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Paper 91
Date: March 30, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GLOBAL HEALTH SOLUTIONS LLC,
Petitioner,

v.

MARC SELNER,
Respondent.

DER2017-00031
Petitioner Application 15/672,197[1]
Respondent Application 15/549,111[2]

Before JAMESON LEE, JOSIAH C. COCKS, and MICHAEL R. ZECHER, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge.*

JUDGMENT
Final Written Decision
Determining No Challenged Claims Derived
35 U.S.C. § 135(b)

I. Introduction

A petition alleging derivation of invention was filed by Global Health Solutions LLC ("Petitioner") on August 11, 2017, against claims in an

[1] Bradley Burnam is the sole named inventor on Petitioner's Application.
[2] Marc Selner is the sole named inventor on Respondent's Application.

application of Marc Selner ("Respondent"). Paper 3. Both Petitioner's and Respondent's application claims changed during the course of examination. On January 28, 2022, with authorization from the Board,[3] and without objection from Respondent, Petitioner filed a "Supplemental Brief." Paper 19 ("Supp. Br."). The Supplemental Brief replaces the initially filed petition.[4] Paper 18, 1.

The parties jointly filed a list of both parties' pending claims. Paper 17. The list identifies claims 1–10 in Petitioner's U.S. Patent Application No. 15/672,197. *Id.* at 1–2. It also identifies claims 24–38 in Respondent's U.S. Patent Application No. 15/549,111. *Id.* at 7–9. However, Respondent's claims 37 and 38 were already cancelled by the Examiner. Ex. 3001. Respondent's pending claims are only claims 24–36. Petitioner challenges all of Respondent's claims 24–36. Pet. 45, 50.

We instituted the derivation proceeding on April 6, 2022. Paper 25 ("Decision to Institute" or "Inst. Dec."). The Decision to Institute authorized Petitioner to obtain a subpoena, pursuant to 35 U.S.C. § 24, from an appropriate United States District Court, to take the testimony of Brad

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[3] Conditions were placed on what changes are permitted. Paper 8, 3. "Petitioner will *not* be given a new opportunity to formulate a new alleged conception of invention, or a new alleged communication of conceived invention to Respondent's inventor(s)." *Id.* The new submission was required "to clearly articulate each element of that invention which was allegedly conceived by Petitioner's inventor and communicated to Respondent's inventor(s). *That articulated invention will be regarded as 'the invention disclosed to the respondent'* under 37 C.F.R. § 42.405." *Id.*

[4] The Supplemental Brief relies on a declaration from inventor Bradley Burnam (Ex. 1011), a declaration from attorney Todd M. Malynn (Ex. 1012), and a declaration from Dr. Eric C. Luo (Ex. 1013).

Meeuwsen, where the scope of the testimony to be taken is limited to that proffered in the Declaration of Todd M. Malynn (Ex. 1012). Inst. Dec. 26.

On May 6, 2022, with the Board's authorization, Petitioner filed the declaration of Brad Meeuwsen (Ex. 1076) and a modified supplemental Petition (Paper 28), which adds citation to the declaration of Brad Meeuwsen. Hereinafter, we cite and refer to the modified supplemental Petition as "Petition" or "Pet." The Board also authorized Petitioner to substitute a declaration of Serina Dai for the declaration of Dr. Eric C. Luo who became unavailable for cross-examination due to a serious medical condition. Paper 40. Petitioner then submitted the declaration of Serina Dai. Ex. 1077.

Respondent filed a Response (Paper 45) and then an authorized Substitute Response (Paper 52). Hereinafter, we cite and refer to the Substitute Response as "Response" or "Resp." The Response relies on the declarations of Marc Selner (Ex. 2117) and Ashley Corbin (Ex. 2118). Petitioner filed a Reply. Paper 58. The Reply relies on a rebuttal declaration of Bradley Burnam (Ex. 1098), a declaration of Robert Daniel Davis (Exhibit 1092),[5] and a declaration of Alex Gelfand (Ex. 1095). Respondent did not file a Sur-Reply. Respondent filed a Motion to Exclude. Paper 69. Petitioner filed an Opposition to the Motion to Exclude. Paper 73. Respondent filed a Reply to that Opposition. Paper 75.

The Response seeks a finding that the filing of the Petition was frivolous and states that "appropriate sanctions are sought." Resp. 52. The

[5] The declaration of Robert Daniel Davis, however, is unsigned and not dated. Ex. 1092.

Response also asks to have Marc Selner named as the sole inventor on Petitioner's involved application. *Id.*

Oral hearing was held on January 9, 2023. A transcript of the oral hearing has been entered into the record.[6] Paper 90 ("Tr.").

Respondent's Motion to Exclude is *dismissed.* We determine that Petitioner has not proven, by a preponderance of the evidence, that any of Respondent's claims 24–36 was derived from Petitioner's inventor. Further, we do not find filing of the Petition to have been frivolous. Respondent's request for imposition of sanctions against Petitioner also is *dismissed.* Respondent's request to have Marc Selner named as sole inventor in Petitioner's involved application is *denied*.

II. Discussion

A. Jurisdiction and Burden of Proof

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 135(b). To prevail in an instituted derivation proceeding, a petitioner must demonstrate that "an inventor named in the earlier application derived the claimed invention from an inventor named in the petitioner's application and, without authorization, the earlier application claiming such invention was filed." 35 U.S.C. § 135(b); *see also* 37 C.F.R. § 42.405(b)(2).

Unlike the statutory provisions governing *inter partes* review and post-grant review, which specify that a petitioner must prove unpatentability of a claim by a "preponderance of the evidence," the statutory provision for

[6] The cover page of the hearing transcript incorrectly indicates that the hearing was held on January 6, 2023. Tr. 1.

derivation proceedings does not set forth an evidentiary standard for proving derivation. *See* 35 U.S.C. §§ 135, 316(e), 326(e). Our rules, however, provide that "[a] derivation proceeding is a trial subject to the procedures set forth in subpart A of this part [i.e., 37 C.F.R. §§ 42.1–42.80]," 37 C.F.R. § 42.400(a), and "[t]he default evidentiary standard [for trial proceedings] is a preponderance of the evidence," 37 C.F.R. § 42.1(d).[7] We apply that standard for purposes of this Final Written Decision. *Andersen Corp. v. GED Integrated Solutions, Inc.*, DER2017-00007, Paper 57 at 17 (PTAB March 20, 2019) (Final Written Decision).

B. Principles of Law

Although a derivation proceeding is a creation of the Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112-29, § 3(i), 125 Stat. 284 (September 16, 2011),[8] 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, the Board applies the jurisprudence which developed in that context, including the case law of the United States Court of Appeals for the Federal Circuit and the United States Court of Customs and Patent Appeals. *Andersen Corporation*,

[7] The threshold showing for institution of a derivation proceeding is "substantial evidence, including at least one affidavit addressing communication of the derived invention and lack of authorization that, if unrebutted, would support a determination of derivation." 37 C.F.R. § 42.405(c).

[8] Leahy-Smith America Invents Technical Corrections Act, Pub. L. No. 112-274, § 1(e)(1), (k)(1), 126 Stat. 2456 (Jan. 14, 2013).

DER2017-00007, Paper 57 at 14; *Catapult Innovations Pty Ltd. v. Adidas AG.*, DER2014-00002, Paper 19 at 3 (PTAB July 18, 2014) (Decision Denying Institution) ("*Catapult Innovations*").

The party asserting derivation must establish prior conception of an invention 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).

"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." *Coleman v. Dines*, 754 F.2d 353, 359 (Fed. Cir. 1985) (quoting *Field v. Knowles*, 183 F.2d 593, 601 (1950). A rule of reason applies to determining whether the inventor's testimony has been corroborated. *Price*, 988 F.2d at 1195. "The rule of reason, however, does not dispense with the requirement for some evidence of independent corroboration." *Coleman*, 754 F.2d at 360. Also, proof of conception must encompass all limitations of the invention. *See Singh v. Brake*, 222 F.3d 1362, 1367 (Fed. Cir. 2000); *Kridl v. McCormick*, 105 F.3d 1446, 1449 (Fed. Cir. 1997); *Sewall v. Walters*, 21 F.3d 411, 415 (Fed. Cir. 1994); *Coleman*, 754 F.2d at 359; *Davis v. Reddy*, 620 F.2d 885, 889 (CCPA 1980).

Likewise, communication of the conception to an inventor of the other party must be corroborated. 37 C.F.R. § 42.405(c) ("The showing of communication must be corroborated."). The purpose of the requirement of corroboration is to prevent fraud. *Berry v. Webb*, 412 F.2d 261, 267 (CCPA

1969). An inventor "must provide independent corroborating evidence in addition to his own statements and documents." *Hahn v. Wong*, 892 F.2d 1028, 1032 (Fed. Cir. 1989); *Reese v. Hurst*, 661 F.2d 1222, 1225 (CCPA 1981).

Also applicable to derivation proceedings are regulations in Subpart E of Part 42 of Title 37, Code of Federal Regulations. 37 C.F.R. §§ 42.400–412. In particular, under 37 C.F.R. § 42.405(b)(3), a petitioner has to show that each challenged claim of the respondent is the same or substantially the same as "the invention disclosed to the respondent." Under 37 C.F.R. § 42.405(a)(2), a petitioner 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."

In the context of 37 C.F.R. § 42.405(a)(2)(ii) and 37 C.F.R. § 42.405(b)(3), "the invention disclosed to the respondent" is that for which a petitioner must prove corroborated conception and communication to an inventor of respondent's application. If a petitioner chooses to rely on more than one such "invention disclosed to the respondent" for purposes of 37 C.F.R. § 42.405(b)(3), then it has to prove corroborated conception and communication for each and satisfy 37 C.F.R. § 42.405(a)(2)(ii) for each.

Assuming that corroborated conception and communication both are established by the petitioner for "the invention disclosed to the respondent" and the respondent has not proved an even earlier time of conception, and that each of the above-identified regulatory requirements are met, a petitioner would be able to regard as a derived invention those challenged

claims of the respondent which are shown by the petitioner to be the same or substantially the same as "the invention disclosed to the respondent."[9] *See* 37 C.F.R. § 42.405(b)(3).

C. The Invention Allegedly Disclosed to Respondent

The Petition specifically identifies the invention allegedly conceived by Bradley Burnam and disclosed to Marc Selner as:

> a stable suspension composition comprising an aqueous phase containing at least one ionic biocide compound dissolved in water in particular amounts, with the aqueous phase suspended as nanodroplets in a petrolatum carrier, and without the composition containing an emulsifier to stabilize the ionic biocide aqueous phase in the hydrophobic petrolatum carrier.

Pet. 5. According to Petitioner, this stated invention encompasses a method Bradley Burnam conceived and disclosed to Marc Selner, because "it was not known prior to Burnam's conception and the February 14, 2014, communication of specific method steps whether the stable suspension could be prepared at all." *Id.* at 6–7. The Petition states: "Since Burnam conceived of the first method of preparing the stable suspension, Burnam is the inventor of the stable suspension *as well as the communicated method of preparing the stable suspension*." *Id.* at 7 (emphasis added).

Because of Petitioner's above-noted representations, in the Decision to Institute we added a method alternative to the stable suspension composition as the "invention disclosed to respondent." Inst. Dec. 6–8.

[9] "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.

That means either party could prove conception by way of either the method alternative or the composition alternative. The method alternative, as identified by Petitioner (Pet. 6), is the one described in an engineering document attached to an email sent by Bradley Burnam on February 14, 2014 (Ex. 1028):

> Place the petrolatum in ingredients of 1kg in a clean stainless steel container. Heat the petrolatum until semi-solid which will appear white not clear (40-45 c). The consistency will be of an almost liquid. Stir constantly if possible once this state is achieved.
>
> 1. Add heated (50 c): 25 gm of preservative with 25gm of USP water. *Add the heated liquid slowly while mixing into the petrolatum. 50gm liquid/1kg petrolatum
>
> 2. Mix while cooling slowly until the mixture has reached a solid state. As it cools the mixture will get more solid and whiter.
>
> 3. Fill vessels with mixture immediately above solidified temperature of mixture.
>
> *The liquid is heavier than the petrolatum so it will always go to the bottom. Make sure you continue stirring all the way to the bottom until the mixture has congealed.
>
> 4. Wait 4-6 hours until sealing vessel.

Ex. 1028, 2.[10]

Petitioner also identifies an email communication (Ex. 1026), dated February 7, 2014, which generally describes a method without any specific

[10] Petitioner explains that Burnam's conceived and disclosed method differed from prior unsuccessful attempts to produce the stable suspension in at least two ways: "First, it called for heating the petrolatum to 40–45ºC prior to mixing with the aqueous phase. . . . Second, it called for heating the aqueous phase slightly hotter, to 50ºC, just before adding the aqueous phase to the petrolatum." Pet. 7.

temperature or temperature range. Pet. 5. Because Petitioner relies on the specifics of the steps in the email communication of February 14, 2014, in performing its analysis under 37 C.F.R. § 42.405(b)(3), the method described in the email communication of February 14, 2014 (Ex. 1028) serves as Petitioner's identification of the method that was conceived by Bradley Burnam and communicated to Marc Seller. Pet. 51–62. However, the email of February 7, 2014, is useful in indicating that the "preservative" mentioned in the email of February 14, 2014, is "PHMB." Exs. 1026, 1028.

Subsequent to institution of this derivation proceeding, neither party objected to the formulation in the Decision to Institute of the "invention disclosed to respondent" having two prongs in the alternative, i.e., a stable suspension composition prong and a method prong with the specific temperature ranges, as reproduced above.

D. Petitioner Having at Least One Claim Satisfying 37 C.F.R. § 42.405(a)(2)(i)

Per 37 C.F.R. § 42.405(a)(2)(i), Petitioner must have at least one claim that is "[t]he same or substantially the same as the respondent's claimed invention." Specifically, Petitioner identifies Petitioner's claim 1 and Respondent's claim 36. Pet. 46–51. In an Order dated December 17, 2021, we explained that for this determination under 37 C.F.R. § 42.405(a)(2)(i), "Petitioner need only show one claim in its application that is same or substantially the same as one claim of Respondent, and that the determination is made one-way in the direction from the Petitioner claim to the Respondent claim." Paper 18, 2–3. "Same or substantially the same" means patentably indistinct. 37 C.F.R. § 42.401.

Petitioner's claim 1 reads as follows:

> 1. A stable suspension, comprising water, greater than about 80% by weight petrolatum, and at least one ionic biocide compound, wherein the suspension contains no emulsifier, and all ionic biocide compounds present are either all cationic or all anionic, wherein the at least one ionic biocide is contained within nanodroplets having a diameter of from about 10 nm to about 10,000 nm.

Paper 17, 1.

Respondent's claim 36 reads as follows:

> 36. A non-separating, non-coalescing, non-flocculating stable suspension essentially consisting of water, petrolatum and at least one cationic biocide; and optionally mineral oil, where the at least one ionic biocide is contained within nanovescicles having a diameter of 100 microns or less.

Id. at 9.

In the Decision to Institute, we tentatively determined that a "stable suspension" is "non-separating, non-coalescing, non-flocculating." Inst. Dec. 12. Also in the Decision to Institute, we tentatively determined that a suspension "comprising water, greater than about 80% by weight petrolatum, and at least one ionic biocide" (as recited in Petitioner's claim 1) and not reciting any other component is one that is "essentially consisting of water, petrolatum and at least one cationic biocide" (as recited in Respondent's claim 36) or at least would have rendered the latter obvious. *Id.* The phrase "consistently essentially of" permits inclusion of components not listed in the claim, provided that they "do not materially affect the basic and novel properties of the invention." *PPG Indus. v. Guardian Indus. Corp.*, 156 F.3d 1351, 1354 (Fed. Cir. 1998). We explained that, although Petitioner's claim 1 uses the more open-ended phrase "comprising," it would

have been obvious to one with ordinary skill in the art to exclude the presence of materials that would materially affect the basic and novel properties of the stable suspension invention. *Id.*

Claim 1 recites that "all ionic biocide compounds present are either all cationic or all anionic." In the Decision to Institute, we tentatively determined that that recitation would have suggested the "at least one cationic biocide" of claim 36. Inst. Dec. 12. We further explained that the recitation in claim 36 of mineral oil is expressly stated as optional and thus need not be met. *Id.* The diameter of the nanodroplets of claim 1 ranges from $1x10^{-5}$ to $1x10^{-8}$ meters, which is completely within the range of the diameter of the nanovescicles of claim 36, i.e., less than $1x10^{-4}$ meters. We explained that the former anticipates the latter. *Id.* at 12–13.

Neither Petitioner nor Respondent argue against the reasoning we provided in the Decision to Institute in this regard. Respondent also does not dispute that the requirement of 37 C.F.R. § 42.405(a)(2)(i) is met by Petitioner's claims 1 and Respondent's claim 36. For the foregoing reasons, we maintain the tentative determinations made in the Decision to Institute, and find that Petitioner has met the requirement of 37 C.F.R. § 42.405(a)(2)(i) through Petitioner's claim 1 and Respondent's claim 36.

E. Petitioner Having at Least One Claim Satisfying 37 C.F.R. § 42.405(a)(2)(ii)

Per 37 C.F.R. § 42.405(a)(2)(ii), Petitioner must have at least one claim that is "[t]he same or substantially the same as the invention disclosed to the respondent." In an Order dated December 17, 2021, we explained that for this determination under 37 C.F.R. § 42.405(a)(2)(ii), "Petitioner need show only one claim of Petitioner that is the same or substantially the same

as 'the invention disclosed to the respondent,' and that is also a one-way analysis in the direction from Petitioner's claim to 'the invention disclosed to the respondent.'" Paper 18, 3. *See Catapult Innovations*, Paper 19 at 17. That means the invention disclosed to the Respondent either must be anticipated by or would have been obvious over a Petitioner claim.

Specifically, Petitioner identifies Petitioner's claim 1. Pet. 39–40. Petitioner asserts: "all the limitations of Petitioner's Claim 1 are present in Petitioner's invention disclosed to Respondent." *Id.* at 44. Corresponding explanation is provided on pages 39–44 of the Petition. *Id.* at 39–44. For this analysis, Petitioner selected the "method" articulation of the "invention disclosed to the respondent." *Id.*

In the Decision to Institute, we explained that there are two deficiencies with Petitioner's approach. Inst. Dec. 13–14. First, the analysis is in the opposite direction. Petitioner is asserting that "the invention disclosed to the respondent" anticipates Petitioner's claim 1, rather than what is required, i.e., "the invention disclosed to the respondent" either must be anticipated by or would have been obvious over a Petitioner claim. Second, it is not true that all the limitations of Petitioner's claim 1 are present in "the invention disclosed to the respondent." Petitioner's claim 1 requires as a component of the suspension "greater than about 80% by weight petrolatum." Petitioner's accounting for that element does not identify anything in the invention disclosed to the Respondent which satisfies that limitation. *See* Pet. 41.

The Decision to Institute also determined that those deficiencies are inconsequential. Inst. Dec. 14. We explained that it is manifestly evident,

without need of any explanation, that claim 1 anticipates the stable suspension composition prong of the "invention disclosed to respondent" (*see* Pet. 5):

> a stable suspension composition comprising an aqueous phase containing at least one ionic biocide compound dissolved in water in particular amounts, with the aqueous phase suspended as nanodroplets in a petrolatum carrier, and without the composition containing an emulsifier to stabilize the ionic biocide aqueous phase in the hydrophobic petrolatum carrier.

Id.

Respondent does not argue against the reasoning we provided in the Decision to Institute in that regard. Neither does Respondent dispute that the requirement of 37 C.F.R. § 42.405(a)(2)(ii) is met by Petitioner's claim 1 and the stable suspension composition prong of the "invention disclosed to respondent." For the foregoing reasons, we maintain the tentative determination made in the Decision to Institute, and find that Petitioner has met the requirement of 37 C.F.R. § 42.405(a)(2)(ii).

F. Petitioner's Showings under 37 C.F.R. § 42.405(b)(3)

Under 37 C.F.R. § 42.405(b)(3), an analysis should be performed by Petitioner of each challenged claim and the "invention disclosed to respondent," which in this case has been defined as having two alternative prongs, a stable suspension composition prong and a method prong. Depending on the challenged claim, Petitioner may rely on either prong. In a derivation proceeding, a challenged claim would be deemed a derived invention under 37 C.F.R. § 42.405(b)(3), if it is shown to be the same or substantially the same as "the invention disclosed to the respondent," provided that Petitioner has proved corroborated conception and

communication of "the invention disclosed to the respondent," and that Respondent has not proved an even earlier conception.

In this case, we need not proceed to review Petitioner's showing with respect to 37 C.F.R. § 42.405(b)(3) because, as we discuss below, Respondent has proven a time of conception that is prior to the time of conception and communication proven by Petitioner.

G. Petitioner's Alleged Conception and Communication

Petitioner relies on Exhibits 1026, 1028, 1041, 1042, and 1076 to prove conception of the invention disclosed to Respondent. Pet. 5. Exhibit 1026 purportedly is an email, dated February 7, 2014, sent by Bradley Burnam to a company "Pro-Tech," which would make the suspension according to his instructions, with Marc Selner allegedly copied on that email. *Id.* Exhibit 1028 purportedly is an email, dated February 14, 2014, and includes an attached engineering document, sent by Bradley Burnam to Pro-Tech, with Marc Selner allegedly copied on that email. *Id.* at 6. Exhibit 1041 purportedly is an email from Bradley Burnam, dated February 28, 2014, to Marc Selner to report the successful production of a stable suspension at Pro-Tech following Bradley Burnam's instructions. *Id.* Exhibit 1042 purportedly is an email from Bradley Burnam including a manufacturing outline from Pro-Tech which Bradley Burnam signed and returned to Pro-Tech via that email to confirm the correctness of the manufacturing steps carried out by Pro-Tech to make the stable suspension. *Id.* Exhibit 1076 is a declaration of Brad Meeuwsen to corroborate the emails that are Exhibits 1026, 1028, and 1042 sent by Bradley Burnam.

As we indicated previously, the engineering document in Exhibit 1028 describes a method:

> Place the petrolatum in ingredients of 1kg in a clean stainless steel container. Heat the petrolatum until semi-solid which will appear white not clear (40-45 c). The consistency will be of an almost liquid. Stir constantly if possible once this state is achieved.
>
> 1. Add heated (50 c): 25 gm of preservative with 25gm of USP water. *Add the heated liquid slowly while mixing into the petrolatum. 50gm liquid/1kg petrolatum
>
> 2. Mix while cooling slowly until the mixture has reached a solid state. As it cools the mixture will get more solid and whiter.
>
> 3. Fill vessels with mixture immediately above solidified temperature of mixture.
>
> *The liquid is heavier than the petrolatum so it will always go to the bottom. Make sure you continue stirring all the way to the bottom until the mixture has congealed.
>
> 4. Wait 4-6 hours until sealing vessel.

Ex. 1028, 2. It reads the same as the method prong of the "invention disclosed to respondent." The email of Exhibit 1026 provides context for the email of Exhibit 1028, and indicates the "preservative" referenced in Exhibit 1028 is "PHMB." Ex. 1026, 2 ("1. Heat the PHMB liquid AND the petrolatum, . . . 2. Ensure that the PHMB solution is slightly hotter than the petrolatum"). Respondent does not dispute that Exhibit 1028 meets all of the requirements of the method prong of "the invention disclosed to the respondent." We determine that it does.[11]

[11] Exhibit 1026 by itself, however, does not, because it has neither the "(50 c)" requirement for heating the aqueous phase nor the "(40-45 c)" requirement for heating the petrolatum. Ex. 1026, 1–2.

Petitioner has shown independent corroboration for the emails of Exhibits 1026, 1028, and 1042. Exhibit 1026 indicates it was sent to Marc Selner and copied to Brad Meeuwsen. Ex. 1026, 1. Exhibit 1028 indicates it was sent to Brad Meeuwsen and copied to Marc Selner. Ex. 1028, 1. Exhibit 1042 indicates it was sent to Brad Meeuwsen. Ex. 1042, 1.

Mr. Brad Meeuwsen testified that he was provided a copy of Exhibits 1019, 1021, 1023, 1025, 1026, 1028, 1029, 1030, 1042, and 1049 cited in Petitioner's "Supplemental Petition,"[12] and that he "located copies of them in Pro-Tech's own records." Ex. 1076 ¶ 2. Mr. Meeuwsen testified: "I have reviewed, and I recall sending or receiving, all ten of these Exhibits, which, pursuant to my custom and practice, I contemporaneously saved at Pro-Tech, and which Pro-Tech kept in its records in the ordinary course of business." *Id.* With respect to Exhibit 1026, Mr. Meeuwsen testified: "**Exhibit 1026** is a copy of an email dated February 7, 2014, from Burnam to Rosenthal and Selner, on which I was copied, disclosing Burnam's general 'recipe to prevent separation.'" *Id.* ¶ 2(d). With respect to Exhibit 1028, Mr. Meeuwsen testified: "**Exhibit 1028** is a copy of an email dated February 14, 2014, from Burnam to me, on which Rosenthal and Selner were copied, attaching an engineering document containing the specific recipe to try on an Engineering run with the goal of preventing separation of the gel." *Id.* ¶ 2(f).[13]

[12] The "Supplemental Petition" is Petitioner's Supplemental Brief.
[13] Exhibit 1042 is not necessary for Petitioner to show conception. Still, Mr. Meeuwsen testified: "Exhibit 1042 is a copy of an email dated April 24, 2014, from Burnam to me attaching one of Pro-Tech's Manufacturing

The above-noted testimony regarding Exhibits 1026 and 1028 constitutes adequate independent corroboration of the alleged conception by Bradley Burnam and the alleged communication to Marc Selner of the method prong of the "invention disclosed to respondent," as of the time of the email of Exhibit 1028, i.e., "February 14, 2014 4:04:17 PM EST" (4:04 PM 17 seconds, Eastern Time, February 14, 2014). Respondent does not dispute this corroborating testimony of Mr. Meeuwsen and, therefore, we credit his testimony on this particular issue.

Respondent asserts that Bradley Burnam did not even understand portions of the general method revealed in Exhibit 1026 and that Petitioner's expert, Serina Dai, equally did not understand that portion. Resp. 5. Specifically, Respondent asserts:

> Even worse, the "conception" document contains some nonsensical direction that "melting points" had to be matched. Exhibit 1026. During his deposition Burnam was unable to explain away the nonsense and admitted the defect in the directions, saying that he had to "take ownership" for the insufficiency of the alleged conception document. Burnam Deposition (Exhibit 2115 A), page 146, line 16 through page 147, line 6 [Ex. 2115, 149:18–150:3]. When asked to explain the process of reducing heat gradually to match melting points, Burnam nonsensically responded: "[y]ou know, I ended up using ambience [sic] temperatures. In my mind again at that point, you know gradually meant just shout out [sic] the heat source and it would surely do it on its own, 'gradually' encompass [sic] that, given the petrolatum heats and cools gradually." Burnam Deposition (Exhibit 2115 A), page 156, lines 4-12 [Ex. 2115, 159:8–13].

Outlines that Burnam signed—documenting the formulation and method steps Pro-Tech followed to create the antimicrobial gel." Ex. 1076 ¶ 2(i).

> Moreover, the description of the process steps in the document was unintelligible, even to Petitioner's expert Ms. Dai. Dai Deposition (Exhibit 2116), page 13, line 6 through page 18, line 8.

Id., *see also id.* at 41–43 (arguing the same). Respondent further asserts: "Mr. Burnam also stated at his deposition that Mr. Meeuwsen did not find the February 7, 2014, directions adequate and asked for more detail. Burnam Deposition (Exhibit 2115 A), Page 160, line 1, through page 160, line 13. [Ex. 2115, 165:1–13]" Resp. 6; *see also id.* at 42–43 (arguing the same).

Respondent's arguments in this regard implicate the portion of Exhibit 1026 which states "4. Reduce the heat gradually to *match melting points*." Ex. 1026, 2 (emphasis added). The language is odd because of the two components to be mixed, the water solution containing PHMB and the petrolatum, where the water solution containing PHMB already is in the liquid phase and need not be melted. When asked what melting points the language refers to, Serina Dai answered: "Yes, but the PHMB and the water are already liquid, so I think it's mostly referring to the petrolatum. It's more of a semisolid." Ex. 2116, 14:3–9. When asked how can the PHMB solution have a melting point, Ms. Dai answered "I mean, I'm not sure." *Id.* at 14:19–15:2. When asked how would she account for the second melting point, Ms. Dai answered:

> Well, yes, the PHMB liquid I don't believe has a melting point. So I'm not really sure what it's really referring to as far as melting points. Maybe it's a typo. Maybe – you know, I kind of just assumed that it was just referring to petrolatum.

Id. at 17:19–18:8.

We agree with Respondent that Bradley Burnam's description of "matching melting points" in Exhibit 1026 makes little sense, and that Bradley Burnam's testimony on cross-examination did not resolve the confusion surrounding that description. However, none of this has much to do with the "invention disclosed to respondent" which does not include any step that reduces heat to "match melting points." We decline to find that Bradley Burnam did not know the content and meaning of what is in Exhibit 1028 on the basis that a part of what he wrote in Exhibit 1026, which is not required by "the invention disclosed to the respondent," does not make sense. Bradley Burnam is not a trained engineer. Ex. 2115, 150:11–14. Nor does Bradley Burnam have a technical degree. *Id.* at 8:15–19. It should not be surprising that some of what Bradley Burnam writes on a technical subject matter may not make sense. Here, that which does not make sense is not a part of the "invention disclosed to respondent." We find the matter inconsequential on whether Bradley Burnam conceived of and communicated "the invention disclosed to the respondent." It is unreasonable to demand that Bradley Burnam's descriptions make perfect sense even as to features not required by "the invention disclosed to the respondent."

Respondent argues that, because Bradley Burnam does not have a technical education or training, and because Bradley Burnam inaccurately stated that the boiling point of water was 110°C and the boiling point of petrolatum was 100°C (Ex. 2115, 73:15–20), Bradley Burnam was unlikely an inventor. Resp. 37. Even if Bradley Burnam was unlikely an inventor, our decision must be based on underlying facts, not speculation and

probabilities. The points raised by Respondent do not refute or undermine the corroborated fact that Bradley Burnam sent by email (Ex. 1028) a description that meets "the invention disclosed to the respondent" in every way, and the evidence does not show Bradley Burnam did not comprehend the steps included in "the invention disclosed to the respondent."

Respondent also argues:

> [D]uring his deposition, Mr. Burnam reluctantly acknowledged receiving educational information relevant to the project of suspending aqueous biocide in petrolatum from Dr. Selner. Burnam Deposition (Exhibit 2115 A), Page 57, line 8 through page 61, line 6. This also included learning that vigorous mixing would not work. Burnam Deposition (Exhibit 2115 A) page 59, line 11-15.

Resp. 34. The assertion, even assumed as true, is vague. It is also inconsequential. The issue here is whether Bradley Burnam put together all the elements of "the invention disclosed to the respondent" as one collective whole, and communicated that conception to Marc Selner.

Respondent argues that it was Marc Selner who first had the idea of not heating the petrolatum above its melting point, pointing to two emails from Marc Selner to Bradley Burnam in which that idea purportedly was conveyed to Bradley Burnam. Resp. 32–33 (citing Ex. 2040). Respondent evidently equates the melting point of petrolatum to 45°C. The argument is unavailing for two reasons, even assuming that the melting point of petrolatum is 45°C.

First, the pertinent limitation in the "invention disclosed to respondent" is the range "(40-45 c)" and not simply < 45°C. Second, as we explained above, the issue here is whether Bradley Burnam put together all the elements of "the invention disclosed to the respondent" as one collective

whole, and communicated that conception of the whole to Respondent's inventor Marc Selner. The issue is not broken into as many parts as there are sub-elements in the "invention disclosed to respondent" and is not determined by whether Bradley Burnam conceived of each and every sub-element first. It is inconsequential whether Marc Selner first came up with one sub-element of the whole conception first.

Respondent notes that Burnam was still pursuing mixing the petrolatum at 60°C for weeks after January 21, 2014. Resp. 35–37 (citing Ex. 2101, Ex. 1076 ¶¶ 3(f), 3(g), 3(h), Ex. 2064). That, however, does not negate or otherwise undermine Bradley Burnam's conceiving of the "invention disclosed to respondent" on February 14, 2014, as discussed above. Respondent points to nothing that indicates Bradley Burnam still was pursuing heating the petrolatum to 60°C after February 14, 2014.

Respondent characterizes Bradley Burnam's accounting of how he arrived at the concept of taking the aqueous phase with the PHMB to a higher temperature, i.e., so that the aqueous phase and the petrolatum would arrive at room temperature at the same time (Ex. 1011 ¶ 32), as "worthy only of ridicule." Resp. 39. According to Respondent, Burnam's so-called idea is plainly incorrect because "[t]he two components would become the same temperature immediately upon the start of the mixing process with the petrolatum at 40 to 45°C because of heat transfer caused by the mixing." *Id.* Even if Respondent's reasoning is true, Respondent's making light of Bradley Burnam's idea is highly inappropriate. Further, whether Bradley Burnam's idea was correct is inconsequential. Taking the aqueous phase with the PHMB to a higher temperature than the petrolatum is an explicit

requirement of the method prong of the "invention disclosed to respondent," and Petitioner must account for it to show conception of "the invention disclosed to the respondent."

Respondent provides five reasons to question the credibility of Bradley Burnam, which we address in turn below. Resp. 38–39, 43–45. First, Respondent asserts that, because Bradley Burnam acknowledged at deposition that Marc Selner was a collaborator on the technology Bradley Burnam was working on, Bradley Burnam's representation to investors that Bradley Burnam was "the inventor" and Bradley Burnam's not recalling whether he informed a potential investor of Marc Selner's role as collaborator "casts great doubt on his credibility and forthrightness." *Id.* at 43–44. We disagree. The circumstance is not as clear as Respondent makes it out to be. A "collaborator" does not necessarily occupy the role of a co-inventor, and it is uncertain to what level one must disclose all "collaborators" to all potential investors. We decline to find Bradley Burnam not credible on the basis that he identified himself to investors as "the inventor" and said he did not remember whether he informed a potential investor of Marc Selner's role as collaborator.

Second, Respondent notes that Bradley Burnam raised substantial investment capital for Petitioner. Resp. 45 (citing Ex. 2115, 40:2–41:13). Respondent asserts that Bradley Burnam's role in that regard "would subject Mr. Burnam to pressures and stress and the magnitude of the investment should be factored into an assessment of the credibility of Mr. Burnam's testimony." *Id.* This contention is vague. Respondent does not explain adequately how the connection of Bradley Burnam raising substantial capital

investment for Petitioner amounts to "pressures and stress" to say something untruthful. Bradley Burnam is the sole inventor named on Petitioner's involved application. We decline to discredit his testimony on the basis that he raised capital investment for Petitioner.

Third, Respondent also asserts that we should discredit Bradley Burnam's testimony because he questions the authenticity of Respondent's Exhibit 2041, which, according to Respondent, was an email sent by Marc Selner to Bradley Burnam on February 14, 2014, at 12:55 PM. Resp. 44. We disagree that Bradley Burnam not authenticating Marc Selner's email, i.e., not saying that he recalls receiving it on the date and time indicated on the email, constitutes a reason to discredit Bradley Burnam's testimony. Respondent states that Bradley Burnam "could have and should have seen the subject email." *Id.* at 45. That may be true, but it also may be true that Bradley Burnam either did not receive the purported email or did not remember seeing the email. Bradley Burnam not authenticating the Exhibit 2041 email is not a sufficient basis to question his credibility as a witness.

Fourth, Respondent questions the credibility of Bradley Burnam by pointing to the statement in Bradley Burnam's declaration that it was his idea to preheat the PHMB solution to a higher temperature than the petrolatum prior to mixing. Resp. 38 (citing Ex. 1011 ¶ 34). Respondent asserts:

> However, on January 31, 2014 at 11:43 AM, ***Meeuwsen*** found an article speaking about preheating by a few degrees the aqueous phase of a lipid and water ointment prior to mixing. He suggested to ***Burnam*** preheating the aqueous phase a few degrees above the temperature of the petrolatum. Exhibit 2063

> and Meeuwsen Deposition (Exhibit 2114) page 98, line 2 through page 100, line 14.

Resp. 38 (emphases in original omitted). Respondent appears to contend that the idea of preheating the PHMB solution to a higher temperature than the petrolatum prior to mixing was Brad Meeuwsen's, not Bradley Burnam's idea, and that Bradley Burnam falsely claimed credit to it. The record does not support Respondent's assertion.

At Brad Meeuwsen's deposition, Respondent questioned him with respect to an email from Brad Meeuwsen to Bradley Burnam. Ex. 2114, 98:13–14. That email was referenced as Exhibit 5013. *Id.* The parties submitted an exhibit conversion chart which maps Exhibit 5013 to Exhibit 2013. Paper 47. The text in the body of that email is:

> Brad,
>
> I was just reading some articles on mixing Petrolatum and ointments. I *saw the statement* below and *wonder if that is what we are seeing*. The water/PHMB is cooling quicker than the Petrolatum and then separating.
>
> *When both an oil and aqueous phase are being mixed together to make an ointment, it is helpful to heat the aqueous phase a few degrees higher than the oil phase prior to mixing. The aqueous phase tends to cool faster than the oil phase and may cause premature solidification of some ingredients[.]
>
> Just a though[t]. *I am thinking we need to come up with way* to mix at lower temperatures and let it fully cool before filling. I think our new filler will allow us to fill at room temperature. We will experiment move next week.
>
> Thanks,
>
> Brad Meeuwsen

Id. (emphases added).

It is a stretch to say that, by sending the above-quoted email, Brad Meeuwsen affirmatively suggested to Bradley Burnam to include a step of preheating the aqueous phase to a few degrees higher than the oil phase prior to mixing. Rather, it is more accurate to say that Brad Meeuwsen called Bradley Burnam's attention to the content of an article and posed a question about the content's applicability to what Bradley Burnam was trying to do, for Burnam to consider further. We decline to find that Bradley Burnam falsely claimed credit to Brad Meeuwsen's idea.

Fifth, Respondent further questions Bradley Burnam's credibility as follows:

> In addition, Burnam's credibility is further at issue. His website, as of July 14, 2022 at 3:09 PM EST, in advertising one of his products AtopX, states that "[AtopX] [m]anages symptoms via addressing the root cause of eczema." Exhibit 2059, page 4. However, according to the Mayo Clinic, "[n]o cure has been found for atopic dermatitis [eczema]." Exhibit 2060, page 1. Not only does Burnam demonstrate a total lack of understanding of the field of science in which he is marketing products, but he is falsely marketing his AtopX to consumers.

Resp. 38–39. The quoted statement does not represent that AtopX is a "cure" for eczema, but merely states that it manages symptoms. Respondent has articulated no basis, based on the statement on Bradley Burnam's website, to undermine the credibility of Bradley Burnam.

For the foregoing reasons, Petitioner has proven, by a preponderance of the evidence, that its inventor, Bradley Burnam, conceived of the method prong of the "invention disclosed to the respondent" by 4:04:17 PM on February 14, 2014, and communicated that conception to Respondent's inventor, Marc Selner, at 4:04:17 PM on February 14, 2014 (the time stamp

on the email that is Exhibit 1028). Petitioner does not demonstrate communication of the full "invention disclosed to the respondent" any earlier than 4:04:17 PM on February 14, 2014.

H. Respondent's Conception

If Respondent proves conception by Marc Selner of the "invention disclosed to respondent" earlier than 4:04:17 PM, February 14, 2014, then Petitioner's conception and communication time of February 14, 2014, 4:04:17 PM, would not be sufficient to prove prior conception and communication by Bradley Burnam to Marc Selner to support Petitioner's assertion of derivation of invention by Marc Selner.

Marc Selner testifies as follows with regard to his education and background:

> I am a podiatrist, and currently practice medicine in Los Angeles. I am a graduate of the California College of Podiatric Medicine with a Doctor of Medicine and a [Bachelor of Science] in Medical Sciences. I fulfilled the entrance requirements for the California College of Podiatric Medicine by studying for three years taking premed classes at Valley College and Pierce College. I have also had experience developing and manufacturing petroleum-based antifungal preparations prior to my work developing the invention at issue in this proceeding.

Ex. 2117 ¶ 2.

1. The Two Emails of January 21, 2014 and January 22, 2014

Respondent asserts that Marc Selner's conception was "At Least as Early as January 21, [2014]." Resp. 3. Respondent asserts:

> More particularly, on January 21, 2014 [] at 11:17 PM an email from Dr. Selner (to Burnam) explicitly directs "keep[ing] the temperature [of the petrolatum] below the melting point" so that the petrolatum "retain[s] its waxy like properties," and that

> "turning it into a liquid like mineral oil would cause it to lose its suspension properties." Exhibit 2040. Exhibit 2062. The next day, on January 22, 2014 at 7:45 AM, Dr. Selner gave a further description of the inventive process: "retains its properties while melted and cooled, does not separate, never turns clear." Exhibit 2040. Burnam has admitted that Dr. Selner and Burnam "often talked about what things look like" in connection with the mixing process and that visual cues, including color, can be used for "validation." Burnam Deposition (Exhibit 2115 A), page 157, lines 8–16.

Resp. 4. The above assertions are inadequate to account for each element of the method prong of "the invention disclosed to the respondent." For example, the "invention disclosed to respondent" specifies two temperature ranges for heating, one for the aqueous phase including PHMB, and the other for the petrolatum. The aqueous phase including PHMB must be heated to 50°C, and the petrolatum must be heated to 40°C–45°C. *See supra* Section II.C. The emails as identified by Respondent above do not account for two temperature ranges for heating. Thus, even assuming that there were such emails authored by Marc Selner, Respondent has not established conception by January 21, 2014, or January 22, 2014, on the basis of those emails.

2. The Alpha Formulation

Alternatively, Respondent potentially may establish conception by the composition prong of "the invention disclosed to the respondent." A possible candidate is what Respondent refers to as an "Alpha Formulation" that Marc Selner allegedly prepared. Resp. 9. Respondent is not specific about when the Alpha Formulation was made. That, however, does not

matter, because the record does not convey that Alpha Formulation was a stable suspension composition.

Respondent states: "Stability of the early Alpha Formulation of the ointment was achieved for only a limited time before the components of the biocide started to separate." *Id.* at 10. Marc Selner testifies: "While the Alpha Formulation was an effective antimicrobial ointment, its stability was limited and it at least started to separate a little bit overnight, and sometimes separation began in just a few hours or less." Ex. 2117 ¶ 13.

Accordingly, Respondent has not shown conception of "the invention disclosed to the respondent" by reliance on the Alpha Formulation.

3. The January Batch

Respondent also refers to a composition Marc Selner allegedly made in January of 2014 (hereinafter "January batch"). Resp. 13; Ex. 2117 ¶ 17. However, there is no independent corroboration of the constitution of the January batch. Also, there is no independent corroboration that the January batch was a stable suspension. There is Marc Selner's own testimony: "After making the ointment by heating the petrolatum, but not to the point where it became clear like mineral oil, I poured it into tubes. The ointment in those tubes remained stable with the aqueous biocide in suspension for many weeks." Ex. 2117 ¶ 17. And there is Marc Selner's own email communication to Bradley Burnam, dated January 22, 2014, which states: "ok good news! Even when melting the omnicide, retains its properties while melted and cooled, does not separate, never turns clear. . . Yeah!" Ex. 2040.

Neither Marc Selner's own testimony nor the email of January 22, 2014, is backed up with independent corroboration that the January batch actually was a stable suspension composition having the composition required by the "invention disclosed to respondent." Thus, production of the January batch is inadequate to show conception by Marc Selner of "the invention disclosed to the respondent."

4. The Two Emails of February 14, 2014

Respondent identifies two emails dated February 14, 2014, both allegedly from Marc Selner to Mark Burnam. Resp. 6 (citing Exhibit 2067 and Exhibit 2041) (hereinafter "the Exhibit 2067 email" and "the Exhibit 2041 email"). The Exhibit 2067 email was time stamped "Feb 14, 2014 12:22 pm" and the Exhibit 2041 email was time stamped "Feb 14, 2014 12:55 pm." Exs. 2067, 2041. Respondent characterizes the Exhibit 2041 email as a "follow-up" email to the Exhibit 2067 email. Resp. 6. The Exhibit 2067 email contains no content but includes an attachment which is separately submitted as Exhibit 2067A. Ex. 2067 (hereinafter "the Exhibit 2067A Attachment"). In its caption, the Exhibit 2067 email includes a line that reads: "Attachments: Omnicide engineering document for gel.docx (15k)." *Id.*

The Exhibit 2067A Attachment reads as follows:

> Omnicide engineering document for gel
>
> Place the petrolatum in ingredients of 1kg in a clean stainless steel container. Heat the petrolatum until semi-solid which appear white not clear. The consistency will be of an almost liquid. Stir constantly once this state is achieved.

1. Add heated 25 gm of phmb 20% with 25 gm of distilled water. Add the heated 50gm slowly while mixing to the petrolatum. 50gm to 1kg petrolatum
2. Option – add room temperature liquid to the semi-solid petrolatum while stirring.
3. Mix while cooling until the mixture has reached a solid state. As it cools the mixture will get more solid and whiter.

Hint: the liquid is heavier than the petrolatum so it will always go to the bottom. Make sure you continue stirring all the way to the bottom until the mixture has congealed.

4. Fill the syringe with 5gm of the mixture with the plunger removed. Place the plunger back. While holding the syringe vertical, remove the air.

Hint: If the syringe builds up vacuum pressure, simply pull back on the plunger then move forwards. This will solve that problem

5. Place the cap on the syringe and cool.
6. Check for liquid at the bottom always
7. Use the same procedure for the tube. Fill the tube with the cooled mixture with 60gms of gel. Cool for hours in incubator with container opened. Seal the container and check for liquid at bottom. In the case of the tube, this will be easy, since the tube cools inverted or upside down with the cap downward. The liquid will always move to the bottom since it is [heavy], if there is separation.
8. Use test amounts first and check for separation before doing a large batch

> Hint: the petrolatum is a wax. The wax will form honeycomb like micelles around the liquid. The micelles should be microscoped. In this state they should not separate.

Ex. 2067A.

The Exhibit 2041 email, sent by Marc Selner approximately 33 minutes after the Exhibit 2067 email, reads as follows: "Oh the temperature of the mixture to be heated concerning the petrolatum is *40-45 C*. So the phmb liquid has to be heated to *50C* before mixing." Ex. 2041 (emphases added).

For purposes of comparison, the method prong of "the invention disclosed to the respondent" is reproduced below:

> Place the petrolatum in ingredients of 1kg in a clean stainless steel container. Heat the petrolatum until semi-solid which will appear white not clear (40-45 c). The consistency will be of an almost liquid. Stir constantly if possible once this state is achieved.
>
> 1. Add heated (50 c): 25 gm of preservative with 25gm of USP water. *Add the heated liquid slowly while mixing into the petrolatum. 50gm liquid/1kg petrolatum
>
> 2. Mix while cooling slowly until the mixture has reached a solid state. As it cools the mixture will get more solid and whiter.
>
> 3. Fill vessels with mixture immediately above solidified temperature of mixture.
>
> *The liquid is heavier than the petrolatum so it will always go to the bottom. Make sure you continue stirring all the way to the bottom until the mixture has congealed.
>
> 4. Wait 4-6 hours until sealing vessel.

See supra Section II.C. The method described in the Exhibit 2067A Attachment and supplemented with the specific temperature ranges provided

in the Exhibit 2041 email meets each and every element of the method prong of "the invention disclosed to the respondent." That is not disputed by Petitioner.

Rather, Petitioner argues that Respondent lacks "third-party corroboration" for Exhibits 2067, 2067A, and 2041. Reply, 1, 5. Petitioner does not admit that Bradley Burnam received the Exhibit 2067 email, including Exhibit 2067A as an attachment, and the Exhibit 2041 email. Paper 83.

As discussed above, proof of conception does require some form of independent corroboration. *Coleman*, 754 F.2d at 360. But a rule of reason applies to determining whether the inventor's testimony has been corroborated. *Price*, 988 F.2d at 1195. For the reasons discussed below, we determine that, under a rule of reason, Respondent has provided sufficient independent corroboration that Marc Selner sent the Exhibit 2067 email, the Exhibit 2067A Attachment, and the Exhibit 2041 email.[14] *See* Ex. 2117 ¶ 22.

The independent corroboration comes in the form of the declaration of Ashley Corbin, law clerk of Respondent's lead attorney, who testified that she accessed Marc Selner's email account at AOL associated with the email address lpcoll22@aol.com, located the Exhibit 2067 email, the Exhibit 2041 email, and the Exhibit 2067 Attachment, and printed them to PDF to be used

[14] The issue is not one of authentication under the Federal Rules of Evidence. Marc Selner authenticated these exhibits in his declaration as author of the Exhibit 2067 email and the Exhibit 2041 email. Ex. 2117 ¶¶ 18, 22. Petitioner has not filed a Motion to Exclude based on lack of authentication.

as exhibits in this proceeding. Ex. 2118 ¶¶ 3, 5. Ashley Corbin also testified that she "made no modification or alteration to the substance of the exhibits" and that "[t]he exhibits are all authentic." *Id.* ¶ 6. Adding to that is the fact that AOL is a well-known email service provider who stores all the emails of its account holders that are sent or received using an AOL email address.

Petitioner does not explain why it believes there is, under a rule of reason, no independent corroboration for Exhibits 2067, 2067A, and 2041. In our view, based on the testimony of Ashley Corbin and the status of AOL as a well-known email service provider, there is. In particular, we note that Ashley Corbin, an individual other than Marc Selner, testified that she accessed and printed the emails and attachment from Marc Selner's email account at AOL, not that she accessed and printed them from storage in Marc Selner's own computer.

Furthermore, there is other circumstantial evidence that reinforces the testimony of Ashley Corbin and makes the case of corroboration even stronger, although such additional evidence is unnecessary. For instance, the email Bradley Burnam sent to Brad Meeuwsen on February 14, 2014, time stamped "4:04:17 PM EST," is subsequent in time but on the same day as Marc Selner's Exhibit 2067 email and Exhibit 2041 email and includes an attachment with text that reads:

> Place the petrolatum in ingredients of 1 kg in a clean stainless steel container. Heat the petrolatum until semi-solid which will appear white not clear (40-45 c). The consistency will be of an almost liquid. Stir constantly if possible once this state is achieved.

1. Add heated (50 c): 25 gm of preservative with 25gm of USP water. *Add the heated liquid slowly while mixing into the petrolatum. 50gm liquid/1kg petrolatum
2. Mix while cooling slowly until the mixture has reached a solid state. As it cools the mixture will get more solid and whiter.
3. Fill vessels with mixture immediately above solidified temperature of mixture.

*The liquid is heavier than the petrolatum so it will always go to the bottom. Make sure you continue stirring all the way until the mixture has congealed.

4. Wait 4-6 hours until sealing vessel.

Ex. 1028, 2. The above-quoted language bears substantial resemblance to the language used by Marc Selner in the Exhibit 2067A Attachment attached to the Exhibit 2067 email. *See, e.g.*, Resp. 49 (pointing out the verbatim language "Place the petrolatum in ingredients of 1 kg in a clean stainless steel container" in both documents). Such resemblance is circumstantial evidence that Marc Selner did send the Exhibit 2067 email with the Exhibit 2067A Attachment, and the Exhibit 2041 email to Bradley Burnam.

In addition, there is Exhibit 2065, an email sent by Bradley Burnam to Marc Selner's daughter Melissa Selner, copied to Marc Selner's email address on Yahoo, and time stamped "April 24, 2014 at 08:36 PM EDT." Ex. 2065. Ashley Corbin testified that she accessed Marc Selner's email account on yahoo.com, located the email on yahoo.com, and printed it out for use as an exhibit. Ex. 2118 ¶¶ 3, 4. Petitioner does not dispute Bradley

Burnam sent the email from his email address at yahoo.com. Paper 83, 2. The content of the email reads as follows:[15]

> Hi Melissa:
> I'm a massive fan of your dad; that I can say without question. But, this magic goo he invented is something special on another level. Today we started blasting the world with samples of it and this flyer:
>
> Also attached is the following:
>
> 1. PHMB Consensus Document by UK Wound Society (amazing read)
> 2. USP <51> Antimicrobial Effectiveness Test with GLP Writeup-Kill/log reduction data in this study
> 3. NIOSH challenge for bandage filtration media-Note the pressure drop in this, indicating the breathability
> 4. The copied text from our consumer brochure detailing the competition (I pulled out the stuff relevant for personal education and left out the rest of my marketing babble)
> 5. Product flyer with SSI reduction guarantee

Ex. 2065.

The above-quoted text suggests the antimicrobial stable composition Bradley Burnam was making with collaboration from Marc Selner used methodology that originated from Marc Selner and thus constitutes circumstantial evidence that independently corroborates Exhibits 2067, 2067A, and 2041, in the absence of any adequate explanation from Petitioner about that quoted text. Petitioner's Reply does not address the content of Exhibit 2065, even though Respondent's Response presented it as

[15] There is an icon in the email for the flyer and for each attachment, but the flyer itself and the attachments themselves have not been reproduced as a part of Exhibit 2065.

purported acknowledgment of Marc Selner's Inventorship. *Compare* Reply, *with* Resp. 28.

At oral hearing, counsel for Petitioner attempted to explain the content of Exhibit 2065 by stating: "They were estranged and it was one colleague saying nice things about another colleague. It's a lot easier to praise somebody when you're trying to – he was asked to help repair a relationship and he doesn't know what 'invention' means as a layperson at this point in time."[16] Tr. 24:4–8; *see also* Ex. 2115, 190:5-191:5 (Burnam on cross-examination stating that "I don't understand the word 'invented,'" and then proceeding to discuss his personal relationship with Marc Selner). Petitioner's explanation is untimely because it was not provided in the Reply. Further, counsel provides no explanation of what Bradley Burnam thought "invent" meant that would make the email from Bradley Burnam to Marc Selner not have the meaning it facially indicates. Thus, notwithstanding this representation by Petitioner's counsel at oral hearing, Exhibit 2065 is circumstantial evidence adding to the independent corroboration of Exhibits 2067, 2067A, and 2041.

Next, Petitioner alleges that the temperature settings in Marc Selner's Exhibit 2041 email are inconsistent with the Exhibit 2067A

[16] At oral hearing, counsel for Petitioner when answering the question "Do you dispute that the magic goo that [t]he references in that email is what's disclosed in the applications at issue in this proceeding?" responded with: "We have not taken that position." Tr. 24:20–25:3. When asked the follow-up question "So, no –" to confirm the answer, counsel responded with: "Yes –" *Id.* at 25:4–5.

Attachment and that "Selner's explanation for the 'Oh, So' email [Exhibit 2041 email] is fabricated." Reply 26. Petitioner asserts:

> Selner's explanation for the "Oh, So" email [Exhibit 2041 email with the temperature ranges] is fabricated. Selner says that he does **not** believe the liquid biocide "has to be heated," *at all*, let alone to 50°C to form a stable suspension. Thus he would not have originated the "has to be heated" line or the 50°C setting for the liquid biocide in the "Oh, So" email. And he admitted to not recalling coming up with that setting.
>
> Selner also never meant 40°-45°C when he wrote "almost liquid," as Selner's engineering document [Exhibit 2067A Attachment] vaguely states. Petrolatum does not become "almost liquid" until it is heated near its melting point per its MSDS [Material Safety Data Sheet] sheet. Selner's June 3, 2015 email and February 4, 2016 non-provisional application remove any doubt as to his state-of-mind in authoring his engineering document. He disagreed with Burnam's lowest temperature/gradient thing in Burnam's February 7, 2014 email and advocated for heating petrolatum to higher temperatures.
>
> Indeed, nobody forgets to include temperature settings from an engineering document, let alone start a conversation with an email with no subject matter with the word "Oh" to correct a prior omission. Selner also had not before used "mixture" verbiage like this ("Oh the temperature of the mixture to be heated . . . is 40-45 C"); that is verbiage in Burnam's Recipe for Non-Separation ("Mix together at the lowest possible heat to allow complete mixing").
>
> The reality is Selner never measured any temperatures during his experiments and did not start for the first time when allegedly authoring this document. Rather, as Burnam testified, Selner had to have been parroting what Burnam had already told him after conducting his cooling curve experiment, which identified the temperature settings implementing his Recipe for Non-Separation—writing, "Oh" the mixture temperature is 40°-45°C, "So" the liquid "has to be heated" to 50°C.

Reply 26–28 (citations and footnotes omitted).

It is unclear what Petitioner means by "Selner's explanation for the 'Oh, So' email [Exhibit 2041 email] is fabricated." Reply 26. The explanation that matters for the Exhibit 2041 email is that Marc Selner wrote and sent that email to Bradley Burnam including the two temperatures ranges. As discussed above, Respondent has shown sufficient independent corroboration for the Exhibit 2041 email, and the two temperatures ranges are explicitly included in the email. We do not find Selner's inclusion of the two temperature ranges in the Exhibit 2041 email to be a fabrication.

We disagree with Petitioner's speculation that "Selner had to have been parroting what Burnam had already told him after [Burnam] conduct[ed] his cooling curve experiment." Reply 27. Petitioner does not specifically identify any communication from Bradley Burnam to Marc Selner, which states the temperature range 40°C–45°C for heating petrolatum or otherwise unambiguously conveys that range in some other manner.

We also disagree with Petitioner that, because Marc Selner used the word "mixture," and because he did not previously say "mixture," that indicates he copied the language from earlier communication from Bradley Burnam which used the verb "mix." Reply 27. That suggestion is highly speculative, as "mix" and "mixture" are common words in the English language. We do not think it is unusual for two people to think of using "mix" or "mixture" independently to describe adding two components in liquid form.

It is also inconsequential whether Mac Selner actually made temperature measurements of the petrolatum, because there is no requirement as to how an inventor conceives of an invention. We also decline to find that Marc Selner did not make actual temperature measurements of the petrolatum because, based on his testimony, he appears to have made actual measurements:

> I started heating the petrolatum using the same petrolatum which Burnam and Meeuwsen were using in their FDA [Food and Drug Administration] / commercial manufacturing work. I believe that the petrolatum I was using was taken from a 55 gallon drum of petrolatum purchased by Burnam, as reflected in the purchase documentation dated January 13, 2014. Exhibit 2104. The petrolatum, typical in my experience of almost all common petrolatum, began to lose its cloudy white translucent appearance a few degrees above body temperature, around 40°C. as the temperature of the petrolatum rose, continued to lose its cloudy appearance until it turned clear like mineral oil, around 45 degrees C. It was most certainly a clear liquid at 60°C.

Ex. 2117 ¶ 16.

We also disagree with Petitioner's statement that "nobody forgets to include temperature settings from an engineering document, let alone start a conversation with an email with no subject matter with the word 'Oh' to correct a prior omission." Reply 27. The assertion is extreme, and Marc Selner is not an engineer either by training or by trade. It is also uncertain what follows from Petitioner's assertion. If it is that the Exhibit 2067A Attachment is fabricated, we disagree. Respondent has shown sufficient independent corroboration for the Exhibit 2067A Attachment. Further, we find nothing out of the ordinary for a follow-up email sent shortly after a previous email, in this case approximately 33 minutes, to leave blank the

subject line and to start with "Oh" to correct an omission in the earlier email. Indeed, these facts are sufficient to indicate the second email is a follow-up communication to the first email and pertains to the same subject matter.

As for the alleged inconsistency between the Exhibit 2067A Attachment's mention of heating the petrolatum to "an almost liquid," and the Exhibit 2041 email stating the petrolatum should be heated to "40-45 C," we do not find clear inconsistency. *See* Reply 26–27. Based on various MSDS sheets (Material Safety Data Sheets (Exs. 1087–1091) originally identified as Exs. 1081–1085), Petitioner's expert, Serena Dai, who did not disagree with the MSDS sheets, testified that the melting point of petrolatum may have different ranges (e.g., 49°–60°C, 36°–60°C, 38°–80°C, and 35°–80°C). Ex. 2116, 43:13–49:21. The Exhibit 2067A Attachment stated to heat the petrolatum "until semi-solid," and stated "the consistency will be of an almost liquid." Ex. 2067A. Given that the melting point of petrolatum can vary and has a range,[17] and that the word "almost" is a subjective term, the temperature range of "40-45 C" is not necessarily inconsistent with the description in the Exhibit 2067A Attachment.

Further, Marc Selner's later urging of heating the petrolatum to higher temperatures, in Exhibits 2015 and 2016, does not negate the fact that in the Exhibit 2041 email to Bradley Burnam, he said to heat the petrolatum to "40-45 C." We find unpersuasive Petitioner's assertion that Marc Selner did not mean "40-45 C" when he wrote "40-45 C" in the Exhibit 2041 email

[17] Petitioner's expert, Serena Dai, testified that the melting point of petrolatum "can vary" and "can have a wide range." Ex. 2116, 46:1–7.

(*see* Reply 26–27), especially in light of Marc Selner's testimony in paragraph 16 of his supplemental declaration quoted above (Ex. 2117 ¶ 16).

As for Petitioner noting that Marc Selner said that he does not believe the liquid biocide "has to be heated," at all, let alone to 50°C to form a stable suspension, citing the cross-examination testimony of Marc Selner (*see* Reply 26 (citing Ex. 1107, 115:16–116:11, 440:24–25, 451:2–12)), it is true that Marc Selner said: "I told Brad [Burnam] that I thought heating the liquid hotter than the petrolatum was unnecessary." Ex. 1107, 440:24–25. It is also true that Marc Selner did not think the aqueous phase has to be heated. *Id.* at 451:2–12. There is also an email from Marc Selner to Bradley Burnam, dated January 31, 2014, in which Marc Selner stated: "I don't think heating the liquid higher will help." Ex. 2063. None of this is disputed by Respondent.

But this does not defeat Marc Selner's conception of the subject matter of "the invention disclosed to the respondent" on February 14, 2014. *See* Exs. 2041, 2067, 2067A. Bradley Burnam and Marc Selner were collaborating on creating a stable suspension; it was Bradley Burnam who was then actively engaged with Brad Meeuwsen at Pro-Tech to attempt to make the stable composition; and Bradley Burnam believed heating the aqueous phase to a higher temperature was important. Thus, it was logical and within reason for Marc Selner to propose heating the aqueous phase higher in the Exhibit 2041 email. The situation would be different if Marc Selner believed that heating the aqueous phase and heating it higher than the petrolatum would cause failure. But that is not the case here. Marc Selner merely believed that heating the aqueous phase and, in particular, heating the

aqueous phase higher than the petrolatum would not help, i.e., would not improve anything. Additionally, the "has to be heated to 50C" language in the Exhibit 2041 email, in context, does not indicate a technical necessity to obtain stable results. This was Marc Selner's instruction to Bradley Burnam for making a suspension.

As for Petitioner's assertion that Marc Selner "admitted to not recalling coming up with that setting" (Reply 26), citing "Exhibit 2015 (Burnam Dep.) at 283:6-15, 278:2-18," we checked the cited portions of the deposition testimony of Burnam (Ex. 2115 (not Ex. 2015)), and find no admission of any kind by Marc Selner. If by "that setting" Petitioner refers to the "50C" temperature for the aqueous phase, there is no admission by Marc Selner that he did not come up with it.

For the foregoing reasons, and notwithstanding Petitioner's other arguments, which we discuss below, we find that Respondent has shown conception by Marc Selner of the subject matter of "the invention disclosed to the respondent" by the time of the stamp on the Exhibit 2041 email, i.e., "Feb 14, 2014 12:55 pm."[18]

5. Petitioner's Other Arguments

Petitioner makes numerous other arguments, which we address in turn below, none of which is availing for Petitioner.

First, Petitioner asserts that Brad Meeuwsen testified that "Burnam is the true inventor." Reply 1, 8. Petitioner provides no citation to this alleged

[18] It is uncertain whether this time is Eastern Standard Time, Pacific Standard Time, or a time between the two. Nevertheless, for reaching our conclusion on whether Marc Selner's conception was prior to Bradley Burnam's conception, the outcome is the same.

testimony. There also is no indication that Brad Meeuwsen possessed or considered all of the evidence that is now before us, in particular Exhibits 2067, 2067A, and 2041. Further, inventorship is a legal question. *Univ. of Colorado Found. Inc. v. American Cyanamid Co.*, 342 F.3d 1298, 1304 (Fed. Cir. 2003). Although Brad Meeuwsen as a fact witness may testify to what he heard or received from Bradley Burnam or Marc Selner, and such testimony would be probative, any testimony from Brad Meeuwsen with regard to the ultimate conclusion of inventorship carries no weight.

Second, Petitioner incorrectly asserts that "a reduction to practice is a requisite for complete conception," and faults Marc Selner for not "ever successfully manufactur[ing] the claimed composition without using Burnam's temperature gradient." Reply 2. Conception and actual reduction to practice are different concepts, and Petitioner provides no controlling authority that requires proof of actual reduction to practice to show conception. Further, there is no dispute between the parties that the process according to the method prong of "the invention disclosed to the respondent" works in producing a stable suspension composition.

Third, Petitioner asserts that Marc Selner advocated, at various times both before and after February 14, 2014, heating the petrolatum to a temperature higher than the 40°-45°C range that Bradley Burnam disclosed and is required by the "invention disclosed to respondent." Reply 5–6. But an inventor is not restricted to having a single unchanging thought for a long period of time. That Marc Selner considered other ideas does not defeat or undermine the fact that on February 14, 2014, he proposed a specific method

to Bradley Burnam, which included heating the petrolatum to 40°-45°C and the aqueous phase including the PHMB to 50°C. Ex. 2067, 2067A, 2041.

Fourth, citing Exhibit 1024, Petitioner asserts that on January 31, 2014, Marc Selner advocated against heating the aqueous phase with the PHMB at all, regarding such heating not to be "helpful," and, citing Exhibit 2067A, Petitioner asserts that even on February 14, 2014, Marc Selner regarded heating the aqueous phase with the PHMB to be optional. Reply 7. The argument is misplaced, because (1) optional inclusion still is a proposal to include, and (2) we find nothing in Exhibit 2067A where, supposedly, Marc Selner stated that heating the aqueous phase with the PHMB is "optional." Further, in the follow-up email on February 14, 2014 (Ex. 2041), sent within 33 minutes of the Exhibit 2067 email, Marc Selner stated: "Oh the temperature of the mixture to be heated concerning the petrolatum is 40-45C. *So* the phmb liquid *has to be heated to 50C before mixing*." Ex. 2041 (emphasis added). There is nothing in this language that would suggest that heating the phmb liquid is optional. Rather, Marc Selner said "the phmb liquid *has to be heated to 50C before mixing*." *Id.*

In any event, there is nothing inconsistent or awry about Marc Selner proposing to include a component that he might have deemed to have no effect on enhancing the stability of the suspension composition, so long as the entire process described by him through the Exhibit 2067 email, the Exhibit 2067 Attachment, and the Exhibit 2041 email is effective in creating a stable suspension composition, which is the case here.

Fifth, Petitioner argues:

> Selner has admitted that prior to filing a patent application, he had **not** reduced his alleged methodology to practice and did not

> know whether just heating the petrolatum below 60°C would work. In fact, he admitted that his disclosed more preferred range for the petrolatum was a "mistake." And Selner's August 14, 2020 declaration filed in response to an office action attests to him being unable to make a stable composition by simply heating the petrolatum to 45°C. Exhibit 1069 (¶¶ 7c-8). He declared that just heating petrolatum above 43.8°C "does" not work to form a stable suspension. *Id.* Thus, *as of his filing date*, Selner had plainly not reduced to practice his alleged prior conception, having disclosed an **inoperative** preferred temperature range for the petrolatum (45°-50°C) in his application.

Reply 7–8 (footnotes omitted). The argument is misplaced. We already discussed above that actual reduction to practice is not necessary to show conception. Also, Petitioner is focusing on the wrong conception. At issue is conception of that subject matter which is presented by Petitioner as "the invention disclosed to the respondent," not any other conception. Also as discussed above, there is no dispute that the method prong of "the invention disclosed to the respondent" is operative to produce a stable suspension composition.

Petitioner argues that, "[d]uring cross-examination, Selner admitted that he contributed nothing to Burnam's Recipe for Non-Separation, which included the below four novel points that comprise *the Disclosed Invention*, which are reiterated in Selner's patent applications and encompassed within his claims 24 and 36." Reply 9–12 (citing Ex. 1107, 430:10–18) (emphasis added). We have read the deposition transcript from page 427, line 18, to page 430, line 18 to ascertain the proper context. Ex. 1107, 427:18–430:18. Petitioner's assertion is misplaced and unavailing.

The reference to "the Disclosed invention" is not "the invention disclosed to the respondent" discussed above, but the content of Exhibit 1026, which we determined above in Section II.G does not disclose either the "(50 c)" requirement for heating the aqueous phase or the "(40-45 c)" requirement for heating the petrolatum. The cited testimony of Marc Selner indicates only that the bullet points in Bradley Burnam's email that is Exhibit 1026, which do not include specific temperatures, and which include "Reducing heat gradually to match melting points," were "not relying on what [Marc Selner] said." Ex. 1107, 430:10–18. The testimony clearly is not an admission by Marc Selner that Bradly Burnam conceived of "the invention disclosed to the respondent" without relying on anything from Marc Selner, as Petitioner suggests.

On pages 19–24 of its Reply, Petitioner provides an outline or summary of the events which occurred, as seen from Petitioner's perspective, from January 20, 2014, to January 31, 2014. Reply 19–24. We have reviewed that summary and do not find that the events as described by Petitioner undermine Respondent's conception of subject matter of "the invention disclosed to the respondent" as established through the Exhibit 2067 email, the Exhibit 2067 Attachment, and the Exhibit 2041 email.

For instance, Petitioner asserts that Marc Selner at deposition represented that Bradley Burnam in a telephone call, and in a follow-up email to the telephone call, thanked Marc Selner for providing "a great interim solution." Reply 23. But it is unclear whom Bradley Burnam was thanking and for what "interim solution." The conference call included Brad Meeuwsen and Pro-Tech's President, according to Petitioner (Reply 2),

which is not disputed by Respondent. We do not find that Bradley Burnam thanked Marc Selner for "an interim solution" to anything, and no such purported "thank you" from Bradley Burnam forms any part of our conclusion that Respondent has shown conception by Marc Selner of the subject matter of "the invention disclosed to the respondent" by Feb 14, 2014, 12:55 pm.

On pages 24–25 of the Reply, and also on pages 31–32, Petitioner again asserts that Respondent has not provided certified proof of stability, asserts that Respondent's theory of why stability results from the formation and suspension of biocide nanodroplets in petrolatum's lattice is faulty, and asserts that "Selner has produced no data, no scientific literature, and no expert to support his 'lattice' speculation." Reply 24–25, 31–32. The argument is misplaced, because Petitioner appears to be addressing Respondent's proposals (1) to heat petrolatum to much higher temperatures than 40°C-45°C, and (2) to not heat the aqueous phase. What is at issue is stability of a suspension composition produced by the method prong of "the invention disclosed to the respondent" for which Respondent presents proof of conception by Marc Selner that is earlier than the showing of conception and communication by Bradley Burnam. Petitioner does not dispute that the method prong of "the invention disclosed to the respondent" results in a stable suspension composition. Stability of a suspension composition produced by a different method is irrelevant to whether Respondent conceived the subject matter of "the invention disclosed to the respondent."

Petitioner argues that, during cross-examination, Marc Selner "took the Fifth Amendment four times." Reply 32–33. Petitioner does not explain

how or why this fact deprived Petitioner of a meaningful cross-examination. Petitioner does not even assert that it was deprived of a meaningful opportunity to cross-examine Marc Selner. Simply noting that Marc Selner "took the Fifth Amendment four times" is unavailing for Petitioner.[19]

Petitioner argues that "Selner has testified to three 'mistakes' in filing his patent applications." Reply 28. The first is making heating the aqueous phase a requirement, which is a mistake that Marc Selner allegedly fixed years later by amendment to make heating the aqueous phase optional. *Id.* The second is initially naming Bradley Burnam as a co-inventor on Marc Selner's provisional application.[20] *Id.* The third, according to Petitioner, is Marc Selner's referring, in his non-provisional application, to the petrolatum being heated to where it is half-melted at 45 to 50° C. *Id.* at 28–29. Petitioner does not explain how or why these alleged mistakes, assuming that they are mistakes, negate or defeat Marc Selner's conception of "the invention disclosed to the respondent" as discussed above. We are not persuaded that they do.

Finally, Petitioner asserts that Marc Selner "Admits to [Making] False Statements in His August 14, 2020 Declaration Submitted to the USPTO [to] Obtain an Allowance." Reply 29. Petitioner asserts that Marc Selner submitted a declaration to the Office, dated August 14, 2020, in which Marc Selner stated that not heating the petrolatum to above 43.8°C was critical,

[19] It appears those answers were given when Marc Selner was asked about Happ Medical Inc., which supposedly listed Marc Selner on its website as Chief Medical Officer. Reply 33.

[20] Bradley Burnam was subsequently taken off as a co-inventor on Marc Selner's provisional application. Tr. 68:1–3.

and that, two years later, Marc Selner testifies that heating petrolatum to 45°C does work, but only if there is enough lattice, which is not always the case. *Id.* at 29–30.[21] We do not read the subsequent explanation as an admission to making a false statement. The earlier declaration indicated that adding the aqueous phase to petrolatum that was heated to 43.8°C "does not work." Ex. 1069 ¶¶ 7–8. We find the subsequent testimony not to be necessarily contradictory. In any event, Petitioner does not explain the relevance of this alleged false statement to whether Marc Selner conceived of "the invention disclosed to the respondent" on February 14, 2014. In this proceeding, neither party disputes that the method prong of "the invention disclosed to the respondent" works to produce a stable suspension composition.

Petitioner asserts that in the August 14, 2020, declaration, Marc Selner said he asked Brad Meeuwsen to heat the petrolatum to 40°C, but then testified on cross-examination in this proceeding that he did not actually ask Brad Meeuwsen to heat the petrolatum to 40°C as he had declared, and that he meant he communicated through Burnam to heat the petrolatum to 40°C. Reply 29–30. The statement in the August 14, 2020, declaration is inaccurate, but we do not find that Marc Selner in his cross-examination testimony admitted to making a false statement to the Examiner. It is plausible that Marc Selner thought Bradley Burnam would relay the information to Brad Meeuwsen, who was engaged by Bradley Burnam to

[21] Petitioner inadvertently cites to the August 14, 2020, declaration of Marc Selner as Exhibit 1107 when, in fact, the relevant declaration is Exhibit 1069.

make the composition. Also, although Respondent does not prove that Marc Selner specifically mentioned 40°C to Bradley Burnam, that does not necessarily mean Marc Selner did not. None of this negates or defeats Marc Selner's conception of "the invention disclosed to the respondent" on February 14, 2014. In this proceeding, neither party disputes that the method prong of "the invention disclosed to the respondent" works to produce a stable suspension composition.

Lastly, Petitioner asserts: "Selner also falsely testified to achieving a 'permanent suspension' of liquid biocide in a 'shelf stable' petrolatum drug without using Burnam's temperature gradient after doing a test in response to an office action. But he did not [have] enough time (3 months accelerated aging) to determine 'permanent' or 'shelf stable' stability." Reply 30–31. Petitioner provides no citation to this alleged false testimony and we find no such testimony in Marc Selner's August 14, 2020 declaration (Ex. 1069). Further, the assertion, even if true, does not amount to any admission by Marc Selner that he made a false statement. In any event, the assertion would not negate or defeat Marc Selner's conception of "the invention disclosed to the respondent" on February 14, 2014. In this proceeding, neither party disputes that the method prong of "the invention disclosed to the respondent" works to produce a stable suspension composition.

I. Conclusion

As explained above, Petitioner's proven time of conception and communication of the subject matter of "the invention disclosed to the respondent" is "February 14, 2014 4:04:17 PM EST." Respondent's proven time of conception of the subject matter of "the invention disclosed to the

respondent" is "Feb 14, 2014 12:55 pm." If Respondent's time is Eastern Standard Time, then Respondent's conception precedes Petitioner's conception and communication by 3 hours and 9 minutes. If Respondent's time is Pacific Standard Time, it precedes Petitioner's conception and communication by 9 minutes.

Accordingly, Petitioner has not shown that Bradley Burnam conceived of "the invention disclosed to the respondent" prior to Marc Selner's conception of that same subject matter, and Petitioner has not shown that Bradley Burnam communicated "the invention disclosed to the respondent" to Marc Selner prior to Marc Selner's conception of the same subject matter.

As a result, Petitioner has not proven, by a preponderance of the evidence, that any one of claims 24–36 of Respondent's Application 15/549,111 is derived from Bradley Burnam.

J. Respondent's Motion to Exclude

Respondent has filed a Motion to Exclude. Paper 69. Petitioner opposes. Paper 73. Respondent filed a Reply to Petitioner's Opposition. Paper 75. Respondent seeks to exclude Exhibits 1092, 1094, 1095, 1097, 1098, 1103, 1107, and 1109. Paper 69, 1.

We need not decide Respondent's Motion to Exclude because, even considering all of the evidence Respondent seeks to exclude, Petitioner still does not prevail. Further, Respondent's reasons for excluding Exhibit 1107 do not address admissibility, but rather implicate the proper weight to give to Marc Selner's cross-examination testimony. *See, e.g, Corning Inc. v. DSM IP Assets B.V.*, IPR2013-00053, Paper 66 at 19 (PTAB May 1, 2014) (Final

Written Decision) ("[T]he Board, sitting as a non-jury tribunal . . . is well-positioned to determine and assign appropriate weight to the evidence presented."). Accordingly, Respondent's Motion to Exclude is *dismissed* as moot.

III. ORDER

It is

ORDERED that, pursuant to 35 U.S.C. § 135(b), Petitioner has failed to prove, by a preponderance of the evidence, that any one of claims 24–36 of Respondent's U.S. Patent Application No. 15/549,111 is derived from Petitioner's inventor;[22]

FURTHER ORDERED that Respondent's request for imposition of sanctions against Petitioner is *dismissed*;[23]

[22] No other application of Respondent is involved in this proceeding.
[23] The request for imposition of sanctions is a motion and Respondent did not obtain the required prior authorization for filing the motion. *See* 37 C.F.R. § 42.20(b). We also do not find that the filing of the Petition by Petitioner to have been frivolous, as alleged by Respondent. Resp. 52.

FURTHER ORDERED that Respondent's request to have Marc Selner named as sole inventor on Petitioner's U.S. Patent Application No. 15/672,197 is *denied*;[24]

FURTHER ORDERED that jurisdiction over Petitioner's involved application and Respondent's involved application is herein returned to the appropriate officials under the Commissioner for Patents;

FURTHER ORDERED that a copy of this Decision be placed in the files of Petitioner's involved application and Respondent's involved application; and

FURTHER ORDERED, because this is a final written decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

[24] Respondent merely states that Petitioner's involved application "should have its inventorship changed to indicate Dr. Selner as the sole inventor," but includes no substantive argument as to why such relief is appropriate under the circumstances. *See* Resp. 52. "In appropriate circumstances, the Patent Trial and Appeal Board may correct the naming of the inventor in any application or patent at issue." 35 U.S.C. § 135(b). The circumstance here is not appropriate, because (1) our analysis above in determining whether Respondent's claims are derived from Bradley Burnam does not support naming Marc Selner as the sole inventor in Petitioner's involved application, and (2) Respondent has its own application with Marc Selner named as the sole inventor and with an earlier effective filing date than Petitioner's involved application.

DER2017-00031
Petitioner Application 15/672,197
Respondent Application 15/549,111

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