NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

TUBE-MAC INDUSTRIES, INC., GARY MACKAY, DAN HEWSON,
Plaintiffs-Appellees

v.

STEVE CAMPBELL,
Defendant-Appellant

TRANZGAZ, INC.,
Defendant

2022-2170

Appeal from the United States District Court for the Eastern District of Virginia in No. 2:20-cv-00197-RCY-LRL, Judge Roderick C. Young.

Decided: March 15, 2024

LYNN J. ALSTADT, Buchanan Ingersoll & Rooney PC, Pittsburgh, PA, for plaintiffs-appellees. Also represented by RALPH GEORGE FISCHER.

STEVE CAMPBELL, St. John's, NL, Canada, pro se.

Before LOURIE, HUGHES, and STARK, *Circuit Judges*.

PER CURIAM.

Steve Campbell appeals from a decision and accompanying order of the United States District Court for the Eastern District of Virginia mandating the correction of inventorship of U.S. Patent 9,376,049 (the "'049 patent"), as well as several corresponding foreign patents, to add Gary Mackay and Dan Hewson as named inventors. *Tube-Mac Indus., Inc. v. Campbell*, 616 F. Supp. 3d 498 (E.D. Va. 2022) ("*Decision*"). For the following reasons, we *affirm*.

BACKGROUND

Campbell was the original, sole inventor named on the '049 patent, which claims a container for transporting gaseous fluids. *Decision* at 506–07. Independent claim 1 is presented below:

> 1. A lightweight intermodal container or road trailer based system for transporting refrigerated gaseous fluids, comprising:
>
> an enclosed and insulated transportation housing;
>
> a plurality of low-temperature resistant pressure vessels at least three feet in diameter secured within said transportation housing for containing said gaseous fluids, each of said pressure vessels including a body portion and opposing domed end portions attached to said body portion, each of said domed end portions having a wall thickness that is greater than a wall thickness of said body portion and an opening; and
>
> at least one port boss affixed to each of said domed end portions, said at least one port boss including an inner component and an outer component, said inner component including an inner pipe and an inner plate transversely extending from said inner

> pipe, and said outer component including an outer pipe and an outer plate transversely extending from said outer pipe, wherein said inner pipe is inserted through said opening in each of said domed end portions and through said outer pipe such that said inner component and said outer component are compressed together to cause said inner plate to engage an inner surface of a respective one of said domed end portions and said outer plate to engage an outer surface of said respective one of said domed end portions to affix said at least one port boss to each of said domed end portions.

'049 patent, col. 12 l. 43–col. 13 l. 3 (emphases added).

Campbell originally contracted with Composites Atlantic Ltd. ("Composites Atlantic") to assist in fabrication of the claimed transportation vessels. *Decision* at 503. However, the resulting prototypes suffered from numerous problems, including slippage of the port boss on the vessel's liner. *Id.* The port boss is essentially a nozzle comprising a male inner component compressed against a female outer component, which together sandwich the liner of the vessel that contains the gas to be transported. *See* '049 patent, col. 5 ll. 5–49; *see also id.* at FIG. 8 (female plate 40 compressed with male plate 36, sandwiching liner 44).

Campbell then approached Gary Mackay to help fix the port boss/liner slippage problem. *See Decision* at 504; *see also* A.A.[1] 252. Dan Hewson, the Vice President of Projects at Mackay's company Tube-Mac Industries Ltd., subsequently provided preliminary design drawings to Campbell. *Decision* at 504. Over the next several months, Campbell, Mackay, and Hewson continued to exchange draft designs and components engineered to improve the port boss design. *Id.* at 504–06.

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[1] A.A. refers to the appendix filed by Appellees.

After issuance of the '049 patent, Mackay and Hewson brought an action contending that they should have been listed as co-inventors, as their contributions to the design process were described and claimed in the patent. *Decision* at 502. The district court agreed and subsequently ordered the U.S. Patent and Trademark Office to issue a certificate of correction adding Mackay and Hewson as named inventors on the '049 patent. A.A. 1–2. Campbell appealed.

We have jurisdiction under 28 U.S.C. § 1295(a).

DISCUSSION

We review inventorship disputes *de novo* and the underlying findings of fact for clear error. *Blue Gentian, LLC v. Tristar Prods., Inc.*, 70 F.4th 1351, 1358 (Fed. Cir. 2023). Under the clear error standard, factual findings "will not be overturned in the absence of a definite and firm conviction that a mistake has been made." *Impax Lab'ys, Inc. v. Aventis Pharms. Inc.*, 468 F.3d 1366, 1375 (Fed. Cir. 2006) (internal quotation marks and citation omitted).

Under 35 U.S.C. § 256, a district court may order the correction of inventorship of a patent once it determines that a co-inventor has been erroneously omitted. Evaluating an inventorship claim under § 256 begins with "a construction of each asserted claim to determine the subject matter encompassed thereby." *Trovan, Ltd. v. Sokymat SA*, 299 F.3d 1292, 1302 (Fed. Cir. 2002). The alleged contributions of each asserted co-inventor are then compared with "the subject matter of the properly construed claim to then determine whether the correct inventors were named." *Id.* "The named inventors are presumed correct, and the party seeking correction of inventorship must show by clear and convincing evidence that a joint inventor should have been listed." *Blue Gentian*, 70 F.4th at 1357 (citing *Eli Lilly & Co. v. Aradigm Corp.*, 376 F.3d 1352, 1358 (Fed. Cir. 2004)).

To be a joint inventor, one must:

> (1) contribute in some significant manner to the conception or reduction to practice of the invention, (2) make a contribution to the claimed invention that is not insignificant in quality, when that contribution is measured against the dimension of the full invention, and (3) do more than merely explain to the real inventors well-known concepts and/or the current state of the art.

Pannu v. Iolab Corp., 155 F.3d 1344, 1351 (Fed. Cir. 1998). Although the district court here wrote generally of Mackay and Hewson's "[c]ontribution to [c]onception or [r]eduction to [p]ractice," *Decision* at 510 (alterations to punctuation added), it focused its analysis on the alleged joint inventors' contributions to conception; we will do the same.

The contribution of a joint inventor must be significant. *See Fina Oil & Chem. Co. v. Ewen*, 123 F.3d 1466, 1473 (Fed. Cir. 1997) ("[A] joint inventor must contribute in some significant manner to the conception of the invention."). We review a district court's finding as to the significance of a purported joint inventor's contribution for clear error. *See Plastipak Packaging, Inc. v. Premium Waters, Inc.*, 55 F.4th 1332, 1343 (Fed. Cir. 2022) ("[O]ften the assessment of what contribution has been made by a purported inventor, and whether that contribution is significant, is bound up with material fact disputes which a reasonable factfinder could resolve in favor of either party.").

Campbell first argues that the district court erred in determining the scope of the subject matter of the claims. But Campbell misunderstands the first step of the inventorship analysis as well as the analysis conducted by the court. The court correctly began with "an independent claim construction analysis, which is the first step in determining inventorship." *Trovan*, 229 F.3d at 1304. As explained by the court, neither party requested claim

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