

How to Contest Inventorship of Patented Subject Matter Through Derivation Proceedings

A derivation proceeding is a novel proceeding applicable to claims filed on or after March 16, 2013 (the date these proceedings went into effect), which offers a mechanism for contesting inventorship at the United States Patent and Trademark Office (USPTO). The 2011 America Invents Act (AIA) replaced interference proceedings with this new proceeding. Reinhart attorney [John Paul Kale](#) discusses how inventors can contest inventorship of patented subject matter through derivation proceedings, a less expensive alternative to traditional litigation proceedings.

Since the AIA went into effect, the United States has adopted a “first-inventor-to-file” approach. Under this approach, the patent rights are reserved by the first inventor to file a patent application. In this regard, a person who is not an inventor or has an insufficient proprietary interest in the invention has no right to seek patent protection. Thus, an inventor who was not the first to file a patent application may file a derivation petition with the USPTO to contest the patent rights of an earlier applicant.

However, it is important to know that derivation proceedings are only applicable to patent applications or patents that include at least one claim with a priority date of March 16, 2013, or later.

Derivation proceedings are a trial-like proceeding under 35 U.S.C. 135 conducted before a panel of judges at the Patent Trial and Appeal Board (PTAB) to determine whether (1) an inventor named in an earlier application derived the claimed invention from an inventor named in the petitioner’s application; and (2) the earlier application claiming such invention was filed without authorization.

This petition must be filed concurrently with the petitioner’s patent application and within one year following the publication of the unauthorized application or patent. The unauthorized application or patent must contain claims that are substantially comparable to the petitioner’s claimed invention. In order to support the petition, the petitioner must provide at least one affidavit demonstrating how the invention was communicated to the original applicant and that the original applicant’s filing was not authorized. In addition, the petitioner must pay a petition fee, which is currently \$420.

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The original applicant retains the right to respond to the petition by arguing why no derivation proceeding should be initiated, including submitting any evidence or affidavits supporting their right to file the application. After all the evidence is in, the PTAB may invalidate claims covering the derived subject matter. Further, the PTAB can correct the naming of the inventor in any application or patent in derivation proceedings under appropriate circumstances. The USPTO may also extend the term of a patent subject to a derivation proceeding.

After the PTAB renders a final decision, either party may request a rehearing of the decision. However, the request must include a list of all concerns the party believes the PTAB disregarded. Alternatively, the aggrieved party may appeal to either the district court or the Federal Circuit Court of Appeals.

In light of the preceding, it is essential that inventors and, in particular, large corporations maintain records, including the dates of conception of ideas and the list of individuals who contributed to the ideas' reduction to practice. Further, it is important that applications be filed as soon as possible to limit the time during which the invention could be derived.

If you have any questions or would like more information regarding derivation proceedings, please contact JP Kale or your Reinhart attorney.

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