

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JON R. RASMUSSEN and BRANDON J. FAIR
Petitioner Application 17/846,932,
Petitioner,

v.

NICHOLAS KLEINSCHMIT and AARON HOLMBERG,
Respondent Application 17/522,731,
Respondent.

Case DER2023-00012

Before JAMESON LEE and RAE LYNN GUEST,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

ORDER
Conduct of Proceeding
37 C.F.R. § 42.5(a)

I. Introduction

On June 20, 2025, a conference call was held between Judges Lee and Guest and respective counsel for the parties. The purpose of the call was to acknowledge Petitioner's desire to file a substitute petition to account for the changed claims of the parties, and to explain to Petitioner that if we proceed with having petitioner file a substitute petition, the substitute petition is authorized to include only arguments regarding derivation of invention, and not anything about the North Dakota state court judgment, ostensibly regarding ownership of inventions, which has been filed by Petitioner as Exhibit 1031 and represented by Petitioner as final and not-appealed.

II. Discussion

We, however, provided Petitioner an alternative, based on its apparent belief that it now owns both Petitioner's and Respondent's involved applications, based on the North Dakota state court judgment, i.e., seek a remand of both party's applications back to the Examiner, for the limited purpose of Petitioner to attempt to assert and record official ownership of Respondent's involved application. Counsel for Respondent expressed no objection to this alternative electable by Petitioner. Counsel for Respondent also does not dispute that the North Dakota state court judgment is final and non-appealed, but expressed a belief that Respondent's subject application did not fall within the North Dakota state court judgement.

Under this alternative, if Petitioner ultimately fails to record Petitioner's ownership of Respondent's application, the applications would return to the Board to continue with the derivation proceeding, in which the North Dakota state court judgment regarding who owns what subject matter will not be considered. If

Petitioner prevails in recording Petitioner's ownership of Respondent's application, then this proceeding can be terminated as moot on the ground that Petitioner owns both involved applications.

Counsel for Petitioner requested one week to consider which course of action Petitioner desires. We authorized two weeks.

III. Order

It is

ORDERED that within two weeks of the date of entry of this order, Petitioner shall inform the Board by email, copying Respondent, whether it seeks a limited remand of both parties' applications back to the Examiner to pursue actions concerning ownership of the applications, and whether its request is opposed by Respondent;

FURTHER ORDERED that if Petitioner responds by email that it does not seek a limited remand as noted in the immediately preceding paragraph, Petitioner's is authorized to file a substitute petition due one month from the date of entry of the date of this order.¹ Petitioner is reminded that they are not permitted to produce additional evidence to support conception and/or communication of invention to the Respondent. Rather, the substitute petition may add necessary analysis based on changes to the claim language of Respondent's and Petitioner's claims since the time the original Petition was filed.

¹ The substitute petition will replace the original petition filed by Petitioner on May 11, 2023 in its entirety and nothing from the original Petition will be considered. Further, the substitute petition shall not raise any argument based on the North Dakota state court judgment (Exhibit 1031), given that Petitioner has been given a separate opportunity to pursue relief specifically based on that judgment.

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