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District Court Denies Plaintiff's Summary Judgment Motion on Improper Inventorship Defense, But Grants Plaintiff's Motion on Derivation Defense

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Cellular Communications Equipment LLC v. HTC Corp., involves several patents, one of which names a single inventor, Mr. Benoist Sebire. Before the November 2007 filing date, Mr. Sebire, along with other members of a working group, participated in conference relating to 3G technology. At the conference, materials were distributed to attendees, including a proposal by Ericsson. After the conference, but still before the filing date, an attendee circulated a summary of the working group's discussions to Mr. Sebire and other attendees. The meeting and materials became the bases for HTC's defenses of improper inventorship and derivation with regard to the Sebire patent. HTC did not, however, identify the alleged correct inventor(s). Plaintiff moved for summary judgment on both the improper inventorship defense as well as the derivation defense.

The court first addressed the improper inventorship defense. Pre-AIA 35 U.S.C. § 102(f) provides that "[a] person shall be entitled to a patent unless . . . he did not himself invent the subject matter sought to be patented." To prove invalidity for improper inventorship, one must show clear and convincing proof that the patent names "more or fewer than the true inventors." *Gemstar-TV Guide Int'l, Inc. v. Int'l Trade Comm'n*, 383 F.3d 1352, 1381-82 (Fed. Cir. 2004). Cellular Communications urged that the law required the defendant to identify the purportedly true inventor(s) to support its defense. The court, however, rejected this argument, noting that Cellular Communications "failed to cite case law that explicitly requires the identification of a putative inventor to establish a genuine issue of material fact with respect to improper inventorship." After resolving this legal issue, the court considered the evidence. According to the court, two pieces of evidence–the email summary, and expert

testimony regarding the summary's contents–established an issue of fact with regard to inventorship. As a result, summary judgment was denied on this issue.

With respect to derivation, however, the court granted the plaintiff's motion for summary judgment. Like improper inventorship, a derivation defense is rooted in pre-AIA 35 U.S.C. § 102(f). *Cumberland Pharm. v. Mylan Inst.*, 846 F. 3d 1213, 1217-18 (Fed. Cir. 2014). To establish this defense, one must demonstrate "both prior conception of the invention by another and communication of that conception to the patentee" by clear and convincing evidence. *Eaton Corp. v. Rockwell Int'l Corp.*, 323 F.3d 1332, 1334 (Fed. Cir. 2003). In turn, to show conception, one must show "formation *in the mind of the inventor* of a definite and permanent idea of the complete and operative invention." *Singh v. Brake*, 317 F.2d 1334, 1340 (Fed. Cir. 2003) (emphasis added). To support its derivation defense, HTC pointed to a slide deck and the Ericsson proposals coupled with the working group's discussions. With respect to the slide deck, the court agreed with Cellular Communications that the deck merely disclosed "one step out of many that [were] claimed" in the Sebire patent. Accordingly, this was insufficient to establish conception. With respect to the Ericsson proposals and the group's discussions, the court concluded that this evidence failed to show that "*another inventor* conceived a definite and permanent idea of the . . . invention." Accordingly, the court granted summary judgment in favor of Cellular Communications on the issue of derivation.

Cellular Communications Equipment LLC v. HTC Corp., Civil No. 6-16-cv-475-KNM (E.D. Tex. July 5, 2018) (Mitchell, MJ)

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District Court | Eastern District of Texas

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