



UNIVERSITY OF  
MARYLAND  
SCHOOL OF LAW

**PATENT LAW  
UPDATE**

***Univ. of W. Va.  
v. VanVoorhies***

No. 02-1533  
Federal Circuit  
Sept. 3, 2003

*“Under Rule 70, the trial court may order the performance of specific acts by a third party on behalf of a disobedient party [i]f a judgment directs a party . . . to perform any other specific act and the party fails to comply within the time specified.”*

On September 3, 2003, the Federal Circuit reversed the district court’s denial of VanVoorhies’ motions for relief from an order requiring the assignment of certain patents to the University. The patented technology related to contrawound toroidal helical antennas. The Federal Circuit stated:

This appeal requires that we determine whether the district court properly denied VanVoorhies’s motion for relief under Rules 59 and 60. . . . Under Rule 70, the trial court may order the performance of specific acts by a third party on behalf of a disobedient party “[i]f a judgment directs a party . . . to perform any other specific act and the party fails to comply within the time specified.” According to VanVoorhies, the district court improperly acted under Rule 70, because he has faithfully complied with the district court’s mandate by enclosing with his correspondence dated April 29, 2002, assignments mirroring the language of the May 25 Order. The University rejoins that the assignments prepared by VanVoorhies violated the May 25 Order by omitting three patents already adjudged to be the University’s property: U.S. Patent Nos. 6,218,998, 6,239,760, and 6,320,550 (collectively, “the second generation patents”). [T]he dispositive question for this appeal is whether VanVoorhies was required to assign the second generation patents to the University. . . .

The original assignment of the ‘970 Application does not compel the inventor to assign his rights in the second generation patents to the University. [T]he assignment agreement only covers the exact invention embodied by the ‘970 Application; its reissues or extensions; and its immediate lineal descendants, including divisionals, continuations, continuations-in-part, or substitute applications. [T]he second generation patents do not fall into any of those covered categories, and are therefore outside of the scope of the assignment agreement. . . .

Similarly, the University patent policy cannot presently form the basis of VanVoorhies’s obligation to assign the second generation patents. That patent policy “applies to any invention conceived or first reduced to practice under terms of contracts, grants or other agreements,” and provides that the University “owns all inventions that are made by University personnel or made with substantial use of University resources.” But whether or not the second generation patents fall within the scope of the patent policy remains to be decided, since they were not part of the original litigation. [The University’s] assertion of ownership rights over the second generation patents based on the patent policy has yet to be adjudicated on the merits. . . .

On remand, the trial court must restore the status quo ante litem motam while it considers again the merits of the University’s Rule 70 motion. As a result of the improper denial of the motion for relief from the improvidently granted Rule 70 Order, the University has obtained ownership of the second generation patents and, on that basis, recorded the assignments with the PTO on July 11, 2002. However, the University has yet to establish that either the May 25 Order or its patent policy gives it ownership over those patents. Until it does so, those patents remain VanVoorhies’s personal property.