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NOTE: This order is nonprecedential.

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

In re: THOMAS WILKINS,
Petitioner

2020-141

On Petition for Writ of Mandamus to the United States
District Court for the Eastern District of California in No.
1:10-cv-00674-LJO-JLT, Judge Lawrence J. O'Neill.

ON PETITION

Before NEWMAN, LOURIE, and HUGHES, *Circuit Judges*.
PER CURIAM.

ORDER

In *General Electric Co. v. Wilkins*, 750 F.3d 1324 (Fed. Cir. 2014), this court affirmed the judgment of the United States District Court for the Eastern District of California that Thomas Wilkins was not a co-inventor of U.S. Patent No. 6,921,985. Mr. Wilkins now petitions this court for a writ of mandamus to vacate, reverse, or dismiss various

rulings in that and other related closed appeals and in the closed underlying district court proceedings.*

Mr. Wilkins' petition appears to be an attempt to relitigate that prior litigation concerning his inventorship dispute with GE. Mr. Wilkins lost the first time around on the issues that he seeks review, and mandamus is not intended to afford him a second bite of the appellate apple. *Cf. Roche v. Evaporated Milk Ass'n*, 319 U.S. 21, 26 (1943) (explaining that mandamus is not a substitute for an appeal). Because Mr. Wilkins clearly does not have a right to the relief he seeks, the court denies his petition.

Accordingly,

IT IS ORDERED THAT:

The petition is denied.

FOR THE COURT

August 14, 2020

Date

/s/ Peter R. Marksteiner

Peter R. Marksteiner
Clerk of Court

s25

* General Electric ("GE") had also sought to quiet title as to U.S. Patent No. 6,924,565, but the district court found that claim was time-barred, and GE voluntarily withdrew its appeal from that judgment. Mr. Wilkins filed a separate complaint asserting claims for malicious prosecution and abuse of process against GE and its counsel. Mr. Wilkins voluntarily dismissed that complaint in 2014. To the extent that he is seeking mandamus relief as to that separate case, we must deny for the reasons stated herein.

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18 **UNITED STATES DISTRICT COURT**
 19 **EASTERN DISTRICT OF CALIFORNIA**

20 GENERAL ELECTRIC COMPANY, a New York corporation; and GE WIND ENERGY, LLC, a Delaware limited liability company,
 21)
 22 Plaintiffs and Counter-Defendants,)
 23 vs.)
 24 THOMAS WILKINS, an individual,)
 25 Defendant and Counter-Plaintiff.)

Case No. CV 10-00674-LJO-JLT

NOTICE OF PLAINTIFFS GENERAL ELECTRIC COMPANY AND GE WIND ENERGY, LLC'S ABANDONMENT OF CERTAIN ASSERTED CLAIMS

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GE'S NOTICE OF ABANDONMENT OF CERTAIN ASSERTED CLAIMS

1 NOTICE IS HEREBY GIVEN THAT Plaintiffs General Electric Company and GE Wind
2 Energy, LLC ("GE"), in anticipation of trial and in an effort to streamline the issues the Court
3 may be asked to consider by the parties in summary judgment submissions due to be filed
4 tomorrow, June 29, 2012, GE hereby abandons, with prejudice, certain contract claims asserted
5 against Defendant Mr. Thomas Wilkins ("Mr. Wilkins") in its Amended Complaint (Doc. 76).
6 GE notified Mr. Wilkins and Intervenor Mitsubishi Heavy Industries, Ltd. and Mitsubishi
7 Power Systems Americas, Inc. ("MHI") of its intent to abandon these contract claims on June 15,
8 2012. The parties were unable to reach agreement on a stipulation. GE called the Court's clerk
9 and was advised that referring to the dismissal of claims in GE's motion for summary judgment
10 would be sufficient, as would this Notice of Abandonment. Pursuant to Local Rule 281, GE will
11 include a similar statement of the abandoned issues but GE did not want to wait until the pre-trial
12 statement to make all parties and the Court aware of its intentions.

13 Specifically, GE hereby abandons, with prejudice, the following:

- 14 a. First Claim for Relief for Breach of Contract as to '985 Patent—C&I Agreement;
- 15 b. Second Claim for Relief for Breach of Contract as to '985 Patent—EIP
16 Agreement;
- 17 c. Fourth Claim for Relief for Breach of Contract as to '565 Patent—C&I
18 Agreement;
- 19 d. Fifth Claim for Relief as to '565 Patent—EIP Agreement;
- 20 e. Seventh Claim for Relief for Declaratory Relief—Appointment of Attorney-in-
21 Fact Under C&I Agreement; and
- 22 f. Eighth Claim for Relief for Declaratory Relief—Rights to Inventions During
23 Employment, but only to the extent this claim for relief is based on Paragraphs 95
24 or 96 of the Amended Complaint; and
- 25 g. GE's corresponding claims for compensatory damages as described in its Prayer
26 for Relief Paragraphs H and I.

27 GE intends to pursue its remaining claims at trial, and hereby maintains its request for
28 relief with respect to those remaining claims. As stated above, GE submits this Notice of

GE'S NOTICE OF ABANDONMENT OF CERTAIN ASSERTED CLAIMS

1 Abandonment with prejudice, but does not intend this Notice to constitute a stipulation as to any
2 facts at issue or relevant to this Action.

3 ***

4
5 Dated: June 28, 2012

/s/ Alex C. Boudreau
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21 **Attorneys for Plaintiffs**
GENERAL ELECTRIC COMPANY AND
GE WIND ENERGY, LLC

1 ///

2 WHEREAS, GE contends that it is the sole owner of the equitable and legal rights to the
3 „565 and „985 Patents; and

4 WHEREAS, Wilkins' counsel, on behalf of Wilkins, contends that the International
5 Trade Commission, in their opinion dated January 19, 2010, in the matter of Investigation No.
6 337-TA-641, at page 35, stated that "Wilkins is an unnamed inventor of claim 15 of the „985
7 patent, that GE has not provided any showing to the effect that Wilkins had an obligation to
8 assign the patent to GE As an inventor, Wilkins does have an equitable interest that can be
9 perfected to legal title . . .;" and

10 WHEREAS, Wilkins' counsel, on behalf of Wilkins, further contends that Thomas
11 Alexander Wilkins, the man, is the primary inventor of, among other things, the technologies
12 known as Ride Through for Wind Turbines, Low Voltage Ride Through For Wind Turbines,
13 Power Factor Control For Wind Turbines, Reactive Power Control For Wind Turbines, and
14 Continuous Reactive Power Control For Wind Turbines, and was the primary inventor of various
15 other claims in the „985 and „565 patents. Wilkins claims to have inventorship rights in those
16 inventions, which rights Wilkins claims have never been assigned to any entity, including GE;
17 and

18 WHEREAS, on July 9, 2010, GE filed a motion for a preliminary injunction to enjoin
19 Wilkins from *inter alia* licensing the rights to the „565 and „985 Patents pending a trial on the
20 merits (Docket No. 15); and

21 WHEREAS, on July 15, 2010, Wilkins filed a motion to dismiss GE's complaint on
22 statute of limitations grounds (Docket No. 26); and

23 WHEREAS, on July 26, 2010, GE filed a motion for a temporary restraining order to
24 enjoin Wilkins from *inter alia* licensing the rights to the „565 and „985 Patents pending
25 hearing on the motion for a preliminary injunction (Docket No. 30); and
26
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 20 GE WIND ENERGY, LLC

21 UNITED STATES DISTRICT COURT
 22 EASTERN DISTRICT OF CALIFORNIA

23)
 24) GENERAL ELECTRIC COMPANY, a New
 25) York corporation; and GE WIND ENERGY,
 26) LLC; a Delaware limited liability company,
 27)
 28) Plaintiffs,
)
) vs.
)
) THOMAS WILKINS, an individual,
)
) Defendant.
)
)

Case No. CV 10-00674-OWW-JLT

**STIPULATED TEMPORARY
 RESTRAINING ORDER AND
 SCHEDULING ORDER**

23 WHEREAS, on April 15, 2010, Plaintiffs General Electric Company and GE Wind
 24 Energy, LLC (collectively "GE") filed their unverified complaint against Defendant Thomas
 25 Wilkins ("Wilkins") for declaratory relief, breach of contract, injunctive relief and specific
 26 performance related to United States Patent Nos. 6,924,565 and 6,921,985 (the "565 and 985
 27 Patents") (Docket No. 1); and

28

1 4. Represent on his website or otherwise, unless under oath in judicially required or
2 requested testimony, that he believes he has an ownership interest in the „565 and
3 „985 Patents, or that he believes he has the lawful right to license under the „565
4 and „985 Patents.

5 ///

6 ///

7 Wilkins, through his counsel, hereby asserts that these orders are, or could be, a
8 significant suspension of Wilkins' rights under the law.

9 Dated: July 30, 2010

10 /s/ Jonathan A. Eldredge
11 Jonathan A. Eldredge
12 Attorney for Plaintiffs

13 Dated: July 30, 2010

14 /s/ Michael L. Schulte (as authorized 7/30/2010)
15 Michael L. Schulte
16 Attorney for Defendant

17 PURSUANT TO THE STIPULATION OF THE PARTIES, the Court hereby ORDERS

18 that:

- 19 1. GE's motion for a temporary restraining order (Docket No. 30) is denied as moot;
- 20 2. The hearing date for GE's motion for a preliminary injunction (Docket No. 15) is
21 taken off calendar pending the hearing on Wilkins' motion to dismiss;
- 22 3. The hearing date for Wilkins' motion to dismiss (Docket No. 26) shall be on
23 September 27, 2010 at 10:00AM.
- 24 4. The briefing schedule on Wilkins' motion to dismiss shall be pursuant to the
25 Local Rules; and
- 26 5. The Court will set a hearing date and briefing schedule for GE's motion for a
27 preliminary injunction at the hearing on Wilkins' motion to dismiss.

28 THE COURT FURTHER ORDERS that Wilkins (and all those acting in concert with
him) be enjoined as follows pending GE's hearing on the motion for a preliminary injunction:

1 WHEREAS, Wilkins and GE neither admit nor deny anything herein or otherwise by
2 means of agreeing to this stipulation, and Wilkins reserves the right to oppose GE's motion for a
3 preliminary injunction, including the bond amount;

4 ///

5 WHEREAS, the parties stipulate and agree that:

- 6 1. GE's motion for a temporary restraining order (Docket No. 30) is denied as moot;
- 7 2. The hearing date for GE's motion for a preliminary injunction (Docket No. 15) is
8 taken off calendar pending the hearing on Wilkins' motion to dismiss;
- 9 3. The hearing date for Wilkins' motion to dismiss (Docket No. 26) shall be set on a
10 date agreeable to the Court at the earliest practicable opportunity, and the briefing
11 4.
12 5. schedule shall be pursuant to the Local Rules; and
- 13 6. The Court will set a hearing date and briefing schedule for GE's motion for a
14 preliminary injunction at the hearing on Wilkins' motion to dismiss. The parties
15 request that the hearing on GE's motion for a preliminary injunction be set within
16 35 days of the hearing on Wilkins' motion to dismiss.

17 THEREFORE, the parties stipulate and agree that pending GE's hearing on the motion
18 for a preliminary injunction that neither Wilkins, nor any person or entity acting in concert with
19 Wilkins, shall:

- 20 1. Take any steps to license, purport to license, grant, or purport to grant, rights to
21 third parties in GE's Patent Nos. 6,924,565 and 6,921,985 (the "565 and 985
22 Patents"); or
- 23 2. Modify or extend the license agreement with Mitsubishi Heavy Industries, Ltd.
24 and/or related entities related to GE's 565 and 985 Patents; or
- 25 3. Engage in any conduct that would convey or tend to convey to third parties that
26 Wilkins is licensing or will license any ownership interest in the 565 or 985
27 Patents; or

28

PUBLIC VERSION

The Commission finds that Wilkins is an unnamed inventor of claim 15 of the '985 patent,¹² that GE has not provided any showing to the effect that Wilkins had an obligation to assign the patent to GE, and that GE has not joined Wilkins as a party to this investigation. Nevertheless, it is undisputed that Wilkins is not named on the face of the patent, and we find that Wilkins therefore lacks such legal title as to make him an owner of the '985 patent. As an inventor, Wilkins does have an equitable interest that can be perfected to legal title upon application to the USPTO, or through correction by a district court under 35 U.S.C. § 256. The Commission, however, lacks the authority to correct inventorship under Section 256 or any other statutory provision, and the Commission's authority in this regard must be conferred by statute. Moreover, Mitsubishi cannot properly assert an equitable interest on behalf of Wilkins. *See Dorr-Oliver v. United States*, 432 F.2d 447, 451 (Ct. Cl. 1970); *Mercantile National Bank of Chicago v. Howmet Corp.*, 524 F.2d 1031, 1034 (7th Cir. 1975); *Bd. of Trustees of Leland Stanford Jr. Univ. v. Roche Molecular Sys.*, 583 F.3d 832, 848 (Fed. Cir. 2009).

Mitsubishi and the IA have relied upon two cases, *Ethicon, Inc. v. U.S. Surgical Corp.*, 135 F.3d 1456, 1458 (Fed. Cir. 1998), and *Roche Molecular Sys.*, 583 F.3d at 841-42, 848-49 (Fed. Cir. 2009), in support of their argument that GE lacks standing. *Ethicon* is distinguishable because the court corrected inventorship pursuant to Section 256 prior to dismissing the complaint for failure to properly join all owners. *Ethicon*, 135 F.3d at 1459-60. Similarly, in

¹² The ALJ's finding that GE failed to name Wilkins as an inventor is corroborated by the Lake Benton II report and by Lutze and Fogarty regarding contributions during and after Lake Benton II in conceiving of the claimed uninterruptible power supply. JX-10 at 218-220; RX-354C at GEWT00163510; Tr. 2007:21-24; 2012:3-25 (Fogarty); Tr. 2206-07, 2226-35 (Wilkins).

- 1 1. Taking any steps to license, purport to license, grant, or purport to grant, rights to
2 third parties in GE's Patent Nos. 6,924,565 and 6,921,985 (the "„565 and „985
3 Patents"); or
4 2. Modifying or extending the license agreement with Mitsubishi Heavy Industries,
5 Ltd. and/or related entities related to GE's „565 and „985 Patents; or
6 ///
7 ///
8 3. Engaging in any conduct that would convey or tend to convey to third parties that
9 Wilkins is licensing or will license any ownership interest in the „565 or „985
10 Patents; or
11 4. Representing on his website or otherwise, unless under oath in judicially required
12 or requested testimony, that he believes he has an ownership interest in the „565
13 and „985 Patents, or that he believes he has the lawful right to license under the
14 „565 and „985 Patents.

15
16
17
18 IT IS SO ORDERED.

19 Dated: July 30, 2010

/s/ Oliver W. Wanger
UNITED STATES DISTRICT JUDGE