

NOTE: This order is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

MEMORYLINK CORP.,
Plaintiff-Appellant,

v.

**MOTOROLA, INC., JONATHAN P. MEYER, HUGH
C. DUNLOP, THOMAS G. BERRY, J. RAY WOOD,
AND TERRI S. HUGHES,**
Defendants-Appellees.

2010-1533

Appeal from the United States District Court for the
Northern District of Illinois in case no. 09-CV-7401, Judge
William J. Hibbler.

ON MOTION

Before RADER, *Chief Judge.*

O R D E R

Motorola, Inc. et al. (Motorola) move to transfer this
appeal to the United States Court of Appeals for the Sev-
enth Circuit. Memorylink Corp. opposes transfer. Mo-
torola replies.

Based upon our review of the papers submitted, it appears that the district court's jurisdiction over this legal malpractice action arose in part under 28 U.S.C. § 1338 and thus our jurisdiction is proper. Although a claim for relief may be denied on non-patent grounds as it was here, to determine the district court's jurisdiction and our own jurisdiction we must look to what the plaintiff would be required to prove to prevail on the claim for relief. See *David v. Brouse McDowell, L.P.A.*, 596 F.3d 1355, 1361-62 (Fed. Cir. 2010) (determining district court's jurisdiction based upon what the plaintiff would have to prove to prevail in a legal malpractice action).

Here, Memorylink's complaint sought to correct the inventorship of the "Secret Patent," which would have required Memorylink to prove, inter alia, that certain individuals were and/or other individuals were not the actual inventors in order to prevail on its claim. Although patent ownership might not necessarily raise an issue of patent law, patent inventorship does. *Shum v. Intel Corp.*, 633 F.3d 1067, 1076 n.4 (Fed. Cir. 2010) (state law claims involving patent law issue of inventorship gave district court subject matter jurisdiction under 28 U.S.C. § 1338). We therefore deny the motion without prejudice to the parties continuing to address the jurisdictional issue to the merits panel.

Accordingly,

IT IS ORDERED THAT:

(1) The motion is denied without prejudice to the parties raising the jurisdictional issue in the briefs.

(2) Memorylink's opening brief is due within 40 days from the date of filing of this order.

FOR THE COURT

MAY 02 2011

Date

/s/ Jan Horbaly

Jan Horbaly
Clerk

cc: Paul Eugene Schaafsma, Esq.
Anne M. Sidrys, Esq.

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FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

MAY 02 2011

JAN HORBALY
CLERK