



## **INTRODUCTION**

1. FSURF brings this action to seek redress for Defendant's unauthorized taking and use of FSURF's academic research on linear actuator technologies.

2. SentiMetal LLC, and its president Richard Hutchins ("Hutchins"), sought out and engaged FSURF to conduct modeling and simulation research on linear actuators and to develop novel linear actuator designs.

3. FSURF was to own all inventions that resulted from the research, and Defendant was required to submit to FSURF any potential publications of the research results prior to publication thereof.

4. Defendant, however, claimed FSURF's research as its own via United States Patent Nos. 10,774,696 and 10,601,293 (individually the '696 Patent and '293 Patent, collectively the Patents-in-Suit), where Hutchins is listed as the sole inventor of the '696 Patent and Hutchins and Joseph Scott Rust ("Rust") are listed as joint inventors of '293 Patent, which disclose and claim subject matter FSURF's researchers had previously conceived, reduced to practice, and disclosed via various reports and updates in connection with FSURF's academic research.

5. Defendant's acts have resulted in erroneous inventorship of the Patents-in-Suit, and in Defendant's unauthorized exploitation of, and dominion over, FSURF's intellectual property.

6. The facts will demonstrate that FSURF researchers, who have assigned their rights as inventors to FSURF, are inventors of subject matter claimed in the Patents-in-Suit. Accordingly, the Patents-in-Suit should be corrected to identify their true inventors. Furthermore, because Defendant SentiMetal LLC is the assignee of the Patents-in-Suit solely because Rust and/or Hutchins's incorrect status as alleged inventor(s), the assignments from Rust and/or Hutchins to SentiMetal LLC and/or SentiMetal Inc, and the assignments between SentiMetal LLC and SentiMetal Inc., also must be reversed and FSURF named the assignee of the Patents-in-Suit.

7. FSURF will provide Hutchins and Rust of notice of this action proximate its filing, via FSURF's provision to them of copies of this complaint via federal express, such that they will have the opportunity to be heard, should they desire.

### **PARTIES, JURISDICTION, AND VENUE**

8. Plaintiff FSURF is a Florida not-for-profit corporation, and a direct-support organization of Florida State University ("FSU"), located at 2000 Levy Avenue, Suite 351, Tallahassee, Florida 32310. FSURF serves as the principal conduit for the Office of Commercialization, whereby the products of FSU's research are made available to the marketplace. FSURF is the assignee of FSU's Intellectual Property (IP), and therefore, is the fiscal agent for all activities with respect to the commercialization of the IP.

9. Dr. Edrington is an individual that was, at all times material hereto, an associate professor of electrical and computer engineering at FSU and associate director of FSU's Center for Advanced Power Systems in Tallahassee, Florida. Dr. Edrington is currently the Warren H. Owen Distinguished Professor of Electrical and Computer Engineering at Clemson University and a resident of the state of South Carolina. Dr. Edrington was the lead researcher for the linear actuator research FSURF performed for SentiMetal.

10. Members of Dr. Edrington's research team included Dr. David Gonsoulin (Dr. Gonsoulin), Dr. Dallas Perkins (Dr. Perkins), and Dr. Hesam Vahedi (Dr. Vahedi) (Dr. Edrington, Dr. Gonsoulin, Dr. Perkins, and Dr. Vahedi collectively referred to as the Researchers). At all times material hereto the Researchers were employed by FSU. All of the Researchers have been provided notice of this action by the undersigned, who represents them in this action, and the Researchers have provided their consent for FSURF's efforts to add them as inventors on the Patents-in-Suit.

11. Dr. Gonsoulin and Dr. Perkins's work with Dr. Edrington was primarily focused on developing and simulating linear actuator designs, and Dr. Vahedi's work with Dr. Edrington was primarily focused on the design of the power electronics and control algorithm needed for the linear actuator designs, though Dr. Vahedi also contributed on development and simulation of linear actuator designs.

12. Pursuant to the FSU Intellectual Property Policy, all individuals whose work for FSU results in patentable subject matter assign their rights to that subject matter to FSURF. For this reason, FSURF owns the patentable subject matter that resulted from the work of the Researchers.

13. Defendant SentiMetal LLC is a Nevada limited liability company whose registered agent, Legalinc Corporate Services Inc., is located at 1810 East Sahara Avenue, Suite 215, Las Vegas, Nevada 89104. Based on SentiMetal LLC's various representations to FSURF, its principal administrative office is located at 4245 Hackamore Drive Reno, Nevada 89519. SentiMetal also has a place of business at 1379 San Mateo Avenue, South San Francisco, California 94080. Upon information and belief, SentiMetal LLC converted to SentiMetal Inc., a California Corporation, for a period of time and then reconverted back to SentiMetal LLC as a domestic Nevada limited liability company. SentiMetal LLC is the current assignee of the Patents-in-Suit. Hutchins is the founder and president of SentiMetal LLC.

14. This Court has original federal subject matter jurisdiction over this action pursuant to 28 U.S.C. §§1331 and 1338, as this is an action arising under 35 U.S.C. § 256 of the patent laws of the United States of America. This Court further has supplemental jurisdiction over FSURF's state law claims pursuant to 28 U.S.C. § 1367. This Court further has diversity jurisdiction because, upon information and belief Plaintiff and Defendant are citizens of different states, and the value of the

amount in controversy exceeds seventy-five thousand dollars (\$75,000.00), exclusive of interest and costs, jurisdiction being conferred in accordance with 28 U.S.C. § 1332.

15. Venue is proper in this district pursuant to 28 U.S.C. § 1391(b) because Defendant has transacted business in this district and/or a substantial part of the events or omissions giving rise to the claim occurred in this District.

16. This Court has personal jurisdiction over Defendant because it has transacted business in the State of Florida and in this judicial district and the exercise of personal jurisdiction over Defendant is consistent with due process. For example, as detailed below, SentiMetal LLC and Hutchins approached and contracted for FSURF to perform academic research for relating to linear actuator technology and the inventive subject matter of the Patents-in-Suit. Further, SentiMetal LLC brought Case No. 2020-CA-001600, currently pending within this judicial district in the Circuit Court of the Second Judicial Circuit in and for Leon County, against FSURF relating to the sponsored academic research FSURF completed for SentiMetal LLC after Hutchins approached FSURF. Hutchins has also visited Tallahassee, Florida on multiple occasions specifically relating to FSURF's research on linear actuator technologies for Defendant, which forms the basis for the subject matter incorrectly claimed inventorship of in the Patents-in-Suit. The actions of SentiMetal LLC necessarily apply to SentiMetal Inc. by virtue of the entity conversion.

## **BACKGROUND ALLEGATIONS**

### **Defendant Approaches FSURF and Dr. Edrington**

17. In March of 2015, Hutchins, a named inventor on the Patents-in-Suit and several other patents and patent applications assigned to SentiMetal LLC, first contacted FSURF regarding a potential sponsored research arrangement where FSURF would perform academic research regarding linear actuator technology. A linear actuator is an actuator that creates motion in a straight line.

18. On or about April 6, 2015, after the execution of a Confidential Disclosure Statement between SentiMetal LLC and FSURF, (the “Confidential Disclosure Statement”), Hutchins met with Dr. Edrington in person in Tallahassee, Florida to discuss academic research on linear actuator technology.

19. Dr. Edrington is currently a Professor at Clemson University. He earned his B.S. in Engineering from Arkansas State University in 1999 and a Ph.D. in Electrical Engineering at the Missouri University of Science and Technology in 2004. At all times relevant hereto, Dr. Edrington was a Professor of Electrical and Computer Engineering with the FAMU-FSU College of Engineering and was the lead researcher for the Energy Conversion and Integration Thrust program at the Florida State University-Center for Advanced Power Systems. He has over 20 years of experience in the field of electrical engineering. Dr. Edrington has published over 160 papers (including 2 Institute of Electrical and Electronics Engineers Prize

Awards), has graduated 23 MS students and 16 PhD students (with 5 in process) and is a named inventor on at least seven patents.

20. At this meeting, Hutchins discussed the possibility of research directed to modeling and simulation relating to linear actuator technology, with Dr. Edrington to lead any such research.

21. Over the course of the next several months, Hutchins, FSURF, and Dr. Edrington continued discussions and exchanged draft statements of work that would describe the scope of FSURF's academic research on linear actuator technology.

ERA1

22. On or about November 1, 2015, FSURF and SentiMetal LLC entered into a first "Educational Research Agreement" ("ERA1") for the "Design and Analysis of a non-rare-earth Linear Machine for ICE Valve Control." **Ex. A** (ERA1).

23. The purpose of ERA1 was to use software to simulate and model linear actuators that used electromagnets for both the thruster (moving) and stator (fixed) components. Dr. Edrington and his research team would analyze the results of the simulations and create novel designs that addressed difficulties and problems that the simulations would reveal.

24. ERA1, among other things, provided for the following:

- Section 8.2 – SentiMetal LLC would have the right to publish results of the research, but only if SentiMetal LLC submitted a copy of any



potential publication to FSURF prior to any publication, among other conditions;

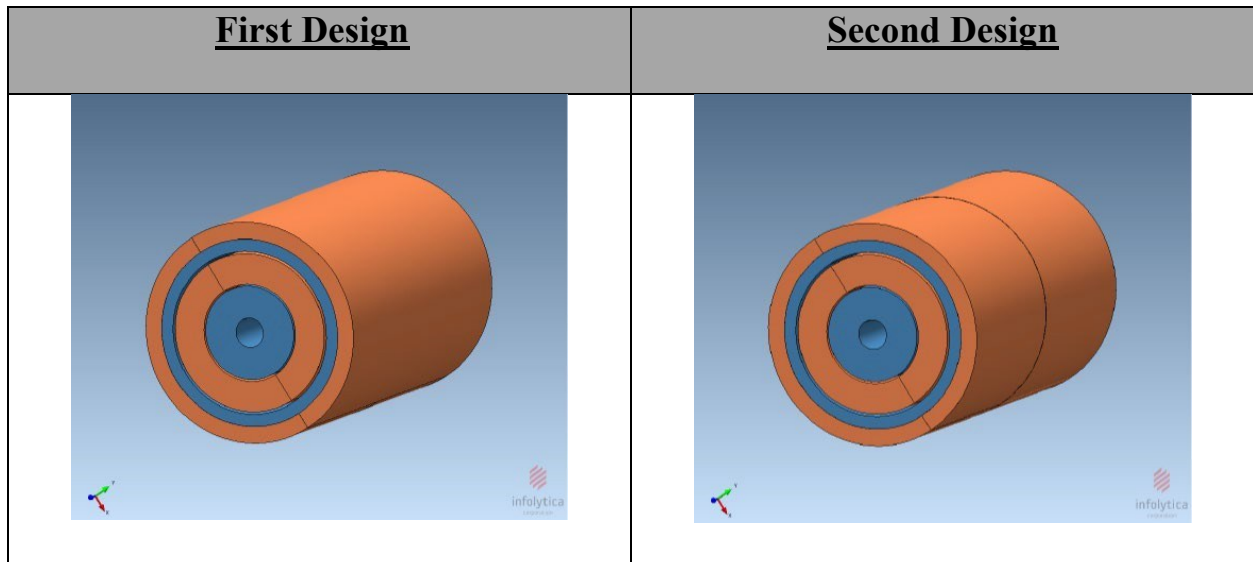
- Section 9.1 – inventions made during the research would belong to FSURF; and
- Section 10 – FSURF would grant SentiMetal LLC a royalty free, non-exclusive license for *internal use* of inventions FSURF researchers made during the research, and a first option to negotiate a royalty-bearing agreement to license inventions made during the research by FSURF.

25. ERA1 defined inventions as “any discovery, concept, or idea, whether or not patentable or copyrightable, including but not limited to processes, methods, computer software, formulas and techniques, improvements thereof, experimental results, and know-how relating thereto.” **Ex. A** (ERA1, Section 9.1)

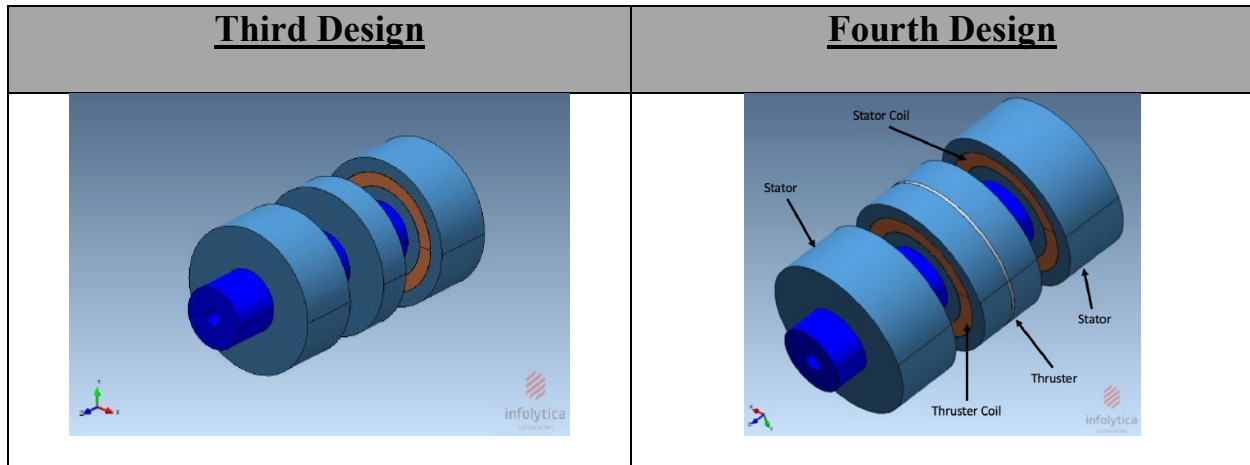
26. ERA1 stated that inventions were “made during the RESEARCH” if they arose “from work performed pursuant to the RESEARCH conducted under this [ERA1] AGREEMENT and [are] conceived and reduced to practice, actively or constructively, during the term of the AGREEMENT, or [are] conceived during the term of the AGREEMENT and reduced to practice within six (6) months after termination of the work performed hereunder.” **Ex. A** (ERA1, Section 9.1).

27. On or about July 25, 2016, after completing the research tasks of ERA1, FSURF submitted a report to SentiMetal LLC, and Hutchins via his role at SentiMetal LLC, entitled “Report: Design and Analysis of a Non-rare-earth Linear Machine for ICE Valve Control” describing the findings that resulted from FSURF’s research (the “ERA1 Report”), attached hereto as **Ex. B** (ERA1 Report).

28. The ERA1 Report presented multiple design iterations of the linear actuator and test results.



29. The first two designs presented certain difficulties and drawbacks that led FSURF to propose two new linear actuator designs, a third and fourth design.



30. The success of FSURF’s research under ERA1, supported by the novel inventions the Researchers had conceived, reduced to practice, and disclosed to Defendant in the ERA1 Report, led to discussions between FSURF and SentiMetal LLC for a second phase of sponsored academic research for the modeling, simulation, and refinement of designs conceived by the Researchers and an electronic control package.

#### ERA2 and Termination of the Research

31. On or about December 6, 2016, FSURF and SentiMetal LLC entered into a second Educational Research Agreement (“ERA2”), attached hereto—along with subsequent amendments thereto—as **Ex. C** (ERA2).

32. The provisions and obligations of ERA2 are substantially identical to those of ERA1, including the following:

- Section 8.2 – SentiMetal LLC would have the right to publish results of the research, but only if SentiMetal submitted a copy of any potential

publication to FSURF prior to any publication, among other restrictions;

- Section 9.1 – inventions made during the research would belong to FSURF; and
- Section 10 – FSURF would grant SentiMetal LLC a royalty free, non-exclusive license for *internal use* of inventions FSURF made during the research, and a first option to negotiate a royalty-bearing agreement to license inventions made during the research by FSURF.

33. ERA2, just like ERA1, defined inventions as “any discovery, concept, or idea, whether or not patentable or copyrightable, including but not limited to processes, methods, computer software, formulas and techniques, improvements thereof, experimental results, and know-how relating thereto.” **Ex. C** (ERA2, Section 9.1)

34. ERA2, just like ERA1, stated an invention was “made during the RESEARCH” if it arose “from work performed pursuant to the RESEARCH conducted under this [ERA2] AGREEMENT and is conceived and reduced to practice, actively or constructively, during the term of the AGREEMENT, or is conceived during the term of the AGREEMENT and reduced to practice within six (6) months after termination of the work performed hereunder.” **Ex. C** (ERA2, Section 9.1).

35. During the term of ERA2, FSURF submitted periodic updates to SentiMetal LLC that tracked the progress of the research under ERA2. FSURF and SentiMetal LLC also had regularly scheduled phone calls to discuss progress on ERA2's stated objectives and deliverables.

36. FSURF provided SentiMetal LLC with a report in July of 2017 entitled "Stage 2: Design, Analysis of a Non-rare-earth Linear Machine for ICE Valve Control" (the "ERA2 Report"), attached hereto as **Ex. D** (ERA2 Report).

37. FSURF and SentiMetal LLC executed two amendments to ERA2 to extend the timeframe for the completion of the research identified in ERA2. **Ex. C** (ERA2).

38. FSURF and SentiMetal LLC entered into the first amendment on October 30, 2017, which extended the timeframe for completion of the research to March 5, 2018.

39. The second amendment was entered into on March 22, 2018 to accommodate certain changes in design and control of the subject linear actuators. This amendment required SentiMetal LLC to pay FSURF an additional \$50,000 and extended ERA2 to August 6, 2018.

40. On June 7, 2018, FSURF and SentiMetal LLC executed a Mutual Termination Agreement terminating ERA2 and the extensions thereof as of June 8, 2018 (the "Termination Agreement").

41. On more than one occasion, FSURF invited SentiMetal LLC to negotiate an exclusive royalty-bearing license to the inventions developed under the sponsored academic research. SentiMetal LLC did not pursue its licensing rights.

Defendant's Unauthorized and Erroneous Patent Filings, and the Impacts Thereof

42. Unbeknownst to FSURF, on February 23, 2018 Hutchins filed U.S. Provisional Patent Application No. 62/634,592 (the '592 Application) entitled "Highly Efficient Linear Motor." Hutchins is listed as the sole inventor of the '592 Application.

43. On April 4, 2018, Hutchins assigned the '592 Application to SentiMetal LLC.

44. On April 6, 2018, SentiMetal LLC filed U.S. Patent Application No. 15/947,131 (the '131 Application), which claims priority to the '592 Application. Hutchins is listed as the sole inventor of the '131 Application.

45. On March 4, 2019, SentiMetal LLC assigned the '592 and '131 Applications to SentiMetal Inc.

46. On March 29, 2019, SentiMetal Inc. filed U.S. Patent Application No. 16/370,576 (the '576 Application) as a Continuation in part of the '131 Application. Hutchins and Rust are listed as the sole inventors of the '576 Application.

47. On February 7, 2020, SentiMetal Inc. assigned the '592, '131, and '576 Applications to SentiMetal LLC.

48. On March 24, 2020, the USPTO issued the '293 Patent, based on the '576 Application, to SentiMetal LLC with Hutchins and Rust as the sole inventors.

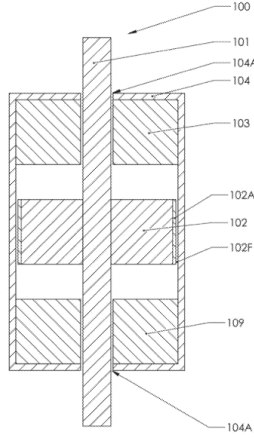
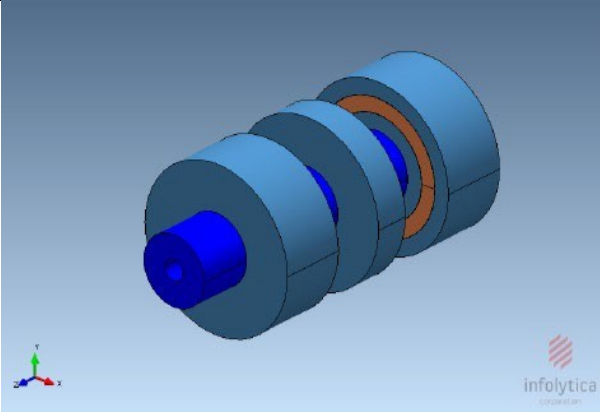
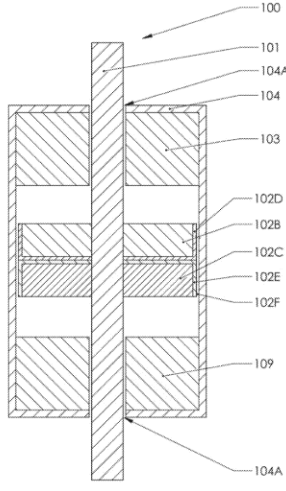
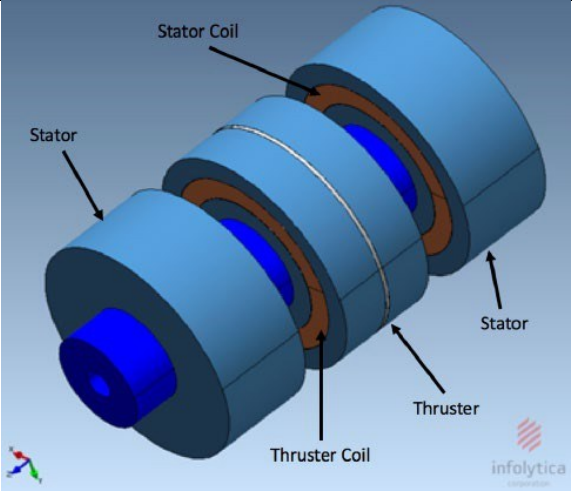
49. On September 15, 2020, the USPTO issued the '696 Patent, based on the '131 Application, to SentiMetal LLC with Hutchins as the sole inventor.

50. The inventions disclosed and claimed in the Patents-in-Suit were conceived and reduced to practice through the research FSURF conducted under ERA1 and ERA2, which FSURF disclosed to SentiMetal LLC and Hutchins, via his affiliation with SentiMetal LLC, through various reports and updates that included the ERA1 and ERA2 Reports. These inventions were reduced to practice during the term of the relevant research agreement.

51. Upon information and belief, SentiMetal LLC and/or Hutchins provided the ERA1 and ERA2 Reports to SentiMetal Inc. and Rust.

52. Defendant did not provide a copy of the '529, the '131, or the '576 Applications to FSURF in compliance with Section 8.2 of ERA1 and ERA2.

53. That the inventive subject matter of the Patents-in-Suit was obtained from FSURF and the Researchers is confirmed at least by a comparison of the drawings in the Patents-in-Suit to the novel designs the Researchers conceived and reduced to practice during the term of ERA1, and disclosed to SentiMetal LLC and Hutchins in the ERA1 Report:

<u>Patents-in-Suit</u>	<u>FSURF's Corresponding Novel ERA1 Designs</u>
 <p data-bbox="438 766 495 787">FIG. 1</p>	 <p data-bbox="998 724 1226 766">(Third Design)</p>
 <p data-bbox="422 1291 511 1323">FIG. 1A</p>	 <p data-bbox="990 1281 1242 1323">(Fourth Design)</p>

54. On or about July 16, 2018, FSURF filed a provisional patent application, U.S. Pat. App. No. 62/698,473 (the '473 Application), relating to the novel designs conceived of and reduced to practice by the Researchers during FSURF's provision of services under ERA1 and ERA2.



55. On or about January 16, 2019, FSURF filed a non-provisional patent application, U.S. Pat. App. No. 16/249,320 (the '320 Application), claiming the benefit of its provisional '473 Application. The Researchers were the named inventors for the provisional '473 Application and non-provisional '320 Application because their work while employed by FSU contributed to the conception of the invention as defined by the claims of the '473 and '320 Applications.

56. The named inventors for FSURF's '473 and '320 Applications, the Researchers, did not own the inventions because, as employees of FSU, an invention which is made in the field or discipline in which the employee is employed by the university, or by using university support, is the property of the university. The Researchers also signed assignments of those applications to FSURF.

57. On July 14, 2020, the United States Patent and Trademark Office ("USPTO") issued a final office action refusal for FSURF's '320 Application, citing to SentiMetal LLC's '131 Application in support thereof.

58. Specifically, the final office action rejected claims 1, 4-7, 9-13, and 16-30 of FSURF's '320 Application as being anticipated under 35 U.S.C. §102(a)(2) by SentiMetal LLC's '131 Application. The final office action also rejected claims 2, 8 and 14-15 under 35 U.S.C. § 103 as obvious over SentiMetal LLC's '131 Application and in further view of other various prior art references.

59. On August 31, 2020, Dr. Edrington executed a declaration under 37 C.F.R § 1.130 (the “Edrington Declaration”) to disqualify SentiMetal LLC’s ‘131 Application as prior art because the subject matter the examiner cited from SentiMetal LLC’s ‘131 Application to reject FSURF’s ‘320 Application was obtained by SentiMetal LLC and Hutchins directly from FSURF via the ERA1 and ERA2 Reports. In other words, the Edrington Declaration established that Hutchins did not invent the subject matter in the ‘131 Application that was cited against FSURF’s ‘320 Application.

60. The chart below details certain portions of SentiMetal LLC’s ‘131 Application that correspond to inventions and discoveries the Researchers conceived and reduced to practice during the research FSURF completed under ERA1 and ERA2, which were disclosed in the ERA1 and ERA2 Reports.

<b><u>Defendant’s ‘131 Application</u></b>	<b><u>Corresponding Disclosure from FSURF’s ERA1 and ERA2 Reports</u></b>
FIG. 1 and 1A.	ERA1, at pages 1, 3, 9-12, and FIGS. 7 and 8.  ERA2 at pages 8- 13 and FIGS. 4, 5a, and 5b.
Thruster coil 102, coils 102B and 102C, ferrous cup 102D and 102E, and air gap 102F.	ERA1, at pages 3, 9- 12, and FIGS. 7, 8, and 17.  ERA2, at pages 8- 13 and FIGS. 4, 5a, and 5b.

<b><u>Defendant’s ‘131 Application</u></b>	<b><u>Corresponding Disclosure from FSURF’s ERA1 and ERA2 Reports</u></b>
Central shaft 101, fixed upper forcer coil 103, and fixed lower forcer coil 109; paragraph [0047].	ERA1 at pages 3, 9- 12, and FIGS. 7, 8, and 17.  ERA2, at pages 8- 13 and FIGS. 4, 5a, and 5b.
Housing 104.	ERA2, at pages 7-8 and FIGS. 3 and 4a.
Paragraph [0047].	ERA1, at pages 3, 9- 12, 17-19 and FIGS. 7, 8, and 17.  ERA2, at pages 3, 8-15 and FIGS. 4, 5a, and 5b.
Paragraph [0053]; controller OCU and ACU in FIGS. 6 and 7.	ERA1, at pages 13-20 and FIG. 9.  ERA2, at pages 13- 16 and FIGS. 10 and 11.
Steps 320, 322, and 324; fixed upper forcer coil 103, and fixed lower forcer coil 109; thruster coil 102.	ERA1, at pages 3, 9- 12, and FIGS. 7, 8, and 17.  ERA2, at pages 8-13 and FIGS. 4, 5a, and 5b.

61. On October 20, 2020, after FSURF submitted a request for continued examination of the ‘320 Application, the USPTO issued a non-final office action that addressed the Edrington Declaration. The examiner stated that the Edrington Declaration “provides persuasive information that the claimed subject matter of [FSURF’s ‘320 Application] was developed by and in the possession of [FSURF] at the time before the filing of [the ‘131 Application] and would be sufficient to overcome [the ‘131 Application].”

62. The examiner, however, concluded that he could not advance FSURF's '320 Application to allowance because SentiMetal LLC's '131 Application had, in the intervening time, issued as the '696 Patent on September 15, 2020.

63. The timing of issuance of the '696 Patent caused the examiner to issue a double patenting rejection of FSURF's '320 Application to expedite prosecution on the merits because the '696 Patent and FSURF's '320 Application were not patentably distinct, where the earlier filed '696 Patent disclosed information—improperly sourced from FSURF—that FSURF's '320 Application claimed.

64. On March 1, 2021, FSURF proposed amendments to the claims of the '320 Application that would increase the inner travel path diameter of the thruster as it travels in the sheath to overcome the '696 Patent, which brought FSURF's '320 Application in condition for allowance.

65. On March 24, 2021, the USPTO issued a Notice of Allowance for the '320 Application.

66. On May 11, 2021 the '320 Application issued as U.S. Pat. No. 11,004,587 (the '587 Patent), albeit without the broader claim scope FSURF was otherwise entitled to because of the erroneous exclusion of the Researchers as inventors on Defendant's patent filings.

**COUNT I**

(Correction of the Inventorship of Patent No. 10,774,696 under 35 U.S.C. § 256, against SentiMetal LLC)

67. The allegations of paragraphs 1–66 above are incorporated by reference as if fully set forth herein.

68. “Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.” 35 U.S.C. § 256(a).

69. “The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly.” 35 U.S.C. § 256(b).

70. As detailed above, the ‘696 Patent claims subject matter that was conceived of and reduced to practice by the Researchers at least as early as July 2016 with respect to information disclosed in the ERA1 Report, and July 2017 for information disclosed in the ERA2 Report.

71. One or more or all of the Researchers are inventors of the subject matter claimed in each of claims 1-37 of the ‘696 Patent.

72. The Researchers’ inventorship of subject matter claimed in claims 1-37 of the ‘696 Patent is corroborated by at least the ERA1 and ERA2 Reports.

73. Hutchins and SentiMetal LLC received copies of the ERA1 and/or ERA2 Reports prior to filing the '592 and/or '131 Applications. Hutchins and SentiMetal LLC failed to name the Researchers as true and actual inventors on the claims in those Applications.

74. Hutchins and SentiMetal LLC incorrectly claimed that Hutchins is the true and sole inventor of the subject matter claimed in the '696 Patent. SentiMetal LLC incorrectly claimed that the assignment of the '696 Patent to it was proper, and Hutchins incorrectly claimed a role in conceiving and reducing to practice all inventions claimed in the '696 Patent when he did not conceive and reduce to practice all of the subject matter claimed in the '696 Patent.

75. Hutchins and SentiMetal LLC's omission of the Researchers as inventors on the '696 Patent arose without any deceptive intention on the part of the Researchers or FSURF.

76. Hutchins and SentiMetal LLC filed the '592 and '131 Applications and obtained patent protection for the inventions claimed in the '696 Patent without FSURF or the Researchers' authorization.

77. Hutchins and SentiMetal LLC's actions, as detailed above, have deprived FSURF of its assignable and licensable ownership interest in the '696 Patent and of the proceeds, commercial opportunities, and reputational goodwill that would have resulted therefrom.

78. Each of the Researchers also has been deprived of the reputational and professional advantages of being a named inventor on the '696 Patent.

79. Hutchins and SentiMetal LLC's actions, as detailed above, have resulted in erroneous inventorship on the '696 Patent.

80. This Court should therefore order (i) correction of the inventorship of the '696 Patent to add the Researchers as the inventors so that the Director of the USPTO may issue a correction certificate as authorized and required by statute (35 U.S.C. § 256); and (ii) that SentiMetal LLC undertake all other reasonable and necessary actions to obtain such correction.

81. Alternatively, at the very least, this Court should order (i) correction of the inventorship of the '696 Patent to identify all inventors as the facts demonstrate under 35 U.S.C. § 116, as authorized and required by statute (35 U.S.C. § 256), which may include removal of Hutchins as a named inventor. Furthermore, pursuant to this Court's inherent authority and equitable powers, this Court should order correction of ownership of the '696 Patent to make FSURF either the exclusive owner, or a joint owner with its current owner, depending on the affiliations of the true inventors.

**COUNT II**

(Correction of the Inventorship of Patent No. 10,601,293 under 35 U.S.C. § 256,  
against SentiMetal LLC)

82. The allegations of paragraphs 1–66 above are incorporated by reference as if fully set forth herein.

83. As detailed above, the '293 Patent claims subject matter that was conceived of and reduced to practice by the Researchers at least as early as July 2016 with respect to information disclosed in the ERA1 Report, and July 2017 for information disclosed in the ERA2 Report.

84. One or more or all of the Researchers are inventors of the subject matter claimed in each of claims 1-38 of the '293 Patent.

85. The Researchers' inventorship of the subject matter claimed in claims 1-38 the '293 Patent is corroborated by at least the ERA1 and ERA2 Reports.

86. SentiMetal LLC and Hutchins, via his affiliation with SentiMetal LLC, received copies of the ERA1 and ERA2 Reports prior to filing the '592 and '131 Applications. Upon information and belief, SentiMetal LLC and/or Hutchins provided copies of the ERA1 and ERA2 Reports to Rust and SentiMetal, Inc., such that Hutchins, Rust, and SentiMetal Inc. all received copies of the ERA1 and ERA2 Reports prior to filing the '576 Application.

87. Hutchins and SentiMetal LLC failed to name the Researchers as true and actual inventors for the '592 and '131 Applications. Rust, Hutchins, and



SentiMetal Inc. failed to name the Researchers as true and actual inventors for the '576 Application, which claimed the benefit of the '131 Application, which claimed the benefit of the '592 Application.

88. Rust, Hutchins, and SentiMetal Inc. incorrectly claimed that Hutchins and Rust were the true and sole inventors of the subject matter claimed in the '293 Patent. SentiMetal LLC incorrectly claimed that the assignment of the '293 Patent to it was proper, and Hutchins and Rust incorrectly claimed a role in conceiving and reducing to practice all inventions claimed in the '293 Patent when they did not conceive and reduce to practice all of the subject matter claimed in the '293 Patent.

89. The omission of the Researchers as inventors on the '293 Patent arose without any deceptive intention on the part of the Researchers or FSURF.

90. Hutchins and SentiMetal LLC filed the '592 and '131 Applications, and Rust, Hutchins, and SentiMetal Inc. filed the '576 Application, thereby obtaining patent protection for the inventions claimed in the '293 Patent without FSURF or the Researchers' authorization.

91. Defendant's actions as detailed above have deprived FSURF of its assignable and licensable ownership interest in the '293 Patent and of the proceeds, commercial opportunities, and reputational goodwill that would have resulted therefrom.

92. Each of the Researchers also have been deprived of the reputational and professional advantages of being a named inventor on the '293 Patent.

93. Defendant's actions as detailed above have resulted in erroneous inventorship on the '293 Patent.

94. This Court should therefore order correction of the inventorship of the '293 Patent to add the Researchers as the inventors so that the Director of the USPTO may issue a correction certificate as authorized and required by statute (35 U.S.C. § 256) and that Defendant undertake all other reasonable and necessary actions to obtain such correction.

95. Alternatively, at the very least, this Court should order (i) correction of the inventorship of the '293 Patent identifying all inventors as the facts demonstrate under 35 U.S.C. § 116, as authorized and required by statute (35 U.S.C. § 256), which may include removal of Hutchins and Rust as named inventors; and (ii) that Defendant undertake all other reasonable and necessary actions to obtain such correction. Furthermore, pursuant to this Court's inherent authority and equitable powers, this Court should order correction of ownership of the '293 Patent to make FSURF either the exclusive owner, or a joint owner with its current owner, depending on the affiliations of the true inventors.

**COUNT III**

(Breach of ERA1, against SentiMetal LLC)

96. The allegations of paragraphs 1–66 above are incorporated by reference as if fully set forth herein.

97. This is a cause of action for breach of contract under the common laws of the state of Florida by FSURF against SentiMetal LLC for failure to comply with the terms of Sections 8.2, 9.1, and 10 of ERA1.

98. ERA1 is a valid, enforceable contract between SentiMetal LLC and FSURF.

99. FSURF has fully performed all necessary obligations under the terms and obligations set forth in ERA1, or was excused from doing so by virtue of SentiMetal LLC's breaches. FSURF's performance included offering SentiMetal LLC an exclusive royalty-bearing license to the inventions developed under ERA1 and ERA2, as provided under both agreements. SentiMetal LLC did not pursue its licensing rights.

100. Section 8.2 of ERA1 placed restrictions on SentiMetal LLC's ability to publish information resulting from FSURF's research under ERA1, and: (1) required SentiMetal LLC to submit all publications containing research results for review prior to publication; (2) allowed for a delay in publication to allow FSURF to protect the patentability of inventions that arose from the research; (3) allowed FSURF to

ensure proper credit was given to FSU and its researchers; and (4) allowed for corrections of any inaccuracies in SentiMetal LLC's publications.

101. SentiMetal LLC did not provide FSURF or any of the Researchers with copies of the '592 and '131 Applications, and the '576 Application by virtue of SentiMetal LLC's assignment of the '592 and '131 Applications from which the '576 Application claims benefit, which included information and inventions produced by the Researchers during ERA1 (including at least the novel actuator designs and baseline power control system designs) precluding FSURF and the Researchers' review thereof.

102. SentiMetal LLC's failure to comply with Section 8.2 of ERA1 prevented FSURF from exercising its right to delay publication and protect the patentability of the Researchers' ERA1 inventions, prevented the appropriate credit to the Researchers, and prevented the correction of inaccuracies (including the omission of the Researchers as inventors).

103. SentiMetal LLC's breach of Section 8.2 of ERA1 resulted in reputational and other damages to FSURF due to: (1) lack of attribution to its Researchers and lack of ownership interest in the '592, '131, and '576 Applications, and the '696 and '293 Patents that issued therefrom; (2) increased patent prosecution costs for FSURF's patent filings relating to the research under ERA1; (3) reduced scope of subject matter FSURF was entitled to claim in the '320 Application and the

resulting '587 Patent, thereby reducing the commercial value thereof; and (4) loss of the right to exclusive control of licensing patents that claim the Researcher's inventions from the research under ERA1.

104. Section 9.1 of ERA1 specifies that FSURF, not SentiMetal LLC, is the owner of inventions from the ERA1 research. This provision imposed a duty on SentiMetal LLC to not claim ownership of inventions resulting from FSURF's provision of research services under ERA1.

105. SentiMetal LLC breached its duty to FSURF under Section 9.1 of ERA1 via SentiMetal LLC's ownership claim to the '592, '131, and '576 Applications and the '696 and '293 Patents, because these filings claim linear actuator designs and power control system designs conceived and reduced to practice by FSURF Researchers during the term of ERA1.

106. SentiMetal LLC's breach of Section 9.1 of ERA1 has resulted in reputational and other damages to FSURF due to: (1) lack of attribution to its Researchers and lack of ownership interest in the '592, '131, and '576 Applications, and the '696 and '293 Patents that issued therefrom; (2) increased patent prosecution costs for FSURF's patent filings relating to the research under ERA1; (3) reduced scope of subject matter FSURF was entitled to claim in the '320 Application and the resulting '587 Patent, thereby reducing the commercial value thereof; and (4) loss of FSURF's right to exclusive control of patents that claim the Researchers' inventions

from the research under ERA1, including the exclusive right to control licensing decisions and receive licensing income.

107. Section 10 of ERA1 specifies that FSURF granted SentiMetal LLC “a royalty free, non-exclusive license for *internal use*” of inventions made during the research by the Researchers.

108. SentiMetal LLC’s filing of the ‘592 and ‘131 Applications, and subsequent assignment thereof to SentiMetal Inc., are non-internal uses that exceeded the scope of the limited license FSURF granted SentiMetal LLC. Further, SentiMetal LLC’s provision of the ERA1 Report, which identified the Researchers’ novel discoveries, to SentiMetal Inc. for its own use, including use of the ERA1 Report as a basis for the ‘576 Application, exceeded the scope of the limited license FSURF granted SentiMetal LLC.

109. Such use by SentiMetal Inc. was an expected and foreseeable consequence of SentiMetal LLC’s assignment to SentiMetal Inc. of the ‘592 and ‘131 Applications and provision to SentiMetal Inc. of the ERA1 Report, each of which are non-internal uses by SentiMetal LLC of FSURF’s novel research discoveries.

110. SentiMetal LLC’s breach of Section 10 of ERA1 has damaged FSURF due to: (1) lack of attribution to its Researchers and lack of ownership interest in the ‘592, ‘131, and ‘576 Applications, and the ‘696 and ‘293 Patents that issued

therefrom; (2) increased patent prosecution costs for FSURF's patent filings relating to the research under ERA1; (3) reduced scope of subject matter FSURF was entitled to claim in the '320 Application and the resulting '587 Patent, thereby reducing the commercial value thereof; and (4) loss of FSURF's right to exclusive control of patents that claim the Researchers' inventions from the research under ERA1, including the exclusive right to control licensing decisions and receive licensing income.

111. As outlined above, as a direct and proximate cause of SentiMetal LLC's breaches of Sections 8.2, 9.1, and 10 of ERA1, FSURF has suffered damages in an amount to be proven at trial.

112. As a result of the foregoing, FSURF has suffered and will continue to suffer irreparable harm as a proximate and direct result of SentiMetal LLC's foregoing acts, which have prevented FSURF from commercializing all of the inventions derived from the Researchers' work under ERA 1 and ERA 2. FSURF will suffer additional irreparable harm unless and until SentiMetal LLC is preliminarily and later permanently enjoined by the Court from continuing such acts. Such harm includes at least the fact that FSURF may not be able to determine the full value of the lost opportunity to commercialize all of these inventions, leaving FSURF without an adequate remedy at law.

**COUNT IV**  
(Breach of ERA2, against SentiMetal LLC)

113. The allegations of paragraphs 1–66 above are incorporated by reference as if fully set forth herein.

114. This is a cause of action for breach of contract under the common laws of the state of Florida by FSURF against SentiMetal LLC for failure to comply with the terms Sections 8.2, 9.1, and 10 of ERA2 and the Amendments thereto.

115. ERA2 and the Amendments thereto constitute a valid, enforceable contract between SentiMetal LLC and FSURF.

116. FSURF has fully performed all necessary obligations under the terms and obligations set forth in ERA2, or was excused from doing so by virtue of SentiMetal LLC's breaches. FSURF's performance included offering SentiMetal LLC an exclusive royalty-bearing license to the inventions developed under ERA1 and ERA2, as provided under both agreements. SentiMetal LLC did not pursue its licensing rights.

117. Section 8.2 of ERA2 placed restrictions on SentiMetal LLC's ability to publish information resulting from FSURF's research under ERA2, and: (1) required SentiMetal LLC to submit all publications containing research results for review prior to publication; (2) allowed for a delay in publication to allow FSURF to protect the patentability of inventions that arose from the research; (3) allowed FSURF to



ensure proper credit was given to FSU and its researchers; and (4) allowed for corrections of any inaccuracies in SentiMetal LLC's publications.

118. SentiMetal LLC did not provide FSURF or any of the Researchers with copies of the '592 and '131 Applications, and the '576 Application by virtue of SentiMetal LLC's assignment of the '592 and '131 Applications from which the '576 Application claims benefit, which included information and inventions produced by the Researchers during ERA2 (such as the novel actuator designs and the power control system designs) precluding FSURF and the Researchers' review thereof.

119. SentiMetal LLC's failure to comply with Section 8.2 of ERA2 prevented FSURF from exercising its right to delay publication and protect the patentability of the Researchers' ERA2 inventions, prevented the appropriate credit to the Researchers, and prevented the correction of inaccuracies (including the omission of the Researchers as inventors on SentiMetal's patent filings).

120. SentiMetal LLC's breach of Section 8.2 of ERA2 has resulted in reputational and other damages to FSURF due to: (1) lack of attribution to its Researchers and lack of ownership interest in the '592, '131, and '576 Applications, and the '696 and '293 Patents that issued therefrom; (2) increased patent prosecution costs for FSURF's patent filings relating to the research under ERA2; (3) reduced scope of subject matter FSURF was entitled to claim in the '320 Application and the

resulting '587 Patent, thereby reducing the commercial value thereof; and (4) loss of the right to exclusive control of licensing or sale of patents that claim the Researchers' inventions from the research under ERA2.

121. Section 9.1 of ERA2 specifies that FSURF, not SentiMetal LLC, is the owner of inventions from the ERA2 research. This provision imposed a duty on SentiMetal LLC to not claim ownership of inventions resulting from FSURF's provision of research services under ERA2.

122. SentiMetal LLC breached its duty to FSURF under Section 9.1 of ERA2 via SentiMetal's ownership claim to the '592, '131, and '576 Applications and the '696 and '293 Patents, because these filings claim linear actuator designs and power control system designs conceived and reduced to practice by FSURF Researchers during the term of ERA2.

123. SentiMetal LLC's breach of Section 9.1 of ERA2 has resulted in reputational and other damages to FSURF due to: (1) lack of attribution to its Researchers and lack of ownership interest in the '592, '131, and '576 Applications and the '696 and '293 Patents that issued therefrom; (2) increased patent prosecution costs for FSURF's patent filings relating to the research under ERA2; (3) reduced scope of subject matter FSURF was entitled to claim in the '320 Application and the resulting '587 Patent, thereby reducing the commercial value thereof; and (4) loss of

the right to exclusive control of licensing or sale of patents that claim the Researcher's inventions from the research under ERA2.

124. Section 10 of ERA2 specifies that FSURF granted SentiMetal LLC "a royalty free, non-exclusive license for *internal use*" of inventions made during the research by the Researchers.

125. SentiMetal LLC's filing of the '592 and '131 Applications, and subsequent assignment thereof to SentiMetal Inc., are non-internal uses that exceeded the scope of the limited license FSURF granted SentiMetal LLC. Further, SentiMetal LLC's provision of the ERA2 Report, which identified the Researchers' novel discoveries, to SentiMetal Inc. for its own use, including use of the ERA2 Report as a basis for the '576 Application, also exceeded the scope of the limited license FSURF granted SentiMetal LLC.

126. Such use by SentiMetal Inc. was an expected and foreseeable consequence of SentiMetal LLC's assignment to SentiMetal Inc. of the '592 and '131 Applications and provision to SentiMetal Inc. of the ERA2 Report, each of which are non-internal uses by SentiMetal LLC of FSURF's novel research discoveries.

127. SentiMetal LLC's breach of Section 10 of ERA1 has damaged FSURF due to: (1) lack of attribution to its Researchers and lack of ownership interest in the '592, '131, and '576 Applications, and the '696 and '293 Patents that issued

therefrom; (2) increased patent prosecution costs for FSURF's patent filings relating to the research under ERA1; (3) reduced scope of subject matter FSURF was entitled to claim in the '320 Application and the resulting '587 Patent, thereby reducing the commercial value thereof; and (4) loss of FSURF's right to exclusive control of patents that claim the Researchers' inventions from the research under ERA1, including the exclusive right to control licensing decisions and receive licensing income.

128. As outlined above, as a direct and proximate cause of SentiMetal LLC's breaches of Sections 8.2, 9.1, and 10 of ERA1, FSURF has suffered damages in an amount to be proven at trial.

129. As a result of the foregoing, FSURF has suffered and will continue to suffer irreparable harm as a proximate and direct result of SentiMetal LLC's foregoing acts, which have prevented FSURF from commercializing all of the inventions derived from the Researchers' work under ERA 1 and ERA 2. FSURF will suffer additional irreparable harm unless and until SentiMetal LLC's is preliminarily and later permanently enjoined by the Court from continuing such acts. Such harm includes at least the fact that FSURF may not be able to determine the full value of the lost opportunity to commercialize all of these inventions, leaving FSURF without an adequate remedy at law.

**COUNT V**

(Unjust Enrichment, against SentiMetal LLC)

130. The allegations of paragraphs 1–66 above are incorporated by reference as if fully set forth herein.

131. Alternatively, with respect to Defendant, if this Court should hold that either ERA1 or ERA2 are not enforceable or that either ERA1 or ERA2 do not govern the acts of Defendant, Plaintiff submits this claim of unjust enrichment.

132. If this Court holds that the Researchers should be named as inventors on any of the Patents-in-Suit, while also holding that Hutchins and/or Rust should remain as an inventor on any of the Patents-in-Suit, the resulting corrected patents will be subject to joint ownership rules. Under those rules, FSURF loses the right to exclusive control over the inventions jointly owned patents for licensing and other purposes.

133. Defendant has received a benefit from FSURF in Defendant's improper taking, possession, and use of FSURF's intellectual property that resulted from the research under ERA1 and ERA2, including the Patents-in-Suit.

134. Defendant has knowledge of, and continues to retain, the benefit improperly obtained from FSURF, yet Defendant has not provided compensation or consideration to FSURF for their improper taking and use of FSURF's intellectual property, and the Patents-in-Suit that issued therefrom.

135. Defendant's retention and profitable exploitation of FSURF's intellectual property and the Patents-in-Suit without appropriately compensating FSURF is inequitable.

136. Defendant is therefore liable for the assignment of the Patents-in-Suit to FSURF as full or joint owner, and for all harm suffered by FSURF and benefits enjoyed by Defendant, including the value of the benefit acquired by Defendant, an accounting and disgorgement of Defendant's improperly obtained incremental and/or complete profits, FSURF's lost profits, FSURF's reasonable past and future royalties in amounts to be proven at trial, and such other and further relief as warranted under the facts.

**COUNT VI**  
(Conversion, against SentiMetal LLC)

137. The allegations of paragraphs 1–66 above are incorporated by reference as if fully set forth herein.

138. Alternatively, with respect to Defendant, if this Court should hold that either ERA1 or ERA2 are not enforceable or that either ERA1 or ERA2 do not govern the acts of Defendant, Plaintiff submits this claim of conversion.

139. Count IV is an action for conversion, under the common law of the state of Florida, regarding Defendant's unauthorized conversion of FSURF's intellectual property via the Patents-in-Suit and the underlying filings related thereto.

140. As detailed above, FSURF is the owner of the inventions from the research under ERA1 and ERA2. Even without the ERA contract terms, the Researchers' work is owned by FSURF because they were FSU employees when they performed the research at issue.

141. Defendant has wrongfully claimed in the Patents-in-Suit and related filings that FSURF's inventions are Defendant's inventions.

142. FSURF should be the assignee or a joint owner of the Patents-in-Suit, as it is the owner of claimed inventions in the Patents-in-Suit under the terms of ERA1 and ERA2, and pursuant to the Intellectual Property Policy governing the work of the Researchers that developed the claimed inventions, and who were employed by FSU at all relevant times.

143. Defendant did knowingly, willfully, unlawfully, and with intent to steal, commit an act of conversion of FSURF's intellectual property by possessing and interfering, without justification, with FSURF's intellectual property, and with its ownership interest in, and rights to, inventions claimed in the Patents-in-Suit.

144. As a direct and proximate result of Defendant's conduct, FSURF has suffered a deprivation of its intellectual property.

145. Defendant's actions have interfered with FSURF's ownership rights over the converted intellectual property, over which Defendant has improperly exercised acts of dominion and control. For example, comingling FSURF inventions

with Hutchins and/or Rust inventions deprives FSURF of exclusive control over the licensing and collection of revenue from use of the Patents-in-Suit.

146. Defendant's improper conduct has injured FSURF by depriving FSURF of its ownership of, and rights to, the Patents-in-Suit and by preventing and usurping FSURF's ability to take monetary advantage of its inventions and of the Patents-in-Suit.

147. If this Court holds that the Researchers should be named as inventors on any of the Patents-in-Suit, while also holding that Hutchins and/or Rust should remain as an inventor on any of the Patents-in-Suit, the resulting corrected patents will be subject to joint ownership rules. Under those rules, FSURF loses the right to exclusive control over the inventions developed by the Researchers for licensing and collection of revenue, because they would have been commingled by Defendant in one or more patents that also contain inventions developed by Hutchins and/or Rust were assigned to SentiMetal LLC.

148. Under the facts set forth above, FSURF could have filed one or more patent application that claimed only the work of the Researchers, not commingled with any invention by Hutchins, Rust, or any other individual.

149. As such, FSURF seeks (i) compensatory damages equal to the loss incurred as a result of the Defendant's actions and proximately caused by the Defendant's conduct; (ii) a preliminary and permanent injunction; (iii) punitive



damages; (iv) costs of this action; and (v) such additional relief as the Court deems appropriate or to which FSURF is entitled to by law or in equity.

150. As a result of the foregoing, FSURF has suffered and will continue to suffer irreparable harm as a proximate and direct result of Defendant's foregoing acts, which have prevented FSURF from commercializing all of the inventions derived from the Researchers' work under ERA 1 and ERA 2. FSURF will suffer additional irreparable harm unless and until Defendant is preliminarily and later permanently enjoined by the Court from continuing such acts. Such harm includes at least the fact that FSURF may not be able to determine the full value of the lost opportunity to commercialize all of these inventions, leaving FSURF without an adequate remedy at law.

#### **PRAYER FOR COSTS AND ATTORNEYS FEES**

FSURF requests an award of reasonable costs and attorney fees pursuant to 35 U.S.C. § 285 and any other applicable basis for costs and attorneys' fees based upon the claims brought herein and any governing authority.

#### **REQUEST FOR JURY TRIAL**

FSURF requests jury trial of any matter so triable as a matter of right.

#### **PRAYER FOR RELIEF**

WHEREFORE, for all the forgoing reasons, FSURF requests this Honorable Court grant relief in the following manner:

- a) A determination that the Researchers are the sole and original inventors of the inventions claimed in in the '696 and '293 Patents;
- b) An Order directing the USPTO to issue a Certification of Correction to correct the inventorship and ownership for the '696 and '293 Patents pursuant to 35 U.S.C. § 256;
- c) An Order Requiring Defendant to take all reasonable and necessary actions to obtain correction of the '696 and '293 Patents;
- d) A judgment against Defendant and an award of compensatory damages against Defendant for the actual damages suffered by FSURF as a result of Defendant's breaches of ERA1 and ERA2;
- e) A judgment against Defendant and a disgorgement of Defendant's improperly obtained incremental and/or complete profits, FSURF's lost profits, and FSURF's reasonable past and future royalties as a result of Defendant's unjust enrichment;
- f) A judgment against Defendant and an award of compensatory damages against Defendant equal to FSURF's loss incurred as a result of the Defendant's acts of conversion;
- g) An award of punitive damages against Defendant in an amount to be determined at trial;

- h) A preliminary and a permanent injunction barring Defendant from exploiting, marketing, advertising, or otherwise using the ‘696 and ‘293 Patents;
- i) The costs of this action;
- j) An award of Plaintiffs’ reasonable attorneys’ fees;
- k) An award of prejudgment interest; and
- l) Any and all other relief that this Honorable Court deems just.

DATED: December 5, 2022

Respectfully Submitted,

*s/Cameron C. Murphy/*

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