NOTE: This order is nonprecedential.

United States Court of Appeals for the Federal Circuit

HEAT TECHNOLOGIES, INC.,
Plaintiff-Respondent

v.

PAPIERFABRIK AUGUST KOEHLER SE, MANFRED HUBER, JOACHIM UHL, LUTZ KUHNE, MICHAEL BOSCHERT,
Defendants-Petitioners

2019-120

On Petition for Permission to Appeal pursuant to 28 U.S.C. Section 1292(b) from the United States District Court for the Northern District of Georgia in No. 1:18-cv-01229-LMM, Judge Leigh Martin May.

ON PETITION

Before MOORE, O'MALLEY, and HUGHES, *Circuit Judges*.

MOORE, *Circuit Judge*.

O R D E R

Papierfabrik August Koehler SE et al. (collectively, "Koehler") petition for permission to appeal an order

certified for immediate appeal by the United States District Court for the Northern District of Georgia denying their motion to dismiss Heat Technologies, Inc.'s ("HTI") claim for correction of inventorship under 35 U.S.C. § 256. HTI opposes the petition. Koehler also moves for leave to file a reply in support of its petition, which HTI opposes. For the following reasons, we *deny* the petition.

HTI filed this suit against Koehler in the Northern District of Georgia. In addition to state law claims of unjust enrichment and conversion, HTI asked the district court to correct inventorship of Koehler's U.S. Patent No. 9,851,146.* HTI asserted that Koehler's patent claimed an invention that was conceived solely by HTI's president, Gene Plavnik, and had been previously disclosed to Koehler in connection with its evaluation of HTI's technology. The complaint also asserted that most, if not all, of the subject matter was previously disclosed in HTI's own patent application filed more than two years earlier.

Koehler moved to dismiss HTI's correction of inventorship claim for failure to state a claim for relief and moved the court to decline to exercise supplemental jurisdiction over the remaining state law claims. Koehler argued that § 256 cannot be used when the same alleged facts underlying the correction of inventorship claim would invalidate the patent for lack of novelty, obviousness, and the on-sale bar. The district court denied the motion, concluding

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* Section 256(a) authorizes a court to order the United States Patent and Trademark Office to issue a certificate of correction when through "error an inventor is not named in an issued patent." Section 256(b) states, in relevant part, that such an omission "shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section."

that § 256 jurisdiction does not depend on whether the patent is valid. However, because other district courts had reached a different conclusion on the same issue, the district court granted Koehler's request to certify the order for interlocutory appeal under 28 U.S.C. § 1292(b).

Section 1292(b) requires three criteria for certification: (1) the otherwise non-appealable order must be one that "involves a controlling question of law"; (2) "there is substantial ground for difference of opinion"; and (3) "an immediate appeal from the order may materially advance the ultimate termination of the litigation." § 1292(b). Even when the district court is of the opinion that these criteria are established, it is left up to the discretion of the appellate court to decide whether to permit the appeal. *Id.*

Here, the district court agreed to certify the order based on the following question of law: "Can a claimant obtain relief under 35 U.S.C. § 256 when its inventorship allegations, if taken or proven as true, would necessarily invalidate the subject patent under other provisions of the Patent Act?" We must decline review because we cannot say that there is a "substantial ground for difference of opinion" on that question or that resolving this question now would likely lead to the end of the litigation.

We see no error in the district court's conclusion that a § 256 claim for correction of inventorship can proceed notwithstanding other potential challenges to the patent's validity. As the district court noted, "[n]othing in § 256 concerns whether naming the true inventor would cause the patent to be invalid for other reasons," and the court's jurisdiction under § 256 does not depend on whether the patent may be shown to be invalid. And while this court has not directly addressed the issue, our prior cases compel the conclusion reached by the district court. *Cf. Frank's Casing Crew & Rental Tools, Inc. v. PMR Techs., Ltd.*, 292 F.3d 1363, 1377 (Fed. Cir. 2002) (stating that "[n]othing in the statute governing a court's power to correct

inventorship, 35 U.S.C. § 256, . . . prevents a court from correcting the inventorship of an unenforceable patent"); *see also Pannu v. Iolab Corp.*, 155 F.3d 1344, 1351 & 1351 n.5 (Fed. Cir. 1998).

Moreover, the district court did not address whether the allegations would actually lead to the patent being determined invalid and instead concluded that even if it could consider whether the patent would be invalid for other reasons, then such inquiry—"if required at all—should be at a later date with a fulsome record." It is therefore far from clear that interlocutory appeal would actually produce a saving of the court's or the parties' resources or shorten the time to complete resolution of this case.

Accordingly,

IT IS ORDERED THAT:

(1) The petition is denied.

(2) The motion for leave to file a reply is granted. The reply, ECF No. 20 (pages 9–26), is accepted for filing.

FOR THE COURT

July 18, 2019
Date

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

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