

No. _____

In the Supreme Court of the United States

MUSSA ALI,

Petitioner,

v.

CARNEGIE INSTITUTION OF WASHINGTON,
UNIVERSITY OF MASSACHUSETTS,

Respondents.

*On Petition for Writ of Certiorari to the
United States Court of Appeals for the Federal Circuit*

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. In *Florida Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank*, 527 U.S. 627, 640 (1999), this Court struck down the Patent Remedy Act which held States liable for patent infringement and did so noting that “Congress identified no pattern of...constitutional violations” to show such legislation is warranted to force waiver of a state’s Eleventh Amendment sovereign immunity. In the Federal Circuit case of *Xechem Int’l, Inc. v. Univ. of Tex. M.D. Anderson Cancer Ctr.*, 382 F.3d 1324, 1335 (Fed. Cir. 2004), *cert. denied* 543 U.S. 1149, 125 S. Ct. 1314 (2005), that court held that states have sovereign immunity to inventorship corrective suit under 35 U.S.C. § 256, but Judge Newman noted in additional views that the States’ increasing use of sovereign immunity was creating “an increasing urgency, as the states enter the private competitive arena governed by the laws of intellectual property, to establish fair relationships and just recourse.” In this action, the Federal Circuit affirmed the dismissal of a suit under 35 U.S.C. § 256 by an omitted inventor to correct inventorship on patents jointly owned by the state-entity University of Massachusetts and the private Carnegie Institution of Washington, with sovereign immunity for UMass barring joinder for the inventor to maintain the action against Carnegie. Both the lower District of Columbia District Court and Federal Circuit noted that the current law does not provide the omitted inventor with the possibility of “complete relief” due to UMass’ sovereign immunity, providing the Petitioner no recourse. At what point do patent-owning States waive their sovereign immunity when they voluntarily participate in the patent system?

2. The limited monopoly an inventor gains with the issuance of a patent is a right in equity without a monetary equivalent. By holding that States and their private patent co-owners are immune to inventor-corrective suit under § 256, an omitted inventor has no way to obtain the equitable right to which he is entitled, and no state can provide the federal rights of a patent to the wronged inventor as compensatory damages for an unlawful taking. If Eleventh Amendment sovereign immunity is extended to allow patent-owning states to escape suits under § 256, how is this not a taking from wrongfully omitted inventors and a violation of due process of law under the Fourteenth Amendment?

3. Carnegie is a private entity and does not have Eleventh Amendment sovereign immunity. If a State is allowed to essentially extend its sovereign immunity privilege to a private entity who co-owns a patent, how is this not a State granting a privileged status to select citizens and violative of the equal protection clause of the Fourteenth Amendment?

4. The Constitution states at Art. 1, Sec. 8, that, "The Congress shall have Power...To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." 35 U.S.C. § 256 embodies this power of Congress and was specifically enacted to provide a judicial mechanism to correct inventorship in patents. Can Eleventh Amendment sovereign immunity subjugate Congress' express power under Art. 1, Sec. 8?

**PARTIES TO THE PROCEEDING
AND RULE 29.6 STATEMENT**

Petitioner, Mussa Ali, who was Plaintiff-Appellant below, is an individual.

Respondents, who were Defendants/Appellees below, are: Carnegie Institution of Washington, and the University of Massachusetts.

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PETITION FOR A WRIT OF CERTIORARI

Petitioner Mussa Ali respectfully submits this petition for a writ of certiorari.

OPINIONS BELOW

The opinion of the Court of Appeals for the Federal Circuit (App. 1-21) is not yet reported in the Federal Reporter, but is available at 2017 WL 1349280. The denial of the petition for rehearing *en banc* of that opinion is not yet reported (App. 140-141). The order dismissing the district court action for failing to join a necessary party by the District Court in the District of Columbia (App.60-88) is published at 309 F.R.D. 77 (D.D.C. 2015). The opinion of the District Court for the District of Oregon dismissing the University of Massachusetts as immune from suit (App. 89-120) is published at 976 F. Supp. 2d 1367 (D.Or. 2013).

JURISDICTION

The Court of Appeals for the Federal Circuit entered its original judgment on April 12, 2017 (App. 1-21), and denied a petition for rehearing *en banc* on July 20, 2017 (App. 140-141). This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

This case involves the interpretation of U.S. Constitution, Art. 1, Sec. 8 (App. 142), the Eleventh Amendment (App. 144), the Fourteenth Amendment (App. 144), and 35 U.S.C. § 256 (App. 146).

STATEMENT OF THE CASE

1. The Petitioner is an immigrant to the United States from Ethiopia and was a graduate student in the late 1990s at the University of Massachusetts (“UMass”) working in the laboratory of Dr. Craig C. Mello. (App. 3). The work in the lab involved methods of gene-specific inhibition through the use of double-stranded ribonucleic acid, a technology that has become generally known as “mRNA inhibition.”

2. The technology developed in Dr. Mello’s lab ultimately led to the inventions of U.S. Patent Nos. 6,506,559, 7,538,095, 7,560,438, 7,622,633, and 8,283,329 (the “UMass Patents”). These inventions also led to Dr. Mello being awarded the Nobel Prize in Medicine in 2006, along with Dr. Andrew Fire of the Carnegie Institution of Washington (“Carnegie”). The UMass patents are jointly owned by UMass and Carnegie. (App. 3).

3. The Petitioner made a critical contribution to the claimed inventions of the UMass patents while he was employed in Dr. Mello’s laboratory, and attempted on many occasions to have the Respondents add him as a co-inventor. (App. 3). If Petitioner were named as a co-inventor, he would become a joint owner of the UMass patents and possess the equitable rights bestowed by them.

4. The Petitioner filed a complaint against Carnegie in the District of Oregon, which was later amended to join UMass as a co-defendant, which sought, *inter alia*, to have the Oregon court name

Petitioner as a co-inventor to the UMass patents under 35 U.S.C. § 256. (App. 3).¹

5. UMass then moved, *inter alia*, for dismissal of the case against it under Fed. R. Civ. P. (12)(b)(1), arguing that the Oregon court lacked subject matter jurisdiction because UMass has sovereign immunity as an “arm” of Massachusetts under the Eleventh Amendment. (App. 4).

6. The Oregon court concluded that the Eleventh Amendment provided UMass sovereign immunity from suit under § 256 and dismissed it from the case. The Oregon court ultimately, *sua sponte*, transferred the remaining case against Carnegie to Washington, D.C. (App. 5).

7. The District of Columbia court dismissed the transferred action against Carnegie because UMass was a required party under Fed. R. Civ. P. 19(a) to correct inventorship of the patents and could not be joined due to its sovereign immunity. (App. 5-11).

8. On appeal of the dismissal from the District of Columbia Court, a Federal Circuit panel unanimously affirmed the lower court’s holding that UMass is entitled to sovereign immunity from suit under § 256, and did not waive this immunity here.

¹ While he had initial counsel in the Oregon action, Petitioner Ali has appeared *pro se* throughout most of the district court and all of the appellate proceedings in this action. Ali does not have any formal legal training or qualifications. In federal court, *pro se* pleadings receive liberal construction. See *Haines v. Kerner*, 404 U.S. 519, 520–21, 92 S. Ct. 594, 30 L. Ed. 2d 652 (1972); *Pouncil v. Tilton*, 704 F.3d 568 (9th Cir. 2012).

The Federal Circuit also affirmed dismissal of the remaining case against Carnegie for failure to join a necessary party (App. 13).²

9. In a separate concurrence, Judge Dyk of the Federal Circuit expressed concern and stated that “a state law remedy is not available [to correct inventorship], and a claimant’s only remedy lies in a federal cause of action under 35 U.S.C. § 256 to correct inventorship.” (App. 20). With respect to dismissal of the § 256 action, Judge Dyk further noted that “[u]nder these circumstances, it seems to me particularly harsh to hold that the federal action—in which the relief sought is directed to the Director of the Patent Office—cannot proceed without the state entity as a party.” (App. 16-19) .

10. The Federal Circuit’s judgment is now final with the denial of the petition for rehearing *en banc*. (App. 140-141).

Accordingly, Petitioner now seeks certiorari and challenges the Federal Circuit’s holding.

²The Federal Circuit notes that many of Petitioner’s arguments on appeal were “confusing,” see, e.g. fn. 6, App. 13, which is certainly due to the *pro se* appearance. Although perhaps without the greatest clarity, all of the arguments and issues raised in this Petition were made by Petitioner before the district courts and Federal Circuit in the initial appeal brief and the Petition for Rehearing *en banc* and were preserved for appeal to this Court.

REASONS FOR GRANTING THE PETITION

The sole and main issue before the Court boils down to one question: to what extent do patent-owning states waive sovereign immunity when they voluntarily participate in the United States' patent system by owning and enforcing patents. Currently, the case law says a State merely owning a patent causes no waiver whatsoever. But, absent from the previous jurisprudence on this issue before this Court and the Federal Circuit, there is now a raft of evidence of States actively participating in the marketplace with their patents and abusing their right of sovereign immunity by tactically wielding it against private citizens.

The Petitioner does not dispute that States are entitled to immunity under the Eleventh Amendment and that immunity can apply to certain aspects of patent litigation generally. However, the Petitioner asserts that, at the barest minimum, when a State owns a patent, either jointly or solely, the State must waive immunity from suit to correct the inventorship of that patent. Any interpretation extending Eleventh Amendment sovereign immunity to the contrary clearly violates an omitted inventor's constitutional rights and eviscerates the power expressly delegated to Congress under Art. 1, Sec. 8, which is manifest in § 256.

I. The public’s interest is to stop States from abusing sovereign immunity in the “private competitive arena governed by the laws of intellectual property.”

When this Court addressed whether a State’s Eleventh Amendment immunity may be abrogated in the federal patent law context in 1998 in the *Florida Prepaid* case, it had little to no evidence of the participation of States in the patent arena, as a litigant or otherwise. See *Florida Prepaid*, 527 U.S. at 640 (Congress “identified no pattern of patent infringement by the States, let alone a pattern of constitutional violations, to support abrogation of a State’s Eleventh Amendment immunity.”) Things have changed dramatically since then. In the 20 years since *Florida Prepaid*, States have greatly and actively increased their participation in the private competitive arena with their patents, suing for patent infringement and demanding royalties from private entities, which is amply demonstrated in the case law shown below. And, as feared by Judge Newman in *Xechem Int’l, Inc.*, 382 F.3d at 1335, the States have now entered the private competitive arena governed by the laws of intellectual property and leveraged their sovereign immunity to establish unfair relationships and no recourse for omitted inventors.

States, typically through their university arms like UMass here, have brought numerous patent infringement suits over the last two decades against private entities. Here is merely a sampling: *Regents of Univ. of Minnesota v. AT & T Mobility LLC*, 135 F. Supp. 3d 1000, 1003 (D. Minn. 2015); *Bd. of Trustees of Univ. of Illinois v. Micron Tech., Inc.*, No. 2:11-CV-

2288-SLD-JEH, 2017 WL 1164483 (C.D. Ill. Mar. 28, 2017); *Univ. of Pittsburgh of Commonwealth Sys. of Higher Educ. v. Varian Med. Sys., Inc.*, 561 F. App'x 934, 935 (Fed. Cir. 2014); *Univ. of Colorado Found., Inc. v. Am. Cyanamid Co.*, 196 F.3d 1366 (Fed. Cir. 1999); *Bd. of Regents of Univ. of Nebraska v. Siemens Healthcare Diagnostics, Inc.*, No. 4:09CV3075, 2010 WL 5254944, at *1 (D. Neb. Dec. 15, 2010); *Regents of Univ. of Cal. v. Micro Therapeutics, Inc.*, 507 F. Supp. 2d 1074 (N.D. Cal. 2007); *Wisconsin Alumni Research Found. v. Intel Corp.*, 656 F. Supp. 2d 898, 901 (W.D. Wis. 2009); *Research Found. of State Univ. of New York v. Mylan Pharm. Inc.*, 531 F. App'x 1008, 1010 (Fed. Cir. 2013).

States also clearly use their sovereign immunity to avoid patent-related lawsuits and proceedings as a litigation tactic. See, e.g., *Pennington Seed, Inc. v. Produce Exch. No. 299*, 457 F.3d 1334, 1344 (Fed. Cir. 2006) (finding that Pennington's patent infringement and conversion claims against the University and University officials were barred by the Eleventh Amendment); *Tegic Commc'ns Corp. v. Bd. of Regents of Univ. of Texas Sys.*, 458 F.3d 1335, 1339 (Fed. Cir. 2006) (holding that the University was immune from suit in federal courts pursuant to the Eleventh Amendment and had not waived its immunity as to Tegic's declaratory judgment action); *A123 Sys., Inc. v. Hydro-Quebec*, 626 F.3d 1213, 1222 (Fed. Cir. 2010) (holding that the University of Texas System was not only a necessary party but also an indispensable party, making dismissal appropriate); *Xechem Int'l, Inc.*, 382 F.3d 1324 (Affirming dismissal of § 256 action against University of Texas based upon sovereign immunity).

Ironically, States themselves utilize § 256 to correct inventorship to patents they seek to own. See *Regents of the University of California v. Chen, et al.*, 2017 WL 3215356 at *3 (N.D. Ca. July 26, 2017) (“ The University’s first claim for relief is for correction of inventorship under 35 U.S.C. § 256.”). Thus, the current case law allows States to file actions under § 256 to attack the property rights of private entities, yet allows those same States to use sovereign immunity to prevent private entities from doing the same thing to the States’ patents. See *Xechem Int’l, Inc.*, 382 F.3d 1324; *Ali*, App. 1-21). How is this logical or fair?

The most recent example of States abusing sovereign immunity in the patent arena has occurred in the quasi-judicial post grant reviews at the USPTO. There, States have been able to have entire *inter partes* reviews (IPRs) dismissed, as well as themselves dismissed as parties thereto. See, e.g., *Covidien LP v. University of Florida Research Foundation Inc.*, Case Nos. IPR 2016-01274; -01275, and -01276, Paper No. 21 (PTAB January 25, 2017) (Florida successfully had three inter partes reviews dismissed based upon sovereign immunity); *Neochord, Inc. v. University of Maryland, Baltimore*, IPR2016-00208, Paper No. 28 (PTAB May 23, 2017) (Maryland had *inter partes* review dismissed and terminated based upon Eleventh Amendment sovereign immunity); *Reactive Surfaces Ltd., LLP v. Toyota Motor Corp.*, IPR2016-01919, Paper No. 36 (PTAB July 13, 2017) (Regents of University of Minnesota were successfully dismissed from *inter partes* review as immune, and IPR was maintained against Toyota).

The case law demonstrates that States have repeatedly and extensively abused Eleventh Amendment sovereign immunity to gain litigation advantages against private entities in the patent arena and deprive private citizens of their patent rights. It is indisputably in the public's interest that the Court curtail this abuse. Accordingly, Petitioner requests that certiorari be granted to clarify the extent to which patent-owning States waive sovereign immunity.

II. At a minimum, States waive Eleventh Amendment sovereign immunity to inventor-corrective suit under § 256 when they voluntarily own a patent.

Here, it is undisputed that UMass voluntarily obtained the patents-in-suit along with Carnegie and enjoys the benefits and exclusivity conferred by the patents, including the royalty fees from licensing. A State does not *have* to own any patent if it so chooses; there is no requirement in the Bayh-Dole Act or elsewhere that a State must own a patent. If a State then voluntarily enters the patent arena to enjoy all of the benefits conferred from patent ownership, how has it not consented to the rules regarding patent ownership and waived its sovereign immunity?

The Court “has long recognized” that a State’s Eleventh Amendment immunity may be waived. *College Savings Bank*, 527 U.S. at 675, 119 S. Ct. 2219. Waiver is generally found either when the State makes a “clear declaration” that it intends to waive immunity, such as by statute, see *Port Auth. Trans-Hudson Corp. v. Feeney*, 495 U.S. 299, 110 S. Ct. 1868, 109 L. Ed. 2d 264 (1990) (immunity with respect to suits against the Port of New York Authority waived by statute), or

when the state voluntarily invokes federal jurisdiction, see *Gunter v. Atlantic Coast Line R.R. Co.*, 200 U.S. 273, 26 S. Ct. 252, 50 L.Ed. 477 (1906) (State waiving immunity by voluntarily becoming a party to a suit). *Xechem Int'l, Inc.*, 382 F.3d at 1329.

The Court has confirmed the principle that “where a State voluntarily becomes a party to a cause and submits its rights for judicial determination, it will be bound thereby and cannot escape the result of its own voluntary act by invoking the prohibitions of the Eleventh Amendment.” *Gunter*, 200 U.S. at 284, 26 S. Ct. 252; see also *Clark v. Barnard*, 108 U.S. 436, 447, 2 S. Ct. 878, 27 L.Ed. 780 (1883) (noting that immunity from suit is a “privilege” that is waived when a state voluntarily submits to the jurisdiction of a federal court); *Gardner v. New Jersey*, 329 U.S. 565, 574, 67 S. Ct. 467, 91 L.Ed. 504 (1947) (holding that the state waives any immunity regarding the adjudication of a claim voluntarily filed in federal court).

This Court has also recognized that “[l]egislation which deters or remedies constitutional violations can fall within the sweep of Congress’ enforcement power even if in the process it prohibits conduct which is not itself unconstitutional and intrudes into ‘legislative spheres of autonomy previously reserved to the States.’” *Florida Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. at 638, citing *City of Boerne v. Flores*, 521 U.S. 507, 518 (1997). § 256 does not expressly exempt State-owned patents from its text, nor speak to issues of States’ sovereign immunity.

Here, UMass waived sovereign immunity with respect to inventorship correction under § 256 when it obtained the patents in suit. In *College Savings*, this

Court recognized a fundamental difference between a State engaging in ordinary business activity as opposed to voluntarily accepting a federal gratuity, such as a patent. See *College Savings*, 527 U.S. at 686-87, 119 S. Ct. 2219 (citing *Petty v. Tennessee-Missouri Bridge Commission*, 359 U.S. 275, 79 S. Ct. 785, 3 L. Ed. 2d 804 (1959) (noting that a state's waiver as a condition for Congressional approval of an interstate compact is a valid waiver as Congressional approval of a compact is a gratuity); *South Dakota v. Dole*, 483 U.S. 203, 107 S. Ct. 2793, 97 L. Ed. 2d 171 (1987).

In *Florida Prepaid*, this Court noted that the State of Florida was conducting “ordinary business activities” when it was sued for patent infringement. *Florida Prepaid*, 527 U.S. at 631, 119 S. Ct. at 2203. Conversely, here, UMass’ acquiring and owning a patent is substantially different from conducting ordinary business activities. See, e.g., *New Star Laser, Inc. v. Regents of the University of California*, 63 F. Supp. 2d 1240, 1243 (E.D. Cal. 1999). A patent “constitutes a unique form of nationally recognized intellectual property, created by Congress pursuant to its authority under the Patent Clause” (citing U.S. Const. Art. I, Sec. 8), and can only be obtained through the federal Patent and Trademark Office where the patent owner receives an “ironclad monopoly for a limited number of years” in exchange for disclosure of the art. *Id.* (citations omitted). The patent applicant *must* also agree to disclose the true inventors, among other things. 35 U.S.C. § 1 et seq. Thus, acquiring a patent is more than “ordinary commercial activity,” it is a “gift or gratuity” bestowed by the federal government that UMass has intentionally accepted. *Id.*

The logical dichotomy of allowing States to obtain, possess, and enforce patents, and then to allow them to selectively claim sovereign immunity to escape the laws regarding patents is plainly obvious—and unfair results follow. This has been noted by this Court:

“It would seem anomalous or inconsistent for a State both (1) to invoke federal jurisdiction, thereby contending that the ‘Judicial power of the United States’ extends to the case at hand, and (2) to claim Eleventh Amendment immunity, thereby denying that the ‘Judicial power of the United States’ extends to the case at hand. And a Constitution that permitted states to follow their litigation interests by freely asserting both claims in the same case could generate seriously unfair results.” *Lapides v. Board of Regents of the University System of Georgia, et al.*, 535 U.S. 613; 619 (2002).

This has also been noted with respect to patents by the Federal Circuit:

“[S]eriously unfair’ results could obtain if a state were permitted to file suit in federal court seeking to enforce a right to ownership of patents arising from certain contractual agreements and conduct and, at the same time, to claim immunity from liability for royalties or other compensation arising from those same contracts and conduct.” *The Regents of the University of New Mexico v. Knight*, 321 F.3d 1111, 1124 (Fed. Cir. 2003).

Both of these holdings predict exactly what has happened in this case, as noted by Judge Dyk, results that are “particularly harsh hold[ing] that the federal

action—in which the relief sought is directed to the Director of the Patent Office—cannot proceed without the state entity as a party.” (App. 20-21). This is manifestly unfair to the Petitioner and leaves him without any recourse or relief. Here, “the plaintiff has a right, but is absolutely without a remedy--a condition which the law abhors, as nature does a vacuum.” *Reilly v. Reilly*, 14 Mo. App. 62, 65 (1883). Constitutionality mandates that patent-owning States waive sovereign immunity to inventor-corrective suits.

III. Allowing States to avoid suits to correct inventorship is a taking that deprives omitted inventors their due process rights.

As noted by this Court, “patents shall have the attributes of personal property,” § 261, including “the right to exclude others from making, using, offering for sale, or selling the invention,” § 154(a)(1).” *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 392 (2006). The limited monopoly given to an inventor with the issuance of a patent is a right in equity without a monetary equivalent, with the power to exclude others from practicing the invention. *Id.* at 391 (to obtain an injunction, “[a] plaintiff must demonstrate...(2) that remedies available at law, such as monetary damages, are inadequate to compensate for that injury.”). By holding that States and their private patent co-owners are immune to inventor-corrective suit under § 256, the Federal Circuit has left an omitted inventor with no way to obtain the equitable right to which he is entitled, and no State can provide the federal rights of a patent to the wronged inventor as compensatory damages for an unlawful taking.

An inventor has a property interest in a patent grant that provides her with exclusive rights in her invention in exchange for the disclosure of the invention to the public. Only the named inventors in the patent grant enjoy this limited monopoly. When an inventor is wrongfully omitted, the only method she has to correct inventorship is through a federal cause of action under 35 U.S.C. § 256. But with the Federal Circuit expansion of the scope of sovereign immunity to allow States to avoid challenges from omitted inventors from the patent grant, those inventors have no other avenue to share in the exclusive patent rights. As a result, these omitted inventors cannot perfect their property interest in the patent and are deprived of due process in violation of the Fourteenth Amendment.

When the subject matter of the action in question is the conduct of individual States, the Due Process Clause at issue is the Due Process Clause of the Fourteenth Amendment. See *Coll. Sav. Bank v. Florida Prepaid Postsecondary Educ. Expense Bd.*, 148 F.3d 1343, 1348 (Fed. Cir. 1998), *rev'd*, 527 U.S. 627, 119 S. Ct. 2199, 144 L. Ed. 2d 575 (1999) (“The Fourteenth Amendment is a clear limitation on the authority of the states.”) In *Florida Prepaid*, this Court held that the Eleventh Amendment immunity may be abrogated and the Fourteenth Amendment invoked “only where the State provides no remedy, or only inadequate remedies, to injured patent owners for its infringement of their patent could a deprivation of property without due process result.” *Florida Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. at 643 (citing *Parratt v. Taylor*, 451 U.S. 527, 539–541, 101 S. Ct. 1908, 68 L. Ed. 2d 420 (1981); *Hudson v. Palmer*, 468 U.S. 517, 532–533, 104 S. Ct. 3194, 82 L. Ed. 2d 393 (1984); *id.*, at 539, 104

S. Ct. 3194 (O’CONNOR, J., concurring) (“[I]n challenging a property deprivation, the claimant must either avail himself of the remedies guaranteed by state law or prove that the available remedies are inadequate.... When adequate remedies are provided and followed, no ... deprivation of property without due process can result”).

In the context of patent inventorship claims, a state law remedy is not available. A claimant’s only remedy lies in a federal cause of action under 35 U.S.C. § 256 to correct inventorship. See *Ali* (Circuit Judge Dyk’s concurrence)(App. 20). Federal law “ousts” state courts of jurisdiction over inventorship claims. The statute provides that “[n]o State court shall have jurisdiction over any claim for relief arising under any Act of Congress relating to patents.” 28 U.S.C. § 1338(a). This statute prescribes exclusive jurisdiction in the federal courts. *See id.*

The Federal Circuit in *Xechem* and this Court in *Florida Prepaid* and *College Savings* did not fully explore whether state courts could provide a remedy to an omitted inventor of a patent. If the courts did fully explore this issue, the answer is that state courts plainly cannot. How can a state court issue a federal injunction against patent infringement?

The invocation of sovereign immunity here by UMass leaves Petitioner with no redress in either state or federal courts for his lost equitable rights under his inventorship claim to the UMass patents, and this fact is undisputed. Eleventh Amendment sovereign immunity cannot be construed in a manner to deprive an inventor of due process. It is incumbent upon this Court to address the lack of remedy and due process

that omitted inventors face when they cannot be added to a patent that is fully or jointly owned by a State.

IV. Allowing States to extend their sovereign immunity to non-state patent co-owners violates equal protection of the laws.

The District of Columbia court dismissed the transferred action against Carnegie because UMass was a required party under Fed. R. Civ. P. 19(a) to correct inventorship of the patents and could not be joined due to its sovereign immunity. (App. 60-88). The Federal Circuit panel unanimously affirmed this dismissal (App. 1-21). Thus, UMass has given Carnegie the benefit of sovereign immunity from suit under § 256.

“The equal protection clause of the Fourteenth amendment is applicable whenever the state chooses to act. Thus, whenever a state chooses to waive its sovereign immunity, it must do so in a manner that does not irrationally discriminate between classes of its citizens.” *Greyhound Food Mgmt., Inc. v. City of Dayton*, 653 F. Supp. 1207, 1215 (S.D. Ohio 1986), *aff’d and remanded*, 852 F.2d 866 (6th Cir. 1988). Here, Carnegie is a private entity and does not have Eleventh Amendment sovereign immunity with respect to the patents it owns. If a State, such as Massachusetts, is allowed to essentially extend its sovereign immunity privilege to a private entity who co-owns a patent, this is plainly discriminating between classes of its citizens.

The Petitioner is “entitled to equal protection of the laws at all times.” See *United States v. Avery*, 137 F.3d 343, 355 (6th Cir. 1997). “[I]f a state chooses to confer [a] right...to its citizens, it is ‘obligated to do so in a

manner consistent with the Constitution.’” *Molinari v. Bloomberg*, 564 F.3d 587, 597 (2d Cir. 2009)(citation omitted). Massachusetts cannot confer a benefit on Carnegie by extending its sovereign immunity to protect Carnegie’s jointly owned patent from inventor corrective suit. The holding of the Federal Circuit to allow this condones a violation of the equal protection of the law and must be overturned.

V. Extending Eleventh Amendment sovereign immunity to inventorship-corrective actions under § 256 undermines Congress’ express power under Art. 1, Sec. 8.

The Federal Circuit held that UMass did not waive sovereign immunity here with respect to § 256. (App. 1-21). That court cursorily reviewed this issue with respect to potential waiver of immunity under the Baye-Dole Act, 35 U.S.C. §§ 200–12 (App. 13-15). The Federal Circuit did not address, however, what specific impact granting a State sovereign immunity here would have on Congress’ power and duty to insure inventors’ ability to secure rights to their discoveries, as expressly delegated in Art. 1, Sec. 8.

The Constitution states at Art. 1, Sec. 8, that “The Congress shall have Power...To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” The USPTO’s ability to secure these rights to the respective inventors comes from 35 U.S.C. § 256, which allows correction of a patent’s inventorship through an action in federal district court. See *Ethicon, Inc. v. U.S. Surgical Corp.*, 135 F.3d 1456 (Fed. Cir. 1998) (adding co-inventor pursuant to a § 256 motion).

“The Constitution creates a Federal Government of enumerated powers. See Art. I, § 8.” *United States v. Lopez*, 514 U.S. 549, 552 (1995). It is indisputable that Congress has the power to secure rights to inventors, and § 256 embodies that power. Moreover, § 256 itself is a “necessary and proper” exercise of the power conferred upon the Congress by Art. 1, Sec. 8, an “appropriate” means, and “plainly adapted” to the end prescribed in the preamble, “promot[ing] Progress of Science and useful Arts.” See *McCulloch v. Maryland*, 17 U.S. (4 Wheat.) 316, 421, 4 L.Ed. 579 (1819). There is no question as to the propriety of either the Congressional power to enact § 256 or with the text of that statute, and none have argued to the contrary here.

Rather than a conflict existing with the § 256 statute itself or the language of Art. 1, Sec. 8, the constitutional conflict arises when a State is an “owner” of a patent, standing in the shoes of the inventor, who originally owns the patent, either solely or jointly with other inventors. The framers of the Constitution clearly did not envision States owning patents. Although, Congress certainly did when it enacted the Baye-Dole act. In fact, with respect to the present issue, a question could be raised as to whether Congress had the power to authorize States to own patents in the first instance.

However, assuming that Congress could properly authorize States to be patent owners, Congress did not comment on the implications that sovereign immunity might have with respect to the other enumerated “end” prescribed in Art. 1, Sec. 8—securing rights to inventors. This creates a clear conflict with Eleventh

Amendment sovereign immunity and undermines the express power and purpose of Art. 1, Sec. 8.

In cases involving conflicts between clauses of the Constitution, there is no clear guidance on which clause ought to be reined in in view of the other. This Court is often the arbiter of which provision takes precedence. And this Court has been willing to constrain or promote congressional power under one clause in the name of restrictions imposed elsewhere in the Constitution. See, e.g. *Nixon v. Administrator of General Services*, 433 U.S. 425 (1977); *New York v. United States*, 505 U.S. 144 (1992).

In resolving a constitutional conflict this Court has noted in *dicta* that it is very hesitant to view a Constitutional clause that has an express limitation in a manner to vitiate that limitation. See, e.g., *Ry. Labor Executives' Ass'n v. Gibbons*, 455 U.S. 457, 468–69, 102 S. Ct. 1169, 1176, 71 L. Ed. 2d 335 (1982) (“Thus, if we were to hold that Congress had the power to enact nonuniform bankruptcy laws pursuant to the Commerce Clause, we would eradicate from the Constitution a limitation on the power of Congress to enact bankruptcy laws.”). Thus, the Eleventh Amendment should not be viewed as expansive here to subvert the express power to secure the rights of inventions to their inventors.

And moreover, such a construction of the Eleventh Amendment denies the rights of the petitioner by allowing the State to invoke sovereign immunity. “Constitutional rights would be of little value if they could be * * * indirectly denied,” *Harman v. Forssenius*, 380 U.S. 528, 540, 85 S. Ct. 1177, 1185, 14 L. Ed. 2d 50 (1965), citing *Smith v. Allwright*, 321 U.S. 649, 664, 64

S. Ct. 757, 765, 88 L. Ed. 987 (1944). The Court should give precedence to the express power of Art. 1, Sec. 8 in this instance as the Eleventh Amendment cannot be used to indirectly deny a citizen their constitutional rights.

CONCLUSION

Accordingly, the petition for a writ of certiorari should be granted.

Respectfully submitted,

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APPENDIX

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APPENDIX A

NOTE: This disposition is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

2016-2320

[Filed April 12, 2017]

MUSSA ALI,)
<i>Plaintiff-Appellant</i>)
)
v.)
)
CARNEGIE INSTITUTION OF)
WASHINGTON, UNIVERSITY)
OF MASSACHUSETTS,)
<i>Defendants-Appellees</i>)

Appeal from the United States District Court for the
District of Columbia in No. 1:13-cv-02030-RC, Judge
Rudolph Contreras.

Decided: April 12, 2017

MUSSA ALI, Seattle, WA, pro se.

KURT CALIA, Covington & Burling LLP, Redwood
Shores, CA, for defendants-appellees. Also represented

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by NATHAN EVANS SHAFROTH, ALEXA HANSEN, San Francisco, CA.

Before DYK, BRYSON, and CHEN, *Circuit Judges*.

Opinion for the court filed PER CURIAM.

Concurring opinion filed by *Circuit Judge Dyk*.

PER CURIAM.

This longstanding patent dispute began when Mussa Ali, proceeding pro se, filed a civil suit in the U.S. District Court for the District of Oregon (Oregon court) against the Carnegie Institution of Washington (Carnegie) and the University of Massachusetts (UMass) (collectively, defendants), alleging that they erroneously omitted Mr. Ali as a co-inventor on a handful of patents that the defendants co-owned. Mr. Ali sought to be added as a co-inventor to the patents-in-suit, as well as monetary damages from UMass for this alleged omission. Afterwards, the Oregon court dismissed UMass on the ground that it is entitled to sovereign immunity under the Eleventh Amendment of the U.S. Constitution and sua sponte transferred the case to the U.S. District Court for the District of Columbia (DC court) because it lacked personal jurisdiction over Carnegie. The DC court then dismissed the case because UMass was a necessary party that could not be joined and ultimately entered judgment against Mr. Ali. Although we have liberally construed Mr. Ali's appeal of various decisions rendered by the Oregon court and the DC court, we conclude that neither court erred in any respect, and we, therefore, *affirm*.

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BACKGROUND

U.S. Patent Nos. 6,506,559, 7,538,095, 7,560,438, 7,622,633, and 8,283,329 (patents-in-suit) are generally directed to methods of gene-specific inhibition through the use of double-stranded ribonucleic acid and are jointly owned by the defendants. Two of the named co-inventors of the claimed inventions, Dr. Andrew Fire of Carnegie and Dr. Craig C. Mello of UMass, received the Nobel Prize in Medicine in 2006 for these inventions. Mr. Ali alleges that he made a critical contribution to the claimed inventions of the patents-in-suit while he was employed in Dr. Mello's laboratory at UMass and that Dr. Mello then shared Mr. Ali's contribution with Dr. Fire. Mr. Ali attempted on many occasions to have the defendants add him as a co-inventor on the patents-in-suit, but they refused to do so. Their refusal led to this litigation.

Mr. Ali filed a complaint against Carnegie in the Oregon court, which he would later amend to join UMass as a co-defendant, seeking to become a named co-inventor to the patents-in-suit under 35 U.S.C. § 256 (2012) (inventorship claim), as well as to recover damages from UMass for any money derived from the patents-in-suit that he was entitled to as a co-inventor (damages claims). UMass then moved for dismissal of the case against it under Fed. R. Civ. P. (12)(b)(1), arguing that the Oregon court lacked subject matter jurisdiction because UMass has sovereign immunity as an "arm" of Massachusetts under the Eleventh Amendment. In light of this argument, the defendants jointly filed a motion for complete dismissal of the case pursuant to Fed. R. Civ. P. 12(b)(7), asserting that UMass was a necessary party that could not be joined

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in the case. Alternatively, they jointly moved for complete dismissal under Fed. R. Civ. P. 12(b)(2) as well, contending that the Oregon court lacked personal jurisdiction over them.¹

The Oregon court concluded that the Eleventh Amendment provided UMass sovereign immunity from suit as it was essentially one and the same as Massachusetts and that UMass had not engaged in any conduct that suggested it waived this immunity. Thus, the Oregon court granted UMass's Rule 12(b)(1) motion, dismissing it from the case. The Oregon court then considered whether it had personal jurisdiction over Carnegie, but deferred making a decision so as to permit Mr. Ali to conduct limited jurisdictional discovery into any relationship between Carnegie and Oregon.

Mr. Ali sought reconsideration of the Oregon court's dismissal decision. Mr. Ali contended that UMass waived its sovereign immunity when it accepted funds from the federal government under the University and Small Business Patent Procedures Act, 35 U.S.C. §§ 200–12 (2012), commonly known as the Bayh-Dole Act, in support of certain research that led to the issuance of the patents-in-suit because UMass's receipt of federal funds was conditioned on the waiver of its sovereign immunity.² The Oregon court rejected Mr.

¹ The defendants also moved for partial dismissal under Federal Rule of Civil Procedure 12(b)(6), but that is irrelevant to this appeal.

² “In 1980, Congress passed the Bayh-Dole Act to ‘promote the utilization of inventions arising from federally supported research,’ ‘promote collaboration between commercial concerns and nonprofit

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Ali's contention, finding no provision in the Bayh-Dole Act that supported this theory of conditional receipt of funds.

For its part, Carnegie sought reconsideration of the Oregon court's discovery order, and the Oregon court reversed course. It explained that even if it accepted Mr. Ali's allegations concerning Carnegie's research, educational, and licensing efforts directed at Oregon as true, they would not constitute the systematic and continuous contacts necessary to hold that the court had general personal jurisdiction over Carnegie. Moreover, because Mr. Ali's lawsuit was unrelated to any such alleged efforts, the Oregon court held that it could not exert specific personal jurisdiction over Carnegie in this particular dispute. The Oregon court then sua sponte transferred the case to Washington, D.C. And in doing so, it declined to address the then-pending Rule 12(b)(7) motion.

Upon transfer to the DC court, the court resolved the Rule 12(b)(7) motion and considered three variables in evaluating whether to dismiss the action due to the absence of UMass as a party:

- (1) [W]hether the absent party is "required" for the litigation according to the factors enumerated in [Fed. R. Civ. P. 19(a)];

organizations,' and 'ensure that the [g]overnment obtains sufficient rights in federally supported inventions.'" *Bd. of Trustees of Leland Stanford Junior Univ. v. Roche Molecular Sys., Inc.*, 563 U.S. 776, 782 (2011) (quoting 35 U.S.C. § 200 (2006)); see also *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 929 (Fed. Cir. 2004) ("The Bayh-Dole Act was intended to enable universities to profit from their federally-funded research.").

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(2) whether the required party can be joined; and (3) if joinder is not feasible, whether the action can nevertheless proceed in “equity and good conscience” under [the factors identified in Fed. R. Civ. P. 19(b)].

J.A. at 46 (first citing *OAO Healthcare Solutions, Inc. v. Nat’l Alliance of Postal & Fed. Emps.*, 394 F. Supp. 2d 16, 19 (D.D.C. 2005); and then citing *Kickapoo Tribe of Indians of Kickapoo Reservation in Kan. v. Babbitt*, 43 F.3d 1491, 1494 (D.C. Cir. 1995)). The DC court further explained that under the first variable,

[A] party is to be joined if feasible if (1) the court cannot accord complete relief among existing parties; (2) the party’s absence may, as a practical matter, impair or impede that party’s ability to protect its interest; or (3) the party’s absence may subject the existing parties to substantial risk of incurring multiple or otherwise inconsistent obligations.

Id. at 46–47 (citing Fed. R. Civ. P. 19(a)(1)). The DC court also identified the following factors for consideration under the third variable:

(1) the extent to which a judgment rendered in the person’s absence might prejudice that person or the existing parties; (2) the extent to which any prejudice could be lessened or avoided by: (A) protective provisions in the judgment[,] (B) shaping the relief[,] or (C) other measures; (3) whether a judgment rendered in the person’s absence would be adequate; and (4) whether the plaintiff would have an adequate remedy if the action were dismissed for nonjoinder.

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Id. at 50 (quoting Fed. R. Civ. P. 19(b)). Considering all of these factors, the DC court made several findings that led it to conclude that Mr. Ali’s case could not proceed without UMass as a party.

First, the DC court found that UMass was a required party under Rule 19(a). More specifically, Mr. Ali’s inventorship claim jeopardized UMass’s “ownership interest” in the patents-in-suit and that interest “could be impaired or impeded in its absence” from the case. *Id.* at 47. And although Mr. Ali could receive complete relief on his inventorship claim as the DC court could order the U.S. Patent and Trademark Office to correct the inventive entity of the patents-in-suit without UMass’s presence, complete relief could not be received on his damages claims.³ *See id.* at 47–48. The DC court also noted that our court has remarked in the past “that patent owners are required to be joined if feasible under Rule 19(a).” *Id.* at 47 (quoting *Univ. of Utah v. Max-Planck-Gesellschaft Zur Forderung Der Wissenschaften E.V.*, 734 F.3d 1315, 1326 (Fed. Cir. 2013)). Therefore, it concluded that “UMass [was] a necessary party because it is a co-owner of the [patents-in-suit], and its interests would be highly prejudiced in its absence, even if the [c]ourt could afford partial relief to [Mr. Ali] as to inventorship.” *Id.* at 48–49.

Second, the DC court found that UMass could not be joined to the case, adopting the Oregon court’s

³ In addition to being unable to afford complete relief on these damages claims in UMass’s absence, the DC court elaborated on how UMass would be prejudiced by its absence in its Rule 19(b) analysis. *See J.A.* at 48 (citing *Kickapoo*, 43 F .3d at 1497 n.9).

conclusion that UMass had sovereign immunity. *Id.* at 49.

Third, the DC court found that equity and good conscience did not permit it to proceed with the case under Rule 19(b). As a preliminary matter, it explained that the Rule 19(b) inquiry “calls for a pragmatic decision based on practice considerations in the context of particular litigation” and so it had “*substantial discretion* in considering which factors to weigh and how heavily to emphasize certain considerations” *Id.* at 50 (emphasis added) (quoting *Kickapoo*, 43 F.3d at 1495). Moreover, the DC court observed that, in the D.C. Circuit, “sovereign immunity reigns supreme” when analyzing the Rule 19(b) factors. *Id.* at 50–51 (citation omitted).

For the first factor, the DC court found that, for the inventorship claim, UMass would be prejudiced in its absence from the case because it is a “co-owner[] of the patents[-in-suit], and the addition of [Mr. Ali] would change [its] ownership rights.” *Id.*; *see also id.* (“[Although] Carnegie’s interest in protecting the inventorship status of the patents[-in-suit] aligns with UMass’s, UMass’s relationship with [Mr. Ali] is much more central to the case than is Carnegie’s.”). It also found that “Carnegie may even be incentivized to settle the case early as to the . . . inventorship claim to eliminate *its own* potential liability which would highly prejudice the absent UMass’s ownership interest in the patents.” *Id.* at 53 (emphasis in original). As for the damages claims, because Mr. Ali directed those only at UMass, “it would be highly prejudicial to Carnegie to force it to vigorously defend a suit . . . in a case that involves only potential financial loss to UMass—a

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party that cannot be joined.” *Id.* at 52–53. So this factor favored dismissal of the case.

Next, the DC court determined that the prejudice to UMass could not be mitigated by any alternative relief to dismissal for either the inventorship claim, *see id.* at 57 & n.9, or the damages claims, *see id.* at 56–57. Thus, this factor also favored dismissal of the case.

The DC court then determined that as to whether a judgment rendered in UMass’s absence would provide adequate relief to Mr. Ali, this factor favored proceeding with the case in part and dismissal of the case in part. *See id.* at 58–59. While the DC court could afford complete relief to Mr. Ali for his inventorship claim if his case proceeded, the same could not be said for his damages claims. *See id.* On balance, the DC court concluded that the Rule 19(b) factors weighed against proceeding in the case without UMass. *Id.* at 61.

The DC court then dismissed Mr. Ali’s first amended complaint, but granted him leave to file a second amended complaint to the extent that he wished to pursue *only* the inventorship claim against the UMass officials responsible for incorrectly identifying the inventive entity of the patents-in-suit. *Id.* at 57 & nn. 9–10, 63. Mr. Ali did not seek leave to file such an amended complaint.

As Mr. Ali did before the Oregon court, he sought reconsideration of the DC court’s decision with respect to its financial prejudice analysis for Rule 19(b). First, he contended that the DC court erred in finding that UMass would be prejudiced financially if he were to litigate his case successfully because the amount that

UMass pays to its inventors is fixed and would not change. Alternatively, he contended that if he were successful, the DC court could order the other co-inventors to pay monetary damages on behalf of UMass. The DC court rejected the former contention because regardless of how UMass currently pays the other co-inventors of the patents-in-suit, UMass would ultimately have to pay Mr. Ali if he were successful in the case. It rejected the latter contention, observing that Mr. Ali had not previously raised it before the court and explaining that, in any event, the court had no power to issue judgments against non-parties to cases. The DC court also noted that financial prejudice to UMass was only one factor, “and a secondary one at that,” in its 19(b) analysis, so its ultimate conclusion that neither his inventorship claim nor his damages claims could proceed without UMass would remain undisturbed by Mr. Ali’s contentions.⁴ *See, e.g., id.* at 78 (“UMass faced not only financial prejudice if Mr. Ali prevailed on his . . . damages claims, but also potential impairment of its ownership interests in the [patents-in-suit] if he prevailed solely on his . . . inventorship claim.” (emphasis added) (citing prior opinion)); *id.* at 79 (“[T]he [c]ourt repeatedly emphasized that when determining whether the action should proceed without UMass, ‘sovereign immunity reigns supreme in the analysis.’” (citation omitted) (quoting prior opinion)); *id.* (“[I]t was not only the financial prejudice to an absent sovereign that governed the [c]ourt’s Rule 19 analysis, but also the likely prejudice to UMass’s

⁴ Mr. Ali suggested, in a footnote in his motion, that he was unconstitutionally deprived of due process, but then informed the court it need not entertain that possibility. *See J.A.* at 82 n.5.

patent-ownership interests and to Carnegie if it was forced to defend the suit alone despite the fact that ‘UMass’s relationship with [Mr. Ali] [was] much more central to the case than Carnegie’s.’” (quoting prior opinion)).

Second, Mr. Ali included a one-sentence motion for leave to amend his first amended complaint such that it would reflect his initial complaint, which did not name UMass as a co-defendant. The DC court denied his request for leave because it did not comply with: (1) Fed. R. Civ. P. 15(a), which required Mr. Ali to explain how a second amended complaint would not have been futile; (2) Local Civ. R. 15.1, which required Mr. Ali to attach a copy of the proposed second amended complaint; and (3) the DC court’s prior order, which granted leave to amend the first amended complaint solely to add the names of UMass officials responsible for correctly identifying the inventive entity of the patents-in-suit. *See* J.A. at 83–84. The proposed second amended complaint did not name UMass officials, as the DC court had earlier suggested.

The DC court’s denial of Mr. Ali’s request for leave caused him to file a second motion for reconsideration, where he accused the DC court of making several mistakes. The DC court dismissed any notion that its denial was erroneous.

Mr. Ali now appeals, and we have jurisdiction pursuant to 28 U.S.C. § 1295(a)(1) (2012).

STANDARDS OF REVIEW

We apply our own law to the issue of sovereign immunity, as well as any waivers thereof, arising from patent cases. *See Univ. of Utah*, 734 F.3d at 1320 (“We have held that the question of Eleventh Amendment waiver is a matter of Federal Circuit law.” (citing *Regents of the Univ. of N.M. v. Knight*, 321 F.3d 1111, 1124 (Fed. Cir. 2003))); *see also Delano Farms Co. v. Cal. Table Grape Comm’n*, 655 F.3d 1337, 1343 (Fed. Cir. 2011) (“In addressing the issue of sovereign immunity, we apply our own law in light of the special importance of ensuring national uniformity on such questions.” (first citing *Pennington Seed, Inc. v. Produce Exch. No. 299*, 457 F.3d 1334, 1338 (Fed. Cir. 2006); and then citing *Regents*, 321 F.3d at 1124)). A district court’s decision on sovereign immunity is subject to de novo review. *See Univ. of Utah*, 734 F.3d at 1320.

On the other hand, we apply the law of the regional circuit to procedural questions that are not unique to patent cases, such as those pertaining to the propriety of discovery, the amendment of pleadings under Rule 15, and the joinder of parties under Rule 19, except to the extent that these questions implicate patent law issues. *E.g.*, *A123 Sys., Inc. v. Hydro-Quebec*, 626 F.3d 1213, 1220 (Fed. Cir. 2010); *Patent Rights Prot. Grp., LLC v. Video Gaming Techs., Inc.*, 603 F.3d 1364, 1371 (Fed. Cir. 2010); *Pressure Prod. Med. Supplies, Inc. v. Greatbatch Ltd.*, 599 F.3d 1308, 1315 (Fed. Cir. 2010). In the Ninth Circuit, a denial of a discovery request is reviewed for an abuse of discretion. *E.g.*, *Boschetto v. Hansing*, 539 F.3d 1011, 1020 (9th Cir. 2008). Decisions bearing upon Rule 15 and Rule 19 are both reviewed

for an abuse of discretion in the D.C. Circuit.⁵ *E.g.*, *Firestone v. Firestone*, 76 F.3d 1205, 1208 (D.C. Cir. 1996) (denial of leave to amend is reviewed for an abuse of discretion); *Kickapoo*, 43 F.3d at 1495 (decision that a party is indispensable under Rule 19(b) is reviewed for an abuse of discretion (citing *Cloverleaf Standardbred Owners Ass'n v. Nat'l Bank of Wash.*, 699 F.2d 1274, 1276 (D.C. Cir. 1983))).

DISCUSSION

A. The Oregon Court's Decisions

1. Sovereign Immunity

Mr. Ali does not dispute the Oregon court's conclusion that UMass is entitled to sovereign immunity from his suit. Rather, he argues that the Oregon court erred in refusing to conclude that UMass waived sovereign immunity when, in return for federal funding under the Bayh-Dole Act, it allegedly signed a contract controlled by and consistent with the Bayh-Dole Act (Bayh-Dole contract) and expressly declared that it would be amenable to suit in federal court.⁶ *See*

⁵ Mr. Ali has challenged no decision of the Oregon court grounded in either of these rules.

⁶ Mr. Ali has confusingly argued that his standing to bring suit against UMass compels a finding of UMass's waiver of sovereign immunity. *See* Appellant Br. at 19–21. Whatever force this argument may have is irrelevant because the argument has been waived. *See, e.g., Fresenius USA, Inc. v. Baxter Int'l, Inc.*, 582 F.3d 1288, 1296 (Fed. Cir. 2009) (explaining that arguments are waived if they were not raised or properly developed before the district court). In any event, Mr. Ali cites no authority for such a proposition, and we are aware of none.

Appellant Br. at 17–19; *see also id.* at 17 (citing 35 U.S.C. § 202(c)(7)(B)). We see no error in the Oregon court’s conclusion.

UMass waives sovereign immunity under “only two circumstances: first, if the state on its own initiative invokes the jurisdiction of the federal courts; and second, upon a clear declaration by the state of its intent to submit to federal jurisdiction.” *Xechem Int’l, Inc. v. Univ. of Tex. M.D. Anderson Cancer Ctr.*, 382 F.3d 1324, 1329 (Fed. Cir. 2004) (citing *Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666, 675–76 (1999)); *see also Biomedical Patent Mgmt. Corp. v. Cal., Dep’t of Health Servs.*, 505 F.3d 1328, 1333 (Fed. Cir. 2007) (explaining same).

Here, UMass’s alleged agreement to be subject to suit *by the federal government* under a contract controlled by and consistent with the Bayh-Dole Act cannot operate as a “clear declaration”⁷ that it waived its sovereign immunity as to Mr. Ali’s suit against it for damages arising from his alleged omission as a co-inventor of the patents-in-suit. We agree with the Oregon court that “[t]here is nothing in the Bayh-Dole Act that suggests waiver of sovereign immunity in federal court is a prerequisite to accepting funding under the [Bayh-Dole] Act, thereby permitting suit against a state in a § 256 action,” which also seeks to collect monetary damages. J.A. at 25. And, following the Supreme Court, we have rejected “the argument that a state waives its immunity by entering into arrangements controlled by federal law and reviewable

⁷ The first circumstance under which a waiver can occur is not at issue in this case. J.A. at 22 n.2.

only in federal court.” *Xechem*, 382 F.3d at 1329 (relying on *Coll. Sav. Bank*, 527 U.S. at 675). Therefore, the Oregon court correctly declined to find any waiver of UMass’s sovereign immunity.

2. Discovery

Mr. Ali faults the Oregon court for denying him discovery of: (1) the alleged Bayh-Dole contract between UMass and the federal government, Appellant Br. at 16–18; and (2) the names of UMass officials that were responsible for correctly identifying the inventive entity of the patents-in-suit,⁸ *id.* at 21–22. We detect no reversible error in the Oregon court’s denial of discovery.

First, as mentioned above, any alleged contractual agreement between UMass and the federal government that could provide the federal government with a right to sue UMass does not amount to a waiver of sovereign immunity permitting others to sue UMass. *See, e.g., West Virginia v. United States*, 479 U.S. 305, 311 (1987) (“States have no sovereign immunity as against the [f]ederal [g]overnment” (citing *United States v. Texas*, 143 U.S. 621, 646 (1892))); *see also A123 Sys*, 626 F.3d at 1219 (“a state university’s participation in one lawsuit does not amount to a waiver of immunity in a separate lawsuit” (citing *Biomedical Patent*, 505 F.3d at 1339)).

⁸ We have previously permitted suits against state officials to ensure the enforcement of federal law that seek prospective injunctive relief. *See Pennington Seed*, 457 F.3d at 1341–42 (explaining doctrine developed in *Ex parte Young*, 209 U.S. 123 (1908)). Such suits do not run afoul of the Eleventh Amendment. *Id.* at 1341.

Second, as the Oregon court correctly observed, Mr. Ali already possessed the titles of those UMass officials responsible for identifying the correct inventive entity of the patents-in-suit. *See* J.A. at 10 n.3. Any additional discovery was unwarranted. We, therefore, see no abuse of discretion with the Oregon court’s handling of Mr. Ali’s discovery requests. *See, e.g., White v. Univ. of Cal.*, 765 F.3d 1010, 1025 (9th Cir. 2014) (no abuse of discretion where discovery into sovereign immunity question was based on “speculative arguments”).

B. The DC Court’s Decisions

1. Joinder

Mr. Ali contends that the DC court erred in its Rule 19(b) analysis when the court determined that UMass would be financially prejudiced by Carnegie’s defense of the case (as Carnegie would have less incentive to vigorously defend the suit). Mr. Ali argues that the DC court’s analysis is inherently contradictory because the court, in his view, simultaneously reasons that Mr. Ali is and is not obligated to assign his purported rights in the patents-in-suit to the defendants. *See* Appellant Br. at 23–30. Mr. Ali misunderstands the DC court’s financial prejudice analysis and fails to undermine the court’s finding that UMass would be prejudiced, if it were absent from the case, because it would ultimately have to pay damages to Mr. Ali were he successful, whereas Carnegie would not. In other words, the DC court relied on Mr. Ali’s allegations that he is entitled to monetary damages, *regardless* of whether Mr. Ali is obligated to assign any purported ownership interest in the patents-in-suit. *See* J.A. at 75 (“[T]he financial prejudice to UMass . . . stemmed from [Mr. Ali’s] claim[s] for damages, wherein he seeks not only to be

included in future payouts but also to be compensated by UMass for several years of unpaid royalties.”); *see also id.* at 49–61.

Mr. Ali also lodges a series of objections to the Rule 19(b) analysis that can be summed up as accusing the DC court of depriving him of constitutional due process. *See* Appellant Br. at 35–47. Mr. Ali objects to the DC court’s dismissal because it deprives him of private property (patent rights) without due process in violation of the Fourteenth Amendment. *See id.* at 41–47. Mr. Ali further objects to the DC court’s “sua sponte arguments” that were made on behalf of UMass and to which he had no notice and opportunity to respond. *See id.* at 35–41. We find these objections unfounded.

First, the DC court properly relied on Mr. Ali’s representation that it need not consider any argument he may have concerning an unconstitutional deprivation of due process under the Fourteenth Amendment. *See* J.A. at 82 n.5.

Second, the DC court did not make any findings such that Mr. Ali was stripped of due process. Mr. Ali points out that the DC court found that he was seeking past monetary damages from UMass based on his alleged omission from the patents-in-suit. He now asserts that he never sought such damages, but this assertion is directly contradicted by his first amended complaint, which alleges that he is entitled to both retrospective and prospective monetary relief from UMass. *See id.* at 52–53, 328.

And his other due process complaints are merely disagreements with the DC court’s findings, which do

not render the court's analysis constitutionally unsound. For example, Mr. Ali asserts that the DC court wrongly found that UMass would be prejudiced as a result of its absence from the case. But again, this finding is predicated on Mr. Ali's allegations against UMass. *See id.* at 52–53 (citing paragraphs from Mr. Ali's first amended complaint that show that his relationship with UMass, as opposed to Carnegie, is “much more central to the case”); *see also id.* at 323–25, 328.

Significantly, while Mr. Ali challenges (without justification) various premises of the DC court's Rule 19(b) determination—that the action cannot proceed without UMass as a party—on appeal, he makes no challenge to the DC court's overall Rule 19(b) determination. We note, however, that in *University of Utah*, we concluded that a district court acted within its discretion in proceeding with a suit involving an inventorship claim against, among others, certain UMass officials, while UMass, a co-owner of the patents-in-suit, was absent from the suit. *See* 734 F.3d at 1325–28. The DC court correctly observed that, in so concluding, we found that UMass would not be prejudiced and its interests would be adequately protected “because UMass had entered into a[n] . . . agreement wherein it ‘handed sole and exclusive control of th[e] suit’ to one of the named defendants in the action.” J.A. at 54 (quoting *Univ. of Utah*, 734 F.3d at 1327–28). No such agreement between UMass and Carnegie has been alleged. We have no occasion here to determine whether the DC court abused its discretion in this case by not allowing Mr. Ali's inventorship claim to go forward given Mr. Ali's limited challenge on

appeal from the DC court and his failure to amend his complaint to name the UMass officials as parties.

2. Amending a Pleading

Mr. Ali protests the DC court's denial of his motion for leave to amend the first amended complaint to reflect his initial complaint. *See* Appellant Br. at 30–35. We see no abuse of discretion here because Mr. Ali did not—and still has not—explained how leave to amend under Rule 15(a) would not have been futile and would have cured the infirmities that plagued his first amended complaint. *See* J.A. at 83–84; *see also Foman v. Davis*, 371 U.S. 178, 182 (1962). For example, he “has offered no argument whatsoever as to how reinstating the first complaint—which is premised on substantially the same factual allegations and once again would have Carnegie as the sole defendant opposing Mr. Ali's claims to correct inventorship and for related damages—would affect . . . [the] decision that UMass is a necessary party without which this case must not proceed.” J.A. at 84 (citation omitted). And in any event, Mr. Ali failed to attach a copy of his proposed amended pleading in accordance with Local Rule 15.1. Either of these deficiencies justifies the DC court's denial of leave to amend.

Finally, we have considered all of Mr. Ali's other alleged errors directed at either the Oregon court or the DC court and find them unpersuasive.

CONCLUSION

For the foregoing reasons, the DC court's entry of judgment is *affirmed*.

AFFIRMED

COSTS

No Costs.

DYK, *Circuit Judge*, concurring.

Ordinary property disputes between individuals and state entities are resolved in state court. In these circumstances, the Eleventh Amendment, which bars suit only in federal courts, does not operate to leave the property owner without a remedy when a suit in federal court is dismissed. *See Alden v. Maine*, 527 U.S. 706, 755 (1999) (“Many States, on their own initiative, have enacted statutes consenting to a wide variety of suits.”).

Patent inventorship claims are different. A state law remedy is not available, and a claimant’s only remedy lies in a federal cause of action under 35 U.S.C. § 256 to correct inventorship. This is so because federal law ousts state courts of jurisdiction over inventorship claims. The statute provides that “[n]o State court shall have jurisdiction over any claim for relief arising under any Act of Congress relating to patents.” 28 U.S.C. § 1338(a).¹ The statute instead prescribes exclusive jurisdiction in federal courts. *See id.* Under these circumstances, it seems to me particularly harsh to hold that the federal action—in which the relief sought

¹ *See also Larson v. Correct Craft, Inc.*, 569 F.3d 1319, 1324–25 (Fed. Cir. 2009) (“There is no doubt that § 256 supplies such a valid basis for federal jurisdiction: an action to correct inventorship under § 256 ‘aris[es] under’ the patent laws for the purpose of § 1338(a).”)

is directed to the Director of the Patent Office—cannot proceed without the state entity as a party. I note that in *University of Utah v. Max-Planck-Gesellschaft Zur Forderung Der Wissenschaften E.V.*, 734 F.3d 1315, 1328 (Fed. Cir. 2013), we allowed the federal action to proceed without the state entity.

Thus, while I join the majority opinion, it remains for us to determine in another case how the Rule 19(b) factors should apply to a claim for inventorship, given the lack of any alternative remedy.² (These concerns may not, of course, extend to a damages claim for misappropriation of patent rights, since a state court remedy may well be available).

² “The factors for the court to consider include: (1) the extent to which a judgment rendered in the person’s absence might prejudice that person or the existing parties; (2) the extent to which any prejudice could be lessened or avoided by: (A) protective provisions in the judgment; (B) shaping the relief; or (C) other measures; (3) whether a judgment rendered in the person’s absence would be adequate; and (4) whether the plaintiff would have an adequate remedy if the action were dismissed for nonjoinder.” Fed. R. Civ. P. 19(b).

APPENDIX B

**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA**

Civil Action No.: 13-2030 (RC)

[Filed September 8, 2015]

MUSSA ALI,)
Plaintiff,)
)
v.)
)
CARNEGIE INSTITUTION OF)
WASHINGTON,)
Defendant.)

Re Document No.: 92

MEMORANDUM & ORDER

**DENYING PLAINTIFF'S SECOND
MOTION FOR RECONSIDERATION**

Now before the Court is *pro se* Plaintiff Mussa Ali's motion for relief pursuant to Federal Rule of Civil Procedure 60. Mr. Ali argues that the final paragraph of this Court's prior Memorandum Opinion, which denied his motion for reconsideration or, alternatively, for leave to amend his complaint, contains "inaccurate" holdings and should be "expunged." *See generally* Pl.'s 2d Mot. Recons., ECF No. 92. For the reasons stated below, the Court will deny the motion.

I. FACTUAL AND PROCEDURAL BACKGROUND

Mr. Ali initiated this matter in September 2012 by filing suit against the Carnegie Institution of Washington (“Carnegie”) in the U.S. District Court for the District of Oregon. *See* Compl., ECF No. 1. Mr. Ali alleged that he was erroneously omitted as an inventor on multiple U.S. patents co-owned by Carnegie and the University of Massachusetts (“UMass”), and he sought to correct inventorship and to recover more than \$100,000 in related damages. After retaining counsel, Mr. Ali filed an amended complaint that added UMass as a defendant. *See generally* Am. Compl., ECF No. 4. In May 2013, the District Court of Oregon dismissed UMass from the case for lack of subject-matter jurisdiction, finding that the university was an arm of the state and entitled to sovereign immunity, and it provided Mr. Ali with leave to amend his complaint to include claims against UMass officials pursuant to *Ex Parte Young*, 209 U.S. 123 (1908). *See* Op. & Order at 10 n.3, ECF No. 41. Mr. Ali did not amend his complaint, and he instead sought reconsideration that the court denied. *See* Op. & Order at 7–12, ECF No. 66. The court also ruled that it lacked personal jurisdiction over Carnegie and *sua sponte* transferred the case to this Court pursuant to 28 U.S.C. § 1406(a). *See id.* at 13–26.

On August 29, 2014, this Court granted Carnegie’s motion to dismiss the case pursuant to Federal Rule of Civil Procedure 12(b)(7) for failure to join UMass, a necessary party. *See generally* *Ali v. Carnegie Inst. of Wash.*, No. 13-2030, 2014 WL 4260995 (D.D.C. Aug. 29, 2014). In response to Mr. Ali’s request for leave to file

a second amended complaint naming UMass officials as defendants, the Court observed that such an amendment would not be permitted as to the claims for financial damages, and that it was unclear whether *Ex Parte Young* would permit a plaintiff to sue state officials in their official capacities for correction of inventorship. *Id.* at *7. Nevertheless, the Court gave Mr. Ali until October 1, 2014, to seek leave to amend his complaint to include correction of inventorship claims against UMass officials in their official capacities. Order, Aug. 29, 2014, ECF No. 77. The Court subsequently extended the time for filing such an amendment to November 14, 2014, on Mr. Ali's motion. *See* Order, Sept. 19, 2014, ECF No. 84.

Mr. Ali did not seek leave to amend his complaint to include correction of inventorship claims against UMass officials in their official capacities. Instead, on September 29, 2014, he filed a motion for reconsideration or, in the alternative, for leave to amend his complaint. *See generally* Pl.'s Mot. Recons., ECF No. 85. Specifically, he asked that the Court reconsider its holding that UMass is a necessary party or, in the alternative, that he “be given an opportunity for leave of Court to remedy his amended complaint to address the concern of this Court, for example by re-amending his complaint back to the original complaint in which ONLY Carnegie was named as a defendant” *Id.* at 9–10.

On June 26, 2015, the Court denied Mr. Ali's motion for reconsideration and—as is pertinent here—denied his alternative request for leave to amend his complaint due to his failure to comply with Local Rule 15.1 and Federal Rule of Civil Procedure 15(a). *See*

Mem. Op. at 20, June 26, 2015, ECF No. 90. As explained in the Court's Memorandum Opinion, "Mr. Ali's general request for leave to amend in an unspecified manner [was] insufficient to satisfy the requirements of Rule 15(a)," as it did not indicate "the particular grounds on which amendment [was] sought," *id.* at 20 (quoting *U.S. ex rel. Williams v. Martin-Baker Aircraft Co.*, 389 F.3d 1251, 1259 (D.C. Cir. 2004)), and it "failed to comply with Local Rule 15.1, which dictates that a motion for leave to amend 'shall be accompanied by an original of the proposed pleading as amended,'" *id.* (quoting Local Rule 15.1).

The Court went on to explain that alternatively, even if Mr. Ali's proposal of reinstating his first complaint could be viewed as satisfying Local Rule 15.1, he failed to explain "how reinstating the first complaint—which is premised on substantially the same factual allegations and once again would have Carnegie as the sole defendant opposing Mr. Ali's claims to correct inventorship and for related damages—would affect this Court's decision that UMass is a necessary party without which this case must not proceed." *Id.* at 21 (citing *Greggs v. Autism Speaks, Inc.*, 987 F. Supp. 2d 51, 54 (D.D.C. 2014) for the proposition that a court may deny a motion to amend if such amendment would be futile, if, for example, it "merely restates the same facts as the original complaint in different terms, reasserts a claim on which the court previously ruled, fails to state a legal theory or could not withstand a motion to dismiss"). Additionally, the Court noted that it had provided Mr. Ali with a limited period of time in which to seek leave to amend, and had limited the scope of such amendment to a request "to name UMass officials

in their official capacities,” with instructions that any motion seeking such leave must “address whether this Court would have personal jurisdiction over these officials.” *Id.* (citing Order, Aug. 29, 2014, ECF No. 78). Mr. Ali’s request to reinstate his first complaint thus exceeded the scope of the Court’s Order and was unaccompanied by any argument as to why it should be permitted. Finally, the Court observed that as of June 2015, Mr. Ali had still not filed any motion for leave to amend his complaint to name UMass officials in their official capacities, despite the fact that the Oregon District Court had authorized him to do so in May 2013, and despite the fact that the deadline imposed by this Court for seeking such leave “had long since come and gone.” *Id.*

Mr. Ali has now filed a second motion for reconsideration pursuant to Federal Rule of Civil Procedure 60, arguing that the Court’s holdings pertaining to the denial of his request for leave to amend are “inaccurate,” and asking that they be “expunge[d].” *See generally* Pl.’s 2d Mot. Recons., ECF No. 92.

II. LEGAL STANDARDS

As a threshold matter, the Court notes that Mr. Ali has not stated whether he seeks relief pursuant to Rule 60(a) or Rule 60(b)(1). Rule 60(a) permits a court to “correct a clerical mistake or a mistake arising from oversight or omission,” Fed. R. Civ. P. 60(a), but this authority to correct extends only to errors of “pure inadvertence, rather than a mistaken exercise of judgment.” *King v. District of Columbia*, 930 F. Supp. 2d 45, 46 (D.D.C. 2013) (quoting *Lowe v. McGraw–Hill Cos.*, 361 F.3d 335, 341 (7th Cir.2004)); *see also Robert*

Lewis Rosen Assocs., Ltd. v. Webb, 473 F.3d 498, 505 n.11 (2d Cir. 2007) (“Rule 60(a) permits the correction of . . . inadvertent errors when correction is necessary not to reflect a new and subsequent intent of the court, but to conform the order to the contemporaneous intent of the court.”) (quotation omitted); *In re Walter*, 282 F.3d 434, 440 (6th Cir. 2002) (explaining that Rule 60(a) does not “authorize the court to revisit its legal analysis or otherwise correct an error of substantive judgment” but only to “correct mistakes or oversights that cause the judgment to fail to reflect what was intended at the time of trial”). Here, Mr. Ali argues that the Court erred in holding that he had not complied with the Court-imposed deadline for seeking leave to amend his complaint because the deadline should have been tolled while his motion for reconsideration was pending. *See generally* Pl.’s 2d Mot. Recons., ECF No. 92. This argument asks the Court to revisit the substance of its timeliness analysis and not simply to correct an inadvertent mistake that caused the Court’s written decision to fail to reflect its intent at the time of decision. Accordingly, Mr. Ali’s motion does not fall within the parameters of a Rule 60(a) motion, and the Court will consider the motion under Rule 60(b).

Rule 60(b) allows a court to relieve a party from a final judgment “[o]n motion and just terms” for reasons including “mistake, inadvertence, surprise, or excusable neglect.” Fed. R. Civ. P. 60(b). The Rule “was intended to preserve the delicate balance between the sanctity of final judgments and the incessant command of the court’s conscience that justice be done in light of all the facts. It cannot be employed simply to rescue a litigant from strategic choices that later turn out to be

improvident.” *Smalls v. United States*, 471 F.3d 186, 191 (D.C. Cir. 2006) (internal quotation marks and ellipses omitted). “To obtain Rule 60(b) relief, the movant must give the district court ‘reason to believe that vacating the judgment will not be an empty exercise or a futile gesture.’” *Norman v. United States*, 467 F.3d 773, 775 (D.C. Cir. 2006) (quoting *Murray v. District of Columbia*, 52 F.3d 353, 355 (D.C. Cir. 1995)). Reconsideration pursuant to Rule 60(b) is a remedy that should be sparingly used, *see Kramer v. Gates*, 481 F.3d 788, 792 (D.C. Cir. 2007), and the party seeking reconsideration bears the burden of establishing that such relief is warranted under the circumstances, *Elec. Privacy Info. Ctr. v. U.S. Dep’t of Homeland Sec.*, 811 F. Supp. 2d 216, 226 (D.D.C. 2011).

III. ANALYSIS

In his second motion for reconsideration, Mr. Ali argues that the last three sentences of the Court’s analysis of his request for leave to amend are inaccurate, erroneous, and should be expunged. He first takes issue with the Court’s statements that Mr. Ali had declined to seek leave to amend in the manner permitted by the Court and had failed to explain his non-compliance with the limitations of the Court’s Order, noting that his motion for reconsideration did say that “[t]he issue of when and where to invoke the *Ex Parte Young* doctrine as a way to sustain this case would be relevant and is to be addressed if Ali’s instant motion for reconsideration were to bear no fruit.” Pl.’s 2d Mot. Recons. at 2, ECF No. 92 (quoting Pl.’s Mot. Recons. at 8, ECF No. 85). He then argues that the Court erred by holding that the Court-imposed deadline for seeking leave to amend had lapsed,

claiming that he could not have delayed in complying or failed to comply with a deadline imposed by court order when that very order was under reconsideration. *Id.* at 3. Defendant Carnegie protests that Mr. Ali has identified no mistakes in the Court's statements, that he has failed to offer any authority in support of his belief that his motion for reconsideration could unilaterally override a court-imposed filing deadline, and that he has failed to establish entitlement to relief under Rule 60(b). The Court agrees with Carnegie.

Mr. Ali does not and cannot dispute that the Court-imposed deadline by which he was to seek leave to file an amended complaint was November 14, 2014. *See* Order, Sept. 19, 2014, ECF No. 84. He did not file a motion seeking leave to amend his complaint by that date, and indeed, he has not done so to this day. As Carnegie correctly notes, Mr. Ali has offered no authority to support his assertion that by filing a motion for reconsideration of one portion of an order, a party automatically stays or extends any filing deadlines contained within that order. And Mr. Ali's statement in his motion for reconsideration that he would determine "when and where" to invoke a legal doctrine if his motion was denied in no way resembles a cognizable motion for leave to amend a complaint. In short, Mr. Ali did not seek leave to amend his complaint in the manner or time established by Court order, and he did not request or obtain an extension of the pertinent deadline. Accordingly, he has not established any basis for reconsideration under Rule 60(b).

Alternatively, the Court finds that even if Mr. Ali's arguments had merit—and they do not—he would still

not have established entitlement to relief under Rule 60(b). The Court's denial of Mr. Ali's request for leave to amend his complaint was premised on his failure to comply with Local Rule 15.1 and Federal Rule of Civil Procedure 15(a). *See* Mem. Op. at 20, June 26, 2015, ECF No. 90 ("Given that this Court cannot review Mr. Ali's proposed second amended complaint and has no way to assess the merits of his 'bare request to amend,' and in light of his failure to comply with Rule 15(a) and Local Rule 15.1, his general request for leave to amend must be denied."). Mr. Ali's current motion for reconsideration does not dispute that holding. *See* Pl.'s Reply at 1, ECF No. 92. And he has expressly stated that the instant motion is not a request for leave to amend his complaint to add UMass officials. *See id.* Under these circumstances, Mr. Ali has given the court no reason to believe that granting his motion would be anything other than "an empty exercise or a futile gesture." *See Norman*, 467 F.3d at 775.

IV. CONCLUSION

Accordingly, it is hereby **ORDERED** that Mr. Ali's motion for relief pursuant to Rule 60 is **DENIED**.

SO ORDERED.

Dated: September 8, 2015

RUDOLPH CONTRERAS
United States District Judge

APPENDIX C

**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA**

Civil Action No.: 13-2030 (RC)

[Filed June 26, 2015]

MUSSA ALI,)
Plaintiff,)
)
v.)
)
CARNEGIE INSTITUTION OF)
WASHINGTON,)
Defendant.)

Re Document Nos.: 85, 88

MEMORANDUM OPINION

**GRANTING PLAINTIFF’S MOTION FOR LEAVE TO FILE
SUPPLEMENTAL STATEMENT REGARDING FILING
DATE, DENYING PLAINTIFF’S ALTERNATIVE
REQUEST TO FILE *NUNC PRO TUNC*, & DENYING
PLAINTIFF’S MOTION FOR RECONSIDERATION OR
LEAVE TO AMEND**

I. INTRODUCTION

Pro se Plaintiff Mussa Ali initiated this matter in September 2012 by filing suit against the Carnegie Institution of Washington (“Carnegie”) in the U.S. District Court for the District of Oregon. Mr. Ali

alleged that he was erroneously omitted as an inventor on multiple U.S. patents co-owned by Carnegie and the University of Massachusetts (“UMass”), and he sought to correct inventorship and to recover more than \$100,000 in related damages. After retaining counsel, Mr. Ali filed an amended complaint that added UMass as a defendant and that requested a portion of the proceeds that Defendants had received from the patents in question. The Oregon court dismissed UMass from the case on the basis of sovereign immunity, ruled that the court lacked personal jurisdiction over Carnegie, and transferred the case to this Court. This Court subsequently granted Carnegie’s motion to dismiss the amended complaint for failure to join a necessary party: UMass. Mr. Ali now seeks reconsideration of that dismissal, arguing that UMass is not a necessary party and that the Court’s finding to the contrary relies on the clearly erroneous assumption that UMass’s financial interests would be prejudiced if the case proceeded in its absence. Alternatively, Mr. Ali seeks leave to amend his complaint in an unspecified manner, perhaps by reinstating the first complaint he filed, which named only Carnegie as a defendant. For the reasons set forth below, the Court denies Mr. Ali’s motion for reconsideration and his request for leave to amend his complaint.

II. FACTUAL BACKGROUND

As explained in detail in this Court’s prior Memorandum Opinion,¹ Carnegie and UMass co-own

¹The Court hereby incorporates by reference its earlier Memorandum Opinion. *See generally Ali v. Carnegie Inst. of Washington*, No. 13-cv-2030, 2014 WL 4260995, at *1–2 (D.D.C. Aug. 29, 2014).

five patents relating to methods of inhibiting the expression of a particular gene in a cell through a process called ribonucleic acid interference (“RNAi”). The patents were allegedly issued as a result of the collaboration between Dr. Andrew Fire and Dr. Craig C. Mello, the two lead inventors of the laboratories of Carnegie and UMass, respectively. *See* Def.’s Mot. Dismiss 4, ECF No. 73-1; Am. Compl. ¶ 19, ECF No. 4. Mr. Ali alleges that he made a critical contribution to the discovery of RNAi while employed at UMass in Dr. Mello’s laboratory, and that he should be named as a co-inventor on the five patents. *See* Am. Compl. ¶¶ 8–20.

Mr. Ali filed his original complaint in the U.S. District Court for the District of Oregon in September 2012. *See* Compl., ECF No. 1. He named only Carnegie as a defendant, sought to correct inventorship pursuant to 35 U.S.C. § 256, and demanded “more than \$100,000” in damages for related claims of conversion, unfair competition, unjust enrichment, and fraud under Oregon state law. After retaining counsel, Mr. Ali filed an amended complaint against both Carnegie and UMass in December 2012. *See generally* Am. Compl.

In his Amended Complaint, Mr. Ali again asserted a claim under § 256 to be named a co-inventor of the patents at issue, and he also asserted two alternative claims for “Legal Damages.” In his first claim for legal damages, Mr. Ali states that if he was contractually obligated to assign his rights in the patents to UMass, then he seeks his share of the patent-related proceeds that have been received by UMass and divided between the named UMass inventors. *See* Am. Compl. ¶¶ 28–32.

Alternatively, if Mr. Ali was not obligated to assign his rights, then his second claim for legal damages seeks a portion of the proceeds received by both UMass and Carnegie from the sale, license, or transfer of their patent rights. *See* Am. Compl. ¶¶ 33–36.

In May 2013, the District Court of Oregon dismissed UMass from the case for lack of subject-matter jurisdiction, finding that the university was an arm of the state and entitled to sovereign immunity. *See* Op. & Order at 10, ECF No. 41. In the same decision, the court also provided Mr. Ali with leave to amend his complaint to include claims against UMass officials pursuant to *Ex Parte Young*, 209 U.S. 123 (1908), which Mr. Ali had invoked in his motion for jurisdictional discovery. *Id.* at 10 n.3. Mr. Ali chose instead to seek reconsideration of the dismissal and denial of discovery, which the court denied. *See* Op. & Order at 7–12, ECF No. 66. The court also ruled that it lacked personal jurisdiction over Carnegie and *sua sponte* transferred the case to this Court pursuant to 28 U.S.C. § 1406(a). *See id.* at 13–26.

On August 29, 2014, this Court granted Carnegie’s motion to dismiss the case pursuant to Federal Rule of Civil Procedure 12(b)(7) for failure to join UMass, a necessary party. *See generally Ali*, 2014 WL 4260995. The Court explained that UMass was a required party due to its ownership interest in the patents, that it was entitled to sovereign immunity and could not be joined, and that the action could not proceed in equity and good conscience without UMass. *Id.* In response to Mr. Ali’s request for leave to file a second amended complaint naming UMass officials as defendants, the Court observed that such an amendment would not be

permitted as to the claims for financial damages, and that it was unclear whether *Ex Parte Young* would permit a plaintiff to sue state officials in their official capacities for correction of inventorship. *Id.* at *7. Nevertheless, the Court gave Mr. Ali until October 1, 2014, to seek leave to amend his complaint to include correction of inventorship claims against UMass officials in their official capacities. Order, Aug. 29, 2014, ECF No. 77. The Court subsequently extended the time for filing such an amendment to November 14, 2014, on Mr. Ali's motion. *See* Order, Sept. 19, 2014, ECF No. 84.

To date, Mr. Ali has not sought leave to amend his complaint to include correction of inventorship claims against UMass officials in their official capacities. Instead, on September 29, 2014, Mr. Ali filed the instant motion for reconsideration or, in the alternative, for leave to amend his complaint, possibly by reinstating his first complaint that named only Carnegie as a defendant. *See generally* Pl.'s Mot. Recons., ECF No. 85.

III. ANALYSIS

Mr. Ali argues that the Court's determination that UMass was a necessary party was based on a clearly erroneous factual finding that UMass would be financially prejudiced if Mr. Ali prevailed in this matter and was named as a co-inventor. *Id.* at 2–4. He also claims that the Court erred by failing to find that he has no alternative forum in which to have his case heard on the merits. *Id.* at 5–6. Alternatively, if the Court still views UMass as a necessary party, Mr. Ali asks that he be granted leave “to remedy his amend complaint,” perhaps by reverting “back to the original

complaint in which ONLY Carnegie was named as a defendant.” *Id.* at 9–10. Defendants, on the other hand, maintain that Mr. Ali’s motion should be denied as untimely under Rule 59(e), that it has no basis in fact or law, and that it improperly seeks reconsideration of arguments that were previously considered by the Court or that could have been presented previously. *See generally* Def.’s Opp’n, ECF No. 86. The Court considers each argument in turn.

A. Legal Standards for Reconsideration

The Federal Rules of Civil Procedure provide three avenues for seeking reconsideration of judicial decisions. The first is Rule 54(b), which permits reconsideration of interlocutory orders. *See* Fed. R. Civ. P. 54(b) (“[A]ny order or other decision, however designated, that adjudicates fewer than all the claims or the rights and liabilities of fewer than all the parties does not end the action as to any of the claims or parties and may be revised at any time before the entry of a judgment adjudicating all the claims and all the parties’ rights and liabilities.”).

Relief pursuant to Rule 54(b) is to be provided “as justice requires,” and may be warranted when a court has “patently misunderstood the parties, made a decision beyond the adversarial issues presented, made an error in failing to consider controlling decisions or data, or where a controlling or significant change in the law has occurred.” *U.S. ex rel. Westrick v. Second Chance Body Armor, Inc.*, 893 F. Supp. 2d 258, 268 (D.D.C. 2012) (internal citation, quotation, and alteration omitted); *see also Cobell v. Norton*, 224 F.R.D. 266, 272 (D.D.C. 2004). “These considerations leave a great deal of room for the court’s discretion and,

accordingly, the ‘as justice requires’ standard amounts to determining ‘whether [relief upon] reconsideration is necessary under the relevant circumstances.’” *Lewis v. District of Columbia*, 736 F. Supp. 2d 98, 102 (D.D.C. 2010) (quoting Cobell, 224 F.R.D. at 272). At the same time, a court’s discretion under Rule 54(b) is “limited by the law of the case doctrine and subject to the caveat that where litigants have once battled for the court’s decision, they should neither be required, nor without good reason permitted, to battle for it again.” *Singh v. George Washington Univ.*, 383 F. Supp. 2d 99, 101 (D.D.C. 2005) (citations omitted).

Whereas Rule 54 governs reconsideration of interlocutory orders, Rules 59(e) and 60(b) dictate when a party may obtain reconsideration of a final judgment. Rule 59(e) permits a party to file a motion to alter or amend a judgment within 28 days of the entry of that judgment. Fed. R. Civ. P. 59(e). Such motions are disfavored, are entrusted to the district court’s discretion, and “need not be granted unless the district court finds there is an intervening change of controlling law, the availability of new evidence, or the need to correct a clear error or prevent manifest injustice.” *Ciralsky v. CIA*, 355 F.3d 661, 671 (D.C. Cir. 2004) (quoting *Firestone v. Firestone*, 76 F.3d 1205, 1208 (D.C. Cir. 1996)).

Rule 60(b), on the other hand, allows a party to seek relief from a final judgment “within a reasonable time” after entry of the judgment, but only for specified reasons. *See* Fed. R. Civ. P. 60(b). Such reasons include, among other things, “mistake, inadvertence, surprise, or excusable neglect,” *id.* at (60)(b)(1), “newly discovered evidence that, with reasonable diligence,

could not have been discovered in time to move for a new trial under Rule 59(b),” *id.* at (60)(b)(2), and “any other reason that justifies relief,” *id.* at 60(b)(6). The Rule “was intended to preserve ‘the delicate balance between the sanctity of final judgments and the incessant command of the court’s conscience that justice be done in light of all the facts.’ It cannot be employed simply to rescue a litigant from strategic choices that later turn out to be improvident.” *Smalls v. United States*, 471 F.3d 186, 191 (D.C. Cir. 2006) (quoting *Good Luck Nursing Home, Inc. v. Harris*, 636 F.2d 572, 577 (D.C. Cir. 1980)). Accordingly, reconsideration pursuant to Rule 60 is a remedy that should be sparingly used. *See Kramer v. Gates*, 481 F.3d 788, 792 (D.C. Cir. 2007).

A motion for reconsideration filed outside the 28-day window provided by Rule 59(e) is typically viewed as a Rule 60(b) motion. *See McMillen v. District of Columbia*, No. 04-cv-2036, 2005 WL 3370820, at *1 n.1 (D.C. Cir. Dec. 13, 2005) (holding that motions for reconsideration filed within Rule 59(e)’s time limit are treated as Rule 59(e) motions, while those filed outside it are treated as motions under Rule 60(b)); *Computer Professionals for Soc. Responsibility v. U.S. Secret Serv.*, 72 F.3d 897, 903 (D.C. Cir. 1996) (“An untimely motion under Rule 59(e) may be considered as a motion under Rule 60(b) if it states grounds for relief under the latter rule.”).

Regardless of the Rule pursuant to which reconsideration is sought, “it is well-established that ‘motions for reconsideration,’ whatever their procedural basis, cannot be used as ‘an opportunity to reargue facts and theories upon which a court has already

ruled, nor as a vehicle for presenting theories or arguments that could have been advanced earlier.” *Estate of Gaither ex rel. Gaither v. District of Columbia*, 771 F. Supp. 2d 5, 10 (D.D.C. 2011) (quoting *SEC v. Bilzerian*, 729 F. Supp. 2d 9, 14 (D.D.C. 2010)); *id.* at 10 n.4 (explaining that the same principle extends to motions under Rule 59(e), 60(b), and 54(b)). Additionally, the party seeking reconsideration bears the burden of establishing that such relief is warranted under the circumstances. *Elec. Privacy Info. Ctr. v. U.S. Dep’t of Homeland Sec.*, 811 F. Supp. 2d 216, 226 (D.D.C. 2011) (“The party seeking relief from a judgment bears the burden of demonstrating that it satisfies the prerequisites for such relief.”); *Second Chance Body Armor*, 893 F. Supp. 2d at 268; *Niedermeier v. Office of Baucus*, 153 F. Supp. 2d 23, 28 (D.D.C. 2001).

Although Mr. Ali does not specify the Rule pursuant to which he seeks reconsideration, his invocation of “clear error,” *see* Pl.’s Mot. Recons. at 2, and his statement that his motion was due within 28 days of the entry of judgment, *see* Pl.’s Mot. for Extension of Time, Sept. 12, 2014, ECF No. 80, suggest that he seeks relief from the Court’s order of dismissal under Rule 59(e). Carnegie has treated the motion as one brought pursuant to Rule 59(e), and it argues that the motion is untimely as it was filed more than 28 days after entry of the Court’s order. *See* Def.’s Opp’n at 4 n.1. Mr. Ali has not disputed the characterization of his motion as one brought pursuant to Rule 59(e), *see* Pl.’s Reply, ECF No. 87, but he has asked the Court to extend the 28-day deadline or to otherwise excuse his delayed filing as the product of a mailing error, *see* Pl.’s

Mot. for Extension of Time; Pl.'s Mot. for Leave to File, Nov. 17, 2014, ECF No. 88.²

The Court will neither retroactively extend the time for filing Mr. Ali's motion under Rule 59(e) nor deny it as untimely. Pursuant to Federal Rule of Civil Procedure 6(b), although courts can extend most filing deadlines for good cause shown, Rule 59(e) motions are an exception for which "[a] court must not extend the time to act . . ." Fed. R. Civ. P. 6(b)(2); *see also Derrington-Bey v. D.C. Dep't of Corr.*, 39 F.3d 1224, 1225 (D.C. Cir. 1994) ("District courts do not have even the customary discretion given by Fed. R. Civ. P. 6(b) to enlarge the Rule 59(e) period."); *Ctr. for Nuclear Responsibility, Inc. v. U.S. Nuclear Regulatory Comm'n*, 781 F.2d 935, 941 (D.C. Cir. 1986) ("[T]he District Court simply has no power to extend [Rule 59(e)'s] time limitation."). This Court thus lacks the authority to extend the filing deadline for a Rule 59(e) motion. But as discussed above, the consequence of untimely filing of a Rule 59(e) motion in this circuit is not denial of reconsideration, but treatment of the motion as one under Rule 60(b). *See McMillian*, 2005 WL 3370820, at *1 n.1.

² Mr. Ali's motion for leave to file a supplemental statement regarding the mailing error (ECF No. 88) is hereby granted, but as explained below, the motion's alternative request to file the motion for reconsideration *nunc pro tunc*, apparently so that the motion would comply with Rule 59(e)'s 28-day filing deadline, is denied. *See Justice v. Town of Cicero*, 682 F.3d 662, 664 (7th Cir. 2012) (holding that a judge may not backdate a late-filed Rule 59(e) motion and that granting leave to file such a motion *nunc pro tunc* is improper).

This Court need not determine under which Rule Mr. Ali's motion was brought or should be considered, however, because as explained below, the Court finds that Mr. Ali's motion should be denied regardless of whether it is treated as a motion for reconsideration pursuant to Rule 54(b), 59(e), or 60(b).³ Mr. Ali has not shown an error in the Court's decision to dismiss his complaint for failure to join a necessary party that would warrant reconsideration under any standard.

³ Although the parties both appear to assume that the Court's August 2014 Order of dismissal constitutes a final judgment, relief from which is governed by Rule 59(e) or 60(b), the issue is not as clear-cut as the parties seem to assume. "The district court ordinarily enters a final judgment only after it has disposed of all claims against all parties." *Capitol Sprinkler Inspection, Inc. v. Guest Servs., Inc.*, 630 F.3d 217, 221 (D.C. Cir. 2011). And certainly, the Court's order dismissing Mr. Ali's entire complaint for failure to join a necessary party did dispose of all claims. But the Order of dismissal also provided a limited period of time in which Mr. Ali could seek leave to amend that had not yet expired at the time that he filed the instant motion for reconsideration, and an order that expressly provides for leave to amend is not generally considered a final judgment. *See* 19 James W. Moore, Moore's Federal Practice § 201.14 (3d ed.2003) (discussing application of final judgment rule to pretrial orders, and explaining that "an order dismissing the complaint with leave to amend is not [final or] appealable unless the grounds of the dismissal make it clear that no amendment of the complaint could cure the defect in the plaintiff's case"); *see also Ciralsky v. CIA*, 355 F.3d 661, 666 (D.C. Cir. 2004) (distinguishing between a final judgment in the form of a dismissal without prejudice of a case, and a non-final order dismissing a complaint without prejudice and with leave to amend). Given this ambiguity, and in light of Mr. Ali's *pro se* status, the Court considers the possibility that Mr. Ali's motion may fall under the auspices of Rule 54(b) governing reconsideration of an interlocutory decision, and the Court's analysis will proceed on that basis as well.

B. The Court's Finding that UMass would be Financially Prejudiced

At the heart of Mr. Ali's motion for reconsideration is his contention that the Court erred by assuming that UMass's financial interests would be prejudiced if this action proceeded in its absence. *See* Pl.'s Mot. Recons. at 2. Mr. Ali argues that contrary to the Court's "presupposition that UMass [policy] obligates UMass to pay an additional percentage or amount based on the number of UMass-affiliated co-inventors listed on the patents-in-suit," UMass pays a *set* percentage of its patent proceeds to the co-inventors, and that percentage is divided equally among the inventors. *Id.* at 3–4. He notes that this factual allegation was contained in paragraph 30 of his complaint, which states that under university policy, "[U]Mass would pay the co-inventors a percentage of all revenue realized by [U]Mass through exploitation of that invention . . . to be shared equally between inventors." Am. Compl. ¶ 30. Mr. Ali has also provided a new exhibit to support his assertion: a heavily redacted e-mail from his former attorney, stating that "under UMass policy the University's share is distributed 30% to the inventors pro rata." May 2014 e-mail, Pl.'s Ex. 1, ECF No. 85. On these facts, Mr. Ali argues, it would make no difference financially to UMass if he were named a co-inventor and the university's proceeds were divided among four inventors instead of three. *See id.* at 2–4.

In opposition, Carnegie argues that Mr. Ali's assertion that UMass would not be affected financially if he were named a co-inventor is contradicted by his own pleadings. Def.'s Opp'n at 4. Additionally,

Carnegie contends that Mr. Ali fundamentally misunderstands the Court's decision, which did not depend on potential financial prejudice to UMass, but rather considered such prejudice as one of many factors weighing in favor of finding UMass a necessary party. Def.'s Opp'n at 4–7.

As an initial matter, Rules 54(b), 59(e), and 60(b) would each allow this Court to reconsider a decision premised on factual error. *See Second Chance Body Armor, Inc.*, 893 F. Supp. 2d at 268 (holding that reconsideration under Rule 54(b) may be warranted when a court has “patently misunderstood the parties” or “made an error in failing to consider . . . data”); *Ciralsky*, 355 F.3d at 671 (holding that relief under Rule 59(e) “need not be granted unless the district court finds there is . . . a clear error” of fact or law); *United Bhd. of Carpenters & Joiners of Am. v. Operative Plasterers' & Cement Masons' Int'l Ass'n of U.S. & Canada*, 721 F.3d 678, 690 (D.C. Cir. 2013) (finding that district court did not abuse its discretion in granting reconsideration under Rule 60(b)(1) when its decision “turned . . . on [its] mistaken understanding of the record”). In this instance, however, Mr. Ali has failed to show that the Court's decision was affected by any factual error, clear or otherwise.

First, the e-mail from Mr. Ali's attorney that he has attached to his motion shows that it was received by Mr. Ali months before this Court ruled on Carnegie's motion to dismiss. *See* May 2014 e-mail, Pl.'s Ex. 1. The fact that Mr. Ali chose not to provide that document to the Court previously does not mean that it constitutes “new evidence that was not previously available” or

“newly discovered evidence” that would support a motion for reconsideration. *See, e.g., Bain v. MJJ Prods., Inc.*, 751 F.3d 642, 649 (D.C. Cir. 2014) (affirming denial of motion for reconsideration where “newly discovered” evidence was known to plaintiff prior to entry of judgment and plaintiff offered “no justification” for his failure to mention it to the court); *Lans v. Gateway 2000, Inc.*, 110 F. Supp. 2d 1, 5 (D.D.C. 2000) (“[E]vidence in the possession of the party before the judgment was rendered . . . is not newly discovered evidence that affords relief.”) (internal quotation marks omitted); *Stewart v. Panetta*, 826 F. Supp. 2d 176, 177 (D.D.C. 2011) (explaining that reconsideration under Rule 54 may be premised on the “discovery of new evidence *not previously available*”) (emphasis added). Nor can the Court’s failure to consider evidence not before it constitute error. More to the point, however, the e-mail provides no new material facts.

The e-mail from Mr. Ali’s attorney explains that under UMass policy, a percentage of the university’s patent-related income is distributed “to the inventors pro rata.” May 2014 e-mail, Pl.’s Ex. 1. But in its prior decision, this Court expressly considered—indeed, quoted twice verbatim—Mr. Ali’s factual allegation that UMass policy “would pay the co-inventors [who assigned their rights to the university] a percentage of all revenue realized by UMass through exploitation of that invention . . . to be shared equally between inventors.” *See Ali*, 2014 WL 4260995, at *1, *5 (quoting Am. Compl. ¶ 30)). And while Mr. Ali argues that this fact makes the Court’s subsequent finding of financial prejudice to UMass clearly erroneous, his argument rests on a misreading of the Court’s analysis.

Mr. Ali contends that if he is found to have assigned his rights, his “*prospective* addition as a co-inventor” would not prejudice UMass financially because the amount the university pays to its inventors is fixed and would not change. Pl.’s Mot. Recons. at 2–3. That may well be true. But the Court did not assume that the total percentage paid to co-inventors at UMass would increase simply because another co-inventor may be added to the patent. Instead, the financial prejudice to UMass that concerned this Court stemmed from Mr. Ali’s claim for damages, wherein he seeks not only to be included in future payouts but also to be compensated by UMass for several years of unpaid royalties. Put another way, the Court’s finding of financial prejudice stemmed not from the mathematical operation of UMass policy, but from Mr. Ali’s claim for damages premised on the alleged violation of that policy.

As the Court explained, in addition to alleging a right to be recognized as a co-inventor and a contractual right to receive a percent of patent-related revenues, Mr. Ali “also seeks damages from UMass,” *Ali*, 2014 WL 4260995, at *3, and he “alleges that he ‘is entitled to a portion of all proceeds realized by [U]Mass as a consequence of . . . any and all of the Patents.’” *Id.* at *1 (quoting Am. Compl. ¶ 30). Far from making a limited request for prospective relief, Mr. Ali asserted entitlement to “a portion of all proceeds realized by [U]Mass,” Am. Compl. ¶ 31, or if he did not assign his rights to UMass, “to recover from [U]Mass and Carnegie a portion of the moneys they have secured” from the patents in question, *id.* at ¶ 36. If the latter, Mr. Ali has acknowledged, “then he will be able to assign or license his right, title, and interest in the patents-in-suit without encumbrance from UMass . . .

[so] Ali's inventorship stake could thus potentially damage the value of both Carnegie's and UMass'[s] licenses and the licensing income they generate." Pl.'s Opp'n Mot. to Dismiss at 23, ECF No. 75. It is thus clear from Mr. Ali's own allegations and arguments that if he were to succeed in this suit, it would prejudice the financial interests of the absent sovereign, UMass.

Undaunted, Mr. Ali suggests that his success in this matter need not harm UMass financially because the Court could fashion relief that would require the other UMass co-inventors to compensate him instead of UMass. Pl.'s Mot. Recons. at 4–5. He notes that "it is the UMass-affiliated co-inventors . . . who have been siphoning off Ali's shares of the proceeds," so the Court "could compel the said co-inventors to pay back Ali's share of the proceeds to him," or "fashion a judgment in which Ali would be entitled to a bigger share of the portion of money distributed among the UMass-affiliated co-inventors." *Id.* As Carnegie correctly notes, however, Mr. Ali's proposed alternatives would require this Court either to order non-party UMass to restructure its reimbursement contracts so that Mr. Ali could receive a greater share of future payouts, or to order the non-party co-inventors to pay money damages to Mr. Ali. *See* Def.'s Opp'n at 10–11. This Court, however, lacks the authority to issue a judgment that would bind a non-party. *See Taylor v. Sturgell*, 553 U.S. 880, 893 (2008) ("[O]ne is not bound by a judgment *in personam* in a litigation in which he is not designated as a party or to which he has not been made a party by service of process.") (internal quotation marks omitted); *Provident Tradesmens Bank & Trust Co. v. Patterson*, 390 U.S. 102, 110 (1968) ("Of course, since the outsider

is not before the court, he cannot be bound by the judgment rendered.”); *see also* Charles Alan Wright & Arthur R. Miller, *et al.*, 7 Fed. Prac. & Proc. Civ. § 1608 (3d ed.) (explaining that under Rule 19(b), courts should attempt to “promote judicial economy by avoiding going forward with actions in which the court may end up rendering hollow or incomplete relief because of the inability to bind persons who could not be joined”).

Moreover, even if Mr. Ali’s alternative proposals were a viable means of shaping relief to avoid prejudice to UMass, they would nevertheless fail to warrant reconsideration of this Court’s judgment because such arguments could have been, but were not, presented to the Court prior to the entry of judgment. *See Kittner v. Gates*, 783 F. Supp. 2d 170, 173 (D.D.C. 2011) (deeming waived an argument that plaintiff could have but did not include “in her briefing on Defendants’ Motion to Dismiss,” because “a motion for reconsideration may not . . . be used to raise arguments or defenses that could have been advanced during the original proceeding”). When opposing Carnegie’s motion to dismiss for failure to join UMass, Mr. Ali addressed each factor under Rule 19(b), including the second factor, which requires a court to consider whether “prejudice could be lessened or avoided by . . . shaping the relief.” Fed. R. Civ. P. 19(b)(2). The entirety of Mr. Ali’s argument on the subject consisted of a two-sentence assertion that this matter involves no prejudice, so “the second factor carries ‘little weight’ in balancing the Rule 19(b) factors with respect to Carnegie’s Rule 12(b)(7) motion.” Pl.’s Opp’n at 28. Far from arguing in favor of the means of shaping relief that he now proposes, Mr. Ali actually argued that the

Court should give little attention to the possibility of shaping the requested relief to avoid prejudice.

This strategic choice cannot be undone via a motion for reconsideration. Rule 60(b) does not provide “an opportunity for unsuccessful litigants to take a mulligan.” *Kramer v. Gates*, 481 F.3d 788, 792 (D.C. Cir. 2007); *Mcmanus v. District of Columbia*, 545 F. Supp. 2d 129, 134 (D.D.C. 2008) (“Although they might have, Plaintiffs did not make this argument in response to [defendant’s] motion for sanctions, and their belated attempt to challenge the Court’s grant of sanctions on this ground is therefore improper. Rule 60(b) may not be relied upon to rescue Plaintiffs from their poor strategic choices.”). And Rules 54 and 59 likewise do not afford reconsideration on the basis of arguments that could have been, but were not, previously presented to the court. *Paleteria La Michoacana, Inc. v. Productos Lacteos Tocumbo S.A. De C.V.*, No. CV 11-1623 (RC), 2015 WL 456400, at *8 (D.D.C. Feb. 3, 2015) (“[I]t is well established in this Circuit that motions for reconsideration, whatever their procedural underpinnings, cannot be used as a vehicle for presenting theories or arguments that could have been advanced earlier.”) (internal quotation marks omitted); *Fresh Kist Produce, LLC v. Choi Corp.*, 251 F. Supp. 2d 138, 140 (D.D.C. 2003) (“[A] Rule 59(e) motion to reconsider is not simply an opportunity to reargue facts and theories upon which a court has already ruled, nor is it a vehicle for presenting theories and arguments that could have been advanced earlier.”) (internal quotation marks and citations omitted). In short, Mr. Ali cannot utilize his motion for reconsideration to take a second bite at the proverbial

apple, and his new arguments pertaining to the possibility of shaping relief are therefore unavailing.

As a final matter, the Court observes that even if Mr. Ali's claim of factual error had merit, and even if the Court could fashion relief at the financial expense of non-parties, Mr. Ali has still failed to establish a basis for reconsideration of the Court's finding that the case could not proceed without UMass, because financial prejudice to UMass was only one factor in the Court's analysis, and a secondary one at that. As explained in the prior Memorandum Opinion, UMass faced not only financial prejudice if Mr. Ali prevailed on his assignment-based damages claims, but also potential impairment of its ownership interests in the patents in question if he prevailed solely on his correction of inventorship claim. *Ali*, 2014 WL 4260995, at *3 (explaining that "UMass is a necessary party because it is a co-owner of the patents, and its interests would be highly prejudiced in its absence, even if the Court could afford partial relief to Plaintiff as to inventorship"). Moreover, the Court repeatedly emphasized that when determining whether the action should proceed without UMass, "sovereign immunity reigns supreme in the analysis." *Id.* at *4; *see also Republic of Philippines v. Pimentel*, 553 U.S. 851, 867 (2008) (holding that "where sovereign immunity is asserted, and the claims of the sovereign are not frivolous, dismissal of the action *must* be ordered where there is a potential for injury to the interests of the absent sovereign") (emphasis added). And although the Court detailed the potential financial prejudice to UMass posed by Mr. Ali's claims for damages, it did so in the context of explaining that it would be unfair to force Carnegie to defend this suit alone when, in fact,

Mr. Ali's claims derive from his period of employment with UMass, implicate a potential contract with UMass, and do not include allegations that would allow him to recover money damages from Carnegie. *Id.* at *5.

In other words, it was not only the financial prejudice to an absent sovereign that governed the Court's Rule 19 analysis, but also the likely prejudice to UMass's patent-ownership interests and to Carnegie if it was forced to defend the suit alone despite the fact that "UMass's relationship with Plaintiff is much more central to the case than Carnegie's." *Id.* (explaining that "it would be highly prejudicial to Carnegie to force it to vigorously defend a suit and pay attorney's fees in a case" where the plaintiff alleged that he was entitled to money damages exclusively from a non-party); see also Op. & Order at 6 ("Ali alleges that he has an agreement with UMass, but he does not allege any separate agreement that would entitle him to a financial benefit from Carnegie. Therefore, if Ali is named a co-inventor of some or all of the patents-in-suit and he is entitled to compensation from UMass, Ali cannot receive that compensation in this suit unless UMass is a party-defendant."). Mr. Ali's arguments are simply insufficient to disturb this Court's finding that, in light of the many factors bearing on the decision of whether UMass is a necessary party,⁴ the case could

⁴ The decision of whether to proceed without a required party "must be based on factors varying with the different cases, some such factors being substantive, some procedural, some compelling by themselves, and some subject to balancing against opposing interests." *Republic of Philippines v. Pimentel*, 553 U.S. 851, 863 (2008) (quoting *Provident Tradesmens Bank & Trust Co. v.*

not in equity and good conscience proceed without UMass.

C. The Availability of an Alternative Forum

Mr. Ali's final argument in favor of reconsideration asserts that the Court should have rejected Carnegie's position that Mr. Ali had access to an alternative forum in the Massachusetts state courts. While acknowledging that the Court's treatment of the fourth Rule 19(b) factor was "largely neutral," Mr. Ali nevertheless contends that the Court should have rejected Carnegie's alternative forum proposal as unworkable and implausible. Pl.'s Mot. Recons. at 5. Though the precise contours of Mr. Ali's argument are less than clear, it appears that he takes issue with the Court's apparent acceptance of Carnegie's argument that he should be required to go to state court to vindicate his claims when state court judges are incapable of correcting the inventorship of an issued patent. *See id.* at 5–6. If the Court had properly rejected Carnegie's argument and recognized that Mr. Ali had no alternative forum available to him, he reasons, the Court may have found that this case could proceed without UMass.

There are two major flaws in Mr. Ali's argument. First and foremost, his argument that no alternative forum is available to him was fully briefed in his

Patterson, 390 U.S. 102, 119 (1968)). The factors are not rigid, and "the district court has substantial discretion in considering which factors to weigh and how heavily to emphasize certain considerations in deciding whether the action should go forward." *Kickapoo Tribe of Indians of Kickapoo Reservation in Kansas v. Babbitt*, 43 F.3d 1491, 1495 (D.C. Cir. 1995).

opposition to Carnegie's motion to dismiss, *see* Pl.'s Opp'n at 30–32, and duly considered in this Court's prior Memorandum Opinion, *Ali*, 2014 WL 4260995, at *8. Mr. Ali's argument for reconsideration does nothing more than repeat those same arguments previously considered by the Court, and as such, it provides no basis for reconsideration. *Capitol Sprinkler*, 630 F.3d at 226–27 (district courts act within the scope of their discretion in denying “reconsideration” under Rule 54(b) where the motion raises no arguments not already rejected on the merits); *State of N.Y. v. United States*, 880 F. Supp. 37, 38 (D.D.C. 1995) (“A Rule 59(e) motion to reconsider is not simply an opportunity to reargue facts and theories upon which a court has already ruled.”); *Hampton v. Vilsack*, 791 F. Supp. 2d 163, 166 (D.D.C. 2011) (denying reconsideration under 60(b) where “Plaintiff's instant motion merely repeats his prior arguments on this point,” because “[a] motion for reconsideration is not simply an opportunity to reargue facts and theories upon which a court has already ruled”) (internal quotation marks omitted).

Second, Mr. Ali mischaracterizes the Court's analysis. The Court did not “accept” Carnegie's assertion of an available alternative forum for Mr. Ali's claims. In actuality, the Court said that “[t]here may or may not be an alternative forum for Plaintiff's claims,” that the factor was “inconclusive,” and that “it is unclear whether he can sue UMass in state court for damages, and/or whether the statute of limitations has run on his state law claims.” *Ali*, 2014 WL 4260995, at *8. The Court explained, however, that even if Mr. Ali had no alternative forum and no other remedy available for his claims, that was not enough “to persuade the Court that dismissal was no longer

warranted,” given “the weighty competing interest of preserving . . . sovereign immunity.” *Id.* at *18, *19 n.13. In short, the Court expressly foreclosed the possibility that the lack of an alternative forum would alter the Court’s decision that this action could not proceed in equity and good conscience without UMass. There is thus no merit to Mr. Ali’s contention that such a finding would have changed the Court’s decision.

In sum, Mr. Ali’s motion provides no basis for reconsidering the dismissal of his complaint for failure to join a necessary party, and his request for reconsideration is therefore denied.⁵

⁵ Mr. Ali’s motion includes a footnote that appears to invoke the possibility of a due process issue under the 14th Amendment. *See* Pl.’s Mot. Recons. at 3 n.5. The footnote concludes, however, by observing that for the purpose of this case, “this Court doesn’t need to go there and or entertain that possibility.” *Id.* The Court takes Mr. Ali at his word and declines to address an unnecessary constitutional question, the nature of which is not clearly identified in Mr. Ali’s motion.

**D. Request for Leave to File
Second Amended Complaint⁶**

In the conclusion section of Mr. Ali's motion for reconsideration, he includes an alternative request for relief in the form of leave "to remedy his amended complaint to address the concern of this Court, for example by re-amending his complaint back to the original complaint in which ONLY Carnegie was named as a defendant." Pl.'s Mot. Recons. at 9–10.

Typically, leave to amend a complaint "shall be given freely when justice so requires." *See* Fed R. Civ. P. 15(a). In deciding whether to allow a party to amend a complaint, courts may consider "undue delay, bad faith or dilatory motive on the part of the movant, repeated failure to cure deficiencies by amendments

⁶ If this Court's Order of dismissal constitutes a final judgment subject to reconsideration under Rule 59(e) or 60(b), then Mr. Ali's request for leave to amend must be denied outright given that his motion for reconsideration has been denied. Once a final judgment has been entered, a court cannot permit an amendment unless the plaintiff first satisfies" the "more stringent standard[s]" of Rule 59(e) or Rule 60(b). *See Ciralsky v. CIA*, 355 F.3d 661, 673 (holding that district court properly concluded that plaintiff's motion to amend his complaint was moot because reconsideration of dismissal without prejudice was not warranted); *see also W. Wood Preservers Inst. v. McHugh*, 292 F.R.D. 145, 147 (D.D.C. 2013) ("It is well established that 'where a district court is presented with a motion for leave to amend following a dismissal, the court considers the motion for leave to amend only after consideration of a party's motion to amend or alter the dismissal.'" (quoting *DeGeorge v. United States*, 521 F.Supp.2d 35, 40–41 (D.D.C. 2007))). For the purpose of analyzing Mr. Ali's request for leave to amend, the Court thus assumes without deciding that the Court's order of dismissal did not constitute a final judgment and that Mr. Ali's motion for reconsideration was brought pursuant to Rule 54(b).

previously allowed, undue prejudice to the opposing party by virtue of allowance of the amendment, futility of amendment, etc.” *Foman v. Davis*, 371 U.S. 178, 182 (1962). “An amended complaint is futile if it merely restates the same facts as the original complaint in different terms, reasserts a claim on which the court previously ruled, fails to state a legal theory or could not withstand a motion to dismiss.” *Robinson v. Detroit News, Inc.*, 211 F. Supp. 2d 101, 114 (D.D.C. 2002). Additionally, request for leave to amend may be denied if a plaintiff fails to comply with Local Rule 15.1, which dictates that a motion for leave to amend “shall be accompanied by an original of the proposed pleading as amended.” Local Rule 15.1; *see also Johnson v. District of Columbia*, 49 F. Supp. 3d 115, 122 (D.D.C. 2014) (denying leave to amend due to plaintiff’s failure to attach her proposed amended complaint); *Belizan v. Hershon*, 434 F.3d 579, 583 (D.C. Cir. 2006) (affirming denial of oral motion for leave to amend for failure to comply with Rule 15(a) and Local Rule 15.1).

In this case, Mr. Ali’s general request for leave to amend in an unspecified manner is insufficient to satisfy the requirements of Rule 15(a). *See U.S. ex rel. Williams v. Martin-Baker Aircraft Co.*, 389 F.3d 1251, 1259 (D.C. Cir. 2004) (holding that dismissal of complaint with prejudice was appropriate given plaintiff’s “failure to articulate to the district court anything more than a bare request to amend his complaint,” and explaining that a request for leave to amend “without any indication of the particular grounds on which amendment is sought—does not constitute a motion within the contemplation of Rule 15(a)”). In addition, his one-sentence request for leave to file a second amended complaint, unaccompanied by

any such proposed pleading, fails to comply with Local Rule 15.1. Given that this Court cannot review Mr. Ali's proposed second amended complaint and has no way to assess the merits of his "bare request to amend," and in light of his failure to comply with Rule 15(a) and Local Rule 15.1, his general request for leave to amend must be denied.

Even if this Court were inclined to interpret Mr. Ali's suggestion that he might re-instate his first complaint as a request for leave to do the same, a grant of leave to amend would still be inappropriate. Mr. Ali has offered no argument whatsoever as to how reinstating the first complaint—which is premised on substantially the same factual allegations and once again would have Carnegie as the sole defendant opposing Mr. Ali's claims to correct inventorship and for related damages—would affect this Court's decision that UMass is a necessary party without which this case must not proceed. *See Greggs v. Autism Speaks, Inc.*, 987 F. Supp. 2d 51, 54 (D.D.C. 2014) (explaining that a court may deny a motion to amend if such amendment would be futile, for example, if it "merely restates the same facts as the original complaint in different terms, reasserts a claim on which the court previously ruled, fails to state a legal theory or could not withstand a motion to dismiss" (quoting *Robinson*, 211 F. Supp. 2d at 114)).

Additionally, such an amendment exceeds the limited scope of leave to amend set forth in the Court's Order, which constrained Mr. Ali to seeking leave "to name UMass officials in their official capacities," and instructed him that if he wished to do so, he must "address whether this Court would have personal

jurisdiction over these officials.” Order, Aug. 29, 2014, ECF No. 78. Mr. Ali has not argued that this Court’s prior grant of leave was too narrow or otherwise explained his disregard for the limitations of the Court’s August 2014 Order. Instead, he has declined to seek leave to amend in the manner permitted by both this Court and by the Oregon District Court, and the deadline for such an amendment has long since come and gone. *See* Order, Sept. 19, 2014, ECF No. 84 (giving Mr. Ali until November 14, 2014 to seek leave to file a second amended complaint); *see also Foman v. Davis*, 371 U.S. 178, 182 (1962) (citing “undue delay” and “repeated failure to cure deficiencies by amendments previously allowed” as reasons for which a court might deny leave to amend).

The Court therefore denies Mr. Ali’s request for leave to amend his complaint.

IV. CONCLUSION

For the foregoing reasons, Mr. Ali’s motion for leave to file a supplemental statement regarding the filing date of his motion for reconsideration is **GRANTED**, his alternative request for leave to file *nunc pro tunc* is **DENIED**, and his motion for reconsideration or, in the alternative, to amend his complaint is **DENIED**. An order consistent with this Memorandum Opinion is separately and contemporaneously issued.

Dated: June 26, 2015

RUDOLPH CONTRERAS
United States District Judge

**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA**

Civil Action No.: 13-2030 (RC)

[Filed June 26, 2015]

MUSSA ALI,)
Plaintiff,)
)
v.)
)
CARNEGIE INSTITUTION OF)
WASHINGTON,)
Defendant.)

Re Document Nos.: 85, 88

ORDER

**GRANTING PLAINTIFF’S MOTION FOR LEAVE TO FILE
SUPPLEMENTAL STATEMENT REGARDING FILING
DATE, DENYING PLAINTIFF’S ALTERNATIVE
REQUEST TO FILE *NUNC PRO TUNC*, & DENYING
PLAINTIFF’S MOTION FOR RECONSIDERATION OR TO
AMEND COMPLAINT**

For the reasons stated in the Court’s Memorandum Opinion separately and contemporaneously issued, Plaintiff’s motion for leave to file a supplemental statement regarding the date of filing (ECF No. 88) is **GRANTED**, his alternative request for leave to file *nunc pro tunc* is **DENIED** (ECF No. 88), and his motion for reconsideration or, in the alternative, to file a second amended complaint (ECF No. 85) is **DENIED**. This case is dismissed in its entirety.

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This is a final, appealable order.

SO ORDERED.

Dated: June 26, 2015

RUDOLPH CONTRERAS
United States District Judge

APPENDIX D

**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA**

Civil Action No.: 13-2030 (RC)

[Filed August 29, 2014]

MUSSA ALI,)
Plaintiff,)
)
v.)
)
CARNEGIE INSTITUTION OF)
WASHINGTON,)
Defendant.)

Re Document No.: 73

MEMORANDUM OPINION

GRANTING CARNEGIE'S MOTION TO DISMISS

I. INTRODUCTION

The present action arises out of the Plaintiff's claim that he was erroneously omitted as an inventor on five U.S. patents co-owned by the Defendant, the Carnegie Institution of Washington ("Carnegie") and the University of Massachusetts ("UMass"), originally brought in the U.S. District Court for the District of Oregon. The Oregon court transferred the action to this Court pursuant to 28 U.S.C. § 1406(a). Carnegie now moves to dismiss the Plaintiff's Amended Complaint

under Federal Rule of Civil Procedure 12(b)(7), for failure to join a necessary party, or in the alternative, under Federal Rule of Civil Procedure 12(b)(6) for failure to state a claim. For the following reasons, the Court grants Carnegie's motion to dismiss under Rule 12(b)(7).

II. FACTUAL BACKGROUND

Plaintiff Mussa Ali seeks, pursuant to 35 U.S.C. § 256 (“§ 256”), to correct the inventorship on five U.S. patents.¹ Am. Compl. ¶ 1, ECF No. 4. Carnegie and UMass are co-owners, by assignment, of the patents at issue. *Id.* ¶¶ 3–4. The patents were allegedly issued as a result of the collaboration between Dr. Andrew Fire and Dr. Craig C. Mello, the two lead inventors of the laboratories of Carnegie and UMass, respectively. *See* Def.'s Mot. Dismiss 4, ECF No. 73-1. The patents claim methods of inhibiting the expression of a particular gene in a cell through the introduction of a double stranded ribonucleic acid (“RNA”) molecule. Am. Compl. ¶ 19. As a result of the discovery of this process, called RNA interference (“RNAi”), the two lead inventors were awarded the Nobel Prize in Medicine in 2006. *See* Def.'s Mot. Dismiss 1.

The Plaintiff alleges that he made a critical contribution to the discovery of RNAi, which is central to the claims in each of the patents, while working at UMass in Dr. Mello's laboratory, and that Dr. Mello then shared his discovery with Dr. Fire. *See* Am. Compl. ¶¶ 8–20; *see also* Pl.'s Opp'n Mot. 3, ECF

¹ U.S. Patent Nos. 6,506,559, 7,538,095, 7,560,438, 7,622,633, and 8,283,329. *See* Am. Compl. ¶ 3, ECF No. 4.

No. 75. The Plaintiff subsequently approached Carnegie and UMass on numerous occasions seeking to be named a co-inventor. *Id.* When those attempts failed, the Plaintiff filed his original complaint and his Amended Complaint against Carnegie and UMass in the U.S. District Court for the District of Oregon in September and December 2012, respectively. *See generally* Compl., ECF No. 1; Am. Compl., ECF No. 4.

In his Amended Complaint, the Plaintiff asserted a claim to be named a co-inventor of the patents at issue under § 256 and two alternative claims for damages for the revenue derived from the patents, proceeds he alleges he is owed as a result of his role in the discovery of RNAi. *See* Am. Compl. Counts 1, 2, and Alternative Count 2. Ali's alternative counts are titled "Legal Damages." In Count 2 for Legal Damages, Ali alleges that "[o]n information and belief, during the time of Ali's work at [U]Mass, [U]Mass had a policy that all [U]Mass employees making inventions assigned, or had an obligation to assign, those inventions and all rights thereto, to [U]Mass. In consideration of that assignment, [U]Mass would pay the co-inventors a percentage of all revenue realized by [U]Mass through exploitation of that invention, including licensing, to be shared equally between investors." Am. Compl. ¶ 30. Ali further alleges that he "is entitled to a portion of all proceeds realized by [U]Mass as a consequence of any sale, licensing, enforcement or threatened enforcement of any and all of the Patents" *Id.* ¶ 31. In Alternative Count 2, Ali alleges that "[o]n information and belief, [U]Mass and Carnegie have secured substantial fees by reason of selling, licensing, or otherwise transferring their rights in and to the Patents to third parties," and that

as such, “Ali is entitled to recover from [U]Mass and Carnegie a portion of moneys they have secured by reason of selling, licensing, or otherwise transferring their rights in and to the Patents to third parties, as a reasonable measure of the moneys Ali would have been entitled to recover if properly named as a co-inventor from the filing date.” *See* Am. Compl. ¶¶ 35–36.

In two separate sets of opinions and orders, the District Court of Oregon first dismissed UMass from the case on the basis of sovereign immunity and then ruled that the court lacked personal jurisdiction over Carnegie. *See* Op. & Order, ECF No. 41; Op. & Order, ECF No. 66. After the Oregon court transferred the case *sua sponte* to this Court pursuant to 28 U.S.C. § 1406(a), the Defendant moved to dismiss the case for failure to join a necessary party—UMass—or, in the alternative to dismiss or strike the Plaintiff’s two alternative claims for damages. *See* Def.’s Mot. Dismiss 1–3.² Because the Court finds that UMass is a necessary party that must, but cannot be joined, and that the action cannot “in equity and good conscience” continue absent UMass, the Court will grant Carnegie’s motion to dismiss under Federal Rule of Civil Procedure 12(b)(7).

² Carnegie also moved to dismiss under Federal Rule of Civil Procedure 12(b)(7) while this action was pending before the Oregon court. *See* ECF No. 19. But the Oregon court deferred ruling on that motion because of the impending transfer to this Court. *See* Op. & Order 25, ECF No. 66.

III. ANALYSIS

Carnegie first argues that the case should be dismissed in its entirety under Federal Rule of Civil Procedure 12(b)(7) because UMass must, but cannot, be joined. Specifically, Carnegie contends that UMass is a required party under Rule 19(a), but that UMass's sovereign immunity precludes its joinder, effectively barring the Plaintiff's claims. Thus, according to the Defendant, the complaint must be dismissed under Rule 19(b) because the case cannot proceed "in equity and good conscience" in UMass's absence. Plaintiff meanwhile argues that UMass is not a necessary party under Rule 19(a), but that even if it were, it is not required to be joined under Rule 19(b).³ The Court finds that UMass is a necessary party under Rule 19(a) and required to be joined under Rule 19(b), and as such, the case must be dismissed for failure to join UMass.

A. Legal Standard

Federal Rule of Civil Procedure 12(b)(7) provides for the dismissal of a complaint for "failure to join a party under Rule 19." FED. R. CIV. P. 12(b)(7). Dismissal under Rule 12(b)(7) is "warranted only when the defect is serious and cannot be cured." *Direct Supply, Inc. v. Specialty Hospitals of America, LLC*, 878 F. Supp. 2d

³ Prior versions of Federal Rule of Civil Procedure 19 used the word "indispensable" in 19(b). In 2007, that word was "discarded as redundant." See FED. R. CIV. P. 19 advisory committee's note; see also *Republic of Philippines v. Pimentel*, 553 U.S. 851, 856 (2008) ("[T]he word 'indispensable,' which had remained as a remnant of the pre-1966 Rule, is altogether deleted from the current text. Though the word 'indispensable' had a lesser place in the 1966 Rule, it still had the latent potential to mislead.").

13, 23 (D.D.C. 2012) (citations omitted). For the purposes of a Rule 12(b)(7) motion, the court must accept the complaint's allegations as true, and may also consider matters outside the pleadings when determining whether Rule 19 requires that a party be joined. *Id.* The burden is on the defendant seeking dismissal for failure to name an absent person to show "the nature of the interest possessed by an absent party and that the protection of that interest will be impaired by the absence." *Citadel Inv. Group, L.L.C. v. Citadel Capital Co.*, 699 F. Supp. 2d 303, 317 (D.D.C. 2010) (citations omitted).

Federal Rule of Civil Procedure 19 establishes a three-step procedure for determining whether an action must be dismissed because of the absence of a party required for a just adjudication: the court must determine (1) whether the absent party is "required" for the litigation according to the factors enumerated in Rule 19(a); (2) whether the required party can be joined; and (3) if joinder is not feasible, whether the action can nevertheless proceed in "equity and good conscience" under Rule 19(b). *See OAO Healthcare Solutions, Inc. v. Nat'l Alliance of Postal & Fed. Emps.*, 394 F. Supp. 2d 16, 19 (D.D.C. 2005); *see also Kickapoo Tribe of Indians of Kickapoo Reservation in Kansas v. Babbitt*, 43 F.3d 1491, 1494 (D.C. Cir. 1995) (Citing FED. R. CIV. P. 19). Multiple factors bear on the decision whether to proceed without a required person, such that the decision "must be based on factors varying with the different cases, some such factors being substantive, some procedural, some compelling by themselves, and some subject to balancing against opposing interests." *Republic of Philippines v. Pimentel*, 553 U.S. 851, 863 (2008) (quoting *Provident*

Tradesmens Bank & Trust Co. v. Patterson, 390 U.S. 102, 119 (1968)). With these principles in mind, the Court now turns to whether the case should be dismissed under Rule 19's three-step test.

B. UMass is a Required Party Under Rule 19(a)

Under the first step in the Rule 19 analysis, the Court must determine whether UMass is a required party in the instant action. Pursuant to Rule 19(a), a party is to be joined if feasible if (1) the court cannot accord complete relief among existing parties; (2) the party's absence may, as a practical matter, impair or impede that party's ability to protect its interest; or (3) the party's absence may subject the existing parties to substantial risk of incurring multiple or otherwise inconsistent obligations. *See* FED. R. CIV. P. 19(a)(1).

Due to UMass's ownership interest in the patents whose inventorship the Plaintiff now challenges, the Court finds that UMass is a required party that must be joined if feasible. UMass and Carnegie are co-owners of the patents. *See* Am. Compl. ¶¶ 3–4. UMass's ability to protect its interests in the patents could be impaired or impeded in its absence. While there is no per se rule that patent owners are required parties in a suit challenging inventorship, the Federal Circuit has commented that there are several cases that "strongly support the conclusion that patent owners are required to be joined if feasible under Rule 19(a)," even though those cases "deal with standing to bring suit, not with indispensability under Rule 19(b)." *Univ. of Utah v. Max-Planck-Gesellschaft Zur Forderung Der Wissenschaften E.V.* ("*Univ. of Utah*"), 734 F.3d 1315, 1326 (Fed. Cir. 2013); *see also Delano Farms Co. v. California Table Grape Com'n*, 655 F.3d 1337, 1342

(Fed. Cir. 2011) (“It is well established that a patentee is a necessary party to an action on the patent, whether it be a coercive action or a declaratory judgment suit.”); *Aspex Eyewear, Inc. v. Miracle Optics, Inc.*, 434 F.3d 1336, 1344 (Fed. Cir. 2006) (“For the same policy reasons that a patentee must be joined in any lawsuit involving his or her patent, there must be joinder of any exclusive licensee.”); *Berry Floor USA, Inc. v. Faus Group, Inc.*, No. 08-0044, 2008 WL 4610313, at *3 (E.D. Wisc. Oct. 15, 2008) (“A patent owner should be viewed as a necessary party if it retains ‘any interest’ in the patent.”) (citing *Erbamont Inc. v. Cetus Corp.*, 720 F. Supp. 387, 393 (D. Del. 1989)).

As to the ability to accord complete relief absent UMass, Carnegie contends that the Court cannot accord complete relief among the existing parties because Carnegie would not be under any obligation to compensate the Plaintiff for his damages claims, as there is no contractual agreement between Carnegie and the Plaintiff. Financial compensation, however, is not the only relief that the Plaintiff requests: in the first count of his Amended Complaint, the Plaintiff seeks a correction of inventorship pursuant to § 256. Am. Compl. Count 1. If the Plaintiff were to succeed on this claim, “an order from the district court to the Director of the [United States Patent and Trademark Office] to issue a certificate naming [the Plaintiff] as an inventor,” *Chou v. Univ. of Chicago*, 254 F.3d 1347, 1359 (Fed. Cir. 2001), would provide the Plaintiff with complete redress as to Count I.

This finding however, does not preclude the Court from finding that UMass is still required under Rule 19(a). *See Angst v. Royal Maccabees Life Ins. Co.*, 77

F.3d 701, 705 (3d Cir. 1996) (“Notwithstanding a determination of complete relief, a party may still be [required] under subsection [(a)(1)(B)] of the rule.”). Although complete relief could be accorded—at least with respect to the Plaintiff’s claim for correction of inventorship—Plaintiff also seeks damages from UMass, and UMass’s financial interests would be highly prejudiced by Carnegie litigating a case in its absence—especially if, as Ali alleges, he had a quasi-contractual relationship with UMass wherein he was obligated to assign any “inventions and all rights thereto” to UMass in exchange for a percentage of any revenue realized by UMass. *See* Am. Compl. ¶¶ 30, 31. Because the “[e]valuation of the first Rule 19(b) factor overlaps considerably with the Rule 19(a) analysis,” the Court will address the prejudice faced by UMass more fully in its analysis of whether the case should proceed under Rule 19(b). *Capitol Medical Ctr., LLC v. Amerigroup Maryland, Inc.*, 677 F. Supp. 2d 188, 194 n. 9 (D.D.C. 2010); *see also Kickapoo*, 43 F.3d at 1497 n.9 (“The inquiry as to prejudice under Rule 19(b) is the same as the inquiry under Rule 19[(a)(1)(B)(i)] regarding whether continuing the action will impair the absent party’s ability to protect its interest.”). But for purposes of Rule 19(a), the Court finds that UMass is a necessary party because it is a co-owner of the patents, and its interests would be highly prejudiced in its absence, even if the Court could afford partial relief to Plaintiff as to inventorship. Accordingly, the Court finds that UMass is a necessary party, and next turns

to whether UMass can be joined, and if not, whether the action can proceed in its absence.⁴

C. UMass Cannot Be Joined

The second step under the Rule 19 analysis requires the Court to determine whether UMass, a required party, can be joined. While this case was pending before the District Court of Oregon, the Oregon court dismissed UMass from the case after finding that UMass was entitled to sovereign immunity under the Eleventh Amendment. See Op. & Order 10, ECF No. 41. There is vast case law support for the proposition that state universities, like UMass, are arms of the state entitled to Eleventh Amendment immunity from suit in federal court.⁵ Although Ali preserves his arguments on this issue, he does not re-argue his points before this Court. Thus, the Court does not revisit the Oregon court's conclusion that UMass is entitled to sovereign immunity, and finds

⁴ The Federal Circuit has further noted that “when a necessary patent owner is not joined, even when Rule 19(a) is satisfied, the court must still perform the inquiry under Rule 19(b) to determine whether that owner is indispensable.” See *Univ. of Utah v. Max-Planck-Gesellschaft Zur Forderung Der Wissenschaften E.V.*, 734 F.3d 1315, 1326 (Fed. Cir. 2013) (citing *Alfred E. Mann Found. for Sci. Research v. Cochlear Corp.*, 604 F.3d 1354, 1363 (Fed. Cir. 2010)).

⁵ See, e.g., *Raj v. La. State Univ.*, 714 F.3d 322, 328-329 (5th Cir. 2013); *Clissuras v. City Univ. of N.Y.*, 359 F.3d 79, 82-83 (2d Cir. 2004); *Power v. Summers*, 226 F.3d 815, 818 (7th Cir. 2000); *Cooper v. St. Cloud State Univ.*, 226 F.3d 964, 968-69 (8th Cir. 2000); accord *Bennett v. U.S. Chess Fed'n*, 468 F. Supp. 2d 79, 85 (D.D.C. 2006).

that UMass cannot be joined as a party in this case as a result.

D. The Action Cannot Proceed Without UMass

The third and final step in the Rule 19 analysis is whether “in equity and good conscience” the action should proceed in the absence of UMass or whether it should be dismissed. FED. R. CIV. P. 19(b). The nonexclusive factors for the court to consider include:

- (1) the extent to which a judgment rendered in the person’s absence might prejudice that person or the existing parties;
- (2) the extent to which any prejudice could be lessened or avoided by:
 - (A) protective provisions in the judgment;
 - (B) shaping the relief; or
 - (C) other measures;
- (3) whether a judgment rendered in the person’s absence would be adequate; and
- (4) whether the plaintiff would have an adequate remedy if the action were dismissed for nonjoinder.

FED. R. CIV. P. 19(b). These four factors are not rigid but rather “guides to the overarching ‘equity and good conscience’ determination.” *Cloverleaf Standardbred Owners v. National Bank*, 699 F.2d 1274, 1279 n.11 (D.C. Cir. 1983). Courts of appeal review a district court’s determination under Rule 19(b) for abuse of discretion. *See Kickapoo*, 43 F.3d at 1495. Rule 19(b) “calls for a pragmatic decision based on practical considerations in the context of particular litigation.” *Id.* “In that regard, the court has acknowledged that the district court has substantial discretion in considering which factors to weigh and how heavily to emphasize certain considerations in deciding whether the action should go forward.” *Id.* (citation omitted).

And “[s]ince joinder is an issue not unique to patent law,” the law of the regional circuit, in this case the D.C. Circuit, applies. *A123 Systems, Inc. v. Hydro-Quebec*, 626 F.3d 1213, 1220 (Fed. Cir. 2010); *see also Univ. of Utah*, 734 F.3d at 1320 (“Whether a party is indispensable under Rule 19(b) is a matter of regional circuit law.”).

In the D.C. Circuit, a party’s sovereign immunity is pivotal in the Rule 19 analysis. In *Kickapoo*, the court explained that “there is very little room for balancing of other factors set out in Rule 19(b) where a necessary party under Rule 19(a) is immune from suit because immunity may be viewed as one of those interests ‘compelling by themselves.’” 43 F.3d at 1496 (quoting *Wichita and Affiliated Tribes of Oklahoma v. Hodel*, 788 F.2d 765, 777 n.13 (D.C. Cir. 1986)). Specifically, the *Kickapoo* court elaborated that “notwithstanding the discretion generally accorded to the district court to consider which factors to weigh and how heavily to emphasize certain considerations, the district court [i]s confronted with a more circumscribed inquiry when it assesses[s]” whether an action could “in equity and good conscience” proceed in the absence of a party that is both necessary to and immune from the lawsuit. *Id.* at 1497 (citations omitted). Thus, in the D.C. Circuit, while the balancing of the Rule 19(b) factors is relevant and important, sovereign immunity reigns supreme in the analysis. *See also* CHARLES ALAN WRIGHT & ARTHUR MILLER, ET AL., 7 FED. PRAC. & PROC. CIV. § 1617 (3d ed.) (“No doubt because of the sovereign-immunity concept, the application of Rule 19 in cases involving the government reflects a heavy emphasis on protecting its interests.”).

This position was confirmed by the Supreme Court in *Republic of Philippines v. Pimentel*, 553 U.S. 851 (2008). In *Pimentel*, an interpleader action, the district court dismissed the Republic of the Philippines and the Philippine Presidential Commission of Good Governance (“Commission”) from the case on sovereign immunity grounds. *Id.* at 855. However, the district court allowed the case to proceed in their absence. The Republic and the Commission appealed, arguing that under Rule 19, the action should not have been allowed to continue. *Id.* The Supreme Court found that the district court and Court of Appeals had failed to give “full effect to sovereign immunity” in allowing the case to proceed, and reversed, holding that “where sovereign immunity is asserted, and the claims of the sovereign are not frivolous, dismissal of the action *must* be ordered where there is a potential for injury to the interests of the absent sovereign.” *Id.* at 867 (emphasis added). As the Court of Federal Claims recently explained, *Pimentel* “illustrates that sovereign immunity often will be compelling itself in swaying the Rule 19(b) analysis. *Pimentel* stands for the proposition that where a sovereign party should be joined in an action, but cannot be owing to sovereign immunity, the entire case must be dismissed if there is the potential for the interests of the sovereign to be injured.” *Klamath Tribe Claims Committee v. US*, 106 Fed. Cl. 87, 96 (Fed. Cl. 2012), *aff’d*, 541 F. App’x 974 (Fed. Cir. 2013). In light of those principles, the Court now turns to analyze the Rule 19(b) factors against the backdrop of UMass’s sovereign immunity.

*1. Carnegie and UMass will
be prejudiced by UMass's absence*

The Court finds that, despite Plaintiff's arguments to the contrary, Carnegie and UMass will be prejudiced by UMass's absence. Both Carnegie and UMass are currently co-owners of the patents, and the addition of the Plaintiff as a co-inventor would change both their ownership rights. Though Carnegie's interest in protecting the inventorship status of the patents aligns with UMass's, UMass's relationship with Plaintiff is much more central to the case than is Carnegie's. First, all the purported inventorship activity occurred while Plaintiff was employed at UMass, whereas Plaintiff was never employed by Carnegie. *See* Am. Compl. ¶¶ 8–18 (describing Plaintiff's relationship with Dr. Mello at UMass, and Ali being hired "pursuant to a Pew grant to [U]Mass and Mello's laboratory"). Second, Plaintiff alleges that he has a contractual, or at least quasi-contractual relationship with UMass that he does not have with Carnegie. Specifically, he alleges that UMass "had a policy that all [U]Mass employees making inventions assigned, or had an obligation to assign, those inventions and all rights thereto, to [U]Mass. In consideration of that assignment, [U]Mass would pay the co-inventors a percentage of all revenue realized by [U]Mass through exploitation of that invention, including licensing, to be shared equally between inventors." Am. Compl. ¶ 30. Meanwhile, Plaintiff alleges no relationship with Carnegie in which Plaintiff would be able to recover financial compensation from Carnegie; the Oregon court acknowledged just as much. *See* Op. & Order 6, ECF No. 66 ("Therefore, if Ali is named a co-inventor of some or all of the patents-in-suit and he is entitled to

compensation from UMass, Ali cannot receive that compensation in this suit unless UMass is a party-defendant.”). In light of this, it would be highly prejudicial to Carnegie to force it to vigorously defend a suit and pay attorney’s fees in a case that involves only a potential financial loss to UMass—a party that cannot be joined. Indeed, Carnegie has a disincentive to vigorously litigate the case to the bitter end given that only UMass’s financial liability is at stake. Carnegie may even be incentivized to settle the case early as to the § 256 inventorship claim to eliminate *its own* potential liability—which would highly prejudice the absent UMass’s ownership interest in the patents.

This is the scenario *Pimentel* cautioned against: according “insufficient weight to the likely prejudice” to the sovereign’s interest should the action proceed in its absence, especially where, as here, the sovereign’s claims are not frivolous. 553 U.S. at 869. If Ali is added as a co-inventor, and if he does have the contractual relationship with UMass he alleges he has, then UMass will likely have to share part of the revenues from the patents-in-suit with him. And such a determination would injure the financial interests of the absent sovereign. Given the weight the Court must accord to UMass’s sovereign immunity under D.C. Circuit and Supreme Court precedent, this factor weighs heavily in favor of dismissing this action because it cannot proceed “in equity or good conscience” without UMass.⁶

⁶ The Plaintiff argues that *Pimentel*, *Wichita*, and *Kickapoo* are inapposite because those cases dealt with foreign and tribal sovereign immunity, respectively, whereas UMass is protected by state sovereign immunity. *See* Pl.’s Opp’n Mot. 11–12. However, in

The Court does not find Plaintiff's analogies to *Univ. of Utah* and *Dainippon Screen Mfg. Co., Ltd v. CFMT, Inc.*, 142 F.3d 1266 (Fed. Cir. 1998), persuasive.

reaching its holding in *Pimentel* that “[a] case may not proceed when a required-entity sovereign is not amenable to suit,” the Supreme Court considered “authorities involving the intersection of joinder and the governmental immunity of the United States.” See *Pimentel*, 553 U.S. at 866–67 (citing *Mine Safety Appliances Co. v. Forrestal*, 326 U.S. 371, 373–75 (1945) (dismissing a suit where the Under Secretary of the Navy was sued in his official capacity and was required to be joined, but could not be joined because the Government withheld consent to be sued) & *Minnesota v. United States*, 305 U.S. 382, 386–88 (1939) (dismissing the action because the United States was a party required to be joined because it was the owner of the land in question but had not consented to suit)). Thus, the central inquiry is *immunity* generally—and it is less meaningful whether that immunity stems from a party’s status as a foreign sovereign, state sovereign, or tribe. Accord *Klamath Tribe Claims Committee v. US*, 106 Fed. Cl. 87, 96 (Fed. Cl. 2012), *aff’d*, 541 F. App’x 974 (Fed. Cir. 2013) (explaining that the *Pimentel* “rationale applies to domestic sovereigns, *i.e.*, States and Indian nations, as much as it does to foreign sovereigns, *e.g.*, the Philippines”); *Diaz v. Glen Plaid, LLC*, No. 7:13-cv-853(TMP), 2013 WL 5603944, at *7 (N.D. Ala. Oct. 11, 2013) (“While the University of Alabama is not a *foreign* sovereign, it is nonetheless clothed with the sovereign immunity of the State of Alabama, making its status comparable to that of the Philippines and the Commission, at least for Rule 19(b) purposes.”) (emphasis in original). The Court, then, finds *Pimentel* controlling.

And while Plaintiff is correct that Carnegie and UMass’s interests are not in conflict, as they were between the parties in *Wichita* (several Tribes) & *Kickapoo* (a Tribe and a State), nor are their interests identically aligned, as set forth above, making Plaintiff’s attempts to distinguish the cases unpersuasive. Moreover, because the D.C. Circuit has made sovereign immunity a crucial factor in the Rule 19 context, this Court is bound to do the same.

While Carnegie and UMass's ownership interests *overlap*, they are not *identical*, as they were in *Univ. of Utah* or *Dainippon*. In *Univ. of Utah*, the Federal Circuit affirmed the district court's finding that UMass's interest was adequately protected by defendants because UMass had entered into a settlement agreement wherein it "handed sole and exclusive control of this suit" to one of the named defendants in the action. 734 F.3d at 1327–1328. Indeed, the Federal Circuit acknowledged that this fact might be dispositive to the identity of interests inquiry. *Id.* at 1328 ("[I]f an unforeseeable conflict arises which negates UMass's assignment to Alnylam of sole and exclusive control over this lawsuit, UMass may be free to renew this motion.").⁷ And in *Dainippon*, the identity of interests arose out of a parent-subsidiary relationship—an identical interest, then, not just an overlapping one. *See* 142 F.3d at 1271, 1272 n.4 (finding that the subsidiary company's interests were adequately protected by the parent, because the parent owned the subsidiary in its entirety and essentially created the subsidiary for the purpose of being an

⁷ *Univ. of Utah* is also distinguishable in two other important regards. First, in that case, the court acknowledged that because the plaintiffs amended their complaint to name UMass officials, as opposed to UMass itself, there was no sovereign immunity issue. *See Univ. of Utah v. Max-Planck-Gesellschaft Zur Forderung Der Wissenschaften E.V.*, 734 F.3d 1315, 1325 (Fed. Cir. 2013). Second, because, as set forth above, the issue was procedural, the Federal Circuit applied First Circuit joinder law, which does not place as much weight on sovereign immunity as the D.C. Circuit does. *See, e.g., Katherine Florey, Making Sovereigns Indispensable: Pimentel and the Evolution of Rule 19*, 58 UCLA L. REV. 667, 683 n. 102, 686–687 (2011) (explaining that several Circuits, including the D.C. Circuit, "favor[] dismissal when the absent party is immune").

intellectual property holding company). Such identity of interests between Carnegie and UMass is lacking here.

And while here, as in *Univ. of Utah* and *Dainippon*, legal counsel jointly represents Carnegie and UMass, the Court is not persuaded that this renders Carnegie adequately able to protect UMass's interest. Rather, the Court finds persuasive Judge Moore's dissenting comment in *Univ. of Utah* that in *Dainippon*, where the court found the common counsel factor persuasive, the parties' interests were identical, not merely overlapping, because "the absent party was a wholly-owned subsidiary of the named party and was created by the named party to enforce the patents-in-suit." *See Univ. of Utah*, 734 F.3d at 1332 (Moore, J., dissenting) (citing *Dainippon*, 142 F.3d at 1267–1268). As such, the Court finds that Carnegie would not be able to adequately defend UMass's interest in this litigation, and would be unduly prejudiced by defending this case in UMass's absence.⁸ And UMass would be prejudiced

⁸ Carnegie also argues that because UMass may assert sovereign immunity against third party subpoenas, Carnegie will be prejudicially limited in its access to relevant evidence and traditional discovery mechanisms. *See* Def.'s Reply 11–13, ECF No. 76. Although there is authority supporting that contention, the Defendant has misconstrued the effect that immunity has on a sovereign's obligation to respond to a subpoena. While "Eleventh Amendment immunity entitles a state not only to protection from liability, but also from suit, including the burden of discovery, *as a party*, within the suit," *Univ. of Texas at Austin v. Vratil*, 96 F.3d 1337, 1340 (10th Cir. 1996) (emphasis added), "Eleventh Amendment sovereign immunity does not protect *non-party* state entities from responding to [third-party] discovery requests." *Arista Records LLC v. Does 1014*, No. 7:08cv205, 2008 WL

by having a case to which it is so crucially linked, and upon which its financial interests depend, proceed in its absence.

2. There is no adequate alternative to dismissal

The second factor in the Rule 19(b) analysis includes the extent to which any prejudice could be lessened or avoided by relief or measures alternative to dismissal. *See* FED. R. CIV. P. 19(b)(2). “[T]his second factor calls the court’s attention to the possibility of granting remedies other than those specifically requested that would not be merely partial or hollow but would minimize or eliminate any prejudicial effect of going forward without the absentees.” *See* CHARLES ALAN WRIGHT & ARTHUR R. MILLER, ET AL., 7 FED.

5350246, at *4 (W.D. Va. Dec. 22, 2008) (emphasis added); *see also In Re Mo. Dep’t of Natural Res.*, 105 F.3d 434, 436 (8th Cir. 1997) (“There is simply no authority for the position that the Eleventh Amendment shields government entities from discovery in federal court.”); *Allen v. Woodford*, 544 F. Supp. 2d 1074, 1078–79 (E.D. Cal. 2008) (concluding that “issuance and required compliance with a third-party subpoena by State custodians of records in an action in which the State is not a party” does not constitute “any suit in law or equity” within the meaning of the Eleventh Amendment, and thus that “the Eleventh Amendment does not apply to preclude discovery from a State agency”). The Eleventh Amendment, therefore, does not completely shield UMass from certain non-party discovery requests. *See* FED. R. CIV. P. 45, FED. R. CIV. P. 34(c). As such, UMass’s ability to participate in discovery would help assuage any prejudice faced by Carnegie in UMass’s absence as a party—as to discovery. But even still, under Rule 19(b), the Court is tasked with balancing the factors, and given the weight the Court must place on UMass’s sovereign immunity, UMass’s ability to participate in discovery does not outweigh the substantial prejudice it will incur if the case proceeds in its absence.

PRAC. & PROC. CIV. § 1608 (3d ed.). Though the parties have not entirely briefed this issue, the Plaintiff has asked for leave to amend his complaint to name UMass officials as defendants. *See* Pl.’s Opp’n Mot. 26–27 (“Ali has sought to reserve its right to file a Second Amended Complaint naming, as additional defendants, one or more UMass employees subject to this Court’s jurisdiction.”). Though this alternative may be preferable to dismissal, as to Ali’s claim for financial damages, there is no meaningful difference between naming UMass and naming state officials in their official capacities as defendants, given that doing so would only allow Ali to seek injunctive relief against the state officials under the doctrine of *Ex Parte Young*. *Ex Parte Young*, 209 U.S. 123 (1908), allows a plaintiff to bring suit against a state official in his official capacity, but is limited to claims for prospective injunctive relief only, and generally does not allow a plaintiff to seek past financial compensation from a state government. *See Edelman v. Jordan*, 415 U.S. 651, 677 (1974) (“[A] federal court’s remedial power, consistent with the Eleventh Amendment, is necessarily limited to prospective injunctive relief, and may not include a retroactive award which requires the payment of funds from the state treasury.”) (citations omitted). Thus, Plaintiff’s count for legal damages arising from his contractual relationship with UMass could not be brought against state officials in their official capacities.

As to Plaintiff’s claim for correction of inventorship, it is not clear whether naming the UMass officials as defendants would be permissible, as there is no Supreme Court, Federal Circuit, or D.C. Circuit case that directly addresses whether suing state officials in

their official capacities for correction of inventorship is permissible under *Ex Parte Young*.⁹ Given this uncertainty, and given that adding UMass officials in their official capacities as defendants would have no bearing on Plaintiff's damages claim, this factor weighs slightly in favor of dismissing *this Complaint*,¹⁰ where only UMass and Carnegie are named defendants.

⁹ In *Univ. of Utah v. Max-Planck-Gesellschaft zur Forderung der Wissenschaften E.V.*, the district court found that it had jurisdiction over the action against UMass state officials under *Ex Parte Young*. 881 F. Supp. 2d 151, 156 (D. Mass. 2012). That decision was affirmed on other grounds by the Federal Circuit, with the Circuit explaining that it need not address the *Ex Parte Young* issue because, given that the case involved a suit *by a State against State officials*, and not “a suit *by citizens* against a State, there is no sovereign immunity issue here.” *Univ. of Utah v. Max-Planck-Gesellschaft Zur Forderung Der Wissenschaften E.V.*, 734 F.3d 1315, 1323 (Fed. Cir. 2013) (emphasis added). In *Xechem Int'l, Inc. v. Univ. of Tex. M.D. Anderson Cancer Ctr.*, Judge Newman, writing to express “additional views,” “express[ed] no view as to whether *Young* offers a path to relief” on a correction of inventorship claim, but her opinion and analysis suggests that perhaps it does. 382 F.3d 1324, 1335 (Fed. Cir. 2004) (Newman, J.) (expressing “additional views”). This precise issue is neither briefed by the parties nor squarely presented in this case and the Court need not decide it now. For purposes of this prong of the analysis, given that amending his complaint to name UMass officials *may or may not* allow Ali to pursue his correction of inventorship claim *only*, and definitively would not allow him to pursue financial damages, this prong still weighs slightly in favor of dismissal of *this Complaint*.

¹⁰ Plaintiff may seek leave to file a second amended complaint, per the Order contemporaneously issued with this Memorandum Opinion.

3. The Court can only enter a partial judgment in UMass's absence

With respect to the third Rule 19(b) factor, whether a judgment rendered in the party's absence will be adequate, "[t]his consideration promotes judicial economy by avoiding going forward with actions in which the court may end up rendering hollow or incomplete relief because of the inability to bind persons who could not be joined." *See* CHARLES ALAN WRIGHT & ARTHUR R. MILLER, ET AL., 7 FED. PRAC. & PROC. CIV. § 1608 (3d ed.). The court in *Univ. of Utah* found that an order directing the PTO to correct inventorship would be sufficient in the absence of UMass. *Univ. of Utah*, 734 F.3d at 1328; *see also* 35 U.S.C. § 256(b) ("The 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."); *Stark v. Advanced Magnetics, Inc.*, 119 F.3d 1551, 1554 (Fed. Cir. 1997) ("As noted, section 256 permits the Commissioner and the federal courts to correct erroneous listing of inventors in an issued patent."). Similarly, in this case, the Court can order the PTO to correct the inventorship of the patents at issue without UMass's presence.¹¹ Thus, the Plaintiff could

¹¹ The Court would, of course, have to give UMass notice pursuant to 35 U.S.C. § 256. *See* 35 U.S.C. § 256(b) ("The 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."). But that does not automatically mean that UMass is a party required to be joined under Rule 19(b). *See FFOC Co. v. Invent A.G.*, 882 F. Supp. 642, 650 (E.D. Mich. 1994)("[B]efore this court may correct the

potentially receive all the relief he requests as to his § 256 claim, even in UMass's absence.

However, the Plaintiff also asserts two claims in the alternative for damages for the royalties derived from the patents. As the District Court of Oregon pointed out prior to transferring this case, "Ali cannot receive that compensation in this suit unless UMass is a party-defendant." Op. & Order 6, ECF No. 66. Because UMass is a required party that cannot be joined, even if the Plaintiff were entitled to compensation from UMass as a result of being named a co-inventor of some or all of the patents-in-suit, he could not receive the financial relief he seeks from Carnegie. Thus, because the Court could award the Plaintiff part of the relief he seeks absent UMass, the third prong of the 19(b) analysis is inconclusive, as it weighs in part in favor of dismissal and in part in favor of going forward.

4. There may or may not be an alternative forum for Plaintiff's claims

The final 19(b) factor is also inconclusive but ultimately may be the least important of the four in the context of an immune party. "The fourth factor requires consideration of whether 'the plaintiff will have an adequate remedy if the action is dismissed,' which is different from whether the plaintiff can obtain precisely the same relief elsewhere." *Kickapoo*, 43 F.3d at 1499 (citation omitted). *See also id.* at n.12 ("The Advisory Committee on the Federal Rules of Civil

inventorship, [co-inventors] must be given notice of the action and an opportunity to testify on this issue, *even though they are not parties* to the action.") (citing *MCV, Inc. v. King-Seeley Thermos Co.*, 870 F.2d 1568, 1570 (Fed. Cir. 1989)) (emphasis added).

Procedure, in its Note on the 1966 Revision of Rule 19, stated that “the fourth factor, looking to the practical effects of a dismissal, indicates that the court should consider whether there is any assurance that the plaintiff, if dismissed, could *sue effectively* in another forum where better joinder would be possible.”) (emphasis in original).

As the D.C. Circuit explained in *Wichita*, “[a]lthough we are sensitive to the problem of dismissing an action where there is no alternative forum, we think the result is less troublesome in this case than in some others. The dismissal of this suit is mandated by the policy of tribal immunity. This is not a case where some procedural defect such as venue precludes litigation of the case. Rather, the dismissal turns on the fact that society has consciously opted to shield Indian tribes from suit without congressional or tribal consent.” 788 F.2d at 777. The Court of Federal Claims has further elaborated that while the weight given to sovereign immunity “does not mean that balancing can be completely avoided simply because an absent person is immune from suit,’ it does mean that ‘the plaintiff’s inability to obtain relief in an alternative forum is not as weighty a factor when the source of that inability is a public policy that immunizes the absent party from suit.” *Klamath Tribe Claims Committee*, 106 Fed. Cl. at 95 (quoting *Davis ex rel. Davis v. United States*, 343 F.3d 1282, 1293–94 (10th Cir. 2003)).

Here, it is unclear whether Plaintiff has another remedy available. On the one hand, he may be able to pursue state law contract or ownership claims against UMass in state court. See *Xechem Int’l, Inc. v. Univ. of Tex. M.D. Anderson Cancer Center*, 382 F.3d 1324, 1332

(Fed. Cir. 2004) (“Although the Federal Circuit has held that inventorship is determined under federal law, state courts can apply federal law to issues properly before the state court. Federal preemption of causes arising under the Patent Act does not include matters of ownership or license.”) (citations omitted). He may even be able to amend his complaint to seek injunctive relief against UMass officials—though that too remains unclear, as set forth in note 9. On the other hand, it is unclear whether he can sue UMass in state court for damages,¹² and/or whether the statute of limitations has run on his state law claims.¹³ Thus, this factor on its own neither favors dismissal nor moving forward. But as set forth in *Wichita* and *Klamath Tribe*, because of the weight given sovereign immunity, this factor ultimately is subsidiary in the analysis.

¹² See *Alden v. Maine*, 527 U.S. 706, 754 (1999) (“In light of history, practice, precedent, and the structure of the Constitution, we hold that the States retain immunity from private suit in their own courts, an immunity beyond the congressional power to abrogate by Article I legislation.”).

¹³ The statute of limitations for breach of contract claims in Massachusetts is six years. See MASS. GEN. LAWS 260 § 2 (West 1948). The D.C. Circuit has found the running of the statute of limitations to be an important factor weighing against dismissal. See *Park v. Didden*, 695 F.2d 626, 631 n. 13 (D.C. Cir. 1982) (“Even when a person fits Rule 19(a)’s description and therefore should be joined if feasible, expiration of the statute of limitations counts heavily against dismissal.”). However, that case did not involve sovereign immunity, and as set forth above, UMass’s sovereign immunity is of paramount importance under D.C. Circuit joinder law. Thus, even if the statute of limitations had run on Plaintiff’s state law claims—an issue the Court need not and does not decide—it would not persuade the Court that dismissal was no longer warranted.

* * *

In sum, then, the first two Rule 19(b) factors favor dismissal of Plaintiff's Amended Complaint: UMass and Carnegie would be prejudiced by this case proceeding without UMass because Carnegie cannot adequately represent UMass's interests, and the Court cannot fashion adequate alternative relief on this Complaint in UMass's absence. The final two Rule 19(b) factors are inconclusive and favor neither dismissal nor going forward. But because the Court must accord significant weight to UMass's sovereign immunity under D.C. Circuit and Supreme Court precedent, and the first two factors weigh in favor of dismissal of Plaintiff's Amended Complaint, the Court finds that this action cannot proceed "in equity and good conscience" without UMass. As such, the Court grants Carnegie's motion to dismiss under Federal Rule of Civil Procedure 12(b)(7).¹⁴

¹⁴ In the alternative, Carnegie asks the Court to dismiss the alternative counts for legal damages in the complaint for failure to state a claim under Federal Rule of Civil Procedure 12(b)(6), or to strike the counts as redundant under Federal Rule of Civil Procedure 12(f). Ali's alternative counts are titled "Legal Damages." Ali's Count 2 for Legal Damages is only alleged against UMass. UMass is no longer a party to this case, nor can it be, as set forth above. As such, this Count does not state a claim for relief, and would be dismissed even if the action were not dismissed under Federal Rule of Civil Procedure 12(b)(7).

In Alternative Count 2, Ali alleges that "[o]n information and belief, [U]Mass and Carnegie have secured substantial fees by reason of selling, licensing, or otherwise transferring their rights in and to the Patents to third parties," and that as such, "Ali is entitled to recover from [U]Mass and Carnegie a portion of moneys they have secured by reason of selling, licensing, or otherwise

IV. CONCLUSION

For the foregoing reasons, Carnegie's Motion to Dismiss under Federal Rule of Civil Procedure 12(b)(7) is GRANTED and Plaintiff's Amended Complaint is DISMISSED WITHOUT PREJUDICE. An order consistent with this Memorandum Opinion is separately and contemporaneously issued.

Dated: August 29, 2014

RUDOLPH CONTRERAS
United States District Judge

transferring their rights in and to the Patents to third parties, as a reasonable measure of the moneys Ali would have been entitled to recover if properly named as a co-inventor from the filing date." *See* Am. Compl. ¶¶ 35-36. The Court, much like the Oregon court, is unclear under what theory the Plaintiff means to pursue this cause of action against Carnegie. Though titled a claim for "Legal Damages," this cause of action sounds in unjust enrichment, contract, or tort. Indeed, the Oregon court found that "[a]lthough it is not clear how Ali intends to pursue these claims for legal damages, the Court construes Ali's claims as arising under contract law." *See* Op. & Order 5, ECF No. 66. Accordingly, the Court would also dismiss this Count without prejudice, as it does not currently state a claim upon which relief can be granted.

**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA**

Civil Action No.: 13-2030 (RC)

[Filed August 29, 2014]

_____)
MUSSA ALI,)
Plaintiff,)
)
v.)
)
CARNEGIE INSTITUTION OF)
WASHINGTON,)
Defendant.)
_____)

Re Document No.: 73

ORDER

GRANTING CARNEGIE'S MOTION TO DISMISS

For the reasons stated in the Court's Memorandum Opinion separately issued today, defendant Carnegie's motion to dismiss under Federal Rule of Civil Procedure 12(b)(7) (ECF No. 73) is **GRANTED**. Carnegie's motion to strike (ECF No. 73) is **DENIED AS MOOT**. It is hereby:

ORDERED that Plaintiff's Amended Complaint (ECF No. 4) is **DISMISSED WITHOUT PREJUDICE**; and it is

FURTHER ORDERED that Plaintiff shall have until **October 1, 2014**, to seek leave to file a second

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amended complaint that names UMass officials in their official capacities as defendants.¹

SO ORDERED.

Dated: August 29, 2014

RUDOLPH CONTRERAS
United States District Judge

¹ In briefing this issue, the parties shall also address whether this Court would have personal jurisdiction over these officials.

APPENDIX E

**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF OREGON
PORTLAND DIVISION**

Case No. 3:12-cv-01764-SI

[Filed November 25, 2013]

MUSSA ALI,)
Plaintiff,)
)
v.)
)
CARNEGIE INSTITUTION OF)
WASHINGTON, and UNIVERSITY)
OF MASSACHUSETTS,)
Defendants.)

OPINION AND ORDER

Joseph W. Berenato III, and Steven B. Kelber, Berenato & White, LLC, 6550 Rock Spring Drive, Suite 240, Bethesda, MD 20817. Joel P. Leonard, and John D. Ostrander, Elliott, Ostrander & Preston, P.C., 707 S.W. Washington Street, Suite 1500, Portland, OR 97205. Attorneys for Plaintiff.

Kurt G. Calia, Covington & Burling LLP, 333 Twin Dolphin Drive, Suite 700, Redwood Shores, CA 94065. Alexa R. Hansen, and Nathan E. Shafroth, Covington & Burling, LLP, 1 Front Street, Floor 35, San Francisco, CA 94111. Kelly M. Jaske, Jaske Law LLC,

521 S.W. Clay Street, Suite 209, Portland, OR 97201.
Attorneys for Defendants.

Michael H. Simon, District Judge.

Plaintiff Mussa Ali (“Ali”) brings this lawsuit against Defendants Carnegie Institution of Washington (“Carnegie”) and University of Massachusetts (“UMass”) (collectively “Defendants”) to correct the inventorship of five issued patents related to gene silencing. In an earlier Opinion and Order, the Court granted Defendants’ motion to dismiss UMass as immune from suit and deferred ruling on the remainder of Defendants’ motion. Dkts. 18, 41. For the reasons stated below, Ali’s Motion for Reconsideration re Waiver of Sovereign Immunity (Dkt. 45) is **DENIED**; Defendant Carnegie’s Motion for Reconsideration of the Court’s Order Granting in Part Plaintiff’s Motion for Jurisdictional Discovery is **GRANTED** (Dkt. 46); and Defendants’ Motion to Dismiss or Strike Plaintiff’s Amended Complaint (Dkt. 18) is **GRANTED IN PART** and **DENIED AS MOOT IN PART**. Pursuant to 18 U.S.C. § 1406(a), the Court **TRANSFERS** this case to the United States District Court for the District of Columbia.

BACKGROUND

This case arises out of Ali’s claim that he was erroneously omitted as a named inventor on five patents: U.S. Patent Nos. 6,506,559; 7,538,095; 7,560,438; 7,622,633 and 8,283,329. Dkt. 4 at ¶¶ 3, 25-26. Defendants are owners, by assignment, of the patents at issue. *Id.* at ¶¶ 3-4.

Defendants move to dismiss or strike Ali’s First Amended Complaint. Dkt. 18. On May 28, 2013, the

Court issued an Opinion and Order resolving some of the issues in this case and setting a procedure for resolving the remaining issues. Dkt. 41. In that Opinion and Order, the Court dismissed UMass because it was entitled to sovereign immunity, and the Court granted in part jurisdictional discovery, which the Court temporarily stayed. Subsequently, and in accordance with the Court's request, the parties briefed whether UMass is a "required party." In addition to briefing whether UMass is a "required party," Carnegie argued that Ali lacks standing to bring this lawsuit. Carnegie also submitted a motion asking the Court to reconsider its grant of jurisdictional discovery. Ali submitted a motion requesting that the Court reconsider its finding that UMass is entitled to sovereign immunity.

Remaining to be decided by the Court are the following issues: (1) whether Ali has standing to bring suit pursuant to 35 U.S.C. § 256; (2) the motion to reconsider UMass's sovereign immunity; (3) the motion to reconsider jurisdictional discovery; (4) the motion to dismiss the suit because the Court lacks personal jurisdiction over the Defendants; and (5) the motion to dismiss the suit because UMass is a necessary party that cannot be joined.

DISCUSSION

Carnegie asserts three independent grounds for complete dismissal of this case. First, Carnegie argues that Ali's arguments regarding whether UMass is a necessary party demonstrate that Ali lacks standing to bring this lawsuit. Second, Carnegie argues that because the Court lacks personal jurisdiction over it, this case must be dismissed under Federal Rule of Civil

Procedure 12(b)(2). Third, Carnegie argues that UMass, which the Court previously dismissed, is a required party that cannot be joined; thus, the case must be dismissed pursuant to Federal Rule of Civil Procedure 12(b)(7). In the alternative to these three arguments for complete dismissal, Carnegie contends that Ali's second count and alternative second count must be dismissed for failure to state a claim pursuant to Federal Rule of Civil Procedure 12(b)(6). In response to Defendants' motion to dismiss, Ali sought discovery related to Carnegie's motion, which the Court previously granted in part.

A. Article III Standing

In Carnegie's Reply Brief, Carnegie argues for that first time that Ali lacks Article III standing to bring suit under 35 U.S.C. § 256. *See* Dkt. 56 at 3-5. Because Carnegie first raised this issue in a reply brief and Ali did not seek leave to file a sur-reply, Ali has not responded to this argument. Generally, any argument first raised in a reply brief is waived. *See Graves v. Arpaio*, 623 F.3d 1043, 1048 (9th Cir. 2010) (citing *U.S. ex rel. Meyer v. Horizon Health Corp.*, 565 F.3d 1195, 1199 n.1 (9th Cir. 2009)). A challenge to a plaintiff's standing, however, cannot be so easily swept aside. Because "standing is an essential and unchanging part of the case-or-controversy requirement of Article III," *Lujan v. Defenders of Wildlife*, 504 U.S. 555, 560 (1992), courts "are required sua sponte to examine jurisdictional issues such as standing" regardless of whether the parties raise the issue. *Bernhardt v. County of Los Angeles*, 279 F.3d 862, 868 (9th Cir. 2001). Moreover, defects in a plaintiff's standing cannot be waived by a defendant. *See D'Lil v. Best W. Encina*

Lodge & Suites, 538 F.3d 1031, 1036 (9th Cir. 2008) (quoting *United States v. Hays*, 515 U.S. 737, 742 (1995)). Accordingly, in assuring itself of proper jurisdiction, the Court will address Carnegie's challenge to Ali's standing.

1. Legal Standards

It is axiomatic that “[f]ederal courts are courts of limited jurisdiction.” *Kokkonen v. Guardian Life Ins. Co. of Am.*, 511 U.S. 375, 377 (1994). Article III standing “is [a] threshold [requirement] in every federal case,” determinative of “the power of the court to entertain the suit.” *Warth v. Seldin*, 422 U.S. 490, 498 (1975). The essential question is whether a plaintiff can satisfy the “case or controversy” requirement of Article III of the Constitution. U.S. Const. art. III, § 2, cl. 1; *Friends of the Earth, Inc. v. Laidlaw Envtl. Servs. (TOC), Inc.*, 528 U.S. 167, 180 (2000). To satisfy the requirements of Article III, a plaintiff must demonstrate: (1) injury in fact, (2) that is causally connected to the conduct complained of, and (3) may be redressed by a favorable court decision. *Chou v. Univ. of Chicago*, 254 F.3d 1347, 1357 (Fed. Cir. 2001) (citing *Lujan*, 504 U.S. at 560-61).

To have Article III standing to bring a claim seeking to correct the named inventors on an issued patent, a plaintiff must have at least a non-contingent ownership interest in the patent or be able to identify some concrete financial or personal reward that would spring from the plaintiff's listing as a named inventor. See *Larson v. Correct Craft, Inc.*, 569 F.3d 1319, 1327 (Fed.

Cir. 2009); *Chou*, 254 F.3d at 1358-59.¹ Without such an interest, a plaintiff cannot establish that he suffered an injury in fact and lacks standing. *See Chou*, 254 F.3d at 1359.

2. Analysis

In addition to Ali's claim for correction of inventorship, Ali asserts two additional claims in the alternative, which are both styled, "Legal Damages." *See* Dkt. 4, at ¶¶ 28-36. In his first claim for legal damages, Ali asserts that he is entitled to a certain percentage of the revenues derived from the licensing and monetization of the patents-in-suit pursuant to a UMass policy. *See id.* at ¶¶ 28-32. Ali alleges that his entitlement to this compensation was given in exchange for the assignment of his whole interest in the patents-in-suit to UMass. *Id.* at ¶ 30. In his second, alternative claim for legal damages, Ali asserts that he did not assign any of his interest in the patents-in-suit to UMass, retaining it for himself; thus, Ali is entitled to a portion of the royalties and fees that Defendants' derived from exploiting the patents-in-suit. *Id.* at ¶¶ 33-36. Although it is not clear how Ali intends to pursue these claims for legal damages, the Court construes Ali's claims as arising under contract law.

¹ In *Chou*, the Federal Circuit discussed, without deciding, whether a reputational interest alone could provide sufficient standing to a plaintiff who could not allege an ownership or financial interest. *See Chou*, 254 F.3d at 1359. Because Ali does not assert a reputational interest in the patents-in-suit, the Court need not decide whether such an interest satisfies the requirements of Article III standing. *See Larson*, 569 F.3d at 1327-28 (declining to address reputational interests when the plaintiff had claimed no reputational injury).

Relying on *Larson*, Carnegie argues that Ali does not concretely allege an interest sufficient to confer Article III standing. Carnegie argues that Ali's Opposition to Defendant's Motion to Dismiss (Dkt. 43) concedes the issue by stating that his entitlement to financial compensation "is not an issue presented to the court." Dkt. 43, 13-14; Dkt. 56, at 4. In *Larson*, the plaintiff did not have the necessary ownership or financial interests because it was undisputed that he assigned those interests to the defendants. *See Larson*, 569 F.3d at 1322, 1326-27. The plaintiff's ownership interest in the patents-in-suit—necessary for standing—was predicated upon his success on state law contract claims, which would nullify the assignments. *See id.* at 1326-27 ("Without first voiding his patent assignments, Larson has no ownership interest in the [patents-in-suit.]"). Unlike *Larson*, Ali's success on his state law contract claims, which he styles as claims for "Legal Damages," will not cause any interests in the patents-in-suit to vest. Ali asserts that he has not assigned his interest in the patents-in-suit to Defendants. In the event that Ali is found to be an omitted co-inventor of one or more of the patents-in-suit, Ali alleges that his interests in those patents will vest in accordance with UMass's policies and that he will be entitled to financial remuneration. Specifically, Ali contends that the UMass agreement will pay Ali a percentage of all revenues realized in consideration for his assignment to UMass. *See Larson*, 569 F.3d. at 1326-27. Based on this allegation, Ali suffers an injury due to a financial loss that is traceable to UMass's alleged conduct in omitting Ali as a co-inventor. *See Chou*, 254 F.3d at 1359.

Ali alleges that he has an agreement with UMass, but does not allege any separate agreement that would entitle him to a financial benefit from Carnegie. Therefore, if Ali is named a co-inventor of some or all of the patents-in-suit and he is entitled to compensation from UMass, Ali cannot receive that compensation in this suit unless UMass is a party-defendant. This does not defeat Ali's standing to bring suit under § 256 because Ali's success on that claim will entitle him to an "order from the [Court] to the Director of the PTO to issue a certificate naming [him] as an inventor." *Chou*, 254 F.3d at 1359. Although resolution of the § 256 claim alone will not give Ali a judgment against any party for the allegedly promised compensation, the redressability requirement of Article III is satisfied so long as a plaintiff shows "that a favorable decision will relieve a discrete injury to himself." *Massachusetts v. E.P.A.*, 549 U.S. 497, 525 (2007) (quoting *Larson v. Valente*, 456 U.S. 228, 244, n.15 (1982)). Ali "need not show that a favorable decision will relieve his *every* injury." *Id.* Accordingly, for standing purposes, the injury suffered by Ali in his § 256 claim is, at least, partially redressable by the Court without UMass being party to this lawsuit. *Chou*, 254 F.3d at 1358-59 (explaining that not being named a co-inventor "would be redressable by an order from the district court to the Director of the PTO to issue a certificate naming [the plaintiff] as an inventor, which would entitle her under the University's policy to a share of the licensing proceeds and stock").

Ali's two claims for legal damages appear to be alleged in the alternative: either Ali and UMass have a contract that compels Ali to assign his interests in the patents-in-suit in exchange for a fixed percentage

of derived revenues, or there is no contract and Ali retains his ownership interests in the patents-in-suit. *See* Dkt. 4, at ¶¶ 26-36; *see* Fed. R. Civ. P. 8(d)(2), (3). At this preliminary stage, Ali has sufficiently alleged standing to bring suit.

B. Reconsideration of UMass’s Sovereign Immunity

Ali filed a motion to reconsider the Court’s prior dismissal of UMass from this lawsuit on the basis of sovereign immunity. *See* Dkt. 45. As grounds for the Court’s reconsideration of its prior decision, Ali argues that UMass waived its sovereign immunity with respect to the patents-in-suit. Ali contends that because the United States allegedly provided some or all of the funding that supported the research underlying the patents-in-suit, any patents resulting from that funding fall within the purview of the Bayh-Dole University and Small Business Patent Procedures Act, 35 U.S.C. § 200 *et seq.* (“Bayh-Dole Act” or “Act”). With respect to the patents-in-suit, Ali argues that UMass “made a clear declaration” of its submission to the jurisdiction of the federal courts, waiving sovereign immunity. Dkt. 45 at 5.²

² A state may also waive sovereign immunity when it voluntarily invokes the jurisdiction of the federal courts. *Coll. Sav. Bank v. Florida Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666, 675-76 (1999) (citing *Gunter v. Atl. Coast Line R.R. Co.*, 200 U.S. 273, 284 (1906)); *see also, e.g., Regents of Univ. Of N.M. v. Knight*, 321 F.3d 1111, 1124 (Fed. Cir. 2003) (“[I]t has long been established that a state waives its Eleventh Amendment immunity when it consents to federal court jurisdiction by voluntarily appearing in federal court.”). This means of waiver is not at issue here.

1. Legal Standards

“[A]ny waiver of sovereign immunity by a state must be express and voluntary, and cannot be implied or constructive.” *State Contracting & Eng’g Corp. v. State of Fla.*, 258 F.3d 1329, 1336 (Fed. Cir. 2001) (citing *Coll. Sav. Bank*, 527 U.S. at 682). The Supreme Court has expressly rejected the argument that a state may impliedly or constructively waive sovereign immunity. *See Coll. Sav. Bank*, 527 U.S. at 680-81 (overruling *Parden v. Terminal Ry. of Ala. Docks Dept.*, 377 U.S. 184 (1964)). A state’s use of “arrangements controlled by federal law and reviewable only in federal court,” such as the state acting as a market participant, cannot erode sovereign immunity. *See Xechem Int’l, Inc. v. Univ. of Tex. M.D. Anderson Cancer Ctr.*, 382 F.3d 1324, 1329-30 (Fed. Cir. 2004). Waiver by statute may be sufficient, but the statute must go beyond “ambiguous and general consent to suit provisions” to include specific consent to suit in federal court. *See Port Auth. Trans-Hudson Corp. v. Feeney*, 495 U.S. 299, 306-07 (1990) (finding waiver where the state statute’s venue provision expressly included suits in courts of the United States).

Congress enacted the Bayh-Dole Act to enable the “use [of] the patent system to promote the utilization of inventions arising from federally supported research or development” and to “ensure that the Government obtain[ed] sufficient rights in federally supported inventions.” 35 U.S.C. § 200. To achieve these goals, the Act vests several unique rights to “subject inventions,” which are researched and developed by contractors, including universities, through the use of federal funds. *See generally Bd. of Trustees of Leland*

Stanford Junior Univ. v. Roche Molecular Sys., Inc., 131 S. Ct. 2188, 2193 (2011) (citing 35 U.S.C. § 200, *et seq.*). Included in this bundle of rights, the Federal Government, through a funding agency, obtains: (1) “a nonexclusive, nontransferable, irrevocable, paid-up license,” 35 U.S.C. § 202(c)(4), and (2) “march-in rights,” which permit the funding agency to license a subject invention to a third-party who will commercialize the invention, *id.* at §§ 201(f), 203(a). Further, when the contractor declines title to an invention, the agency may vest title in the inventor, subject to provisions of the Act and any funding agreement between the agency and the contractor. *Id.* at § 202(d).

2. Discussion

Ali contends that the Bayh-Dole Act places UMass at the center of a *quid pro quo* arrangement where the funding incentives provided by the Act are conditioned on UMass’s selective waiver of sovereign immunity to suits in federal court relating to patents funded by the Act. *See* Dkt. 45 at 5-6. Although this argument is innovative, the Bayh-Dole Act does not “expressly” require UMass to respond to a § 256 action in a United States District Court. The Court rejects Ali’s arguments for three reasons.

First, Ali notes that his suit questions whether UMass is in compliance with the requirements under the Act; however, as Ali acknowledges, no court has recognized a private cause of action under the terms of the Act. *See, e.g., Network Signatures, Inc. v. Citibank, N.A.*, No. SACV 08-0718 DOC (RNBx), 2008 WL 5216032, at *3 (C.D. Cal. Dec. 4, 2008) (collecting cases). Indeed, the Act “clarif[ies] the order of priority

of rights between the Federal Government and a federal contractor[, such as UMass,] in a federally funded invention that already belongs to the contractor. Nothing more.” *Stanford*, 131 S. Ct. at 2197; see also *Therien v. Trustees of Univ. of Pa.*, No. Civ.A. 04-4786, 2006 WL 83448, at *3 (E.D. Pa. Jan. 10, 2006) (“[T]he Act does not determine the relationship between universities and their faculty members. Rather, the Bayh-Dole Act regulates the relationship between government agencies and institutions that receive federal funding.”) (citation omitted). Although the Act does make limited reference to the inventor, the Federal agency is solely tasked with determining whether or not the inventor may retain rights to the invention under specified conditions. See 35 U.S.C. § 202(d) (“the Federal agency *may consider* . . . requests for retention of rights by the inventor”) (emphasis added). If the inventor disagrees with the agency’s determination, the inventor may appeal the agency’s decision in a petition to the United States Court of Federal Claims. See *id.* at § 203(b). Thus, no court has recognized a private right of action because it is not granted by the text of the statute.

Second, Ali argues that the funding agreements, which provided for the research leading to the patents-in-suit, “includ[e] the agreement to regulation . . . by federal authority.” Dkt. 58 at 6. Although this is true, there is nothing in the text of the statute requiring a funding recipient to consent to suit in federal court, which is unsurprising because enforcement of the Act’s provisions by the United States would not require a state’s waiver of sovereign immunity. See, e.g., *West Virginia v. United States*, 479 U.S. 305, 311 (1987) (“States have no sovereign immunity as against the

Federal Government.”) (citation omitted). Submitting to “some” regulation by a funding agency is not equivalent to an express waiver of sovereign immunity from suit in a federal court. *See Coll. Sav. Bank*, 527 U.S. at 676-77. Ali’s second argument falls short of the requirements mandated by the Supreme Court’s strong presumption against waiver of sovereign immunity. *See id.* at 682.

Third, the Court notes that Ali’s argument that UMass’s receipt of federal funding for the patents-in-suit came with a number of strings attached, including compliance review in the federal courts, also fails to establish a waiver of sovereign immunity. Pursuant to *South Dakota v. Dole*, 483 U.S. 203 (1987), the Spending Clause permits “Congress to further its policy objectives by conditioning the receipt of federal funds on compliance with federal mandates.” *Mayweathers v. Newland*, 314 F.3d 1062, 1066 (9th Cir. 2002) (citing *Dole*, 483 U.S. at 206). There is nothing in the Bayh-Dole Act that suggests waiver of sovereign immunity in federal court is a prerequisite to accepting funding under the Act, thereby permitting suit against a state in a § 256 action. *See Atascadero State Hosp. v. Scanlon*, 473 U.S. 234, 243 (1985) (requiring courts “to be certain of Congress’ intent before finding that federal law overrides the guarantees of the Eleventh Amendment.”). Even assuming there was some intent in the Bayh-Dole Act to condition a state’s receipt of funds on a waiver sovereign immunity, the expression of such intent was insufficiently clear to abrogate UMass’s sovereign immunity. *Cf. id.* (requiring Congress to “unequivocally express” its intention to abrogate state sovereign immunity).

In sum, UMass’s receipt of funds from the United States to perform the research underlying the patents-in-suit did not deprive it—through waiver, abrogation, or any other means—of its sovereign immunity from suit in federal court.

C. Reconsideration of Jurisdictional Discovery

Carnegie also filed a motion asking the Court to reconsider granting Ali limited jurisdictional discovery. For the reasons stated below, Carnegie’s motion is granted.

1. Legal Standards

In patent cases, Federal Circuit law governs the relevance of a request for jurisdictional discovery. *See Commissariat A L’Energie Atomique v. Chi Mei Optoelectronics Corp.*, 395 F.3d 1315, 1323 (Fed. Cir. 2005); *Beverly Hills Fan Co. v. Royal Sovereign Corp.*, 21 F.3d 1558, 1564 (Fed. Cir. 1994). Whether jurisdictional discovery is warranted, however, is a question answered by the law of the regional circuit. *See Chi Mei*, 395 F.3d at 1323 (relying on regional circuit law to determine whether the party seeking discovery “made a sufficient threshold showing”); *see also Autogenomics, Inc. v. Oxford Gene Tech. Ltd.*, 566 F.3d 1012, 1021 (Fed. Cir. 2009) (“We review the district court’s denial of discovery, an issue not unique to patent law, for abuse of discretion, applying the law of the regional circuit.”).

Because there is no statutorily mandated method for resolving jurisdictional disputes before trial, the mode of resolution is left in the discretion of the trial court. *See Data Disc, Inc. v. Sys. Tech. Assocs., Inc.*, 557 F.2d 1280, 1285 (9th Cir. 1977) (citing *Gibbs v. Buck*,

307 U.S. 66, 71-72 (1939)). Generally, discovery is appropriate “where pertinent facts bearing on the question of jurisdiction are controverted or where a more satisfactory showing of the facts is necessary.” *Id.* at 1285 n.1 (citing *Wells Fargo & Co. v. Wells Fargo Express Co.*, 556 F.2d 406, 430 n.24 (9th Cir. 1977)). A court may deny jurisdictional discovery unless the denial “will result in ‘actual and substantial prejudice to the complaining litigant’ (e.g., ‘a reasonable probability that the outcome would have been different had discovery been allowed’).” *Digeo, Inc. v. Audible, Inc.*, 505 F.3d 1362, 1370 (Fed. Cir. 2007) (quoting *Laub v. U.S. Dep’t of Interior*, 342 F.3d 1080, 1093 (9th Cir. 2003)).

2. Discussion

In the Court’s prior Opinion and Order, the Court granted Ali limited discovery into the relationship between Carnegie and its licensees of the patents-in-suit in Oregon, if any existed. Underlying the Court’s reasoning was the expectation that limited, non-burdensome jurisdictional discovery should generally be given when the discovery sought is “relevant.” *See Alaska Cargo Transp., Inc. v. Alaska R.R. Corp.*, 5 F.3d 378, 383 (9th Cir. 1993) (affirming a district court’s stay of discovery when there was no indication “the discovery sought was relevant to whether or not the court has subject matter jurisdiction”); *Jarvis v. Regan*, 833 F.2d 149, 155 (9th Cir. 1987) (affirming a district court’s stay of discovery when the complaint “did not raise factual issues that required discovery for their resolution”). In light of the parties’ arguments and as will be discussed more thoroughly below, the Court finds that jurisdictional discovery is not warranted

because even if Ali obtains the discovery sought, it will be insufficient for the Court to exercise personal jurisdiction over Carnegie. Carnegie's Motion for Reconsideration (Dkt. 46) is, therefore, granted.

D. Personal Jurisdiction

Carnegie argues that Ali cannot demonstrate that this Court has either general or specific personal jurisdiction over Carnegie. The Court previously deferred ruling on the issue of personal jurisdiction. It has become apparent, however, in the parties' subsequent briefing that even with the requested discovery, Ali will not be able to establish the Court's personal jurisdiction over Carnegie. Based on the analysis that follows, the Court finds that it lacks personal jurisdiction over Defendant Carnegie, the only remaining defendant.

1. Legal Standards

"Federal Circuit law governs the issue of personal jurisdiction in . . . patent-related cases." *Deprenyl Animal Health, Inc. v. Univ. of Toronto Innovations Found.*, 297 F.3d 1343, 1348 (Fed. Cir. 2002). To assert personal jurisdiction over an out-of-state defendant in a patent-related dispute, a court must resolve two inquiries: "whether a forum state's long-arm statute permits service of process and whether assertion of personal jurisdiction violates due process." *Genetic Implant Sys., Inc. v. Core-Vent Corp.*, 123 F.3d 1455, 1458 (Fed. Cir. 1997). Oregon's long-arm statute extends jurisdiction to the outer limits of due process. *Freeman v. Duffy*, 983 P.2d 533, 534 (Or. 1999). Therefore, the Court considers only whether the exercise of personal jurisdiction over a defendant would

satisfy federal due process. *Accord Inamed Corp. v. Kuzmak*, 249 F.3d 1356, 1360 (Fed. Cir. 2001) (collapsing the two part inquiry where a state's long-arm statute is coextensive with the limits of due process).

The Due Process Clause “protects an individual’s liberty interest in not being subject to the binding judgments of a forum with which he has established no meaningful contacts, ties, or relations.”³ *Burger King Corp. v. Rudzewicz*, 471 U.S. 462, 471-72 (1985) (citation and internal quotation marks and citation omitted). To satisfy due process, the plaintiff must show that the defendant has “certain minimum contacts with [the forum state] such that the maintenance of the suit does not offend traditional notions of fair play and substantial justice.” *Int’l Shoe*

³ The Federal Circuit has noted that because a federal court’s subject matter jurisdiction to hear patent disputes is based on federal question jurisdiction, 28 U.S.C. § 1331, rather than diversity jurisdiction, 28 U.S.C. § 1332, the Due Process Clause of the Fifth Amendment, rather than the Due Process Clause of the Fourteenth Amendment, governs the court’s assertion of personal jurisdiction. *Deprenyl Animal Health*, 297 F.3d at 1350; see generally *Honeywell, Inc. v. Metz Apparatewerke*, 509 F.2d 1137, 1143 (7th Cir. 1975). *Int’l Shoe Co. v. Washington*, 326 U.S. 310 (1945), and its progeny were decided under the Due Process Clause of the Fourteenth Amendment. See *id.* at 311 (the question “for decision [is] whether, within the limitations of the due process clause of the Fourteenth Amendment, appellant, a Delaware corporation, has by its activities in the State of Washington rendered itself amenable to proceedings in the courts of that state”). Nonetheless, the Federal Circuit applies the standards developed in *Int’l Shoe* and its progeny “to Fifth Amendment due process cases arising under the federal patent laws.” *Deprenyl Animal Health*, 297 F.3d at 1350.

Co. v. Washington, 326 U.S. 310, 316 (1945). Under the “minimum contacts” test, “a defendant may be subject to either specific jurisdiction or general jurisdiction.” *LSI Indus. Inc. v. Hubbell Lighting, Inc.*, 232 F.3d 1369, 1375 (Fed. Cir. 2000). A court has general personal jurisdiction over an out-of-state defendant when that defendant has “continuous and systematic general business contacts” with the forum state. *Helicopteros Nacionales de Colombia, S.A. v. Hall*, 466 U.S. 408, 416 (1984). A court has specific personal jurisdiction where “the defendant has purposefully directed his activities at residents of the forum, and the litigation results from alleged injuries that arise out of or relate to those activities.” *Burger King Corp.*, 471 U.S. at 472 (citation and internal quotation marks omitted). Thus, in “contrast to general, all-purpose jurisdiction, specific jurisdiction is confined to adjudication of issues deriving from, or connected with, the very controversy that establishes jurisdiction.” *Goodyear Dunlop Tires Operations, S.A. v. Brown*, 131 S. Ct. 2846, 2851 (2011) (citation and internal quotation marks omitted).

2. Discussion

In this case, Ali argues that the Court may assert both general and specific jurisdiction over Carnegie.⁴ In support of general jurisdiction, Ali asserts that Carnegie’s substantial support of research activities in

⁴The actual jurisdictional allegations in Ali’s Amended Complaint are quite bare. See Dkt. 4 at ¶¶ 2-7. Ali merely alleges that the Court has personal jurisdiction over Carnegie because it does business in this district, generally or related to the patents-in-suit. See *id.* at ¶ 6.

the forum provide sufficient contacts. In support of specific jurisdiction, Ali argues that Carnegie's use of the patents through licensing in the forum and the actions of the patents' listed inventors in the forum are sufficient to establish jurisdiction. The Court addresses each jurisdictional argument in turn.

a. General Jurisdiction

A court may not assert general personal jurisdiction over an out-of-state defendant unless the defendant's contacts with the forum state "are so 'continuous and systematic' as to render [it] essentially at home in the forum [s]tate." *Goodyear*, 131 S. Ct. at 2851 (quoting *Int'l Shoe*, 326 U.S. at 317). Neither the United States Supreme Court nor the Federal Circuit "has outlined a specific test to follow when analyzing whether a defendant's activities within a forum are continuous and systematic." *Synthes (U.S.A.) v. G.M. Dos Reis Jr. Ind. Com de Equip. Medico*, 563 F.3d 1285, 1297 (Fed. Cir. 2009) (alteration, citation, and internal quotation marks omitted). Instead, the "court must look at the facts of each case to make such a determination." *LSI Indus.*, 232 F.3d at 1375.

In a letter to the Court, Ali offered a comprehensive picture of the specific actions of Carnegie that Ali argues warrant further discovery. *See* Dkt. 52. Even accepting the existence of the activities described by Ali and making all reasonable inferences in his favor, these activities do not demonstrate Carnegie's "continuous and systematic contacts" with the forum state.

In large part, the activities cited by Ali concern Carnegie's collaborative research efforts with the forum

state, primarily through Oregon State University (“OSU”) or Oregon Health Sciences University (“OHSU”). *See generally* Dkt. 52. Ali alleges that over the last several years, Carnegie has given almost \$300,000 per year in funding to the state. *See id.* at 1. This funding has supported research by OSU, and other participating out-of-state universities, into magma flows under the tectonic plate beneath Oregon, carbon-isotope sample collection in the Metolius region of Oregon, and biological research into the methylation patterns of plants and animals, among other projects. *See id.* at 1-3. In addition to collaborative research, Ali alleges that Carnegie organized and held several banquets honoring research efforts by scientists and held a symposium and screening of a film about the Willamette River. *See id.* at 3.

The standard for general jurisdiction is “fairly high.” *See Autogenomics*, 566 F.3d at 1018; *see also Schwarzenegger v. Fred Martin Motor Co.*, 374 F.3d 797, 801 (9th Cir. 2004) (describing it as an “exacting standard” because “general jurisdiction permits a defendant to be haled into court in the forum state to answer for any of its activities anywhere in the world”). Carnegie’s status as a not-for-profit institution complicates the jurisdictional analysis because the activities Ali cites as evidence of Carnegie’s sufficient contacts are unlike those activities typically cited by a court asserting, or considering, general jurisdiction. *See, e.g., Perkins v. Benguet Consol. Min. Co.*, 342 U.S. 437, 447 (1952) (finding “continuous and systematic” contacts from a corporation that temporarily relocated its business operations to the forum state while its primary revenue generating activity, mining, was suspended in a distant forum). In various Federal

Circuit cases, that court has considered, *inter alia*, the following activities in the forum state: attending and meeting potential customers at conferences and trade shows, *Autogenomics*, 566 F.3d at 1018; “purchases of parts and machinery” and the sale of products, *Synthes*, 563 F.3d at 1297; and, exhibiting products, shipping products, and advertising, *Grober v. Mako Products, Inc.*, 686 F.3d 1335, 1346 (Fed. Cir. 2012). These contacts are unlike those that Carnegie carries on in Oregon.

Perhaps most significantly, all of the activities cited by Ali are conducted in collaboration with one or more universities. This is significant because it precludes Carnegie from developing the infrastructure or personnel footprint in Oregon that might lead a court to find the approximation of its physical presence. *See Helicopteros*, 466 U.S. at 416 (citing a place of business or a license to do business in the forum state as prototypical examples of physical presence). By way of comparison, Carnegie maintains facilities in several states in addition to its primary operations in the District of Columbia. For example, Carnegie’s Department of Plant Biology, which is involved in the methylation patterning experience cited by Ali, is physically located in Stanford, California. *See generally Department of Plant Biology*, available at <https://dpb.carnegiescience.edu/> (last visited Nov. 20, 2013). But Carnegie maintains no facilities in Oregon. Even assuming some of Carnegie’s research personnel conduct some of their research in Oregon, their work in the forum state is connected only to discrete projects. This type of work, even if it is ongoing, does not establish the continuous and systematic contacts courts have found to satisfy the requirements of general

jurisdiction. Moreover, Carnegie's researchers are more akin to the employees sent by the defendant in *Helicopteros* to receive training in the forum than to employees sent to perform general business functions. Compare *Helicopteros*, 466 U.S. at 416, with *Perkins*, 342 U.S. at 447-48 (listing forum as location of president and general manager, who performed numerous general functions for the defendant). This is not to minimize the importance of the research activity carried on by Carnegie's employees; instead, it highlights that Carnegie's employees' forays into this forum are for discrete, specialized, and non-commercial purposes and are not continuous and systematic.

Several courts have analyzed activities that fall short of establishing general personal jurisdiction using *Helicopteros* and *Perkins* as guideposts. See *Helicopteros*, 466 U.S. at 416 (finding the defendant sent its employees to negotiate a contract, to receive purchased goods, and to receive training); *Perkins*, 342 U.S. at 447-48 (describing the forum as the location where the defendant's president performed numerous general business functions). The Court in *Autogenomics* rejected a plaintiff's characterization of the defendant's appearance at conferences as using "mobile offices." See 566 F.3d at 1018. The court rejected personal jurisdiction because such contacts were only "sporadic and insubstantial." *Id.*

In *Campbell Pet Co. v. Miale*, 542 F.3d 879 (Fed. Cir. 2008), the defendant attended a conference in the forum state where an employee demonstrated products, offered them for sale, took orders, and threatened competitors with infringement. See *id.* at 881-82. The *Campbell* court explained that the limited contacts

with the forum reflected “far less than the required ‘continuous and systematic’ contacts with the state” needed to establish general personal jurisdiction. *Id.* at 883. More limited activities within a forum state may be sufficient to establish specific personal jurisdiction, but not general jurisdiction. *Cf. id.* (reasoning that the activities in *Campbell* were insufficient for general jurisdiction, but were sufficient to establish specific jurisdiction).

Underlying the Supreme Court’s line of personal jurisdiction cases is idea that a defendant enjoying “the privilege of conducting activities within a state” and “the benefits and protection of the laws of that state” must respond to suits brought in that state. *Int’l Shoe*, 326 U.S. at 319; *see also Burger King Corp.*, 471 U.S. at 476 (“[B]ecause [a defendant’s] activities are shielded by ‘the benefits and protections’ of the forum’s laws it is presumptively not unreasonable to require him [or her] to submit to the burdens of litigation in that forum as well.”). This concern is highlighted by courts’ frequent references to and reliance on the amount of revenue derived from defendants’ contacts with the forum. *See, e.g., Campbell*, 542 F.3d at 884 (noting the defendant’s contact with the forum amounted to less than two percent of gross revenue); *see also* Charles W. Rhodes, *Clarifying General Jurisdiction*, 34 Seton Hall L. Rev. 807, 846, 846 n.190 (2004) (collecting cases and describing courts’ focus on “forum sales and other revenue-generating activities”). Although derived revenue might be only one proxy for a defendant’s use of a forum’s benefits and protections, the lack of revenue directly derived from Carnegie’s research collaborations is significant. *Cf. LSI Indus.*, 232 F.3d at 1375 (finding general jurisdiction over a defendant

with a “broad distributorship network” and “millions of dollars of sales” in the forum). As Ali alleges, Carnegie appears to direct money into the forum, in addition to the intrinsic value of the research Carnegie supports.⁵ See Dkt. 52 at 1. This type of intermittent activity, based on limited research agreements that do not generate revenue, is not akin to the commercial benefit *quid pro quo* arrangement that justifies general personal jurisdiction.

Ali also argues that Carnegie’s enforcement and licensing of the patents-in-suit in Oregon contribute to a finding of general personal jurisdiction. In *Campbell*, however, the Federal Circuit found that the defendant’s sending of cease and desist letters, an enforcement activity, was more relevant to specific jurisdiction and did not increase the defendant’s quantum of relevant commercial activity. 542 F.3d at 883-84. Similarly, in *Breckenridge Pharm., Inc. v. Metabolite Labs., Inc.*, 444 F.3d 1356 (Fed. Cir. 2006), the court’s discussion of licensing agreements and personal jurisdiction was related to specific personal jurisdiction in the context of a declaratory judgment action. See *id.* at 1359, 1363, 1366. When looking at general jurisdiction, licensing agreements are simply another component of a

⁵ Indeed, in cases where research agreements have supported a finding of general jurisdiction, the defendant was also engaged in a substantial amount of commercial activity within the forum state. See, e.g., *Avery Dennison Corp. v. Alien Tech. Corp.*, 632 F. Supp. 2d 700, 710-11 (N.D. Ohio 2008) (noting, in addition to five research agreements in the forum, the sale of “millions of RFID devices”); *Massachusetts Inst. of Tech. v. Micron Tech., Inc.*, 508 F. Supp. 2d 112, 121-23 (D. Mass. 2007) (noting, in addition to a research agreement, approximately \$20 million made in sales to the forum).

defendant's contacts with the forum that a court must consider. *Cf. Helicopteros*, 466 U.S. at 416 (describing a defendant's negotiation of a transportation-services contract). The Court is not persuaded, however, that Carnegie's limited licensing in the forum, if such licensing occurs, creates the systematic and continuous contacts necessary for general jurisdiction.

In sum, Ali has not alleged that Carnegie has "the kind of continuous and systematic general business contacts" necessary to permit the Court to exact the severe price of general personal jurisdiction on Carnegie. *See Helicopteros*, 466 U.S. at 416.

b. Specific Jurisdiction

Even where a defendant is not subject to general personal jurisdiction, "a district court may nonetheless exercise specific personal jurisdiction over the defendant subject to a three part test." *Autogenomics*, 566 F.3d at 1018. The three factors are: "(1) whether the defendant 'purposefully directed' its activities at residents of the forum; (2) whether the claim 'arises out of or relates to' the defendant's activities with the forum; and (3) whether assertion of personal jurisdiction is 'reasonable and fair.'" *Inamed*, 249 F.3d at 1360 (quoting *Akro Corp. v. Luker*, 45 F.3d 1541, 1545 (Fed. Cir. 1995)). "The plaintiff has the burden of proving parts one and two of the test, and then the burden shifts to the defendant to prove that personal jurisdiction is unreasonable." *Grober*, 686 F.3d at 1346.

Specific jurisdiction provides a cabined basis for jurisdiction over a defendant who has some dealings in a forum, but not enough to justify general jurisdiction. Critically, however, a court's assertion of specific

jurisdiction is limited to occasions when the lawsuit arises out of the defendant's contact with the forum. *See, e.g., Burger King Corp.*, 471 U.S. at 472 (“the litigation results from alleged injuries that arise out of or relate to [forum] activities” (quotation marks omitted)).

Regardless of Carnegie's contacts with Oregon, it is undisputed that those contacts do not relate to Ali's claim that he should be listed as a co-inventor on the patents-in-suit. Thus, the activities that may create jurisdiction are constrained to those activities relating to the *issuance* of the patents-in-suit. Any action by Carnegie in Oregon involving the patents-in-suit axiomatically occurred independently of the issuance of the patents. Ali's allegations demonstrate that his alleged involvement in inventing the patents-in-suit occurred solely at UMass's campus in Massachusetts, *see* Dkt. 4 at ¶ 8. There is simply no connection to Oregon that relates to the subject matter of Ali's § 256 suit.⁶

The cases cited by Ali are inapposite. In cases where courts have evaluated the defendants' enforcement actions with the forum state, the plaintiffs were seeking a declaratory judgment of non-infringement. *See, e.g., Radio Sys. Corp. v. Accession, Inc.*, 638 F.3d 785, 789-90 (Fed. Cir. 2011). In declaratory judgment

⁶ Nor do Ali's alternative claims for legal damages support specific personal jurisdiction. Both claims involve the existence or non-existence of a policy promulgated by UMass to govern its relationship with its employees. The locus of the agreement is Massachusetts, and it lacks any connection to the forum beyond Ali's current residence.

cases, the Federal Circuit noted that “the relevant activities are those that the defendant ‘purposefully directs . . . at the forum which relate in some material way to the enforcement or the defense of the patent.’” *Autogenomics*, 566 F.3d at 1020 (quoting *Avocent*, 552 F.3d at 1336). These types of contacts are irrelevant to an action seeking to correct the inventorship of an issued patent, which implicates a time period before the existence of a patent to enforce. *See Acromed Corp. v. Sofamor Danek Grp., Inc.*, 253 F.3d 1371, 1379 (Fed. Cir. 2001) (requiring, for a § 256 claim, “corroborating evidence of any asserted contributions to the conception” and that the contribution was not “insignificant” as measured against the patent as a whole). Similarly, the activities of Carnegie’s forum-licensees of the patents are irrelevant because the licensing activities necessarily occurred after to the operative period for the § 256 action—after the patents issued. Accordingly, regardless of the extent of Carnegie’s contacts with the forum, Ali’s § 256 claim does not arise out of or relate to those contacts, and the Court cannot assert specific jurisdiction over Carnegie.

E. Transfer of Venue

Because the Court finds that it cannot assert personal jurisdiction over Carnegie, the Court must decide whether to dismiss or transfer this case. The parties appear to have acknowledged that other judicial districts are a more appropriate place for this suit. Neither party, however, has formally asked the Court to transfer this suit to a more appropriate district. The Court *sua sponte* exercises its authority to transfer this case for the reasons stated below.

1. Legal Standards

If a district court determines that venue is inappropriate, the district court “shall dismiss, or if it be in the interest of justice, transfer such case to any district or division in which it could have been brought.” 28 U.S.C. § 1406(a). Personal jurisdiction over the defendant is not required for a transfer under § 1406(a). 28 U.S.C. § 1631; *Goldlawr, Inc. v. Heiman*, 369 U.S. 463, 466-67 (1962). A court may raise and decide the issue of venue *sua sponte*. See *Costlow v. Weeks*, 790 F.2d 1486, 1487-88 (9th Cir. 1986). Because a defendant may waive an objection to venue or personal jurisdiction, however, a court must provide notice to the parties. See *id.* at 1488; see also *Wood v. Santa Barbara Chamber of Commerce, Inc.*, 705 F.2d 1515, 1523 (9th Cir. 1983) (noting that 28 U.S.C. § 1406(a) may be used to transfer actions “to cure [a] lack of personal jurisdiction”) (citing *Goldlawr v. Heiman*, 369 U.S. 463, 466 (1961)).

To determine whether transfer is “in the interest of justice,” courts will generally consider judicial economy, the relative injustice imposed on plaintiff and defendant, whether the statute of limitations has expired, and whether the action would be re-filed if the case were dismissed. *Grain Millers, Inc. v. Pacific Flexpac, Co.*, No. 07-cv-1065-AS, 2008 WL 550124, at *2 (D. Or. Feb. 26, 2008); see also *Citizens for a Better Env’t—Ca. v. Union Oil Co. of Ca.*, 861 F. Supp. 889, 898 (N.D. Cal. 1994) *aff’d*, 83 F.3d 1111 (9th Cir. 1996); William W. Schwarzer *et al.*, *Rutter Group Practice Guide: Fed. Civ. Pro. Before Trial* ¶ 4:578 (explaining that under 28 U.S.C. §1406(a) a court “must consider the basic equities of the case”).

A transfer under 28 U.S.C. § 1406(a) must be to a transferee court where the case “could have been brought.” Under the general venue statute,⁷ venue may be found in three circumstances: (1) in a “judicial district in which [the defendant] resides”; (2) in a “judicial district in which a substantial part of the events or omissions giving rise to the claim occurred, or a substantial part of property that is the subject of the action is situated”; or (3) otherwise, “any judicial district in which any defendant is subject to the court’s personal jurisdiction with respect to such action.” See 28 U.S.C. § 1391(b). A defendant-corporation is “deemed to reside . . . in any judicial district in which such defendant is subject to the court’s personal jurisdiction with respect to the civil action in question.” See 28 U.S.C. § 1391(c)(2).

Transfer is preferred over the harsh remedy and “injustice that results from dismissing an action because the plaintiff [has] made an honest mistake as to where it could have been brought.” 14D Charles Alan Wright & Arthur R. Miller, *et al.*, *Federal Practice and Procedure*, § 3827 (3d ed. 2007). Dismissal is appropriate when the case was obviously or deliberately filed in the wrong court. *Wood*, 705 F.2d at 1523.

2. Discussion

In this case, venue is proper if the court has personal jurisdiction over Carnegie, a “substantial part of the events . . . giving rise to the claim” occurred in

⁷ 28 U.S.C. § 1400, the patent venue statute, does not apply in this action because this is not a suit for patent infringement.

this district, or a substantial part of the subject property is located within this district. As discussed above, the Court does not have personal jurisdiction over Carnegie. Further, to the extent the patents-in-suit qualify as property under § 1391(b)(2), they are presumably not located within this district because their owners are located in Massachusetts and the District of Columbia. Accordingly, venue is only proper if “a substantial part of the events . . . giving rise to the claim” occurred within this district. *See* 28 U.S.C. § 1391(b)(2). It is undisputed that none of the events giving rise to this action occurred within the District of Oregon. Ali’s alleged contributions to the patents-in-suit occurred while he was working for the named inventors at UMass’s campus in Massachusetts. *See* Dkt. 4 at ¶ 8. Ali’s relocation to Oregon occurred at some point after his allegedly material contributions to the patents-in-suit and before his filing of this lawsuit. *See Costlow*, 790 F.2d at 1488 (finding no venue in the district court because “virtually all of the activity providing the basis of the complaint took place in” another district). Because Ali cannot establish that venue is proper within this district, this suit must be dismissed or transferred pursuant to 28 U.S.C. § 1406(a).

Instead of dismissing a suit brought in an improper venue, a court may, “in the interest of justice,” transfer it to a proper district. 28 U.S.C. § 1406(a). Although Ali does not face an explicit statute of limitation problem if this case were dismissed and he were forced to re-file, the Court notes that the patents-in-suit were issued as early as 2003. *See Burnett v. New York Cent. R.R. Co.*, 380 U.S. 424, 430 (1965) (noting that many courts have transferred rather than dismissed cases to preserve a

plaintiff's opportunity for a hearing on the merits). It is not clear why Ali brought suit in this district, however, the Court notes that Ali originally filed his complaint *pro se*, which may have contributed to this procedural misstep. Further, there is no evidence that Ali brought suit in this district in bad faith. Ali has explicitly suggested that he would join with Carnegie in seeking to transfer this case to a court of "unquestioned jurisdiction," such as the United States District Court for the District of Columbia. Dkt. 64 at 5. Accordingly, the Court finds that the interests of justice would be served by transferring this action to the United States District Court for the District of Columbia, where the bulk of Carnegie's research departments and its administration are headquartered. *See, e.g., Loreto v. Cushman*, 930 F. Supp. 2d 1, 7 (D.D.C. 2013). The Court will stay the transfer order for fourteen days in order to preserve Carnegie's opportunity to waive objections to venue and personal jurisdiction, resulting in this suit remaining in this district. *See Costlow*, 790 F.2d at 1487-99; *Wood*, 705 F.2d at 1523.

Additionally, although the Court appreciates the briefs provided by the parties regarding whether UMass is a necessary and indispensable party to this suit, the Court declines to rule on this issue, which is governed by regional circuit law, due to the pending transfer. *See Muldoon v. Tropitone Furniture Co.*, 1 F.3d 964, 967 (9th Cir. 1993) (holding that the laws of the transferee district are applicable in a case transferred pursuant to 28 U.S.C. § 1406(a)); *Univ. of Utah v. Max-Planck-Gesellschaft Zur Forderung Der Wissenschaften E.V.*, Nos. 2012-1540, 2012-1541, 2012-1661, 2013 WL 4406638, at *8-9 (Fed. Cir. Aug. 19, 2013) (applying the law of the regional circuit court).

For the same reason, the Court declines ruling on Carnegie's motion to dismiss Ali's second and third claims. These arguments are denied as moot with leave to renew before the United States District Court for the District of Columbia.

CONCLUSION

Plaintiff Ali's Motion for Reconsideration re Waiver of Sovereign Immunity (Dkt. 45) is **DENIED**. Defendant Carnegie's Motion for Reconsideration of the Court's Order Granting in Part Plaintiff's Motion for Jurisdictional Discovery is **GRANTED** (Dkt. 46), and Plaintiff Ali's Motion for Jurisdictional Discovery is **DENIED** (Dkt. 30). Defendants' Motion to Dismiss or Strike Plaintiff's Amended Complaint (Dkt. 18) is **GRANTED IN PART** and **DENIED AS MOOT IN PART**; specifically, Carnegie's Motion to Dismiss for lack of personal jurisdiction is **GRANTED**, and the remaining issues are **DENIED AS MOOT WITH LEAVE TO RENEW**. In fourteen days, unless otherwise ordered by the Court, the Clerk of the Court is directed to **TRANSFER** this action to the United States District Court for the District of Columbia pursuant to 28 U.S.C. § 1406(a). All other pending motions are **DENIED AS MOOT**.

IT IS SO ORDERED.

DATED this 25th day of November, 2013.

/s/ Michael H. Simon

Michael H. Simon

United States District Judge

APPENDIX F

**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF OREGON
PORTLAND DIVISION**

Case No. 3:12-cv-01764-SI

[Filed May 28, 2013]

MUSSA ALI,)
Plaintiff,)
)
v.)
)
CARNEGIE INSTITUTION OF)
WASHINGTON, and UNIVERSITY)
OF MASSACHUSETTS,)
Defendants.)

OPINION AND ORDER

Joseph W. Berenato III, and Steven v. Kelber, Berenato & White, LLC, 6550 Rock Spring Drive, Suite 240, Bethesda, MD 20817. Joel P. Leonard, and John D. Ostrander, Elliott, Ostrander & Preston, P.C., 707 SW Washington Street, Suite 1500, Portland, OR 97205. Attorneys for Plaintiff.

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Attorneys for Defendants.

Michael H. Simon, District Judge.

Plaintiff brings this lawsuit to correct the inventorship of five issued patents related to gene silencing. For the reasons stated below, Defendants' Motion to Dismiss (Dkt. 18) is GRANTED IN PART AND DEFERRED IN PART, Plaintiff's Motion for Jurisdictional Discovery (Dkt. 30) is GRANTED IN PART AND DENIED IN PART AND STAYED, and Plaintiff's request for a Rule 16 conference (Dkt. 33) is GRANTED.

BACKGROUND

This case arises out of Plaintiff Mussa Ali's claim that he was erroneously omitted as a named inventor on five patents: U.S. Patent Nos. 6,506,559; 7,538,095; 7,560,438; 7,622,633 and 8,283,329. Am. Compl. ¶ 3, 25-26. Defendants Carnegie Institute of Washington ("Carnegie") and University of Massachusetts ("UMass") are owners, by assignment, of the patents at issue. Am. Compl. ¶ 3-4.

Defendants have filed a motion to dismiss or strike Plaintiff's First Amended Complaint ("FAC"). Dkt. 18. They argue that the Court lacks subject matter jurisdiction over the action based on the sovereign immunity of Defendant UMass and its status as a "required party." In the alternative, Defendants contend that the Court lacks personal jurisdiction over all Defendants. Before Plaintiff's response was due, Plaintiff filed a motion seeking jurisdictional discovery on both aspects of Defendants' motion to dismiss. Dkt. 30. Simultaneously, Plaintiff filed a request for a

Rule 16 Conference to discuss and schedule any allowed jurisdictional discovery. Dkt. 33. Defendants oppose Plaintiff's request for a Rule 16 conference, urging the Court to decide their motion to dismiss without permitting discovery. Dkt. 34.

On April 9, 2013, the Court issued a Minute Order stating that it was considering ordering a stay of this litigation until the U.S. Court of Appeals for the Federal Circuit issued its opinion in a pending case that appears to involve similar factual and legal issues. Dkt. 35 referring to *University of Utah v. Max-Planck*, No. 12-1540 (Fed. Cir. 2013). The Court invited any party wishing to be heard on that question to file a motion within 14 days. *Id.* All parties objected to the Court's contemplated stay, arguing that the cited case would not be dispositive or the pending motion to dismiss could be decided on alternative grounds. Dkts. 39, 40. Since that time, Defendants filed a memorandum arguing that Plaintiff's failure substantively to respond to Defendants' motion to dismiss is sufficient grounds for the Court to grant that motion. Dkt. 37. Defendants also filed their opposition to Plaintiff's request for jurisdictional discovery. Dkt. 38.

STANDARDS

In patent cases, Federal Circuit law governs the relevance of a request for jurisdictional discovery. *See Commissariat A L'Energie Atomique v. Chi Mei Optoelectronics Corp.*, 395 F.3d 1315, 1323 (Fed. Cir. 2005); *Beverly Hills Fan Co. v. Royal Sovereign Corp.*, 21 F.3d 1558, 1564 (Fed. Cir. 1994). Whether jurisdictional discovery is warranted, however, is a question answered by the law of the regional circuit.

See Chi Mei, 395 F.3d at 1323 (relying on regional circuit law to determine whether the party seeking discovery “made a sufficient threshold showing”); *see also Autogenomics, Inc. v. Oxford Gene Tech. Ltd.*, 566 F.3d 1012, 1021 (Fed. Cir. 2009) (“We review the district court’s denial of discovery, an issue not unique to patent law, for abuse of discretion, applying the law of the regional circuit.”).

Because there is no statutorily proscribed method for resolving jurisdictional disputes before trial, the mode of resolution is left in the discretion of the trial court. *See Data Disc, Inc. v. Sys. Tech. Assocs., Inc.*, 557 F.2d 1280, 1285 (9th Cir. 1977) (citing *Gibbs v. Buck*, 307 U.S. 66, 71-72 (1939)). If a court limits the presentation of relevant evidence to “affidavits plus discovery materials,” as opposed to holding an evidentiary hearing, then the plaintiff “must make only a prima facie showing of jurisdictional facts through the submitted materials in order to avoid a defendant’s motion to dismiss.” *Id.* In considering whether to grant or deny jurisdictional discovery, a trial court has broad discretion. *Id.* Generally, discovery is appropriate “where pertinent facts bearing on the question of jurisdiction are controverted or where a more satisfactory showing of the facts is necessary.” *Id.* at 1285 n.1 (citing *Wells Fargo & Co. v. Wells Fargo Express Co.*, 556 F.2d 406, 430 n.24 (9th Cir. 1977)). A court may deny jurisdictional discovery unless the denial “will result in ‘actual and substantial prejudice to the complaining litigant’ (e.g., ‘a reasonable probability that the outcome would have been different had discovery been allowed’).” *Digeo, Inc. v. Audible, Inc.*, 505 F.3d 1362, 1370 (Fed. Cir. 2007) (quoting

Laub v. U.S. Dep't of Interior, 342 F.3d 1080, 1093 (9th Cir. 2003)).

DISCUSSION

Defendants assert two independent grounds for complete dismissal of this case. First, Defendants argue that UMass is entitled to sovereign immunity and that UMass is a required party that cannot be joined; thus, the case must be dismissed, Defendants argue, pursuant to Federal Rule of Civil Procedure 12(b)(7). Second, Defendants argue that the Court cannot properly exercise personal jurisdiction over them. In the alternative to these two arguments for complete dismissal, Defendants contend that Plaintiff's second count and alternative second count must be dismissed for failure to state a claim pursuant to Federal Rule of Civil Procedure 12(b)(6). In response to Defendants' motion to dismiss, Plaintiff seeks discovery related to Defendants' motion and a Rule 16 conference. Except in part, Plaintiff has not yet responded to the merits of Defendants' motion.

A. UMass's Sovereign Immunity

Defendants argue that UMass should be dismissed because it is immune from suit under the Eleventh Amendment as an arm of the state of Massachusetts. Plaintiff opposes Defendants' contention, arguing that discovery is necessary to determine whether UMass is entitled to immunity or if it has waived its sovereign immunity.

The Eleventh Amendment provides sovereign immunity to states from suits brought in federal court.¹ See *Idaho v. Coeur d'Alene Tribe of Idaho*, 521 U.S. 261, 268 (1997). “[A] federal court has subject matter jurisdiction to hear cases involving federal law, but the Eleventh Amendment gives the state ‘a sovereign immunity from suit.’” *Tegic Commc’ns Corp. v. Bd. of Regents of Univ. of Texas Sys.*, 458 F.3d 1335, 1340 (Fed. Cir. 2006) (quoting *Coeur d'Alene Tribe*, 521 U.S. at 267). Sovereign immunity applies to actions brought under the patent laws of the United States. See generally *Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank*, 527 U.S. 627 (1999) (holding that Congress did not properly abrogate states’ Eleventh Amendment immunity from suits under the Patent Act). A state, however, may waive its immunity from suit under two circumstances: “when the state makes a ‘clear declaration’ that it intends to waive immunity, such as by statute, or when the state voluntarily invokes federal jurisdiction.” *Tegic Commc’ns*, 458 F.3d at 1340 (internal citations omitted) (citing *Port Auth. Trans-Hudson Corp. v. Feeney*, 495 U.S. 299 (1990); *Gunter v. Atl. Coast Line R.R. Co.*, 200 U.S. 273 (1906)).

The Eleventh Amendment only applies to states and state officials; it does not apply “to counties and similar municipal corporations.” *Mt. Healthy City Sch. Dist.*

¹ Because sovereign immunity is not unique to patent law, the Federal Circuit applies the law of the regional circuit court. See *Intel Corp. v. Commonwealth Scientific & Indus. Research Org.*, 455 F.3d 1364, 1369 (Fed. Cir. 2006) (applying Ninth Circuit law to a claim of immunity under the Foreign Sovereign Immunities Act).

Bd. of Educ. v. Doyle, 429 U.S. 274, 280 (1977). If a defendant is an “arm of the state,” then it is entitled to Eleventh Amendment immunity from suit. *See id.* To determine whether a public entity is an arm of the state, a court looks at five factors:

- (1) whether a money judgment would be satisfied out of state funds,
- (2) whether the entity performs central governmental functions,
- (3) whether the entity may sue or be sued,
- (4) whether the entity has the power to take property in its own name or only the name of the state, and
- (5) the corporate status of the entity.

Holz v. Nenana City Pub. Sch. Dist., 347 F.3d 1176, 1180 (9th Cir. 2003) (internal quotation marks and citation omitted). “To determine these factors, the court looks to the way state law treats the entity.” *Durning v. Citibank, N.A.*, 950 F.2d 1419, 1423 (9th Cir. 1991) (quoting *Mitchell v. Los Angeles Cmty. Coll. Dist.*, 861 F.2d 198, 201 (9th Cir. 1988), *cert. denied*, 490 U.S. 1081 (1989)). The party asserting sovereign immunity has the “burden of proving the facts that establish its immunity.” *ITSI T.V. Prods., Inc. v. Agric. Assocs.*, 3 F.3d 1289, 1292 (9th Cir. 1993). The Ninth Circuit has noted, however, that immunity will be in serious dispute “only where a relatively complex institutional arrangement makes it unclear whether a given entity ought to be treated as an arm of the state.” *Id.*

Notwithstanding Plaintiff’s arguments to the contrary, the five factors identified generally do not require the presentation of extraneous evidence. *See, e.g., ITSI*, 3 F.3d at 1292-94 (deciding the defendant was not an arm of the state with reference to various portions of the California Code); *Durning*, 950 F.2d at

1424 (deciding the defendant was not an arm of the state with reference to Wyoming statutes and case law). This issue can be decided solely with reference to Massachusetts statutes and the consensus of Massachusetts courts, which conclude that UMass is entitled to sovereign immunity.

The first factor—whether a monetary judgment for the plaintiff “would have to be satisfied out of public funds from the state treasury”—is the most important. *See Durning*, 950 F.2d at 1424 (relying on *Edelman v. Jordan*, 415 U.S. 651, 663 (1974)). With limited exceptions not relevant here, Massachusetts indemnifies members of UMass’s Board of Trustees “for any claim arising out of any official judgment, decision, or conduct of said member.” Mass. Gen. Laws ch. 75, § 1A; *see also Hannigan v. New Gamma-Delta Chapter of Kappa Sigma Fraternity, Inc.*, 367 Mass. 658, 659, 327 N.E.2d 882, 883 (1975) (holding the trustees “are one and the same party, namely the Commonwealth of Massachusetts”). Thus, the first factor favors a finding of sovereign immunity for UMass.

The second factor is whether the entity performs central government functions. The Ninth Circuit has recognized that “public education is a central government function.” *See Durning*, 950 F.2d at 1426 (collecting cases). It is undisputed that UMass’s central function is public education. *See* Mass. Gen. Laws ch. 75, § 1 (creating UMass “as a public institution of higher learning”). Thus, the second factor favors sovereign immunity.

The third factor is whether the entity may sue or be sued. The Massachusetts Supreme Judicial Court has recognized that “[f]or purposes of the Commonwealth’s

consent to be sued, the University of Massachusetts and the Commonwealth are one and the same.” *Wong v. Univ. of Mass.*, 438 Mass. 29, 36, 777 N.E.2d 161, 167 (2002) (quotations and citation omitted). Thus, the third factor favors sovereign immunity.

The fourth factor is whether the entity can take property in its own name. Generally, UMass’s ability to manage its property is limited, doing so only “on behalf of the commonwealth.” Mass. Gen. Laws ch. 75, § 12; *see also* Mass. Gen. Laws ch. 75, § 25 (granting the trustees limited powers to convey land “in the name of and for the commonwealth”). Thus, the fourth factors favors sovereign immunity.

The fifth and final factor is whether the entity has its own independent corporate identity. As mentioned above, the Massachusetts courts consider UMass and the commonwealth to be “one and the same.” *See Wong*, 438 Mass. at 36, 777 N.E.2d at 167. Indeed, Massachusetts courts explicitly hold that UMass, as the alter ego of the commonwealth, is entitled to sovereign immunity. *See, e.g., Cameron Painting, Inc. v. Univ. of Mass.*, 83 Mass. App. Ct. 345, 347, 983 N.E.2d 1210, 1213 (2013) (“[A]s a component of the Commonwealth, the University cannot be sued unless the Commonwealth has consented to a waiver of its sovereign immunity.”) Because all five factor point in the same direction, the Court concludes that UMass is an arm of the state of Massachusetts and is entitled to sovereign immunity from suit.²

² The cases cited by Plaintiff are inapplicable. In *Comeau v. Volusia Cnty.*, 609-CV-1907-ORL28KRS, 2010 WL 2293291 (M.D. Fla. June 7, 2010), the court, relying on a Florida Supreme Court

Plaintiff also asserts the possibility of UMass's waiver of sovereign immunity as a basis for granting relevant discovery. As noted above, a state waives sovereign immunity in only two instances: (1) a state's voluntarily invocation of the jurisdiction of a federal court; or (2) a state's "clear declaration" that it intends to submit itself to the jurisdiction of a federal court. *See Coll. Sav. Bank*, 527 U.S. at 675-76. "[A]ny waiver of sovereign immunity by a state must be express and voluntary, and cannot be implied or constructive." *State Contracting & Eng'g Corp. v. State of Fla.*, 258 F.3d 1329, 1336 (Fed. Cir. 2001) (citing *Coll. Sav. Bank*, 527 U.S. at 682).

Plaintiff cites *Intel Corp. v. Commonwealth Scientific & Indus. Research Org.*, 455 F.3d 1364 (Fed. Cir. 2006), to support his argument that a state-patent owner may waive sovereign immunity by licensing or threatening to enforce its patents. Pl.'s Disc. Br. at 5. *Intel*, however, is inapposite because the immunity at issue in that case was conferred by the Foreign Sovereign Immunities Act ("FSIA"), 28 U.S.C. §§ 1602-

case, held that determining whether "a governmental action qualifies as a discretionary governmental process," which Florida exempted from a waiver of immunity, was a "fact-intensive inquiry." *Id.* at *2 (internal quotations omitted) (citing *Commercial Carrier Corp. v. Indian River Cnty.*, 371 So.2d 1010, 1919 (Fla. 1979)). In *Walker v. City of Waterbury*, 228 F.R.D. 118 (D. Conn. 2005), the court declined to rule whether a non-party was entitled to sovereign immunity because the non-party, not the plaintiff, would "be in a far better position . . . to bring to the Court's attention all relevant facts." *Id.* at 120-21. None of the unique circumstances present in these cited cases apply here; instead, UMass falls squarely within the definition of an "arm of the state" as elucidated by the five-factor test.

11, not by the Eleventh Amendment. *Id.* at 1366. As the court noted, FSIA contains an immunity exception for foreign sovereigns engaged in “commercial activity carried on in the United States.” *Id.* at 1369 (quoting 28 U.S.C. § 1605(a)(2)). The FSIA’s legislative history emphasizes Congress’s attempt to “codify the so-called ‘restrictive’ principle of sovereign immunity, . . . [wherein] the immunity of a foreign state is ‘restricted’ to suits involving a foreign state’s public acts . . . and does not extend to suits based on its commercial or private acts . . .” *Id.* (citing H.R.Rep. No. 94-1487, at 7 (1976), *reprinted in*, 1976 U.S.C.C.A.N. 6604, 6605). As the Supreme Court has made clear, however, Eleventh Amendment sovereign immunity cannot be characterized as “restrictive.” *See, e.g., Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666, 686 n.4 (“[S]tate sovereign immunity, unlike foreign sovereign immunity, is a *constitutional* doctrine that is meant to be both immutable by Congress and resistant to trends.”). Except for the specific methods of waiver previously identified, the Eleventh Amendment does not contain exceptions for the commercial activity of states. As such, the information that Plaintiff seeks about UMass’s use of the patents in suit would not support a waiver of sovereign immunity.

Even assuming that UMass litigates or licenses the patents in suit, UMass has not “invoked” the jurisdiction of *this* federal court by engaging in “classic litigation tactics . . . [with] the patents in suit” or by participating in an *inter partes* reexamination. *See* Pl.’s Disc. Br. at 6. A state’s filing of a patent infringement suit does not effectuate a complete waiver of sovereign immunity, even with respect to the infringed patents. *See Tegic Commc’ns*, 458 F.3d at 1341-43. Any such

waiver is limited to the complete adjudication of the state's suit, including any compulsory counterclaims, in the state's chosen forum. *See id.* The state's suit does not, however, waive sovereign immunity from a suit on the same patent filed in a different court by a different party. *See id.* (citing *Lapides v. Bd. of Regents of the Univ. Sys. of Ga.*, 535 U.S. 613, 620 (2002)) ("While waiver in the litigation context focuses on the litigation act, the waiver must nonetheless be "clear.>"). Thus, no evidence of any litigation by UMass of the patents in suit, assuming that such litigation exists, would effectuate any waiver of immunity sufficient to permit Plaintiff's suit in this district. Further, to the extent that UMass may have participated in the *inter partes* reexamination of one of the relevant patents, that reexamination, at most, would have waived UMass's immunity to any review of that decision. *See Vas-Cath, Inc. v. Curators of Univ. of Mo.*, 473 F.3d 1376, 1384 (Fed. Cir. 2007) ("[W]hen the University initiated and participated in the interference, its participation included the ensuing statutory review procedures; the University cannot invoke Eleventh Amendment immunity, after it prevailed, to shield the agency decision from review.>").

Because none of the theories advanced by Plaintiff can demonstrate that UMass is not entitled to, or has waived, state sovereign immunity, Plaintiff's proposed discovery is not relevant. Accordingly, Plaintiff's Motion for Jurisdictional Discovery is denied with respect to any issues relating to sovereign immunity. Further, there does not appear to be any dispute in the case law that UMass is an arm of the state of

Massachusetts entitled to sovereign immunity; thus, UMass is dismissed from this lawsuit.³

B. Personal Jurisdiction

Defendants also argue that this case should be dismissed because they are not subject to personal jurisdiction in this forum. Plaintiff responds that Defendants' actions and use of the patents in suit, primarily through licensing, are sufficient to confer

³ The Court recognizes that Plaintiff has not been heard on the legal issues surrounding UMass's status as an arm of the state. The Court has independently researched the issues in granting this portion of Defendants' motion and concludes the dictates of sovereign immunity and efficiency counsel the immediate dismissal of UMass. If, however, Plaintiff believes the Court's conclusion on this point is in error, then Plaintiff is given leave to file a motion to reconsider within 14 days stating the *legal* basis for his contrary conclusion.

Plaintiff also argues that discovery is necessary so he can determine the appropriate UMass officers to sue pursuant to *Ex Parte Young*, 209 U.S. 123 (1908). Plaintiff's citation to *Univ. of Utah v. Max-Planck-Gesellschaft zur Forderung der Wissenschaften E.V.*, 881 F. Supp. 2d 151 (D. Mass. 2012), appears to provide that information. In *Univ. of Utah*, instead of UMass, the plaintiff filed suit against the "President of the University of Massachusetts . . . Executive Vice President and Chief Operating Officer of the University of Massachusetts . . . Senior Vice President for Administration, Finance, & Technology and University Treasurer of the University of Massachusetts . . . and . . . Executive Director, Office of Technology Management of the University of Massachusetts," each in their official capacities. *Id.* at 151. If Plaintiff so chooses, he is given leave to amend his complaint to include some or all of these officials. *See* Fed. R. Civ. P. 15(a) ("The court should freely give leave [to amend] when justice so requires.").

personal jurisdiction. He requests related discovery to support his contentions.

To assert personal jurisdiction over an out-of-state defendant in a patent-related dispute, a court must resolve two inquiries: “whether a forum state’s long-arm statute permits service of process and whether assertion of personal jurisdiction violates due process.” *Genetic Implant Sys., Inc. v. Core-Vent Corp.*, 123 F.3d 1455, 1458 (Fed. Cir. 1997). In this case, these inquiries merge because Oregon’s long-arm statute extends jurisdiction “to the outer limits of due process.” *State ex rel. Hydraulic Servocontrols Corp. v. Dale*, 294 Or. 381, 384 (1982); accord *Inamed Corp. v. Kuzmak*, 249 F.3d 1356, 1360 (Fed. Cir. 2001) (“[B]ecause California’s long-arm statute is coextensive with the limits of due process, the two inquiries collapse into a single inquiry: whether jurisdiction comports with due process.”).

The Due Process Clause “protects an individual’s liberty interest in not being subject to the binding judgments of a forum with which he has established no meaningful contacts, ties, or relations.”⁴ *Burger King*

⁴ The Federal Circuit has noted that because a federal court’s subject matter jurisdiction to hear patent disputes is based on federal question jurisdiction, 28 U.S.C. § 1331, rather than diversity jurisdiction, 28 U.S.C. § 1332, the Due Process Clause of the Fifth Amendment, rather than the Due Process Clause of the Fourteenth Amendment, governs the court’s assertion of personal jurisdiction. *Deprenyl Animal Health, Inc. v. Univ. of Toronto Innovations Found.*, 297 F.3d 1343, 1350 (Fed. Cir. 2002); see generally *Honeywell, Inc. v. Metz Apparatewerke*, 509 F.2d 1137, 1143 (7th Cir. 1975). *Int’l Shoe Co. v. Washington*, 326 U.S. 310 (1945), and its progeny were decided under the Due Process Clause

Corp. v. Rudzewicz, 471 U.S. 462, 471-72 (1985) (internal quotation marks and citation omitted). To satisfy due process, the plaintiff must show that the defendant has “certain minimum contacts with [the forum state] such that the maintenance of the suit does not offend traditional notions of fair play and substantial justice.” *Int’l Shoe Co. v. Washington*, 326 U.S. 310, 316 (1945). Under the “minimum contacts” test, “a defendant may be subject to either specific jurisdiction or general jurisdiction.” *LSI Indus. Inc. v. Hubbell Lighting, Inc.*, 232 F.3d 1369, 1375 (Fed. Cir. 2000). A court has general personal jurisdiction over an out-of-state defendant when that defendant has “continuous and systematic general business contacts” with the forum state. *Helicopteros Nacionales de Colombia, S.A. v. Hall*, 466 U.S. 408, 416 (1984). A court has specific personal jurisdiction where “the defendant has purposefully directed his activities at residents of the forum, and the litigation results from alleged injuries that arise out of or relate to those activities.” *Burger King Corp.*, 471 U.S. at 472 (internal quotation marks and citations omitted). Thus, in “contrast to general, all-purpose jurisdiction, specific jurisdiction is confined to adjudication of issues deriving from, or connected with, the very controversy

of the Fourteenth Amendment. *See id.* at 311 (the question “for decision [is] whether, within the limitations of the due process clause of the Fourteenth Amendment, appellant, a Delaware corporation, has by its activities in the State of Washington rendered itself amenable to proceedings in the courts of that state”). Nonetheless, the Federal Circuit applies the standards developed in *Int’l Shoe* and its progeny “to Fifth Amendment due process cases arising under the federal patent laws.” *Deprenyl Animal Health*, 297 F.3d at 1350.

that establishes jurisdiction.” *Goodyear Dunlop Tires Operations, S.A. v. Brown*, 131 S. Ct. 2846, 2851 (2011) (internal quotation marks and citation omitted).

In this case, the parties disagree about the extent to which actions of related third-parties—primarily licensees and co-inventors—can subject an entity to personal jurisdiction in a forum. Plaintiff’s primary contentions are that Defendants’ use of the patents through licensing and the actions of the patents’ listed inventors subject Defendants to personal jurisdiction in Oregon. As a basis for general personal jurisdiction, Plaintiff asserts that Defendants support research conducted in Oregon.

Personal jurisdiction cannot be based on “the unilateral activity of another party or a third person,” *Burger King Corp.*, 471 U.S. at 475 (quoting *Helicopteros Nacionales*, 466 U.S. at 417). Jurisdiction may be appropriate, however, when a party’s contacts with a forum resident create “continuing obligations” between the parties. *See id.* at 475-76. The mere existence of a licensor-licensee relationship is insufficient, without more, to subject the licensor to personal jurisdiction in a forum where its licensee has sufficient contacts. *See Red Wing Shoe Co., Inc. v. Hockerson-Halberstadt, Inc.*, 148 F.3d 1355, 1361 (Fed. Cir. 1998) (“[D]oing business with a company that does business in Minnesota is not the same as doing business in Minnesota.”). Indeed, due process requires more than “contact with parties in the forum state beyond the sending of cease and desist letters or mere attempts to license the patent at issue there.” *See Breckenridge Pharm., Inc. v. Metabolite Laboratories, Inc.*, 444 F.3d 1356, 1366 (Fed. Cir. 2006). Where a

defendant-licensor grants an exclusive license to a third-party doing business in a forum, a court must give “close examination” to the license agreement. *Id.* Personal jurisdiction is proper in the third party-licensee’s forum where the license gives the defendant-licensor “the right to litigate infringement cases or granting the licensor the right to exercise control over the licensee’s sales or marketing activities.” *Id.*

In declarations submitted in support of their motion to dismiss, Defendants aver that no licensee of the patents in suit is domiciled in Oregon. *See* Allen Decl., Dkt. 20, ¶ 6; Williams Decl., Dkt. 21, ¶ 6. Plaintiff argues that there is evidence that product derived from the patents in suit are manufactured and sold in Oregon. *See, e.g.,* Kelber Decl., Dkt. 32, Exs. B. Defendants contend that any such licenses would be legally insufficient to support jurisdiction, but their argument omits any discussion of the nature of the licenses. Further, the distinction between non-exclusive and exclusive licenses is not as clear as Defendants suggest. *See generally Breckenridge*, 444 F.3d at 1366 (delineating between “mere attempts to license the patent at issue” and exclusive licenses, without discussing non-exclusive licenses). What is clear, however, is that the nature of the relationship between Defendants and their licensees in Oregon, if any, may be relevant to the resolution of the question of personal jurisdiction. *See Digeo, Inc.*, 505 F.3d at 1370.

Thus, the Court will permit Plaintiff to conduct limited discovery regarding this issue of personal jurisdiction. To that extent, the Court GRANTS IN PART Plaintiff’s motion for discovery related to personal jurisdiction. Dkt. 30. Given the potentially

dispositive nature of the still-pending Rule 12(b)(7) motion, however, which can independently resolve this case, the grant of this discovery is stayed. *See, e.g., Alaska Cargo Transp., Inc. v. Alaska R.R. Corp.*, 5 F.3d 378, 383 (9th Cir. 1993) (affirming a district court's stay of discovery when there was no indication "the discovery sought was relevant to whether or not the court has subject matter jurisdiction"); *Jarvis v. Regan*, 833 F.2d 149, 155 (9th Cir. 1987) (affirming a district court's stay of discovery when the complaint "did not raise factual issues that required discovery for their resolution").

Finally, the Court GRANTS Plaintiff's request for a Rule 16 conference. Dkt. 33. The Courtroom Deputy will contact the parties to arrange for a telephone conference for that purpose.

CONCLUSION

Defendants' Motion to Dismiss (Dkt. 18) is GRANTED IN PART AND DEFERRED IN PART; Defendant University of Massachusetts is DISMISSED, and the Court's ruling on the remaining issues contained in Defendants' motion is DEFERRED. Within 14 days, Plaintiff may file a motion for reconsideration as provided for in footnote 3 of the Court's Opinion and Order. Also within 14 days, Plaintiff shall file his response to Defendant Carnegie Institution of Washington's Motion to Dismiss (Dkt. 18) concerning the argument that the University of Massachusetts is a necessary party. Defendant Carnegie Institution of Washington shall file its reply brief 14 days thereafter. As part of this briefing, the parties should also address the following two questions: (1) If this case must be dismissed because the

University of Massachusetts is necessary party, may Plaintiff bring this action in any other court of competent jurisdiction; and (2) if not, does this result raise due process concerns? *See Xechem Int'l, Inc. v. Univ. of Tex. M.D. Anderson Cancer Ctr.*, 382 F.3d 1324, 1332-35 (Fed. Cir. 2004) (Newman, J. additional views). Plaintiff's Motion for Jurisdictional Discovery (Dkt. 30) is GRANTED IN PART AND DENIED IN PART; Plaintiff's request for discovery regarding personal jurisdiction is GRANTED BUT STAYED, and Plaintiff's request for discovery regarding any other matter is, at this time, DENIED. Plaintiff's Motion for a Rule 16 conference (Dkt. 33) is GRANTED; the Courtroom Deputy will contact counsel for the parties to arrange for a telephonic Rule 16 conference. Finally, the deadline for Plaintiff to file an amended complaint will be set during the Rule 16 conference.

IT IS SO ORDERED

DATED this 28th day of May, 2013.

/s/ Michael H. Simon
Michael H. Simon
United States District Judge

APPENDIX G

NOTE: This order is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

2016-2320

[Filed July 20, 2017]

MUSSA ALI,)
<i>Plaintiff-Appellant</i>)
)
v.)
)
CARNEGIE INSTITUTION OF)
WASHINGTON, UNIVERSITY)
OF MASSACHUSETTS,)
<i>Defendants-Appellees</i>)

Appeal from the United States District Court for the
District of Columbia in No. 1:13-cv-02030-RC, Judge
Rudolph Contreras.

ON PETITION FOR REHEARING EN BANC

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Before PROST, *Chief Judge*, NEWMAN, LOURIE,
BRYSON*, DYK, MOORE, REYNA, WALLACH, TARANTO,
CHEN, HUGHES, and STOLL, *Circuit Judges***

PER CURIAM.

O R D E R

Appellant Mussa Ali filed a petition for rehearing en banc. A response was invited by the court, and filed by appellees Carnegie Institution of Washington and University of Massachusetts. The petition was first referred as a petition for rehearing to the panel that heard the appeal, and thereafter the petition for rehearing en banc was referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

The mandate of the court will issue on July 27, 2017.

FOR THE COURT

July 20, 2017
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

* Circuit Judge Bryson participated only in the decision on the petition for panel rehearing.

** Circuit Judge O'Malley did not participate.

APPENDIX H

U.S. Const. art. 1, sec. 8

The Congress shall have power to lay and collect taxes, duties, imposts and excises, to pay the debts and provide for the common defense and general welfare of the United States; but all duties, imposts and excises shall be uniform throughout the United States;

To borrow money on the credit of the United States;

To regulate commerce with foreign nations, and among the several states, and with the Indian tribes;

To establish a uniform rule of naturalization, and uniform laws on the subject of bankruptcies throughout the United States;

To coin money, regulate the value thereof, and of foreign coin, and fix the standard of weights and measures;

To provide for the punishment of counterfeiting the securities and current coin of the United States;

To establish post offices and post roads;

To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries;

To constitute tribunals inferior to the Supreme Court;

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To define and punish piracies and felonies committed on the high seas, and offenses against the law of nations;

To declare war, grant letters of marque and reprisal, and make rules concerning captures on land and water;

To raise and support armies, but no appropriation of money to that use shall be for a longer term than two years;

To provide and maintain a navy;

To make rules for the government and regulation of the land and naval forces;

To provide for calling forth the militia to execute the laws of the union, suppress insurrections and repel invasions;

To provide for organizing, arming, and disciplining, the militia, and for governing such part of them as may be employed in the service of the United States, reserving to the states respectively, the appointment of the officers, and the authority of training the militia according to the discipline prescribed by Congress;

To exercise exclusive legislation in all cases whatsoever, over such District (not exceeding ten miles square) as may, by cession of particular states, and the acceptance of Congress, become the seat of the government of the United States, and to exercise like authority over all places purchased by the consent of the legislature of the state in which the same shall be, for the erection of forts, magazines, arsenals, dockyards, and other needful buildings;--And

To make all laws which shall be necessary and proper for carrying into execution the foregoing powers, and all other powers vested by this Constitution in the government of the United States, or in any department or officer thereof.

U.S. Const. amend. XI

The judicial power of the United States shall not be construed to extend to any suit in law or equity, commenced or prosecuted against one of the United States by citizens of another state, or by citizens or subjects of any foreign state.

U.S. Const. amend. XIV

Section 1.

All persons born or naturalized in the United States, and subject to the jurisdiction thereof, are citizens of the United States and of the state wherein they reside. No state shall make or enforce any law which shall abridge the privileges or immunities of citizens of the United States; nor shall any state deprive any person of life, liberty, or property, without due process of law; nor deny to any person within its jurisdiction the equal protection of the laws.

Section 2.

Representatives shall be apportioned among the several states according to their respective numbers, counting the whole number of persons in each state, excluding Indians not taxed. But when the right to vote at any election for the choice of electors for President and Vice President of the United States, Representatives in Congress, the executive and judicial

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officers of a state, or the members of the legislature thereof, is denied to any of the male inhabitants of such state, being twenty-one years of age, and citizens of the United States, or in any way abridged, except for participation in rebellion, or other crime, the basis of representation therein shall be reduced in the proportion which the number of such male citizens shall bear to the whole number of male citizens twenty-one years of age in such state.

Section 3.

No person shall be a Senator or Representative in Congress, or elector of President and Vice President, or hold any office, civil or military, under the United States, or under any state, who, having previously taken an oath, as a member of Congress, or as an officer of the United States, or as a member of any state legislature, or as an executive or judicial officer of any state, to support the Constitution of the United States, shall have engaged in insurrection or rebellion against the same, or given aid or comfort to the enemies thereof. But Congress may by a vote of two-thirds of each House, remove such disability.

Section 4.

The validity of the public debt of the United States, authorized by law, including debts incurred for payment of pensions and bounties for services in suppressing insurrection or rebellion, shall not be questioned. But neither the United States nor any state shall assume or pay any debt or obligation incurred in aid of insurrection or rebellion against the United States, or any claim for the loss or

emancipation of any slave; but all such debts, obligations and claims shall be held illegal and void.

Section 5.

The Congress shall have power to enforce, by appropriate legislation, the provisions of this article.

35 U.S.C. § 256

(a) Correction.—

Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

(b) Patent Valid if Error Corrected.—

The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The 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.