

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLORADO
Judge Philip A. Brimmer

Civil Action No. 13-cv-00170-PAB-KLM

ORALABS, INC., a Colorado Corporation,

Plaintiff,

v.

THE KIND GROUP LLC, a New York Limited Liability Company, and
EOS PRODUCTS LLC, a New York Limited Liability Company,

Defendants.

ORDER

This matter is before the Court on the Motion by Counterclaimants for Notice and Hearing to Correct Inventorship of Patent Pursuant to 35 U.S.C. § 256 [Docket No. 229] (public entry at Docket No. 243) and the Unopposed Motion for Order Setting Notice and Hearing to Correct Inventorship of Patent Pursuant to 35 U.S.C. § 256 [Docket No. 276] filed by defendants The Kind Group LLC and eos Products LLC (“defendants”).

Defendant The Kind Group LLC (“Kind Group”) owns United States Patent No. D644,939 (the “’939 Patent”), which covers the “ornamental design for the spherically-shaped lip balm.” Docket No. 1-2 at 1-5. Defendants have asserted, *inter alia*, a counterclaim against plaintiff for infringement of the ’939 Patent. See Docket No. 129 at 10. Plaintiff has asserted two affirmative defenses related to the inventorship of the ’939 Patent, namely, that the ’939 patent is unenforceable and invalid due to misjoinder or non-joinder of inventors. See Docket No. 130 at 12. According to defendants, in reliance on advice of counsel, Jonathan Teller, Kind Group’s founder, was listed as the

sole inventor. Docket No. 229 at 2-3. Defendants now claim that three other individuals – Kind Group co-founder Craig Dubitsky and Coral Garvey and Dennis Payongayong, employees of a creative consulting firm retained by Kind Group – were involved in the design and development of the product that embodies the '939 Patent. *Id.* at 2-3.

Section 256 of Title 35 of the United States Code provides that, “[w]henever through error . . . an inventor is not named in an issued patent, the Director may, on application of all the parties and assignees . . . issue a certificate correcting such error.” 35 U.S.C. § 256(a). In the alternative, Section 256 provides that “[t]he court before which [omission of inventors] 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. § 256(b). Here, defendants have been unable to obtain Mr. Dubitsky’s signed declaration to be added as an inventor to the '939 Patent and therefore seek correction through the notice and hearing provision in Section 256(b). Docket No. 229 at 4. Plaintiff does not oppose defendants’ motion, but notes that parties typically seek correction of inventorship by filing a claim for relief. Docket No. 255 at 1 (citing *Univ. of Utah v. Max-Planck-Gesellschaft*, 734 F.3d 1315, 1323-24 (Fed. Cir. 2013)).

The Court finds that nothing in Section 256(b) requires defendants to seek correction of inventorship through an independent cause of action. The statute provides that correction may be ordered by “[t]he court before which [omission of inventors] is called in question.” 35 U.S.C. § 256(b). Plaintiff has plainly called the issue into question by raising non-joinder of inventors in two affirmative defenses. The

matter is therefore appropriate for disposition via notice and hearing in this matter.

Accord, Illumina, Inc. v. Affymetrix, Inc., No. 09-cv-00277 (Docket No. 208), slip op at 9-10 (W.D. Wisc. Nov. 23, 2010) (rejecting the argument that “a request for correction is a ‘claim’ that must be pleaded”).¹

Wherefore, it is

ORDERED that defendants The Kind Group LLC and eos Products LLC’s Motion for Notice and Hearing to Correct Inventorship of Patent Pursuant to 35 U.S.C. § 256 [Docket No. 229] (public entry at Docket No. 243) is **GRANTED**. It is further

ORDERED that defendants The Kind Group LLC and eos Products LLC’s Unopposed Motion for Order Setting Notice and Hearing to Correct Inventorship of Patent Pursuant to 35 U.S.C. § 256 [Docket No. 276] is **GRANTED**. It is further

ORDERED that a hearing to correct inventorship of United States Patent No. D644,939 is set for May 1, 2015 at 3:30 p.m. It is further

ORDERED that, no later than April 1, 2015, defendant The Kind Group LLC shall provide written notice of the May 1, 2015 hearing to Mr. Craig Dubitsky, Ms. Coral Garvey, and Mr. Dennis Payongayong. The written notice shall include the date and time of the hearing, explain the hearing’s purpose, and state that each purported inventor may have an opportunity to testify if he or she so chooses. Proof of service of the written notice shall be filed with the Court no later than April 3, 2015.

¹In a motion filed on February 27, 2015, defendants suggest that the hearing to correct the inventorship of the ‘939 Patent should take place on March 23, 2015, when the parties are already scheduled to appear before the Court on a different matter. The Court finds that this would be insufficient notice to the interested parties.

DATED March 11, 2015.

BY THE COURT:

s/Philip A. Brimmer
PHILIP A. BRIMMER
United States District Judge