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Paper 21
Entered: October 15, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CATAPULT INNOVATIONS PTY LTD,
Application 14/045,954,
Petitioner,

v.

adidas AG,
Application 13/077,510,
Respondent.

Case DER2014-00006

Before JAMESON LEE, JONI Y. CHANG, and JUSTIN T. ARBES, *Administrative Patent Judges.*

LEE, *Administrative Patent Judge.*

DECISION
Order Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71

Introduction

On August 17, 2014, Petitioner filed a Request for Rehearing (Paper 20, "Req. Rhg.") of the Board's decision denying institution of a derivation proceeding (Paper 19, "Decision"). According to Petitioner, the decision represents an abuse of discretion for two reasons (Req. Rhg. 3, 6):

> 1. Although the Board articulated the law on derivation as requiring a showing of prior "conception" and communication of the prior "conception," not by a showing of prior "possession" and communication of the prior "possession," it is well-settled law that conception may be shown by possession of every feature of the invention; and
>
> 2. After concluding that Petitioner met the requirements of 37 C.F.R. § 42.405(a)(2), the Board does not state any other statutory or legal basis for denying Catapult's Petition.

Discussion

1.

With regard to the first of the above-identified assertions, Petitioner is incorrect that mere possession of an invention, however obtained, even if received via another source, constitutes conception of invention. We are aware of no such authority, and no authority cited by Petitioner supports Petitioner's contention. Petitioner cites to this sentence in *Coleman v. Dines*, 754 F.2d 353, 359 (Fed. Cir. 1985): "It is settled that in establishing conception a party must show possession of every feature recited in the count, and that every limitation of the count must have been known to the inventor at the time of the alleged conception." Req. Rhg. 6. The statement is focused on expressing that every feature must be accounted for, and not that possession alone is sufficient to demonstrate conception of invention.

As we stated in the Decision, derivation addresses originality—who invented the subject matter at issue, not mere possession. Paper 19, 17.

2.

With regard to the second of the above-identified assertions, Petitioner is incorrect in several respects. First, we did not conclude that Petitioner satisfied the requirements of 37 C.F.R. § 42.405(a)(2). Rather, we stated in the Decision, *id*. at 16–17:

> Regardless of which claim serves as Catapult's qualifying claim, however, Catapult failed to identify and keep a consistent D between the P to D analysis and the D to R analysis. Catapult evidently regards all communicated information as the disclosed invention D in the D to R analysis, but has not identified any of its own claims as being the same or substantially the same as all of that communicated information. In this case, the P to D and the D to R analysis are not aligned.

In the context of 37 C.F.R. § 42.405(a)(2), there is just one disclosed invention, i.e., "the disclosed invention." That does not change as one shifts focus from one of Petitioner's claims to another or from one of Respondent's claims to another. We explained in the Decision how Petitioner evidently regards the entire collection of communicated information as its disclosed invention. Paper 19, 10. As is noted in the above-quoted text, Petitioner has not identified any of its own claims as being the same or substantially the same as all of that communicated information. Petitioner's P to D and D to R analysis are not aligned. Also, we explained that, apart from the requirements of 37 C.F.R. § 42.405(a)(2), the law on derivation requires a showing of prior conception and communication of that prior conception. Paper 19, 4, 17–18.

3.

In its Request for Rehearing, Petitioner argues that the events of October 19–20, 2010, constitute an actual reduction to practice that was communicated to adidas Wearable Sports Electronics. Req. Rhg. 7, 9. The argument, however, is new. Per 37 C.F.R. § 42.71(c), a rehearing request must identify the place where each matter was previously addressed. We could not have overlooked an argument that was not presented. The new argument is not entitled to consideration. In any event, shifting the issue to "actual reduction to practice" does not help the Petitioner. That which allegedly is actually made or performed still must be the invention of Petitioner's inventor. There is no escaping from the issue of originality, whether the subject is conception or actual reduction to practice.

4.

In its Request for Rehearing, Petitioner points to its own involved application and notes that Shaun Holthouse is the sole named inventor. Req. Rhg. 7–9. The declaration of the inventor, filed with the application, was not relied on in the Petition, and was not included in the copy of Petitioner's application, provided by Petitioner in this proceeding (Ex. 1010). Also, Petitioner's application has a filing date of October 4, 2013, and does not demonstrate conception of any claimed invention as of October 19–20, 2010, even without considering the need for independent corroboration. Finally, because Petitioner, as explained in the Decision, regards the entirety of the information disclosed on October 19–20, 2010, as its disclosed invention (Paper 19, 10), at issue is conception of that entire body of information. As we noted in the Decision (Paper 19, 16–17),

Petitioner has identified no claim in its application as being the same or substantially the same as all of that disclosure.

Order

The request is *denied*.

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