
In April 1997, the University of South Florida (USF) received an invention disclosure related to a workstation-user interface for digital mammography. In September 1997, the inventors, USF and the USF Research Foundation (USFRF) entered into a revenue allocation agreement assigning all rights in the invention to USF. The inventors also entered into a separate assignment agreement in 2002. The patent issued in 2003. The revenue allocation agreement was later followed by a *nunc pro tunc* license
agreement, which recited an effective date of July 1997.

In May 2016, USFRF sued Fujifilm Medical Systems for infringement of the issued patent. USFRF pled that USF assigned its rights in the issued patent to USFRF such that USFRF was “currently the owner” of the patent. In June 2019, Fujifilm moved for summary judgment, arguing that USFRF lacked statutory standing because USF had not fully assigned the patent to USFRF. Five days later, USFRF amended its complaint to state that it was an exclusive licensee (i.e., it was not the assignee).

In May 2020, the district court dismissed the case, finding that USFRF lacked both statutory and constitutional standing. Analyzing the nunc pro tunc license agreement, the district court found a lack of statutory standing because the agreement was silent on (and thus did not transfer to USFRF) the right to sue to enforce the patent. The district court also found that USFRF lacked constitutional standing because USFRF had not established that the invention disclosure number in the license agreement corresponded to the issued patent and had not shown that the nunc pro tunc agreement was signed before the complaint was filed. USFRF appealed.

The Federal Circuit analyzed both statutory and constitutional standing and affirmed the district court’s finding with respect to statutory standing, reasoning that this case was analogous to others in which an exclusive licensee lacked statutory standing because the right to sue was either not transferred or only partially transferred. The Federal Circuit found that the district court had clearly erred with respect to constitutional standing, however. First, the Court held that there had been sufficient evidence tying the invention disclosure identified in the assignment agreement to the issued patent. Second, the Court found that it did not matter when the nunc pro tunc agreement was signed because the original revenue allocation agreement was signed before the complaint was filed and conveyed at least one exclusionary right to USFRF—enough for USFRF to have constitutional standing.

Because “the district court’s dismissal was predicated on constitutional standing,” the Federal Circuit remanded for further proceedings, including determination of whether USFRF may join USF.

Practice Note: The Federal Circuit might have used USFRF’s lack of statutory standing as a basis to affirm the district court’s dismissal (without prejudice) of the action, but it did not. Instead, it vacated and remanded with instructions to determine whether the necessary party could be joined. This appears to reflect a preference for allowing pleadings to be cured rather than requiring them to be re-filed. Practically, this operates as a benefit to the plaintiff, which may retain its filing date for the suit it brought notwithstanding its lack of a right to bring the suit.

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