

No. 26-

IN THE
Supreme Court of the United States

FORTRESS IRON, LP,

Petitioner,

v.

DIGGER SPECIALTIES, INC.,

Respondent.

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

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Whether an agreed, omitted, co-inventor whose patent rights have been entirely assigned to the patent owner but who could not be found to receive notice is a “party concerned” entitled to notice and hearing under 35 U.S.C. § 256(b) preventing their contribution from being recognized even when all parties agree the omitted inventor is a true co-inventor who should be recognized, the omitted inventor’s rights are owned by the patent owner, and the omitted inventor can only be benefited, not harmed, by being recognized.
2. Whether a patent that correctly names at least some true inventors can be held invalid for the omission of one co-inventor after Congress repealed 35 U.S.C. § 102(f) in the America Invents Act, where the Federal Circuit’s invalidity holding relies on the very statutory framework that Congress eliminated and is contrary to the statutory trend of making correction of inventorship easier and invalidity for incorrect inventorship harder to achieve.
3. Whether the Federal Circuit’s interpretation of 35 U.S.C. § 256(b) and 35 U.S.C. § 101 and its holding that inventorship errors render patents permanently invalid when a co-inventor cannot be located undermines the harmonization of United States patent law with international patent standards that Congress intended to advance through the America Invents Act, by making inventorship errors more consequential to patent validity in the United States than under the patent laws of other major jurisdictions.

PARTIES TO THE PROCEEDING

Petitioner Fortress Iron, LP was the plaintiff-appellant in the court below and no stock ticker symbol for Fortress Iron, LP exists.

Petitioner Fortified IPCO, LLC is the successor-in-interest of the underlying patents and currently holds all rights in same, including all rights to sue for past and future damages, pursuant to assignments during the pendency of these proceedings. No stock ticker symbol for Fortified IPCO, LLC exists.

Respondent Digger Specialties, Inc. was the defendant-appellee in the court below and no stock ticker symbol for Digger Specialties, Inc. exists.

There are no other parties to the proceeding.

CORPORATE DISCLOSURE STATEMENT

Petitioner Fortress Iron, LP is a limited partnership. Petitioner Fortified IPCO, LLC is a limited liability company. No parent corporation or publicly held company owns 10% or more of either of the ownership interests of Fortress Iron, LP or Fortified IPCO, LLC.

RELATED CASES

- *Fortress Iron, LP v. Digger Specialties, Inc.*, No. 3:21-CV-14-CCB, U.S. District Court for the Northern District of Indiana. Judgment entered September 9, 2024.
- *Fortress Iron, LP v. Digger Specialties, Inc.*, No. 2024-2313, U.S. Court of Appeals for the Federal Circuit. Judgment entered April 2, 2026.
- *Fortress Iron, LP v. Digger Specialties, Inc.*, No. 3:25-CV-99-DRL-SJF, U.S. District Court for the Northern District of Indiana. Currently pending case involving different patents within the family of the Patents-in-Suit; no judgment entered.

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OPINIONS BELOW

The opinion of the United States Court of Appeals for the Federal Circuit is reported at *Fortress Iron, LP v. Digger Specialties, Inc.*, 171 F.4th 1310 (Fed. Cir. 2026), and is reproduced in the Appendix at Pet. App. 1a-13a.

The opinion of the United States District Court for the Northern District of Indiana is reported at *Fortress Iron L.P. v. Digger Specialties, Inc.*, 748 F. Supp. 3d 614 (N.D. Ind. 2024), and is reproduced in the Appendix at Pet. App. 14a-25a.

The order of the United States Court of Appeals for the Federal Circuit denying the petition for panel rehearing and rehearing *en banc* was entered on June 5, 2026, and is reproduced in the Appendix at Pet. App. 26a-27a.

JURISDICTION

The judgment of the United States Court of Appeals for the Federal Circuit was entered on April 2, 2026. A timely petition for panel rehearing and rehearing *en banc* was denied on June 5, 2026. This petition for a writ of certiorari is timely filed within 90 days of the denial of rehearing. This Court has jurisdiction under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

35 U.S.C. § 256 provides in relevant part:

(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.

35 U.S.C. § 100(f) provides:

The term “inventor” means the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention.

35 U.S.C. § 101 provides:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Pre-AIA 35 U.S.C. § 102(f) (repealed 2013) provided:

A person shall be entitled to a patent unless . . .
he did not himself invent the subject matter
sought to be patented.

STATEMENT OF THE CASE

A. Factual Background

Petitioner Fortress Iron, LP (“Fortress”)¹ designs and sells railing and fencing products used in the construction of outdoor living spaces. Pet. App. 2a.

In March 2013, Fortress’s owner, Matthew Sherstad, conceived an idea for a vertical cable railing that could be purchased as a pre-assembled panel. Fortress employee Kevin Burt sketched an initial design. Sherstad and Burt worked with two Chinese companies to develop the product: manufacturer Yinxin Handicrafts Co., Ltd. (“YX”) and quality control liaison Quan Zhou Yoddex Building Material Co., Ltd. (“YD”). Pet. App. 2a-3a.

During prototyping, the initial design experienced problems with cables rotating during tensioning. YD employees Hua-Ping Huang and Alfonso Lin suggested

1. Petitioner Fortress Iron, LP was the plaintiff-appellant below. During the pendency of these proceedings, the underlying patents and all rights to sue for past and future damages were assigned to affiliate Fortified IPCO, LLC, which is under common executive control with Fortress Iron, LP. Both entities join this petition to ensure continuity and eliminate any procedural ambiguity regarding successor interest. The subject assignments are recorded with the United States Patent and Trademark Office.

changes to address this issue. Specifically, Huang suggested square-shaped openings and square swages to prevent cable rotation during tensioning, and Lin suggested internal rail changes to strengthen the structure. After discussions with co-inventor Kevin Burt, both suggestions, with some modifications, were incorporated into the final design. The final product thus incorporated aspects of Sherstad's original idea, Burt's early designs, and the contributions of both Lin and Huang. Pet. App. 3a.

Fortress filed patent applications for the vertical cable railing panels, which issued as U.S. Patent Nos. 9,790,707 ("the '707 patent") and 10,883,290 ("the '290 patent"). Initially, the patents named only Sherstad and Burt as inventors; they did not include Lin or Huang. Pet. App. 3a.

Relevant to this case, Huang's employment at YD ended in 2016, and he did not provide his contact information to YD or Fortress. Despite diligent efforts, Fortress was unable to locate Huang². Pet. App. 3a, 18a.

Critically, Fortress owns all of Huang's rights in the patents. The district court found that Huang was a YD employee at the time he co-invented the subject matter of the patents. Pet. App. 16a-17a. Under Article 6 of the Patent Law of the People's Republic of China, Huang's inventive contributions constituted a "service invention

2. After the Federal Circuit issued its opinion, Fortress was able to locate Mr. Huang and obtain his signature on the appropriate documents. Fortress has petitioned the U.S. Patent Office to add Mr. Huang as a co-inventor. Fortress expects the Certificate of Correction to issue but it had not issued as of the filing of this petition.

creation” owned by his employer, YD. YD subsequently executed a written assignment, recorded with the Patent Office, transferring all of its rights in the inventions to Fortress. Thus, regardless of whether Huang is named as a co-inventor, Fortress possesses complete ownership of the patents.

B. Proceedings Below

In January 2021, Fortress sued Digger Specialties, Inc. (“Digger”) for infringement of the ’707 and ’290 patents. During the course of the litigation, Digger learned that Lin and Huang contributed to the invention, and Fortress acknowledged that Lin and Huang were co-inventors. Pet. App. 18a.

Fortress located Lin and successfully added him as a co-inventor using the procedure outlined in 35 U.S.C. § 256(a) and Patent Office regulations, which require the application and signatures of “all the parties and assignees.” Pet. App. 3a-4a.

Because Huang could not be located at the time, Fortress could not use the § 256(a) procedure—which requires all parties’ signatures—to add him. Fortress therefore moved for partial summary judgment to correct inventorship under 35 U.S.C. § 256(b), which permits a court to “order correction of the patent on notice and hearing of all parties concerned.” Pet. App. 4a.

The district court denied Fortress’s motion, holding that Huang was a “party concerned”³ who must receive notice and an opportunity to be heard before any correction could be ordered. Because Fortress conceded it could not locate Huang—and thus could not provide the required notice—the district court held that correction was barred. Pet. App. 22a-23a.

The district court then granted Digger’s cross-motion for summary judgment of invalidity, holding that because the patents omitted a co-inventor and could not be corrected under § 256, they were invalid under 35 U.S.C. § 101. Pet. App. 23a-25a.

Notably, the district court acknowledged: “*It is undisputed that Mr. Huang should be a named inventor on the Patents.*” Pet. App. 24a. Yet the patents were held invalid because the very person everyone agrees should be named could not be found.

C. The Federal Circuit’s Opinion

The Federal Circuit affirmed both holdings. Pet. App. 1a-13a. The court acknowledged this was a “case of first impression.” Pet. App. 6a n.3 (*see* Oral Arg. at 2:56-3:06 (Fortress’s counsel agreeing this is a “case of first impression”); *id.* at 15:30-50 (Digger’s counsel agreeing “there is no case on point” for these facts)).

3. Petitioner notes that the statutory phrase is “all parties concerned.” The use of “party concerned” with respect to Mr. Huang reflects that there was only one party whose lack of notice was considered dispositive by the District Court and the Court of Appeals for the Federal Circuit.

On the § 256(b) notice issue, the Federal Circuit held that Huang is a “party concerned” based on *Chou v. University of Chicago*, 254 F.3d 1347, 1357 (Fed. Cir. 2001), reasoning that “[i]nventors occupy the central role in the patent process” and that “Huang, similarly, as an agreed-upon omitted coinventor, is thus a ‘party concerned’ such that he must be given notice and opportunity for hearing prior to any correction of inventorship under § 256(b).” Pet. App. 7a.

The court rejected Fortress’s argument that “party concerned” should be interpreted through a due process lens to mean only those with an economic or reputational interest that may be adversely affected, stating that such a reading “would be to rewrite the language of the statute.” Pet. App. 8a.

On invalidity, the Federal Circuit held that “a patent which incorrectly lists its inventor(s) and cannot be corrected according to law is invalid,” reasoning from the negative implication of § 256(b): if the error “shall not invalidate the patent . . . if it can be corrected,” then it does invalidate when it cannot be corrected. Pet. App. 11a-13a.

The court rejected Fortress’s argument that the repeal of § 102(f) eliminated invalidity for incorrect inventorship so long as at least one correct inventor is named, holding that § 102(f) “simply stated that non-inventors are not entitled to a patent, not that actual inventors need not be named on a patent.” Pet. App. 12a. The court found that §§ 101, 100(f), and 256(b) independently require that all inventors be listed. Pet. App. 12a.

REASONS FOR GRANTING THE WRIT

I. THE FEDERAL CIRCUIT’S INTERPRETATION OF “PARTY CONCERNED” CONFLICTS WITH THE PURPOSES OF § 256 AND PRODUCES AN ABSURD RESULT.

The Federal Circuit’s holding that every inventor—omitted or recognized and regardless of economic interest, property rights, or the practical consequences of correction—is a “party concerned” under § 256(b) conflicts with the purpose of the notice-and-hearing requirement. Although the focus of this case was an omitted co-inventor, the Federal Circuit’s holding is not limited to omitted inventors but applies to all inventors regardless of whether they have assigned all their rights and their inventorship status is not questioned. The holding thus produces an absurd result Congress could not have intended, and warrants this Court’s review.

A. The Notice-and-Hearing Requirement Serves Due Process and Should Be Construed Accordingly.

The “notice and hearing” requirement of § 256(b) exists to protect the due process rights of those whose interests may be adversely affected by a change in inventorship. This Court has long recognized that “[a]n elementary and fundamental requirement of due process in any proceeding which is to be accorded finality is notice reasonably calculated, under all the circumstances, to apprise interested parties of the pendency of the action and afford them an opportunity to present their objections.” *Mullane v. Central Hanover Bank & Trust Co.*, 339 U.S. 306, 314 (1950).

The purpose of notice is to protect parties who might be harmed. Here, Huang cannot possibly be harmed by being named as a co-inventor on the patents. To the contrary, naming an inventor on a patent is “a mark of success in one’s field”—a benefit, not a burden. *Chou*, 254 F.3d at 1359. Huang owns no rights in the patents; all rights flowed to his former employer YD under Chinese law and then to Fortress by assignment. His legal and economic position is identical whether or not he is named. The Federal Circuit holding has the ironic effect of harming Mr. Huang by preventing his formal recognition as a co-inventor.

The Federal Circuit nonetheless held that Huang is a “party concerned” simply because he is an inventor, regardless of whether his interests could be affected. This mechanical reading divorces the notice requirement from its constitutional foundation and transforms a procedural protection into a substantive bar to relief.

B. The Decision Creates an Internal Contradiction in Federal Circuit Law.

The Federal Circuit’s holding is irreconcilable with its own precedent in *Larson v. Correct Craft, Inc.*, 569 F.3d 1319 (Fed. Cir. 2009). In *Larson*, the court held that an inventor who has assigned all rights in a patent lacks constitutional standing to bring a § 256(b) action to be named as an inventor. *Id.* at 1326-27. The court reasoned that because the inventor had assigned all economic rights, he could not demonstrate the “injury in fact” required for Article III standing.

The logical consequence of *Larson* is inescapable: if an inventor who has assigned all rights cannot invoke § 256(b) because he has no cognizable interest, then he is not a “party concerned” whose notice is a prerequisite to others invoking that same provision. An individual who lacks standing to participate cannot simultaneously be indispensable to the proceeding.

The Federal Circuit attempted to distinguish standing from “party concerned” status by citing *Chou*’s statement that these are “distinct issues.” Pet. App. 9a. But *Chou* addressed a materially different situation: the inventor in *Chou* affirmatively sought to participate in the § 256(b) proceeding and to be named as an inventor—she was not, as here, an absent party whose rights were owned entirely by another.

Moreover, in *Shukh v. Seagate Technology, LLC*, 803 F.3d 659 (Fed. Cir. 2015), the Federal Circuit held that an inventor could demonstrate standing to seek correction of inventorship based on reputational harm—the very interest that *Chou* recognized as a benefit of being named. If that reputational interest establishes standing when an inventor *seeks* correction, then the absence of any adversely affected interest negates “party concerned” status when the correction would *benefit* the inventor.

C. The Decision Produces an Absurd Result Congress Could Not Have Intended.

The practical consequence of the Federal Circuit’s decision is extraordinary: patents are permanently invalid when an agreed co-inventor cannot be located, regardless

of whether the patent owner possesses all rights and regardless of whether the correction would harm anyone.

Consider the facts of this case. It is undisputed that Huang is a co-inventor. It is undisputed that Fortress owns all of Huang's rights. It is undisputed that correcting inventorship would benefit Huang (by giving him credit) and harm no one. Yet the patents are invalid because Fortress could not find Huang at the time to tell him the good news.

This result is not merely harsh—it is irrational. The Federal Circuit's holding means that the very provision Congress designed to save patents from invalidity (§ 256) instead becomes the mechanism of their destruction. Section 256 was enacted as a “savings provision” to prevent the loss of valuable patent rights due to honest inventorship errors. *Pannu*, 155 F.3d at 1350. Under the decision below, § 256 now operates as a trap: if a co-inventor departs without leaving contact information, the patent is irremediably invalid—not because of any substantive deficiency in the invention or the patent's disclosure, but because of an administrative impossibility.

Furthermore, the decision actually *harms* Huang. By preventing correction, the court stripped Huang of the opportunity to be named as a co-inventor on valid patents—the very right it purported to protect. The panel's solicitude for Huang's “rights” produced a result in which Huang loses the credit he deserves, the patent owner loses its patents, and the only beneficiary is the accused infringer—a party with no interest in the integrity of inventorship whatsoever.

D. The Decision Cannot Be Reconciled with Congress's Treatment of Unlocatable Inventors Elsewhere in the Patent Act.

Congress has already addressed the problem of an inventor who cannot be located. Under 35 U.S.C. § 115(d), when an inventor is unavailable or refuses to execute a patent application, a substitute statement may be filed. Fortress successfully used this procedure to name Huang as a co-inventor on a continuation application, which issued as U.S. Patent No. 11,643,838.

It defies logic that Congress would permit a patent to issue without an inventor's signature or participation under § 115(d), yet simultaneously require that same inventor's participation to correct an already-issued patent under § 256(b). The Federal Circuit's interpretation creates an irrational asymmetry: the same inventor who need not be located to obtain a patent must be located to save one.

II. THE INVALIDITY HOLDING RELIES ON A REPEALED STATUTE AND CONFLICTS WITH THE AMERICA INVENTS ACT.

The Federal Circuit's holding—that the patents are invalid because they do not name all inventors—independently warrants this Court's review because it effectively resurrects a statutory provision that Congress deliberately repealed and undermines the move to harmonize U.S. patent law with the rest of the world.

A. Congress Repealed § 102(f), the Historical Basis for Inventorship-Based Invalidity.

Before the America Invents Act (“AIA”), 35 U.S.C. § 102(f) provided that “[a] person shall be entitled to a patent unless . . . he did not himself invent the subject matter sought to be patented.” This provision was the primary statutory basis for invalidating patents based on incorrect inventorship. *See Pannu*, 155 F.3d at 1349 (collecting cases relying on § 102(f)).

In 2011, Congress enacted the AIA and repealed § 102(f) as part of the transition from the first-to-invent system to the first-inventor-to-file system. Pub. L. No. 112-29, § 3(b)(1), 125 Stat. 284, 285-86 (2011). The repeal of § 102(f) was deliberate and reflected Congress’s policy judgment that the patent system should not turn on who conceived first, but on who filed first.

Simultaneously, Congress amended § 256 to remove the requirement that inventorship errors be made “without any deceptive intention on the part of the person omitted.” This amendment further reflected Congress’s intent to make correction of inventorship easier—not harder—in the post-AIA world.

B. The Federal Circuit Effectively Resurrected § 102(f) Under a Different Name.

The Federal Circuit held that §§ 101, 100(f), and 256(b) together “contemplate that when an invention has multiple inventors, they must all be listed on the patent.” Pet. App. 12a. From this, the court concluded that a patent failing to list all inventors is invalid—the identical rule that formerly derived from § 102(f).

But this reasoning proves too much. Section 101 uses permissive language: “Whoever invents or discovers . . . may obtain a patent therefor.” The word “may” is enabling, not restrictive. Section 100(f) merely defines the term “inventor.” Neither provision states that a patent is invalid if it fails to name all co-inventors.

The Federal Circuit’s reliance on the negative implication of § 256(b)—that if inventorship errors “shall not invalidate” when correctable, they *do* invalidate when not correctable—ignores that § 256 is a savings provision. Its purpose is to *save* patents, not to create an independent ground of invalidity. Reading § 256(b) as *both* the shield against invalidity *and* the sword that creates it produces a circular absurdity: a patent is invalid because it cannot be corrected, and it cannot be corrected because a procedural prerequisite is impossible to satisfy.

C. The Decision Conflicts with the AIA’s Policy Direction.

The AIA’s legislative history confirms that Congress intended to make inventorship less consequential to patent validity, not more. By repealing § 102(f) and removing the “deceptive intention” requirement from § 256, Congress signaled that inventorship errors should be correctable administrative matters rather than grounds for destroying patent rights.

The Federal Circuit acknowledged this legislative trend but dismissed it, stating that the repeal of § 102(f) “did not eliminate invalidity due to incorrect listing of inventors.” Pet. App. 12a. Yet the court identified no post-AIA statutory basis for that invalidity other than

the very provisions (§§ 101, 100(f), 256(b)) that existed before § 102(f) was enacted—provisions that Congress never previously understood to mandate invalidity for imperfect inventorship.

This Court’s intervention is needed to determine whether Congress’s repeal of § 102(f) has any operative significance, or whether the Federal Circuit has rendered that repeal a nullity by recreating the same invalidity rule from other, previously existing and unamended, statutory provisions.

III. THE QUESTION IS OF EXCEPTIONAL NATIONAL IMPORTANCE.

The questions presented are of exceptional importance to the patent system. The Federal Circuit’s decision establishes a rule that will affect every patent owner whose co-inventor cannot be located—a situation that arises with increasing frequency in our globalized economy, where inventions are developed collaboratively across borders and personnel turnover is common.

The problem is particularly acute in industries where inventions involve contributions from foreign nationals. As this case illustrates, employees of foreign companies may contribute to inventions and then become unreachable when they change employment. Under the Federal Circuit’s rule, any patent with such a contributor faces permanent invalidity—not because of fraud, not because of a substantive defect, but because of the administrative impossibility of locating a person who has moved on even though the party that owns their rights wants to recognize their contribution. This result undermines the intent to be more consistent, not less, with international norms.

The rule also creates perverse incentives. Patent challengers now have a powerful weapon: if they can identify any uncredited contributor who cannot be located, the patent is invalid *per se*. This incentivizes accused infringers to search for obscure contributors and then argue that the patent owner's inability to locate those contributors renders the patent void—regardless of who owns the rights.

Moreover, the decision creates uncertainty regarding the thousands of patents that have issued under § 115(d) substitute-statement procedures—where inventors were unavailable at the time of filing. If those same patents later face an inventorship challenge, the Federal Circuit's rule would render them vulnerable to invalidity on the ground that the missing inventor cannot receive § 256(b) notice.

The decision also undermines the international harmonization objectives that Congress sought to advance through the AIA. A central purpose of the AIA was to bring the United States patent system into closer alignment with the patent systems of other major jurisdictions. By transitioning to a first-inventor-to-file system and repealing § 102(f), Congress signaled that the identity of all inventors should be less consequential to patent validity. The Federal Circuit's rule moves in the opposite direction, making the United States an outlier among major patent systems by treating the inability to locate a single co-inventor as an automatic ground for patent invalidity—a consequence that does not follow under the European Patent Convention, the Patent Cooperation Treaty framework, or the patent laws of most other industrialized nations. This divergence undermines the predictability and uniformity that international

harmonization was designed to achieve and disadvantages U.S. patent holders who develop inventions through multinational collaboration.

These consequences are not hypothetical. They flow directly from a rule that treats inventorship correction as impossible whenever an agreed co-inventor cannot be found, regardless of who owns the patent rights. Only this Court can resolve whether Congress intended § 256 to function as a trap rather than a remedy.

IV. THIS CASE IS AN IDEAL VEHICLE.

This case presents the questions in their starkest form. There is no dispute about the underlying facts: Huang is a co-inventor; Fortress owns all rights; Huang cannot be located. The Federal Circuit itself acknowledged this was a “case of first impression.” Pet. App. 6a n.3. The legal questions are purely legal—no factual disputes cloud the issues.

The case also presents these questions together in a way that reveals their connection. The Federal Circuit’s notice holding and its invalidity holding are two sides of the same coin: together, they establish that an unlocatable inventor must receive notice, and a patent that cannot be corrected is invalid. The result is automatic invalidity whenever a co-inventor disappears—a rule that affects real patent owners with real economic consequences.

Furthermore, because the Federal Circuit has exclusive appellate jurisdiction over patent cases, 28 U.S.C. § 1295(a)(1), there is no possibility that a circuit split will develop to bring this issue to the Court’s attention

through the ordinary channels. If this Court does not grant review, the Federal Circuit's rule will stand as the final word on these important questions of statutory interpretation.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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**APPENDIX A — OPINION OF THE
UNITED STATES COURT OF APPEALS FOR THE
FEDERAL CIRCUIT, FILED APRIL 2, 2026**

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2024-2313

FORTRESS IRON, LP,

Plaintiff-Appellant,

v.

DIGGER SPECIALTIES, INC.,

Defendant-Appellee.

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

Decided April 2, 2026

Before LOURIE and HUGHES, *Circuit Judges*,
and KLEE¹, *Chief District Judge*.

1. Honorable Thomas S. Kleeh, Chief United States District
Judge, United States District Court for the Northern District of
West Virginia, sitting by designation.

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LOURIE, *Circuit Judge*.

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

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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, 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. at 618. Fortress located Lin and successfully added him as a coinventor to the patents following the procedure outlined

2. J.A. refers to the Joint Appendix filed at ECF 18.

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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. 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

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

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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

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 . . . 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:

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(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.

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

3. See Oral Arg. at 2:56-3:06, *available at* cafc.uscourts.gov/oral-arguments/24-2313_02062026.mp3 (Fortress’s counsel agreeing

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whether Huang—an agreed-upon omitted coinventor—is a “party concerned” under § 256(b).

II

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.

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

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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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 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.

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

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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.

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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 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

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.

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

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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.

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

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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 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

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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

**APPENDIX B — ORDER OF THE UNITED STATES
DISTRICT COURT FOR THE NORTHERN DISTRICT
OF INDIANA, SOUTH BEND DIVISION,
FILED SEPTEMBER 9, 2024**

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF INDIANA
SOUTH BEND DIVISION

Case No. 3:21-CV-14-CCB

FORTRESS IRON L.P.,

Plaintiff,

v.

DIGGER SPECIALTIES, INC.,

Defendant.

ORDER

Fortress Iron, L.P. sued Digger Specialties, Inc. for allegedly infringing two of its patents — U.S. Patent No. 9,790,707 (“707 Patent”) and U.S. Patent No. 10,883,290 (“290 Patent”), (collectively, the “Patents”). [DE 75.] During litigation, Digger identified individuals who were not named as inventors on the Patents even though their ideas were incorporated into the final design. [DE 111, pg. 5.] Fortress realized that two people who worked for Fortress’s Chinese representative should have been named as inventors of the Patents — Afonso Lin and Hua-Ping Huang. *Id.* Because Fortress has been unable to contact Mr. Huang, it seeks an order from this Court that requires the Director of the United States Patent and

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Trademark Office to issue a certificate of correction that names Mr. Huang as an inventor on the Patents. [DE 110.] Fortress moved for partial summary judgment to correct the Patents by adding Mr. Huang under the procedures outlined in 35 U.S.C. § 256(b). *Id.* Digger filed a brief in opposition to Fortress’s motion for partial summary judgment and filed a cross-motion for summary judgment. [DE 121, DE 119.] Digger argues Fortress cannot correct inventorship because it cannot give notice to Mr. Huang under 35 U.S.C. § 256(b). *Id.* Digger contends that the Patents are invalid since Fortress cannot correct them to reflect accurate inventorship, and therefore this Court should grant summary judgment in its favor. *Id.*

FACTUAL BACKGROUND

Fortress designs and sells railing and fencing products. [DE 117, ¶ 1.] Fortress works with Quan Zhou Yoddex Building Material Co., Ltd. of Longqiao Industrial Park, Anxi, Quanzhou, Fujian, China (“YD”) to manage quality control at factories that Fortress collaborates with in China. [DE 117, ¶ 4.] YD makes sure that the factories can meet Fortress’s standards. *Id.* ¶ 5. When Fortress works with a Chinese company to manufacture its products, YD provides employees to monitor quality control and to manage communications. *Id.* ¶ 6. One of the factories that YD works with on behalf of Fortress is Yinxin Handicrafts Co., Ltd., of Anxi Quanzhou, Longmei Industrial Zone, Guanqiao Anxi, Fujian 362441, China (“YX”). *Id.* at ¶ 7.

In March of 2013, Fortress’s owner, Matthew Sherstad, had an idea for a vertical cable railing that could

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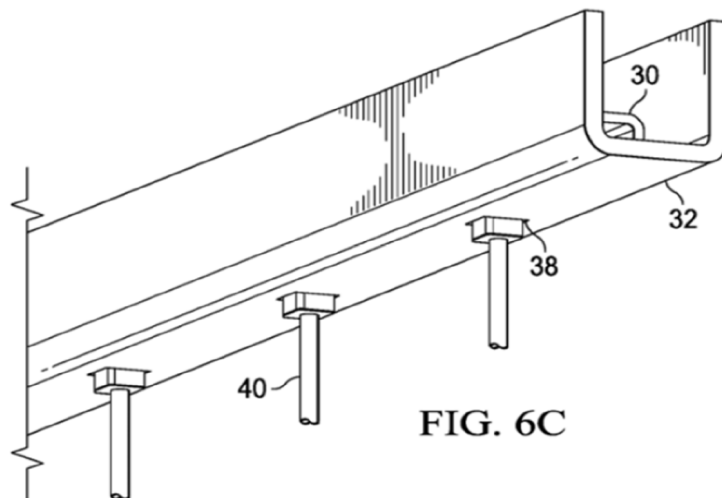
be purchased as a pre-assembled panel, making it easier to install compared to products that must be assembled on site. [DE 117, ¶ 8.] Kevin Burt, a Fortress employee, sketched the initial design in a notebook. *Id.* ¶ 10. Burt's initial design used cables with a ball swage and round swage connections to anchor the inner cables. *Id.* ¶ 12. YD oversaw the production of prototypes manufactured by YX based on this initial design. *Id.* In June of 2013, Mr. Burt, and a representative from YD discussed issues with the prototype. *Id.* ¶13. Mr. Burt expressed the need to find a way to prevent the cables from rotating during tensioning. *Id.* ¶15-16. Mr. Burt's initial design did not prevent the cable from rotating during the tensioning process:



[DE 111, pg. 16.] At this time, Mr. Huang was a YD employee who was involved with the development of Fortress's prototype. [DE 117, ¶17.] He suggested that the invention use square-shaped openings and square

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swages to address the cable-rotation issue. *Id.* ¶18. These suggestions were incorporated into the final design. *Id.* ¶20. Another YD employee, Alfonso Lin, made suggestions to strengthen the structure, that were also incorporated in the final design. *Id.* ¶¶21-22. In the end, “[t]he final design was based on Mr. Sherstad’s original idea, implemented by Mr. Burt’s early designs, and also incorporating the suggestions from Mr. Lin and Mr. Huang to the final design of the rails and cables.” *Id.* ¶ 24. Soon after the design of the vertical cable rail panel was completed, Fortress filed for and received patent protection for its invention. *Id.* ¶ 25. The initial patents named Mr. Sherstad and Mr. Burt as inventors but did not include Mr. Lin or Mr. Huang. *Id.* ¶¶ 25-27. Mr. Huang’s contribution — the use of square shaped openings and square shaped swages — was included in the invention:



[DE 111, pg. 8-9]

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During the course of this lawsuit, Digger identified Mr. Lin and Mr. Huang's contributions to the invention and Fortress acknowledged that it inadvertently failed to name Mr. Lin and Mr. Huang as inventors. [DE 111, pg. 10; DE 117, ¶44.] On February 17, 2023, YD assigned all of its ownership rights to the Patents to Fortress. [DE 117, ¶ 33.] On March 2, 2023, Fortress filed petitions under 35 U.S.C. § 256(a) to have the U.S. Patent Office name Mr. Lin as a joint inventor of the Patents. *Id.* ¶ 35.

Mr. Huang's employment at YD ended in 2016 and he did not provide any way to contact him. *Id.* ¶ 32. YD has been unable to locate Mr. Huang on Fortress's behalf. *Id.* Fortress acknowledges that it cannot add Mr. Huang to the Patents under 35 U.S.C. § 256(a) so "Fortress requests an order from this Court pursuant to 35 U.S.C. § 256(b) instructing the USPTO Director to correct the inventorship of the '707 and '290 patents and add Hua-Ping Huang as a joint inventor." [DE 111, pg. 11.]

LEGAL STANDARD

Summary judgment is appropriate when "the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(a). A genuine issue of material fact exists when "the evidence is such that a reasonable jury could return a verdict for the nonmoving party." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986). To determine whether a genuine dispute of material fact exists, the court must review the record, construing all facts in the light most favorable to the nonmoving party and drawing all reasonable

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inferences in that party's favor. *Heft v. Moore*, 351 F.3d 278, 282 (7th Cir. 2003).

ANALYSIS

Failure to name all true inventors to a patent will invalidate the patent. *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1350 (Fed. Cir. 1998). “Accordingly, if nonjoinder of an actual inventor is proved by clear and convincing evidence, a patent is rendered invalid.” *Id.* at 1349. But a patent will not be invalid if it can be redeemed under the “savings provision” in 35 U.S.C. § 256, which is designed to prevent patent invalidation because of failure to list all true inventors. *Id.* at 1350. “If a patentee demonstrates that inventorship can be corrected as provided for in section 256, a district court must order correction of the patent, thus saving it from being rendered invalid.” *Id.*

Under 35 U.S.C. § 256, there are two ways to add an omitted inventor to an issued patent:

- (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

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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.

Under § 256(a), “all parties and assignees” may seek correction of inventorship by applying to the Director of the Patent Office. Fortress concedes that it cannot correct inventorship under § 256(a) because “the patent office rules implementing 35 U.S.C. § 256(a) cannot be used to add an inadvertently omitted joint inventor to an issued patent without obtaining that inventor’s signature.” [DE 111, pg. 11.] As such, Fortress moved for summary judgment seeking relief under § 256(b). This provision outlines a process in which a court, “on notice and hearing of all parties concerned” can order the Director of the Patent Office to issue a certificate that corrects the inventorship error. 35 U.S.C. § 256(b). A successful action under Section 256 requires clear evidence of inventorship. *Bd. of Educ. ex rel. Bd. of Trs. of Fla. State Univ. v. Am. Bioscience, Inc.*, 333 F.3d 1330, 1337 (Fed. Cir. 2003). To be considered an inventor, “a joint inventor must contribute to the invention’s conception.” *CODA Dev. S.R.O. v. Goodyear Tire & Rubber Co.*, 916 F.3d 1350, 1358-59 (Fed. Cir. 2019) (citing *Eli Lilly & Co. v. Aradigm Corp.*, 376 F.3d 1352, 1358-59 (Fed. Cir. 2004)).

In support of its motion for summary judgment, Fortress presented evidence that Mr. Huang played a key role in developing the invention. The initial design

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did not prevent the internal cables from rotating during tensioning. [DE 117, ¶ 16.] Mr. Huang suggested that they use a square swage to prevent rotation during tensioning. [DE 117, ¶ 20.] The final design incorporated Mr. Huang's suggestions along with Mr. Sherstad's and Mr. Burt's early designs. [DE 117, ¶ 24.] Fortress acknowledges that Mr. Huang made a "not insignificant contribution to the claimed invention" and that "Mr. Huang is a joint inventor of the subject matter of the '707 and '290 patents." [DE 111, pg. 17.] Both parties agree that Mr. Huang is an inventor, and the record supports this conclusion. However, the parties disagree on whether this Court can grant Fortress's requested relief given that Mr. Huang does not have notice of these proceedings.

I. Fortress is not entitled to summary judgment because it did not provide notice to Mr. Huang under 35 U.S.C. § 256(b).

Fortress cannot correct inventorship under § 256(b) because it has not given Mr. Huang notice of these proceedings. A court can correct inventorship under § 256(b) only upon "notice and hearing of all parties concerned." 35 U.S.C. § 256(b). Courts have construed "parties concerned" to include "named inventors, omitted inventors, and assignees." *Harish v. Rubinstein*, 602 F.Supp. 3d 696, 701 (D.N.J. 2022)(citation omitted). Indeed, the only prerequisite to judicial action under § 256(b), is that all parties must be given notice and an opportunity to be heard. *Stark v. Advanced Magnetics, Inc.*, 119 F.3d 1551, 1553 (Fed. Cir. 1997). This is true even if the omitted inventors are not parties to the litigation. *FFOC Co. v. Invent A.G.*, 882 F. Supp. 642, 650 (E.D.

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Mich. 1994). Fortress concedes that it has been unable to locate Mr. Huang. [DE 111, pg. 14-15.] Mr. Huang left YD in 2016 and did not provide any contact information. [DE 117, ¶ 32.] Fortress states that “[a]fter Mr. Huang left YD’s employment in 2016, he did not provide the address where he was going and YD’s employment records do not allow him to be located. Therefore, when requested by Fortress to locate Mr. Huang, YD was unable to do so.” *Id.* These facts pose an obstacle to Fortress’s motion for summary judgment.

Fortress argues that Mr. Huang is not a concerned party because he has no ownership interests in the Patents. [DE 111, pg. 20-22.] Fortress contends that Mr. Huang has no ownership interest because under Chinese law, any ownership he would have in the Patents belongs to his former employer — YD. *Id.* But even if Mr. Huang has no ownership interest in the Patents, he is still among the “parties concerned” who must receive notice of these proceedings before the Court can act because he is an omitted inventor. 35 U.S.C. § 256(b); *Harish v. Rubinstein*, 602 F.Supp. 3d 696, 701 (D.N.J. 2022). Fortress relies on *Larson v. Correct Craft, Inc.*, 569 F.3d 1319 (Fed. Cir. 2009) to support its argument that it need not provide notice. [DE 111, pg. 22; DE 118, pg. 17.] However, *Larson* does not address who must receive notice as a concerned party but addresses who has Article III standing to pursue a claim under § 256. *Larson*, 569 F.3d at 1327.

Fortress’s request for relief undermines its argument that Mr. Huang is not a concerned party. The procedures in § 256(b) allow parties to correct patents that would otherwise be invalid for “omitting inventors or naming

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persons who are not inventors.” 35 U.S.C. § 256. Fortress asks the Court to use its authority under §256(b), to order the director of the Patent Office to issue a certificate naming Mr. Huang as an inventor. [DE 111, pg. 24.] As it stands, Mr. Huang is an inventor — a fact agreed upon by both parties — yet he has been omitted from the Patents. If this Court grants Fortress’s request for relief, Mr. Huang would be officially recognized as an inventor. This outcome directly impacts Mr. Huang’s status, which leads the Court to conclude that he is among the “parties concerned” described in § 256(b) and must receive notice before this Court can act. Because Mr. Huang has no notice of these proceedings, Fortress’s motion for summary judgment must be denied.

II. Digger is entitled to summary judgment because it is undisputed that Fortress cannot correct the Patents under 35 U.S.C. § 256.

A patent is invalid if less than all of the true inventors are named in the patent. *Jamesbury Corp. v. United States*, 207 Ct.Cl. 516, 536, 518 F.2d 1384 (Ct.Cl.1975). Fortress maintains that when Congress enacted the America Invents Act, it removed the invalidity defense for incorrect inventorship when it removed § 102(f). [DE 118, pg. 25-27.] To challenge inventorship, “[h]istorically a party could assert a patent’s invalidity under § 102(f) due to the failure to identify a co-inventor in the patent.” *Bd. of Tr. of Univ. of Ill. v. Micron Tech., Inc.*, 245 F. Supp. 3d 1036, 1041 n.1 (C.D. Ill. 2017). Even though § 102(f) has been eliminated “the defense is presumably still available under § 101, which allows patents to only be provided to [w]hoever invents or discovers any new and

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useful process, machine, manufacture, or composition of matter...” *Id.* See also *Cubist Pharms., Inc. v. Hospira, Inc.*, 75 F. Supp. 3d 641, 673 n. 14 (D. Del. 2014) (stating that after the AIA “proper inventorship remains a requirement of patentability through § 101.”) There is no authority before this Court saying that this defense was abrogated through passage of the America Invents Act.

It is undisputed that Mr. Huang should be a named inventor on the Patents. Fortress provided factual support for this conclusion in support of its motion for summary judgment. [DE 117.] Further, Fortress acknowledges that it cannot proceed under § 256(a) because of Mr. Huang’s unavailability:

Fortress asked YD to locate Mr. Huang but it has no ability to do so. Mr. Huang left YD in 2016 and YD has no information which would allow him to be contacted. SOF 32. Thus, Fortress’s efforts to locate Mr. Huang have been unsuccessful. SOF 32. If Mr. Huang could be located, Fortress would have obtained his written consent and filed a petition directly with the USPTO to correct the listing of inventors on the Patents-in-Suit under 35 U.S.C. § 256(a). Mr. Huang’s unavailability necessitated Fortress moving for correction by the Court.

[DE 111, pg. 14-15.] Digger argues that since Mr. Huang is unreachable to proceed under § 256(a), he is also unable to receive notice under § 256(b). [DE 121, pg. 11-13.] Fortress presented no facts showing that it can provide notice to Mr. Huang under § 256(b). As a result, this Court concludes

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that the notice requirement cannot be satisfied, so the error of omitting Mr. Huang from the Patents cannot be corrected, rendering the Patents invalid.

CONCLUSION

Defendant Digger Specialties, Inc.'s Cross-motion for Summary Judgment [DE 119] is GRANTED. Plaintiff Fortress Iron, L.P.'s Motion for Partial Summary Judgment to Correct Inventorship [DE 110] is DENIED. Further, the following motions are DENIED as MOOT: Plaintiff's Motion for Partial Summary Judgment of No Invalidity of the Asserted Claims Under 35 U.S.C. § 103 and No Invalidity of Claim 1 of U.S. Patent No. 10,883,290 Under 35 U.S.C. § 102 [DE 102]; Plaintiff's No Evidence Motion for Partial Summary Judgment of No Invalidity Under 35 U.S.C. § 112 [DE 105]; Defendant Digger Specialties, Inc.'s Motion for Summary Judgment of Non-Infringement [DE 107]; Plaintiff's Motion to Exclude Certain Noninfringement Opinions of Glenn Akhavein [DE 137]; Plaintiff's Motion to Exclude Claim Construction Opinions of Glenn Akhavein [DE 138]; and Plaintiff's Motion Under Rule 53 For Appointment of a Special Master [DE 158].

SO ORDERED.
September 9, 2024

/s/ Cristal C. Brisco
CRISTAL C. BRISCO, JUDGE
UNITED STATES DISTRICT COURT

**APPENDIX C — DENIAL OF REHEARING AND
REHEARING EN BANC OF THE UNITED STATES
COURT OF APPEALS FOR THE FEDERAL
CIRCUIT, FILED JUNE 5, 2026**

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2024-2313

FORTRESS IRON, LP,

Plaintiff-Appellant,

v.

DIGGER SPECIALTIES, INC.,

Defendant-Appellee.

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

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

Before MOORE, *Chief Judge*, LOURIE, DYK, PROST, REYNA,
TARANTO, CHEN, HUGHES, STOLL, CUNNINGHAM, STARK,
Circuit Judges,¹ and KLEECH, *Chief District Judge*.²

1. Circuit Judge Newman did not participate.

2. Honorable Thomas S. Kleeh, Chief United States District
Judge, United States District Court for the Northern District of
Western Virginia, sitting by designation, participated only in the
decision on the petition for panel rehearing.

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PER CURIAM.

ORDER

Fortress Iron, LP filed a combined petition for panel rehearing and rehearing en banc. The petition was referred to the panel that heard the appeal, and thereafter the petition was referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

June 5, 2026

Date

FOR THE COURT

/s/ Jarrett B. Perlow

Jarrett B. Perlow

Clerk of Court

**APPENDIX D — CONSTITUTIONAL AND
STATUTORY PROVISIONS AT ISSUE**

Constitutional provision:

Article 1, section 8: Congress shall have the power

Clause 8

- To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;

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Appendix D

35 U.S.C. § 100(f)

The term “inventor” means the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention.

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35 U.S.C. § 101

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Appendix D

35 U.S.C. § 102(f), repealed

A person shall be entitled to a patent unless -

(f) he did not himself invent the subject matter sought to be patented.

*Appendix D***35 U.S.C. § 256(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.