

# Federal Circuit Clarifies Standards for AIA Derivation Proceedings

September 25, 2025

The Federal Circuit recently issued its first precedential decision interpreting the America Invents Act's ("AIA") derivation proceeding mechanism. In *Global Health Solutions LLC v. Selner*, No. 23-2009 (Fed. Cir. Aug. 26, 2025), the panel affirmed the Patent Trial and Appeal Board's ("PTAB") ruling in favor of the first filer, holding that the petitioner failed to show derivation.<sup>1</sup> The decision clarifies the statutory framework for derivation under 35 U.S.C. § 135, explains what petitioners must prove, and addresses evidentiary standards including corroboration and the role of reduction to practice.

**Background.** Derivation is a limited safeguard in the AIA's first-inventor-to-file system. A petitioner may challenge an earlier-filed patent application by showing that the earlier filer "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). The petitioner must prove conception and communication of the invention before the respondent's filing date. A respondent may defeat the claim by showing independent conception. Unlike validity or priority disputes, derivation proceedings focus solely on whether the first filer misappropriated another's invention rather than developed it independently.

If you have any questions concerning this memorandum, please reach out to your regular firm contact or to the Cleary authors below.

## WASHINGTON

**David J. Hlavka**  
+1 202 974 1796  
[dhlavka@cgsh.com](mailto:dhlavka@cgsh.com)

**Bert C. Reiser**  
+1 202 974 1962  
[breiser@cgsh.com](mailto:breiser@cgsh.com)

## BAY AREA

**Thomas W. Yeh**  
+1 415 796 4350  
[tyeh@cgsh.com](mailto:tyeh@cgsh.com)

**S. Giri Pathmanaban**  
+1 650 815 4140  
[gpathmanaban@cgsh.com](mailto:gpathmanaban@cgsh.com)

**Greg Sobolski**  
+1 415 796 4390  
[gsobolski@cgsh.com](mailto:gsobolski@cgsh.com)

## NEW YORK

**Clement Naples**  
+1 212 225 2516  
[cnaples@cgsh.com](mailto:cnaples@cgsh.com)

<sup>1</sup> *Global Health Solutions LLC v. Selner*, No. 23-2009 (Fed. Cir. Aug. 26, 2025).

[clearygottlieb.com](http://clearygottlieb.com)



© Cleary Gottlieb Steen & Hamilton LLP, 2025. All rights reserved.

This memorandum was prepared as a service to clients and other friends of Cleary Gottlieb to report on recent developments that may be of interest to them. The information in it is therefore general, and should not be considered or relied on as legal advice. Throughout this memorandum, "Cleary Gottlieb" and the "firm" refer to Cleary Gottlieb Steen & Hamilton LLP and its affiliated entities in certain jurisdictions, and the term "offices" includes offices of those affiliated entities.

# I. *Global Health Solutions LLC v. Selner.*

The dispute in this case arose from competing patent applications filed just days apart in August 2017. Marc Selner filed one application naming himself as the sole inventor, while Global Health Solutions LLC (“GHS”) filed another application naming the company’s founder, Bradley Burnam, as the sole inventor. Both applications claimed methods for producing an emulsifier-free wound treatment ointment with nanodroplets of polyhexamethylene biguanide suspended in petrolatum.<sup>2</sup> GHS petitioned the PTAB to institute a derivation proceeding, alleging that Selner “derived the claims of his [application] from Burnam.”<sup>3</sup> The PTAB instituted a derivation proceeding, finding that the claims of Selner’s application were “[t]he same or substantially the same as . . . the respondent’s claimed invention” and “‘[t]he same or substantially the same as . . . the invention disclosed to the respondent’ by GHS’ inventor, Burnam.”<sup>4</sup> Thus, the Board found it “undisputed that both Applications claim” the same invention.<sup>5</sup>

After weighing the record, including contemporaneous emails exchanged between Burnam and Selner, the Board concluded that Burnam “conceived the Invention and communicated it to Selner via email . . . on February 14, 2014.”<sup>6</sup> But the Board also determined that the evidence showed Selner “had already conceived of the Invention earlier that same day.”<sup>7</sup> The Board therefore held that GHS failed to demonstrate that Selner “derived the Invention from Burnam.”<sup>8</sup> On appeal, GHS argued

that Selner’s testimony lacked independent corroboration, that the Board improperly shifted the burden of proof, and that complete conception in this case required showing actual reduction to practice.<sup>9</sup>

The Federal Circuit found that the PTAB applied the wrong legal framework. The panel observed that “[n]either the parties nor the Board appears to have appreciated the difference in the derivation standard governing AIA derivation proceedings as compared to pre-AIA interferences.”<sup>10</sup> By focusing on whether Burnam or Selner was “the first-to-invent,” the Board applied an interference-style standard that is “no longer dispositive in an AIA derivation proceeding.”<sup>11</sup> The panel clarified that “to prevail in [an AIA derivation] proceeding, a first-to-file respondent like Selner need only prove that his conception was *independent*.”<sup>12</sup> Although the Board’s analysis was framed in terms of priority, the error was harmless because “in finding Selner was the *first*-to-invent, the Board also indirectly determined that he *independently* conceived and, thus, did not derive his invention from Burnam.”<sup>13</sup>

The panel also addressed corroboration of Selner’s testimony. Applying the “rule of reason,” the court held that the PTAB did not abuse its discretion in relying on emails from Selner’s AOL account that were authenticated by his attorney’s law clerk.<sup>14</sup> The panel explained that “documentary or physical evidence that is made contemporaneously with the inventive process provides the most reliable proof

<sup>2</sup> *Global Health Solutions LLC v. Selner*, No. 23-2009, slip op. at 3-4 (Fed. Cir. Aug. 26, 2025).

<sup>3</sup> *Id.* at 4.

<sup>4</sup> *Id.* at 5.

<sup>5</sup> *Id.*

<sup>6</sup> *Id.* at 6.

<sup>7</sup> *Id.*

<sup>8</sup> *Id.*

<sup>9</sup> *Id.* at 12.

<sup>10</sup> *Id.* at 11-12.

<sup>11</sup> *Id.*

<sup>12</sup> *Id.* at 12 (emphasis in original).

<sup>13</sup> *Id.*

<sup>14</sup> *Id.* at 13-15 (quoting *Sandt Tech., Ltd. v. Resco Metal & Plastics Corp.*, 264 F.3d 1344, 1350 (Fed. Cir. 2001)).

that the inventor's testimony has been corroborated."<sup>15</sup>

The panel further rejected GHS's argument that the Board improperly shifted the burden of proof. GHS asserted that the Board effectively required it to disprove Selner's conception, rather than requiring Selner to prove it. The panel disagreed, emphasizing that "the Board properly held each party to its burden of proof."<sup>16</sup> The panel emphasized that at no point did the Board "require GHS to prove that Selner did not conceive the Invention."<sup>17</sup>

The panel also rejected GHS's argument that Selner could not establish conception without showing actual reduction to practice. GHS argued that because the invention involved creating a stable nanodroplet suspension, conception could not be complete until the invention was successfully reduced to practice.<sup>18</sup> The panel disagreed, emphasizing that "actual reduction to practice was not required for complete conception of the Invention."<sup>19</sup> Instead, conception occurs when the inventor has "a definite and permanent idea of the complete and operative invention."<sup>20</sup> The panel explained that the PTAB had correctly found conception based on Selner's detailed February 14, 2014 email describing the invention.<sup>21</sup>

Finally, the panel rejected GHS's alternative request to add Burnam as a joint inventor. The panel noted that GHS included only "a single sentence" requesting joint inventorship in its petition and never raised the issue again.<sup>22</sup> Because PTAB rules require such relief to be sought in a separate motion with supporting

reasoning, the court held that "any error the Board may have committed in not expressly addressing an undeveloped request for alternative relief, buried in a petition and never referenced again, is attributable to GHS's own failings and is harmless."<sup>23</sup>

**II. Key Implications.** The Federal Circuit's decision establishes that AIA derivation proceedings are not contests of priority. The panel rejected the PTAB's reliance on interference precedent and clarified that the dispositive question is whether the first filer conceived independently or instead derived the invention from another. Although the Board's analysis was framed in terms of who was "first to invent," the court deemed the error harmless because Selner's showing of earlier conception necessarily demonstrated independent conception.

The opinion also clarifies evidentiary and substantive standards for derivation proceedings. The panel endorsed the use of contemporaneous emails and metadata as sufficient corroboration under the "rule of reason" and held that actual reduction to practice is not required to prove conception, even for technically complex inventions. An inventor who can describe the invention with a "definite and permanent idea" has satisfied the conception requirement, without the need for experimental proof.

Finally, the decision underscores the procedural rigor required at the PTAB. GHS forfeited its request to add Burnam as a joint inventor by raising it only in a conclusory sentence rather than in a separate motion, as the rules require. Together, these holdings confirm that derivation will remain

<sup>15</sup> *Id.*

<sup>16</sup> *Id.* at 15-16.

<sup>17</sup> *Id.*

<sup>18</sup> *Id.* at 16-17.

<sup>19</sup> *Id.*

<sup>20</sup> *Id.* (quoting *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1206 (Fed. Cir. 1991)).

<sup>21</sup> *Id.*

<sup>22</sup> *Id.* at 17-18.

<sup>23</sup> *Id.*

a narrow and demanding remedy: petitioners must present strong, contemporaneous evidence of both conception and communication, while respondents can defeat such claims by proving independent conception with well-documented records.

...

CLEARY GOTTLIB