

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF MASSACHUSETTS**

TEVA PHARMACEUTICALS  
INTERNATIONAL GMBH and  
TEVA PHARMACEUTICALS  
USA, INC.,

*Plaintiffs,*

v.

ELI LILLY AND COMPANY,

*Defendant.*

Civil Action No.  
1:18-cv-12029-ADB

**TEVA’S BENCH BRIEF CONCERNING PATENT ASSIGNMENT LAW AND  
STANDING**

Recording an assignment with the Patent Office “creates a presumption of validity as to the assignment and places the burden to rebut such a showing on one challenging the assignment.” *SiRF Tech., Inc. v. Int’l Trade Comm’n*, 601 F.3d 1319, 1328 (Fed. Cir. 2010); *see also Dow Chem. Co. v. Nova Chemicals Corp. (Canada)*, 458 F. App’x 910, 912 (Fed. Cir. 2012) (Defendant “failed to overcome the presumption of title created by the record of assignment filed with the PTO. The district court correctly determined that [plaintiff] has standing to enforce the patents in suit.”). “The presumption as to executed assignments is that they are proper unless a challenger comes forward with affirmative evidence to the contrary. ‘Could have been’ is not affirmative evidence.” *Jefferson St. Holdings Intell. Prop. LLC v. Rearth USA, LLC*, No. 2:18-CV-00338-JRG, 2019 WL 6647333, at \*2 (E.D. Tex. Jan. 8, 2019).

By statute, notarization is prima facie evidence of the assignment of a patent. *See* 35 U.S.C. § 261 (“A certificate of acknowledgment under the hand and official seal of a person authorized to administer oaths within the United States . . . shall be prima facie evidence of the execution of an assignment, grant or conveyance of a patent or application for patent.”); *see also See Le Fiell v. U.S.*, 162 Ct. Cl. 865, 867, 868 n.4 (1963); *iBio, Inc. v. Fraunhofer USA, Inc.*, No. CV 10256-VCMR, 2016 WL 4059257 (Del. Ch. July 29, 2016); *US SolarTech, Inc. v. j-fiber, GmbH*, No. CIV.A. 06-10293-RWZ, 2013 WL 1755212, at \*3 (D. Mass. Apr. 24, 2013) (On summary judgment standard, resolving ownership issue because there was a “notarized assignment” as to which defendant had not presented evidence of “fraud or forgery.”).

“[A]n exclusive license may be tantamount to an assignment for purposes of creating standing if it conveys to the licensee all substantial rights to the patent at issue.” *Keranos, LLC v. Silicon Storage Tech., Inc.*, 797 F.3d 1025, 1031 (Fed. Cir. 2015) (citation omitted). Even where an exclusive licensee lacked sufficient rights to assert a patent “*in its own name* . . . the exclusive licensee may have standing to participate in a patent infringement suit, but it must join the owner of legal title to satisfy the standing requirement.” *Id.*

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**CERTIFICATE OF SERVICE**

I, Elaine Herrmann Blais, hereby certify that this document filed through the ECF system will be sent electronically to the registered participants as identified on the Notice of Electronic Filing (“NEF”) and paper copies will be sent to those indicated as non-registered participants on November 4, 2022.

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