

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF TEXAS
LUBBOCK DIVISION**

CARA WESSELS WELLS,
Plaintiff

v.

TEXAS TECH UNIVERSITY, SAMUEL
PRIEN, LINDSAY PENROSE,
Defendants.

§
§
§
§
§
§
§

CAUSE NO. 5:23-CV-00060-H

**INDIVIDUAL DEFENDANTS’ REPLY TO THEIR MOTION TO
DISMISS PLAINTIFF’S FIRST AMENDED COMPLAINT PURSUANT
TO FEDERAL RULE OF CIVIL PROCEDURE 12(B)(1) AND 12(B)(6)**

TO THE HONORABLE JAMES WESLEY HENDRIX:

Defendants Dr. Samuel D. Prien (“Dr. Prien”) and Dr. Lindsay Penrose (“Dr. Penrose”), collectively (“Individual Defendants”), file Individual Defendants’ Reply to Their Motion to Dismiss Plaintiff’s First Amended Complaint Pursuant to Federal Rule of Civil Procedure 12(B)(1) and 12(B)(6) (“Motion to Dismiss”). All of Plaintiff’s claims brought against the Individual Defendants should be dismissed.

1. Plaintiff’s intentional torts require mandatory dismissal under § 101.106(e) of the Texas Tort Claims Act.

Plaintiff claims that Drs. Prien and Penrose “failed to prove that their tortious misconduct was outside the scope of their employment.” Dkt. 34 at 4. However, it is not the Individual Defendants’ burden to “prove” Plaintiff’s alleged tort claims. Rather, it is the Plaintiff’s burden to allege sufficient facts and provide legal authority that would support how conducting research as research professors is outside the “general scope of the employee’s employment.” § 101.106(f).

Importantly, Plaintiff cites to a case in which the plaintiff alleged assault and battery against the professor in his individual capacity. *Jackson v. Texas S. Univ.*, 997 F. Supp. 2d 613, 649 (S.D. Tex. 2014). The defendants claimed that the professor was entitled to mandatory dismissal as the professor was acting within the scope of his employment under § 101.106(f) of the Texas Tort Claims Act. *Id.* The court held that proctoring an exam would be considered within the professor's scope of employment under "§ 101.106(f) [and] would extend sovereign immunity protection to him [for assault and battery] and foreclose the claim against him in his individual capacity." *Id.*

Assault and battery are quite distinguishable from Plaintiff's claims against Individual Defendants who, as she alleges, interacted with Wells in their capacity as research professors at TTU. Dkt. 19. Plaintiff did not bring any of her claims against Individual Defendants in their individual capacity according to her First Amended Complaint ("Complaint"). This is the first time that Defendants are notified that Plaintiff is bringing any claims against the Individual Defendants in their individual capacities. However, even had Plaintiff done so, *Jackson* establishes that under § 101.106(f), Individual Defendants' work as research professors would have been within the scope of their authority, foreclosing any individual capacity claim, and requiring mandatory dismissal. 997 F. Supp. 2d at 649.

Plaintiff alleges that she began working as a "research assistant in [Dr. Prien's] lab" around 2009 when she was an undergraduate student and that Dr. Prien "helped her attain a research internship at the Howard Hughes Medical Institute." Dkt. 19 ¶¶ 32-34. Through her research professors, Drs. Prien and Penrose, Wells alleges that beginning in October 2012, she began attending annual American Society for Reproductive Medicine conferences. *Id.* ¶¶ 38, 41, 44, 51. Plaintiff consistently alleges throughout her Complaint that she engaged in research with the Individual Defendants. Dkt. 19.

Accordingly, all of Plaintiff's intentional tort claims are subject to mandatory dismissal under both § 101.106(e) and § 101.106(f) and should be dismissed as a matter of law.

2. Sovereign immunity bars Plaintiff's patent inventorship claims.

Plaintiff amended her complaint to remove the patent inventorship claims against TTU, and asserting them *only* against the Individual Defendants, clearly admitting that Plaintiff is barred from bringing the claims against TTU by sovereign immunity and the Eleventh Amendment. Dkt. 19. This is the first time Plaintiff claims that she is bringing the claims against the Individual Defendants in both their official *and individual* capacities. She does not provide notice of this in the amended petition. Nevertheless, it is a distinction without a difference.

A. The relief that Plaintiff seeks is against TTU, not the Individual Defendants.

Importantly, TTU owns the patent at issue. If Plaintiff were to prevail on a correction of inventorship or invalidity claim, TTU's interests would be implicated by operation of law. Accordingly, TTU, not the professors, is the real party in interest to any claim related to its patents. This is a controversy with the State, and as such falls within the Eleventh Amendment and is barred.

It is settled law that "a federal court does not have the power to adjudicate the State's interest in property without the State's consent." *Kennedy Memorial Found. V. Mauro*, 21 F.3d 667, 671 (5th Cir. 1994).¹ For example, in *Kennedy Memorial Found.*, the court held that the plaintiff's suit against a state official seeking a declaration that the plaintiff had title to certain

¹ TTU has a concrete and recognized interest in the inventorship of the patent as owner of the patent and will be prejudiced if it is not joined in the claims. While the Individual Defendants are not the proper parties for Plaintiff's patent claims, for these same reasons, TTU is an indispensable party to the patent claims that cannot be joined under Rule 19 of the Federal Rules of Civil Procedure.

disputed property was not permissible under *Ex parte Young*. *Id.* at 673 (explaining the relief sought by the plaintiff—“no matter how its request for relief is phrased—would operate against the State” and therefore the State of Texas and not the state official is the “real, substantial party in interest”). Similarly, here, the substance of the relief Plaintiff seeks is an adjudication of inventorship whereby the right to who currently owns and has an interest in the patent is determined. Put another way, Plaintiff seeks to recover property of TTU that Plaintiff believes has been wrongfully withheld from her. No adjudication against the Individual Defendants would permit the relief that Plaintiff seeks.²

The Eleventh Amendment “prohibits suits against state officials or agencies that are effectively suits against a state.” *City of Austin v. Paxton*, 943 F.3d 993, 997 5th Cir. 2019); *Will v. Michigan Dep’t of State Police*, 491 U.S. 58, 71 (1989); *see also Hafer v Melo*, 502 U.S. 21, 25 (1991) (“Suits against state officials in their official capacity [] should be treated as suits against the State.”). Plaintiff’s attempt to re-characterize the relief she seeks for these claims as relief against the Individual Defendants is factually and legally infirm.

B. The *Ex parte Young* Exception Does Not Apply.

To the extent Plaintiff brings the claims against the Individual Defendants in their official capacity, the *Ex parte Young* exception does not apply.

Under *Ex parte Young*, a “federal court may enjoin ongoing activity that violates federal law.” *Pennington Seed, Inc. v. Produce Exch. No. 299*, 457 F.3d 1334, 1341 (Fed. Cir. 2006).

² For this reason, as well, Plaintiff lacks standing to bring these claims against the Individual Defendants because she has not shown facts demonstrating each element of standing, including: (1) an actual or imminent, concrete, and particularized injury-in-fact; (2) *that is fairly traceable to the challenged action of the defendant*; and (3) *that is likely to be redressed by a favorable decision*. *Lujan v. Defs. Of Wildlife*, 504 U.S. 555, 560-61 (1992) (emphasis added).

Here, Plaintiff's attempt to invoke *Ex parte Young* fails for the additional reason that it does not seek to enjoin the Individual Defendants from *any* ongoing violation of federal law.

Plaintiff has purported to assert claims against the Individual Defendants under the correction of inventor statute, 35 U.S.C. § 256. The statute provides two alternative paths for correcting the inventors named on a patent: a path in the USPTO (§ 256(a)), and a path in federal district court (§ 256(b)). With respect to the latter path, the statute provides that “[t]he court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned”³ and order the *Director of the USPTO*—not any of the parties—to issue a certification of correction. *Id.* Under this path, the district court would not direct any relief against the Individual Defendants, but directly to the USPTO. This would not result in the district court enjoining any ongoing activity on the part of the Individual Defendants, much less any ongoing violation of federal law. Instead, the Individual Defendants would be mere stand-ins for the State, in violation of state sovereign immunity. *See Pennington Seed, Inc.*, 457 F.3d at 1342 (holding that an *Ex parte Young* action was improper where plaintiff did not seek to enjoin any activity in violation of federal law by state official defendants; officials were merely a “representative of the state,” which “improperly make[s] a state a party to the suit”).

Similarly, Plaintiff has not established the required nexus between the violation of a federal law and the individual accused of violating that law. *Pennington Seed, Inc.*, 457 F.3d at 1341. As stated in *Pennington Seed*, “there must be a connection between the state officer and the enforcement of the act or else the suit will merely make him a representative of the state and therefore improperly make the state a party to the suit.” *Id.* at 1342. There must be “[a] nexus

³ For the reasons stated above, Plaintiff cannot bring the claims against “all parties concerned,” because sovereign immunity prevents Plaintiff from bringing the claims against TTU.

between the violation of federal law and the individual accused of violating that law requir[ing] more than simply a broad general obligation to prevent a violation; it requires an actual violation of federal law by that individual.” *Id.* at 1342–1343 (“The fact that a University Official has a general, state-law obligation to oversee a University’s patent policy does not give rise to a violation of federal patent law.”). When a violation of federal law is alleged, the state official whose actions violate that law is the rightful party to the suit and prospective injunctive relief can only be had against him.

Plaintiff’s claims against the Individual Defendants under 35 USC § 256 do not seek to enjoin those officials from engaging in any ongoing activities in violation of federal law. Plaintiff has not even attempted to identify any such activities in violation of federal law. Instead, Plaintiff’s claims are simply a means to Plaintiff’s desired end of obtaining property of the State of Texas—a patent owned by TTU.

Plaintiff’s argument is flawed for the additional reason that correction of inventorship under 35 U.S.C. § 256 is itself inherently retrospective in nature. The purpose of § 256 is to “correct” a past “error” of having omitted inventors (or of having named persons who are not inventors) on a patent application that later issues as a patent. Further, correction of inventorship is given retroactive effect. *See, e.g., Pannu v. Iolab Corp.*, 155 F.3d 1344, 1350-51 (Fed. Cir. 1998). This is impermissible retroactive relief barred by *Edelman v. Jordan*, 415 U.S. 651, 663 (1974).

Plaintiff’s claims are prevented by sovereign immunity and fail to state proper claims against the Individual Defendants. The district court should dismiss the correction of inventorship and invalidity claim with prejudice.

3. Sovereign immunity bars Plaintiff's Section 1983 Equal Protection claim.

Again, the Amended Complaint was filed against the following parties: “Defendant Dr. Samuel Prien . . . a professor of reproductive physiology at Texas Tech Health Sciences Center (TTUHSC)” and “Defendant Dr. Lindsay Penrose . . . an associate professor at TTUHSC,” clearly bringing the claims against Individual Defendants in their official capacities.” Dkt. 19 ¶¶ 18-19. Given that Plaintiff has alleged the Equal Protection claim against Individual Defendants in their official capacities, as a simple reading of the Amended Complaint demonstrates, the Individual Defendants are entitled to sovereign immunity for the § 1983 Equal Protection claim.

The *Ex parte Young* exception does not apply because Plaintiff has not alleged an *ongoing* violation of federal law. *See Pennington Seed, Inc.*, 457 F.3d at 1341. Plaintiff alleged that the last time she was a student or employee of TTU was in 2017. Dkt. 19. She fails to allege any ongoing violation since 2017. Furthermore, a § 1983 claim must be brought within two years of the alleged violation, or by 2019 in this case. *Price v. City of San Antonio*, 431 F.3d 890, 892 (5th Cir. 2005); *Ogletree v. Glen Rose Indep. Sch. Dist.*, 314 S.W.3d 450, 454 (Tex. App.—Waco 2010, pet. denied). Accordingly, Plaintiff's § 1983 Equal Protection claim is barred by sovereign immunity and time-barred.

4. Plaintiff fails to state a claim for relief against the Individual Defendants in their individual capacities.

By its terms, 42 U.S.C. § 1983 imposes liability on state and local officials who, acting under color of law in their individual capacity, deprive plaintiff of rights created by the Constitution and federal law.

As explained above, Plaintiff does not identify a violation of a constitutionally protected or federal law. Nor does Plaintiff establish a requisite nexus between an action taken by the

Individual Defendants and a violation of a federal law. Nevertheless, the Individual Defendants enjoy qualified immunity from suit.

Qualified immunity protects public officials from personal liability unless their conduct violates then clearly established constitutional law of which a reasonable person would have known. *See Pearson v. Callahan*, 555 U.S. 223, 236 (2009); *see also Hope v. Pelzer*, 536 U.S. 730, 739 (2002). Plaintiff utterly fails to plead that her constitutional rights were violated, that the right violated was “clearly established,” and that the Individual Defendants were personally responsible for the violation of her rights. Plaintiff’s claims against the Individual Defendants in their individual capacities should summarily be dismissed with prejudice.

5. Individual Defendants are entitled to official immunity.

Plaintiff incorrectly claims that Individual Defendants are not entitled to official immunity. As Plaintiff alleges, the Individual Defendants were always acting within their discretionary duties as research professors at TTU. Dkt. 19. Drs. Prien and Penrose acted in good faith and within their scope of authority in teaching, mentoring, and in their work as research professors at TTU. Dkt. 19 ¶¶ 32-34, 38, 41, 44, 47, 51. Wells alleges that she worked in Dr. Prien’s lab as a research assistant. *Id.* ¶¶ 34, 47. Wells alleges that she served as a teaching assistant in Dr. Prien’s class. *Id.* ¶ 50. The Individual Defendants have properly established that Plaintiff’s allegations support the Individual Defendants’ official immunity defense. Accordingly, all of Plaintiff’s state law claims against the Individual Defendants in their individual capacities should be dismissed as a matter of law.

6. Plaintiff fails to state a claim for misappropriation of trade secrets.

In her response, Plaintiff clarifies that her claim for trade secret misappropriation is based on an allegation that Dr. Prien interfered with Plaintiff’s contract with Simplot, which also

allegedly violated his contract with TTU. Dkt. 34 at 5. In the amended complaint, Plaintiff alleges that Embryotics (not herself personally) had a non-disclosure agreement in place with Simplot, which required Simplot's permission in order to disclose the alleged trade secret. Dkt. 19 ¶ 97. Nevertheless, Plaintiff alleges that the information that was subject to the agreement with Simplot is a trade secret. Dkt. 34 at 6.

Importantly, Plaintiff fails to allege that it is Plaintiff that owns the trade secret or has any standing to assert the rights over the trade secret. Instead, Plaintiff alleges that the alleged trade secret information belongs to Simplot and was only shared with her or Embryotics under a non-disclosure agreement. The DTSA and TUTSA only provide causes of action for the *owner* of a trade secret that is misappropriated. Under § 1839(4) of the DTSA, an “owner” is the person or entity in whom or in which rightful legal or equitable title to, or license in, the trade secret is reposed. 18 U.S.C. § 1839(4). Persons or entities without rights to the information at issue cannot be a party to the federal trade secret misappropriation cause of action. *See uSens, Inc. v. Shi*, No. 18-CV-01959-SVK, 2018 WL 11436323, at *3 (N.D. Cal. Oct. 11, 2018) (“[E]ven more fundamentally, Plaintiff has not shown that it is the owner of the alleged trade secrets.”). Similarly, under the TUTSA, an “owner” of a trade secret must have “rightful, legal, or equitable title to, or the right to enforce rights in, the trade secret.” Tex. Civ. Prac. & Rem. Code 134A.002(3-a). Plaintiff's failure to allege ownership over the alleged trade secret is a fatal defect to her claim.

7. This Court should deny Plaintiff's request for leave to amend because it would be futile.

Having failed to allege sufficient facts to support any of her causes of action, Plaintiff requests leave to amend her complaint a second time. Dkt. 34. at 8-9. Plaintiff has already been granted leave to amend once as of right. At this point, an amendment would be futile as Plaintiff cannot get around the § 1983, Title VII, and Title IX statute of limitations issues, qualified

immunity, official immunity, and sovereign immunity issues raised by Individual Defendants and TTU in their separate Motions to Dismiss and Replies. Accordingly, leave to amend should be denied as it would be futile and an inefficient use of judicial resources.

CONCLUSION

For all the foregoing reasons, Dr. Samuel D. Prien and Dr. Lindsay Penrose respectfully request that this Court grant Individual Defendants' Motion to Dismiss Plaintiff's First Amended Complaint Pursuant to Federal Rule of Civil Procedure 12(B)(1) and 12(B)(6) in their entirety.

August 15, 2023

/s/ Kirstin M. Erickson

KIRSTIN M. ERICKSON

Attorney in charge

Texas Bar No. 24134194

ALYSSA BIXBY-LAWSON

Texas Bar No. 24122680

Assistant Attorneys General

General Litigation Division

Kirstin.Erickson@oag.texas.gov

Alyssa.Bixby-Lawson@oag.texas.gov

Office of the Attorney General

P.O. Box 12548, Capitol Station

Austin, Texas 78711-2548

Phone: (512) 463-2120

Fax: (512) 320-0667

Counsel for Defendants

CERTIFICATE OF SERVICE

I hereby certify that on August 15, 2023, the foregoing *Individual Defendants' Reply to Their Motion to Dismiss Plaintiff's First Amended Complaint Pursuant to Federal Rule of Civil Procedure 12(B)(1) and 12(B)(6)* was electronically filed with the Clerk of the Court using the CM/ECF system, which will send a notice of electronic filing to the following counsel of record:

Matthew H. Davis
Brewer, Attorneys & Counselors
1717 Main Street, Suite 5900
Dallas, Texas 75201
mhd@brewerattorneys.com
Counsel for Plaintiff

William A. Brewer
Brewer, Attorneys & Counselors
750 Lexington Avenue, 14th Floor
New York, New York 10022
wbb@brewerattorneys.com
Counsel for Plaintiff
Admitted Pro hac vice

/s/ Kirstin M. Erickson

KIRSTIN M. ERICKSON

Assistant Attorney General