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America Invents Act (AIA) - Derivation Proceedings - Other

- ▼ Can a party to a derivation proceeding appeal the Board's final decision? (Question: DER1060)

Yes, a party dissatisfied with a final decision in a derivation proceeding may appeal to district court or the Federal Circuit.

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- ▼ In lieu of a derivation, can the parties to a derivation proceeding resolve inventorship in any other way? (Question: DER1070)

Yes, the parties to a derivation proceeding may resort to binding arbitration to determine inventorship.

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- ▼ Can the parties to a derivation proceeding engage in settlement? (Question: DER1080)

Yes, the AIA permits the parties to a derivation proceeding to settle. A settlement in a derivation proceeding will be accepted by the Board unless inconsistent with the evidence of record.

▼ What are the requirements for seeking a derivation proceeding? (Question DER1020)

A derivation proceeding requires that an applicant for patent file a petition to institute the proceeding. The petition must set forth with particularity the basis for finding that an inventor named in an earlier application derived the claimed invention from the petitioner. The petition must be made under oath and supported by substantial evidence. The petition must be filed within 1 year of the date of the first publication of a claim to an invention that is the same or substantially the same as the earlier application's claim to the invention.

▼ What statutory requirements must a petitioner meet in a petition for a derivation proceeding? (Question: DER1030)

In a petition for a derivation proceeding, the petitioner must (i) identify which application or patent is disputed; and (ii) provide at least one affidavit addressing communication of the derived invention and the lack of authorization for filing the earlier application.

▼ What is the standard for instituting a derivation proceeding and who will decide whether the standard is met? (Question: DER1040)

A derivation may be instituted where the petition sets forth a basis for finding that the inventor named in an earlier application derived the claimed invention and there is substantial evidence to support the allegations raised in the petition. The Patent Trial and Appeal Board will decide petitions for derivation and conduct any ensuing derivation proceeding.

▼ How will the Board conclude a derivation proceeding? (Question: DER1050)

The AIA provides that where a derivation proceeding is instituted and not dismissed, the Board shall issue a written decision that states whether an inventor named in an earlier application derived the claimed invention from an inventor named in the petitioner's application without authorization.

▼ What is the effective date for the derivation provision in the AIA? (Question: DER1010)

The effective date for the derivation provision in the AIA is March 16, 2013.

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