

Changes to Implement Derivation Proceedings, 77 Fed. Reg. 56068, 56076 (September 11, 2012) (Final Rule).

Here, a Final Office Action was entered in Petitioner's '973 application on July 23, 2019, setting forth a six-month statutory period for reply. Ex. 3001 (Final Office Action). Subsequently, the Office entered a Notice of Abandonment on February 28, 2020, after the six-month statutory period has expired. Ex. 3002 (Notice of Abandonment). Petitioner's '973 application is abandoned in view of Petitioner's failure to timely file a proper reply to the Final Office Action. *Id.* at 2. A brief review of the Office records shows that Petitioner has not filed a continuing application.

In Petitioner's '973 application, the only claims remained under consideration, claims 7, 9, and 11−18, were finally rejected. Ex. 3001, 3. The Final Office Action indicates that these claims were rejected, for example, under 35 U.S.C. § 103 as being unpatentable over Wietgrefe in view of Bostrom, Krenek, Berryman, and Ohlson, and as being unpatentable over Oren in view of Bostrom, Krenek, Berryman, and Wietgrefe. *Id.* at 9, 15. None of the prior art references relied upon by the examiner is based on Respondent's '769 publication or Respondent's '082 patent.

In addition, the Final Office Action indicates that the effective filing date of claims 7, 9, and 11−18 is October 14, 2015, the actual filing date of Petitioner's '973 application. Ex. 3001, 5. The Final Office Action notes that these claims have been amended such that Petitioner's '973 application no longer includes a claim copied from or claiming the same invention as any of the original claims of Respondent's '420 application. *Id.* at 9. The

Final Office Action further notes that Respondent's original claims were amended such that Respondent's patent claims are narrower in scope than the original claims, and recite subject matter that is not disclosed or presently claimed in Petitioner's '973 application.

In view of the particular facts before us, we enter this Order to show cause why the instant Petition should not be dismissed.

ORDER

Accordingly, it is:

ORDERED that Petitioner has 30 days from the date of this Order to show cause why the instant Petition should not be dismissed.

FURTHER ORDERED that any response to this Order shall not exceed 15 pages in length.

DER2016-00001
Petitioner Application No. 14/882,973
Respondent Patent No. 9,758,082 B2

For PETITIONER:

Jeffrey S. Whittle
Jason D. Lohr

HOGAN LOVELLS US LLP
jeffrey.whittle@hoganloveUs.com
jason.lohr@hoganloveHs.com

For RESPONDENT:

Christopher R. Liro
Aaron T. Olejniczak

ANDRUS INTELLECTUAL PROPERTY LAW, LLP
chris.liro@andruslaw.com
aarono@andruslaw.com
mariem@andruslaw.com
cathym@andruslaw.com