

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SOLAR JUNCTION CORPORATION,  
Petitioner Application No. 16/132,059,

v.

IQE, PLC,  
Respondent Patent No. 9,768,339 B2,  
Respondent.

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Case DER2018-00019

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

CHANG, *Administrative Patent Judge.*

ORDER  
Conduct of Proceeding  
*37 C.F.R. § 42.5*

On July 29, 2019, Judges Chang, Cocks, and Arbes held a conference call with respective counsel for the parties. The purpose of the call was to discuss the status of Petitioner's pending Application No. 16/132,059 (the "'059 application") and whether the Board should exercise exclusive jurisdiction under 37 C.F.R. § 42.3(a) over the application and Respondent's involved patent at this time for the purpose of determining whether to institute a derivation proceeding.

During the conference call, Petitioner indicated that the Examiner entered a second Final Office Action on June 5, 2019, rejecting Petitioner's pending claims under 35 U.S.C. § 103, as obvious based on prior art that does not involve Respondent's Patent No. 9,768,339 B2 (the "'339 patent"). According to Petitioner, based on a previous Final Office Action and After-Final Amendment from Respondent, there appears to be a misunderstanding or confusion regarding the Examiner's outstanding rejection. Nevertheless, Petitioner indicated that it has not requested an interview with the Examiner, and has not yet responded to the Examiner's Final Office Action entered on June 5, 2019. Instead, Petitioner contacted a Supervisory Patent Examiner who is a specialist in Technology Center 1700.

In addition, during the conference call, Petitioner requested that the Board (1) exercise exclusive jurisdiction over the '059 application and the '339 patent to decide whether to institute a derivation proceeding, and (2) if a derivation proceeding is instituted, address the patentability of Petitioner's and Respondent's claims pursuant to 37 C.F.R. § 42.400(b), because Petitioner's claims are identical to those in the '339 patent.

In this regard, Respondent opposed, arguing that it would be more efficient for Petitioner to resolve the patentability issues regarding Petitioner's claims with the Examiner at this time. Under the particular factual circumstances of this case, we agree with Respondent and do not exercise exclusive jurisdiction over the involved application and patent at this time.

"A derivation is unlikely to be instituted, even where the Director thinks the standard for instituting a derivation proceeding is met, if the petitioner's claim is not otherwise in condition for allowance." *Changes to Implement Derivation Proceedings*, 77 Fed. Reg. 56,068, 56,069 (Sept. 11, 2012) (final rule); cf. *Brenner v. Manson*, 383 U.S. 519, 528 n.12 (1966); accord *Ewing v. Fowler Car Co.*, 244 U.S. 1, 7 (1917).

Here, Petitioner's claims are not otherwise in condition for allowance. In the Final Office Action entered on June 5, 2019, the Examiner indicated that Petitioner's "claims 1–3, 5–11, and 13–30 are not entitled to the benefit of the prior applications," and "are rejected under 35 U.S.C. 103 as being unpatentable over Jones et al. (US 2011/023273) as evidenced by Bedell et al. (US 2012/0255600) and as evidenced by Hieslmari et al. (US 2007/0212510)." Ex. 3001, 3, 5–11. None of the prior art relied upon by the Examiner involves the '339 patent. Furthermore, if there is a misunderstanding or confusion with the Examiner's outstanding rejection, it would be more efficient at this time for Petitioner to seek clarification from the Examiner concerning the rejection, by requesting an interview or responding to the Final Office Action.

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In sum, Petitioner's request that the Board exercise exclusive jurisdiction over the '059 application and the '339 patent to decide whether to institute a derivation proceeding is *denied*.

We would like to remind the parties that, should circumstances change with respect to the '059 application in the future, they may contact the Board and jointly request a conference call with the panel regarding any issues in connection with the derivation proceeding.

Finally, we note that both the '059 application and the '339 patent are available to the public. Petitioner's '059 application published as U.S. Patent Application Publication No. 2019/0013430 A1 on January 10, 2019. Respondent's '339 patent issued on September 19, 2017. Pursuant to 37 C.F.R. § 42.412(b)(1), the record of this proceeding (other than documents subject to Petitioner's pending motion to seal, Paper 1) will be made publicly available, unless either party notifies the Board, by email to *Trials@uspto.gov* by August 6, 2019, that it objects to doing so.

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