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1. Name of conveying party(ies)/Execution Date(s):
Michel PUECH

Execution Date(s): 9/10/04

Additional name(s) of conveying party(ies) attached? ☐ Yes ☐ No

3. Nature of Conveyance:

- ☐ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Government Interest Assignment
☐ Executive Order 9424, Confirmatory License
☒ Other French Court Decision requiring Assignment of patent

2. Name and address of receiving party(ies)

Name: Centre National de la Recherche Scientifique

Internal Address: _____

Street Address: _____

3, rue Michel-Ange
75794 Paris Cedex 16
FRANCE

City: _____

State: _____

Country: _____

Zip: _____

Additional name(s) & address(es) attached: ☐ Yes ☒ No

4. Application or patent number(s):

A. Patent Application No.(s)
10/981,727☐ This document is being filed together with a new application.B. Patent No.(s)
6,837,855 B1

Additional numbers attached?

☐ Yes ☒ No

5. Name and address to whom correspondence concerning document should be mailed:

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6. Total number of applications and patents involved:

2

7. Total fee (37 CFR 1.21(h) & 3.41) \$ 80.00

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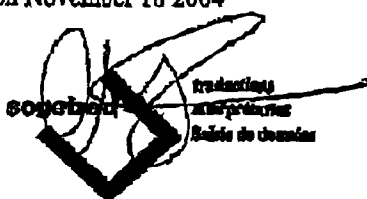
TRANSLATION CERTIFICATE

We, SOGETRAD SARL - 21 rue Royale, F-75008 PARIS, hereby certify and attest that this translation was made by a translator whose native tongue is English, and who has a perfect knowledge of the French language, and that this translation is true and sincere as far as he knows,

AND

we make this declaration conscientiously believing the statement contained herein to be true in every particular.

Signed in Paris, France
on November 18 2004


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COURT OF APPEAL OF PARIS

4th division, section B

DECISION OF SEPTEMBER 10, 2004

(N° , 10 pages)

Entry number in the case list: 2002/12276

Decision referred to the Civil Judgment rendered on April 2, 2002 by the REGIONAL COURT OF PARIS
(Tribunal de Grande Instance), 3rd Division. Case list: 2000/12782

APPELLANT:

THE CNRS
CENTRE NATIONAL DE LA RECHERCHE SCIENTIFIQUE (NATIONAL CENTRE FOR SCIENTIFIC
RESEARCH)

A public institution of science and technology
brought into the proceedings through the person of its legal representatives,
the registered office of which is located at 3, rue Michel Ange
Paris 75015

represented by SCP BAUFUME & GALLAND, solicitor,
Assisted by Mr. Pierre VERON, barrister

APPELLANT:

Ms. Genevieve BERGER
residing at 11, rue Charpentier
92340 Boulogne-la-Peinture

represented by SCP BAUFUME & GALLAND, solicitor,
assisted by Mr. Pierre VERON, barrister

APPELLANT:

Mr. Antoine SAIED
residing at 3, rue Fagot
75015 Paris

represented by SCP BAUFUME & GALLAND, solicitor,
assisted by Mr. Pierre VERON, barrister

[Seal - Clerk's Office of the Court of
Appeal of Paris - Copy issued 2004/9
for information]

Court of Appeal of Paris
4th division, section B

Case list: 2002/12276
10/9/2002

APPELLANT:

Mr. Pascal LAUGIER
residing at 93, rue Nollet
75017 Paris

represented by SCP BAUFUME & GALLAND, solicitor,
assisted by Mr. Pierre VERIN, barrister

RESPONDENTS:

Mr. Michel FURCH
residing at 14, avenue de Bercy
75007 Paris,

represented by SCP BOMMART-FORSTER, solicitor,
assisted by Mr. Yves MARCELLIN, barrister at the Bar of Paris D 426,

MEMBERS OF THE COURT:

Pursuant to the provisions of article 714 of the New Code of Civil Procedure, the case was argued on June 18, 2004 before Mr. PEZARD, the reporting judge, in public hearing as the barristers did not object.

The aforesaid judge reported the arguments for decision of the Court comprised of

Mr. PEZARD, presiding judge
Mr. REONTEZ, judge
Mr. MARCIN, judge

THE CLERK during the proceedings: L. MALTEBRE-PAYARD

DECISION

- Inter partes;
- Adjudicated in public hearing before Mr. PEZARD, presiding judge;
- Signed by Mr. PEZARD, presiding judge and by L. MALTERRE-PAYARD, the clerk attending the adjudication.

The CNRS, a public institution of sciences and technology, lodged an appeal to the Court against an *inter partes* judgment rendered by the Regional Court of Paris (*Tribunal de Grande Instance*) on April 2, 2002, which judgment:

- dismissed the claims of the CNRS, Mr. BERGER, Ms. SAIED and Mr. LAUGIER;
- ordered the CNRS to pay Mr. PUECH the sum of 155,000 euros as damages and interest as a result of this abusive proceeding and the prejudice brought to him on Mr. PUECH;
- ordered the CNRS to pay Mr. PUECH the sum of 7,700 euros pursuant to article 700 of the New Code of Civil Procedure and to pay the court costs;
- applied article 609 of the New Code of Civil Procedure in favour of Mr. Yves-Marcelin, barrister, regarding the share of the costs that he advanced without having receiving prior provision thereon;

It is of crucial importance to state that Mr. PUECH, ophthalmologist, attended a training course from September 1996 to July 1997 without remuneration at the LIP-CNRS laboratory under the responsibility of Ms. SAIED, Head of Research at the CNRS, the purpose of this course being to study improvements that could be made in the examination of the eyeball by using high frequency echography devices. During these experiments it appeared that by using an echography device of high frequency, it was possible to obtain high resolution images not only of the eyeball's anterior chamber, which was already known, but also of the eyeball's posterior segment, which was new. These researches were the subject of a dissertation done for a postgraduate degree entitled: "Application of echography of 20 to 30 Mhz for exploration of the human eyeball's posterior segment" defended by Mr. PUECH on September 18, 1997 at the Technology University of Compiègne. Mr. PUECH filed a patent application for this invention.

The Centre National de la Recherche Scientifique (National Centre for Scientific Research) (CNRS) remunerated Mr. PUECH for the share of ownership in the patent applications n° 9716071 and PCT 9802788.

In their later submissions served on June 16, 2004, the CNRS, Mr. BERGER, Ms. SAIED and Mr. LAUGIER, the appellants, requested the Court to:

- Rule that the internal rules of the LIP are an administrative document which is imposed *ex tunc* on all users of this administrative department, and that Mr. PUECH was one of such users;
- Rule that, whenever the issue, the courts of law lack jurisdiction to declare these internal rules illegal or to refuse the application thereof;
- Find and hold that the filings in the name of Mr. PUECH of the applications for French patents n° 97 16071 and PCT n° 98 02788 were made in disregard of the CNRS's rights;
- admit the CNRS' claim of ownership of French patents n° 97 16071 and PCT n° 98 02788;

* | -hold that the CNRS shall impute Mr. PUECH to the ownership of French patents n° 97 16071 and PCT n° 98 02788 and of all foreign patents deriving from said claims;

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-hold that Mr. BERGER, Mr. SAIED, Mr. LAUTNER and Mr. FUECH shall be designated as the inventors in said patents, unless Mr. FUECH declares that he does not want to appear therein;

-order Mr. FUECH to pay the CNRS the sum of 150,000 euros in redress of the injury incurred which is proportionate to his misconduct, of which he is today aware, unless said amount needs to be supplemented on the day that the CNRS can effectively claim ownership of the disputed patents;

-uphold any further demand that the CNRS may make of Mr. FUECH in redress of the totality of the injury that may subsequently appear;

-order Mr. FUECH to pay Mr. BERGER, Mr. LAUTNER and Mr. SAIED each the sum of 1 euro for damages and interest for infringement of the non-pecuniary right of inventor;

-for summary application of article 92 of the New Code of Civil Procedure, declare its lack of jurisdiction in ruling on Mr. FUECH's counterclaim for damages and interest, since said claim does not fall within the jurisdiction of courts of law;

-alternatively, reject this claim for lack of a legal basis;

-order Mr. FUECH to pay the sum of 20,000 euros pursuant to the provisions of article 760 of the New Code of Civil Procedure and to pay the procedural costs;

In his later submissions served on June 14, 2004, Mr. FUECH, the respondent, requested the court to:

-find that Mr. FUECH is the sole author of the dissertation produced for a postgraduate degree entitled: "Application of echography of 20 to 30 MHz for exploration of the human eyeball's posterior segment";

-find that the letters patent filed by Mr. FUECH, inventor, reproduce said dissertation;

-hold that Mr. FUECH is the sole inventor of the invention covered by patent n° 97 16071 and that, consequently, in the absence of contractual or legal provisions to the contrary, he is the sole owner of said letters patent;

-consequently, declare that the CNRS's action in claim ownership in said letters patent and in its extension, PCT, as well as all of its other actions, applications and allegations, lack grounds, are inadmissible and shall be dismissed;

Consequently,

-affirm all of the provisions of the judgment, but with an increase in the amount of damages and interest awarded to Mr. FUECH and, pursuant to his counterclaim, order the CNRS to pay Mr. FUECH the sum of 650,000 euros in redress of the non-pecuniary and pecuniary injury he has suffered as a result of this manifestly abusive proceeding and of the wrongful conduct of the CNRS which brought possession to bear on Mr. FUECH to the extent that he resigned/ was dismissed from the Ophthalmology Department at the Hôtel Dieu, and which prevented Mr. FUECH from negotiating with the Quinzel Medical Company as well as with the Fumidian Company or other companies;

-alternatively, find that the internal labour rules of the IIP lack standing to govern the legal situation of the inventor, Mr. FUECH, whose right to file letters patent concerning his invention derives only from the provisions of Article L. 511-5 of the Intellectual Property Code, since he is not an employee or a public agent of the CNRS;

-find that Mr. FUECH was not bound by any status or contract with the CNRS;

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-further, find that the agreements binding the Pierre et Marie Curie University to the CNRS do not entail a right for the CNRS to bring an action to claim ownership of letters patent in the name of said University;

-consequently, hold that the CNRS' action claiming that it alone is the owner of Mr. PUECH's letters patent, is inadmissible.

-order the CNRS to pay Mr. PUECH the sum of 10,000 euros pursuant to article 700 of the New Code of Civil Procedure and all of the costs of the proceedings below and of appeal.

THREEFORE

Regarding the authorship of the invention which is the subject of patent n° 97 146971 of December 15, 1997

Considering that the appellants allege that they have the status of inventors along with Mr. PUECH;

That, contrary to his assertions, Mr. PUECH never participated in the experiments made by the LIP in the context of a research programme regarding an echography of corneal implants conducted in cooperation with Hôpital-Dieu;

That he visited the LIP only in December 1994, accompanied by Professor Legrand for whom he was working during his studies at Hôpital-Dieu, since the Hôpital-Dieu's Ophthalmology Department wanted to develop, along with the LIP, a research programme regarding a qualitative cornea diagnosis by way of high-frequency echographies and regarding the surveillance of injected implants;

That Mr. PUECH participated only as a technician and for the purpose of defining the needs of echoplates, and only at the stage of the meetings held in the middle of 1996 between the LIP and the B.V.I. company in order to determine the development specifications of a prototype for a specific echography.

That his training session at the LIP lasted from March to July 1997;

That Ms. SAIED, Mr. LAUDER and Mr. BERGER asked the DASSAULT company for the loan of two probes at the end of February 1997, as Mr. PUECH was conducting tests during his training;

That it was during the meetings held at the end of September and on October 20, 1997 in the context of the LIP-Hôpital-Dieu cooperation programme for the construction of a prototype - and of its industrialization by the B.V.I. company - that the idea was raised of expanding the programme to the development of a prototype for an echography of the eyeball's anterior and posterior segments by integrating the perimeters of a long focal probe, as well as the idea of increasing the value of his work by filing a patent application specifying Ms. SAIED, Mr. PUECH, Mr. LAUDER and Mr. BERGER as co-inventors;

That Ms. SAIED prepared a text that was supposed to be of assistance in the drafting of the text of the patent application, which she transmitted to a consulting firm specialized in industrial property and to Mr. PUECH;

That the initial tests of the Dassault probes were conducted by Ms. SAIED on April 11 and 24, 1997;

That the development of the invention (completed, in its entirety, as soon as the loan for the Dassault probes was requested) which consists of using a high-frequency and long focal echography probe for exploration of the posterior segment of the eyeball and, particularly, of the retina, was confirmed as of June 11, 1997, even before Mr. PUECH conducted the last experiment in the context of his training;

That these experiments could not be accomplished by Mr. PUECH alone (since the experiments had requires particular technical skills, and the calculations to analyse signals are developed by others);

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That the credit for the idea of using a high-frequency and long focal ophthalmography probe for exploration of the eye's posterior segment, and the development of this utilization go to Mr. BERGER, Mr. SAIED and Mr. LAUGER;

That, consequently, the appellants' inventive contribution involves not only the "simple provision of means or advice" as considered by the Court, but also the principle of the invention itself and its development;

However, considering that, by virtue of article L. 611-3 of the Industrial Property Code, it is up to the party that claims ownership of a title pursuant to said provision to provide proof of its status as the inventor or of the breach of the obligation it invokes;

That the appellants do not provide proof of their status as the inventor;

That, indeed, an statement facts established by Mr. BERGER on August 20, 1996, states that she had known Mr. PUECH for a year and that he was effectuating a "collaboration in high-frequency ophthalmography imaging";

That it is not contested that Mr. PUECH participated in several meetings in June and July 1996 as well as on January 7, 1997 in the presence of a few researchers of the CNRS and of managers of companies such as Quantel Medical and Biotect, for the purpose of developing and marketing a high frequency device designed for the anterior segment;

That Mr. PUECH pursued his work at the L.I.P. from September 1996 in the context of his postgraduate degree, the dissertation subject of which is "In Vivo Transfer of ophthalmologists for characterization of eye vessels by high frequency ophthalmography" ("Transfert in vivo des ophtalmologistes de caractérisation de vaisseaux oculaires par échographie de haute fréquence");

That, while using transducers used, especially, a parametric probe focused at 25 mm, it was "by accident" that he observed that this utilization could be efficient for the eye's posterior segment, and that he re-orientated his dissertation to the high frequency retinal exploration;

That the appellants have not produced in the grounds of appeal, or in the proceedings below, any element to demonstrate that this re-orientation was made on the recommendations of Mr. BERGER, Mr. SAIED or Mr. LAUGER;

That merely the loan of Dossat probes at Mr. SAIED's request is insufficient to prove that the contribution to the invention, insofar as no document can establish the purpose at the time of the probes in question;

That, in addition, the letter that Mr. SAIED had sent to the consulting firm specialized in industrial property, purportedly to assist in the drafting of the text of the patent application, is not provided to the proceedings;

That it is inappropriate to take into account the votes in the computer files transmitted by the parties when the court is in the process of deliberation.

That it was for just and relevant reasons, which the Court adopts, that the court below considered that the personal contribution of Mr. BERGER, Mr. SAIED and Mr. LAUGER to the invention, which is the subject of the disputed patent, was not established, since a simple provision of means or advice is not sufficient to prove a status of co-inventor;

Regarding the ownership of the application for invention n° 9718071 and PCT filed by Mr. PUECH and PCT

Considering that the respondent alleges that he is not subject to the internal rules of the L.I.P. since it would be contrary to the provisions applicable to that regime specified in articles L. 132-34 and L. 122-35 of the Labor Code; that, as a further argument, he points out that the agreements binding the Pierre et Marie Curie University to the CNRS do not provide a right for it to bring an action to claim ownership of letters patent in the name of said University;

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But, considering that Mr. PUECH participated in the developments of the invention when he was attempting working at the I.L.P.;

That the I.L.P. is a laboratory of the CNRS, a national public institution of science and technology which is responsible for fulfilling assignments of the administrative public service;

That Mr. PUECH is a user of the public administrative service performed by the CNRS via the laboratory;

That the user of an administrative public service, such as Mr. PUECH, is subject to the internal rules imposed by the head of department, the authority that defines the conditions of organization and operation of this service;

That he must abide by those internal rules and their modifications; he can contest only the provisions thereof that he finds abusive in the context of the assignment given to the head of department;

That the internal rules of service are distinct from the internal rules specified by article L 225-35 and those that follow of the Labour Code, the scope of which is to govern only the relationships in respect to labour law and not those between an administrative public service and its users;

Therefore, article 3 of "Internal Industrial Rules at the parasitic drug laboratory" is applicable to Mr. PUECH, who subscribed to these rules with his signature;

That they provide:

"If work performed results in the development of manufacturing processes or techniques susceptible of being patented, the patent, knowledge or computer developments shall be the property of CNRS".

That, unlike property rights which governmental regulations provide to public agents, it is legitimate that students who participate in an invention do not participate in its pecuniary fruits;

That Mr. PUECH is the user of a public service; that he attends courses at the University of Compiègne as well as at the I.L.P. and benefits from the facilities of this laboratory and from the work of all of the technical staff; that Mr. PUECH will also receive a university degree, with his name designated in the patent in which he participated;

That, in addition, even if Mr. PUECH signed these rules only on May 22, 1997, which was after realization of his invention, they are rules of service that are imposed on him as a user of the I.L.P.;

That the judges below erroneously stated that the rules could not involve the disputed invention since Mr. PUECH was able to use the Damsalt probe as of March 1997;

That the above observations demonstrate that the applications for French patents n° 97 16071 and PCT n° 98 02788 filed by Mr. PUECH are the property of the CNRS; that, consequently, the CNRS has good grounds for bringing an action to claim ownership in its own name; that the CNRS shall replace Mr. PUECH as the owner of French patents n° 97 16071 and PCT n° 98 02788 and of all foreign patents deriving from this application; that the judgment dismissing the action to establish the ownership of the CNRS, M. BERGER, M. SAÏED and M. LAUDIER, shall be reversed;

Regarding the damages incurred by the CNRS

Considering that the appellants allege that Mr. PUECH illegitimately appropriated to himself an invention, which caused serious damage to the CNRS;

But considering that Mr. PUECH might in good faith have misinterpreted the scope of his rights as inventor, that the appellants' claim based on damage shall be rejected on such ground;

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Regarding the damages claimed by Mr. PUECH

Considering that article 1.413-17 of the Intellectual Property Code gives jurisdiction to ordinary courts when the issues in question involve "all of the litigation derived from the present claim"; that, consequently, the claim for damages and interest brought by Mr. PUECH is admissible;

However, considering that, since the Court admitted the CNRS' action to establish ownership, Mr. PUECH has no basis for claiming any damage resulting from said action; that the claim for damages and interest brought by Mr. PUECH shall be dismissed; that the judgment ordering the CNRS to pay Mr. PUECH 150,000 euros as damages and interest shall be set aside;

Considering that equity does not require it, indemnity pursuant to article 700 of the New Code of Civil Procedure shall not be awarded;

That each party shall cover its own procedural costs;

ON THESE GROUNDS

Set aside the appealed judgment except for the award to Mr. PUECH of the authorship of the invention, which is the subject of patent n° 97 16071 and PCT n° 98 02783, and declare his claim for damages and interest inadmissible;

By further ruling:

Hold that the CNRS shall replace Mr. PUECH as the owner of patent n° 97 16071 and PCT n° 98 02783 and of all foreign patents resulting from said application;

Hold that Mr. PUECH shall be designated the inventor of said patents;

Set aside all other claims;

Hold that each party shall cover its own procedural costs;

THE CLERK
[signature]

THE PRESIDING JUDGE
[signature]

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