

STC.UNM v. Intel

Motion for Summary Judgment

April 10, 2012



Terminal Disclaimer and Limits on Enforceability of '998 Patent

PTO Rejects the '998 Application as an Improper Extension of the '321 patent

October 1, 1998: PTO's double patenting rejection

10. Claims 1, 15, and 27 are rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 5,705,321 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Ferrall Decl. Exh. C

UNM Responds by Filing a "Terminal Disclaimer"

On May 18, 1999, UNM promises that the '998 will only be enforceable so long as it is commonly owned with the '321 patent.

The University of New Mexico is the owner of record of a 100 percent interest in the instant application and the University of New Mexico hereby disclaims, except as provided below, the terminal part of the statutory term of present Claims of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154-156 and 173, as presently shortened by any Terminal Disclaimer, of prior Patent No. 5,705,321. The owner hereby agrees that the Claims of any patent so granted on this instant application shall be enforceable only for and during such period that the instant application (or resulting patent) and the prior patent are commonly owned. This agreement runs with the Claims of any patent granted on the instant application and is binding upon the grantee, its successors and/or assigns.

“Common Ownership” Requires 100% Common Ownership

“The term ‘commonly owned’ is intended to mean that the subject matter which would otherwise be prior art to the claimed invention and the claimed invention are **entirely or wholly owned by the same person(s) or organization(s)/business entity(ies)** at the time the claimed invention was made. If the person(s) or organization(s) owned less than 100 percent of the subject matter which would otherwise be prior art to the claimed invention, or less than 100 percent of the claimed invention, then common ownership would not exist.”

MPEP 706.02(I)(2)(I)

“Common Ownership” Requires 100% Common Ownership

Example 2

- Parent Company owns 100% of Subsidiary A and 90% of Subsidiary B.
- Inventions of A and B are not commonly owned by the Parent Company.

MPEP 706.02(I)(2)(I), Example 2 (emphasis added)

Unenforceability

Unenforceability

- No common ownership *before* December 2011
- No common ownership *after* December 2011

Draper First Mistakenly Assigns Rights in '321 Patent to UNM in May 1996

JOINT ASSIGNMENT

Whereas (name, address) An-Shuang Chu - 3128 Don Quixote NW, Albuquerque, NM 87104; Bruce L. Draper - 7827 Pioneer Trail NE, Albuquerque, NM 87109; Steven R.J. Bruck - 5601 Cometa Court NE, Albuquerque, NM 87111 and Saleem Zaidi - 5358 San Mateo NE #74E, Albuquerque, NM 87109 (hereinafter referred to as "Assignors" or "inventors") are employees of the University of New Mexico (hereinafter referred to as "Assignee") have made a certain invention entitled METHOD FOR MANUFACTURE OF QUATUM SIZED PERIODIC STRUCTURES IN SI MATERIALS and further identified as UNM Docket No. UNM-322 for which a patent application was filed at the expense of the Assignees on September 20, 1995 in the United States Patent and Trademark Office. The patent application is identified as SN 08/123,543 filed on September 20, 1995.

Now, therefore, in view of the above premises and good and valuable consideration the receipt whereof is hereby acknowledged, Assignors do hereby sell, assign, and transfer unto Assignee all their right, title, and interest in and to the invention in the United States and in all foreign countries and their entire right, title, and interest in and to any and all Patents which may be issued thereon in the United States and in any and all foreign countries and in and to any and all divisions, reissues, continuations, and extensions thereof.

UNM Corrects the Mistake By Assigning Draper's Interest to Sandia National Labs in October 1996

Whereas The University of New Mexico, an educational institution of the State of New Mexico, having offices at 1805 Roma NE, Albuquerque, New Mexico 87131 (hereinafter referred to as "Assignor") was assigned all rights, title and interest in U.S. Patent Application Serial Number 08/123,543 by the inventors, one of which was Bruce L. Draper (hereinafter referred to as "Bruce Draper"), who at the time was employed by Sandia National Laboratories (hereinafter referred to as "Assignee");

Whereas, Assignor has determined Bruce Draper was and is an employee of Assignee and the assignment from Bruce Draper to Assignor was made in error,

the receipt whereof is hereby acknowledged, Assignor does hereby sell, assign, and transfer unto Assignee those rights and interests previously assigned to Assignor by Bruce Draper in the United States and in all foreign countries and to any and all Patents which may be issued thereon in the United States and in any and all foreign countries and in and to any and all divisions, reissues, continuations, and extensions thereof.

Sandia Had No Interest in the '998 Patent

The '998 Inventors assigned rights only to UNM in May 1997

JOINT ASSIGNMENT

Whereas Steven R.J. Brueck, 5601 Cometa Ct., NE, Albuquerque, New Mexico 87111, and Saleem Zaidi, 9813 Fostoria Road, NE, Albuquerque, New Mexico 87111 (hereinafter referred to as "Assignors" or "inventors") are employees of the University of New Mexico (hereinafter referred to as "Assignee") and have made a certain invention entitled "METHOD AND APPARATUS FOR EXTENDING SPATIAL FREQUENCIES IN PHOTOLITHOGRAPHY IMAGES" for which a patent

Now, therefore, in view of the above premises and good and valuable consideration the receipt whereof is hereby acknowledged, Assignors do hereby sell, assign, and transfer unto Assignee all their right, title, and interest in and to the invention in the United States and in all foreign countries and their entire right, title, and interest in and to any and all Patents which may be issued thereon in the United States and in any and all foreign

STC's Representations That It Is the Sole Owner of the '998 Patent

STC v. Intel Complaint November 2010

UNITED STATES DISTRICT COURT DISTRICT OF NEW MEXICO	
STC.UNM, Plaintiff, v. INTEL CORPORATION Defendant.	Civil No. _____
COMPLAINT	
The plaintiff, STC.UNM ("STC"), alleges in the afore-captioned matter as follows:	

3. STC is the owner by assignment of U.S. Patent No. 6,042,998, entitled "Method and Apparatus for Extending Spatial Frequencies in Photolithography Images" ("the '998 patent"), which issued on March 28, 2000. Exhibit A - '998 patent.

STC's Representations That

It Is the Sole Owner of the '998 Patent

STC v. Toshiba Complaint dated March 30, 2009

UNITED STATES DISTRICT COURT DISTRICT OF NEW MEXICO	
THE SCIENCE AND TECHNOLOGY CORPORATION OF THE UNIVERSITY OF NEW MEXICO,	
Plaintiff,	
v.	Civil No. 09-CV-310
TOSHIBA AMERICA ELECTRONIC COMPONENTS, INC. and TOSHIBA CORPORATION,	
Defendants.	
COMPLAINT	
The plaintiff, the Science and Technology Corporation of the University of New Mexico	

10. STC is the owner by assignment of U.S. Patent No. 6,042,998, entitled "Method and Apparatus for Extending Spatial Frequencies in Photolithography Images" (the "998 patent"), which issued on March 28, 2000. '998 patent at 1 (attached as Exhibit A).

Ferrall Decl. Ex. O

STC's Representations That It Is the Sole Owner of the '998 Patent

STC v. Samsung/TSMC Complaint dated June 23, 2010

UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C. 20436

In the Matter of
CERTAIN SEMICONDUCTOR PRODUCTS)
MADE BY ADVANCED LITHOGRAPHY)
TECHNIQUES AND PRODUCTS)
CONTAINING SAME)

Investigation No. 337-TA-__

COMPLAINT OF STC.UNM

UNDER SECTION 337 OF THE TARIFF ACT OF 1930, AS AMENDED

4. An uncertified copy of the '998 patent accompanies this Complaint as Exhibit 1.

STC owns by assignment the entire right, title, and interest in and to this patent. Uncertified copies of the recorded assignments for the '998 patent

Ferrall Decl. Ex. Q

STC's Representations That

It Is the Sole Owner of the '998 Patent

Petition to Correct Inventorship May 2008

PETITION TO CORRECT INVENTORSHIP UNDER 37 C.F.R. § 1.324

Pursuant to 35 U.S.C. § 256, and 37 C.F.R. § 1.324, Applicants petition for issuance of a Certificate of Correction to correct inventorship in the above-identified patent. Specifically, this petition seeks to add Steve Hersee and Kevin Malloy as inventors.

STATEMENT BY ASSIGNEE and 37 C.F.R. § 3.73(b) STATEMENT

Pursuant to 35 U.S.C. § 256, and 37 C.F.R. § 1.324(b)(3), this is a statement by assignee STC.UNM agreeing to the change of inventorship and establishing ownership under 37 C.F.R. § 3.73(b) of U.S. Patent No. 6,042,998.

- 1) STC.UNM is the assignee of the entire right, title, and interest of U.S. Patent No. 6,042,998.

Ferrall Decl. Exh. J

1/14/08
Date

Elizabeth J. Kurtila
Elizabeth J. Kurtila
President and CEO
STC.UNM

STC's Representations That It Is the Sole Owner of the '998 Patent

STC September 2008 Request for Certificate of Correction

Patent No.: 6,042,998

Issued: March 28, 2000

For: Method And Apparatus For Extending Spatial Frequencies In Photolithography Images

REQUEST FOR CERTIFICATE OF CORRECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I am the:
☐ Applicant/Inventor.

OR

☒ Assignee of record of the entire interest. See 37 CFR 3.71.
Statement under 37 CFR 3.73(b) (Form PTO/SB/98) submitted herewith or filed on _____

SIGNATURE of Applicant or Assignee of Record

Signature	Name	Date
<i>Elizabeth L. Knutla</i>	Elizabeth L. Knutla	9/15/08
	Title and Company	Telephone
	President and CEO of STCLMM	