

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

Derivation Proceeding DER2023-00012

Jon R. Rasmussen and Brandon J. Fair

Petitioners,

vs.

Nicholas Kleinschmit and Aaron Holmberg

Respondents

RESPONDENTS' RESPONSE TO BOARD ORDER OF
FEBRUARY 20, 2026

In its Order dated February 20, 2026 (the “Order”), the Patent Trial and Appeal Board (the “Board”) has directed each of the Parties to submit to the Board a status update as to actions taken in the Patent Office since July 24, 2025. Pursuant to that Order, Respondents submit the following:

Actions Taken by Respondents

Pursuant to the Board Orders of July 9, 2025 and July 24, 2025, a limited Motion for Remand of Application Ser. No. 17/522,731 (the “Application”) was granted by the Board such that Petitioners could attempt to pursue unilateral assignment and recording actions regarding the Application.

As the Remand was limited to actions to be undertaken solely by Petitioners, Respondents were under no obligation to, and have not taken, any actions in the Application following the Board Order of July 24, 2025.

Respondents’ Preferred Course of Action

In the Order, the Board has ordered that both parties shall “indicate a course of action it prefers at this stage.”

Respondents note for the record that the subject Derivation proceeding is directed solely to the determination of *inventorship* of the Application and not to any *ownership* issues as has been repeatedly conflated by Petitioner in its filings in this case. *See*, 35 U.S.C. 135. Indeed, the Board itself has expressly stated:

[A]ny opposition by Respondent should clearly distinguish between (1) opposing a remand to the Examiner for Petitioner to raise and resolve application ownership issues as a procedural matter, (2) disagreeing with the merits of Petitioner’s assertion that it owns Respondent’s involved application, **an issue we do not intend to resolve in this proceeding**, and (3) any other basis for opposing the remand.¹

¹The opposition should focus on (1) and/or (3) **and not (2)**.

Board Order, July 9, 2025, (emphasis added).

To date, Petitioner has provided no evidence which addresses the *actual* technical

features recited in the allowable claim recitations of the Application, much less demonstrated that Petitioner conceived of any novel portion thereof such that they are an inventor. Rather, as has occurred again in its Response to Board Order filed February 23, 2026, Petitioner continues to rely on a misplaced theory of ownership as being dispositive of inventorship in a Derivation proceeding.

In view of such absence of evidence of conception, Respondents request that the Board Dismiss the Derivation on such no-evidence grounds or, in the alternative, request leave to file a Motion to Dismiss the Derivation on such no-evidence grounds.

To the extent the Board should decline to dismiss or give leave to file a Motion to Dismiss on such grounds, Respondents request that the Derivation proceeding be allowed to continue such that Respondent may further demonstrate that Respondents are the sole inventor of the allowable subject matter of the Application. Particularly, Respondents request leave to submit a Respondents' Answer to the Petition which demonstrates that Respondents are the only proper inventors of the allowable subject matter.

In the event the Board deems such an Answer premature, Respondents request, as suggested by the Board in the Order, that the Board "resume jurisdiction over the involved applications, and consider the Petition but exclude consideration of any argument by Petitioner that its inventors own Respondent's involved application and any reliance by Petitioner on the state court's decision and judgment to the extent it relates to ownership of technology."

Conclusion

Should the Board have any questions regarding these submissions or require further documentation, the Board is invited to contact Respondent's counsel.

Dated: February 24, 2026

Respectfully submitted,



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CERTIFICATION OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4)(i) and 42.406, the undersigned certifies that on April 24, 2025, a complete and entire copy of this submission was provided to counsel of record for Petitioners as follows:

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Dated: February 24, 2026

Respectfully submitted,



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