No. 26-362

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

REPLY BRIEF FOR PETITIONER

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RULE 29.6 STATEMENT

The corporate disclosure statement in the petition for a writ of certiorari remains accurate.

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INTRODUCTION

The Brief in Opposition of Digger (or DSI) does not dispute what matters most. It does not dispute that Hua-Ping Huang is a true co-inventor of the patents-in-suit.[1] It does not dispute the district court's acknowledgment that "[i]t is undisputed that Mr. Huang should be a named inventor on the Patents." Pet. App. 24a. It does not dispute that the Federal Circuit decided a "case of first impression," Pet. App. 6a n.3, or that the Federal Circuit's exclusive jurisdiction means no circuit split can ever develop. And it does not dispute the result: the only beneficiary of the decision below is an accused infringer with no inventive or ownership stake in the patents, while all the agreed inventors lose out.

Digger instead offers three responses, and each one strengthens the case for review. First, Digger maintains that perfect inventorship is "fixed in the Constitution." Opp. Br. 14. It is not, and that position cannot be squared with the first-inventor-to-file system Congress adopted in the America Invents Act ("AIA"). It also conflicts with copyright decisions based on the same Constitutional grant, which do not invalidate copyright registrations if all contributors are not identified. Second, Digger treats the "notice and hearing of all parties concerned" clause of 35 U.S.C. §256(b), which uses classic procedural due process terms, as divorced from due process principles. Due process protects persons from unfairly being deprived of "life,

1. On October 27, 2026, the U.S. Patent and Trademark Office issued Certificates of Correction adding Huang as a co-inventor to the patents-in-suit. Because the invalidity judgment of the district court has not yet been vacated, this petition is not moot.

liberty, or property" and does not require notice to a person without an interest in the outcome of the action. Third, Digger tries to manufacture a vehicle problem by casting doubt on Huang's employment without any record basis. The district court found that Huang was a YD employee, Pet. App. 16a, and the Federal Circuit described him the same way, Pet. App. 3a. With the assignment from YD to Fortress, the chain of title puts Huang's rights, if any, in Fortress's hands. Speculation, without evidence, does not create a vehicle problem. The petition should be granted.

ARGUMENT

I. The Constitution Does Not Make Perfect Inventorship a Condition of Patent Validity, and Holding Otherwise Would Call the AIA Into Question.

Digger argues that perfect inventorship is required by the Constitution. It is not. Digger argues that the Intellectual Property Clause "attaches exclusivity rights to inventors—not owners, employers, or assignees," and that "[t]he principle that a valid patent must name all true inventors is cemented within . . . the U.S. Constitution." Opp. Br. 14, 16. Only this Court can definitively answer the Constitutional question raised here.

A. The Intellectual Property Clause grants flexible power to Congress; it does not invalidate the America Invents Act that implemented a "first-inventor-to-file" patent system.

The Clause authorizes Congress "[t]o 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." U.S. Const. art. I, § 8, cl. 8. This Clause applies equally

to patents and copyrights. *See Impression Prods., Inc. v. Lexmark Int'l, Inc.*, 581 U.S. 360, 378–79 (2017) ("And differentiating the patent exhaustion and copyright first sale doctrines would make little theoretical or practical sense. . . . There is a historic kinship between patent law and copyright law, and the bond between the two leaves no room for a rift on the question of international exhaustion.") (internal quotation marks and citations omitted); *Allen v. Cooper,* 589 U.S. 248, 256 (2020) ("[t]hat provision—call it the Intellectual Property Clause—enables Congress to grant both copyrights and patents"). Copyright registrations have not been held invalid when some, but not all, contributors are identified in the registration. *See Maurel v. Smith*, 271 F. 211, 215–16 (2d Cir. 1921) (holding that if one of the co-authors of a joint work obtained a valid copyright registration, that co-author held the copyright in a constructive trust for the other authors). The same analysis applies to the patent statute. Fortress has never disputed that a patent must identify at least one person who actually invented. A non-inventor cannot obtain a patent. But the Clause does not mandate the result Digger seeks: that a patent that correctly names three true inventors (Sherstad, Burt, and Lin) becomes constitutionally void because a fourth agreed co-inventor was not yet added and could not be found. The Clause is a grant of power to Congress, and how inventorship is listed, corrected, and given effect is left to Congress's legislative judgment.

B. Digger is trying to turn back the clock

Decisions as early as 1915 and before hold a patent invalid if perfect inventorship is not complied with. *See Pannu v. Iolab Corp.*, 155 F.3d 1344, 1349 (Fed. Cir.

1998) (citing *Smart v. Wright*, 227 F. 84, 87 (8th Cir. 1915)). Other cases followed suit until the requirement was codified in 35 USC 102(f) of the 1952 Patent Act. *See id.* at 1349-1350. The 1952 Patent Act contained multiple provisions implementing procedures to ensure that all true inventors were named and that errors could be easily corrected. These provisions included § 102(g) and interference practice that invalidated a first filed patent if the true inventors had invented first but filed later. Along with the repeal of 102(f), the procedures to identify the true inventors including 102(g) and interference practice were also repealed. This was necessary to implement the "first-inventor-to-file" system of the America Invents Act. *See Egenera, Inc. v. Cisco Sys.*, 972 F.3d 1367, 1377 n.4 (Fed. Cir. 2020). Digger's argument that the Constitution requires perfect inventorship would return the U.S. patent system to its state in 1915, invalidating the AIA and the "first-inventor-to-file" system it implemented. The Constitution does not require this result.

Digger's authorities do not hold otherwise. *Egenera* stated that courts "have ***historically*** held that if a patent does not reflect its true inventorship, it is invalid," citing *Pannu*, a pre-AIA case applying § 102(f). *Egenera, Inc. v. Cisco Sys., Inc.*, 972 F.3d 1367, 1376 (Fed. Cir. 2020) (emphasis added); Opp. Br. 15. *Egenera* then *permitted* correction under § 256 and recognized that the AIA replaced § 102(f) with derivation proceedings. *Id.* at 1376–77 & n.4. *Sperry Rand* likewise arose under the pre-AIA regime. *Iowa State Univ. Rsch. Found., Inc. v. Sperry Rand Corp.*, 444 F.2d 406, 408 (4th Cir. 1971). The Constitution's "objective" is served by correcting inventorship, not by destroying patents over it. *A.F. Stoddard & Co. v. Dann*, 564 F.2d 556, 564 (C.C.P.A. 1977).

C. A constitutional perfect-inventorship rule cannot coexist with the first-inventor-to-file system.

Before the AIA, United States law held that "the right to a patent derives from priority of invention, not priority of patent application filing." *Hyatt v. Boone*, 146 F.3d 1348, 1351 (Fed. Cir. 1998). In the AIA, Congress repealed § 102(f) and moved to a first-inventor-to-file system. Pub. L. No. 112-29, § 3(b)(1), 125 Stat. 284, 285–86 (2011); Pet. 13. Under that system, a patent may validly issue to the first inventor to file even when different persons conceived the same invention first and are not named on the issued patent. The true, first inventors can be left off the patent entirely, and the patent remains valid.

If Digger were right that the Constitution requires a valid patent to name every true inventor, that core feature of the AIA would be unconstitutional. Digger cannot escape this point. Below, Digger acknowledged that "[p]re-AIA Section 102(f) indisputably constituted part of the fabric of the prior 'first-to-invent' system." Appellee Br. 38 n.16, ECF No. 16. Congress removed that part of the fabric deliberately. Its judgment that a patent may be valid without naming every person with a claim to the title "inventor" is an exercise of the power the Clause confers, not a violation of it.

A Constitutional interpretation that mandates perfect inventorship also conflicts with copyright statutes enacted under the same constitutional authority. *See Unicolors, Inc. v. H&M Hennes & Mauritz, L. P.*, 595 U.S. 178, 182, (2022) (citing 17 U.S.C. § 411(b) as a safe

harbor provision that excuses inaccuracy in a copyright registration). Digger acknowledges that Copyright law and Patent Law are supported by the same Constitutional provision by citing *Goldstein v. California,* 412 U.S. 546, 555 (1973). Opp. Br. p. 14. If the Constitution requires perfect inventorship as a requirement for valid patent, it must also require perfect identification of contributors to a copyrighted work for a valid copyright registration. It does not.

D. The constitutional question has significance far beyond this case.

Rejecting Digger's argument (that the Constitution mandates perfect inventorship), exposes a fundamental error in the Federal Circuit's opinion: the repeal of 102(f) eliminated perfect inventorship as a statutory requirement and 101 cannot be newly interpreted to carry that weight.[2] The Federal Circuit held that sections 101, 100(f), and 256(b) together require all inventors to be listed and that with respect to section 101 "'[w]hoever' does not mean less than all." Pet. App. 12a. Digger, apparently recognizing that the statutory language of, *inter alia*, 101 cannot carry the weight the Federal Circuit gave it, particularly in view of the repeal of 102(f), now argues that perfect inventorship is mandated by the Constitution itself. If Digger is right, every patent issued under the AIA's first-inventor-to-file regime, and every patent issued on a substitute statement under § 115(d), rests

2. Section 101 already carries enough weight with *Alice, Mayo* and the law of patentable subject matter. *See Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012); *Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208 (2014).

on uncertain constitutional ground. Pet. 16. If Digger is wrong, the Federal Circuit has rebuilt repealed § 102(f) out of statutory provisions Congress left unchanged in the AIA. Either way, only this Court can say whether Congress's repeal of § 102(f) should be ignored. Because the Federal Circuit has exclusive jurisdiction, 28 U.S.C. § 1295(a)(1), no other court will ever answer that question.

II. Section 256(b)'s "Notice and Hearing of All Parties Concerned" Requirement Is a Due Process Safeguard

Section 256(b) provides that the court "may order correction of the patent on notice and hearing of all parties concerned." 35 U.S.C. § 256(b). It describes *how* a court that already has a case before it is to proceed. It does not limit the court's power to act. That the procedure provides for notice and an opportunity for hearing shows that Congress prescribed this procedural due process to protect against *deprivations* of life, liberty, or property. U.S. Const. amend. V.

Digger does not seriously argue otherwise. Below, it described the clause as reflecting "Congress's intent to balance the correction of inventorship errors with due process rights." Appellee Br. 16. In this Court, Digger says the clause "guarantees that any interest—pecuniary or reputational—is given due consideration." Opp. Br. 9. Digger also stresses that the clause requires only an "opportunity" to be heard, not attendance, Opp. Br. 9, and faults Fortress for not attempting "constructive notice[3]."

3. While recognizing that the prescribed procedure only affords an ***opportunity*** for hearing, Pet. App. 5a, 7a 8a, the Federal

Opp. Br. 16–17. Each of those points describes a due-process safeguard: "notice that is reasonably calculated, under all the circumstances, to apprise interested parties." *See A. A. R. P. v. Trump*, 605 U.S. 91, 94-95 (2025) (quoting *Mullane v. Cent. Hanover Bank & Tr. Co.*, 339 U.S. 306, 314 (1950)). The Federal Circuit nonetheless treated 256(b) as an inflexible prerequisite as to Huang whose nonobservance renders patents "invalid," erroneously rejecting any reading "through a 'due process' lens." Pet. App. 8a, 10a, 13a. This Court should correct this error.

A. Due process requires notice only where a person's interests may be adversely affected, and adding an inventor's name confers a benefit.

Procedural due process protects against unfair *deprivations* of life, liberty, or property. U.S. Const. amend. V. Section 256(b) addresses two different errors: "omitting inventors" and "naming persons who are not inventors." Removing a named inventor can strip a presumptive ownership interest, see 35 U.S.C. § 262; *Ethicon, Inc. v. U.S. Surgical Corp.*, 135 F.3d 1456, 1465 (Fed. Cir. 1998), and notice to that person is required. Adding an agreed inventor takes nothing away. Being named "an inventor of important subject matter is a mark of success in one's field." *Chou v. Univ. of Chicago*, 254

Circuit erroneously suggests that the statutory prerequisite demands that an unnamed inventor must be heard, which eliminates constructive notice as an option. Pet. App. 8a ("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.")

F.3d 1347, 1359 (Fed. Cir. 2001). The "legal, financial, and ownership consequences" the Federal Circuit invoked, Pet. App. 9a, all run in favor of the person being added.

Courts applying § 256 have recognized that its notice component exists "to preserve one's due process rights in relation to property interests." *Fina Tech., Inc. v. Ewen*, 857 F. Supp. 1151, 1156 (N.D. Tex. 1994), a case Digger itself relies on, Opp. Br. 9. The Federal Circuit has also held that an inventor who has assigned all rights lacks standing to invoke § 256 at all. *Larson v. Correct Craft, Inc.*, 569 F.3d 1319, 1326–27 (Fed. Cir. 2009). The Federal Circuit opinion and Digger say "due process" standing and "party concerned" status are distinct, Opp. Br. 8–9, but both ask the same basic question: does the person have a cognizable interest at stake? A person with nothing to lose from a correction, and no standing to seek it, is not one whose absence can forfeit the patent for everyone else.

To the extent a court has attempted to elucidate a distinction, the Federal Circuit held that a putative inventor had standing because she alleged "a concrete financial interest in the patent, albeit an interest less than ownership." *Chou*, 254 F.3d at 1359. And "parties with an economic stake in a patent's validity are entitled to be heard on inventorship issues once a putative inventor has sued to correct inventorship." *Id.* Thus, correctly applying the primary case relied on by the Federal Circuit, Pet. App. 7a-8a, Huang would not have standing because he lacks a concrete financial interest in the patents, and he would not be entitled to notice and an opportunity to be heard because he is not being deprived of an economic interest.

III. Huang Is Not a "Party Concerned" Because the Only Record Evidence, and the District Court's Own Finding, Establish That He Worked for YD.

Digger's poor vehicle argument rests on the premise that Huang's "employment status with YD (or lack thereof) was disputed." Opp. Br. 6. The record does not support that premise.

A. The district court found, and the Federal Circuit accepted, that Huang was a YD employee.

The district court found: "At this time, Mr. Huang was a YD employee who was involved with the development of Fortress's prototype." Pet. App. 16a. The Federal Circuit described Huang and Lin as "YD employees." Pet. App. 3a. That finding rests on the deposition testimony of co-inventor Kevin Burt, C.A. App. 230, and contemporaneous correspondence from YD, C.A. App. 183, 240, 248–249, ECF No. 18-1. See Appellant Reply Br. 15–16, ECF No. 17. Digger offered no contrary evidence. It argued only that Fortress's evidence was hearsay; the district court relied on that evidence anyway, and Digger did not cross-appeal. *Id.* at 13. Indeed, Digger's own invalidity contentions and expert attributed Huang's contribution to Fortress's Chinese supplier, not to Huang acting on his own. *Id.* at 14 (citing C.A. App. 386, 459).

B. Because Fortress took by assignment from YD, Huang's rights, if any, passed through that chain of title.

Under Article 6 of the Patent Law of the People's Republic of China, an invention made "in the course of performing any task for an entity to which the person belongs" is a service invention, and "the right to apply for a patent belongs to the entity." Appellant Br. 12 n.3. YD then assigned all of its ownership rights in the patents to Fortress on February 17, 2023, and that assignment was recorded. Pet. App. 18a. Whatever rights Huang's contribution generated were therefore conveyed to Fortress. Huang has no independent stake that a correction adding his name could impair, so he is not a "party concerned" entitled to notice under § 256(b).

C. Digger's remaining points do not create a genuine dispute or a vehicle problem.

First, the absence of a written employment agreement, Opp. Br. 6, is irrelevant. Article 6 operates by law based on the work performed, and the same YD correspondence that identified Huang as the person who "offered guidance" on the prototype also reported that he worked for YD without an employment contract. Appellant Reply Br. 16 (citing C.A. App. 240).

Second, the Federal Circuit's statement that "[n]either the parties, nor we, know for certain whether Huang would be adversely affected or would benefit," Pet. App. 8a, was not a finding that Huang retained any interest. It was a reason the court gave for refusing to look at Huang's interests at all. The legal question is squarely presented.

Third, Huang's April 2026 quitclaim, Opp. Br. 7 n.2, arose after judgment and is not in the record. At most, it confirms that Huang, once located, claims no interest adverse to the patent owner.[4]

The questions presented therefore arise on undisputed facts: Huang is an agreed co-inventor; the district court found he worked for YD; YD assigned its rights to Fortress; and naming Huang could only benefit him. This case presents the issues cleanly.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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4. Digger's suggestion that neither petitioner has standing, Opp. Br. 1–2 n.1, is misplaced. Fortress Iron, LP was the plaintiff-appellant below and remains a petitioner. Fortified IPCO, LLC, the recorded successor-in-interest under common executive control, joined only to ensure continuity. Pet. 3 n.1.