IN THE UNITED STATES DISTRICT COURT

FOR THE WESTERN DISTRICT OF WISCONSIN

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ILLUMINA, INC.,

Plaintiff,

ORDER

09-cv-277-bbc
09-cv-665-bbc

v.

AFFYMETRIX, INC.,

Defendant.

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Plaintiff Illumina, Inc. has filed a motion for reconsideration of the November 24, 2010 order in which I concluded that a hearing was needed to determine whether the court should employ 35 U.S.C. § 256 to correct two patents plaintiff owns, U.S. Patent Nos. 7,510,841 and 7,612,020, by adding Gregory Kirk as an inventor. Plaintiff raises two arguments against holding a hearing: (1) the court cannot correct the patents "unless there are no genuine issues of material fact in dispute," Plt.'s Br., dkt. #167, at 1; and (2) defendant does not have standing to ask for a correction. Because I conclude that factual disputes regarding the motion for correction are intertwined with defendant Affymetrix's invalidity defense under 35 U.S.C. § 102(f), I will grant plaintiff's motion.

I disagree with plaintiff's second contention. As I concluded in the November 24 order, defendant has standing to request a correction because it is Kirk's assignee and has an economic interest in adding Kirk as an inventor. Plaintiff does not cite any authority requiring a different conclusion.

With respect to the first issue, plaintiff cites DDB Technologies, LLC v. MLB Advanced Media, L.P., 517 F.3d 1284, 1291 (Fed. Cir. 2008), and Torres-Negrón v. J & N Records, LLC, 504 F.3d 151, 163 (1st Cir. 2007), for the proposition that "[w]here, as here, the jurisdictional issues are intertwined with the merits of the lawsuit, the Court cannot decide the jurisdictional motion to dismiss unless there are no factual issues in dispute." Plt.'s Br., dkt. #167, at 2. This argument misstates the issue slightly because the purpose of the hearing is not to determine whether the court has jurisdiction, but whether the patent should be corrected under § 256. Although a correction could affect plaintiff's standing (because the newly named inventor or its assignee might refuse to join the suit), that determination would be made *after* the hearing.

Ultimately, however, this is not a relevant difference. Like standing, correction of a patent under § 256 is generally decided by the court, not the jury. 35 U.S.C. § 256 ("[T]he court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly."). However, the Court of Appeals for the Federal Circuit has held that a court

cannot decide a motion under § 256 if it requires resolution of facts in common with a claim or defense that would be tried by the jury. Shum v. Intel Corp., 499 F.3d 1272, 1277 (Fed Cir. 2007). In concluding that a § 256 hearing should be held, I overlooked Shum.

In this case, defendant has raised an invalidity defense under 35 U.S.C. § 102(f). Defendant does not deny that any disputed facts regarding that defense must be resolved by a jury and that the defense overlaps with the request for a correction because § 102(f) requires a determination of inventorship. Pannu v. Iolab Corp., 155 F.3d 1344, 1349 (Fed. Cir. 1998) ("[I]f nonjoinder of an actual inventor is proved by clear and convincing evidence, a patent is rendered invalid.").

Defendant cites Ethicon, Inc. v. U.S. Surgical Corp., 921 F. Supp. 901 (D. Conn. 1995), for the proposition that "[t]he existence of an invalidity defense based on inventorship does not require correction of inventorship under 35 U.S.C. § 256 to be decided by a jury." This case is not really helpful, however, because the defendant in Ethicon was not raising an invalidity defense under § 102(f). Rather, the court emphasized that it could determine inventorship because only equitable claims were at issue. Id. at 902-05.

Defendant's primary argument against plaintiff's motion for reconsideration is that "the undisputed facts establish that Dr. Kirk is an inventor" of the patents at issue. Dft.'s Br., dkt. # 214, at 1. It is wrong about what the undisputed facts establish. As I stated in the November 24 order, the email defendant relies on is ambiguous about where the ideas

in the email came from. That is enough to create a genuine dispute regarding Kirk's status as an inventor.

Accordingly, I will grant plaintiff's motion for reconsideration, deny defendant's motion to dismiss and cancel the hearing scheduled for December 15, 2010. Because I concluded in the November 24 order that plaintiff retains standing to sue until a correction has been made, this leaves the court free to consider the parties' motions for summary judgment on the merits. If those motions do not resolve the case, the issue of inventorship will be resolved at trial.

ORDER

IT IS ORDERED that

1. Plaintiff Illumina, Inc's motion for reconsideration, dkt. #210, is GRANTED.

2. Defendant Affymetrix, Inc.'s motion to dismiss for lack of jurisdiction, dkt. #122, is DENIED.

3. The hearing set for December 15, 2010 is CANCELED. Defendant is directed to

give notice of the cancellation to all parties listed in its notice of hearing. Dkt. #213.

Entered this 3d day of December, 2010.

BY THE COURT:

/s/
BARBARA B. CRABB
District Judge