

No. 23-185

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IN THE  
**Supreme Court of the United States**

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HIP, INC.,

*Petitioner,*

*v.*

HORMEL FOODS CORPORATION,

*Respondent.*

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ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED  
STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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**BRIEF IN OPPOSITION**

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Dated: September 28, 2023

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**QUESTIONS PRESENTED FOR REVIEW**

Whether the court of appeals erred in determining that a party seeking to establish joint inventorship under 35 U.S.C. §§ 116 and 256 had not met its burden of establishing, by clear and convincing evidence, that the putative inventor made a contribution to the claimed invention in the patent that was not insignificant in quality, when that contribution was measured against the dimension of the full invention.

**CORPORATE DISCLOSURE STATEMENT**

Respondent Hormel Foods Corporation has no parent corporation and no publicly held corporation owns 10% or more of its stock.

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## INTRODUCTION

The Federal Circuit unanimously held that David Howard, the CEO of Petitioner HIP, Inc., was not a joint inventor of the invention claimed in Hormel’s U.S. Patent No. 9,980,498 (the “498 patent”) relating to methods for making precooked bacon and meat. App. 11a. Applying the Federal Circuit’s long-standing, three-factor test for joint inventorship set forth in *Pannu v. Iolab Corp.*, 155 F.3d 1344 (Fed. Cir. 1998), the panel found that Howard’s alleged contribution, preheating meat with an infrared oven, was “insignificant in quality” to the claimed invention and did not pass the second *Pannu* factor, which requires that a party claiming joint invention “make a contribution to the claimed invention that is not insignificant in quality, when that contribution is measured against the dimension of the full invention.” App. 11a (quoting *Pannu*, 155 F.3d at 1351).

The Federal Circuit’s reliance on *Pannu* to decide this dispute was not a surprise. HIP argued to both the district court and Federal Circuit that *Pannu* provided the proper framework for analyzing joint inventorship disputes under 35 U.S.C. §§ 116 and 256. In its appellee brief before the Federal Circuit, for example, HIP explained that the “Parties agree that [the *Pannu*] three-part test applies for inventorship”, and HIP framed its arguments in terms of the test. HIP Appellee Br. 23; App. 8a (“The parties here frame their arguments using the three-part test articulated in *Pannu*, 155 F.3d at 1351.”).

Dissatisfied with the outcome at the Federal Circuit, HIP now argues that the Federal Circuit took a wrong turn in 1998 in deciding *Pannu* and asks that the Court reverse the Federal Circuit’s application of *Pannu*, overturn *Pannu*, and upset 25 years of Federal Circuit



precedent in the process. The Court need not consider that request. Having repeatedly argued to the lower courts that *Pannu* is the proper test, HIP has waived any argument that *Pannu* was wrongly decided.

Even without waiver, HIP's attack on *Pannu* would fail. The *Pannu* test is entirely consistent with the Federal Circuit's preceding decisions and has been applied consistently by the appellate court for 25 years without any notable dissenting opinions.

HIP manufactures a strawman for its other line of attack, claiming that the Federal Circuit created a bright-line, quantitative rule requiring a party challenging inventorship to provide a certain quantity of evidence in the form of a disclosure within the challenged patent to establish that an alleged contribution was significant in quality to the full invention. HIP claims this violates the statutory underpinnings of *Pannu*.

The Federal Circuit's opinion here creates no such bright-line rule. As the district court pointed out, the evidence for significance in this case is limited to the patent disclosure itself, as HIP failed to introduce any evidence of significance beyond the patent's four corners. HIP did not attempt to introduce contemporaneous documents supporting the contribution's importance to the claimed method or present expert testimony explaining the contribution's significance to the invention. Instead, HIP chose to rely on the patent disclosure alone, leaving the district court and Federal Circuit with a limited record upon which to assess whether the alleged contribution was significant by clear and convincing evidence. The Federal Circuit decided the case based on the record presented, not based on a bright-line rule indicating that a disclosure

amounting to fewer than 20 words, for example, is *per se* insignificant.

The petition should be denied.

## STATEMENT OF THE CASE

### I. LEGAL BACKGROUND

Inventorship is a question of law that the Federal Circuit reviews without deference to the district court. *Gen. Elec. Co. v. Wilkins*, 750 F.3d 1324, 1329 (Fed. Cir. 2014). The burden on the party asserting that an individual should be added as an inventor to a patent is a heavy one. *Pannu*, 155 F.3d at 1349. The issuance of a patent creates a presumption that the named inventors are the true and only inventors. *Gen. Elec. Co.*, 750 F.3d at 1329. As such, an alleged joint inventor must prove a claim of joint inventorship by clear and convincing evidence. *Hess v. Advanced Cardiovascular Sys., Inc.*, 106 F.3d 976, 980 (Fed. Cir. 1997).

To qualify as a joint inventor, a person must make a significant contribution to the invention as claimed. *Fina Oil & Chem. Co. v. Ewen*, 123 F.3d 1466, 1473 (Fed. Cir. 1997). Under the three-part test articulated in *Pannu*, HIP needed to establish that Howard (1) contributed in some significant manner to the conception of the invention; (2) made a contribution to the claimed invention that is not insignificant in quality, when that contribution is measured against the dimension of the full invention; and (3) did more than merely explain to the real inventors well-known concepts or the current state of the art. 155 F.3d at 1351. All three factors were at issue at the Federal Circuit level, along with the question of whether HIP adequately corroborated Howard's inventorship testimony. App.

8a-10a. The Federal Circuit limited its decision to the second *Pannu* factor, as discussed below.

## II. FACTUAL BACKGROUND

Hormel is a leading food processing company with special expertise in bacon. Among its many meat and bacon offerings, Hormel has been making precooked bacon for decades. Precooked bacon refers to bacon that has been cooked by the producer prior to sale to the customer or consumer. The '498 patent at issue in this case represents Hormel's latest innovation in precooked bacon.

In early 2005, Hormel embarked on a project to improve its microwave cooking process for precooked bacon. App. 5a. In 2007, Hormel met with Howard of Unitherm Food Systems, Inc. ("Unitherm") to discuss the products and processes that Hormel was developing and Unitherm's equipment. *Id.* Unitherm, which became HIP, was a company that produced food safety and thermal processing equipment. *Id.*

Howard and Tom Van Doorn, both of Unitherm, met with Hormel in July 2007 and in subsequent months. *Id.* The parties eventually entered into a joint agreement to develop a commercial spiral oven for making precooked bacon using 100% superheated steam. *Id.*; CA JA 1690-1692. In December 2007, Hormel conducted pork loin testing relating to color development. App. 5a. Hormel compared cooking pork loins in an infrared oven to a conventional spiral oven. *Id.*; CA JA 771-772, 1719. Howard later alleged that it was during these meetings and testing process that he disclosed the infrared preheating concept at issue in this case. App. 5a.

Through January 2008, Hormel conducted bacon testing using Unitherm's mini spiral test oven at Unitherm's facility. *Id.* Unfortunately, cooking bacon in Unitherm's mini spiral oven left the bacon with a charred, off flavor, and also noticeably reduced the flavor intensity. CA JA 58-59 ('498 patent, col. 1 ll. 31-47), 669, 745-747. After experiencing problems with the spiral oven and testing at Unitherm's facility, Hormel leased the oven and moved it to its own research and development facility to continue testing. App. 5a. Hormel's subsequent in-house testing revealed that turning off internal electrical heating elements in the oven solved the charred, off flavor of the bacon, and preheating the bacon with a microwave oven prevented condensation from washing away the salt and flavor and reducing the flavor intensity. App. 6a. That testing resulted in a two-step cooking process, the first step involving preheating the bacon and the second step involving cooking the meat in a superheated steam oven. *Id.*

Hormel filed a non-provisional patent application for the two-step cooking process in August 2011, listing Brian J. Srsen, Richard M. Herreid, James E. Mino, and Brian E. Hendrickson as joint inventors. *Id.* The application issued in May 2018 as the '498 patent. *Id.* The '498 patent names the four inventors, all of whom assigned their interests in the patent to Hormel. *Id.*

The '498 patent is directed to methods of precooking bacon and meat pieces. App. 2a. It claims a two-step method that involves a first preheating step using a microwave oven, infrared oven, or hot air, followed by a second, higher-temperature cooking step. *Id.* The first step creates a layer of melted fat around the meat pieces, protecting the meat from condensation that may wash away salt and flavor during cooking. *Id.* The second step prevents the charred, off flavor associated with cooking

the meat pieces at higher temperatures. *Id.* (citing '498 patent, col. 3 ll. 52-61).

The '498 patent has three independent claims, with claims 1 and 5 being the most relevant here (reproduced below with emphasis added to demonstrate the differences in the claim language):

Claim 1	Claim 5
<p>1. A method of making precooked <b>bacon</b> pieces using a hybrid cooking system, comprising:</p> <p>preheating <b>bacon slices with a microwave oven</b> to a temperature of <b>140° F. to 210° F.</b> to create preheated <b>bacon</b> pieces, the preheating forming a barrier with melted fat around the preheated <b>bacon</b> pieces and reducing an amount of condensation that forms on the preheated <b>bacon</b> pieces when transferred to a cooking compartment <b>of an oven</b>, the barrier preventing any condensation that forms from contacting the preheated <b>bacon</b> pieces under the melted fat and diluting flavor in the preheated <b>bacon</b> pieces;</p>	<p>5. A method of making precooked <b>meat</b> pieces using a hybrid cooking system, comprising:</p> <p>preheating <b>meat pieces in a first cooking compartment using a preheating method selected from the group consisting of a microwave oven, an infrared oven, and hot air</b> to a temperature of <b>at least 140° F.</b> to create preheated <b>meat</b> pieces, the preheating forming a barrier with melted fat around the preheated <b>meat</b> pieces and reducing an amount of condensation that forms on the preheated <b>meat</b> pieces when transferred to a <b>second</b> cooking compartment, the barrier preventing any condensation that forms from contacting the preheated <b>meat</b> pieces</p>

<p>transferring the preheated <b><u>bacon</u></b> pieces to the cooking compartment <b><u>of the oven</u></b>, the cooking compartment heated with <b><u>steam from an external steam generator</u></b>, the external <b><u>steam generator</u></b> being external to the cooking compartment, <b><u>the steam being injected into the cooking compartment and being approximately 400° F. to 1000° F. when the steam leaves the external steam generator</u></b>, the cooking compartment including internal surfaces, <b><u>the steam</u></b> assisting in keeping the internal surfaces at a temperature below <b><u>375° F.</u></b> thereby reducing off flavors during cooking in the cooking compartment; and</p> <p>cooking the preheated <b><u>bacon</u></b> pieces in the cooking compartment to a water activity level of 0.92 or less to create precooked <b><u>bacon</u></b> pieces.</p>	<p>under the melted fat and diluting flavor in the preheated <b><u>meat</u></b> pieces;</p> <p>transferring the preheated <b><u>meat</u></b> pieces to the <b><u>second</u></b> cooking compartment, the <b><u>second</u></b> cooking compartment heated with <b><u>an external heating source</u></b>, the external <b><u>heating source</u></b> being external to the <b><u>second</u></b> cooking compartment, the <b><u>second</u></b> cooking compartment including internal surfaces, <b><u>the external heating source</u></b> assisting in keeping the internal surfaces at a temperature below <b><u>a smoke point of fat from the meat pieces</u></b> thereby reducing off flavors during cooking in the <b><u>second</u></b> cooking compartment; and</p> <p>cooking the preheated <b><u>meat</u></b> pieces in the <b><u>second</u></b> cooking compartment to a water activity level of 0.92 or less to create precooked <b><u>meat</u></b> pieces.</p>
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*See* App. 2a-4a (citing '498 patent, col. 9 ll. 23-48 and col. 9 l. 57-col. 10 l. 17).

### III. THE DISTRICT COURT DECISION

In April 2021, HIP sued Hormel in the United States District Court for the District of Delaware, alleging that Howard was either the sole inventor or a joint inventor of the '498 patent. App. 6a.

After a bench trial, the district court determined that Howard was not the sole inventor of the '498 patent. App. 6a. HIP then argued that Howard contributed to at least one of the following: (1) using superheated steam at a level of 90% or more in claims 3 and 12; (2) heating the internal surfaces of the oven to a temperature less than 375° Fahrenheit in claim 1; (3) preheating by hot air in claim 5; and/or (4) preheating with an infrared oven in claim 5. *Id.* The district court rejected HIP's first three arguments, but it found that Howard was a joint inventor based on his alleged contribution of the infrared preheating concept in claim 5. *Id.* As encouraged by the parties, the district court applied the *Pannu* three-factor test and assessed the purported significance of Howard's contribution to the full invention in claim 5. App. 30a.

After acknowledging that there are multiple differences between the claim language in claims 1 and 5 (*e.g.*, the substitution of "meat" for "bacon" and removal of the 210 Fahrenheit cap in the preheating step), the district court focused on the addition of the hot air and infrared oven portions in claim 5 as the inventive difference between the two claims and asserted: "It has to be significant". *See* App. 30a-31a. The district court

acknowledged that its analysis was based solely on the difference in claim language, stating:

And by the way, I don't think that HIP has put on any testimony or record evidence that would establish that these three things are significant. So you have an appeal issue in the sense that I'm basing this solely on what's in the patent. Essentially, I'm doing claim construction.

App. 31a.

The district court then found that HIP had adequately corroborated Howard's testimony that he had contributed the infrared oven element to the claims. App. 33a-34a. When Hormel asked whether the district court was also finding that the alleged contribution of infrared ovens was not well known in the art (*i.e.*, the first *Pannu* factor), the district court repeated the claim differentiation theory and indicated that the use of an infrared oven had to be significant based on the difference in language between claims 1 and 5. *See* App. 37a-38a.

#### **IV. THE FEDERAL CIRCUIT APPEAL**

On appeal to the Federal Circuit, Hormel challenged the district court's findings on the *Pannu* factors and determination that Howard's testimony had been adequately corroborated for purposes of joint inventorship. App. 7a.

Both parties again framed their arguments using the three-factor test articulated in *Pannu*. App. 8a, HIP Appellee Br. 23 ("The Parties agree that [the *Pannu*]



three-part test applies for inventorship.”). Among other things, HIP asserted that the district court did not err in applying claim differentiation to claims 1 and 5 to determine that the infrared oven was significant to the full invention in claim 5.

The Federal Circuit reversed. App. 14a. It disregarded the district court’s claim differentiation approach and proceeded to analyze the record for evidence relating to infrared preheating and its significance. App. 11a. Focusing on the second *Pannu* factor, the Federal Circuit found that “Howard’s alleged contribution of preheating meat pieces using an infrared oven is ‘insignificant in quality’ to the claimed invention.” *Id.* (quoting *Pannu*, 155 F.3d at 1351). As evidence of this insignificance, the Federal Circuit walked methodically through the patent’s disclosure and noted that “Howard’s alleged contribution, preheating with an infrared oven, is mentioned only once in the ’498 patent specification as an alternative heating method to a microwave oven.” *Id.* (citing ’498 patent, col. 5 ll. 40-42). The Federal Circuit noted that the infrared preheating approach is not discussed in the patent’s summary of the invention, described in any of the patent’s multiple examples, or depicted in any figures. App. 11a-12a. By comparison, the use of the microwave approach is discussed and depicted extensively: “In contrast to the insignificant disclosure of preheating with an infrared oven, preheating with microwave ovens, and microwave ovens themselves, feature prominently throughout the specification, claims, and figures.” App. 12a. Example 3 in the patent discusses the use of four preheating methods, including a microwave/superheated steam system, which, the specification discloses, “is the system in accordance with the present invention.” App.

13a (citing '498 patent, col. 6 ll. 23-40). After reviewing the evidence, the court concluded:

In summary, the specification, claims, and figures all illustrate that Howard's alleged contribution of preheating the bacon or meat pieces with an infrared oven is "insignificant in quality" when "measured against the dimension of the full invention," *Pannu*, 155 F.3d at 1351, which squarely focuses on a preheating step using a microwave oven. Thus, we conclude that Howard is not a joint inventor of the '498 patent.

App. 13a.

Having found one of the three *Pannu* factors lacking, the Federal Circuit declined to address the other two factors or otherwise weigh in on the question of corroboration. App. 14a. In its conclusion, the Federal Circuit indicated that it had considered the remaining arguments (*e.g.*, HIP's assertion that the district court was correct to rely on claim differentiation to establish significance) and found them unpersuasive.

The opinion was unanimous.

## V. PETITION FOR REHEARING EN BANC

After the decision, HIP filed a combined petition for panel rehearing and rehearing en banc. App. 40a. The Federal Circuit denied both petitions.

## REASONS FOR DENYING THE PETITION

There is no compelling reason for the Court to review this case. There is no conflict of law between the Federal Circuit and other appellate courts regarding joint inventorship law. The Federal Circuit is the circuit court that reviews cases arising out of patent law, so any conflict would need to come from within the Federal Circuit's body of case law. Nor does HIP assert that there is any conflict between this Court's decisions and the opinion below. Ultimately, HIP is asserting that the Federal Circuit misapplied a properly stated rule of law, which is generally not considered a viable ground for review before this Court. Supreme Court Rule 10.

### I. HIP WAIVED ITS CURRENT CHALLENGE TO *PANNU* BY URGING THE FEDERAL CIRCUIT TO APPLY THAT CASE

In its petition, HIP attempts to manufacture a conflict within Federal Circuit precedent between *Pannu* on the one hand and the appellate court's earlier inventorship cases on the other.

This effort fails for at least two reasons. First, HIP waived any challenge to *Pannu* by encouraging the Federal Circuit to apply it. HIP affirmatively argued to the Federal Circuit that *Pannu* presented the proper test for joint inventorship. App. 8a. HIP cannot raise an issue on petition for writ of certiorari that it failed to present and preserve below. *See Wood v. Milyard*, 566 U.S. 463, 474 (2012) (concluding a failure to raise an argument below constituted waiver). Second, HIP's argument fails on its merits. The *Pannu* court gathered and synthesized prior

holdings from Federal Circuit decisions into the test; it did not depart from those holdings. 155 F.3d at 1351 (citing *Fina Oil & Chemical Co.*, 123 F.3d at 1473 and *Ethicon, Inc. v. United States Surgical Corp.*, 135 F.3d 1456, 1460 (Fed. Cir. 1998)). Indeed, the second *Pannu* factor upon which the Federal Circuit based its decision in this case comes directly from *Fina Oil*, in which the Federal Circuit required a contribution “that is not insignificant in quality, when that contribution is measured against the dimension of the full invention.” 123 F.3d at 1473.

In the 25 years since *Pannu* was decided, there has been no push for its reversal. There was no dissent in *Pannu* when the test was laid out, and there was no dissent to its application in this case. Given the lack of interest at the Federal Circuit level in rehearing HIP’s petition en banc, this case does not present any burning issue requiring the Court’s attention.

## **II. THE FEDERAL CIRCUIT DID NOT CREATE A NEW, BRIGHT-LINE RULE ESTABLISHING A LOWER LIMIT ON INVENTORSHIP EVIDENCE**

HIP also contends that the Federal Circuit in this case has created a new, bright-line test for significance under the second *Pannu* factor that it used to improperly reject HIP’s inventorship claim. HIP suggests that the Federal Circuit’s opinion means that unless the patent disclosure contains some magic number of words describing a contribution, then that contribution is *per se* insignificant to the full invention.

HIP overstates its case. Contrary to HIP’s suggestion, the Federal Circuit’s opinion does not identify any bright

line below which HIP's evidence dropped and caused its defeat. The Federal Circuit did not state, for example, that a party seeking to meet the significance test must point to a minimum of five references in the specification or that the combined disclosures in the specification must total at least 50 words to qualify for significance. These examples would impose explicit lower limits not contemplated by *Pannu*. Rather, the Federal Circuit here reviewed the entirety of the record evidence, and concluded that, when compared to the disclosed importance of other key features to the invention, and in light of the full invention and its focus, preheating in an infrared oven was not significant when measured against the full invention. That is precisely the kind of qualitative analysis that *Pannu* contemplates.

The Federal Circuit focused on the patent specification here not because that is the only allowable evidence, but because that was the only evidence HIP provided. As the district court pointed out, there was no evidence in the record regarding the significance of infrared preheating to the invention *other* than the patent itself. App. 31a (“And by the way, I don’t think that HIP has put on any testimony or record evidence that would establish that these three things are significant.”). Rather than put evidence into the record through documents, testimony, or expert opinions showing that infrared preheating provided unexpected results or constituted something new in the field, HIP limited its presentation of evidence to the patent and relied on the district court’s claim differentiation between claims 1 and 5 to demonstrate significance.<sup>1</sup>

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1. In contrast, though the Federal Circuit did not rely on it, Hormel presented additional evidence that preheating meat pieces with an infrared oven was not new, but was well known and part of the state of the art. App. 8a-9a.

Had the Federal Circuit created a bright-line rule, as HIP claims, the decision would have been much shorter. The Federal Circuit would have noted that there is only one reference to infrared preheating in the patent specification and stopped, finding one reference insignificant *per se*. But that is not what the panel did. It worked its way methodically through the summary of the invention, description of embodiments, figures, and the claims, looking for evidence of significance and finding it lacking. Given the heavy burden of proving joint invention by clear and convincing evidence and the dearth of evidence in the record supporting HIP's claim, the court correctly determined that the quality of the contribution, particularly relative to other enumerated elements, was insignificant.

This is not a new approach. The Federal Circuit analyzed a similar set of facts in an invention dispute in 2009 and likewise found the asserted contribution insignificant to the full invention. *Nartron Corp. v. Schukra U.S.A. Inc.*, 558 F.3d 1352, 1353 (Fed. Cir. 2009). In *Nartron*, the putative inventor claimed to have contributed an "extender" element for an automobile seat control module contained in a dependent claim. *Id.* at 1354. The Federal Circuit analyzed the purported contribution and found it insignificant when measured against the full dimension of the invention of that claim. *Id.* at 1357-58. After analyzing the entire patent, the court noted that the specification mentioned the extender "only once in a twenty-column patent" and stated that the "only time that the specification mentions the extender, it does no more than refer to it as background upon which the invention is built." *Id.* at 1358.

The *Nartron* decision thus applied the same test with the same result, analyzing the same type of evidence and finding it lacking. There is no dissenting opinion in *Nartron*. Nor has there been any suggestion in 14 years since that decision that the Federal Circuit created an impermissible bright-line rule by pointing out the paucity of support in the specification.

The Federal Circuit did not create a new, bright-line rule for this Court to review. It applied its long-standing test consistent with how it has been applied for the past 25 years.

### **III. THE FEDERAL CIRCUIT'S DECISION IS CORRECT ON THE MERITS**

Beyond being a poor candidate for a writ of certiorari, this case was also correctly decided on the merits. As indicated above, inventorship is a question of law that the Federal Circuit reviews *de novo*. *Gen. Elec. Co.*, 750 F.3d at 1329. The named inventors are presumed correct, and an alleged joint inventor must prove a claim of joint inventorship by clear and convincing evidence. *Hess*, 106 F.3d at 980.

The Federal Circuit was correct to reverse, as the district court decision relied upon an impermissible shortcut to finding significance under *Pannu*. The district court acknowledged the lack of record evidence but determined that because there were differences in scope between claims 1 and 5, the element causing that difference in scope *must* be significant to the full invention. App. 30a-31a (“It has to be significant.”).

Claim differentiation has its uses, but determining whether a purported contribution is significant in an inventorship inquiry is not one of them. The Federal Circuit has held multiple times that a contribution to elements in an independent claim or added by a dependent claim are not automatically significant. *See, e.g., Nartron*, 558 F.3d at 1356-57 (finding a contribution that appeared in a dependent claim not significant “because it was in the prior art ... and ... was merely the basic exercise of ordinary skill in the art”); *Sewall v. Walters*, 21 F.3d 411, 416-17 (Fed. Cir. 1994) (same); *Trovan, Ltd. v. Sokymat SA, Irori*, 299 F.3d 1292, 1302 (Fed. Cir. 2002) (same); *see also Hess*, 106 F.3d at 981 (“explaining to the inventors what the then state of the art was and supplying a product to them for use in their invention” was insufficient even where the product appeared in the claims). If the district court were correct that any element appearing in one claim and not another is necessarily significant, the Federal Circuit cases listed above would have all been wrongly decided.

Indeed, in *Nartron*, the *sole* difference between the dependent claim at issue and its independent claim was the inclusion of the extender element that the putative inventor contributed. *Nartron*, 558 F.3d at 1358. The Federal Circuit rejected the argument that this would result in *de facto* significance:

One further point should be made. Borg Indak asserts that Benson was the inventor of the sole feature added by claim 11. However, a dependent claim adding one claim limitation to a parent claim is still a claim to the invention of the parent claim, albeit with the added feature;



it is not a claim to the added feature alone. Even if Benson did suggest the addition of the prior art extender to what Nartron had invented, the invention of claim 11 was not the extender, but included all of the features of claims 1, 5, and 6, from which it depends. It has not yet been determined whether Benson contributed to the invention of claim 1 (although he does not claim to be a co-inventor with respect to claims 5 and 6). If Benson did not make those inventions, he does not necessarily attain the status of co-inventor by providing the sole feature of a dependent claim.

*Id.* In other words, claim differentiation is not a shortcut to proving significance.

Moreover, the district court erred in applying the doctrine of claim differentiation. While the district court focused on the inclusion of infrared preheating in claim 5 and its absence from claim 1, there are *multiple* differences between independent claims 1 and 5, as shown above. Claim 1 provides an upper limit of 210 degrees Fahrenheit on the range in the preheating step, while claim 5 has no upper limit. Claim 1 is limited to bacon, while claim 5 covers “meat”. And claim 1 contains a 375-degree Fahrenheit limitation in its second step that is absent from claim 5. Each of these differences make claim 5 broader, independent from the inclusion of an infrared oven as an option for preheating meat in the first step of claim 5. With several variables changing between claims, the district court’s logic that the optional infrared oven is the change that *had* to be significant to the full invention was tenuous at best. It was incorrect to focus on

one difference, among many, between independent patent claims and conclude that difference alone was significant. *See Indacon, Inc. v. Facebook, Inc.*, 824 F.3d 1352, 1358 (Fed. Cir. 2016) (declining to apply claim differentiation across four independent claims, explaining: “we have declined to apply the doctrine of claim differentiation where, as here, the claims are not otherwise identical in scope”).

Without a shortcut to significance based on claim differentiation, the record contained no evidence through which HIP could prove by clear and convincing evidence that the infrared oven was significant to the full invention in claim 5. While HIP complains this is a structural problem (because patent owners control the writing of patent specifications and can choose what to include or emphasize), there is nothing requiring a challenger to limit its evidence to the patent specification. The challenging party can (and should) attempt to marshal affirmative evidence of significance from outside the patent when trying to carry its high burden of proving significance by clear and convincing evidence. HIP simply failed to do so.

HIP should have recognized that its record was too thin to prevail by clear and convincing evidence using the patent alone. It could have sought evidence of significance from outside the patent, such as with documents touting infrared preheating as a new approach, or expert testimony regarding its importance to Hormel’s two-step method. And indeed, HIP likely did seek that evidence, and found none. Thus, HIP was forced to put all its eggs in the claim differentiation basket. When the Federal Circuit correctly rejected that approach, HIP was left without evidence to meet its burden.

#### IV. HIP'S WARNINGS ABOUT THE POTENTIAL FALLOUT FROM THE FEDERAL CIRCUIT'S DECISION ARE UNFOUNDED

HIP lists a parade of horrors that it predicts will befall the patent field if the Federal Circuit's decision here is allowed to stand, including wholesale challenges to patents on inventorship grounds. Pet. 17-20. HIP asserts that no patent is safe because the panel found that a single reference to a contributed element was not significant to the full invention of a claim containing that element. *See id.*

If that were true, it would have happened after *Nartron* was decided in 2009. The *Nartron* court likewise noted that there was only one reference to the contributed element in the patent-at-issue and no other evidence of significance. 558 F.3d at 1358. There is no evidence that any of the fallout that HIP predicts will happen now happened in the 14 years after *Nartron* was decided.

Just the opposite. The Federal Circuit's joint inventorship jurisprudence has been remarkably stable for the past three decades. *Pannu* has been the test now for 25 years with no vigorous dissent or challenges. And the Federal Circuit has strong institutional knowledge about this specific area of law. Judge Lourie penned not only the decision here, but also the decisions in *Pannu* and *Nartron*. The other two circuit judges on the panel similarly have joint inventorship experience, with Judge Clevenger having authored the opinion in *Fina Oil* that Judge Lourie incorporated into the *Pannu* three-part test and Judge Taranto joining Judge Lourie on the panel for the *General Electric* case cited above. HIP has not pointed to any dissenting opinions calling for changes or

other vigorous debate coming out of the Federal Circuit about joint inventorship law suggesting that it needs an overhaul. Joint inventorship remains a niche issue, not a hot area requiring this Court's intervention.

### CONCLUSION

While HIP warns of impending calamity, none of the negative effects that HIP predicts will occur actually came to pass after 2009 when the Federal Circuit issued a similar decision in *Nartron*. This case is a routine application of a 25-year-old test that HIP itself urged the lower courts to apply. It does not rise to this Court's level and was correctly decided in any case. The petition should be denied.

Respectfully Submitted,

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Dated: September 28, 2023