

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JON R. RASMUSSEN et al.,
Petitioner Application 17/846,932,
Petitioner,

v.

NICHOLAS KLEINSCHMIT et al.,
Respondent Application 17/522,731,
Respondent.

Case DER2023-00012

**PETITIONERS' RESPONSE TO
BOARD ORDER OF FEBRUARY 20, 2026**

On February 20, 2026, the Patent Trial and Appeal Board (the “Board”) entered an Order (the “Order”) requesting that each of the Parties submit to the Board a three-month status report. This follows an Order from the Board dated July 24, 2025, providing for a remand of the pending patent application at issue, U.S. Pat. App. No. 17/522,731. The remand was for the purpose of providing Petitioner with the opportunity to “assert ownership of Respondent’s involved application by Petitioner’s inventors.”

In response, Petitioner would show the following.

A. Recordation of Assignment

Pursuant to the Board’s invitation, a Certified Copy of the North Dakota District Court’s Order in Civil Case No. 53-2021-CV-01197 was filed with the U.S. Patent and Trademark Office. The Order was entered by the District Court in Williams County, North Dakota, on July 21, 2023. Paragraph 59 of the Court’s Order, which became final many months ago, states that “Fair and Rasmussen are entitled to any patents on the Triton Tool, either as the inventor of the design, or as the employers of [Holmberg and Kleinschmit] in the contract of any improvements made by the Plaintiff to the original design.” This serves as evidence of ownership of the patent application at issue.

The North Dakota Court Order was filed with the Assignment Recordation Branch on July 25, 2025, and was recorded at Reel/Frame No. 071839/0001.

A Notice of Recordation of Assignment Document was entered by the Assignment Recordation Branch on July 28, 2025. In the Recordation of Assignment, the Assignees are listed as Jon R. Rasmussen and Brandon J. Fair, individually. This is in accordance with the Court Order.

The Recordation of Assignment places record ownership of the following patent applications into the names of Mr. Rasmussen and Mr. Fair:

U.S. Pat. App. No. 17/522,731;

U.S. Pat. App. No. 63/111,331; and

U.S. Pat. App. No. 63/168,890.

B. Ownership of an Invention is a Matter of State Law

It is unquestioned that a determination of ownership of an invention is a matter of state law. *MyMail, Ltd. v. AOL, Inc.*, 476 F.3d 1372, 1376 (Fed. Cir. 2007) (citing *Int'l Nutrition Co. v. Horphag Research Ltd.*, 257 F.3d 1324, 1329-30 (Fed. Cir. 2001)). There is no federal preemption of state law governing patent ownership.

In the present case, a state court has determined that Petitioners are the owners of the inventions that are the subject of U.S. Pat. App. No. 17/522,731. See **Exhibit 1031** on file with the Board. There are at least two basis for this ruling: (i) the wireline release tool was invented by Jon Rasmussen and Brandon Fair, and, alternatively, (ii) Aaron Holmberg and Nicholas Kleinschmit developed the wireline release tool at the request of Jon Rasmussen and Brandon Fair, and became “gratuitous employees” under the laws of the State of North Dakota.

Notice the following language from the Court Order:

In considering this issue, the Court also notes the manner in which [Respondents] became involved in the development of the Triton Tool. It’s undisputed that Fair and Rasmussen sent the first prototype to [Respondents], and that [Respondents] agreed to examine this tool. . . . [Respondents] 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 [Respondents] agreed to examine the tool.

Under the laws of the State of North Dakota, any contribution that Respondents may have made, and assuming that such contributions were ever made, belong to Rasmussen and Fair.

37 CFR § 42.9 provides that “[a]n owner of the entire interest in an involved [patent] application . . . may act to the exclusion of the inventor.” Based on the evidence presented at trial and a fair and good faith reading of the Court Order from the North Dakota state court, Petitioners have the right to file the North Dakota State Court Order with the U.S. Patent and Trademark Office (the “Office”) as evidence of ownership.

C. Correction of Applicant

On February 21, 2026, Petitioners filed a Request for Correction of Applicant (Form PTO/AIA/41) with the Office in connection with U.S. Pat. App. No. 17/522,731. The purpose was to change the Applicant from Mechanical Revolution, LLC to Messrs. Rasmussen and Fair.

In accordance with requirements set forth in the Manual of Patent Examining Procedure, Petitioners also submitted a Statement of Ownership (Form PTO/AIA/96) and a corrected Application Data Sheet.

Of interest, the Application Data Sheet corrects an omission by adding Jon R. Rasmussen as an inventor. This brings the list of inventors in line with U.S. Pat. App. No. 63/111,331 filed November 09, 2020. See Doc. No. 1011. This is the provisional patent application on which priority was claimed.

D. Suspension of Patent Applications

Both U.S. Pat. App. No. 17/846,932 and U.S. Pat. App. No. 17/522,731 remain suspended. The undersigned counsel submits that there is no reason for Petitioners' underlying patent application to be suspended. There has never been any challenge to ownership or inventorship of that application, and the claims have been allowed. Accordingly, Petitioners respectfully request that the Board consider lifting the suspension of U.S. Pat. App. No. 17/846,932 in light of the undisputed ownership and allowed claims in that application.

E. Three-Month Status Reports

As noted in the Board's Order, neither Petitioners nor Respondents have submitted a three-month status report to the Board. On information and belief, the Parties were unaware of this requirement. The undersigned counsel thanks the Board for bringing this matter to his attention.

F. Power of Attorney

It is the intent of the undersigned counsel to file a Power of Attorney in connection with U.S. Pat. App. No. 17/522,731, consistent with the Recordation of Assignment. It is also the intent of Petitioners to file a Request to Correct Inventors in order to add Messr. Rasmussen. This matter

could have been avoided if Messr. Holmberg had communicated with Messr. Rasmussen five years ago before filing his patent application.

Petitioners submit that in view of the joint ownership as between U.S. Pat. App. No. 17/522,731 and U.S. Pat. App. No. 17/846,932, the issues in this Derivation Proceeding are rendered moot.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned counsel hereby certifies that the above-captioned **PETITIONERS' RESPONSE TO BOARD ORDER OF FEBRUARY 20, 2026** was served via e-mail on February 23, 2026, to:

Ms. Stephanie R. Swanson
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Mr. Scot M. Ringenberg
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The undersigned has confirmed with Mr. Ringenberg that electronic copies are sufficient and preferred.

Respectfully submitted,

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