

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIVERSITY OF WATERLOO,

Assignee of U.S. Patent Application No. 15/513,914

Petitioner,

v.

SALIENT ENERGY INC.

Assignee of U.S. Patent No. 9,780,412

Respondent.

Case No.: _____

**PETITION TO INSTITUTE DERIVATION PROCEEDING
PURSUANT TO 35 U.S.C. § 135**

TABLE OF CONTENTS

LIST OF EXHIBITS.....	ii
I. INTRODUCTION	1
II. MANDATORY NOTICES	2
A. Real Party-In-Interest	2
B. Related Matters.....	2
C. Lead and Back-Up Counsel.....	3
D. Service Information.....	3
III. STANDING UNDER 37 CFR § 42.402.....	3
IV. TIMELINESS OF THE INSTANT PETITION UNDER 37 CFR § 42.403	4
V. RELIEF REQUESTED.....	4
VI. DERIVATION FEE UNDER 37 C.F.R. § 42.404.....	4
VII. STATEMENT OF MATERIAL FACTS UNDER 37 CFR § 42.22(c)	5
A. The '914 Application.....	5
B. The '412 Patent.....	6
C. Dr. Nazar Contributed to the Conception of the claimed invention recited in claims 1-16 of the '412 Patent.....	7
D. Corroboration of Dr. Nazar's Inventive Contribution.....	8
VIII. SUFFICIENCY OF SHOWING -- CONCEPTION OF THE '412 PATENT INVENTION	10
IX. CLAIM CONSTRUCTION AND SUBSTANTIAL SIMILARITY OF RESPONDENT'S CLAIMS TO THE DERIVED INVENTION	13
X. UNAUTHORIZED FILING OF THE APPLICATION ISSUING AS THE '412 Patent	13
XI. COMMON INTERESTS IN THE INVENTION (37 C.F.R. § 42.411) ..	14
XII. CONCLUSION	14

LIST OF EXHIBITS

UW Ex.	Description
1001	U.S. Patent No. 9,780,412
1002	U.S. Patent App. 15/513,914
1003	U.S. Prov. App. No. 62/230,502: manuscript and filing receipt
1004	PCT/CA2016/050613, published as WO2016/197236
1005	Confidential - Declaration of Dipan Kundu
1006	Confidential - Declaration of Linda F. Nazar
1007	Assignment Abstract of U.S. Patent App. 15/513,914
1008	Assignment Abstract of U.S. Patent No. 9,780,412
1009	Confidential - Oct. 22, 2015 e-mail from Brian Adams
1010	§ 1.64 substitute statement from U.S. Patent No. 9,780,412 file history
1011	Kundu et al., "A high-capacity and long-life aqueous rechargeable zinc battery using a metal oxide intercalation cathode," Art. No. 16119, Nature Energy (Aug. 26, 2016)
1012	US20170250449A1 (publication of U.S. Patent App. 15/513,914)
1013	US20170207492A1 (publication of U.S. Patent App. 15/461,849)
1014	Reserved
1015	Reserved
1016	Confidential - Technology Disclosure Form dated May 28, 2015
1017	Confidential - PowerPoint Presentation dated January 12, 2015
1018	U.S. Patent Application No. 13/794,508 to Pellion
1019	Confidential - PowerPoint Presentation

1020	Reserved
1021	Confidential - Laboratory notebook excerpts from August 7 to September 25, 2014
1022	Confidential - Laboratory notebook excerpts from September 15, 2014 to March 20, 2015
1023	Confidential - Laboratory notebook excerpts from April 20 to May 30, 2015
1024	Default Protective Order

I. INTRODUCTION

University of Waterloo (“UW” or “Petitioner”) hereby petitions and respectfully requests that the Patent Trial and Appeal Board institute a derivation proceeding against U.S. Patent No. 9,780,412 (“the ’412 Patent”) assigned in part to Salient Energy Inc. (“Salient” or “Respondent”), submitted herewith as UW Exhibit 1001.

Pursuant to 35 U.S.C. § 135 and 37 C.F.R. § 42 et seq., this Petition should be granted and a derivation proceeding should be instituted based on the following:

- (1) this Petition is timely filed within one year of first publication of the application issuing as the ’412 Patent;
- (2) Petitioner has standing by virtue of being the named applicant on U.S. Patent App. 15/513,914 (“the ’914 Application”), filed March 23, 2017, submitted herewith as UW Exhibit 1002;
- (3) the ’914 Application identifies three co-inventors of the claimed subject matter, Linda Nazar, Brian Adams, and Dipan Kundu;
- (4) the ’412 Patent issued with 16 claims, all of which are identical to the claims of the ’914 Application after the amendments recently filed;
- (5) the ’412 Patent identifies two co-inventors of the subject matter of those 16 claims, Brian Adams and Dipan Kundu. Linda Nazar is not identified as a co-inventor. As such, the inventive entities are different;

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