

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

JED MARGOLIN	)	Case No. 3:09-CV-00421-LRH-VPC
	)	
Plaintiff,	)	
	)	
v.	)	
	)	
NATIONAL AERONAUTICS AND	)	
SPACE ADMINISTRATION,	)	
	)	
Defendant.	)	
_____	)	

**DECLARATION OF COURTNEY B. GRAHAM  
IN SUPPORT OF DEFENDANT'S  
RESPONSE TO MOTION FOR COSTS**

I, COURTNEY B. GRAHAM, hereby declare under penalty of perjury as follows:

1. I am the Associate General Counsel for Commercial and Intellectual Property Law in the Office of General Counsel of the National Aeronautics and Space Administration ("NASA"), and respectfully submit this declaration in support of defendant's opposition to plaintiff's motion for award of costs based upon my knowledge of the facts set forth herein, as well as my review of the pertinent documents referred to herein and annexed hereto.

2. The Court granted Defendant's Motion for Summary Judgment with the exception of the document identified at line #252 of the Index of Withheld documents. See Court's March 31, 2011 Order at page 18, lines 9-14.

3. The document identified at line #252 of the Index of Withheld Documents is a draft letter referenced “Administration Claim of W. Calvert for Infringement of U.S. Patent No. 6,107,962; NASA Case No. I-217” dated December 4, 2002, from John Mannix to Mr. W. Calvert. This document was attached to an email dated January 6, 2009 from Ms. Kathy Bayer, a Legal Technician in the NASA Headquarters Office of General Counsel, to Mr. Jan McNutt. The email and the document identified at line #252 are identified by Bates Nos. 03709-03711 (annexed hereto as Exhibit A).

4. Plaintiff's June 28, 2008 FOIA No. 08-270 requested “all documents related to the Administrative Claim for Jed Margolin for Infringement of U.S. Patent Nos. 5,566,073 and 5,904,724; NASA Case No. 1-222.”

5. The December 4, 2002 draft letter to W. Calvert was provided by Ms. Bayer to Mr. McNutt to use as a template in drafting the final determination in Case I-222, the claim that was the subject of Plaintiff's FOIA request. The draft letter is not related to Case I-222, nor does it reference Case I-222.

6. The December 4, 2002 draft letter is not responsive to FOIA No. 08-270 because it is not a document “related to the Administrative Claim for Jed Margolin for Infringement of U.S. Patent Nos. 5,566,073 and 5,904,724; NASA Case No. 1-222.”

7. The document identified at line #252 was released inadvertently because it is not within the scope of FOIA No. 08-270 and should not have been identified as responsive to Defendant's request.

I hereby declare under the penalty of perjury that the foregoing is true and correct to the best of my information and belief.

Dated: Washington, D.C.  
April 19, 2011

  
COURTNEY B. GRAHAM

# **EXHIBIT A**

**From:** Bayer, Kathy (HQ-MC000)  
**Sent:** Tuesday, January 06, 2009 12:14 PM  
**To:** McNutt, Jan (HQ-MC000)  
**Subject:** 02-37062.doc



02-37062.doc

Jan:

Here is the electronic version of the infringement letter I gave you in case you should need it.

Thanks.

Kathy Bayer  
Legal Technician  
NASA Headquarters  
Office of the General Counsel  
Suite 9T39  
300 E Street, SW  
Washington, DC 20546  
202-358-2040 (Phone)  
202-358-4341 (Fax)

December 4, 2002

GP(02-37062)

Mr. W. Calvert  
219 Friendship Street  
Iowa City, IA 52245

Re: Administrative Claim of W. Calvert for Infringement of U.S. Patent No. 6,107,962; NASA Case No. I-217

Dear Mr. Calvert:

This is in response to your letter of November 9, 2002, in which you reasserted your claim of NASA's unauthorized use of your Patent No. 6,107,962. As you were informed in my letter to you dated September 10, 2002, NASA has denied your administrative claim for patent infringement.

Under 28 U.S.C. § 1498(a), a patent owner has the right to file an action in the United States Court of Federal Claims for the recovery of his reasonable and entire compensation for the unauthorized use of an invention by the United States Federal Government. Thus, the United States Court of Federal Claims is where you have the right to bring your claim against NASA or any other Government agency. However, prior to filing a claim in the United States Court of Federal Claims, a patent owner has the option of pursuing an administrative claim directly against the responsible Government agency, in this case, NASA. In your case, you have pursued that option by filing an administrative claim against NASA for patent infringement. We have reviewed your claim and have denied it. That denial was based on the following three reasons:

- (1) Prior art has been brought to my attention that was not reported to the United States Patent and Trademark Office by you.
- (2) It appears that this invention was developed under a team project with other team members who were working with you under a NASA contract. None of the other team members were listed as inventors on your patent application.

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We are concerned that a team member may have contributed to the development of this invention and, thus, should have been acknowledged as a joint inventor.

- (3) There is strong evidence that this invention should have been reported under a contract with NASA with your former employer, University of Massachusetts, Lowell. In that case NASA would be entitled to a royalty free, nonexclusive license to use this invention.

Because of the above reasons, we do not agree with you that it is clear that you are entitled to compensation for the infringement of the subject patent. This agency decision is final. Any further consideration for your claim must be pursued in the United States Court of Federal Claims.

Cordially,

John G. Mannix  
Associate General Counsel  
(Intellectual Property)