2013 IL App (1st) 112894-U

THIRD DIVISION
June 26, 2013

No. 1-11-2894

IN THE
APPELLATE COURT OF ILLINOIS
FIRST DISTRICT

JACQUES M. DULIN, Plaintiff-Appellant, v. PRIVATE PALLET SECURITY SYSTEMS, LLC., a limited liability corporation, and ROGERS BRACKMANN, Defendants-Appellees.	)))))))))	Appeal from the Circuit Court of Cook County. No. 10 CH 35430 The Honorable Peter Flynn, Judge Presiding.

JUSTICE HYMAN delivered the judgment of the court.
Justices Sterba and Pierce concur in the judgment.

ORDER

¶ 1 Plaintiff, Jacques Dulin, sued to quiet title to defendants', Private Pallet Security, LLC., and Rogers Brackmann's[1], United States Patent Application Serial No. 11/962,084 and any resulting patent, claiming defendants concealed that they had applied for a patent on an invention of plaintiff's. The trial court dismissed the action for lack of subject matter jurisdiction.

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[1] The spelling of defendant Rogers Brackmann's first and last name differs throughout the record, appearing sometimes as Roger Brackman.

¶ 2 Dulin seeks reversal of the court's dismissal and remand with instructions that the trial court reinstate his case and set the matter for further proceedings, contending the trial court erred in finding his complaint concerned the inventorship of a patent, rather than the ownership of a patent.

¶ 3 We hold the trial court properly dismissed Dulin's complaint as moot because there was no longer an actual case or controversy between the parties where it is undisputed that the regular patent application had been abandoned and, therefore, Dulin is effectively seeking to be declared a co-inventor on a patent application that no longer exists. In addition, the trial court properly held that Dulin's claims, were they not moot, fell within the exclusive jurisdiction of the federal court.

¶ 4 BACKGROUND

¶ 5 Dulin is a registered patent attorney and inventor, having invented or co-invented 20 patents in the last 40 years, who lives in Washington. Since 1970, Dulin has worked with defendant Rogers Brackmann on a variety of projects, including various projects for defendant Private Pallet Security Systems. On December 20, 2006, Dulin prepared and filed a provisional application for patent on a mini-pallet box container and a related system used in maintaining forensic and legal evidence, titled "System for Maintaining Security of Evidence Throughout Chain of Custody." Dulin, Brackmann and others were named as inventors on the provisional application.

¶ 6 Dulin contends defendants[2] filed a regular U.S. patent application on the evidence integrity invention, with U.S. Serial No. 11/962,084 on December 20, 2007. Dulin alleges defendants failed to notify him that they filed the regular parent application or that they excluded him as an inventor in the application.

¶ 7 On August 17, 2010, Dulin filed his complaint to quiet title to the regular patent application and any U.S. patents that issued from that application. On August 30, 2011, the trial court granted defendants' motion to dismiss, finding it lacked subject matter jurisdiction and held the complaint concerned the inventorship, not ownership, of a patent application.

¶ 8 Dulin timely appealed.

¶ 9 ANALYSIS

¶ 10 Dulin contends the trial court erred in dismissing his complaint for lack of subject matter jurisdiction under section 2-619(1) of the Code of Civil Procedure. 735 ILCS 5/2-619(1) (West 2010).

¶ 11 Section 2–619 provides for the involuntary dismissal of a cause of action based on certain defects and defenses, including where "the claim asserted against defendant is barred by other affirmative matter avoiding the legal effect of or defeating the claim." 735 ILCS 5/2–619(a)(9) (West 2010). Our review of the dismissal of a complaint under section 2–619 is *de novo. Lacey v. Village of Palatine,* 232 Ill. 2d 349, 359 (2009).

[2] Rogers Brackmann and Private Pallet Security Systems will be collectively referred to as defendants throughout the decision. We will note any instance in which an individual defendant is the subject.

¶ 12 Dulin argues the trial court erred in finding it lacked jurisdiction to determine ownership of the regular patent application.

¶ 13 The trial court held it lacked subject matter jurisdiction for two reasons: (1) the action was moot because the regular patent application on which Dulin sought relief was abandoned and (2) Dulin's disputed and unresolved claim concerned inventorship of the patent, not ownership and, therefore, fell within the exclusive jurisdiction of the federal courts. The trial court reasoned that although Dulin's complaint is "framed as addressing the 'ownership' of the work described in the Regular Patent Application, Dulin's 'inventorship' is his only pleaded basis for claiming that ownership. Thus, deciding inventorship is essential to resolving plaintiff's claim." The trial court concluded that because the issue of inventorship was disputed, the federal courts had exclusive jurisdiction over the matter.

¶ 14 Mootness

¶ 15 Defendants contend Dulin ignores the issue of mootness as a consequence of the abandonment of the regulation patent application.

¶ 16 At the time of the court's ruling, the regular patent application, the subject of Dulin's complaint, was no longer pending before the United States Patent and Trademark Office, having been abandoned on December 9, 2010. Dulin recognized this fact in his response to defendants' motion to dismiss. Based on the abandonment, the trial court held Dulin's claims had become moot and, therefore, the trial court had no subject matter jurisdiction.

¶ 17 "The existence of an actual controversy is an essential requisite to appellate jurisdiction, and courts of review will generally not decide abstract, hypothetical, or moot questions." *In re*

Marriage of Nienhouse, 355 Ill. App. 3d 146, 149 (2004) (citing *Steinbrecher v. Steinbrecher,* 197 Ill. 2d 514, 523 (2001)). In other words, a moot case leaves no justiciable issue for the court to decide. An issue is moot if no actual controversy exists or events happen that make it impossible for the court to grant effectual relief. *Dixon v. Chicago and North Western Transp. Co.*, 151 Ill. 2d 108, 116 (1992). A claim that an alleged inventor should have been included on a patent application that no longer exists does not present an "actual controversy." Accordingly, on this basis alone, we hold this appeal should be dismissed.

¶ 18 Inventorship/Ownership Distinction

¶ 19 The trial court also dismissed Dulin's complaint for lack of subject matter jurisdiction finding it involved the disputed issue of inventorship, which raises a question of federal patent law under exclusive jurisdiction of the federal courts. In holding as it did, the trial court cited *HIF Bio, Inc. v. Yung Shung Pharmaceuticals Industrial Co.*, 600 F. 3d 1347 (Fed. Cir. 2010), and *Magnetek, Inc. v. Kirkland and Ellis, LLP*, 954 N.E.2d 803 (2011).

¶ 20 In *HIF Bio, Inc.*, the federal circuit court recognized that "[b]ecause inventorship is a unique question of patent law, the cause of action arises under § 1338(a)," which vests exclusive jurisdiction over the case in federal court. *HIF Bio, Inc.*, 600 F. 3d at 1353. In *Magnetek*, this court determined that whether the subject matter of a patent case falls under federal jurisdiction depends on "whether, based on the well-pleaded complaint, the state law claim necessarily raises a stated federal patent law issue, actually disputed and substantial, which the federal courts may entertain without disturbing any congressionally approved balance of federal and state judicial responsibilities." *Magnetek, Inc.*, 954 N.E.2d at 814.

¶ 21 According to Dulin, it was appropriate and necessary for the state court to exercise jurisdiction over this matter because his claims present no question relating to federal patent law. Dulin argues he filed suit in state court for a determination of his ownership rights, and not to void the patent or prevent defendants from using the patent.

¶ 22 Dulin relies on *Heath v. Zenkich*, 107 Ill. App. 3d 207 (1982), and *Shoup v. Shoup Mfg. Inc.*, 2010 WL 3724765 (C.D. Ill.), for his contention that the state court has jurisdiction to decide his ownership rights. Dulin contends that similar to the facts of *Heath*, he filed suit in state court "simply seeking a determination of his rights, independent of Federal patent law and appropriately within the state's jurisdiction." Dulin contends *Shoup*, a federal case, further supports his position. In *Shoup*, the district court, finding it did not have jurisdiction over certain claims that were related to the appellant's ownership of patents, stated, "determination of ownership is a state issue and not sufficient to establish original jurisdiction." *Shoup*, 2010 WL 3724765. But, there is no inventorship issue in *Shoup* and, thus, we find the case inapposite.

¶ 23 In *Heath*, the plaintiff worked on an invention of two medical devices with the defendants, as well as the provisional patent application. The plaintiff was originally included as an inventor in the provisional patent application, but later excluded when the defendants filed a non-provisional patent application with the U.S. Patent Office. After finding out, the plaintiff filed suit in the state court for determination of his ownership rights. *Heath*, 107 Ill. App. 3d at 208-09. On appeal, this court reversed the trial court's determination that it did not have jurisdiction, holding, "we view plaintiff's claim to be one for the determination of his rights which inure to him by virtue of his claimed inventorship and, accordingly, jurisdiction properly

rests in state courts." *Heath*, 107 Ill. App. 3d at 211. Dulin argues he seeks the same relief as the plaintiff did in *Heath* and, therefore, applying the rationale of *Heath*, this court has jurisdiction to decide his ownership rights.

¶ 24 Defendants contend Dulin's complaint is predicated on his contention that he was a co-inventor of the evidence integrity invention due to the improvements and modifications he claimed he made, as well as the inclusion of his name as one of the inventors on the provisional patent application. As such, defendants argue Dulin's allegations necessarily raise a disputed federal patent law issue under exclusive federal jurisdiction because Dulin's alleged inventorship was the only basis for any ownership interest he could have claimed in the patent application.

¶ 25 We agree with defendants that the trial court properly held that "deciding inventorship is essential to resolving plaintiff's claim" and because "inventorship issues, if actually disputed, fall within the exclusive jurisdiction of the Federal courts" (citing *HIF Bio, Inc.*, 600 F. 3d at 1353), the trial court lacked subject matter jurisdiction to hear this case.

¶ 26 Leave to Amend

¶ 27 Lastly, Dulin contends he should have been allowed to amend his complaint, arguing the information he needed "was in the custody and control" of defendants. We find Dulin's claim insincere. Dulin neither requested leave to amend his complaint, nor did he raise any related issues before the case was dismissed. In addition, he offered no basis to allow his complaint to be amended by, for instance, identifying information that if he had could have undermined the trial court's ruling.

¶ 28 CONCLUSION

¶ 29 Assuming the regular patent application had been pending at the time of Dulin's complaint, his claims strictly concerning inventorship implicate issues of federal patent law. Accordingly, the circuit court judge properly determined the lack of subject matter jurisdiction.

¶ 30 Despite Dulin's contention to the contrary, because the patent application was abandoned, the claims raised in Dulin's complaint present no actual controversy and, therefore, we dismiss this appeal as moot.

¶ 31 Appeal dismissed.