

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ESTATE OF LOU GERBER
and
SOCIAL LANGUAGE PROCESSING, INC.,
No Application,
Petitioner,

v.

CORNELL UNIVERSITY,
CORNELL CENTER FOR TECHNOLOGY, ENTERPRISE, &
COMMERICALIZATION,
Application 14/352,350,
Respondent.

Case DER2015-00011

Before JAMESON LEE, JAMES T. MOORE, and JUSTIN T. ARBES,
Administrative Patent Judges.

MOORE, *Administrative Patent Judge.*

DECISION
Dismissing Petition
37 C.F.R. § 42.71(a)

Introduction

On October 5, 2015, Petitioner filed a “Petition for Derivation Hearing” (Paper 1, “Pet.”). It is unclear if Respondent has been served with the Petition pursuant to 37 C.F.R. § 42.406.¹

Petitioner seeks the following relief:

Petitioners hereby request a determination from the Director that they are the joint-inventors and/or joint-owners of the pending Patent assignment for Review Skeptic.

Pet. 1.

Petitioner does not cite to a pending application which they have placed on file at the United States Patent and Trademark Office (“USPTO”). Rather, Petitioner asserts that they “have rights in the Patent [Application 14/352,350] because they provided significant input into at least one claim of the invention.” Pet. 3.

Discussion

Petitioner has an initial burden of demonstrating compliance with 37 C.F.R. § 42.402, which provides that only “[a]n applicant for patent may file a petition to institute a derivation proceeding in the Office.” See 37 C.F.R. § 42.405(a)(1) (“The petition must: (1) Demonstrate compliance with §§ 42.402 and 42.403 . . .”).

Likewise, 35 U.S.C. § 135(a)(1) states “[a]n applicant for patent may file a petition with respect to an invention to institute a derivation proceeding in the Office. The petition shall set forth with particularity the

¹ The Petition fails to include a certificate of service as required by 37 C.F.R. § 42.6(e)(4).

basis for finding that an individual named in an earlier application as the inventor or a joint inventor derived such invention from an individual named in the petitioner's application” Also, under 37 C.F.R. § 42.402, it is an “applicant for patent” who may file a petition to institute a derivation proceeding.

Even assuming *arguendo* that the allegations contained in the Petition are true, Petitioner has not established any grounds for standing, such that we could institute a derivation proceeding pursuant to 35 U.S.C. § 135(a)(1) and 37 C.F.R. § 42.402. Based upon the pleaded facts, Petitioner is not a patent “applicant.”

The only application identified in the Petition is Application 14/352,350. As far as the records of the USPTO are concerned, inventors Myle Ott, Yejin Choi, Claire Cardie, and Jeffrey Hancock assigned their interests in Application 14/352,350 to Cornell University, Cornell Center for Technology, Enterprise, and Commercialization (“CCTEC”), as recorded at Reels/Frames 034145/0825, 034147/0071, 034146/0371, and 034147/0123 of the assignment records. Petitioner Estate of Lou Gerber (“Gerber”) and Social Language Processing, Inc. (“SLP”) do not appear in the records of the USPTO as having any ownership interest in Application 14/352,350. Thus, Application 14/352,350 cannot serve as a basis for Petitioner to assert it is a patent “applicant.”

Moreover, even if Petitioner were a named applicant on Application 14/352,350, this would still be insufficient. The derivation statute contemplates the existence of a contest between *two* applications, the *petitioner's* application and *an earlier* application, during which derivation would be proven. See 35 U.S.C. § 135(b).

A petitioner must show that the respondent, without authorization, filed an application claiming such a derived invention. 35 U.S.C. § 135(a); 37 C.F.R. § 42.405(b)(2). Under 37 C.F.R. § 42.405(a)(2), a petitioner must 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. As Petitioner has no application, it would not be possible for the Board to conduct a derivation proceeding under our rules and render a determination as to derivation under 35 U.S.C. § 135(b).

Finally, 35 U.S.C. § 135(b) mandates that our rules and standards require "parties to provide sufficient evidence to prove and rebut a claim of derivation." Focusing on claiming joint ownership and joint inventorship of the CCTEC application and invention, Petitioner has not identified an application which possibly may support a derivation proceeding under 35 U.S.C. § 135(a)(1) and 37 C.F.R. §§ 42.402, 42.405(b)(2).

Accordingly, Petitioner lacks standing, and the Petition does not state a ground upon which we can grant relief.

As we construe our rules to secure the just, speedy, and inexpensive resolution of every proceeding, we believe the best course of action under these circumstances is to dismiss the Petition before Respondent² and the Office expend resources.³

² Respondent has not yet entered an appearance. *See* 37 C.F.R. § 42.8(a)(2).

³ We also note that Petitioner filed Papers 1 and 2, and Exhibit 1001, in the Patent Review Processing System (PRPS) as "Filing Party and Board Only," but did not file a motion to seal. Respondent's Application 14/352,350 is available to the public. The record of this proceeding,

ORDER

The Petition is *dismissed*.

FOR PETITIONER:

Songfong Tommy Wang
twang@yangwanglaw.com

FOR RESPONDENT:

Valauskas Corder LLC
150 South Wacker Drive
Suite 620
Chicago IL 60606

including the documents filed under seal, will be made available to the public one week from the date of this Decision. *See* 37 C.F.R. § 42.412(b)(1). If Petitioner believes that any materials should not be made public, they may request a conference call by email to the Board at Trials@uspto.gov.