

2024-2313

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

FORTRESS IRON, LP,

Plaintiff-Appellant,

– v. –

DIGGER SPECIALTIES, INC.,

Defendant-Appellee.

*On Appeal from the United States District Court for
the Northern District of Indiana in No. 3:21-cv-00014-CCB*

**PETITION FOR PANEL REHEARING AND
REHEARING *EN BANC***

PAUL V. STORM
JOHN J. MAY
FOLEY & LARDNER LLP
Intellectual Property
2021 McKinney Avenue,
Suite 1600
Dallas, Texas 75201
(214) 999-3000
pvstorm@foley.com
jmay@foley.com

Counsel for Plaintiff-Appellant

MAY 4, 2026

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF INTEREST

Case Number 2024-2313

Short Case Caption Fortress Iron, LP v. Digger Specialties, Inc.

Filing Party/Entity Fortress Iron, LP

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Date: 09/26/2024

Signature: /Paul V. Storm/

Name: Paul V. Storm

<p>1. Represented Entities. Fed. Cir. R. 47.4(a)(1).</p>	<p>2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2).</p>	<p>3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3).</p>
<p>Provide the full names of all entities represented by undersigned counsel in this case.</p>	<p>Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p>	<p>Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.</p> <p><input type="checkbox"/> None/Not Applicable</p>
<p>Fortress Iron, LP</p>		<p>Thrive Five Holdings GP, LLC</p>

Additional pages attached

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

None/Not Applicable Additional pages attached

Foley & Lardner LLP	Chance L. Moser	
Paul V. Storm	Jonathan W. Garlough	
John J. May		

5. Related Cases. Other than the originating case(s) for this case, are there related or prior cases that meet the criteria under Fed. Cir. R. 47.5(a)?

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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/Not Applicable Additional pages attached

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STATEMENT OF COUNSEL UNDER FED. CIR. R. 40(C)

Based on my professional judgment, I believe the panel decision is contrary to the following decision(s) of the Supreme Court of the United States or the precedent(s) of this court: *Chou v. University of Chicago*, 254 F.3d 1347 (Fed. Cir. 2001) requires that “parties concerned” under 35 U.S.C. § 256(b) are assignees, inventors, named or unnamed, only when they have a cognizable ownership or other economic interest in the patent. This decision conflicts with *Chou* by recognizing a right “not to be named” independent of any assignment of rights or identifiable economic interest.

Based on my professional judgment, I believe this appeal requires an answer to one or more precedent-setting questions of exceptional importance: (set forth each question in a separate sentence).

Does a recognized coinventor have the right “not to be named,” therefore rendering a patent invalid, even when all his rights have been assigned and he has no economic or other interest in the patent?

/s/ Paul V. Storm
Paul V. Storm

Counsel for Plaintiff-Appellant

**POINTS OF LAW OR FACT
OVERLOOKED OR MISAPPREHENDED BY THE PANEL**

The panel apparently overlooked the record evidence that Huang’s contribution to the invention was made in China and under Chinese law, his employer, Quan Zhou Yoddex Building Material Co., Ltd. (“YD”), owned his rights which have been assigned to Fortress by YD, and thus Huang has no economic or ownership rights in the asserted patents and therefore could not be one of the “parties concerned” under 35 U.S.C. § 256(b).

Chou v. University of Chicago, 254 F.3d 1347, 1357 (Fed. Cir. 2001) does not hold that **all** coinventors, including recognized coinventors that have not retained any economic or other interest in a patent, are “parties concerned” under 35 U.S.C. § 256(b).

INTRODUCTION

Plaintiff-Appellant Fortress Iron, LP ("Fortress") respectfully petitions for panel rehearing or, in the alternative, rehearing *en banc* of this Court's opinion issued April 2, 2026. *Fortress Iron, LP v. Digger Specialties, Inc.*, 171 F.4th 1310, 1312 (Fed. Cir. 2026) (the "*Opinion*"). The *Opinion* affirms the district court's holding that, although Hua-Ping Huang ("Huang") was agreed to be a coinventor and the record shows that any rights he may have had passed to his employer by operation of Chinese law and were then assigned to Fortress, it nevertheless lacked the power to order his addition to U.S. Patents 9,790,707 and 10,883,290 (collectively, the "Patents"). *Id.* at 1314. The *Opinion* concludes that coinventor, Huang, is a "party concerned" under 35 U.S.C. § 256(b) and therefore was required to receive notice and an opportunity to be heard. *Id.* at 1314-1315. Fortress was unable to locate him to provide him notice, and therefore based on the panel finding that he has a "right not to be named" he could not be added as a named coinventor. Accordingly, this Court affirmed summary judgment invalidating the Patents for the omission of a coinventor under 35 U.S.C. § 101.¹ *Id.* at 1312.

¹ After the *Opinion* issued, Fortress renewed its efforts to find Huang and was successful in doing so. Fortress has filed a petition for certificate of correction with the U.S. Patent and Trademark Office to add his name to the Patents. As of the filing of this petition, those petitions have not been granted.

The *Opinion* creates a new right “not to be named” for *any* unchallenged coinventor, including inventors already named on the face of an issued patent regardless of any assignment of their rights to others. Under the *Opinion*'s holding, a coinventor who retains no legal, financial, or ownership interest in the patent nevertheless possesses an absolute veto over its validity.

The holding is based on an erroneous reading of *Chou v. University of Chicago*, 254 F.3d 1347 (Fed. Cir. 2001) that *all* coinventors, even those who have no economic or other interest in the patent, are “parties concerned.” *Opinion*, 171 F.4th at 1314.

On this record, Huang retains no rights arising from his coinvention and, indeed, under Chinese law, he cannot retain rights to any invention. Therefore, the newly created “right not to be named” is unassignable and inalienable, contrary to 35 U.S.C. § 261.

These errors are contrary to the text, structure, and purpose of the Patent Act as amended by the AIA, and they threaten grave harm to the patent system at large.

ARGUMENT

I. The *Opinion* Creates a Right for Agreed-Upon Coinventors to Refuse Inclusion on a Patent, Rendering It Invalid, Even After Assigning Their Rights

As stated in the *Opinion*, there is no debate that “[i]nventors occupy the central role in the patent process.” *Opinion*, 171 F.4th at 1314. There is also no debate, on

this record, that Huang is a coinventor but retains no rights resulting from his contribution to the claimed invention. Fortress, as the assignee, owns any rights he may have had because they vested under Chinese law in his employer, Quan Zhou Yoddex Building Material Co., Ltd. (“YD”), and were assigned to Fortress by YD. Fortress is the only party whose interests are affected by invalidation of the Patents. The *Opinion* nevertheless holds that Huang is a "party concerned" under § 256(b) because “[n]either the parties, nor we, know for certain whether Huang would be adversely affected or would benefit by being listed as an inventor on the patent.” *Id.* at 1315. This statement in the *Opinion* is not conditioned on whether Huang’s rights have been assigned to Fortress or, contrary to the record, he has any remaining rights.² The newly created “right not to be named” is therefore independent of any assignment of rights. The *Opinion* continues that “[i]nventorship carries legal, financial, and ownership consequences that an inventor has a right to contest.” *Id.* (citing 35 U.S.C. § 262; *Ethicon, Inc. v. U.S. Surgical Corp.*, 135 F.3d 1456, 1465 (Fed. Cir. 1998)). Because these statements are not qualified by whether the agreed inventor has retained any ownership or other rights in the patent, the only right he

² To the extent the *Opinion* is based on the unstated conclusion that there is a fact question regarding whether Huang may have retained rights contrary to the record, such a conclusion would mandate reversal of the summary judgment on the basis of a fact issue in the record. Nothing in the *Opinion* conditions an inventor’s stated right to contest “legal, financial and ownership consequences” on the assignment status of the inventor. *Id.* at 1315. Thus, creating the inalienable right “not to be named” addressed here.

could assert during a 256(b) hearing to make him a “party concerned” is the right “not to be named” – a new right created by this *Opinion*. This *Opinion* improperly creates that right and should be reheard.

The hypothetical that Huang may be adversely affected by being named on the Patents is unsupported but leads to the right “not to be named” when his inventorship status is stipulated to by all parties. *Id.* at 1314-1315. Under this record and the *Opinion*, there are only two possible outcomes of a §256(b) hearing. Either Huang is named a coinventor on valid Patents, or Huang is not named a coinventor on invalid Patents. It is difficult to square the *Opinion*’s conclusion that the patents Huang is undisputedly an inventor on are invalid with the position that inventor’s rights are protected by the patent system. There is no adverse outcome for Huang in not being named. Huang can only benefit. If he had rights in the Patents, he would enjoy the legal, financial, and ownership consequences that inventorship carries. *Id.* at 1315. Moreover, the suggestion that certainty in knowing whether Huang would benefit or be adversely affected is contrary to law. First, if certainty were the requirement, then notice and an opportunity to be heard would not be sufficient. *See Chou v. Univ. of Chicago*, 254 F.3d 1347, 1357 (Fed. Cir. 2001) (“notice and an opportunity for a hearing were provided”); *MCV, Inc. v. King-Seeley Thermos Co.*, 870 F.2d 1568, 1570 (Fed. Cir. 1989) (“all parties must be given notice and an opportunity to be heard”). Rather, Huang would actually have to be heard.

Furthermore, the law never requires absolute certainty before making decisions. Most matters are decided based on a preponderance of the evidence or clear and convincing evidence. Even criminal cases are resolved based on evidence beyond a reasonable doubt, not absolute certainty.

The panel did not explicitly recognize a right “not to be named,” but it follows inexorably from the *Opinion's* reasoning. The panel cites 35 U.S.C. § 262 and the presumption of co-ownership among joint inventors as a justification for treating Huang as a “party concerned.” *Opinion*, 171 F.4th at 1315 (citing 35 U.S.C. § 262; *Ethicon*, 135 F.3d at 1465). But § 262's default rule of co-ownership applies only “[i]n the absence of any agreement to the contrary.” Where an assignment agreement exists—as it does in the vast majority of employer-employee and contractor relationships—the coinventor has no ownership interest, no right to exploit the invention, and no financial stake in the patent. *See Larson v. Correct Craft*, 569 F.3d 1319, 1324 (Fed. Cir. 2009). The predicate for the panel's reasoning thus vanishes entirely when the coinventor has assigned his rights, yet the panel's categorical rule applies equally to inventors who have assigned their rights as well as those who have not.

Nothing in the Patent Act confers such an inalienable right “not to be named.” Yet the *Opinion's* logic inescapably creates one: if correction under § 256(b) requires that all inventors receive notice and an opportunity to be heard, whether their

inventorship is contested or not, whether they have assigned their rights or not, any inventor can appear at a §256(b) hearing and object to their inclusion on the patent. If their inventorship is uncontested, like here, and they assert their right “not to be named,” the patent will then necessarily become invalid under this *Opinion*. Each inventor, regardless of assignment status, is granted the power to invalidate any patent on which they are named. This is not a small concern. For example, if an inventor on an issued patent moves from the company where the invention was made to a competitor, they would have an incentive to invalidate the patent if it was asserted against their new employer. Likewise, an inventor who disagrees with how a patent they are named on is being used, could use the newly identified inalienable right to invalidate the patent.

This result is particularly untenable where, as is exceedingly common, the coinventor has assigned or is obligated to assign all rights in the patent to his employer or a third party. In such cases, the coinventor retains no economic stake in the patent, no right to practice the invention, and no ownership interest that could be affected by correction of inventorship. An employee who was hired to invent, who signed an invention-assignment agreement on his first day of employment, and who contributed to the conception of a claimed invention should not possess the power to invalidate the resulting patent years later by participating in a hearing for the purpose of forcing invalidation by demanding, pursuant to this *Opinion*, that their

name be removed from the patent, even though their inventorship status is uncontested. The *Opinion's* holding confers precisely that power.

In modern research-and-development environments, inventions frequently involve contributions from numerous individuals, including employees, contractors, consultants, and collaborators across multiple organizations and countries. Many of these contributors are bound by invention-assignment agreements that vest all patent rights in the employer or contracting entity. Under the *Opinion's* rule, each of these contributors holds a *de facto* kill switch over the resulting patent for the entire life of the patent. If even one contributor decides they want to invalidate the patent by requiring their name to be removed, even though the contributor has no remaining interest in the patent, they can force that result. No amount of diligence on the patentee's part can cure the problem if the coinventor cannot be found. Nor can the risk be eliminated because, under this *Opinion*, it is inalienable. The *Opinion* thus grants to every coinventor who has assigned his rights a unilateral power to destroy the patent—a power that no provision of the Patent Act was intended to create. The case should be reheard and reversed.

II. The *Opinion* Misreads *Chou* as Holding All Coinventors are “Parties Concerned”

The panel cites *Chou v. University of Chicago*, 254 F.3d 1347 (Fed. Cir. 2001), for the proposition that a coinventor is "clearly within the purview of [§

256(b)]". But the panel extends *Chou* beyond its facts without analyzing whether the rationale for requiring notice and a hearing—the protection of a coinventor's interests—applies when those interests are either nonexistent (because of an assignment) or entirely aligned with the proposed correction (because the correction would add, not remove, the coinventor).

Chou does not definitively hold that “parties concerned” means all coinventors regardless whether they retain an interest in the patent and regardless of whether their interest is aligned with the sought correction. Indeed, Dr. Chou was not determined to be a “party concerned” because she was a coinventor. At the time she invoked 256(b) in the district court, she was not a coinventor—she was a putative coinventor with an interest that would be adversely affected if she was not determined to be a coinventor. *Chou*, 254 F.3d at 1355. Dr. Chou was found to be within the purview of the statute because she was “concerned.” *Id.* at 1357 (“Chou, as a party ‘concerned’ is clearly within the purview of the statute”). *Chou* did not find this term unambiguous or explicitly attempt to construe this ambiguous term. However, *Chou*’s more thorough analysis of the statutory language arose in determining the proper 256(b) defendants (*i.e.* those that would be required to receive notice and hearing under §256(b)). *Id.* at 1359. *Chou* stands for the proposition that a “party concerned” is one “with an economic stake in a patent's validity [who is] entitled to be heard on inventorship issues.” *Id.* The Court should

follow *Chou* and hold that “parties concerned” means “those with an economic interest that may be adversely affected.” This position was explicitly rejected by the *Opinion* at odds with *Chou*. *Opinion*, 171 F.4th 1315; *see also Univ. of Utah v. Max-Planck-Gesellschaft Zur Forderung Der Wissenschaften E.V.*, 734 F.3d 1315, 1331 (Fed. Cir. 2013) (Moore, J., dissenting) (“Indeed, § 256(b) requires a court, before it orders a correction of inventorship, to provide ‘notice and hearing of all parties concerned,’ i.e., those with an ‘economic stake’ in the patent.”).

The Court faults Fortress for conflating “a party concerned” with “those with potentially adversely affected property interests.” *Opinion*, 171 F.4th at 1315. Such conflation, in the Court’s view, would require the Court to rewrite 256(b) to replace “parties concerned” with “those with an economic interest that may be adversely affected.” *Id.* Fortress respectfully disagrees. The statute does not define “parties concerned.” Fortress merely asks this court to construe the statute to explain the meaning to the term “concerned.” The argument that the Court is not permitted to replace the statutory language only applies if the Court has definitively determined that “parties concerned” means named inventors, omitted inventors, and assignees including those with no economic interest in the patent. Otherwise, the Court is merely construing statutory language consistent with the purpose of § 256 as a savings provision. *Id.* at 1314, 1315 (citing *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1350 (Fed. Cir. 1998)).

No case holds that an agreed-upon coinventor, named or unnamed, who has assigned his rights can refuse to be named on the patent, thus rendering it invalid. *See, e.g., Egenera, Inc. v. Cisco Sys.*, 972 F.3d 1367, 1381 (Fed. Cir. 2020); *CODA Dev. S.R.O. v. Goodyear Tire & Rubber Co.*, 916 F.3d 1350, 1358 (Fed. Cir. 2019); *Shukh v. Seagate Tech., LLC*, 803 F.3d 659, 663 (Fed. Cir. 2015); *Univ. of Utah v. Max-Planck-Gesellschaft Zur Forderung Der Wissenschaften E.V.*, 734 F.3d 1315, 1324 (Fed. Cir. 2013); *Larson v. Correct Craft*, 569 F.3d 1319, 1324 (Fed. Cir. 2009); *Chou v. Univ. of Chicago*, 254 F.3d 1347, 1357 (Fed. Cir. 2001); *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1350 (Fed. Cir. 1998); *Ethicon, Inc. v. U.S. Surgical Corp.*, 135 F.3d 1456, 1461 (Fed. Cir. 1998); *Fina Oil & Chem. Co. v. Ewen*, 123 F.3d 1466, 1471 (Fed. Cir. 1997); *Stark v. Advanced Magnetics, Inc.*, 119 F.3d 1551, 1553 (Fed. Cir. 1997); *MCV, Inc. v. King-Seeley Thermos Co.*, 870 F.2d 1568, 1570 (Fed. Cir. 1989); *Iowa State Univ. Rsch. Found., Inc. v. Sperry Rand Corp.*, 444 F.2d 406, 410 (4th Cir. 1971); *Wilson v. Corning, Inc.*, No. CV 13-210 (DWF/TNL), 2023 WL 6218160, at *36 (D. Minn. Sept. 25, 2023), *aff'd*, No. 2024-1065, 2025 WL 440209 (Fed. Cir. Feb. 10, 2025); *Cricut, Inc. v. Enough for Everyone, Inc.*, No. 2:21-cv-00601-TS-DAO, 2023 WL 3309135, at *4 (D. Utah May 8, 2023); *Harish v. Rubinstein*, 602 F. Supp. 3d 696, 701 (D.N.J. 2022); *Janssen Pharms., Inc. v. Teva Pharms. USA Inc.*, 571 F. Supp. 3d 281, 339 (D.N.J. 2021), *aff'd in part, vacated in part on other grounds*, 97 F.4th 915 (Fed. Cir. 2024); *Dyke v. Wake Forest Univ.*

Health Scis., 1:21-cv-627, 2021 WL 5566505, at * 7 (M.D.N.C. Nov. 29, 2021); *Intel Corp. v. Tela Innovations, Inc.*, No. 3:18-CV-02848-WHO, 2019 WL 2476620, at *4 (N.D. Cal. June 13, 2019); *Ecojet, Inc. v. Pure Spa Components, Inc.*, No. SACV1601463CJCKESX, 2017 WL 3485780, at *4 (C.D. Cal. Feb. 10, 2017); *Speedfit LLC v. Woodway USA, Inc.*, 226 F. Supp. 3d 149, 159 (E.D.N.Y. 2016); *Gabriel Techs. Corp. v. Qualcomm Inc.*, No. 08cv1992-MM(POR), 2009 WL 3326631, at *10 (S.D. Cal. Sept. 3, 2009); *Nichols Inst. Diagnostics, Inc. v. Scantibodies Clinical Lab'y, Inc.*, 218 F. Supp. 2d 1243, 1250 (S.D. Cal. 2002); *Fina Tech v. Ewen*, 857 F. Supp. 1151, 1156 (N.D. Tex.), *dismissed sub nom., Fina Oil & Chem. Co. v. Ewen*, 45 F.3d 442 (Fed. Cir. 1994); *FFOC Company v. Invent A.G.*, 882 F. Supp. 642 (E.D. Mich. 1994); *Dee v. Aukerman*, 625 F. Supp. 1427, 1428 (S.D. Ohio 1986); *Mueller Brass Co. v. Reading Indus., Inc.*, 352 F. Supp. 1357, 1379 (E.D. Pa. 1972), *aff'd*, 487 F.2d 1395 (3d Cir. 1973).

III. The Newly Created Right Not to Be Named is Unassignable

Under this record, Haung retained no legal, financial, or ownership interest in the Patents. Yet, the Opinion grants him a right “not to be named.” It follows that this new right cannot be assigned. That is, a coinventor retains the right “not to be named” even if he assigns all of his other rights in a patent. An unassignable patent right is in direct conflict with 35 U.S.C. § 261. Under 35 U.S.C. § 261, [a]pplications for patent, patents, or *any interest* therein, shall be assignable in law by an instrument

in writing.” 35 U.S.C. § 261 (emphasis added). It is doubtful that this Court intended to create an unassignable new right in patents. Construing 256(b) to require notice and hearing to only those with an economic interest in the patent eliminates this conflict.

IV. Rehearing *En Banc* Is Warranted Because the *Opinion* Decides Questions of Exceptional Importance

The panel itself recognized that this case presents an issue "of first impression". *Opinion*, 171 F.4th at 1314. The questions presented are of exceptional importance to the patent system. Collaborative invention is the norm in modern technology development – including collaboration across international borders. Assignment obligations are ubiquitous. The mobility of the modern workforce, including international contributors, means that some coinventors will become unreachable. Under the *Opinion's* rule, all inventors enjoy an inalienable right “not to be named.” Consequently, every patent that suffers from an inventorship error is vulnerable to permanent invalidation if a single coinventor cannot be found or if, upon participation, an inventor demands to have their name stricken from the patent—regardless of whether that coinventor has any remaining stake in the patent, regardless of whether his inventorship status is disputed.

The full Court should address these issues to provide clarity and to prevent the severe and, presumably, unintended consequences that flow from the panel's

holding. The Court should reverse the portion of the *Opinion* that improperly creates an inalienable right to coinventors, who have assigned their interests, to destroy patent validity through requiring their names to be removed.

CONCLUSION

For the foregoing reasons, Fortress Iron, LP respectfully requests that the panel grant rehearing or, in the alternative, that this Court grant rehearing *en banc*.

Respectfully submitted,

By: /s/Paul V. Storm

Paul V. Storm

Texas Bar No. 19325350

John J. May

Texas Bar No. 24041420

Foley & Lardner LLP

2021 McKinney Ave., Suite 1600

Dallas, Texas 75201

Telephone: 214-999-3000

Facsimile: 214-999-4667

pvstorm@foley.com

jmay@foley.com

**ATTORNEYS FOR PLAINTIFF-
APPELLANT, FORTRESS IRON, LP**

Addendum

171 F.4th 1310
United States Court of Appeals, Federal Circuit.

FORTRESS IRON, LP, Plaintiff-Appellant

v.

DIGGER SPECIALTIES,
INC., Defendant-Appellee

2024-2313

|
Decided: April 2, 2026

Synopsis

Background: Patentee brought action for infringement of two patents related to vertical cable railing panels. The United States District Court for the Northern District of Indiana, [Cristal C. Brisco, J., 748 F.Supp.3d 614](#), denied patentee's motion for partial summary judgment to correct inventorship, and then granted alleged infringer's motion for summary judgment, holding that asserted patents were invalid since they omitted a coinventor. Patentee appealed.

Holdings: The Court of Appeals, [Lourie](#), Circuit Judge, held that:

[1] as a matter of first impression, agreed-upon omitted coinventor was a “party concerned,” and thus entitled to notice and an opportunity to be heard before court could order any correction of inventorship;

[2] patentee could not correct inventorship of asserted patents, since it could not satisfy notice and hearing prerequisite; and

[3] asserted patents were invalid due to omitted inventor, since patentee could not correct inventorship.

Affirmed.

Procedural Posture(s): On Appeal; Motion for Summary Judgment.

West Headnotes (16)

[1] **Courts** 🔑 Particular questions or subject matter

Federal Circuit reviews a district court's ruling of summary judgment under law of regional circuit.

[2] **Federal Courts** 🔑 Summary judgment

The Seventh Circuit reviews a district court's grant of summary judgment de novo.

[3] **Federal Courts** 🔑 Summary judgment

Summary judgment will be affirmed only if movant is entitled to prevail as a matter of law on basis of stipulated facts.

[4] **Summary Judgment** 🔑 Favoring nonmovant; disfavoring movant

On a motion for summary judgment, court must draw any necessary fact inferences in favor of nonmovant.

[5] **Patents** 🔑 Inventorship and Priority

A patent must accurately name those who invented its claimed subject matter. [35 U.S.C.A. §§ 115\(a\), 116\(a\)](#).

[6] **Patents** 🔑 Inventorship and Priority

Failure to accurately name those who invented claimed subject matter renders a patent invalid. [35 U.S.C.A. §§ 115\(a\), 116\(a\)](#).

[7] **Patents** 🔑 Court-ordered correction

Statute governing correction of named inventor does not automatically allow a court to order correction of a patent, but rather, court may only do so on notice and hearing of all parties concerned. [35 U.S.C.A. § 256](#).

eventually assign their interests to others, such as employers.

[8] **Patents** 🔑 [Court-ordered correction](#)

Agreed-upon omitted coinventor was a “party concerned,” and thus entitled to notice and an opportunity to be heard before court could order any correction of inventorship, in action for infringement of patents related to vertical cable railing panels; neither parties nor court knew for certain whether coinventor would be adversely affected or would benefit by being listed as an inventor, to conflate a “party concerned” with those with potentially adversely affected interests would be to rewrite statutory language, while statute did not define a “party concerned,” it did not follow that a coinventor was not a “party concerned” when it came to adding or removing a coinventor, and constitutional standing and “party concerned” status were distinct issues with different requirements. [U.S. Const. art. 3, § 2, cl. 1](#); [35 U.S.C.A. § 256\(b\)](#).

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[9] **Patents** 🔑 [Court-ordered correction](#)

Patentee could not correct inventorship of patents related to vertical cable railing panels, since it could not satisfy notice and hearing prerequisite of statute governing correction of named inventor; agreed-upon omitted coinventor was a “party concerned,” and thus entitled to notice and an opportunity to be heard before court could order any correction of inventorship, patentee conceded that it had been unable to contact coinventor, let alone provide him with notice and an opportunity to be heard, and statute made those procedural protections a prerequisite to relief, not a mere formality. [35 U.S.C.A. § 256\(b\)](#).

[More cases on this issue](#)

[10] **Patents** 🔑 [Inventorship and Priority](#)

Explicit references to inventors in statutory framework cannot be taken lightly, as inventors occupy central role in patent process, and they are where it all begins, even if they

[11] **Constitutional Law** 🔑 [Judicial rewriting or revision](#)

Federal Circuit is not empowered to rewrite language of a statute.

[12] **Patents** 🔑 [Inventorship and Priority](#)

Patent inventorship carries legal, financial, and ownership consequences that an inventor has a right to contest. [35 U.S.C.A. § 262](#).

[13] **Patents** 🔑 [Particular inventions](#)

Patents related to vertical cable railing panels, which suffered from error of an omitted coinventor, were invalid due to omitted inventor, since patentee could not correct inventorship; allowing only one true inventor to be identified on the patents would render statutory text meaningless, caselaw showed a historical basis for requiring a correct listing of inventors and that nonjoinder of an actual inventor would render a patent invalid, and in context of joint invention, term “inventor” meant “the individuals collectively who invented or discovered the subject matter of the invention,” so when an invention had multiple inventors, they all had to be listed on patent. [35 U.S.C.A. §§ 100\(f\), 101, 256](#).

[More cases on this issue](#)

[14] **Patents** 🔑 [Misjoinder or nonjoinder](#)

A patent is invalid for error of omitting inventors when that error cannot be corrected. [35 U.S.C.A. § 256\(b\)](#).

[15] **Statutes** 🔑 [Statute as a Whole; Relation of Parts to Whole and to One Another](#)

Statutes 🔑 [Superfluosity](#)

Court must give effect, if possible, to every clause and word of a statute and should avoid

rendering any of statutory text meaningless or as mere surplusage.

[16] **Patents** 🔑 In general; utility

US Patent 9,790,707, US Patent 10,883,290. Invalid.

Appeal from the United States District Court for the Northern District of Indiana in No. 3:21-cv-00014-CCB, Judge [Cristal C. Brisco](#).

Attorneys and Law Firms

Paul V. Storm, Foley & Lardner LLP, Dallas, TX, argued for plaintiff-appellant. Also represented by [John Jacob May](#).

Heather B. Repicky, Barnes & Thornburg LLP, Boston, MA, argued for defendant-appellee. Also represented by [D. Randall Brown](#), Fort Wayne, IN; [Dana Amato Sarros](#), Chicago, IL.

Before [Lourie](#) and [Hughes](#), Circuit Judges, and [Kleeh](#),¹ Chief District Judge.

Opinion

[Lourie](#), Circuit Judge.

***1312** Fortress Iron, LP (“Fortress”) appeals from a decision of the United States District Court for the Northern District of Indiana. *Fortress Iron L.P. v. Digger Specialties, Inc.*, 748 F. Supp. 3d 614, 621 (N.D. Ind. 2024) (“*Decision*”). The district court granted summary judgment, holding that U.S. Patents 9,790,707 (“the ’707 patent”) and 10,883,290 (“the ’290 patent”) were invalid because they omitted a coinventor. *Id.* The district court also denied partial summary judgment to correct inventorship under 35 U.S.C. § 256(b). *Id.* For the reasons given below, we affirm.

Background

I

Fortress designs and sells railing and fencing products used in the construction of outdoor living spaces. *Id.* at 616; Open.

Br. at 6. Fortress works with two Chinese companies to manufacture their products: manufacturer Yinxin Handicrafts Co., Ltd. (“YX”) and quality control liaison Quan Zhou Yoddex Building Material Co., Ltd. (“YD”). *Decision*, 748 F. Supp. 3d at 616.

In March 2013, Fortress's owner, Matthew Sherstad, “had an idea for a vertical cable railing that could be purchased as a pre-assembled panel.” *Id.* The pre-assembled aspect made it easier to install compared to products that needed to be assembled on site. *See id.* Fortress employee Kevin Burt sketched an initial design of the product. *Id.* Sherstad and Burt worked with YD to produce a prototype, but it had problems with the cables rotating during tensioning. *See id.* YD employees Hua-Ping Huang and Alfonso Lin then suggested changes to address the cable tensioning issue. *Id.* at 617. Those suggested changes were incorporated into the final design. *Id.* The final design thus incorporated aspects of Sherstad's original idea, Burt's early designs, and the suggestions of Lin and Huang as to the final cable and rail designs. *Id.*

Soon after the final design was completed, Fortress filed patent applications for the vertical cable railing panels, which issued as the ’707 and ’290 patents. *Id.* Initially, ***1313** the patents named only Sherstad and Burt as inventors; they did not include Lin or Huang. *Id.* As relevant to this appeal, Huang's employment at YD ended in 2016, and he did not provide his contact information to YD or Fortress. *Id.* at 618.

II

In January 2021, Fortress sued Digger Specialties Inc. (“DSI”) for infringement of the ’707 and ’290 patents. *See id.* at 615; J.A. at 13.² During the course of the litigation, DSI learned that Lin and Huang contributed to the invention, and Fortress acknowledged that Lin and Huang were coinventors. *Decision*, 748 F. Supp.3d at 618. Fortress located Lin and successfully added him as a coinventor to the patents following the procedure outlined in 35 U.S.C. § 256(a). *See id.*; J.A. at 330–32, 337–39. But because Huang did not provide his contact information, Fortress was unable to locate him and thus was unable to add him as a coinventor using that same procedure. *See Decision*, 748 F. Supp.3d at 618.

The parties then filed cross motions for summary judgment. *Id.* at 616. Fortress moved for partial summary judgment to correct the ’707 and ’290 patents by adding Huang

as a coinventor pursuant to 35 U.S.C. § 256(b). *Id.*; J.A. at 110–11. DSI opposed Fortress's motion and moved for summary judgment of invalidity due to incorrect inventorship. *Decision*, 748 F. Supp. 3d at 616. The district court denied Fortress's motion to the extent that it did not order correction of the '707 and '290 patents, then granted DSI's motion, holding that the patents were invalid for omission of an inventor. *Id.* at 621.

Fortress appeals, and we have jurisdiction under 28 U.S.C. § 1295(a)(1).

Standard of Review

[1] [2] [3] [4] We review a district court's ruling of summary judgment under the law of the regional circuit—here, the Seventh Circuit. See *Cummins, Inc. v. TAS Distrib. Co.*, 700 F.3d 1329, 1334–35 (Fed. Cir. 2012). “The Seventh Circuit reviews a district court's grant of summary judgment *de novo*.” *Id.* at 1335 (citing *Staats v. Cnty. of Sawyer*, 220 F.3d 511, 514 (7th Cir. 2000)). “Summary judgment will be affirmed only if [the movant] is entitled to prevail as a matter of law on the basis of the stipulated facts.” *Broad. Music, Inc. v. Claire's Boutiques, Inc.*, 949 F.2d 1482, 1486 (7th Cir. 1991). We must draw any necessary fact inferences in favor of the nonmovant. *Id.*

Discussion

Fortress argues that the district court erred in (1) denying its partial summary judgment motion to correct inventorship under 35 U.S.C. § 256(b); and (2) granting DSI's motion for summary judgment of invalidity due to incorrect inventorship. See *Open. Br.* at 16–17. Before we address each argument in turn, we provide a short background on inventorship and 35 U.S.C. § 256.

I

[5] [6] A patent must accurately name those who invented its claimed subject matter. See 35 U.S.C. §§ 115(a), 116(a); *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1348–49 (Fed. Cir. 1998); cf. *Thaler v. Vidal*, 43 F.4th 1207, 1211 (Fed. Cir. 2022) (“The Patent Act also requires inventors ... to submit an oath or declaration [with a patent application].” (citing 35 U.S.C. § 115(b)(2))). Failure to do so renders a patent invalid. See

Pannu, 155 F.3d at 1349 (“[N]onjoinder of an actual inventor *1314 ... render[s] a patent invalid.”) (collecting cases).

Congress, however, affords a patentee who incorrectly listed inventors the opportunity to correct its patent by complying with the requirements of 35 U.S.C. § 256. *Id.* at 1350. Section 256 provides:

(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.

[7] We have described § 256 as a “savings provision” such that “[i]f a patentee demonstrates that inventorship can be corrected as provided for in [§] 256, a district court must order correction of the patent, thus saving it from being rendered invalid.” *Pannu*, 155 F.3d at 1350. Section 256(b), however, does not automatically allow a court to order correction of a patent. Rather, the court may only do so “on notice and hearing of all parties concerned.” 35 U.S.C. § 256(b).

With this background in mind, we turn to the instant appeal and case of first impression,³ which turns on whether Huang—an agreed-upon omitted coinventor—is a “party concerned” under § 256(b).

II

[8] [9] We first address Fortress's argument that the district court erred in denying its partial summary judgment motion to correct inventorship under 35 U.S.C. § 256(b).⁴ Specifically, Fortress contends that the district court erred in concluding that Huang was a “party concerned” under § 256(b) and therefore entitled to notice and an opportunity to be heard before the court could order any correction of inventorship. See *Open. Br.* at 25–31; *Decision*, 748 F. Supp. 3d at 619–20.

[10] We disagree. Inventors occupy the central role in the patent process. They are where it all begins, even if they eventually assign their interests to others, such as employers. Thus, their explicit references in the statutory framework cannot be taken lightly.

In *Chou v. University of Chicago*, where the question arose of an inventor's right to participate in a § 256(b) action even when she had no ownership rights in the patent at issue, we determined that a coinventor was a “party ‘concerned,’ ... clearly within the purview of [§ 256(b)].” 254 F.3d 1347, 1357 (Fed. Cir. 2001). Huang, similarly, as an agreed-upon omitted coinventor, is thus a “party concerned” such that he must be given notice and opportunity *1315 for hearing prior to any correction of inventorship under § 256(b). See *id.*

Fortress concedes that it has been unable to contact Huang, let alone provide him with notice and an opportunity to be heard as required by the statute. See *Decision*, 748 F. Supp. 3d at 619–20; Open. Br. at 12 n.2. It argues that that inability to provide those protections should not deprive it of a valid patent. See Open. Br. at 25–30. But § 256(b) makes those procedural protections a prerequisite to relief, not a mere formality; because Fortress cannot satisfy the notice and hearing prerequisite of § 256(b), it cannot utilize that section to correct the patents.

Fortress's counterarguments are unpersuasive. Fortress first asks us to read a “party concerned” under § 256(b) through a “due process” lens, *i.e.*, a “party concerned” is one with an economic interest in the patent that may be adversely affected. Open. Br. at 25–28; see Oral Arg. at 6:04–6:10, 7:17–22. Fortress asserts that Huang is not a “party concerned” because adding him as a coinventor would benefit him, not adversely affect him. Open. Br. at 27. But Fortress's characterization of Huang's position is unsupported. Neither the parties, nor we, know for certain whether Huang would be adversely affected or would benefit by being listed as an inventor on the patent.

[11] [12] And more importantly, to conflate a “party concerned” with those with potentially adversely affected property interests would be to rewrite the language of the statute from “party concerned” to “those with an economic interest that may be adversely affected”. That is something we cannot do. See *Newport News Shipbuilding & Dry Dock Co. v. Garrett*, 6 F.3d 1547, 1558 (Fed. Cir. 1993) (“This court is empowered to rewrite neither statutes nor regulations.”) While the statute does not define a “party

concerned,” it does not follow that a coinventor of a patent is not a “party concerned” when it comes to adding or removing a coinventor. Inventorship carries legal, financial, and ownership consequences that an inventor has a right to contest. See 35 U.S.C. § 262 (“In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use, offer to sell, or sell the patented invention within the United States, or import the patented invention into the United States, without the consent of and without accounting to the other owners.”); *Ethicon, Inc. v. U.S. Surgical Corp.*, 135 F.3d 1456, 1465 (Fed. Cir. 1998) (“each [coinventor] presumptively owns a pro rata undivided interest in the entire patent”).

Fortress next argues that Huang is not a “party concerned” because he would not have constitutional standing if he sought to name himself a coinventor. Open. Br. at 28–30. That argument fares no better. In *Chou*, we explained that constitutional standing and “party concerned” status under § 256(b) are distinct issues with different requirements. See 254 F.3d at 1357 (“Chou, as a party ‘concerned,’ is clearly within the purview of [§ 256(b)], but she must meet constitutional standing requirements in order to invoke it.”). Fortress thus again asks us to improperly conflate “party concerned” with a different requirement; we again decline. See *Newport News*, 6 F.3d at 1558.

Finally, Fortress argues that the district court erred by “restrictively constru[ing] § 256(b) to avoid saving the validity of the patents-in-suit,” as district courts are to apply the subsection “broadly and permissively” due to its “savings provision” status. Open. Br. at 20–21. While Fortress is correct that § 256 has been characterized as a “savings provision,” *Pannu*, 155 F.3d at 1350, we disagree with its argument. Section 256 is a “savings provision” only to *1316 the extent that its statutory requirements are met. The statute reads, “can be corrected as provided in this section.” 35 U.S.C. § 256(b). As previously stated, because Fortress cannot satisfy the notice and hearing prerequisite of this section, this “savings provision” does not apply.

Accordingly, we affirm the district court's denial of Fortress's partial motion for summary judgment for inventorship correction under § 256(b).

III

[13] Next, we address Fortress's argument that the district court improperly granted summary judgment of invalidity due to incorrect inventorship. The district court, based on § 101, held that because Huang was not named on the patents, they were invalid. *Decision*, 748 F. Supp. 3d at 620–21.

[14] The district court was correct in its invalidity conclusion. Invalidity for incorrect listing of inventors has a clear basis in the statute. Section 256(b) states that “[t]he 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.” (emphasis added). The necessary and opposite implication of § 256(b) is that a patent is invalid for the error of omitting inventors when that error cannot be corrected.

[15] Fortress argues that only one true inventor need be identified on the patents. Reply Br. at 23. But adopting Fortress's position when a patent cannot be corrected under § 256 would render meaningless the “savings provision” that Fortress sought to rely on at summary judgment. Section 256(b) saves patents from invalidity for the “error of omitting inventors.” Fortress's position would mean that omission of an inventor, as long as one inventor is named, would not be an error at all. But “we must ‘give effect, if possible, to every clause and word of a statute’ and should avoid rendering any of the statutory text meaningless or as mere surplusage.” *Sharp v. United States*, 580 F.3d 1234, 1238 (Fed. Cir. 2009) (quoting *Duncan v. Walker*, 533 U.S. 167, 174, 121 S.Ct. 2120, 150 L.Ed.2d 251 (2001)). Because Fortress's position that only one inventor need be listed would render the statutory text meaningless, we decline to adopt it. *See id.*

Furthermore, and as stated above, our caselaw shows a historical basis for requiring a correct listing of inventors and that “nonjoinder of an actual inventor would render a patent invalid.” *See Pannu*, 155 F.3d at 1349 (collecting cases).

Fortress's arguments to the contrary are unavailing. Fortress contends that because 35 U.S.C. § 101 uses permissive language—“[w]hoever invents ... may obtain a patent thereof”—only one inventor need be listed. *See* Open. Br. at 44. We disagree. In the context of joint invention, “[t]he term ‘inventor’ means ... the individuals collectively who invented or discovered the subject matter of the invention.” 35 U.S.C. §

100(f) (emphasis added). Thus, § 101 and § 100(f), when read together with § 256(b), contemplate that when an invention has multiple inventors, they must all be listed on the patent. “Whoever” does not mean less than all.

Fortress next argues that the repeal of section 102(f) supports its view that joinder of all inventors is not necessary for validity. *See* Open. Br. at 44. We again disagree. Section 102(f), repealed after the enactment of the America Invents Act, stated that “[a] person shall be entitled to a patent unless he did not himself invent the subject matter sought to be patented.” But that provision simply stated that non-inventors are not entitled to a patent, not that actual inventors need not be named *1317 on a patent. Courts have long held, even prior to the enactment of § 102(f), that nonjoinder of an inventor invalidates a patent. *See Pannu*, 155 F.3d at 1349 (collecting cases). The relevant legislative history further illuminates that “[§ 102(f)] merely emphasize[d] that it is the inventor that applies for the patent.” *Id.* (quoting *S. Rep. No. 82-1979*, at 5 (1952) (Conf. Rep.), reprinted in 1952 U.S.C.C.A.N. 2394, 2395). Thus, the repeal of § 102(f) did not eliminate invalidity due to incorrect listing of inventors.

Accordingly, we hold that a patent which incorrectly lists its inventor(s) and cannot be corrected according to law is invalid. Because it is undisputed that Huang is a coinventor, *see Decision*, 748 F. Supp. 3d at 619, the patents suffer from the error of an omitted inventor. And because Fortress could not correct the patents under § 256, the patents are therefore invalid due to an omitted inventor. We thus affirm the district court's grant of DSI's motion for summary judgment of invalidity.

Conclusion

We have considered the remainder of Fortress's arguments but find them unpersuasive. For the foregoing reasons, we affirm the summary judgment decision of the district court.

AFFIRMED

All Citations

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Footnotes

- 1 Honorable Thomas S. Kleeh, Chief United States District Judge, United States District Court for the Northern District of West Virginia, sitting by designation.
- 2 J.A. refers to the Joint Appendix filed at ECF 18.
- 3 See Oral Arg. at 2:56–3:06, *available at* cafc.uscourts.gov/oral-arguments/24-2313_02062026.mp3 (Fortress's counsel agreeing this is a “case of first impression”); *id.* at 15:30–50 (DSI's counsel agreeing “there is no case on point” for these facts).
- 4 Before the district court, Fortress conceded it could not utilize the process under [35 U.S.C. § 256\(a\)](#) to add Huang as an inventor to the patents. *Decision*, 748 F. Supp. 3d at 619. We express no view on the basis for that concession, and Fortress does not contend it can satisfy [§ 256\(a\)](#) now. See Open. Br. at 3.

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**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

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