

2020-1715, -1716

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

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OMNI MEDSCI, INC.,

*Plaintiff-Appellee*

v.

APPLE INC.,

*Defendant-Appellant*

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Appeals from the United States District Court, Northern District  
of California, Case Nos. 4:19-cv-05924-YGR and 4:19-cv-05673-  
YGR, Judge Yvonne Gonzalez Rogers

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**OMNI MEDSCI, INC.'S RESPONSE TO  
APPLE INC.'S PETITION FOR REHEARING EN BANC**

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October 18, 2021

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## Certificate of Interest

Counsel for Plaintiff-Appellee, Omni MedSci, Inc., certifies the following:

1. The full name of party represented by me: Omni MedSci, Inc.

2. The name of the real party in interest (please only include any real party in interest NOT identified in Question 3) represented by me is:  
None

3. Parent corporations and publicly held companies that own 10% or more of stock in the party: None

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court (**and who have not or will not enter an appearance in this case**) are: William E. Thomson, Jr. & John M. Halan - Brooks Kushman P.C.

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. *See Fed. Cir. R. 47.4(a)(5) and 47.5(b)*:

- *Omni MedSci, Inc. v. Apple Inc.* – U.S. District Court, N.D. California, Case No. 19-cv-05924-YGR;
- *Omni MedSci, Inc. v. Apple Inc.* – U.S. District Court, N.D. California, Case No. 19-cv-05673-YGR;

- *Omni MedSci, Inc. v. Apple Inc.* – U.S. District Court, N.D. California, Case No. 20-cv-00563-YGR;
- *Apple Inc. v. Omni MedSci, Inc.* – Federal Circuit Appeal No. 2021-1229;
- *Apple Inc. v. Omni MedSci, Inc.* – Federal Circuit Appeal No. 2021-2213; and
- *Apple Inc. v. Omni MedSci, Inc.* – Patent Trial and Appeal Board No. IPR2021-00453.

6. **Organizational Victims and Bankruptcy Cases.** Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6). None

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## Argument in Response

The Court need not rehear this case en banc. Not only did the panel correctly apply the law, but the outcome does not change even under Petitioner’s (“Apple”) analysis because (1) the University’s rules and regulations require a post-invention act to transfer title and (2) Dr. Islam made his inventions under Bylaw 3.10 ¶4, not ¶1.

### **A. Even under Apple’s view of “binding precedent,” there was no automatic assignment of patent rights**

Apple asserts that, “[u]nder binding precedent,” a contract *always* transfers ownership of future patent rights automatically *unless* the employer “requires the inventor to perform a post-invention act to transfer title.” Pet. 2; *see also* UM Amici 4;<sup>1</sup> PRMA 9.<sup>2</sup> Even if that view of the law were correct (it is not), here, the University of Michigan’s (“UM”) rules and regulations require inventors “to perform a post-invention act to transfer title.”

UM employees must “abide by all University rules and regulations.” Appx592. Among those rules and regulations is UM’s Technology Transfer Policy (“Transfer Policy”), which “implements” Bylaw 3.10.

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<sup>1</sup> “UM Amici” refers to amicus brief ECF No. 108.

<sup>2</sup> “PRMA” refers to amicus brief ECF No. 109.



Appx605. Section III of the Transfer Policy, “Invention Reporting,” requires inventors to “report any University Intellectual Property promptly,” Appx607, using an “Invention Report,” Appx1730-1732, that transfers legal title.

As the majority explained, “[t]he language in the Invention Report undermines Apple’s position that paragraph 1 of bylaw 3.10 executed an automatic assignment, which ‘no further acts’ were required to effectuate, because *the unambiguous language of the Invention Report is itself a further act.*” Op. 11.<sup>3</sup> In the signature block, the Invention Report cites Bylaw 3.10, and inventors confirm they “will abide by the same.” Appx1731. But—showing that UM understands the Bylaw requires an assignment step—the inventors, “[a]s *required* [by the Bylaw], *hereby assign our rights* in this invention” to UM. *Id.* This refutes Apple’s claim that “the majority ‘overtur[n] decades of unchallenged understanding and implementation of the University [of Michigan]’s employment agreement and policy.” Pet. 4.

So, even under Apple’s view of the law, the majority correctly held that Bylaw 3.10 does not automatically assign rights because UM

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<sup>3</sup> All emphasis added except as otherwise noted.

“requires the inventor to perform a post-invention act to transfer title.”

Pet. 2.

**B. Apple (and amici’s) statement of the law is wrong.**

Apple asserts, “the controlling standard [is]: when ‘no further act is required once an invention comes into being,’ then, by definition, the assignment occurs ‘automatically’ because ‘the transfer of title occurs by operation of law.’” Pet. 8, citing *DDB Techs., LLC v. MLB Advanced Media, L.P.*, 517 F.3d 1284, 1290 (Fed. Cir. 2008); accord. UM Amici 4; PRMA 2-3. This stands *DDB Techs.* on its head. In *DDB Techs.*, the Court explained that, *if* an agreement transfers only equitable title, *then* a separate post-invention act is needed to transfer legal title. 517 F.3d at 1290. The Court was explaining how to transfer legal title when a contract transfers only equitable title. It did *not* create a rigid rule, as Apple and amici claim, that all contracts lacking a recited post-invention step must be read as transferring legal title.

**C. The panel did not affirm by merely focusing on the Bylaw’s “verb tense”**

Apple and amici assert the panel’s decision conflicts with Federal Circuit and Supreme Court precedent because “[a]ccording to the majority, the analytical ‘focus’ now must be in the verb tense of the

agreement.” Pet. 3; *accord*. UM Amici 5; PRMA 3. That misrepresents the majority’s careful analysis of *four* factors—the majority did not decide this case solely on verb tense.

Following Federal Circuit and Supreme Court precedent, the majority based its decision on “both the text of bylaw 3.10 taken as a whole and a comparison of the language therein to language interpreted in our precedent.” Op. 7. It analyzed (1) the language of Dr. Islam’s contract, Op. 7, (2) the structure of Bylaw 3.10, *id.* 8-9, (3) the verb tense of the operative language, *id.* 9-10, and (4) UM’s requirement that inventors perform a post-invention act to assign inventions, *id.* 11. The majority reviewed and distinguished the cases cited by Apple and amici, and answered Apple’s assertion that the focus was on “magic words.” *Id.* 11-14. The majority also considered evidence of the parties’ past conduct but found it “weak” and conflicting. *Id.* 15-16.

**1. In Dr. Islam’s contract, UM explained that Bylaw 3.10 merely defines “the conditions” that govern assignment of property rights**

Dr. Islam’s contract describes Bylaw 3.10 as: “stipulat[ing] the conditions governing the assignment of property rights to members of the University faculty and staff.” Appx592. “[B]y its own terms, bylaw 3.10

merely ‘stipulates the *conditions* governing the assignment of property rights.’” Op. 7 (emphasis in original), quoting Appx592. This contract language “does not purport to *effectuate* the present transfer of a present or future right.” *Id.* (emphasis in original). Apple ignores this critical point. The majority’s analysis of Dr. Islam’s contract does not “focus” on “verb tense”—it focused on UM’s statement about the Bylaw’s purpose in the contract Dr. Islam signed.

Ignoring these facts, Apple asserts Dr. Islam’s contract is a present-tense assignment because he said, “*I agree* to abide by all University rules and regulations.” Pet. 15 (emphasis added). That is absurd—under that theory, the Federal Circuit has wrongly decided *every* case that found no automatic assignment because those inventors said “I agree” (explicitly or implicitly) when they signed the contract.

## **2. Bylaw 3.10 identifies intended outcomes**

The majority next analyzed the Bylaw’s structure, focusing on internal consistency of the contract, not “verb tense.” Op. 8-9. The structure of Bylaw 3.10 confirms that the Bylaw merely describes three intended ownership outcomes—otherwise the parallel “shall be” language used throughout the Bylaw becomes nonsensical.

Apple admits that the three relevant Bylaw subsections cover “different future conditions” that “can only be known in the future.” Pet. 16. The three subsections cover the three possible invention scenarios: patents made with UM funds (¶1), patents made without UM funds (¶4), and patents made partly with UM funds (¶5):

1. Patents ... issued ... in connection with ... research ... supported ... by funds administered by the University ... ***shall be the property of the University.***

\* \* \*

4. Patents ... resulting from activities which have received no support, direct or indirect, from the University ***shall be the property of the inventor ....***
5. In cases which involve both University-supported activity and independent activity by a University staff member, patents ... ***shall be owned as agreed upon in writing ....***

Appx592.

Apple asserts “shall be” automatically assigns legal title in ¶1. Apple’s interpretation cannot be correct because “shall be” in ¶¶4 and 5 does not assign legal title: In ¶4 inventors do not assign patents to themselves (they already have title, *Bd. of Trs. of the Leland Stanford Junior Univ. v. Roche Molecular Sys.*, 563 U.S. 776, 780 (2011)) and ¶5 expressly requires an agreement to decide ownership. Bylaw 3.10 makes sense only if “shall be” is a statement of intended outcomes. *Giove v. DOT*,

230 F.3d 1333, 1340 (Fed. Cir. 2000) (“we must interpret the contract in a manner that gives meaning to all of its provisions and makes sense.”).

Apple makes the conclusory assertion that “[t]he three paragraphs thus use ‘shall be’ in different operative contexts.” Pet. 16. But Apple does not dispute the law, cited by the majority, that “[i]n general, the identical phrase in two paragraphs of a provision of a contract should be read identically.” Op. 8. Nor does Apple explain how the identical phrase assigns legal title in one paragraph but not in the other two. The only way to understand the Bylaw as internally consistent is if it describes intended outcomes.

### **3. Verb tense is a relevant consideration**

As the third factor, the majority explained, “the language of paragraph 1 of bylaw 3.10 does not use present tense words of execution.” Op. 9. It cited and quoted the Court’s precedential cases,<sup>4</sup> noting, “[e]ach case in which this court found a present automatic assignment examined

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<sup>4</sup> *SiRF Tech., Inc. v. Int’l Trade Comm’n*, 601 F.3d 1319, 1326 (Fed. Cir. 2010); *DDB Techs.*, 517 F.3d at 1290; *Regents of Univ. of New Mexico v. Knight*, 321 F.3d 1111, 1119–20 (Fed. Cir. 2003); *Chou v. Univ. of Chicago*, 254 F.3d 1347, 1357 (Fed. Cir. 2001); *Speedplay, Inc. v. Bebop, Inc.*, 211 F.3d 1245, 1253 (Fed. Cir. 2000); *FilmTec Corp. v. Allied-Signal Inc.*, 939 F.2d 1568, 1570 (Fed. Cir. 1991) (“*FilmTec I*”); *Arachnid, Inc. v. Merit Indus., Inc.*, 939 F.2d 1574, 1576 (Fed. Cir. 1991).

contractual language with a present tense executing verb” while, in the cases finding no present assignment, the contracts used “passive verbs in indefinite or future tense.” *Id.*

Apple ignores *SiRF*, *Speedplay*, *Arachnid*, *Chou*, and *Knight* and cites *FilmTec I* only for its reference to “by operation of law,” not for its relevance to “verb tense.” That Apple ignores this precedent is all-the-more extraordinary because Apple’s primary argument is that the majority ignored precedent when it considered verb tense. Pet. 7-13.

Apple also overlooks that “verb tense” is merely the third of four factors the majority considered to construe Bylaw 3.10. As the majority noted, “[a]lthough the presence or absence of present language of assignment is an important indicator of the parties’ intent as explained above, we do not hold that this indicator is necessarily determinative in all cases.” Op. 10, n. 4.

#### **4. UM uses other mechanisms—not Bylaw 3.10—to transfer patent ownership to UM**

The majority’s fourth factor analyzed how UM implements Bylaw 3.10. Op. 11. As discussed in §A above, UM’s Transfer Policy implements Bylaw 3.10. Appx605 (“This Policy implements Section 3.10 of the Bylaws of the Board of Regents.”). The Transfer Policy requires inventors of

“University Intellectual Property” to report their inventions to UM on an Invention Report in which the inventors “hereby assign” their rights in the invention to UM. Appx1731.

Apple’s Petition (pp. 17-18) rehashes its assertion that the Invention Report is merely confirmatory, ignoring the language of the Invention Report and the majority’s analysis. The majority considered and rejected Apple’s argument, explaining, “this form notes that the assignment is ‘required’ rather than previously executed under bylaw 3.10 .... [T]he language of the Invention Report is not language of confirmation or merely a mirror of the bylaw—it is distinct unambiguous language of present assignment.” Op. 11. Instead of addressing the majority’s analysis, Apple asserts, without basis, that Dr. Islam’s 1992 contract had “no post-invention obligation to assign title to University-supported inventions.” But the contract references “University rules and regulations,” Appx592, which include the Transfer Policy and its post-invention-act requirement.

UM knows a separate assignment step is needed. Bryce Pilz (Director of UM’s Office of Technology Transfer, an attorney, and UM’s designated 30(b)(6) representative), authored a 2012 law review article



where he explained, when employers want to “assign rights in inventions prior to their creation,” they “commonly include in employment agreements language of present assignment (*i.e.*, ‘hereby assigns’)[.]” Appx1693 (footnotes omitted).

UM has implemented this form of assignment. “[A]ll newly appointed faculty and staff” must complete a “Supplemental Appointment Information” form, in which UM recognizes that, because Bylaw 3.10 merely creates an “obligation[.]” to assign inventions, new employees must “hereby assign” patent rights to UM. [hr.umich.edu/sites/default/files/supplemental-appointment-information-1-2019.pdf](http://hr.umich.edu/sites/default/files/supplemental-appointment-information-1-2019.pdf), p. 1 (revised 1/2019) (last accessed 10/15/2021)(“As part of my obligations under Bylaw 3.10, I hereby assign to [UM my] inventions[.]”).

Other UM procedures confirm the majority’s holding that UM does not rely on Bylaw 3.10 to assign patent rights. The dissent cited UM’s assertion that it relies on Bylaw 3.10 to implement its Bayh-Dole policy, Dissent 7, but UM does not do so. UM uses a separate policy that “hereby assign[s]” patent rights, without relying on (or mentioning) Bylaw 3.10: “As required by *37 CFR 401.14(f)(2) and other funding agreements*, any employees and researchers ... *hereby assign* to the University the entire

right, title and interest in and to each invention.”  
<http://techtransfer.umich.edu/for-inventors/policies/bayhdole/> (last  
accessed 10/1/2021).

#### **D. The “precedent” Apple cites is distinguishable**

Apple asserts (Pet. 8-9) that the majority’s opinion “squarely conflicts” with three cases in which courts held that government action vested rights in the government, not the inventor: *Bd. of Trustees of Leland Stanford Junior Univ. v. Roche Molecular Sys., Inc.*, 563 U.S. 776 (2011), *FilmTec Corp. v. Hydranautics*, 982 F.2d 1546 (Fed. Cir. 1992) (“*FilmTec II*”), and *Heinemann v. United States*, 796 F.2d 451 (Fed. Cir. 1986).<sup>5</sup> But these cases involved government action, not private contracts. The majority explained the difference: Unlike private parties, the Congress may change where inventions initially vest. Op. 12.

As the Supreme Court explained in *Roche*, “Since 1790, the patent law has operated on the premise that rights in an invention belong to the

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<sup>5</sup> *Heinemann* is an odd case. The initial administrative decision was, “the Government is entitled to an assignment of the invention.” *Heinemann*, 796 F.2d at 453. Thus, the Executive Order was not automatic—it required an assignment. The PTO, however, turned that obligation into a present assignment with no explanation cited by the Federal Circuit. *Id.* at 454. No one raised the discrepancy, and the Federal Circuit did not mention it. So, *Heinemann* is not relevant to the legal issue in this case.

inventor.” *Roche*, 563 U.S. 780. The Court recognized, however, that Congress has the power to create exceptions to the general rule. It noted that the AEC, NASA, and DoE statutes vest rights *ab initio* in the government—requiring no transfer of legal title—unlike “the Bayh-Dole Act [which] ‘does not automatically void *ab initio* the inventors’ rights in government-funded inventions.” *Roche*, 563 U.S. at 784 (citation omitted). Likewise, in *FilmTec II*, Congress changed the usual vesting of patent rights. 982 F.2d 1548 (“title ... shall vest in the United States, and ... patents ... shall be issued to the United States”).

The issue in this case is not where rights vest *ab initio*. No one disputes that, *ab initio*, the rights at issue here vested in Dr. Islam. The question is whether, *after* those rights vested, did legal title transfer to UM? Nothing the Supreme Court said about vesting under the AEC, NASA, or DoE statutes helps to answer that question. *Roche*, 563 U.S. 787. Congress’s power to change, by statute, where patent rights vest *ab initio* differs from the ability of private parties, by contract, to *transfer* rights *after* they vest with the inventor.

**E. When UM adopted Bylaw 3.10, a present assignment of future inventions conveyed only equitable title**

Bylaw 3.10 has existed in its present form since 1976. *See* UM, Proceedings of the Board of Regents (1975-1978), pp. 337-38 (available at [quod.lib.umich.edu/u/umregproc/ACW7513.1975.001/347?rgn=full+text;view=image;q1=patent\\*](http://quod.lib.umich.edu/u/umregproc/ACW7513.1975.001/347?rgn=full+text;view=image;q1=patent*), last accessed 7/26/2020). When UM adopted Bylaw 3.10, “a present assignment of future inventions ... conveyed equitable, but not legal, title.” *Roche*, 563 U.S. 800 (Breyer, J., dissenting)(before 1991, “patent law appears to have long specified that a present assignment of future inventions (as in both contracts here) conveyed equitable, but not legal, title”).<sup>6</sup> Justice Breyer explained that the Federal Circuit changed that longstanding rule in 1991 when it decided *FilmTec I. Id.* (“The Federal Circuit provided no explanation for what seems a significant change in the law.”)

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<sup>6</sup> Citing G. Curtis, *A Treatise on the Law of Patents for Useful Inventions* § 170, p. 155 (3d ed. 1867) (“A contract to convey a future invention ... cannot alone authorize a patent to be taken by the party in whose favor such contract was intended to operate”); Comment, *Contract Rights as Commercial Security: Present and Future Intangibles*, 67 *Yale L. J.* 847, 854, n. 27 (1958) (“The rule generally applicable grants equitable enforcement to an assignment of an expectancy but demands a further act, either reduction to possession or further assignment of the right when it comes into existence”).

Apple offers no evidence that UM believed, when it wrote Bylaw 3.10, that it was transferring legal title, contrary to settled law. UM could have revised its Bylaw after *FilmTec I* changed the law in 1991 but it chose not to do so. UM actions—not amending Bylaw 3.10 and use, instead, of Supplemental Appointment forms, Invention Report forms, the Transfer Policy, and the Bayh-Dole Policy to transfer legal title—confirm that UM understands Bylaw 3.10 only conveys equitable title.

**F. Apple and amici’s imagined horrors are just that: imagined**

Apple asserts, “[t]here is no telling how many other agreements are now at risk of a similar retroactive change that will disrupt settled, investment-backed decisions.” Pet. 4. Apple takes the phrase “no telling” literally—it identifies no “at risk” agreements. Nor does Apple offer evidence that the panel’s decision will have “retroactive” effect. As explained in §E above, when UM adopted Bylaw 3.10, the language transferred only equitable title. Had the panel held that Bylaw 3.10 transfers now legal title, that decision—not the majority’s—would have a disruptive retroactive effect.

The UM Amici complain, “options are limited for owners to remedy uncertainty.” UM Amici 11. They ignore that they, alone, control the

language in their agreements. Individual employees have no power to change the language dictated by their employers, but universities and corporations can unilaterally write their contracts to avoid ambiguity and make automatic transfers unambiguous.

Apple claims that universities have “relied on [the case law’s flexible approach to interpreting contract language] to implement divergent language.” Pet. 14, citing Blue Br. 46. The majority’s multi-factor approach achieves Apple’s quest to allow for divergent outcomes. This gives universities and other organizations the ability to implement their diverse ownership policies as illustrated by the different policies the amici have adopted:

- Amicus Wisconsin Alumni Research Foundation claims no ownership in most faculty inventions: “the University does not claim ownership rights in the intellectual property generated during research by its faculty, staff, or students.” [policy.wisc.edu/library/UW-4008](http://policy.wisc.edu/library/UW-4008) (last accessed 10/14/2021).
- Amicus the Board of Regents of the University of Illinois (“UI”) understands that “shall belong to” does not assign legal title, uses unambiguous words of automatic assignment:

“intellectual property shall belong to the system and by operation of this Article *is hereby assigned* to and the property of the system[.]”  
[www.bot.uillinois.edu/governance/general\\_rules/](http://www.bot.uillinois.edu/governance/general_rules/), Art. III, §5 (last accessed 10/14/2021).

- Amicus the University of Iowa uses unambiguous words of automatic assignment: “inventors subject to this policy assign to the UIRF their entire right in the qualifying invention[.]”  
[opsmanual.uiowa.edu/administrative-financial-and-facilities-policies/university-iowa-intellectual-property-policy](http://opsmanual.uiowa.edu/administrative-financial-and-facilities-policies/university-iowa-intellectual-property-policy), Ch. 30.3(b) (last accessed 10/14/2021).
- Amicus Purdue Research Foundation uses a present-tense verb to avoid ambiguity: “Intellectual Property ... *is* Purdue Intellectual Property[.]” [www.purdue.edu/policies/academic-research-affairs/ia1.html](http://www.purdue.edu/policies/academic-research-affairs/ia1.html) (last accessed 10/14/2021).<sup>7</sup>

After the Federal Circuit decided *FilmTec I*, UM could have changed its Bylaw from an assignment of equitable title to an assignment

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<sup>7</sup> This usage, which also exists in other university policies, *e.g.*, Blue Br. 46, refutes the argument that it would have been inappropriate to use a present-tense verb in such a contract. UM Amici 9.

of legal title. That it did not do so is further evidence that UM intended its Bylaw would remain a transfer of equitable title, as it was when adopted.

Apple and amici make conclusory claims of disaster, but none cites an agreement that has changed because of the Court's decision. Like Chicken Little, merely saying, "the sky is falling" does not make it so.

**G. Evidence of the parties' past conduct is weak and inconclusive**

The record contains no solid evidence of the parties' past conduct. Apple points to a single, early agreement where Dr. Islam sought UM's confirmation that he owned a different, unrelated patent. Pet. 5, 17. UM drafted the agreement and Dr. Islam, who was not advised by counsel, signed it because UM position was, "This is our form. You've got to sign it." Appx1155(143:22-144:21).

Other facts ignored by Apple—facts involving the patents-in-suit—confirm UM's understanding that the Bylaw was *not* an automatic assignment. UM's Director of its Office of Technology Transfer initially planned to "send [a] letter to [Dr. Islam] agreeing NOT to *claim* ownership" of the at-issue inventions. Appx886 (capitals in original). The Director's proposal to not "claim" ownership makes no sense if UM



believed Bylaw 3.10 had transferred title to UM. The statement makes sense only if the Director understood that UM's ownership was not automatic but must be "claim[ed]."

Further evidence of UM's understanding came during this lawsuit. In May 2019, while Omni and Apple were battling over ownership in the district court, UM sent Omni an unsolicited draft agreement saying, "THE UNIVERSITY MAKES NO REPRESENTATIONS ... THAT IT IS AN OWNER OR THE OWNER OF THE PATENTS[.]" Appx1106, ¶5.1 (capitals in original). In addition, UM never acted as a patent owner:

- UM never recorded its purported ownership in the Patent and Trademark Office.
- After Apple filed its Motion to Dismiss in the district court, UM did not join in Apple's motion, did not move to intervene, did not file an amicus brief, and did not attend the hearing on the motion.
- Apple filed six *Inter Partes* Review petitions attacking the at-issue patents *and served those petitions on UM*. Appx5939-5950. Despite 37 C.F.R. §42.8(a)(2), which *requires* the patent

owner to file *mandatory* notices, UM filed no patent owner notices and did not appear in the IPRs. Appx5952.

This conflicting evidence led the majority to conclude, “[t]he parties’ past conduct is not particularly helpful here with respect to the interpretation of paragraph 1 of bylaw 3.10.” Op. 16.

**H. The facts confirm that Dr. Islam owns the invention under Bylaw 3.10 ¶4**

Regardless of how the Court resolves the legal issues, Dr. Islam owns the patents-in-suit because they fall under Bylaw 3.10 ¶4, not ¶1.<sup>8</sup> Although the district court did not need to reach the issue, it confirmed ¶1 does not apply:

Though not necessary to the Court’s determination, the same canons of interpretation urge the conclusion that *Dr. Islam did not use UM funds to create the invention, as required to grant rights to UM under Bylaw 3.10 ¶ 1*.... UM’s only basis for obtaining any rights to the Asserted Patents was that funds were expended towards “space costs, as well as administrative time required for processing his joint appointment in Cardiovascular Medicine.” [Appx893]. Under this interpretation, mere employment grants UM title to a professor’s invention.... Even UM acknowledges that mere employment does not convey any interest to the University. [Appx575(241:19–22)] .... *[T]he facts here establish that UM had no rights to the Asserted Patents.*

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<sup>8</sup> The majority did not reach this issue. Op. 6 n.3.

Appx11, n.1.

Because Omni recorded its assignment, Appx1808, Apple has the burden of proof. *SiRF*, 601 F.3d at 1327-28 (“The recording of an assignment with the PTO ... creates a presumption of validity as to the assignment and places the burden to rebut such a showing on one challenging the assignment.”). Apple’s “evidence” consists only of conclusory, unsupported assertions from UM employees that, at best, amount to mere employment as UM’s basis to claim ownership. Apple and UM have never linked Dr. Islam’s inventions to UM funding. To the contrary, the researchers who worked most closely with Dr. Islam twice confirmed that Dr. Islam’s patents do not relate to his UM work. Appx566-567(205:10-206:3); Appx580-581(261:14-262:3). This uncontroverted evidence puts the patents-in-suit under Bylaw 3.10 ¶4. For this independent reason, the Court should deny Apple’s Petition.

Respectfully submitted,

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