

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PLASTO-SAC LTD.,
Petitioner Application 14/669,074,
Petitioner,

v.

Hewlett Packard Co.,
Respondent Application 14/426,042,
Respondent.

Case DER2015-00005

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

LEE, *Administrative Patent Judge*.

ORDER
Dismissal of Petition
37 C.F.R. §§ 42.5 and 42.71

Introduction

On March 26, 2015, on the basis of its own U.S. Patent Application 14/669,074, Petitioner filed a Petition to institute a derivation proceeding against claims 1–13 of Respondent’s international application PCT/EP2012/068680, which was published as WO 2014/044322 and entered the national stage as U.S. Patent Application 14/426,042. Paper 1, 1 and 6–7. Respondent’s Application 14/426,042 was published as US 2015-0227064-A1 on August 13, 2015. On August 15, 2016, a Notice of Abandonment was issued in Respondent’s Application 14/426,042, citing applicants’ failure to respond to an Office Action, dated February 4, 2016, that rejected all then pending claims 1–20 in Respondent’s Application 14/426,042 over prior art. On September 14, 2016, a Notice of Abandonment was issued in Petitioner’s Application 14/669,074, citing applicants’ failure to respond to an Office Action, dated March 11, 2016, that rejected all then pending claims 1–23 in Petitioner’s Application 14/669,074 over prior art that does not include either Respondent’s WO 2014/044322 or Respondent’s Pub. App. US 2015-0227064-A1.

On April 6, 2017, we issued an Order for Petitioner to show cause within twenty (20) days of that Order why, under such circumstances, the Petition should not be dismissed. Paper 16. We stated that if Petitioner provides no response within that time, the Petition will be dismissed.

Discussion

Under the present circumstance, where both Petitioner’s Application and Respondent’s Application are abandoned, it is appropriate to exercise discretion to dismiss the Petition to institute a derivation proceeding. Unlike an *inter partes* review proceeding, a post-grant review proceeding, and a covered business method

patent review proceeding, a derivation proceeding is a contest between two inventive entities over which is entitled to a patent on an invention.

See 35 U.S.C. § 135. Under that framework, in this instance it would not be appropriate to proceed when neither party has a pending application for patent. We ordered Petitioner to show cause, by April 26, 2017, why the Petition should not be dismissed. Paper 16. That period has expired without the Petitioner filing any response. Accordingly, we dismiss the Petition.

In the Order dated April 6, 2017, we informed the parties that upon dismissal of the Petition, we intend to make public the records of this proceeding, because the respective applications of the parties have been published.¹ Paper 16, 3. We gave the parties until April 26, 2017, to inform us why the records of this proceeding should remain non-public. *Id.* The due date for a response has passed, and neither party filed a response. Accordingly, the records of this proceeding will be made public after ten days from the date of this communication.

In the Order dated April 6, 2017, we informed the parties that if we dismiss the Petition, we intend to dismiss Petitioner's Motion to Seal because "the Certificate of Non-Publication in Petitioner's Motion to seal is outdated in light of publication of both parties' applications and the passage of time since the filing of Petitioner's Motion to Seal." *Id.* We gave Petitioner until April 26, 2017, to file a paper to recertify the accuracy of the Certificate of Non-Publication in Petitioner's Motion to Seal. *Id.* The due date for a response has passed, and Petitioner filed no response.

¹ Petitioner's Application 14/669,074 was published on September 29, 2016, as US 2016-0282765-A1.

In the Order dated April 6, 2017, we authorized Petitioner to file, by April 26, 2017, a submission including a specific list of all items (1) originally sought to be sealed by Petitioner's Motion to Seal, (2) still deemed confidential by Petitioner and for which Petitioner's Certificate of Non-Publication still is accurate, and (3) for which Petitioner now seeks expungement from the record prior to our making the records of this proceeding public. *Id.* at 3–4. The due date for a response has passed, and Petitioner filed no response.

Order

It is

ORDERED that the Petition is *dismissed*;

FURTHER ORDERED that Petitioner's Motion to Seal (Paper 9) is *dismissed*;

FURTHER ORDERED that the records of this proceeding in their entirety, including those items sought to be sealed by Petitioner's Motion to Seal, will be made public after ten (10) days from the date of entry of this Order.

Case DER2015-00005
Petitioner Application 14/669,074
Respondent Application 14/426,042

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