

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ANDERSEN CORPORATION,
Petitioner Application No. 15/058,862,
Petitioner,

v.

GED INTEGRATED SOLUTIONS, INC.,
Respondent Patent No. 9,428,953 B2,
Respondent.

Case DER2017-00007

Before JONI Y. CHANG, JOSIAH C. COCKS, and JUSTIN T. ARBES,
Administrative Patent Judges.

COCKS, *Administrative Patent Judge.*

DECISION
Institution of Derivation Proceeding
37 C.F.R. § 42.408(a)

I. INTRODUCTION

A. Background

Petitioner, Andersen Corporation (“Andersen”) filed a corrected Petition (Paper 4, “Pet.”) to institute a derivation proceeding under 35 U.S.C. § 135 with respect claims 1–22 of U.S. Patent No. 9,428,953 B2 (the “’953 patent”) (Ex. 1005)¹ owned by Respondent, GED Integrated Solutions, Inc. (“GED”). On May 8, 2017, we issued an Order taking exclusive jurisdiction of each of Andersen’s Application No. 15/058,862 (“the ’862 application”)² and the ’953 patent. Paper 28.³ On January 25, 2018, we issued an Order granting Andersen’s Motion to confirm the accorded filing date of December 16, 2016 for Andersen’s corrected Petition. Paper 31.

35 U.S.C. § 135(a)(1) reads as follows:

(a) Institution of Proceeding.–

(1) In General.–An applicant for patent may file a petition with respect to an invention to institute a derivation proceeding in the Office. The petition shall set forth with particularity the basis for finding that an individual named in an earlier application as the inventor or joint inventor derived such invention from an individual named in the petitioner’s application as the inventor or a joint inventor and, without authorization, the earlier application claiming such invention was filed. Whenever the Director

¹ Application No. 14/703,027 (the “’027 application”) was filed May 4, 2015 and issued as the ’953 patent on August 30, 2016.

² The ’862 application was published on September 8, 2016 as U.S. Patent Application Publication No. 2016/0258205 A1 (Ex. 1004).

³ The panel also subsequently issued a “Supplemental Paper to Paper 28.” Paper 29.

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determines that a petition filed under this subsection demonstrates that the standards for instituting a derivation proceeding are met, the Director may institute a derivation proceeding.

This panel has authority to institute a derivation proceeding on behalf of the Director. *See* 37 C.F.R. § 42.408(a). The threshold showing for institution of a derivation proceeding is whether the petition demonstrates substantial evidence that, if unrebutted, would support a determination of derivation. 37 C.F.R. § 42.405(c).⁴ For the reasons that follow, we conclude that Petitioner has made a sufficient showing as to the requirements of 37 C.F.R. § 42.405 to warrant institution. Accordingly, pursuant to 35 U.S.C. § 135(a) and 37 C.F.R. § 42.408(a), we institute a derivation proceeding.

B. The '953 Patent

The '953 patent is titled "Spacer Frame and Method of Making Same." Ex. 1005, Title. Figure 7 of the '953 patent is reproduced below.

⁴ Substantial evidence is defined as that which a reasonable person might accept as adequate to support a conclusion. *Falkner v. Inglis*, 448 F.3d 1357, 1363 (Fed. Cir. 2006); *see also In re Zurko*, 258 F.3d 1379, 1384 (Fed. Cir. 2001).

[T]he connector structure 34 further comprises a first aperture 70 and corresponding second aperture 72 in the segment 304 [not shown above] for a fastener arrangement (not shown) for both connecting the opposite frame end 54 with the first frame end 56 and providing a temporary vent for the evacuation of air or insertion of gas into the space 20 [not shown above] while the unit 10 [not shown above] is being fabricated. The apertures 70 and 72 are automatically aligned because of the configurable dimensions A and B that when summed equal C (see FIG. 7) when the frame ends 54, 56 are properly telescoped together and the end 54 engages stops 64. The stops 64 reassure concentric alignment of the apertures 70, 72.

Id. at 9:40–52.

The '953 patent also explains that “stops 64 further reassure a repeatable length of the telescopic union of the lateral connection 60. This advantageously reassures that all four corner structures 32 are identical in spacing, size, angle orientation, and construction, thus reducing the potential for failure.” *Id.* at 9:53–57. Further,

the need for sealant 18 to cover the telescopic connection 58 advantageously placed only along the lateral connection 60, which along a single lateral direction see arrow A in FIG. 9). Thus, the dual direction applying and wiping of the seal 18 in conventional space frames . . . is eliminated by the lateral connection spaced away from the corner structures 32 of the present disclosure.

Id. at 11:17–24.

C. The '862 Application

The '862 application is titled “Offset Seam for Insulating Glass Unit Spacer and Method of Using and Manufacturing the Same.” Ex. 1004, Title. Figure 1 of the '862 application is reproduced below.

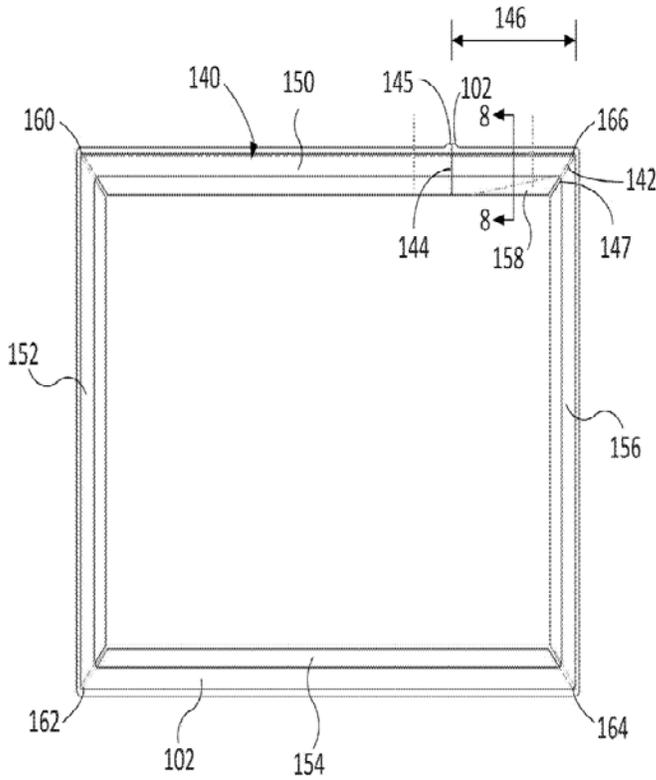


Figure 1

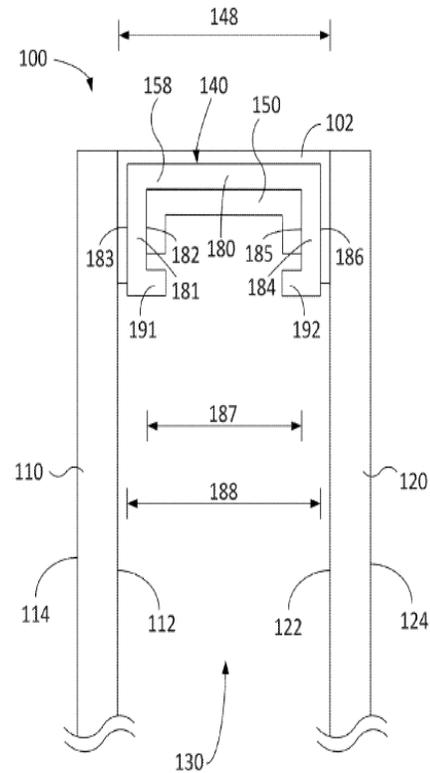


Figure 8

Figure 1 “depicts one illustrative embodiment of a spacer/spacer frame assembly including an offset seam” according to the invention of the ’862 application. *Id.* at 2, ¶ 21. Figure 8 “is a cross-sectional view of the spacer/spacer frame assembly of FIG. 1 taken along line 8-8 in FIG. 1, with a pair of glass panels located on opposite sides of the spacer/spacer frame assembly.” *Id.* at 2, ¶ 29. Frame assembly 140 includes five spacer segments 150, 152, 154, 156, and 158 and four corners 160, 162, 164, and 166. *Id.* at 3, ¶¶ 34–35. As shown in Figure 1, spacer segment 150 and spacer segment 158 overlap to define exterior seam/union point 145, which is located a seam offset distance 146 away from corner 166. *Id.* at 3, ¶¶ 45–46.

The insulating glass unit 100 includes a first pane 110 and a second pane 120. The first and second panes 110, 120 may be constructed of glass or any other material suitable for an insulating glass unit 100. The first pane 110 includes an interior surface 112 and an exterior surface 114 opposite the interior surface 112. The second pane 120 includes an interior surface 122 and an exterior surface 124 opposite the interior surface 122. The interior surface 122 of the second pane 120 faces the interior surface 112 of the first pane 110 and the exterior surface 124 of the second pane 120 faces away from the first pane 110. The insulating glass unit 100 further includes a spacer/spacer frame assembly 140 located between the first and second panes 110, 120. An interior volume 130 of the insulating glass unit 100 is defined between the first pane 110, the second pane 120, and the spacer/spacer frame assembly 140.

Id. at 2, ¶ 31.

D. Illustrative Claims and Claim Correspondence

Andersen contends that claims 60–81 of the '862 application correspond to claims 1–22 of the '953 patent, and that those corresponding claims are identical. Pet. 7–9. Claim 60 of the '862 application and claim 1 of the '953 patent, respectively, are representative and reproduced below. *See Exs. 1005, 3001* (copy of the currently pending claims of the '862 application).

A spacer frame assembly comprising:

a substantially linear channel having first and second ends, the substantially linear channel that when assembled, includes at least three sides and corresponding corners between each of said sides;

a connecting structure located at one of said first and second ends and an opposite frame end located at the other of said one of first and second ends, the opposite frame end having an inner channel for receiving a nose portion of said connecting structure;

a stop extending from said connecting structure of locating the opposite frame end when in the assembled position; and

a lateral connection spaced from said corresponding corners and along one of said at least three sides, the lateral connection forming a union point by said top between said opposite frame end and said connecting structure.

II. ANALYSIS

A. The Applicable Law

Although a derivation proceeding is a creation of the Leahy-Smith America Invents Act (“AIA”), Public Law No. 112-29, § 3(i),⁵ the charge of derivation of invention as a basis for finally refusing application claims and cancelling patent claims had been adjudicated under 35 U.S.C § 135(a) as it existed prior to the enactment of AIA. On the substantive law of derivation of invention, we apply the jurisprudence which developed in that context, including the case law of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals.

Under the AIA, a petitioner must show that the respondent, without authorization, filed an application claiming such derived invention. 35 U.S.C. § 135(a); 37 C.F.R. § 42.405(b)(2). A derivation petition with respect to an invention that is the same or substantially the same as a claim contained in a patent issued on an earlier application, or contained in an earlier application when published or deemed published under section 35 U.S.C. § 122(b), must be filed during the 1-year period following the date on

⁵ Leahy-Smith America Invents Technical Corrections Act, Public Law No. 112- 274, § 1(e)(1), (k)(1).

which the patent containing such claim was granted or the earlier application containing such claim was published, whichever is earlier.⁶ 35 U.S.C. § 135(a).

To prove derivation, the party asserting derivation must establish prior conception of the claimed subject matter and communication of that conception to an inventor of the other party. *Cooper v. Goldfarb*, 154 F.3d 1321, 1332 (Fed. Cir. 1998); *Price v. Symsek*, 988 F.2d 1187, 1190 (Fed. Cir. 1993); *Hedgewick v. Akers*, 497 F.2d 905, 908 (CCPA 1974). ““There can be no derivation without prior conception on the part of the party alleging derivation.”” *Davis v. Reddy*, 620 F.2d 885, 889 (CCPA 1980) (quoting *Egnot v. Looker*, 387 F.2d 680, 687 (CCPA 1967)). A charge of derivation addresses originality—who invented the subject matter at issue. *Price*, 988 F.2d at 1191.

Conception is the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention, as it is therefore to be applied in practice. *Kridl v. McCormick*, 105 F.3d 1446, 1449 (Fed. Cir. 1997); *Burroughs Wellcome Co. v. Barr Labs. Inc.*, 40 F.3d 1223, 1228 (Fed. Cir. 1994); *Coleman v. Dines*, 754 F.2d 353, 359 (Fed. Cir. 1985). “Conception must be proved by corroborating evidence which shows that the inventor disclosed to others his completed thought expressed in such clear terms as to enable those skilled in the art to make the invention.”

⁶ As set forth in our previous Order (Paper 31), the Petition was accorded a filing date of December 16, 2016, which is within one year following publication of the '027 application on December 17, 2015 (U.S. Patent Application Publication No. 2015/0361713 A1). Thus, we conclude based on the current record that Petitioner’s Petition was timely filed.

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Coleman, 754 F.2d at 359. A rule of reason applies to determining whether the inventor's testimony has been corroborated. *Price*, 988 F.2d at 1194. "The rule of reason, however, does not dispense with the requirement for some evidence of independent corroboration." *Coleman*, 754 F.2d at 360.

Thus, the showing of prior conception and communication need be made for an invention disclosed to an inventor of the other party. Any challenged claim which the petitioner demonstrates is "the same or substantially the same" as the disclosed invention constitutes a derived invention.⁷ See 37 C.F.R. § 42.405(b)(3)(i). Proof of conception must encompass all limitations of the disclosed invention. See *Singh v. Brake*, 222 F.3d 1362, 1367 (Fed. Cir. 2000); *Kridl*, 105 F.3d at 1449; *Sewall v. Walter*, 21 F.3d 411, 415 (Fed. Cir. 1994); *Coleman*, 754 F.2d at 359; *Davis*, 620 F.2d at 889.

If the petitioner identifies one of its own claims as defining or representing that invention disclosed to an inventor of the other party, then petitioner has to establish corroborated conception of that claimed invention, as well as corroborated communication of that conception. Assuming that corroborated conception and communication both are established, the petitioner would be able to regard as a derived invention those challenged claims of the respondent which are shown by the petitioner to be drawn to the same or substantially the same invention as the disclosed invention. That

⁷ "Same or substantially the same" means patentably indistinct, 37 C.F.R. § 42.401, and in this specific context, patentably indistinct is evaluated one-way in the direction from the invention disclosed to the respondent to each challenged claim.

question is evaluated in the direction from the disclosed invention to each challenged claim.

Pursuant to 37 C.F.R. § 42.405(a)(2), a petitioner also has to show that it has at least one claim that is (i) the same or substantially the same as the respondent's claimed invention, and (ii) the same or substantially the same as the invention disclosed to the respondent. If the petitioner selects one of its own claims as the "invention disclosed to the respondent," the selection itself can be relied on as satisfying the requirement of 37 C.F.R. § 42.405(a)(2)(ii).

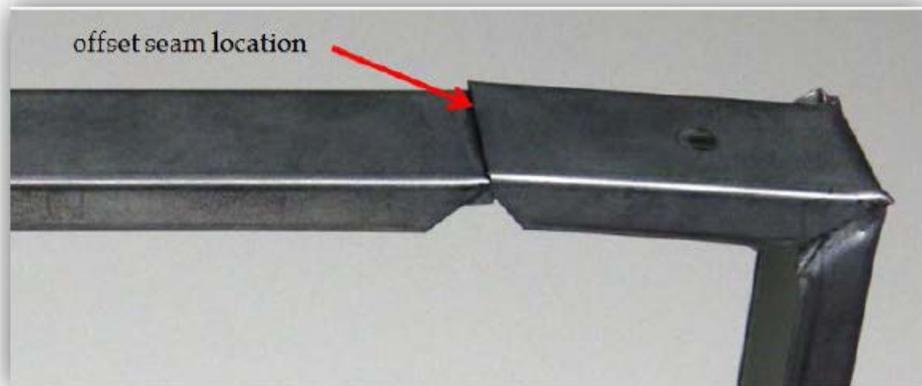
B. Conception

Sammy H. Oquendo is the named inventor of Andersen's '862 application. Ex. 1004, (72). Andersen provides a detailed narrative explaining Mr. Oquendo's work with Silver Line Building Products LLC ("Silver Line")⁸ in developing assemblies termed "insulating glass units" or "IGUs" that were known in the industry around 2009, supported by an affidavit from Mr. Oquendo. *See generally* Pet. 14–25 (citing Ex. 1001). For instance, Mr. Oquendo testifies that he recognized potential deficiencies in connection with sealing of such insulating glass units. *See, e.g.*, Ex. 1001 ¶¶ 10–25. In that respect, Mr. Oquendo testifies the spacer frames of IGUs were understood as having four corners with three of those corners identical in construction and a fourth containing a seam. *See id.* ¶ 11. Mr. Oquendo also attests that he became aware that a root cause of IGU seal failures was due to the presence of the seam at the corner of frame assemblies, including

⁸ Silver Line is stated to be a subsidiary of Andersen. Pet. 14–15.

a particular spacer frame termed “Intercept®” that had been developed by GED. *See id.* ¶¶ 19, 20. Mr. Oquendo further testifies that he conceived of an idea to move the seam away from the fourth corner, which would provide the benefit of: (1) reducing IGU seal failures; (2) eliminating the need to seal the corner manually; and (3) enabling a standardized process for sealing all four corners of an IGU. *Id.* ¶¶ 22–25.

Mr. Oquendo also testifies that in March 2009, he developed a prototype of a spacer frame unit with a seam offset from the fourth corner. *See id.* ¶¶ 26–29; Ex. 1011⁹. More particularly, Mr. Oquendo attests that the March 2009 Prototype was an amalgamation of two traditional Intercept® spacer frames constructed to offset the seam location for the fourth corner, as shown, for instance, in the image below (Ex. 1001 ¶ 28).



The image above is described as depicting the offset seam location that is a “result of using pre-existing Intercept® spacer frames to build the March 2009 Prototype.” Pet. 21. Andersen points to a “May CAD drawing”

⁹ Exhibit 1011 is characterized by Mr. Oquendo as photographs depicting the “March 2009 Prototype.”

and “June 2009 computer-aided drafting drawing” (collectively “2009 CAD drawings”) in which a seam is illustrated offset from the spacer frame corner. *Id.* at 22–23 (citing Exs. 1012, 1013;¹⁰ Ex. 1001 ¶¶ 29, 41, 42).

Andersen further advocates that both the March 2009 Prototype and 2009 CAD drawings depict and describe “a stop mechanism at the offset seam to properly position the frame in its assembled form.” *Id.* at 24. In that respect, Andersen explains that Mr. Oquendo conceived and reduced to practice several embodiments of the stop mechanism. *Id.* at 24–25 (citing Ex. 1001 ¶¶ 36–39; Exs. 1011–1013). Lastly, Andersen contends that the record presents evidence that other individuals associated with Silver Line and Andersen witnessed Mr. Oquendo’s conception and reduction to practice of his invention. *Id.* at 25 (citing Ex. 1015).¹¹

Andersen also presents in its Petition a detailed mapping of record evidence to all of the recited elements of claims 1–22 of the ’953 patent, to establish that Mr. Oquendo conceived of what is recited in those claims. *Id.* at 32–77. That mapping includes reference to the evidence noted above, and other evidence of record. For example, Petitioner references the evidence cited above regarding the stop at the offset seam location for the “stop extending from said connecting structure” and “lateral connection forming a

¹⁰ Exhibit 1013 is characterized by Andersen and Mr. Oquendo as a “June 2009 CAD drawing” (*see* Pet. 22; Ex. 1001 ¶ 29), and we use that same designation. In that respect, although the drawing appears with a “date” of “5/14/09,” Mr. Oquendo testifies that “the creation date of Ex. 1013 is June 5, 2009.” Ex. 1001 ¶ 29 (citing Ex. 1029).

¹¹ Exhibit 1015 constitutes an e-mail from Mr. Oquendo to five individuals said to be associated with Silver Line that includes, as an attachment, the June 2009 CAD drawing.

union point by said stop between said opposite frame end and said connecting structure” limitations of claim 1. *Id.* at 34–36.

The derivation rules provide a framework in which a petitioner would assert and prove that an invention was conceived by a petitioner’s inventor(s) and communicated to a respondent, and then show how one or more of a respondent’s challenged claims is the same patentable invention as that proven by the petitioner as having been conceived by the petitioner’s inventor(s) and communicated to the respondent. *See* 35 U.S.C. § 135(a); 37 C.F.R. § 42.405. That, however, is not the approach taken by Andersen in this Petition. Rather, Andersen asserts that its inventor conceived of the subject matter of *each* of claims 1–22, and communicated *each* conception to GED. Thus, Andersen essentially has used its Petition to assert 22 different derivations covered by the pertinent rules (i.e., 22 different inventions that allegedly were derived). We are aware of no prohibition against this approach and thus treat the Petition accordingly.

In considering the record at hand, and prior to having heard from Respondent, we conclude that there is substantial evidence that demonstrates, for purposes of this Decision, that Mr. Oquendo conceived of the invention of *each* spacer frame assembly that is claimed in claims 1–22 of the ’953 patent (and claims 60–81 of the ’862 application, which are identical), and that such conception is corroborated by record evidence.

C. Communication

Andersen asserts that Mr. Oquendo disclosed his invention to Bill Briese (a named inventor of the ’953 patent) and his colleagues, who were employees of GED. Pet. 26. In particular, Andersen contends the

following: (1) “GED First Learned of the Oquendo Invention at the March 2009 Glass Symposium” (Pet. 26–27 (citing Ex. 1001 ¶¶ 49–52; Ex. 1018¹²; Ex. 1019¹³)); (2) “GED Received Additional Details of the Invention In around June 2009” (*id.* at 27–28 (citing Ex. 1001 ¶¶ 55–56; Ex. 1021¹⁴; Ex. 1016¹⁵)); (3) “GED Obtained Detailed Drawings of the Oquendo Invention and Knew the Invention was Complete” (*id.* at 28–29 (citing Ex. 1001 ¶¶ 57–58; Ex. 1022¹⁶; Ex. 1023¹⁷)); and (4) “GED Marketed Mr. Oquendo’s Invention as ‘Corner Plus’ at a trade show in 2014” (*id.* at 29–31 (citing Ex. 1001 ¶¶ 60–62; Ex. 1002¹⁸ ¶¶ 11, 12)). Petitioner explains in detail how Mr. Oquendo allegedly conceived of the invention of each spacer frame assembly recited in claims 1–22 of the ’953 patent and communicated each such conception to Mr. Briese and others (e.g., by showing him the March

¹² Exhibit 1018 is presented as an e-mail communication from GED employee Timothy McGlinchy to Mr. Briese and others characterized as the “McGlinchy March 16, 2009 E-Mail.”

¹³ Exhibit 1019 is characterized as the “Glass Symposium Review.”

¹⁴ Exhibit 1021 is presented as an e-mail from Mr. Briese to Mr. Oquendo characterized as the “Briese May 29, 2009 Email to Oquendo.”

¹⁵ Exhibit 1016 is presented as an e-mail communication from Mr. Oquendo to Andersen’s Commercialization Engineer Alex Bredemus described as the “Oquendo June 8, 2009 Email to Bredemus.”

¹⁶ Exhibit 1022 is presented as a certificate from GED pertaining to completion of Intercept® Frame Machining service training by Mr. Oquendo designated “Certificate of Completion.”

¹⁷ Exhibit 1023 is presented as an e-mail from Mr. Briese to Mr. Oquendo described as “Briese January 12, 2011 Email to Oquendo.”

¹⁸ Exhibit 1002 is a declaration of Andersen’s Glass Technology Engineering Lead, Mr. Brian Parker.

2009 Prototype), citing to corroborating evidence in the record. *Id.* at 32–77. The above-referenced evidence reflects numerous interactions between Mr. Oquendo and employees of GED, including Mr. Briese, beginning on or around March 2009. In considering the Petition and the record evidence noted above, and prior to having heard from Respondent, we conclude that substantial evidence supports Andersen’s contention that each spacer frame assembly recited in claims 1–22 of the ’953 patent discussed above was conceived by Mr. Oquendo, that each such conception was communicated to Mr. Briese and others at GED, and that each invention was derived from Mr. Oquendo.

D. Substantially the Same Invention

As discussed above, per 37 C.F.R. § 42.405(a)(2), a petitioner must show that it has at least one claim that is (i) the same or substantially the same as the respondent’s claimed invention, and (ii) the same or substantially the same as the invention disclosed to the respondent. Here, Andersen contends that claims 60–81 of the ’862 application and claims 1–22 of the ’953 are “identical.” Pet. 7. We observe that the claims include identical terminology, and there is no suggestion on the record before us that any term of claims 60–81 of the ’862 application takes on a different meaning than any term of claims 1–22 of the ’953 patent.¹⁹ *See* Exs. 1005, 3001. Further, as explained above, Andersen has made a sufficient showing on this record that what is recited in each of those claims is the same or

¹⁹ We address matters of claim construction in the section below.

substantially the same as what was disclosed to Mr. Briese and others at GED. *See supra* Section II.C; Pet. 32–77.

Accordingly, we conclude that, based on the record at hand and prior to having heard from Respondent, Andersen has shown sufficiently that it has at least one claim that is the same or substantially the same as GED’s claimed invention, and also that Andersen has at least one claim that is the same or substantially the same as the invention disclosed to Mr. Briese and others at GED.

E. Claim Construction

Pursuant to 37 C.F.R. § 42.405(b)(3)(ii), a petitioner must identify how claims are to be construed. Here, Andersen proposes an interpretation for one term in the claims of the ’953 patent: “stop.” Pet. 9. According to Andersen, the term “stop” means “[a] physical abutment that prohibits movement of the adjoining structure beyond a predetermined location.” *Id.* In advocating that meaning, Andersen points to various content of the ’953 patent. *Id.* at 9–13. We observe that the ’953 patent makes frequent use of the term “stop.” For instance, the ’953 patent describes a space frame assembly with a connecting structure between first and second ends of a linear channel and an opposite frame end with “a stop extending from the connecting structure for locating the opposite frame end when in the assembled position.” Ex. 1005, 3:27–40. The ’953 patent also characterizes a “stop” as an “abutment stop” that is “for limiting movement” of the above-noted ends. *Id.* at 4:10–16. We also agree with Andersen that the ’953 patent describes various embodiments in which “stops 64” operate as physical abutments for limiting movement. Pet. 10–11 (citing Ex. 1005,

Figs. 7, 10L, 10M; 9:17–22, 10:60–63, 11:3–7). For purposes of this Decision, we adopt Andersen’s proposed meaning of “stop” as “[a] physical abutment that prohibits movement of the adjoining structure beyond a predetermined location,” and conclude that no other terms require interpretation. The parties are encouraged to address claim interpretation during trial, to the extent the meaning of any terms is disputed.

F. The Filing of the ’027 Application

On May 4, 2015, the ’027 application that issued as the ’953 patent was filed naming William Briese and Clifford J. Webber as inventors. Andersen, with reference to Mr. Oquendo’s testimony and to a document designated “Agreement of Confidentiality” (Ex. 1017), contends that the filing of the ’027 application was not authorized by Mr. Oquendo. Pet. 78–79. We accept, for purposes of this Decision, that the filing of the ’027 application was not authorized.

G. Joint Motion to Seal

The parties filed a Joint Motion to Seal Exhibit 1020. Paper 17. In conjunction with that Motion, the parties filed a Stipulated Protective Order, which is a copy of the Board’s Default Protective Order. Exhibit 1040.²⁰

²⁰ The Board has a strong interest in the public availability of the proceeding. We advise the parties that redactions to documents filed in this proceeding should be limited strictly to isolated passages consisting entirely of confidential information, and that the thrust of the underlying argument or evidence must be clearly discernible from the redacted versions. We also advise the parties that information subject to a protective order will become public if identified in a final written decision in this proceeding, and that a motion to expunge the information will not necessarily prevail over the public interest in maintaining a complete and understandable file history.

The standard for granting a motion to seal is “for good cause.” 37 C.F.R. § 42.54(a). The movant bears the burden of proof in showing entitlement to the requested relief, and must explain why the information sought to be sealed constitutes confidential information. *See* 35 U.S.C. § 316(a)(7); 37 C.F.R. § 42.20(c); Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,760. According to the parties, Exhibit 1020 is “a drawing of Andersen’s spacer frame assembly process, designed specifically for Andersen by GED,” which “represents the confidential process of manufacturing Andersen’s commercial products, as well as GED’s research, development, and characterization regarding that process,” and contains a confidentiality notice. Paper 17, 2. Upon reviewing the material sought to be sealed, and the parties’ arguments regarding its confidential nature, we are persuaded that good cause exists to seal Exhibit 1020. We approve the Stipulated Protective Order and grant the parties’ Joint Motion to Seal Exhibit 1020.²¹

III. CONCLUSION

For the foregoing reasons, we conclude that Andersen has made a sufficient showing as to the requirements set forth in 37 C.F.R. § 42.405, and, as a result, it is appropriate to institute a derivation proceeding. Accordingly, pursuant to 35 U.S.C. § 135(a) and 37 C.F.R. § 42.408(a), we

See Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,761 (Aug. 14, 2012).

²¹ We observe that GED filed Paper 30 as “Parties and Board Only” in the Patent Trial and Appeal Board End to End (PTAB E2E) system, without a corresponding motion to seal. Paper 30 is “Respondent’s Updated Notices Pursuant to 37 C.F.R. § 42.8.” Paper 30 will be made public in due course.

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do so. The Board, however, has not made a final determination under 35 U.S.C. § 135(b) as to derivation or any of the issues addressed herein.

In this proceeding, we are instituting trial on 22 allegedly “conceived” and “disclosed” inventions, as presented in the Petition. An initial conference will be conducted to discuss the impact of that scenario on the trial.

IV. ORDER

It is

ORDERED that, pursuant to 35 U.S.C. § 135(a), a derivation proceeding is instituted as to claims 1–22 of the ’953 patent;

FURTHER ORDERED that pursuant to 37 C.F.R. § 42.4 (*see* 37 C.F.R. § 42.400(a)), notice is hereby given of the institution of a trial. The trial will commence on the entry date of this Decision;

FURTHER ORDERED that the parties’ Joint Motion to Seal Exhibit 1020 is *granted*;

FURTHER ORDERED that the Stipulated Protective Order (Exhibit 1040) is entered and shall govern the treatment and filing of confidential information in the instant proceeding; and

FURTHER ORDERED that Paper 30 shall be designated as publicly available in the PTAB E2E system.

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