

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, RAE LYNN P. GUEST, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

ORDER
Conduct of proceeding
37 C.F.R. § 42.5

I. Introduction

On March 2, 2026, we issued an Order retaking exclusive jurisdiction of the parties' applications and authorized petitioner to file a Substitute Petition, with certain limitations. Paper 29.

On March 3, 2026, the Board received an email from Petitioner's counsel, which states:

This is to advise that the Parties have reached an Agreement in the above identified Derivation Proceeding [2023-00012]. Neither party wishes to pursue its arguments further before the Board. Each party desires to have the Derivation Proceeding dismissed and the applications remanded so that they can act upon the Notices of Allowance and receive their respective patents.

Ex. 3002. The email further states: "Petitioners are willing to concede that respondents are the inventors of the claims in the Respondents' patent application. Please advise if a formal Joint Motion to Dismiss is required." *Id.*

II. Discussion

The Board has not yet decided whether to institute a derivation proceeding. The proceeding still is in a preliminary stage. If the parties have resolved their differences and together desire to have the proceeding terminated without a decision whether to institute a derivation proceeding, a Joint Motion to Terminate indicating the same is appropriate. We anticipate that the Board would terminate the proceeding without rendering a decision on whether to institute a derivation proceeding, if the Motion is granted.

III. Order

It is

ORDERED that the parties shall take notice of the settlement agreement filing requirements of 37 C.F.R. § 42.74(b), and the opportunity to file a Request to Keep Agreement Separate under 37 C.F.R. § 42.74(c);

FURTHER ORDERED that the parties are authorized to file, within two weeks of the date of this Order, a Joint Motion to Terminate Proceeding, and that the motion must expressly state whether the agreement filing requirements of 37 C.F.R. § 42.74(b) have been satisfied; and

FURTHER ORDERED that filing of agreements to comply with 37 C.F.R. § 42.74(b) and filing of any request under 37 C.F.R. § 42.74(c) must be made on or prior to filing of the Joint Motion to Terminate Proceeding.

Case DER2023-00012
Petitioner Application 17/846,932
Respondent Application 17/522,731

For Petitioner:

Peter L. Brewer
Bernard Klosowski
Alexander J. Gambino
Thrive IP
pbrewer@thrive-ip.com
ben@thrive-ip.com
alex.gambino@thrive-ip.com

For Respondent:

Scot M. Ringenberg
Suiter Swantz IP
smr@suiter.com
patents@suiter.com