IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

BELCHER PHARMACEUTICALS, LLC,	:	
Plaintiff,	:	
v.	:	C.A. No. 17-775-LPS
HOSPIRA, INC.,	:	
Defendant.	:	

MEMORANDUM ORDER

At Wilmington this **5th** day of **June, 2019**:

Pending before the Court is Plaintiff's motion to dismiss (D.I. 162) Defendant's Counterclaim IV (D.I. 156). Having considered the parties' briefing (D.I. 163, 167) and related materials, IT IS HEREBY ORDERED that Plaintiff's motion to dismiss is GRANTED IN PART and DENIED IN PART.

Counterclaim IV seeks a declaratory judgment that the '197 Patent is "invalid and/or unenforceable" for failing to name the proper inventors as required by 35 U.S.C. § 101 and § 115(a). (D.I. 156 at ¶ 88-101) The parties dispute whether the counterclaim must be pled in accordance with Rule 8 or Rule 9 of the Federal Rules of Civil Procedure.

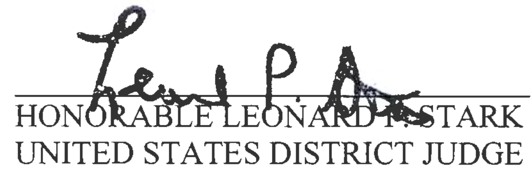
Plaintiff's motion is GRANTED to the extent Defendant's counterclaim asserts unenforceability due to improper inventorship. Generally, unenforceability is an equitable remedy premised on inequitable conduct or fraud, which must be pled in accordance with Rule 9. *See, e.g., Adv. Magnetic Closures, Inc. v. Rome Fastener Corp.*, 607 F.3d 817, 828 (Fed. Cir. 2010) ("If . . . the sole named inventor [] deliberately misrepresented that he invented the [patented idea] to the PTO, his deceit would spoil[ ] the entire barrel, leaving the [] patent

unenforceable.") (internal quotation marks omitted); *Bd. of Educ. ex rel. Bd. of Trustees of Fla. State U. v. Am. Bioscience, Inc.*, 333 F.3d 1330, 1344 (Fed. Cir. 2003) (finding patent unenforceable "for failure to correctly name inventors in cases where the named inventors acted in bad faith or with deceptive intent"); *see also Ferguson Beauregard v. Mega Sys., LLC*, 350 F.3d 1327, 1344 (Fed. Cir. 2003) (holding that "inequitable conduct, while a broader concept than fraud, must be pled with particularity"). Although Defendant insists it does not intend to plead improper inventorship due to inequitable conduct or fraud (*see* D.I. 167 at 3) ("[T]he Counterclaim does not implicate the heightened pleading standard for claims of inequitable conduct."), the Court's ruling makes abundantly clear that no such claim is part of this case.

Plaintiff's motion is DENIED to the extent Defendant's counterclaim asserts invalidity due to improper inventorship. Patent invalidity pursuant to § 101 and § 115(a) is a statutory remedy, and neither cited statute includes a mistake or fraud element that would otherwise implicate Rule 9.[1] *See* 35 U.S.C. § 101 ("Whoever invents or discovers [an invention] may obtain a patent. . . ."); 35 U.S.C. § 115(a) ("An application for patent . . . shall include . . . the name of the inventor. . . ."); 35 U.S.C. § 282(b) (establishing defenses including "[i]nvalidity of the patent . . . on any ground specified in part II as a condition for patentability"); *see also* MPEP § 2157 ("[W]here it is clear that the application does not name the correct inventorship . . . Office personnel should reject the claims under 35 U.S.C. [§] 101 and 35 U.S.C. [§] 115."). In

[1] Allegations of statutory invalidity due to improper inventorship also need not be accompanied by the names of the supposed correct inventors. A patent may be invalid simply because it names the wrong inventors. *See* 35 U.S.C. §§ 101, 115, 282; *see also Pannu v. Iolab Corp.*, 155 F.3d 1344, 1349 (Fed. Cir. 1998) (noting that, under pre-AIA § 102(f), patent validity rests on patent "accurately list[ing] the correct inventors of a claimed invention").

the Court's view, Defendant must plead its invalidity counterclaim in accordance with Rule 8, and here, Defendant has done so. (D.I. 156 at ¶¶ 93-99)



HONORABLE LEONARD P. STARK
UNITED STATES DISTRICT JUDGE