

GLOBAL HEALTH SOLUTIONS LLC v. MARC SELNER, Appeal No. 2023-2009 (Fed. Cir. August 26, 2025). Before Stoll, Stark, and Goldberg. Appealed from PTAB.

Background:

Selner filed an application (“111 Application”), which names Selner as its sole inventor, four days before Global Health Solutions (“GHS”) filed an application (“197 Application”), which names Burnam as its sole inventor. Both applications, along with the applications to which they respectively claim priority, are subject to the America Invents Act (“AIA”) and claim the same method for preparing a wound treatment ointment without requiring emulsifiers. GHS petitioned to institute a derivation, alleging that Selner derived the claims of the ‘111 Application from Burnam. The Board instituted an AIA derivation proceeding, finding that GHS failed to prove its derivation claim and determining that Selner proved earlier conception than Burnham. GHS appealed the Board’s decision to the Federal Circuit.

Issues/Holdings:

Did the Board err by not requiring Selner to corroborate his claim of inventorship with evidence independent of himself? No, affirmed. Did the Board err by shifting the burden to GHS to disprove Selner’s alleged conception. No, affirmed. Did the Board err by not applying the doctrine of simultaneous conception and reduction to practice in order to prove complete conception of the invention? No, affirmed. Did the Board err by not addressing GHS’ alternative request that Burnam be named a joint inventor? No, forfeited.

Discussion:

As this case marks the court’s first review of an AIA derivation proceeding litigated in the PTAB, the Federal Circuit first states that the required elements of a derivation claim have not changed *other than* to the extent necessary to reflect a first-to-file system. It was further noted that, under the AIA, a petitioner must produce evidence sufficient to show (i) conception of the claimed invention and (ii) communication of the conceived invention to the respondent prior to the filing of the respondent’s application. A respondent can overcome the petitioner’s showing by proving independent conception prior to receipt of the relevant communication from the petitioner. Thus, although the Federal Circuit found that the Board erred in focusing on whether Burnam or Selner was the first-to-invent, this error was determined to be harmless.

Next, the Federal Circuit considered each of the grounds on which GHS requested reversal of the Board’s judgement. With respect to requiring Selner to corroborate his claim of inventorship with evidence independent of himself, the Federal Circuit found that the Board had substantial evidence for corroborating Selner’s testimony, including time-stamped emails supporting Selner’s invention story. The Federal Circuit also found that, contrary to GHS’ assertion, the Board properly held each party to its burden of proof and did not require GHS to prove that Selner did not conceive the invention. Further, the Board did not find that actual reduction to practice was required for complete conception of the invention. Thus, the Federal Circuit found that the Board did not irreversibly err in determining that Selner’s earlier conception of the invention was independent and complete.

Finally, the Federal Circuit found that the Board did not err by not expressly addressing GHS’ alternative request that Burnam be named a joint inventor in the ‘111 application. GHS failed to comply with the requirement to file a separate motion for such a request, merely requesting correction of inventorship in a single sentence in its Petition.