

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TENCENT TECHNOLOGY (SHENZHEN) CO. LTD.,
Petitioner Application 16/354,371,
Petitioner,

v.

YOGESH RATHOD,
Respondent Patent 10,990,265,
Respondent.

DER2022-00002

Before JAMESON LEE, MICHAEL R. ZECHER and JUSTIN T. ARBES,
Administrative Patent Judges.

ZECHER, *Administrative Patent Judge.*

DECISION
Denying Institution of Derivation Proceeding
35 U.S.C. § 135

I. INTRODUCTION

Petitioner, Tencent Technology (ShenZhen) Co., Ltd. (“Tencent”), filed a Petition (Paper 2, “Pet.”) requesting to institute a derivation proceeding under 35 U.S.C. § 135 with respect to claims 1–18 of U.S. Patent No. 10,990,265 B2 (Ex. 1004, “the ’265 patent”) owned by Respondent, Mr. Yogesh Rathod. We exercised exclusive jurisdiction over the ’265 patent and Tencent’s involved application, U.S. Patent Application No. 16/354,371 (Ex. 1001, “the ’371 application”), under 37 C.F.R. § 42.3(a) for the purpose of determining whether to institute a derivation proceeding. Paper 15.

“Whenever the Director determines that a petition . . . demonstrates that the standards for instituting a derivation proceeding are met, the Director may institute a derivation proceeding.” 35 U.S.C. § 135(a)(1). We have authority to institute a derivation proceeding on behalf of the Director. 37 C.F.R. § 42.408(a). The threshold showing for institution of a derivation proceeding is whether the petition demonstrates substantial evidence that, if unrebutted, would support a determination of derivation. *See* 35 U.S.C. § 135(a); 37 C.F.R. § 42.405(c).¹ Once a derivation proceeding has been instituted, the standard of proof for establishing that a challenged claim constitutes a derived invention is by a preponderance of the evidence. 37 C.F.R. § 42.1(d). For the reasons set forth below, we conclude

¹ “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) (explaining how to conduct a review under the substantial evidence standard).

that Tencent has not made a sufficient showing to warrant institution of a derivation proceeding and, therefore, we deny the Petition.

A. The '265 Patent

The '265 patent, titled “Application Program Interface or Page Processing Method and Device,” issued from U.S. Patent Application No. 17/001,803 (“the '803 application”), filed August 25, 2020. Ex. 1004, codes (54), (21), (22). The '803 application is a divisional of U.S. Patent Application No. 16/414,787, filed May 17, 2019, which, in turn, is a divisional of U.S. Patent Application No. 15/008,483 (“the '483 application”), filed on January 28, 2016—now U.S. Patent No. 10,310,723 B2. *Id.* at code (60). The '483 application is a continuation of Patent Cooperation Treaty (“PCT”) application No. PCT/IB2013/056314, filed August 1, 2013. *Id.*

The '265 patent discloses “a method and an apparatus for information processing.” Ex. 1004, code (57). As one example of the disclosed apparatus, the '265 patent states the following:

the apparatus includes a storage medium, processing circuitry and network interface circuitry. The storage medium stores a first application program, and other application programs that are downloaded via the network interface circuitry. The processing circuitry executes the first application program in an operating system to provide a running environment. Further, the processing circuitry executes a second application program in the running environment to start a program logic process and a first presentation process corresponding to a first view interface or page of the second application program. The program logic process and the first presentation process respectively interface with the running environment. The program logic process generates initial first interface or page data, and the initial first interface or page data is transferred from the program logic

process to the first presentation process. The first view interface or page is rendered in the first presentation process.

Id.

Mr. Rathod filed the '803 application with original claims 1–20, which are almost identical to original claims 1–20 of the '371 application. Ex. 1003, 75–81.² In response to a Non-Final Action where the Examiner rejected claims 1, 11, and 20 as being anticipated under 35 U.S.C. § 102(a)(1) by Abraham (U.S. Patent Application Pub. No. 2012/0278750 A1), Mr. Rathod amended claims 1, 8, 11, 18, and 20. *Id.* at 99–107, 200–24. After the Examiner maintained the anticipation rejection of claims 1, 11, and 18 by Abraham in a Final Action, Mr. Rathod further amended claims 1, 11, and 20. *Id.* at 229–39, 301–11. In response to an Advisory Action entered by the Examiner, Mr. Rathod cancelled claims 2 and 12 and then incorporated the limitations from those two cancelled claims into claims 1 and 11. *Id.* at 313, 317–27. Shortly thereafter, the Examiner indicated that pending claims 1, 3–11, and 13–20 were in condition for allowance. *Id.* at 329–37. Prior to allowance, Mr. Rathod submitted additional amendments to pending claims 1, 3, 8, 11, 13, 17, and 18 for consistency purposes and amended certain paragraphs in the specification to correct grammatical and typographical errors. *Id.* at 439–63. Pending claims 1, 3–11, and 13–20 issued as claims 1–18 of the '265 patent. *Id.* at 342; Ex. 1004, 29:19–34:23 (claim listing in the '265 patent).

² All references to the prosecution history of the '265 patent refer to the page numbers inserted by Tencent in the bottom, right-hand corner of each page in Exhibit 1003.

B. The '371 Application

The '371 application, similarly titled “Application Program Page Processing Method and Device,” was filed on March 15, 2019, and published on July 11, 2019, as U.S. Patent Application Publication No. 2019/0213019 A1. Ex. 1012, codes (54), (21), (22), (10), (43). The '371 application appears to be essentially the same as the '265 patent, with some minor differences. *Compare* Ex. 1012, *with* Ex. 1004. The named inventors of the '371 application are Hao Hu, Haojun Hu, and Qingjie Lin. Ex. 1012, code (72); *see also* Ex. 1001, 46–48, 198–200³ (37 C.F.R. § 1.63 Declarations of Hao Hu, Haojun Hu, and Qingjie Lin assigning their rights in the disclosed inventions to Tencent).

Tencent filed the '371 application with original claims 1–20. Ex. 1001, 31–37. Prior to examination on the merits, Tencent filed a preliminary amendment cancelling claims 2 and 12 and then incorporating the limitations from those two cancelled claims into claims 1 and 11. *Id.* at 246–56. Shortly thereafter, the Examiner entered a Non-Final Action with the following two rejections: (1) claims 1, 3–11, and 13–20 were rejected under 35 U.S.C. § 102(a)(2) as anticipated by the '265 patent owned by Mr. Rathod; and (2) claim 1 was rejected under 35 U.S.C. § 103 as obvious over Sandman, Jr. (U.S. Patent Application Publication No. 2013/0042201 A1). After three interviews with the Examiner, followed by the submission of remarks directed to traversing the Examiner’s obviousness rejection of

³ All references to the prosecution history of the '371 application refer to the page numbers inserted by Tencent in the bottom, right-hand corner of each page in Exhibit 1001.

claim 1 over Sandman, Jr., the Examiner entered an order titled “Suspension Due to Derivation Proceedings.” Ex. 3001. Based on this order, we understand the ’371 application to be in condition for allowance but for the existence of the ’265 patent. Paper 15, 2.

C. Illustrative Claim and Claim Correspondence

Tencent contends that claims 1–18 of the ’265 patent are the same or substantially the same as pending claims 1, 3–11, and 13–20 of its ’371 application. Pet. 7–16. Claim 1 of the ’265 patent is representative and is reproduced below.

1. A method for information processing, comprising:
 - a) executing, by processing circuitry of a terminal device, a first application program in an operating system, the execution of the first application program providing a running environment for other application programs;
 - b) executing, by the processing circuitry, a second application program in the running environment that is provided by the execution of the first application program, the execution of the second application program starting a program logic process and a first presentation process corresponding to a first view interface of the second application program, and the program logic process and the first presentation process respectively interfacing with the running environment that is provided by the execution of the first application program;
 - c) transferring, by the processing circuitry and via the running environment that is provided by the execution of the first application program, initial first interface data of the first view interface from the program logic process that generates the initial first interface data based on first program logic code of the first view interface to the first presentation process, wherein further comprising:
 - transferring, by the processing circuitry and via the running environment that is provided by the execution of the first application program, updated data for a portion of the first view

interface from the program logic process to the first presentation process;

d) rendering, by the processing circuitry and in the first presentation process, the first view interface according to the initial first interface data of the first view interface, wherein further comprising: re-rendering, by the processing circuitry and in the first presentation process, the portion of the first view interface according to the updated data for the portion of the first view interface; and

e) feeding back, by the processing circuitry and via the running environment that is provided by the execution of the first application program, a completion notification from the first presentation process to the program logic process.

Ex. 1004, 29:19–59.

II. ANALYSIS

A. Principles of Law

Although a derivation proceeding is a creation of the Leahy-Smith America Invents Act, Public L. No. 112-29, 125 Stat. 284 (2011) (“AIA”),⁴ the charge of derivation of invention as a basis for finally refusing application claims and cancelling patent claims had been adjudicated in interference proceedings under 35 U.S.C § 135(a) as it existed prior to the enactment of the AIA. On the substantive law of derivation of invention, we apply the jurisprudence that developed in that context, including the case law of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals.

⁴ The language of 35 U.S.C. § 135 was amended to its current form in the Technical Corrections—Leahy-Smith America Invents Act, Pub. L. No. 112-274 §§ 1(e)(1), (k), 126 Stat. 2456, 2456–58 (2013).

Under the AIA, Tencent must show that Mr. Rathod, without authorization, filed an application claiming a derived invention. 35 U.S.C. § 135(a)(1); 37 C.F.R. § 42.405(b)(2). A derivation petition with respect to an invention that is the same or substantially the same as a claim contained in a patent issued on an earlier application, or contained in an earlier application when published or deemed published under 35 U.S.C. § 122(b), also must be filed during the one-year period following the date on which the patent containing such claim was granted or the earlier application containing such claim was published, whichever is earlier. 35 U.S.C. § 135(a)(2). There is no dispute that the Petition was filed timely.

Pursuant to 37 C.F.R. § 42.405(a)(2), Tencent has to show that it has at least one claim that is (i) the same or substantially the same as Mr. Rathod's claimed invention, and (ii) the same or substantially the same as the invention disclosed to Mr. Rathod. If Tencent selects one of its own claims as the "invention disclosed to [Mr. Rathod]," the selection itself can be relied on as satisfying the requirement of 37 C.F.R. § 42.405(a)(2)(ii). For each claim of the '265 patent that Tencent asserts is a derived invention, Tencent has to show why the claimed invention is the same or substantially the same as the invention disclosed to Mr. Rathod. 37 C.F.R. § 42.405(b)(3)(i). Additionally, Tencent has to show prior conception and communication of the invention disclosed to Mr. Rathod. *See, e.g., Catapult Innovations Pty Ltd. v. Adidas AG.*, DER2014-00002, Paper 19 at 5 (PTAB July 18, 2014) (stating that "the showing of prior conception and communication *need be made* for an invention disclosed to an inventor of the other party" (emphasis added)).

That is, to prove derivation, the party asserting derivation—Tencent—must establish (1) prior conception of the claimed subject matter, and (2) communication of that conception to an inventor of the other party—Mr. Rathod. *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); *see* Changes to Implement Derivation Proceedings, 77 Fed. Reg. 56,068, 56,075 (Sept. 11, 2012) (“Derivation requires both earlier conception by the party alleging derivation as well as communication of the conception.”). “There can be no derivation without prior conception on the part of [Tencent].” *Davis v. Reddy*, 620 F.2d 885, 889 (CCPA 1980) (quoting *Egnot v. Looker*, 387 F.2d 680, 687 (CCPA 1967)). A charge of derivation addresses originality—namely, who invented the subject matter at issue. *Price*, 988 F.2d at 1190.

“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) (quoting *Coleman v. Dines*, 754 F.2d 353, 359 (Fed. Cir. 1985)); *Burroughs Wellcome Co. v. Barr Labs. Inc.*, 40 F.3d 1223, 1227–28 (Fed. Cir. 1994). “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 (citation omitted). As with conception, corroboration also is required to support testimony regarding communication. *Price*, 988 F.2d at 1196; *Davis*, 620 F.2d at 889. 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). A rule of reason applies to determining whether the inventor’s testimony has been corroborated. *Price*, 988 F.2d at 1194–95. “The rule of reason, however, does not dispense with the requirement for some evidence of independent corroboration.” *Coleman*, 754 F.2d at 360.

The showing of prior conception must be made for the invention disclosed to Mr. Rathod. Any challenged claim that Tencent demonstrates is “the same or substantially the same” as the disclosed invention constitutes a derived invention.⁵ See 37 C.F.R. § 42.405(b)(3)(i). Proof of conception must encompass all limitations of the disclosed invention. See *Cumberland Pharms. Inc. v. Mylan Institutional LLC*, 846 F.3d 1213, 1218–19 (Fed. Cir. 2017); *Singh v. Brake*, 222 F.3d 1362, 1367 (Fed. Cir. 2000); *Kridl*, 105 F.3d at 1449; *Sewall v. Walters*, 21 F.3d 411, 415 (Fed. Cir. 1994); *Coleman*, 754 F.2d at 359; *Davis*, 620 F.2d at 889. Likewise, “[t]he communication must be sufficient to enable one of ordinary skill in the art to make the patented invention.” *Eaton Corp. v. Rockwell Int’l Corp.*, 323 F.3d 1332, 1344 (Fed. Cir. 2003).

If Tencent identifies one of its own claims as defining or representing that invention disclosed to Mr. Rathod, then Tencent has to corroborate conception of that claimed invention, as well as corroborate communication of that conception. Assuming that conception and communication both are

⁵ “Same or substantially the same means patentably indistinct.” 37 C.F.R. § 42.401. In this specific context, patentably indistinct is evaluated one-way. That is, in the direction from the invention disclosed to the respondent to each challenged claim.

established by corroborating evidence, Tencent would be able to regard as a derived invention those challenged claims of Mr. Rathod that are shown by Tencent to be drawn to the same or substantially the same invention as the invention disclosed to Mr. Rathod. That question is evaluated in the direction from the disclosed invention to each challenged claim.

B. Tencent's Contentions

Tencent contends that the '371 application was published on July 11, 2019, which is roughly one year before Mr. Rathod submitted the '803 application on August 25, 2020, that eventually issued as the '265 patent on April 27, 2021. Pet. 6, 17. According to Tencent, Mr. Rathod readily admitted that he was aware of the published '371 application in emails he sent to Tencent employees prior to filing the '803 application. *Id.*; Ex. 1005 (email sent by Mr. Rathod to Tencent employees on August 17, 2020, that specifically identifies "Tencent's pending US16354371 . . . related to mini apps"); Ex. 1011 ¶ 2 (Declaration from Paul Lein, Tencent's Senior Intellectual Property Counsel, testifying that he received Mr. Rathod's email "on or about" August 17, 2020). Tencent then argues that Mr. Rathod copied almost verbatim the published claims of the '371 application and submitted them as the claims of the '803 application. Pet. 6–7, 17–18.

Tencent alleges that, during prosecution of the '803 application, Mr. Rathod failed to identify the '371 application to the Examiner. Pet. 7. Tencent also alleges that Mr. Rathod made amendments to then-pending claims of the '803 application that were similar to the preliminary amendments Tencent entered in the '371 application. *Id.* at 18.

According to Tencent, Mr. Rathod’s almost verbatim copying of the original claims of the ’371 application, including the claims that were amended preliminarily prior to examination on the merits, demonstrates that Mr. Rathod “intended to derive his alleged invention from Tencent’s invention and [that] he did this without any authorization from Tencent.” Pet. 19.

C. Conception

For the reasons set forth below, we determine that Tencent does not present substantial evidence that the named inventors in the ’371 application conceived of the invention purportedly communicated to Mr. Rathod.

The Federal Circuit repeatedly has stated that “[c]onception is the touchstone of inventorship.” *CODA Dev. S.R.O. v. Goodyear Tire & Rubber Co.*, 916 F.3d 1350, 1358 (Fed. Cir. 2019) (quoting *Acromed Corp. v. Sofamor Danek Grp., Inc.*, 253 F.3d 1371, 1379 (Fed. Cir. 2001); *Burroughs Wellcome*, 40 F.3d at 1227 (Fed. Cir. 1994)). The corroboration requirement for conception helps establish that the individuals claiming to have invented a claimed invention actually are those who invented the claimed invention. It is an essential element of a claim of derivation under 35 U.S.C. § 135. Historically, corroboration has been shown by contemporaneous documents (e.g., lab notebooks, project reports, communications among inventors, and the like) showing that there was formation “in the mind of the inventor[s] of a definite and permanent idea of the complete and operative invention.” *Kridl*, 105 F.3d at 1449. Again, a rule of reason applies. *Price*, 988 F.2d at 1194–95.

We begin our analysis of conception by noting that Tencent's Petition is devoid of any explanation of the circumstances surrounding conception of the invention by the three named inventors of the '371 application. Most notably, Tencent does not provide supporting testimony from any of the three named inventors or, for that matter, from any other parties that could corroborate the alleged conception. Indeed, the word "conception" does not appear in Tencent's Petition at all. *See* Pet. Put simply, Tencent fails to provide any meaningful information regarding the work done by each of the three named inventors that resulted in conception of the invention covered by the pending claims of the '371 application. Absent some evidence in the record, such as testimony from the three named inventors together with corroborating evidence showing there was formation in the mind of the named inventors of a definite and permanent idea of the complete and operative invention, Tencent has not demonstrated prior conception.⁶

To the extent Tencent expects us to scour the preliminary record to unearth supporting evidence of prior conception, we decline to do so. It is well-settled that Tencent is "master of its complaint." *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018). We are constrained by the arguments and evidence presented and developed in Tencent's Petition, and we are not

⁶ We recognize that Tencent contends that the '265 patent and the three applications in its priority chain lack sufficient written description support for the claimed invention. Pet. 17–28. We need not reach Tencent's arguments that the three applications in the priority chain of the '265 patent lack sufficient written description support for the claimed invention because, as we explain above, Tencent does not demonstrate that the named inventors in the '371 application conceived, at any time, the inventions purportedly communicated to Mr. Rathod.

at liberty to “raise, address, and decide . . . theories never presented by [Tencent] and not supported by record evidence.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016). Moreover, even if we were to overlook the above-noted deficiency in Tencent’s Petition and institute a derivation proceeding, Tencent would not be permitted to deviate from the arguments initially presented in the Petition. *See Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1286 (Fed. Cir. 2017) (explaining that “[s]hifting arguments” during the course of a trial are “foreclosed by statute, [Federal Circuit] precedent, and Board guidelines”). Applying a rule of reason, on the record before us Tencent has not made a sufficient showing of prior conception, even for purposes of instituting trial, because its Petition lacks any explanation regarding this essential element of a claim of derivation.

D. Communication of Conception

As we explain above, because Tencent does not present substantial evidence that the named inventors in the ’371 application conceived of the inventions allegedly disclosed to Mr. Rathod, we need not reach—and do not reach—communication of that conception. More specifically, we do not reach whether Tencent has presented substantial evidence to support its assertion that Mr. Rathod’s admitted awareness of the ’371 application prior to filing the ’803 application that issued as the ’265 patent is sufficient, by itself, to establish communication of prior conception to Mr. Rathod.

E. Conclusion

Pursuant to 35 U.S.C. § 135(a)(1), “[w]henver the Director determines that a petition . . . demonstrates that the standards for instituting a

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derivation proceeding are met, the Director may institute a derivation proceeding.” For the reasons set forth above, we conclude that the standards for institution have not been satisfied because Tencent has not made a sufficient showing of prior conception. We, therefore, do not institute a derivation proceeding.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* and no derivation proceeding is instituted;

FURTHER ORDERED that jurisdiction of the ’371 application and the ’265 patent is returned to the appropriate officials under the Commissioner of Patents; and

FURTHER ORDERED that a copy of this Decision be placed in the files of the ’371 application and the ’265 patent.

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