

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DUANE BROCKMAN,
Petitioner Application 14/877,929,
Petitioner,

v.

WESLEY BAINTEER,
Respondent Application 14/293,778,
Respondent.

Case DER2016-00002

Before JAMESON LEE, JAMES T. MOORE, and
JOSIAH C. COCKS, *Administrative Patent Judges*.
LEE, *Administrative Patent Judge*.

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

I. Introduction

On December 11, 2015, Petitioner filed a derivation petition (“Petition”) on the basis of Petitioner’s Application 14/877,929 (“the ’929 Application”), challenging claims 1–10 in Respondent’s Application 14/293,778 (“the ’778 Application”) as published in US Pub. App. 2014/0360107 A1. Paper 1. On July 7, 2016, the Examiner entered an Office Action rejecting all claims in the ’929 Application. Ex. 3002. On February 9, 2017, the Examiner issued a Notice of Abandonment of the ’929 Application, citing Applicant’s failure to respond to the Office Action mailed July 7, 2016. Ex. 3001. On February 22, 2017, the Board ordered Petitioner to show cause why adverse judgment should not be entered against Petitioner for having abandoned the ’929 Application. Paper 5 (“Show Cause Order”). Petitioner filed a response. Paper 6 (“Response”). For reasons discussed below, we do not enter adverse judgment against Petitioner.

However, also for reasons discussed below, we determine that the Petition is not supported by substantial evidence. Accordingly, we decline to institute a derivation proceeding. The Petition is therefore *denied*.

II. Discussion

In its Response to the Show Cause Order, Petitioner argues that 35 U.S.C. § 135 does not require a petitioner’s involved application to be maintained after a derivation petition has been filed, that Petitioner’s entire purpose for filing the Petition was for the Board to direct that “the Petitioner be added as a named inventor [in] Respondent[’s] Application,” and that “the Respondent be removed as a named inventor from the Respondent Application.” Paper 6, 1–2. Under the circumstances here, we do not enter adverse judgment against Petitioner for having

abandoned the '929 Application. Hereinafter, we discuss the merits of the Petition for purposes of determining whether a derivation proceeding should be instituted.

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 (September 16, 2011),¹ 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, which if unrebutted, would support the assertion of derivation.² 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

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

² 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).

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). Assuming that corroborated conception and communication both are established, a petitioner would be able to regard as a derived invention those challenged claims of the respondent which 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.³ See 37 C.F.R. § 42.405(b)(3).

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 therefore 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

³ “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.

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 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), a petitioner has to show that each challenged claim is the same or substantially the same as the invention disclose 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

In a declaration (Ex. 1003) cited to in the Petition, Petitioner defines the invention he conceived as follows⁴:

Eventually, in 2011, I conceived of an apparatus that would be mounted to the cross-bar of selected towers along a center pivot irrigation system, the apparatus comprising an auger suitable for boring a hole into the earth, an auger guide, a motor, a controller for controlling the motor, and a frame. The apparatus would be mounted by its frame to the tower in such a way that the auger would be positioned vertically. Upon activation by the controller, the motor would cause rotation of the auger such that it would either deploy into the ground or retract from the ground. The auger guide would be fixed to the bottom of the frame, and would have a hole in its center with helical grooves matching the

⁴ The Petition reiterates this formulation of the alleged conception. Pet. 4–5.

shape of the auger through which the auger would pass truly and stably. When the auger was fully deployed into the ground, it would prevent the tower from tipping over due to high winds. I called my invention the “Pivot Anchor System.”

Ex. 1003 ¶ 3. That is the same invention that Petitioner asserts he communicated to Respondent in March of 2013. *Id.* ¶ 5. In his declaration, Petitioner testifies that in a meeting in March of 2013:

I proceeded to disclose my “Pivot Anchor System” invention to Mr. Bainter. I provided to him a copy of two very rudimentary drawings I had made by hand at least a year prior showing the invention as I had previously conceived it. A copy of the first of these two drawings is attached hereto as “Exhibit 1003A.” A copy of the second of these drawings is attached hereto as “Exhibit 1003B.”

Id.

To provide corroboration for the alleged conception and communication of the invention to Respondent, Petitioner provides the two drawings he referred to in the above-quoted testimony and the declarations of Tyler Brockman (Ex. 1004) and Scott Sproul (Ex. 1005). Both Tyler Brockman and Scott Sproul testify that they were present at a meeting in March of 2013 between Petitioner and Respondent. Ex. 1004 ¶ 4; Ex. 1005.

Mr. Sproul does not provide specifics of any invention Petitioner ever disclosed to him, or to Respondent at the meeting in March 2013. Although Mr. Sproul testifies that at the meeting in March of 2013, drawings were given to Respondent, Mr. Sproul does not provide any description of such drawings. Nor does Mr. Sproul verify that it was the drawings designated as Exhibits 1003A and 1003B that were given to Respondent. Thus, Mr. Sproul corroborates only that there was a meeting between Petitioner and Respondent in March of 2013, during which an invention was discussed and some drawings about a “pivot anchor” were

given to Respondent. That corroboration does not account for the specifics of what Petitioner asserts is Petitioner's invention.

Tyler Brockman's testimony, however, is specific and does account for every feature of Petitioner's alleged invention. Tyler Brockman describes Petitioner's invention, as conveyed to Tyler Brockman in 2011, and subsequently disclosed by Petitioner to Respondent in a meeting in March of 2013, where Tyler Brockman was present, as follows:

In 2011, my father, Duane Brockman, disclosed to me an invention he had conceived. The invention was a device to prevent a center pivot irrigation tower from tipping over during heavy wind conditions. The device basically consisted of a motorized earth auger, an auger guide, a controller for the auger motor, and a mounting bracket for the auger. The mounting bracket would be mounted to the cross-bar of a tower of a center pivot irrigation system in such a way that the auger was vertical relative to the ground. The controller was to control the motor, which was capable of causing rotation of the auger in both directions. One direction would cause the auger to rotate through the auger guide in a way that it would deploy downward into the ground and the other direction would cause the auger to rotate through the guide in a way that it would retract upward away from the ground. The auger guide would be fixed to the bottom portion of the bracket, and would have a hole in its center with helical grooves matching the shape of the auger through which the auger would pass up and down stably. My father called his invention the "Pivot Anchor System."

Ex. 1004 ¶ 3. The above-quoted description matches in substance Petitioner's own description of the alleged invention, except that while Petitioner states there is a frame for mounting the apparatus to the cross bar of selected towers and that the auger guide is fixed to the bottom of the frame. Tyler Brockman describes that there is a mounting bracket mounted to the cross bar of a tower and that the auger guide is fixed to the bottom portion of the mounting bracket. On this record, that is a difference without distinction. The mounting bracket referenced by Tyler

Brockman is reasonably deemed the frame referenced by Petitioner. The corroborator need not use the same words to describe Petitioner's invention. In assessing corroboration, a rule of reason applies. *Price*, 988 F.2d at 1195.

For the foregoing reasons, substantial evidence supports Petitioner's assertion of his stated invention in 2011, as defined in Petitioner's testimony reproduced above, and subsequent communication of that invention to Respondent in March of 2013.

C. The Requirements Regarding the Claims

As noted above in the section discussing the applicable law, Petitioner is required to show (1) that the challenged claims are drawn to the same or substantially the same invention as the invention he disclosed to Respondent, (2) that Petitioner has at least one claim that is the same or substantially the same as the Respondent's claimed invention, and (3) that Petitioner has at least one claim that is the same or substantially the same as the invention Petitioner disclosed to the Respondent. For these requirements, the Petition contains only a general citation to "Ex. 1003; Ex. 1004; Ex. 1005." Pet. 7–11. As noted above, Exhibit 1003 is a declaration from Petitioner; Exhibit 1004 is a declaration of Tyler Brockman; and Exhibit 1005 is an affidavit of Scott Sproul. None of the testimony from Petitioner, Tyler Brockman, and Scott Sproul, however, addresses the specifics of any claim.

With regard to the first requirement, it cannot simply be assumed that the challenged claims are drawn to the same or substantially the same invention as that which Petitioner has conceived and communicated to Respondent. The Petitioner provides no reasoning or analysis in that regard. Several features in the challenged

claims demand a meaningful accounting by Petitioner, relative to the invention conceived by Petitioner and communicated by Petitioner to Respondent.

Challenged claims 1, 2, and 6 are independent and all other challenged claims depend, directly or indirectly, from one of claims 1, 2, and 6. Claim 1 requires an actuator, mounted to an irrigation tower and separate from the anchor member, that has a retracted position and an extended position. According to claim 1, the anchor member is mounted to the actuator. Also according to claim 1, when the actuator is in its retracted position, the anchor member is retracted above the soil surface, and when the actuator is in its extended position, the anchor member penetrates the soil surface. The invention conceived by Petitioner and as communicated by Petitioner to Respondent, as identified above, however, includes no such actuator. More particularly, lacking from the Petitioner's conceived and communicated invention is a sufficient disclosure or description of an actuator that, itself, translates between extended and retracted positions, and lacking from the Petition is any reasoning to account for the obviousness of such a feature to one with ordinary skill in the art. Similarly, claim 2 requires a motor, in an actuator, that is slidably mounted to the frame for movement between a retracted position and an extended position. The invention conceived by Petitioner and communicated by Petitioner to Respondent, as identified above, however, includes no such actuator and motor, and the Petition does not account for such a feature.

Claim 6 requires a motor movably mounted to a frame for translation between a retracted position and an extended position, and a control unit that causes both the motor and the anchor member to move from a retracted position to an extended position and from an extended position to a retracted position. The invention conceived by Petitioner and communicated by Petitioner to Respondent,

as identified above, however, includes no such motor and control module, and the Petition does not account for such a feature.

With regard to the second requirement, which is a two-way analysis between a claim of Petitioner and a challenged claim of Respondent, *Catapult Innovations*, slip op at 16, *supra*, Petitioner has not accounted for this limitation in Petitioner's independent claims 1 and 5: "anchor member engaging portion including a pair of opposite diagonally oriented rods which are oriented, spaced and sized to engage the opposing helical surfaces of the helical anchor portion, the rods being sufficiently spaced apart to receive the helical anchor portion there-between." Additionally, Petitioner has not accounted for the recitation in claim 1 of "the anchor member having at least a portion which is fashioned from a flat bar having a generally constant thickness," or the recitation in claim 5 of "the lower end of the anchor member being fashioned from a flat bar having a constant thickness."

With regard to the third requirement, which is a one-way analysis going in the direction from a claim of Petitioner to the invention conceived by Petitioner and communicated by Petitioner to Respondent, *Catapult Innovations*, slip op at 16, *supra*, we are sufficiently satisfied that the requirement is met by Petitioner's claim 1. But that does not cure the deficiencies with regard to the first and second requirements discussed above.

III. Conclusion

We are not persuaded by Petitioner that substantial evidence supports a determination that a derivation proceeding should be instituted.

Case DER2016-00002
Petitioner Application 14/877,929
Respondent Application 14/293,778

IV. Order

It is

ORDERED that the Petition is *denied*; and

FURTHER ORDERED that no derivation proceeding is instituted on the basis of the Petition.

For Petitioner:

Matt Catlett
matt@catlettlaw.com

Turan Odabasi
todabasi@gmail.com

For Respondent:

James Kernell
ERICKSON KERNELL DERUSSEAU & KLEYPAS, LLC
jjk@kcpatentlaw.com

Robert Blinn
rblinn@robertblinn.com