

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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JON R. RASMUSSEN, et al.,

Petitioner Application No. 17/846,932,

Petitioner,

v.

Nicholas Kleinschmit et. al.,

Respondent Application No. 17/522,731,

Respondent.

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DER2023-00012

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**PETITIONER'S RESPONSE TO BOARD ORDER**

**DATED JUNE 24, 2025**

On June 24, 2025, the Patent Trial and Appeal Board (the “Board”) issued an Order entitled “Conduct of Proceeding” (the “Order”). In the Order, the Board requested that, within two weeks of the date of entry of the Order, Petitioners inform the Board whether they seek a limited remand of both Parties’ Applications back to the respective Examiners to pursue actions concerning ownership of the Applications.

Petitioners Jon R. Rasmussen and Brandon J. Fair (the “Petitioners”) hereby move for a remand of both Parties’ Applications to the respective Examiners for the purpose of pursuing and recording actions concerning ownership of those Applications. In support of this Motion for Remand, Petitioners state as follows:

1. On June 24, 2025, the Board issued an Order stating that it would allow “Petitioner to attempt to assert and record official ownership of Respondent’s involved application” by seeking “a remand of both party’s applications back to the Examiner.”
2. Petitioners’ Application is U.S. Pat. App. No. 17/846,932. This application was filed on June 22, 2022.
3. Respondents’ Application is U.S. Pat. App. No. 17/522,731. This application was filed on November 09, 2021.
4. 37 CFR § 3.73(c) provides:
  - (1) In order to request or take action in a patent matter, an assignee who is not the original applicant must establish its ownership of the patent property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by . . . :

(i) Documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment). The submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11 . . .

The statement asserting ownership may be signed by “a person having apparent authority to sign on behalf of the assignee.”

An assignee who is not the original applicant must become the applicant under 37 CFR 1.46(a) in order to request or take action in a patent application. A request to change the applicant under 37 CFR 1.46(c)(2) must be filed and must be accompanied by an application data sheet under 37 CFR 1.76 specifying the applicant in the applicant information section and comply with 37 CFR 3.71 and 37 CFR 3.73.

5. Petitioners have a good faith belief that they are the owners of the application pending as U.S. Pat. App. No. 17/522,731, regardless of how the claims may individually read.
6. Petitioners are the beneficiaries of a Court Order issued by a court of competent jurisdiction, adjudicating the issue of ownership of the inventions at issue. The Court Order provides:

Mechanical Revolution [Respondents herein] . . . was . . . an employee [of Rasmussen and Fair] under the [North Dakota] statute.

. . .

Mechanical Revolution agreed to examine the original prototype tool sent by Rasmussen and Fair, who had already invented it. Any improvements or modifications to the tool that arose after this

examination arose as a result of a gratuitous employment which came into being when Mechanical Revolution agreed to examine the tool.

...

Fair and Rasmussen are entitled to any patents on the Triton Tool, either as the inventors of the design, or as the employers of Mechanical Revolution in the context of any improvements made by [Holmberg and Kleinschmit] to the original design. (emphasis added)

Note that the Court Order is on file with the Board in this Derivation Proceeding as Exhibit No. 1031. The Order was never appealed.

7. Block 4 of the Statement of Ownership form provided by the U.S. Patent Office shows the option of filing a certified copy of a court order:

4. ☐ The recipient, via a court proceeding or the like (*e.g.*, bankruptcy, probate), of an undivided interest in the entirety (a complete transfer of ownership interest was made). The certified document(s) showing the transfer is attached.

The interest identified in option 1, 2 or 3 above (not option 4) is evidenced by either (choose one of options A or B below):

8. In accordance with the Board's Order, the undersigned counsel has conferred with counsel for Respondents, Nicholas Kleinschmit and Aaron Holmberg. The Respondents do not consent to this Motion. Counsel for Respondents asserts that the subject application does not fall within the North Dakota state court judgement. Respondents believe that the North Dakota court's judgment was confined to "the Triton Tool." However, the order clearly states that the order covers "any improvements made by [Holmberg and Kleinschmit] to the original design."
9. Respondent hereby requests that the Parties' applications be remanded to the respective Examiner(s) for the limited purpose of pursuing and recording ownership of the applications.

10. This Response is filed within two weeks of the Board's Order and will not materially delay the proceeding. On the contrary, it is believed that a remand will advance the proceeding.

Respectfully submitted this 5<sup>th</sup> day of July, 2025,

s/ Peter L. Brewer

Peter L. Brewer

U.S. Patent Reg. No. 41,636

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