

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALEXANDER MICHAILOVICH SHUKH,
Petitioner,

v.

JAMES JOHN LUPINO and TOMMY ALLEN AGAN,
Respondent.

Case DER2016-00022
Petitioner Application No. 14/264,014
Respondent Application No. 14/580,240

Before JONI Y. CHANG, JOSIAH C. COCKS, and JUSTIN T. ARBES,
Administrative Patent Judges.

CHANG, *Administrative Patent Judge.*

DECISION
Denying Institution of Derivation Proceeding
35 U.S.C. § 135(a) and 37 C.F.R. § 42.408

I. INTRODUCTION

As the applicant for U.S. Patent Application No. 14/264,014 (“Petitioner’s ’014 application”), Mr. Alexander Mikhailovich Shukh (“Petitioner”), on September 3, 2016, filed a Petition to institute a derivation proceeding directed to claims 1, 2, 4, 5, and 11 of U.S. Patent Application No. 14/580,240 (“Respondent’s ’240 application”) filed by Messrs. James John Lupino and Tommy Allen Agan (collectively, “Respondent”). Paper 2. Petitioner also filed a Corrected Petition on September 13, 2016. Paper 6 (“Pet.”).¹ We exercise exclusive jurisdiction over each party’s involved application under 37 C.F.R. § 42.3(a) in order to enter this Decision. Upon entry of the Decision, the jurisdiction of each application will be returned to the appropriate officials under the Commissioner for Patents.

Under 35 U.S.C. § 135(a), a derivation proceeding may be instituted if it is determined that “a petition filed under this subsection demonstrates that the standards for instituting a derivation proceeding are met.” 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. 37 C.F.R. § 42.405(c).

For the reasons that follow, we do not institute a derivation proceeding involving Petitioner’s ’014 application and Respondent’s ’240 application. The Petition is *denied*.

¹ Our citations are to the Corrected Petition (Paper 6), unless otherwise noted.

II. DISCUSSION

Under 37 C.F.R. § 42.405, a petition to institute a derivation proceeding is required to show that the petitioner has *at least one claim* that is:

- (1) the same or substantially the same as the respondent's claimed invention; and
- (2) the same or substantially the same as the invention disclosed to the respondent.

In the instant Petition, Petitioner asserts that claim 19 of Petitioner's '014 application is substantially the same as claims 1 and 4 of Respondent's '240 application, and Petitioner's claim 20 is substantially the same as Respondent's claim 2. Pet. 16–18. However, Petitioner has cancelled his own involved claims—namely, claims 19 and 20. A review of the file record of Petitioner's '014 application shows that the Amendment that was filed on August 19, 2016, canceled Petitioner's claims 19 and 20, and the Examiner in that case entered the Amendment and issued a Notice of Allowance on September 12, 2016, as to the remaining claims.

In the conference call held between the parties and the panel on October 12, 2016, and in the Order entered on October 14, 2016, we explained to Petitioner that “[i]f a petitioner's application does not contain such a claim, the petition would not comply with 37 C.F.R. § 42.405, and, as a result, no derivation proceeding will be instituted.” Paper 10, 4. We also authorized Petitioner to correct his involved application – Petitioner's '014 application – if he so chose, so that it would contain at least one involved claim in accordance with 37 C.F.R. § 42.405. Paper 10, 4–5. However, Petitioner, rather than making the necessary correction within the time period set forth in

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our Order (10 business days from the entry of the Order), paid the issue fee in Petitioner's '014 application on November 19, 2016.

Based on the record before us, we find that Petitioner does not have at least one claim that is the same or substantially the same as Respondent's claimed invention, or the invention allegedly disclosed to Respondent, as required by 37 C.F.R. § 42.405. Petitioner does not provide, nor do we find, any basis for waiving the requirement. Accordingly, we determine that the instant Petition does not provide sufficient showing for instituting a derivation proceeding.

In view of the foregoing, it is:

ORDERED that the instant Petition to institute a derivation proceeding is *denied*;

FURTHER ORDERED that we do not institute a derivation proceeding, for trial, with respect to any claim of Petitioner's '014 application and Respondent's '240 application;

FURTHER ORDERED that jurisdiction over Application 14/264,014 and jurisdiction over Application 14/580,240 are herein returned to the appropriate officials under the Commissioner for Patents in charge of these applications; and

FURTHER ORDERED that a copy of this Decision will be placed in the file of each party's involved application—Application 14/264,014 and Application 14/580,240.

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