Another Inequitable Conduct Claim Falls in the EDVA: Fred Hutchinson v. Biopet

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Fred Hutchinson sued Biopet for infringement of a patent relating to a kit for dog breed identification services. The EDVA previously entered both a temporary restraining order and a preliminary injunction, enjoining the defendants from further sales of the accused products during the pendency of the litigation. On Monday, Judge Jackson issued another decision on the plaintiff's motion to dismiss and strike Biopet's counterclaims and affirmative defenses asserting inequitable conduct, granting the motion in full based on *Exergen* and *Therasense*.

Although concluding that Biopet had identified with sufficient particularity the "who" prong of Exergen, the Court concluded that "BioPet's cursury [sic] allegations that the inventors were aware of the material aspects of the alleged prior art based on citations to those works in unrelated publications fails to meet the standards for establishing the "what," "where" and "how" of the material omission." Specifically, the Court stated that:

> In order to satisfy this standard, the pleading must set forth "which claims, and which limitations in those claims, the withheld references are relevant to, and where in those references the material information is found" as well as "the particular claim limitations, or combination of claim limitations, that are supposedly absent from the information of record." Exergen, 575 F.3d at 1329.

What is more, the Court concluded that Biopet's allegations failed to allege that the individuals knew of the reference, knew that it was material, and made a deliberate decision to withhold it, as required by Therasense; rather, the allegations merely "invite speculation" about specific intent but do not plead any facts to support knowledge of the materiality of the references along with a deliberate decision to withhold them. That would have been sufficient, but the court went on:

> BioPet has not identified how the alleged prior art materially relates to any specific claim in the patent. It has not shown where in the alleged prior art such material references occur, nor has it provided an explanation of how such information would have been useful to the patent examiner.

This decision certainly sets the bar for what is required to plead inequitable conduct under *Exergen*, *Therasense*, and Rule 9(b).

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