

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICHAEL J. SINDONI, JR.,
Petitioner Application 14/834,548,
Petitioner,

v.

DEYAN NINOV, JOSEPH S. DEHNER,
and GREGORY A. HOWELL
Respondent Patent 9,067,525 B1,¹
Respondent.

Case DER2016-00003

Before JAMESON LEE, SALLY C. MEDLEY, and
JAMES T. MOORE, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

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

¹ Issued from Application 14/209,123, filed March 13, 2014.

I. Introduction

On January 26, 2016, Petitioner filed a derivation petition (“Petition” or “Pet.”) on the basis of Petitioner’s Application 14/834,548 (“the ’548 Application”), challenging claims 1–18 in Respondent’s Application 14/209,123 (“the ’123 Application”).² Paper 1. However, on June 30, 2015, prior to filing of the Petition, Respondent’s ’123 Application issued as U.S. Patent 9,067,525 B1 (“the ’525 patent”), and claims 1–18 of the ’123 Application issued as claims 1–18 of the ’525 patent, without change. Also, Petitioner identified Exhibit 1001 as a copy of the ’123 Application, even though Exhibit 1001 is a copy of the ’525 patent. We treat the Petition as directed to the ’525 patent, and regard claims 1–18 of the ’525 patent as the challenged claims.

For reasons discussed below, we determine that the Petition is not supported by substantial evidence with respect to any challenged claim. Accordingly, we decline to institute a derivation proceeding. The Petition is *denied*.

II. Discussion

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, 289–290

² It is not entirely clear whether Petitioner challenges only claims 1 and 3–12 of the ’123 Application or all claims 1–18 of the ’123 Application, because Petitioner states: “At the very least, Claims 1, 3, 4, 5, 6, 7, 8, 9, 10, 11, and 12 of the ’123 application were directly derived from the teachings provided to Respondent by petitioner, and the remaining claims of the [’]123 application were readily obtainable therefrom.” Pet. 3. We proceed as though Petitioner challenges all claims 1–18.

(September 16, 2011),³ 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 that, if unrebutted, would support the assertion of derivation.⁴ 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 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). The showing of communication must be corroborated. 37 C.F.R. § 42.405(c). Assuming that corroborated conception and communication both are established, a petitioner would be able to regard as a derived invention those

³ Leahy-Smith America Invents Technical Corrections Act, Pub. L. No. 112-274, § 1(e)(1), (k)(1), 126 Stat. 2456 (Jan. 14, 2013).

⁴ 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).

challenged claims of the respondent that 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.⁵ See 37 C.F.R. § 42.405(b)(3)(i).

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 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 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

⁵ “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.

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

First, Petitioner has not sufficiently specifically identified the features of an invention that he allegedly conceived. The closest the Petitioner comes to doing that are these two statements in the Petition: (1) “Petitioner Sindoni conceived of a major advance in the pickup truck equipment field”; and (2) “[T]his invention, which in brief is a ramp system for a pickup truck, was communicated to Respondent by Sindoni before Respondent filed the ’123 application.” Pet. 3, 16. We do not understand the position of Petitioner to be that Mr. Sindoni conceived of the very first ramp system for a pickup truck. An Information Disclosure Statement submitted by Petitioner during prosecution of the ’548 Application identifies three prior art references disclosing a ramp system for a pickup truck, i.e., U.S. Patent Nos. 3,976,209; 4,624,619; and 7,445,268. Ex. 3002. Also, Petitioner’s ’548 Application generally refers to preexisting ramps for pickup trucks and characterizes them as unsatisfactory. Ex. 1002 ¶ 5. Yet, neither the Petition nor the Declaration of Mr. Sindoni sets forth any particular feature of the

“ramp system for a pickup truck” that Petitioner allegedly conceived, much less the entirety of what Petitioner has conceived. This deficiency alone dooms the Petition, because we do not know what was conceived by Petitioner.

Second, Petitioner has not sufficiently identified the features of any invention that he allegedly communicated to Respondent. The closest the Petitioner comes to doing that are these two statements in the Petition: (1) “[T]his invention, which in brief is a ramp system for a pickup truck, was communicated to Respondent by Sindoni before Respondent filed the ’123 application”; and “Petitioner disclosed the invention to Respondent to this end, and Respondent acknowledged receipt of the disclosure.” Pet. 3, 16. The Petition does not, however, point to corroborating evidence of communication or evidence of how Respondent has acknowledged receipt of Petitioner’s conceived “invention” at any time. The Declaration of Mr. Sindoni, the Petitioner, is no better. Mr. Sindoni testifies: “*Details of the invention* were communicated to FCA US LLC by me more than a year before FCA US LLC filed the Chrysler application and more than two years before the Sindoni application was filed.” Ex. 1003 ¶ 7 (emphasis added). However, Mr. Sindoni in his Declaration nowhere identifies or explains the referenced “[d]etails of the invention.”

Submitted by Petitioner as Exhibit 1006 is a document that appears to be signed by Mr. Sindoni and a representative of an entity named “U.S. Patent Commission,” that pertains to disclosure by Mr. Sindoni of an invention to U.S. Patent Commission at some time. But that document has not been addressed in the declaration testimony of Mr. Sindoni. Nor is there a declaration from Angela Stevens, the individual who signed on behalf of U.S. Patent Commission, addressing the document. Thus, it has not been authenticated. Also, although the

Petition generally refers to Exhibit 1006 as “Petitioner’s Invention Disclosure,” (Pet. 9–14), we do not know specifically what subject matter the Petitioner possibly had conceived because the Petitioner makes no averment in that regard. Furthermore, the content of Exhibit 1006 has not been explained either in the Petition or in the Declaration of Mr. Sindoni. Pages 4 and 5 of Exhibit 1006 appear to contain technical illustrations but are substantially illegible. On May 3, 2017, we issued an Order (Paper 7) stating: “[I]f Petitioner can provide a more legible copy of the last two pages of Exhibit 1006, then another full copy of Exhibit 1006, including the more legible last two pages, shall be filed within two weeks of the date of this communication.” Paper 7, 3. Petitioner filed no replacement copy of Exhibit 1006. We note also that the signature of Angela Stevens, on behalf of U.S. Patent Commission, on page 1 of Exhibit 1006, is undated, and Petitioner submitted no declaration of Angela Stevens to substantiate and explain her signature, e.g., when she received the document.

In any event, Petitioner makes no explanation as to the relationship, if any, between U.S. Patent Commission and Respondent. We decline to assume that they are the same entity. Thus, we will not assume communication with U.S. Patent Commission is the same as communication with Respondent.

For the foregoing reasons, the Petition is fatally deficient with regard to the specifics of what Petitioner conceived and also what Petitioner communicated to Respondent prior to filing of Respondent’s ’525 patent. The Petition can be denied on this basis alone. We continue below, however, to discuss additional deficiencies of the Petition based on the requirements of 37 C.F.R. § 42.405.

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 Petitioner 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. 37 C.F.R. § 42.405(a)(2), 37 C.F.R. § 42.405(b)(3)(i). With regard to items (1) and (2), the Petition is deficient, as discussed below.

1. Respondent's Claims as Compared
to the Allegedly Communicated Invention

Even assuming that Exhibit 1006 were to define the invention that was communicated by Petitioner to Respondent prior to filing of Respondent's '525 patent⁶, Petitioner has not sufficiently shown that any challenged claim of Respondent is the same or substantially the same as an invention set forth in Exhibit 1006. Neither the Petition nor the Declaration of Mr. Sindoni explains the document that is Exhibit 1006, much less explains why any challenged claim is the same or substantially the same invention as that which is described in Exhibit 1006. In that regard, all of the limitations of each challenged claim would have

⁶ Petitioner identified insufficient corroborating evidence to support an assertion that the document that is Exhibit 1006 was communicated by Petitioner to an inventor of Respondent prior to the filing of Respondent's application. A showing of communication must be corroborated. 37 C.F.R. § 42.405(c). Although Exhibit 1006 bears the signature of Angela Stevens who signed as "U.S. Patent Commission, As Witness," that signature is undated and the record includes no testimony from Angela Stevens. Furthermore, Petitioner also has not explained the relationship of U.S. Patent Commission to the Respondent.

have to be accounted for at least in an obviousness analysis based on the communicated invention as prior art. The analysis goes in the direction from the communicated invention to the challenged claims. *Catapult Innovations Pty Ltd. v. Adidas AG.*, Case DER2014-00002, slip op. at 16 (PTAB July 18, 2014) (Paper 19). The legible portions of Exhibit 1006, on the first three pages thereof, set forth only the following description:

Testimonial Of Invention

Title of Your Product Concept:

No title as of yet – It's a built in truck ramp

Describe The Idea:

A ramp that comes standard issue in most pick-up truck. A ramp located in the bed of a pick-up, a ramp that slides out over your tailgate for easy loading and off loading of machines. (quads, dirt bikes, golf carts, riding mowers)

Describe How It Works:

It's a ramp that sits in the bed of your pickup truck when not in use, it is locked into place. When you need it, it simply slides out for loading or off loading of heavy machinery.

What makes this idea unique?

This would be better than having to purchase ramps separately, and remembering to have them in your truck when you need them.

Who would use this invention?

All outdoorsmen and women. Anyone who hunts, fishes, mows lawns, or just loves to spend time outside (camping) with quads or even dirt bikes.

Ex. 1006, 2–3. It is unexplained how the above-reproduced generic disclosure would have anticipated or rendered obvious the subject matter of any challenged claim. To the extent that we can discern anything from the last two pages of Exhibit 1006, nothing of significance is added to the material reproduced above.

Based on the content of independent claims 1 and 14 of the '525 patent, it is manifestly evident that each challenged claim includes more limitations than a lockable ramp located in the bed of a pick-up truck, that slides out over the tailgate. We note, especially, the limitations regarding a lateral tailgate track and a track member movable into the lateral tailgate track (Respondent's claim 1), and the limitations regarding a lateral closure member track and track members movable into the lateral closure member track (Respondent's claim 14). Respondent's claims 1 and 14 are reproduced below (emphasis added):

1. A ramp system for a pickup truck having a bed and a tailgate, the ramp system comprising:

- a longitudinal bed channel recessed into a floor of the bed, the bed channel defining a bottom surface having a longitudinal bed track;
- a longitudinal tailgate channel recessed into an inner panel of the tailgate, the tailgate channel aligned with the bed channel and defining a bottom surface having a longitudinal tailgate track, the inner panel facing the floor of the bed when the tailgate is in a closed position;
- a lateral tailgate track recessed into the inner panel and extending substantially transverse to and in communication with the bed and longitudinal tailgate tracks; and*
- a ramp member having a track member, the ramp member configured to be stowed in the bed channel in a stowed position and slidable in the bed and tailgate channels from the stowed position to a fully deployed position during which the *track member moves along the respective bed and longitudinal tailgate tracks and into the lateral tailgate track without having to raise the track member out of the respective bed and longitudinal tailgate tracks;*

wherein upon the track member being received in the lateral tailgate track, the ramp member is laterally adjusted while

coupled to the tailgate through movement of the track member in the lateral in the lateral tailgate track.

14. A vehicle comprising:

a cargo area having a floor and a closure member moveable between an open position and a closed position, the closure member having an inner panel facing the cargo floor when in the closed position; and

a ramp system including:

a pair of longitudinal floor channels recessed into the floor of the cargo area and laterally spaced apart from each other, the floor channels each defining a bottom surface having a longitudinal floor track;

a pair of longitudinal closure member channels recessed into the inner panel, the closure member channels aligned with the bed channels and each defining a bottom surface having a longitudinal closure member track;

a lateral closure member track recessed into the inner panel and extending substantially transverse to and in communication with the floor and longitudinal closure member tracks;

a pair of ramp members each having a track member, the pair of ramp members configured to be stowed in the floor channels in a stowed position and slidable in the floor and closure member channels from the stowed position to a fully deployed position during which *the track members move along the respective bed and longitudinal closure member tracks and into the lateral closure member track without having to raise the track members out of the respective bed and longitudinal closure member tracks;*

wherein upon the track members being received in the lateral closure member track, the ramp members are laterally adjustable relative to each other while

coupled to the closure member through movement of one or more of the track members in the lateral closure member track.

Accordingly, Petitioner has not made a sufficient showing that any of Respondent's claims is directed to the same or substantially the same invention as that which Petitioner allegedly communicated to Respondent.

2. Respondent's Claims as Compared to Petitioner's Claims

As noted above, Respondent's independent claim 1 includes a lateral tailgate track and a track member movable into the lateral tailgate track, and Respondent's independent claim 14 includes a lateral closure member track and track members movable into the lateral closure member track. Claims depending from claim 1 incorporate the limitations of claim 1, and claims depending from claim 14 incorporate the limitations of claim 14. None of Petitioner's claims includes the limitations regarding the lateral tailgate track of Respondent's claims 1–13 or the limitations regarding the lateral closure member track of Respondent's claims 14–18. The Petition on pages 7–14 compares Respondent's claims with Petitioner's claims, but makes no attempt to explain why any of Respondent's claims would have been obvious over any of Petitioner's claims. Petitioner has not even asserted that any of Respondent's claims would have been obvious over any of Petitioner's claims. The comparison between Respondent's and Petitioner's claims involves a two-way analysis. *Catapult Innovations*, slip op. at 16.

As explained above, there are significant deficiencies going in the direction from Petitioner's claims to Respondent's claims, concerning the lateral tailgate track of Respondent's claims 1–13 and the lateral closure member track of Respondent's claims 14–18. For instance, with regard to the lateral tailgate track recited in Respondent's claim 1, Petitioner simply states:

The only difference between the two claims [Petitioner's claim 1 and Respondent's claim 1] is the respondent's additional option of "a lateral tailgate track recessed into the inner panel and extending substantially transverse to and in communication with the bed and longitudinal tailgate tracks[,] and the manner in which the Respondent's ramp member interfaces with the lateral tailgate track.

Pet. 8. And with regard to Respondent's claim 14, Petitioner has not even identified the lateral closure member track of Respondent's claim 14 as a difference from Petitioner's claims. No position is set forth by Petitioner regarding obviousness of any claim of Respondent over any claim of Petitioner.

Accordingly, Petitioner has not made a sufficient showing that Petitioner has at least one claim that is the same or substantially the same as the subject matter of any of Respondent's claims.

3. Petitioner's Claims as Compared
to the Allegedly Communicated Invention

The comparison of Petitioner's claims to the allegedly communicated invention involves a one-way analysis going in the direction from a claim of Petitioner to the invention allegedly conceived by Petitioner and communicated by Petitioner to Respondent. *Catapult Innovations*, slip op. at 16. Assuming that the legible portions of Exhibit 1006, i.e., the first three pages thereof, constitute all of the material communicated by Petitioner to Respondent prior to the filing of the '525 patent, we are sufficiently satisfied that at least one of Petitioner's claims is directed to the same or substantially the same invention as that which was communicated by Petitioner to Respondent. But that does not cure the deficiencies with regard to the two other required comparisons discussed above.

III. Conclusion

We are not persuaded by Petitioner that substantial evidence supports a determination that a derivation proceeding should be instituted with respect to any claim of the '525 patent.

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:

Robert Gray
THE GRAY LAW GROUP LTD.
robert.gray@thegraylawgroup.com

For Respondent:

Thomas Jurecko
REMARCK LAW GROUP PLC
tom@remarck.com