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UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF CALIFORNIA

GERAWN FARMING, INC.,	Case No. 1:11-cv-01273 LJO BAM
Plaintiff,	ORDER ON DEFENDANT’S MOTION FOR
v.	SUMMARY JUDGMENT
REHRIG PACIFIC COMPANY,	(Doc. 69)
Defendant.	

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Pending before the Court is Defendant Rehrig Pacific Company’s (“Defendant’s” or “Rehrig’s”) motion for summary judgment. Plaintiff Gerawan Farming, Inc., (“Plaintiff” or “Gerawan”) has filed an opposition to the motion, and Defendant has filed a reply. Having carefully considered the parties’ submissions and the entire record in this case, the Court GRANTS IN PART and DENIES IN PART Defendant’s motion for summary judgment.

**I. BACKGROUND**

**A. Factual Background**

Plaintiff is the nation’s largest grower of peaches, plums, and nectarines and is also one of the nation’s largest growers of table grapes. Defendant is a manufacturer of plastic-molded containers for industrial use. This case concerns a dispute between the two over the patent and ownership interests in three containers used for harvesting fruit: (1) the Grape Lug; (2) the Harvest Tote; and (3) the Second Generation Harvest Tote.

1                   **1.     The Grape Lug**

2                   In March 1992, Cory Phillips (“Mr. Phillips”), a Marketing Representative for Rehrig, began  
3 researching and marketing a durable container for storing and transporting grapes. Mr. Phillips spoke  
4 with industry experts, researched then-existing agricultural containers, and called potential users of the  
5 product. In the subsequent months, Jeff Ackerman (“Mr. Ackerman”), a Design Engineer for Rehrig,  
6 and William Apps (“Mr. Apps”), Head of New Product Development for Rehrig, joined Mr. Phillips  
7 in the project. The three worked to market and design a mold for a grape container, which would later  
8 become known as the “Grape Lug.”

9                   The project progressed from 1992 through 1993, and included the following notable events.  
10 In December 1992, Rehrig drafted a preliminary memorandum regarding the Grape Lug that contained  
11 general dimensions and price proposals for the product. In February and May 1993, Rehrig drafted  
12 production studies for the Grape Lug. By June 14, 1993, Rehrig had fully engineered drawings of the  
13 Grape Lug depicting the design and specific dimensions of the container. Also, on or around that date  
14 Rehrig ordered the mold for the Grape Lug. On July 1, 1993, Rehrig sent a proposal of the Grape Lug  
15 to Sun World, a potential customer.

16                  In addition to its efforts to sell the Grape Lug, Rehrig sought to patent the product. On July 8,  
17 1993, Rehrig authorized its patent counsel to initiate a patentability search on the Grape Lug. Rehrig  
18 ultimately filed a patent application in August 1993, identifying Mr. Ackerman as the sole inventor of  
19 the Grape Lug. However, a few months later Mr. Phillips and Mr. Apps were added to the application  
20 as inventors. On May 16, 1995, the U.S. Patent Office issued a patent for the Grape Lug. The patent,  
21 U.S. Patent No. 5415293 (“the ‘293 Patent”), identified three individuals as co-inventors of the Grape  
22 Lug: Mr. Ackerman, Mr. Apps, and Mr. Phillips.

23                  At some point in 1993, Mr. Phillips contacted Gerawan and arranged a meeting to gauge the  
24 company’s interest in the Grape Lug. The parties dispute when the meeting actually occurred; Rehrig  
25 asserts that the meeting occurred in late July 1993, while Gerawan asserts that the meeting occurred in  
26 June or early July 1993. In any event, at the meeting Mr. Phillips discussed the Grape Lug with Dave  
27 Dever (“Mr. Dever”) and Ray Gerawan (“Mr. Gerawan”) from Gerawan. Mr. Gerawan and Mr. Dever  
28 reviewed preliminary design drawings of the Grape Lug, but ultimately concluded that their company

1 was not interested in the grape container. Mr. Gerawan and Mr. Dever did, however, express interest  
2 in developing a picking bin for harvesting stone fruit for which Mr. Gerawan had a prior conception.  
3 The picking bin would later become known as the “Harvest Tote.”

## 4 **2. The Harvest Tote**

5 On September 15, 1993, Gerawan and Rehrig signed a confidential disclosure agreement (“the  
6 1993 Confidentiality Agreement”) to facilitate the two companies’ efforts in developing the Harvest  
7 Tote. Under the 1993 Confidentiality Agreement, Gerawan agreed to disclose what it considered to be  
8 trade secrets, patentable information, and other proprietary materials relating to the Harvest Tote. In  
9 exchange, Rehrig agreed not to disclose the information to others and to use the information only to  
10 develop the Harvest Tote for Gerawan. Moreover, Rehrig agreed that the rights to any improvements  
11 or modifications to the Harvest Tote and any inventions conceived as a result of reviewing Gerawan’s  
12 materials would be assigned to Gerawan.

13 In the ensuing months, from October 1993 to July 1994, Gerawan and Rehrig sought to reach  
14 an agreement over the sales and marketing of the Harvest Tote. The companies exchanged numerous  
15 drafts of an Agreement in Principle, which included various terms such as: (1) Gerawan agreed to pay  
16 for the mold of the Harvest Tote; (2) Rehrig agreed to engineer and manufacture the Harvest Tote to  
17 Gerawan’s specifications; (3) Gerawan agreed to provide Rehrig an exclusive license to manufacture  
18 the Harvest Tote; (4) Rehrig agreed to pay Gerawan royalties from the sales of the Harvest Tote; and  
19 (5) Rehrig agreed to refrain from improving the Harvest Tote for anyone besides Gerawan. However,  
20 it is unclear whether a final and firm agreement was ever reached. Gerawan maintains that one was,  
21 while Rehrig asserts that one was not. There is no signed copy of any final “Agreement in Principle”  
22 between the two companies.

23 Whatever the status of an agreement was, Gerawan did agree to buy the mold and Rehrig did  
24 agree to pay royalties to Gerawan from sales of the Harvest Tote. Sales of the Harvest Tote began in  
25 the middle of 1994, but no patent was ever filed for the Harvest Tote.

## 26 **3. The Second Generation Harvest Tote**

27 In or around 2000, Rehrig began to discuss with Gerawan the possibility of producing a next  
28 generation Harvest Tote (“the Second Generation Harvest Tote”), and by 2002, Gerawan understood

1 that Rehrig was actually preparing to begin design work on the Second Generation Harvest Tote. To  
2 express its interest in participating in the designing of the Second Generation Harvest Tote, Gerawan  
3 sent an email to Rehrig on January 14, 2002. However, for reasons that are still unknown, the parties  
4 never met to discuss the Second Generation Harvest Tote and Rehrig proceeded to design the Second  
5 Generation Harvest Tote on its own. Meanwhile, sales of the original Harvest Tote came to an end in  
6 or around September 2002.

7 Rehrig began production of the Second Generation Harvest Tote in March 2003. Though it is  
8 unclear which features, if any, of the Harvest Tote were carried over to the Second Generation Harvest  
9 Tote, the Second Generation Harvest Tote does differ from the Harvest Tote in many significant ways.  
10 In particular, the Second Generation Harvest Tote: (1) has an exterior rib structure; (2) does not have  
11 hollow comers; (3) has exterior sliders; (4) is not made with double thick material; (5) has a contoured  
12 bottom; (6) has a stacking ledge on all four sides; (7) has an open corner design; and (8) has an option  
13 for a plastic handle.

14 Although Rehrig openly advertised the Second Generation Harvest Tote, there is a dispute as  
15 to whether Gerawan was actually aware that Rehrig had begun selling the Second Generation Harvest  
16 Tote. For example, on April 1, 2003, George Papangellin (“Mr. Papangellin”) of Gerawan told Jon  
17 Kalin (“Mr. Kalin”) at Rehrig via email that one of Gerawan’s affiliates in Mexico, Grupo Alto, had  
18 expressed interest in the Second Generation Harvest Tote and might want to buy it the following year.  
19 Although the email makes clear that Mr. Papangellin was aware that Rehrig was designing the Second  
20 Generation Harvest Tote, there is no indication that Mr. Papangellin was aware of the fact that it was  
21 actually available for sale already.

22 Similarly, from 2004 to 2006, Mr. Gerawan observed harvesters using the Second Generation  
23 Harvest Tote at Reedley Farms and Wawona Packing. However, Mr. Gerawan believed the containers  
24 were the products of another company that had simply beaten Gerawan and Rehrig to the market. As  
25 such, Mr. Gerawan did not ask Reedley Farms, Wawona Packing, or Rehrig about the containers.  
26 According to Mr. Gerawan, it was not until August 2008 that he discovered the containers were made  
27 by Rehrig. Mr. Gerawan maintains that a representative at a packing company told him “Rehrig” after  
28 he asked who the container’s manufacturer was.

1           **B.       Procedural History**

2           Plaintiff initiated this action on July 29, 2011. After the Court granted Defendant’s motion to  
3 dismiss, Plaintiff filed an amended complaint on March 23, 2012. The amended complaint, which is  
4 presently the operative complaint, asserts the following causes of action: (1) correction of inventorship  
5 pursuant to 35 U.S.C. § 256; (2) false promise under California tort law; and (3) unfair competition in  
6 violation of California’s Unfair Competition Law (“the UCL”), Cal. Bus. & Prof. Code § 17200, *et*  
7 *seq.*, and California common law.

8           Defendant filed the instant motion for summary judgment on February 14, 2013. Plaintiff filed  
9 an opposition to the motion on February 28, 2013, and Defendant filed a reply on March 7, 2013. The  
10 Court found Defendant’s motion to be suitable for decision without oral argument and took the matter  
11 under submission pursuant to Local Rule 230(g).

12           **II.       LEGAL STANDARD**

13           Summary judgment is appropriate when the pleadings, disclosure materials, discovery, and any  
14 affidavits provided establish that “there is no genuine dispute as to any material fact and the movant is  
15 entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a). A material fact is one that may affect  
16 the outcome of the case under the applicable law. See Anderson v. Liberty Lobby, Inc., 477 U.S. 242,  
17 248 (1986). A dispute is genuine “if the evidence is such that a reasonable trier of fact could return a  
18 verdict in favor of the nonmoving party.” Id.

19           A party seeking summary judgment “always bears the initial responsibility of informing the  
20 district court of the basis for its motion, and identifying those portions of the pleadings, depositions,  
21 answers to interrogatories, and admissions on file, together with the affidavits, if any, which it believes  
22 demonstrate the absence of a genuine issue of material fact.” Celotex Corp. v. Catrett, 477 U.S. 317,  
23 323 (1986) (internal quotation marks omitted). Where the movant will have the burden of proof on an  
24 issue at trial, it must “affirmatively demonstrate that no reasonable trier of fact could find other than  
25 for the moving party.” Soremekun v. Thrifty Payless, Inc., 509 F.3d 978, 984 (9th Cir. 2007). “On an  
26 issue as to which the nonmoving party will have the burden of proof, however, the movant can prevail  
27 merely by pointing out that there is an absence of evidence to support the nonmoving party’s case.”  
28 Id. (citing Celotex, 477 U.S. at 323).

1 If the movant has sustained its burden, the nonmoving party must “show a genuine issue of  
2 material fact by presenting *affirmative evidence* from which a jury could find in [its] favor.” FTC v.  
3 Stefanchik, 559 F.3d 924, 929 (9th Cir. 2009) (emphasis in the original). The nonmoving party must  
4 go beyond the allegations set forth in its pleadings. See Fed. R. Civ. P. 56(c). “[B]ald assertions or a  
5 mere scintilla of evidence” will not suffice. Stefanchik, 559 F.3d at 929. Indeed, the mere presence of  
6 “some metaphysical doubt as to the material facts” is insufficient to withstand a motion for summary  
7 judgment. Matsushita Electric Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 586 (1986). “Where  
8 the record taken as a whole could not lead a rational trier of fact to find for the nonmoving party, there  
9 is no genuine issue for trial.” Id. at 587.

10 In resolving a summary judgment motion, “the court does not make credibility determinations  
11 or weigh conflicting evidence.” Soremekun, 509 F.3d at 984. That remains the province of the jury.  
12 See Anderson, 477 U.S. at 255. Instead, “[t]he evidence of the [nonmoving party] is to be believed,  
13 and all justifiable inferences are to be drawn in [its] favor.” Id. Inferences, however, are not drawn  
14 out of the air; the nonmoving party must produce a factual predicate from which the inference may  
15 reasonably, and therefore justifiably, be drawn. See Richards v. Nielsen Freight Lines, 602 F. Supp.  
16 1224, 1244-45 (E.D. Cal. 1985).

### 17 **III. DISCUSSION**

#### 18 **A. Correction of Inventorship**

19 Plaintiff seeks to correct the ‘293 Patent and have Mr. Gerawan named as a co-inventor of the  
20 Grape Lug. Defendant responds that it is entitled to summary judgment on Plaintiff’s claim for three  
21 reasons. First, Defendant argues that Plaintiff lacks standing to bring this claim. Second, Defendant  
22 contends that even if Plaintiff has standing, Plaintiff’s claim for correction of inventorship is untimely  
23 and barred by the doctrine of laches. Third, Defendant argues that Plaintiff’s evidence is insufficient  
24 to support its claim.

#### 25 **1. Standing**

26 A plaintiff asserting a claim for correction of inventorship pursuant to 35 U.S.C. § 256 must  
27 establish standing. See Larson v. Correct Craft, Inc., 569 F.3d 1319, 1326 (Fed. Cir. 2009). In other  
28 words, “[the plaintiff] must show that [he] has suffered an injury-in-fact, that the injury is traceable to

1 the conduct complained of, and that the injury is redressable by a favorable decision.” Chou v. Univ.  
2 of Chicago & Arch Dev. Corp., 254 F.3d 1347, 1358 (Fed. Cir. 2001) (citations omitted). A plaintiff  
3 typically establishes standing to pursue a § 256 claim by showing that he has an expected ownership  
4 interest in the patent at issue, or otherwise has a concrete financial interest in the patent. See Larson,  
5 569 F.3d at 1326-27; Chou, 254 F.3d at 1358-59.

6 Defendant maintains that Plaintiff does not have an expected ownership interest in the ‘293  
7 Patent. Defendant points to the general rule that absent any assignment, rights to an invention belong  
8 to the inventor. Accord Bd. of Trustees. v. Roche Molecular Sys., 131 S. Ct. 2188, 2195, 180 L. Ed.  
9 2d 1 (2011). Defendant further asserts that there is no evidence that Mr. Gerawan assigned any of his  
10 rights to the ‘293 Patent to Plaintiff prior to filing this case. Therefore, according to Defendant, even  
11 if Plaintiff is successful in proving that Mr. Gerawan is an inventor of the Grape Lug in this case, Mr.  
12 Gerawan, and not Plaintiff, will obtain an ownership interest in the ‘293 Patent.

13 Plaintiff counters that Mr. Gerawan’s relationship with Plaintiff is so close and intertwined that  
14 Mr. Gerawan is essentially Plaintiff’s alter ego. Thus, according to Plaintiff, any patent rights that Mr.  
15 Gerawan obtains in this action will belong to Plaintiff as well, even absent any express assignment of  
16 rights from Mr. Gerawan to Plaintiff. Plaintiff cites LeFiell v. United States, 162 Ct. Cl. 865 (1963)<sup>1</sup>  
17 as support for its argument.

18 In LeFiell, Cecil K. LeFiell (“Mr. LeFiell”) obtained a patent for a tube tapering machine and  
19 subsequently filed suit in the name of himself and his company against the United States for allegedly  
20 manufacturing and using his invention without his prior authorization. Id. at 866-67. In response, the  
21 United States moved to dismiss the company from the case, arguing that the company did not have an  
22 ownership interest in the invention since its title belonged to Mr. LeFiell only. Id. at 867. Mr. LeFiell  
23 countered that he always considered the company as the true owner of the invention, and therefore the  
24 company was a proper party in the case. See id. at 867-68.

25 The Court of Claims agreed with Mr. LeFiell. The court reasoned that an inventor may have  
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27 <sup>1</sup> The holdings of the Court of Claims serve as precedential law in patent cases. See S. Corp. v.  
28 United States, 690 F.2d 1368, 1370 (Fed. Cir. 1982) (en banc). Defendant has not provided, nor has  
the Court independently found, any cases showing that LeFiell is no longer good law.

1 such a close and intertwined relationship with a company that the inventor is essentially the alter ego  
2 of the company. Id. at 869. In those circumstances, the patent rights of the inventor belong entirely to  
3 the company, even if there has been no express assignment of rights. Id. The court concluded that  
4 Mr. LeFiell had alleged facts sufficient to show that he was the company’s alter ego. According to  
5 Mr. LeFiell: (1) he was the president, general manager, and principal stockholder of the company; (2)  
6 he used the company’s time and resources to develop the invention; (3) the company paid the expenses  
7 associated with securing the patent for the invention; and (4) the company received all the profits from  
8 the invention and patent. Id. at 870.

9 In this case, a trier of fact could reasonably conclude that Mr. Gerawan was the alter ego of  
10 Gerawan from 1993 to 1994, the time frame when the Grape Lug was allegedly invented. See Melin  
11 v. United States, 201 Ct. Cl. 748, 756 (1973) (“[I]n determining the question of ownership of a patent  
12 between a company and an employee under the ‘alter ego’ theory, . . . the relationship which existed  
13 between the employer and the employee at the time when the invention was made is determinative,  
14 and not the relationship at a subsequent time.”). Critically, during this time frame Mr. Gerawan was  
15 the most senior officer at Gerawan, a company owned by his family. He was also one of its directors.  
16 There is some uncertainty as to how much actual managerial control Mr. Gerawan exercised, but there  
17 is evidence from which a trier of fact could conclude that Mr. Gerawan had primary responsibility for  
18 product development at the company, which included the designing of harvest containers. Moreover,  
19 Mr. Gerawan believed that his work, and any inventions derived therefrom, belonged to the company.  
20 In fact, the company, not Mr. Gerawan, received all the royalty payments generated from his work on  
21 the Harvest Tote.

22 Because a trier of fact could reasonably conclude that Mr. Gerawan was the alter ego of the  
23 company, the Court cannot rule as a matter of law that Plaintiff does not have an expected ownership  
24 interest in the ‘293 Patent. Accordingly, Defendant is not entitled to summary adjudication on the  
25 basis that Plaintiff lacks standing.

## 26 2. Laches

27 “Laches is an equitable defense that may bar an inventorship claim.” Serdarevic v. Advanced  
28 Medical Optics, Inc., 532 F.3d 1352, 1358 (Fed. Cir. 2008). To establish laches, the party raising the



1 defense carries the ultimate burden of proving that the plaintiff's delay in bringing the instant action is  
2 "unreasonable and inexcusable" and that the defending party has in fact suffered "material prejudice  
3 attributable to the [plaintiff's] delay." Intirtool, Ltd. v. Texar Corp., 369 F.3d 1289, 1297 (Fed. Cir.  
4 2004) (citation omitted).

5 "[A] delay of more than six years after the omitted inventor knew or should have known of the  
6 issuance of the patent [produces] a rebuttable presumption of laches." Advanced Cardiovascular Sys.  
7 v. SciMed Life Sys., 988 F.2d 1157, 1163 (Fed. Cir. 1993). Thus, if the party asserting laches is able  
8 to establish that the plaintiff had actual knowledge of the disputed patent's issuance, or was aware of  
9 facts that would have led a man of ordinary intelligence to inquire into the matter, it is presumed that  
10 the plaintiff's delay in bringing suit was unreasonable and the defending party suffered prejudice. See  
11 id. at 1161-62. The burden then shifts to the plaintiff to rebut this presumption by offering evidence  
12 showing that the delay was reasonable or that the defending party has not suffered prejudice as a result  
13 of the delay. Serdarevic, 532 F.3d at 1359-60. If the plaintiff does not meet its burden of production,  
14 the defending party prevails. Id. at 1359.

15 Defendant attempts to establish a rebuttable presumption of laches by arguing that Plaintiff  
16 knew, or a reasonable person would have known, that a patent had been issued for the Grape Lug at  
17 least six years prior to initiating this action. First, Defendant notes that the '293 Patent is published by  
18 the U.S. Patent Office and can be viewed, as all U.S. patents can, by the public. Second, Defendant  
19 maintains that each of the nearly four million Grape Lugs purchased and used by Plaintiff from 1994  
20 through 2001 was marked "patent pending" or stamped with the Grape Lug's actual patent number.  
21 Defendant contends that these markings, along with any information Plaintiff would have gathered had  
22 it investigated the patent status of the *Harvest Tote*, should have alerted Plaintiff more than a decade  
23 ago that the '293 Patent had been issued to Defendant without naming Mr. Gerawan as a co-inventor  
24 of the Grape Lug.

25 Defendant's argument falls short. As an initial matter, the public recordation of the '293  
26 Patent in the U.S. Patent Office does not mean that, as a matter of law, Mr. Gerawan should have been  
27 aware of the patent's issuance for the purpose of laches. See Advanced Cardiovascular Sys., 988 F.2d  
28 at 1162-63 (explaining that any constructive notice provided by recording a patent in the Patent Office

1 does not impute the knowledge necessary to trigger laches). As for the patent markings on the Grape  
2 Lug, Plaintiff insists that all the Grape Lugs it purchased were marked “Patent Pending” and not with  
3 the actual patent number. In any event, even if Plaintiff knew that the Grape Lugs were marked with a  
4 patent number, the issue is not what *Plaintiff* knew, but what *Mr. Gerawan* knew. Mr. Gerawan is the  
5 alleged co-inventor; therefore, it is the facts in *his* knowledge that matter. See id. at 1163 (“[A] delay  
6 of more than six years after the *omitted inventor* knew or should have known of the issuance of the  
7 patent [produces] a rebuttable presumption of laches.”) (emphasis added). Defendant has not offered  
8 evidence to fill the gap between Plaintiff’s knowledge and Mr. Gerawan’s, and has not demonstrated  
9 that Mr. Gerawan was aware that the Grape Lug was patented or was being patented.<sup>2</sup> Accordingly,  
10 Defendant falls shy of establishing a rebuttable presumption of laches and therefore is not entitled to  
11 summary adjudication on this basis.

### 12 3. Sufficiency of Evidence

13 The issuance of a patent “creates a presumption that the named inventors are the true and only  
14 inventors.” Ethicon, Inc. v. United States Surgical Corp., 135 F.3d 1456, 1460 (Fed. Cir. 1998) (citing  
15 Hess v. Advanced Cardiovascular Sys., 106 F.3d 976, 980 (Fed. Cir. 1997)). However, if a person not  
16 named in an issued patent proves by “clear and convincing evidence” that he is a co-inventor, and that  
17 he was not identified in the patent through error and without any deception intent on his part, a district  
18 court may order the patent corrected. See 35 U.S.C. § 256 (2011); Fina Oil & Chemical Co. v. Ewen,  
19 123 F.3d 1466, 1472 (Fed. Cir. 1997).

20 Conception, which is the “formation in the mind of the inventor[] of a definite and permanent  
21 idea of the complete and operative invention,” is the touchstone of inventorship. Burroughs Wellcome  
22 Co. v. Barr Laboratories, Inc., 40 F.3d 1223, 1227-28 (Fed. Cir. 1994). Therefore, to be a co-inventor,  
23 a person must “contribute in some significant manner to the conception of the invention.” Fina Oil &  
24 Chem., 123 F.3d at 1473. See Ethicon, 135 F.3d at 1460. “[M]erely assisting the actual inventor after  
25 conception of the claimed invention;” providing the actual inventor well-known principles or state of  
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27 <sup>2</sup> The Court acknowledges the tension of viewing Mr. Gerawan as the alter ego of Plaintiff in  
28 the context of standing, but separate entities in the context of laches. Nevertheless, the question of  
assignment and the question of actual knowledge are distinct.

1 the art without ever having a firm and definite idea of the claimed combination as a whole; or reducing  
2 the actual inventor's idea to practice through ordinary skill in the art does not make one a co-inventor.  
3 Ethicon, 135 F.3d at 1460.

4 A co-inventor need not contribute to the conception of every claim contained in a patent; nor  
5 must he make the same amount of contribution as another inventor. See 35 U.S.C. § 116. Rather, “[a]  
6 contribution to one claim is enough.” Ethicon, 135 F.3d at 1460 (citation omitted). Thus, in the end,  
7 “the critical question is who conceived, as the term is used in the patent law, the subject matter of the  
8 claims at issue.” Id.

9 In this case, the concepts that are at issue are the Grape Lug's (1) lid design; (2) use of holes  
10 for ventilation; (3) corner design and structure; and (4) placement of holes in the container's floor for  
11 cooling. Defendant maintains that it conceived these concepts, as well as every other concept tied to  
12 the Grape Lug in the '293 Patent, prior to any discussion or meeting it had with Plaintiff. According  
13 to Defendant, its first meeting with Plaintiff occurred in late July 1993. Defendant stresses that prior  
14 to that point it had already (1) engineered drawings of the Grape Lug's body and lid (June 14, 1993);  
15 (2) sent a proposal of the Grape Lug to Sun World (July 1, 1993); (3) authorized its patent counsel to  
16 initiate a patentability search on the Grape Lug (July 8, 1993); and (4) received three part sheets for  
17 the Grape Lug (July 22, 1993).

18 Defendant's engineered drawings of the Grape Lug, dated June 14, 1993, are critical pieces of  
19 evidence. According to Mr. Phillips, the engineered drawings of the Grape Lug depict the final form  
20 and dimensions of the Grape Lug as it is embodied in the '293 Patent. Notably, the drawings include  
21 (1) a lid; (2) structured corners; and (3) a configuration of holes in the container's sides and floor (i.e.,  
22 the very same aspects that Plaintiff now claims that Mr. Gerawan contributed to the Grape Lug). Mr.  
23 Phillips asserts that Defendant generally creates such drawings so that its tool builder can fabricate a  
24 final mold for the product. Mr. Phillips thus opines that Defendant ordered a mold for the Grape Lug  
25 on or around June 14, 1993.

26 Defendant's proposal to Sun World, which is dated July 1, 1993, is also notable. The proposal  
27 touted the Grape Lug's ventilation and stacking ability. The proposal materials also included pictures  
28 of the Grape Lug that clearly depicted (1) a lid; (2) structured corners; and (3) a configuration of holes

1 in the container's sides and floor. In fact, the pictures included in the proposal materials are virtually  
2 identical to the ones used in the '293 Patent.

3 Taken together, Defendant's evidence demonstrates that Defendant's conception of the Grape  
4 Lug was firm and definite by June 14, 1993. Thus, it became Plaintiff's burden in opposing summary  
5 judgment to offer clear and convincing evidence showing one of two things: (1) the Grape Lug shown  
6 in Defendant's engineered drawings is different from the Grape Lug embodied in the '293 Patent; or  
7 (2) Mr. Gerawan made his alleged inventive contributions to the Grape Lug sometime *before* June 14,  
8 1993. Cf. Ethicon, 135 F.3d at 1460 (assisting an actual inventor after conception of the invention has  
9 already occurred does make one a co-inventor). Plaintiff attempts to do the latter in its opposition and  
10 relies on Mr. Dever's notes and testimony as support for its argument. However, as explained below,  
11 Plaintiff's reliance on this evidence is ultimately misplaced.

12 The first issue that Plaintiff must offer clear and convincing evidence on is the timing of the  
13 first meeting between Mr. Gerawan and Mr. Phillips. This is the only meeting between Plaintiff and  
14 Defendant that could have occurred sometime before June 14, 1993. Mr. Dever asserted that he and  
15 Mr. Gerawan first met with Mr. Phillips "in June or early July 1993." (Doc. 77 ¶ 3; see also Doc. 81,  
16 Ex. C at 31:12-17.) The next meeting between Mr. Gerawan and Defendant, according to Plaintiff's  
17 own evidence, did not take place until mid or late July 1993.

18 Mr. Dever's testimony that the first meeting took place "in June or early July 1993" does not,  
19 in of itself, show that Mr. Gerawan met with Defendant before June 14, 1993. However, Mr. Dever  
20 also testified during his deposition that at the parties' first meeting, Mr. Phillips showed Mr. Gerawan  
21 design drawings of the Grape Lug in which the Grape Lug did *not* have a lid:

22 Q: The design that Mr. Phillips said he had been working on when you said he had  
23 been working on when you first met with him in June, July 1993, did he say it was one-  
or two-piece?

24 A: I don't recall if he specifically stated it was one-piece or two-piece. I remember  
25 just a picture design, and I only remember it being a one-piece. It didn't have a lid on it  
at that time.

26 Q: So, at the very first meeting you had with Mr. Phillips, you remember him  
27 showing you a design which did not have a lid?

28 A: Right. Correct.

1 (Doc. 81, Ex C at 42:4-14.) This testimony, along with Mr. Dever’s assertion that the parties first met  
2 in June or early July 1993, could lead a trier of fact reasonably to conclude that Mr. Gerawan did in  
3 fact meet with Defendant sometime before June 14, 1993, and at a point when the Grape Lug had not  
4 yet been fully conceived.

5 It is, however, not enough to show that the parties met before June 14, 1993. The second issue  
6 that Plaintiff must offer clear and convincing evidence on is the substance of the parties’ discussions at  
7 the meeting. Specifically, Plaintiff must show that at the meeting, Mr. Gerawan made some inventive  
8 contribution to the Grape Lug as embodied in the ‘293 Patent. See Ethicon, 135 F.3d at 1460. Here,  
9 Plaintiff’s evidence falls short.

10 Plaintiff relies almost exclusively on Mr. Dever’s testimony on this issue. But Mr. Dever’s  
11 testimony is neither clear nor convincing in showing that Mr. Gerawan made an inventive contribution  
12 to the Grape Lug at the parties’ first meeting. Although Mr. Dever testified in conclusory fashion that  
13 Mr. Gerawan “provided” Defendant with the ideas for a lid design, ventilation holes, and structured  
14 corners, Mr. Dever did not testify (nor can it be readily inferred from his testimony) that Mr. Gerawan  
15 provided Rehrig with any of these ideas at the parties’ first meeting, as opposed to at one of the other  
16 50 meetings that Mr. Gerawan subsequently had with Mr. Phillips:

17 Q: What was the substance of the conversation [during the first meeting with  
18 Rehrig in June or July 1993]? Can you remember any of the specifics?

19 A: [Mr. Phillips] showed me a design, a drawing, of the grape lug, and we chatted  
20 about that. And then – we didn’t really have – ourselves, Gerawan Farming, didn’t  
21 have a lot of interest in the grape box that they were designing, but we had an interest  
22 in a harvest tote, and so we chatted about a harvest tote.

23 Q: What did you tell Mr. Phillips about the design he showed you for the grape  
24 crate?

25 A: Specifically?

26 Q: Yes.

27 A: That we didn’t see that there was a need for it at the time, is my recollection.

28 Q: Did you tell him anything about the design?

A: About the – good, bad or indifferent, is that what you’re referencing?

Q: Yes.

1 A: I don't recall telling him anything specific about the design of it, whether it was  
2 good, bad or indifferent.

3 \* \* \*

4 Q: Do you recall ever providing any designs for a grape crate to Rehrig in the June,  
5 July 1993 time frame?

6 A: Designs for a grape crate?

7 Q: Yes.

8 A: Not that I recall.

9 Q: Are you aware of anyone else at Gerawan that provided designs for a grape  
10 crate to Rehrig in the June or July 1993 time frame?

11 A: Not to my knowledge.

12 Q: Did you, in the June or July 1993 time frame, provide any specifications for a  
13 grape crate to Rehrig?

14 A: Not to my knowledge.

15 Q: And, to your knowledge, did anyone else at Gerawan Farming in the June or  
16 July 1993 time frame provide any specifications for a grape crate to Rehrig?

17 A: Again, not to my knowledge. Sounded like the same question to me, but.

18 Q: The first question was related to you personally and then I just wanted to know  
19 if you are aware of anyone else at Gerawan who had done that.

20 A: Oh, okay.

21 Q: So, you know, just to be clear, are you aware of anyone at Gerawan, yourself or  
22 any other person working for Gerawan, that provided any specifications to Rehrig for a  
23 grape crate in the June or July 1993 time frame?

24 A: Not to my knowledge.

25 (Doc. 81, Ex. C at 31:18-32:13, 37:8-38:12; 46:22-47:6.)

26 Mr. Gerawan's deposition testimony is also far from enlightening on this issue. Mr. Gerawan,  
27 the supposed co-inventor of the Grape Lug, testified that he could not recall which specific inventive  
28 design features he contributed to the Grape Lug, whether at his first meeting with Mr. Phillips in June  
or at some other time:

Q: Did you conceive any of the specific design features of this product pictured in  
Exhibit 9 [the Grape Lug]?

A: To the best of my knowledge what specifically was I involved in the design of  
that, I don't recall. There were discussions on it. As to what specifics, I don't recall.

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Q: And I want the record to be clear, when I said you, I was talking about you personally.

A: Right.

(Doc. 69-7, Ex. D at 24:3-11.)

Thus, having reviewed the evidence presented as a whole, the Court concludes that Plaintiff has failed to offer clear and convincing evidence demonstrating that Mr. Gerawan made an inventive contribution to the Grape Lug as embodied in the ‘293 Patent. Accordingly, Defendant is entitled to summary adjudication of this claim.

**B. False Promise**

Plaintiff alleges that Defendant made two false promises. First, Plaintiff alleges that Defendant falsely promised that the parties would jointly own any patent claims related to the Harvest Tote. (See Doc. 26 ¶¶ 10, 11, 30.) Second, Plaintiff alleges that Defendant falsely promised that it would not use Plaintiff’s confidential proprietary materials for any purpose other than to develop and sell the Harvest Tote for Plaintiff. (Id. ¶¶ 10, 30.)

A false promise is defined as “[a] promise, made without any intention of performing it.” Cal. Civ. Code § 1710. In California, a cause of action for false promise may lie where a defendant uses a false promise in order to induce the plaintiff into entering a contract. Lazar v. Superior Court, 12 Cal. 4th 631, 638 (1996). To prevail, the plaintiff must show that (1) the defendant made a false promise; (2) the defendant knew that the promise was false at the time it was made; (3) the defendant intended to induce the plaintiff’s reliance; (4) the plaintiff actually and justifiably relied on the promise; and (5) the plaintiff suffered damages as a result of his reliance. See Engalla v. Permanente Med. Group, Inc., 15 Cal. 4th 951, 973-74 (1997).

**1. Joint Ownership of Any Harvest Tote Patents**

Plaintiff’s allegation that Defendant falsely promised it that the parties would jointly own any patent claims related to the Harvest Tote plainly lacks merit. It is undisputed that the Harvest Tote has never been patented, and there is nothing to suggest that the Second Generation Harvest Tote has been patented. Thus, Defendant could not have breached any promise to own jointly any patent claims on these products since there were never any patents to be shared in the first place. Plaintiff does not

1 even address this issue, let alone attempt to argue otherwise in its opposition. Accordingly, Defendant  
2 is entitled to summary adjudication of this claim.

### 3 **2. Use of Proprietary Materials**

4 As for the second alleged false promise, Defendant maintains that there is no evidence showing  
5 that it actually knew that this promise was false when it was made. In other words, Defendant argues  
6 that there is no evidence showing that it promised Plaintiff that it would not misappropriate Plaintiff's  
7 proprietary materials, while all along intending to break the promise. See Lazar, 12 Cal. 4th at 638 (to  
8 prevail on a claim for false promise, the plaintiff must prove that the defendant never actually intended  
9 to keep its promise). The Court agrees.

10 Plaintiff argues in its opposition that Defendant intended from the very outset to use Plaintiff's  
11 proprietary materials for other, non-sanctioned agricultural products, including the Second Generation  
12 Harvest Tote. However, Plaintiff offers no evidence of this. The only facts Plaintiff points to on this  
13 matter are: (1) Defendant does not usually share patents with its customers; and (2) in February 2002,  
14 Defendant noted that its royalty payment to Plaintiff was the largest factor affecting the Harvest Tote  
15 price. While these facts may set a general foundation for showing motive *in 2002*, they alone do not  
16 create a genuine issue of fact with respect to Defendant's intentions *in 1993*, the time when the parties  
17 reached an agreement on Plaintiff's proprietary materials. No trier of fact could reasonably infer from  
18 these two facts alone that Defendant harbored a secret intention in 1993 to take Plaintiff's proprietary  
19 materials to develop its own, unauthorized products, including the Second Generation Harvest Tote.<sup>3</sup>  
20 Accordingly, Defendant is entitled to summary adjudication of this claim.

### 21 **3. Other Promises**

22 The Court notes parenthetically that Plaintiff maintains in its opposition that Defendant made  
23 two other false promises: (1) a promise to file patents for the Harvest Tote; and (2) a promise that any  
24 improvements to the Harvest Tote would be owned by Plaintiff. Neither of these promises is alleged  
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26 <sup>3</sup> The Second Generation Harvest Tote was developed in or around 2001, some *8 years* after  
27 the parties agreed to share Plaintiff's proprietary materials. There is no evidence showing that  
28 Defendant conceived of, let alone intended to sell, a Second Generation Harvest Tote at any point near  
to 1993.



1 in the operative complaint. Moreover, the Magistrate Judge very recently denied Plaintiff's motion to  
2 amend the pleadings to include these very allegations. (See Doc. 89.<sup>4</sup>) The Court therefore disregards  
3 Plaintiff's arguments on these issues.

4 **C. Unfair Competition – Section 17200 and Common Law**

5 Plaintiff alleges that Defendant engaged in unfair competition in violation of the UCL, Cal.  
6 Bus. & Prof. Code § 17200, *et seq.*, and California common law in two specific ways: (1) by applying  
7 for patent protection over Plaintiff's proprietary design for the Harvest Tote without due attribution to  
8 Mr. Gerawan; and (2) by developing and selling the Second Generation Harvest Tote based upon the  
9 Harvest Tote design without ever receiving Plaintiff's authorization and without ever paying Plaintiff  
10 royalties. (Doc. 26 ¶¶ 36-37.)

11 Plaintiff's first allegation lacks merit because, as explained above, Defendant never applied for  
12 patent protection for the Harvest Tote. This, then, leaves Plaintiff's second allegation, specifically that  
13 Defendant developed and sold the Second Generation Harvest Tote based on the Harvest Tote design  
14 without receiving Plaintiff's authorization or paying Plaintiff any royalties. On this issue, Defendant  
15 argues that: (1) any UCL claim based on this conduct is entirely derivative of Plaintiff's other claims  
16 and therefore should "rise or fall" with them; (2) any UCL claim based on this conduct is time-barred;  
17 and (3) Plaintiff cannot recover the damages it requests in connection with its UCL claim. Defendant  
18 does not acknowledge the common law component of Plaintiff's claim.

19 **1. Derivative of Other Claims**

20 It is not particularly clear what Defendant means when it says that Plaintiff's UCL claim is  
21 entirely derivative of Plaintiff's other claims. To the extent that Defendant has construed Plaintiff's  
22 UCL claim as resting solely on the "unlawful" prong of the statute, it is mistaken. The UCL prohibits  
23 any unlawful, unfair or fraudulent business practice. See Cal. Bus. & Prof. Code § 17200. Because  
24 the statute is written in the disjunctive, each prong of the UCL (i.e., unlawful, unfair, or fraudulent) is  
25 a "separate and distinct theory of liability." Kearns v. Ford Motor Co., 567 F.3d 1120, 1127 (9th Cir.  
26 2009). Here, Plaintiff explicitly alleges its UCL claim under the "unfair" prong of the statute, not the

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27 <sup>4</sup> Plaintiff has moved for reconsideration of this order. That motion is still pending.  
28

1 “unlawful” prong. (Doc. 26 ¶ 37.)

2 It is also conceivable that Defendant’s “derivative” argument intended to reassert the argument  
3 Defendant raised with respect to Plaintiff’s claim for false promise. Defendant argued there that there  
4 is no evidence showing that Defendant used Plaintiff’s proprietary materials in developing the Second  
5 Generation Harvest Tote.<sup>5</sup> Defendant maintains that the Harvest Tote and Second Generation Harvest  
6 Tote differ significantly because the Second Generation Harvest Tote (1) has an exterior rib structure;  
7 (2) has exterior sliders with better stacking ability; (3) does not have hollow comers; (4) is not made  
8 with double thick material; (5) has a contoured bottom; (6) has a stacking ledge on all four sides; (7)  
9 has an open corner design; and (8) has a plastic handle option.

10 There is a genuine dispute as to which features of the Harvest Tote design were carried over to  
11 the Second Generation Harvest Tote and which were not. Jon Hassel, Defendant’s design engineer for  
12 the Second Generation Harvest Tote, suggested in his deposition testimony that the Second Generation  
13 Harvest Tote (1) has a similar footprint as the Harvest Tote; (2) stacks similar to the Harvest Tote; (3)  
14 has the same ventilation percentage as the Harvest Tote; and (4) has similar holes in the bottom of the  
15 container for hydrocooling as the Harvest Tote. Mr. Hassel’s deposition testimony creates a genuine,  
16 fact-intensive dispute that only a trier of fact can fully resolve. Accordingly, Defendant is not entitled  
17 to summary adjudication on this basis.

## 18 **2. Statute of Limitations**

19 A plaintiff must bring a claim within the relevant limitations period, which begins to run upon  
20 accrual of the cause of action. See Fox v. Ethicon Endo-Surgery, Inc., 35 Cal. 4th 797, 806 (2005). A  
21 cause of action generally accrues ““when, under the substantive law, the wrongful act is done, or the  
22 wrongful result occurs, and the consequent liability arises.” Norgart v. Upjohn Co., 21 Cal. 4th 383,  
23 397 (1999) (internal quotation marks and citation omitted). In other words, under the general rule, a  
24 cause of action accrues when it is complete with all of its generic elements, those being wrongdoing,  
25 harm, and causation. Id.

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27 <sup>5</sup> The Court did not address this argument in its analysis of Plaintiff’s false promise claim  
28 because the Court fully resolved that claim on other grounds.

1            “An important exception to the general rule of accrual is the ‘discovery rule[.]’” Fox, 35 Cal.  
2 4th at 807. Under the discovery rule, accrual is delayed “until the plaintiff discovers, or has reason to  
3 discover, the cause of action.” Id. (citations omitted). “A plaintiff has reason to discover a cause of  
4 action when he or she ‘has reason at least to suspect a factual basis for its [generic] elements,’” that is  
5 wrongdoing, harm, and causation. Id. (quoting Norgart, 21 Cal. 4th at 398). See Jolly v. Eli Lilly &  
6 Co., 44 Cal. 3d 1103, 1114 (1988) (“In sum, the limitations period begins when the plaintiff suspects,  
7 or should suspect, that she has been wronged.”).

8            Here, it is clear that under the general rule of accrual Plaintiff’s unfair competition claim under  
9 the UCL would be untimely. The alleged factual underpinnings of Plaintiff’s UCL claim appear to be:  
10 (1) the breach of the 1993 Confidentiality Agreement; and (2) the development and selling of the  
11 Second Generation Harvest Tote. Both of these events occurred by 2003, over eight years before  
12 Plaintiff initiated this action. This far exceeds the four-year statute of limitations period for claims  
13 under the UCL. See Cal. Bus. & Prof. Code § 17208; Aryeh v. Canon Business Solutions, Inc., 55  
14 Cal. 4th 1185, 1192 (2013).

15            The critical question, then, is whether Plaintiff can show that its claim accrued at a later date  
16 under the discover rule. See Investors Equity Life Holding Co. v. Schmidt, 195 Cal. App. 4th 1519,  
17 1533 (Ct. App. 2011) (the burden of proving delayed accrual falls on the plaintiff). Plaintiff contends  
18 that it was only in August 2008, when Mr. Gerawan was told affirmatively that Defendant made and  
19 sold the Second Generation Harvest Tote, that Plaintiff suspected its injury. Plaintiff therefore argues  
20 that its claim only began to accrue at that point. Defendant, meanwhile, maintains that Plaintiff was,  
21 or at least should have been, placed on inquiry notice of any injury caused by Defendant’s conduct  
22 long before 2008.

23            Viewed in the light most favorable to Plaintiff, the evidence in the record shows the following:  
24 (1) Plaintiff knew as of 2002 that Defendant began preparations for designing the Second Generation  
25 Harvest Tote; (2) Defendant never represented to Plaintiff that it was actually going to design and sell  
26 its own version of the Harvest Tote; (3) in 2003, Plaintiff indicated that one of its affiliates in Mexico  
27 was interested in purchasing a next generation harvest tote next year, but believed that Defendant was  
28 still in the process of designing the product; and (4) from 2004 to 2006, Mr. Gerawan observed other

1 harvest totes being used at other farms but did not suspect that Defendant was the producer in light of  
2 the 1993 Confidentiality Agreement. A trier of fact could reasonably conclude from these facts that  
3 Plaintiff did not suspect, nor should it have suspected, that Defendant was actually selling the Second  
4 Generation Harvest Tote on its own. In that case, the statute of limitations would not have begun to  
5 run until August 2008.

6 Defendant attempts to tip the scales decisively in its favor by arguing that Plaintiff knew that  
7 the Second Generation Harvest Tote was being sold as early as 2003 because Plaintiff purchased close  
8 to 2100 of them for a Mexican grower, Castelo Farms. As support for its argument, Defendant relies  
9 on the affidavit of Mr. Kalin and an invoice sent to Mr. Papangellin in April 2003. The invoice and  
10 other notes contain the code “pc002,” which according to Defendant is the product code used for the  
11 Second Generation Harvest Tote. However, in his deposition Mr. Papangellin contested this, albeit  
12 indirectly. Mr. Papangellin suggested that he had only purchased original Harvest Totes for Castelo  
13 Farms:

14 Q: And so, it’s fair to say that you were helping facilitate the sale of harvest totes,  
or potential sale of harvest totes from Rehrig to Castelo’s company?

15 A: Which harvest tote are you talking about?

16 Q: Any harvest tote.

17 A: We had facilitated logistics for harvest totes – first generation harvest totes – the  
18 original harvest tote, to be sold and shipped to Nogales for Castelo.

19 (Doc. 81, Ex. E at 85:6-19.) Assuming this to be true, this testimony creates a genuine dispute of fact  
20 that only a trier of fact can resolve.

21 In sum, viewing all of the evidence in the light most favorable to Plaintiff, a trier of fact could  
22 reasonably conclude that Plaintiff had no reason to suspect prior to August 2008 that Defendant was  
23 selling the Second Generation Harvest Tote. If that is the case, the statute of limitations period began  
24 to run only in August 2008, thereby making Plaintiff’s action timely. Accordingly, Defendant is not  
25 entitled to summary adjudication on this basis.

### 26 3. Monetary Damages

27 Plaintiff seeks the following monetary damages in connection with its UCL claim: (1) actual  
28 damages; (2) an accounting of Defendant’s profits generated from the sales of the Harvest Tote and

1 the Second Generation Harvest Tote; (3) disgorgement of all unjust profits; and (4) punitive damages.  
2 Defendant argues that the UCL does not permit such remedies.

3 While the scope of the UCL is “broad” and “sweeping,” its remedies are “generally limited to  
4 injunctive relief and restitution.” Cel-Tech Communications, 20 Cal. 4th at 179-80; see Korea Supply  
5 Co. v. Lockheed Martin Corp., 29 Cal. 4th 1134, 1144 (2003). The California Supreme Court has held  
6 that restitution in the context of the UCL means (1) money or property that was once in the plaintiff’s  
7 actual possession; or (2) money or property that the plaintiff has a “vested interest in.” Korea Supply,  
8 29 Cal. 4th at 1149. “A vested interest is one that is unconditional, absolute, and not contingent. A  
9 contingent interest, on the other hand, is dependent upon an uncertain future event.” Pegasus Satellite  
10 Television, Inc. v. DirecTV, Inc., 318 F. Supp. 2d 968, 979 (C.D. Cal. 2004) (internal quotation marks  
11 and citations omitted).

12 It is difficult for the Court to determine which remedies are available to Plaintiff when neither  
13 party has made any attempt to articulate clearly the underlying basis for Plaintiff’s UCL claim. From  
14 what the Court can discern, there may be two property interests at issue: (1) the right to use Plaintiff’s  
15 proprietary materials; and (2) the assignment rights to the Second Generation Harvest Tote. Facially,  
16 these property interests could implicate Defendant’s profits from the Second Generation Harvest Tote.  
17 As such, the Court cautiously declines to preclude Plaintiff from recovering such as a remedy under its  
18 UCL claim, at least at this time. Plaintiff is, however, not allowed to recover punitive damages under  
19 its UCL claim. See Korea Supply, 29 Cal. 4th at 1144; Groupion, LLC v. Groupon, Inc., 859 F. Supp.  
20 2d 1067, 1083 (N.D. Cal. 2012).

#### 21 **IV. CONCLUSION**

22 For the reasons set forth above, the Court:

- 23 1. GRANTS Defendant summary adjudication on the following claims and issues:
  - 24 a. Correction of inventorship pursuant 35 U.S.C. § 256;
  - 25 b. False promise under California law; and
  - 26 c. Punitive damages under the UCL.
- 27 2. DENIES Defendant summary adjudication on the following claims and issues:
  - 28 a. Unfair competition under the UCL;

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- b. Unfair competition under California common law; and
  - c. Non-punitive monetary remedies under the UCL.
3. ORDERS the parties to file a joint pretrial statement by no later than noon on Tuesday, April 16, 2013. **The Court emphasizes that it expects the parties' positions on the remaining claims to be precise and fully distilled in the joint pretrial statement. The Court will not accept a joint pretrial statement wherein the parties set forth a laundry list of issues and matters that have not been discussed between/among counsel.**

IT IS SO ORDERED.

Dated: April 8, 2013

/s/ Lawrence J. O'Neill  
UNITED STATES DISTRICT JUDGE