

From: Brad Pedersen OY! aUj` ` UXXFYgg' fYXUWYXQ  
Sent: Monday, November 07, 2011 5:37 PM  
To: ai\_a\_implementation  
Subject: Derivation proceedings

Patterson Thuent e Suggesti ons for Group 2 Rulemaki ngs:  
Subgroup 10 – Derivat ion Proceedi ng Rules

The law firm of Patterson Thuent e Christensen Pedersen (“Patterson Thuent e”) appreciates the opportunity to provide input with respect to the Request by Janet Gongola for Public Comments Urged for Group 2 Proposed Rule Maki ngs, dated October 28, 2011 on the USPTO America Invents Act (AIA) website. The suggesti ons contained in this email are submitted with respect to Group 2 Rulemaki ngs – Subgroup 10 – Derivat ion Proceedi ng Rules.

Patterson Thuent e is a firm with significant experience in the areas of ex parte reexamination, inter partes reexamination and interference practice. The firm is also nationally recognized for its expertise with respect to the AIA. Patterson Thuent e represents a wide and diverse spectrum of individuals, companies, and institutions before the United States Patent and Trademark Office.

The comments submitted herewith reflect the general views of Patterson Thuent e and do not necessarily reflect the view of opinions of any individual members of the firm, or any of their clients. Patterson Thuent e understands that the USPTO will not directly respond to these suggesti ons, and Patterson Thuent e reserves the right to formulate specific comments pursuant to formal rule promulgati on with respect to the Group 2 Rulemaki ngs.

With respect to Subgroup 10 – Derivat ion Proceedi ng Rules, Patterson Thuent e has the followi ng suggesti ons:

10.1 Timing to Initiate a Derivat ion

We suggest that the Office should interpret the language in new Section 135(a) to apply to the first publicati on of a “derived” claim, regardless of whether that happens in a published applicati on or patent, and regardless of whether the first publicati on is on a case filed by the alleged deriver or the party allegi ng derivati on.

10.2 Obviousness-type Standard for Derivat ion

We suggest that the Office should promulgate regulati ons that use an “obviousness” type derivati on standard as set forth in *New England Braiding v. Chesteron* 970 F.2d 878 (Fed. Cir. 1992), *DeGroff v. Roth*, 412 F.2d 1401 (CCPA 1969), *Agawam v. Jordon*, 74 US 583 (1868).

10.3 Reissue Available for a Derivat ion

We suggest that the Office should permit cases to be used to petiti on for an initiati on of a derivati on proceedi ng.

10.4 Derivat ion Petiti on Considered Only After Claims Otherwise Allowable

We suggest that the Office should not consider a derivati on until such time as the claims are otherwise in conditi on for allowance.

10.5 Split Resoluti ons in a Derivat ion

We suggest that the Office should permit split resoluti ons as part of a derivati on proceedi ng.

10.6 Claim Amendmets in a Derivat ion

We suggest that the Office should permit claim amendmets as part of a derivati on proceedi ng.

10.7 Validity Challenges in a Derivat ion

We suggest that the Office should permit challenges to the validity of a claim at issues as part of a derivati on proceedi ng.

10.8 Transfer Derivations to PGR

We suggest that the Office should transfer interferences to review proceedings as soon as issues related to inventorship are resolved, and, the party alleging derivation should be required to pay the fees for PGR proceeding should be waived for such a transfer.

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