

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICHAEL J. SINDONI, JR.,
Petitioner Application 14/834,548,
Petitioner,

v.

DEYAN NINOV, JOSEPH S. DEHNER,
and GREGORY A. HOWELL
Respondent Patent 9,067,525 B1,¹
Respondent.

Case DER2016-00003

Before JAMESON LEE, SALLY C. MEDLEY, and
JAMES T. MOORE, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

ORDER
Denying Institution of Derivation Proceeding
37 C.F.R. § 42.71

¹ Issued from Application 14/209,123, filed March 13, 2014.

I. Introduction

On January 26, 2016, Petitioner filed a derivation petition (“Petition” or “Pet.”) on the basis of Petitioner’s Application 14/834,548 (“the ’548 Application”), challenging claims 1–18 in Respondent’s Application 14/209,123 (“the ’123 Application”).² Paper 1. However, on June 30, 2015, prior to filing of the Petition, Respondent’s ’123 Application issued as U.S. Patent 9,067,525 B1 (“the ’525 patent”), and claims 1–18 of the ’123 Application issued as claims 1–18 of the ’525 patent, without change. Also, Petitioner identified Exhibit 1001 as a copy of the ’123 Application, even though Exhibit 1001 is a copy of the ’525 patent. We treat the Petition as directed to the ’525 patent, and regard claims 1–18 of the ’525 patent as the challenged claims.

For reasons discussed below, we determine that the Petition is not supported by substantial evidence with respect to any challenged claim. Accordingly, we decline to institute a derivation proceeding. The Petition is *denied*.

II. Discussion

A. The Applicable 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, 289–290

² It is not entirely clear whether Petitioner challenges only claims 1 and 3–12 of the ’123 Application or all claims 1–18 of the ’123 Application, because Petitioner states: “At the very least, Claims 1, 3, 4, 5, 6, 7, 8, 9, 10, 11, and 12 of the ’123 application were directly derived from the teachings provided to Respondent by petitioner, and the remaining claims of the [’]123 application were readily obtainable therefrom.” Pet. 3. We proceed as though Petitioner challenges all claims 1–18.

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(September 16, 2011),³ 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.*, Case DER2014-00002, slip op. at 3 (PTAB July 18, 2014) (Paper 19).

The threshold showing for institution of a derivation proceeding is whether the petition demonstrates substantial evidence that, if unrebutted, would support the assertion of derivation.⁴ 35 U.S.C. § 135(a); 37 C.F.R. § 42.405(c). 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). The showing of communication must be corroborated. 37 C.F.R. § 42.405(c). Assuming that corroborated conception and communication both are established, a petitioner would be able to regard as a derived invention those

³ Leahy-Smith America Invents Technical Corrections Act, Pub. L. No. 112-274, § 1(e)(1), (k)(1), 126 Stat. 2456 (Jan. 14, 2013).

⁴ 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).

challenged claims of the respondent that are shown by the petitioner to be “same or substantially the same” as petitioner’s disclosed invention, i.e., that which was communicated to the respondent.⁵ See 37 C.F.R. § 42.405(b)(3)(i).

Conception is the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention, as it is to be applied in practice. *Kridl v. McCormick*, 105 F.3d 1446, 1449 (Fed. Cir. 1997); *Burroughs Wellcome Co. v. Barr Labs. Inc.*, 40 F.3d 1223, 1228 (Fed. Cir. 1994); *Coleman v. Dines*, 754 F.2d 353, 359 (Fed. Cir. 1985). Proof of conception must encompass all limitations of the alleged invention. See *Singh v. Brake*, 222 F.3d 1362, 1367 (Fed. Cir. 2000); *Kridl*, 105 F.3d at 1449; *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).

“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*, 754 F.2d at 359 (quoting *Field v. Knowles*, 183 F.2d 593, 601 (1950)).

Corroboration is also required to show communication, like conception. *Price*, 988 F.2d at 1196; *Davis*, 620 F.2d at 889. The purpose of the rule requiring corroboration is to prevent fraud, *Berry v. Webb*, 412 F.2d 261, 266 (CCPA 1969), and 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). In assessing the

⁵ “Same or substantially the same” means patentably indistinct, 37 C.F.R. § 42.401, and in this specific context, patentably indistinct is evaluated one-way in the direction from the invention disclosed to the respondent to each challenged claim.

sufficiency of independent corroboration, a rule of reason applies. *Price*, 988 F.2d at 1195.

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)(i), 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.

B. The Alleged Invention – Conception and Communication

First, Petitioner has not sufficiently specifically identified the features of an invention that he allegedly conceived. The closest the Petitioner comes to doing that are these two statements in the Petition: (1) “Petitioner Sindoni conceived of a major advance in the pickup truck equipment field”; and (2) “[T]his invention, which in brief is a ramp system for a pickup truck, was communicated to Respondent by Sindoni before Respondent filed the ’123 application.” Pet. 3, 16. We do not understand the position of Petitioner to be that Mr. Sindoni conceived of the very first ramp system for a pickup truck. An Information Disclosure Statement submitted by Petitioner during prosecution of the ’548 Application identifies three prior art references disclosing a ramp system for a pickup truck, i.e., U.S. Patent Nos. 3,976,209; 4,624,619; and 7,445,268. Ex. 3002. Also, Petitioner’s ’548 Application generally refers to preexisting ramps for pickup trucks and characterizes them as unsatisfactory. Ex. 1002 ¶ 5. Yet, neither the Petition nor the Declaration of Mr. Sindoni sets forth any particular feature of the

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