

**UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF TEXAS  
MARSHALL DIVISION**

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<p><b>ERFINDERGEMEINSCHAFT UROPEP GbR,</b></p> <p style="text-align: right;"><b>Plaintiff,</b></p> <p style="text-align: center;"><b>vs.</b></p> <p><b>ELI LILLY AND COMPANY, and BROOKSHIRE BROTHERS, INC.,</b></p> <p style="text-align: right;"><b>Defendants.</b></p>	<p style="text-align: center;"><b>CIVIL ACTION No. 2:15-cv-01202-JRG</b></p> <p style="text-align: center;"><b>Judge: Hon. Rodney Gilstrap</b></p>
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**DEFENDANTS' MOTION TO DISMISS**

**I. INTRODUCTION**

Defendants Eli Lilly and Company (“Eli Lilly”) and Brookshire Brothers, Inc. (“Brookshire”) (collectively “Defendants”), pursuant to Fed. R. Civ. P. 12(b)(1), respectfully request that the Court dismiss this case for lack of subject matter jurisdiction. Plaintiff Erfindergemeinschaft Uropep GbR (“Plaintiff”) lacks standing to bring this patent infringement action suit because it does not own asserted U.S. Patent No. 8,791,124 (the “‘124 patent”).

The record in the United States Patent and Trademark Office (USPTO) shows that all title, rights and interest in the ‘124 patent have been assigned to a company called Uropep Biotech GbR, not Plaintiff.<sup>1</sup> Consequently, Plaintiff lacks standing to bring this patent infringement suit. While a later assignment by one of the inventors was attempted to Plaintiff,

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<sup>1</sup> When ruling on a motion to dismiss for lack of subject matter jurisdiction, “the district court may properly look beyond the jurisdictional allegations of the complaint and view whatever evidence has been submitted on the issue to determine whether in fact subject matter jurisdiction exists.” *Apex Digital, Inc. v. Sears, Roebuck & Co.*, 572 F.3d 440, 444 (7th Cir. 2009). Once a defendant challenges jurisdiction under Rule 12(b)(1), “the plaintiff bears the burden of coming forward with competent proof that standing exists.” *Id.*

there was nothing to assign to Plaintiff because all rights had already been transferred to another company, Uropep Biotech GbR, whose name is prominently displayed on the face of the ‘124 patent.

## **II. STATEMENT OF FACTS**

### **A. The ‘124 Patent Family History**

The asserted ‘124 patent is derived from a parent application, No. 09/462,090 (“the ‘090 application”), filed on July 9, 1997, as PCT application PCT/EP97/03617. The ‘090 application was subsequently abandoned.

On May 23, 2003, Application No. 10/443,870 (“the ‘870 application”) was filed as a continuation of the ‘090 application. This application eventually issued as U.S. Patent No. 8,106,061 (“the ‘061 patent”). The named inventors on the ‘061 patent are: Wolf-Georg Forssmann, Christian Georg Stief, Michael Carsten Truss, Stefan Uckert, and Udo Jonas. The named assignee on the ‘061 patent is Uropep Biotech GbR.

On December 29, 2011, Application No. 13/339,561 (“the ‘561 application”) was filed as a continuation of the ‘870 application. This application eventually issued as U.S. Patent No. 8,791,124 (“the ‘124 patent”), which is the patent asserted in this case. The named inventors on the ‘124 patent are the same inventors as on the ‘061 patent, and the named assignee on the ‘124 patent also is Uropep Biotech GbR.

Both the ‘124 and ‘061 patents are based upon continuation applications derived from the original ‘090 applications. Therefore, each application – the ‘090, ‘870 and ‘561 applications – contains the same specification and disclosures.

**B. All Rights, Title And Interest Of The Applications Leading To The ‘124 Patent Are Assigned To Uropep Biotech GbR**

The various assignments recorded in connection with the applications which led to the ‘124 patent show that the patent is owned by the named assignee on the face of the ‘124 patent, Uropep Biotech GbR, not Plaintiff. There are three assignment documents which relate to the ‘124 patent. (F. Boyd Decl, Exs. 1-5.)

In the first assignment document (“Document 1”)<sup>2</sup>, signed April 6, 2000, named inventors Stief, Truss, Uckert and Jonas assign “the entire right title and interest for the United States” in the inventions set forth in the ‘090 application to Forssmann, another named inventor. As noted above, the ‘090 application is the parent application from which both the ‘061 patent and the asserted ‘124 patent issued. As a result of the April 6, 2000 assignment, Forssmann acquired all rights, title, and interest in the alleged invention disclosed in the ‘090 application, *but for the United States only*.<sup>3</sup>

The second assignment document (“Document 2”)<sup>4</sup> was executed by all of the named inventors in August 2011 in connection with the ‘870 application. As noted above, this application is a continuation of the ‘090 application, the next application in the chain leading to the ‘124 patent. In Document 2, Forssmann, Stief, Truss, Uckert and Jonas assign all of their rights in the ‘870 application, as well as “all divisional, continuing, substitute, renewal, reissue, and all other applications”, in all countries, not only the United States, to Uropep Biotech GbR.

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<sup>2</sup> See F. Boyd Decl., Exs. 1, 2 and 4.

<sup>3</sup> For some reason, the same April 6, 2000 assignment (Document 1) has been recorded three times in the USPTO: once when first executed on April 6, 2000, and then twice on June 2, 2015.

<sup>4</sup> See F. Boyd Decl., Ex. 3.

The specific assignment language in the August 11, 2011 assignment (Document 2) is set forth below:

Hereby sell, assign and transfer to UroPep Biotech GbR, located at Erich-Ollenhauer-Str. 3, Garbsen 30827, Germany its successors, assigns and legal representatives (hereinafter, the "Assignee"), the entire right, title and interest for all countries, in and to any and all inventions which are disclosed and claimed, and as possessed by the undersigned, any and all inventions which are disclosed but not claimed in the application for United States Patent U.S. Serial No. 10/443,870 filed May 23, 2003 and is entitled

**USE OF PHOSPHODIESTERASE INHIBITORS IN THE TREATMENT OF PROSTATIC DISEASES**

and in and to said application and all divisional, continuing, substitute, renewal, reissue, and all other applications for U.S. Letters Patent or other related property rights in any and all foreign countries which have been or shall be filed on any of said inventions disclosed in said application; and in and to all original and reissued patents or related foreign documents which have been or shall be issued on said inventions;

Thus, by virtue of Document 2: (A) all the inventors (other than Forssmann) transferred their remaining rights outside the United States to Uropep Biotech GbR; and (B) Forssmann, who already owned all the rights to the application in the United States via the April 6, 2000 assignment (Document 1), transferred those U.S. rights as well as his remaining rights throughout the world, to Uropep Biotech GbR. Consistent with the August 2011 assignment, both the '061 patent and the asserted '124 patent name Uropep Biotech GbR as the owner of the patent.

On the eve of filing the present action, June 15, 2015, Plaintiff's counsel recorded a third assignment document ("Document 3")<sup>5</sup>. In Document 3, Forssmann alone purports to assign "the entire right title and interest for all countries" in U.S. Application No. 10/443,870 (which as noted above contains the identical subject matter and disclosure as the '090 application) to a company called "Erfindergemeinschaft UroPep GbR." Forssmann does so by literally taking

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<sup>5</sup> See F. Boyd Decl., Ex. 5.

Document 2 (the assignment to “Uropep Biotech GbR”) and simply crossing out the typed reference to “Uropep Biotech GbR” and typing above this crossed out name:

“Erfindergemeinschaft UroPep GbR.” Forssmann then signs his name in the margin of the document on June 6, 2015. No other inventor has executed this document.

At the time Forssmann executed Document 3, he had no rights to assign in this application. Forssmann had already assigned all of his rights in the United States and all other countries to “Uropep Biotech GbR” by virtue of Documents 1 and 2. Document 3 does not grant to plaintiff Erfindergemeinschaft UroPep GbR any ownership rights in the United States, or elsewhere, as all such rights were effectively transferred by all inventors to “Uropep Biotech GbR” in August 2011 via Document 2.

### **III. ARGUMENT**

#### **A. Plaintiff’s Complaint Should Be Dismissed For Lack Of Subject Matter Jurisdiction**

##### **1. To Have Standing In A Patent Infringement Action, Plaintiff Must Hold All Substantial Rights Under The Patent**

Federal courts have jurisdiction only to hear actual cases and controversies, U.S. Const. Art. III, § 2, cl. 1, and thus are without power to decide questions that cannot affect the rights of the litigants before them. *North Carolina v. Rice*, 404 U.S. 244, 246 (1971). The question of standing to sue implicates constitutional limitations on federal court jurisdiction. *Bennett v. Spear*, 520 U.S. 154, 162 (1997). If a plaintiff lacks standing, the district court has no subject matter jurisdiction. *See Perry v. Vill. of Arlington Heights*, 186 F.3d 826, 829 (7th Cir. 1999).

A plaintiff in a patent infringement suit must establish that it had standing at the time it filed suit. *Paradise Creations, Inc. v. U V Sales, Inc.*, 315 F.3d 1304, 1308 (Fed. Cir. 2003); *see also Keene Corp. v. U.S.*, 508 U.S. 200, 207 (1993). To demonstrate standing, a plaintiff must

“demonstrate that he has suffered [an] injury in fact, that the injury is fairly traceable to the actions of the defendant, and that the injury will likely be redressed by a favorable decision.” *Bennett*, 520 U.S. at 162 (citing *Lujan v. Defenders of Wildlife*, 504 U.S. 555, 560-61 (1992)); *see also Paradise Creations*, 315 F.3d at 1308. The Patent Act provides that only “[a] patentee shall have remedy by civil action for infringement of his patent.” 35 U.S.C. § 281; *see also Mentor H/S, Inc. v. Med. Device Alliance, Inc.*, 240 F.3d 1016, 1018 (Fed. Cir. 2001).

As defined in 35 U.S.C. § 100(d), the “term ‘patentee’ includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.” *Prima Tek II, LLC v. A-Roo Co.*, 222 F.3d 1372, 1377 (Fed. Cir. 2000). To have standing to sue for patent infringement, the one claiming to be the patentee must hold “all substantial rights under the patent.” *Id.* at 1377-78; *see also Fieldturf, Inc. v. Sw. Recreational Indus., Inc.*, 357 F.3d 1266, 1268 (Fed. Cir. 2004). If a patentee transfers all substantial rights under a patent in an assignment, “the assignee may be deemed the effective patentee under 35 U.S.C. § 281 for purposes of holding constitutional standing to sue another for patent infringement in its own name.” *Sicom Sys. Ltd. v. Agilent Tech., Inc.*, 427 F.3d 971, 976 (Fed. Cir. 2005).

In addition, if a patentee or valid assignee grants an exclusive license to a licensee, that licensee may have constitutional standing to sue for patent infringement. *See Morrow v. Microsoft Corp.*, 499 F.3d 1332, 1340 (Fed. Cir. 2007). However, “these exclusionary rights must be enforced through or in the name of the owner of the patent and the patentee [or valid assignee] who transferred these exclusionary interests is usually joined to satisfy prudential standing concerns.” *Id.*

Because standing to maintain a civil action for infringement must be determined as of the time suit was commenced, the Federal Circuit has repeatedly held that “in order to assert

standing for patent infringement, the plaintiff must demonstrate that it held enforceable title to the patent at the inception of the lawsuit.” *Paradise Creations*, 315 F.3d at 1309 (emphasis in original). A defect in standing at the inception of suit “cannot be cured after the inception of the suit.” *Id.* at 1310; *see also Lans v. Digital Equip. Corp.*, 252 F.3d 1320, 1324, 1328 (Fed. Cir. 2001) (plaintiff lacked standing to sue for infringement because he had previously assigned the patent to another entity); *Gaia Techs., Inc. v. Reconversion Techs., Inc.*, 93 F.3d 774, 778-80 (Fed. Cir. 1996) (plaintiff lacked standing to sue because it was unable to prove that it owned the patents and trademarks in suit at the time the action was filed).

**B. Plaintiff Lacks Standing To Bring This Action Because Uropep Biotech, Not Plaintiff, Owns the Asserted ‘124 Patent**

Plaintiff’s standing in the action, upon which subject matter of this Court depends, is premised on its ownership of the ‘124 patent. Plaintiff alleges that it is the owner “by assignment” of the ‘124 patent (Complaint at para. 17). That allegation, however, is false.

All the named inventors – including Forssmann – previously, in August 2011, assigned all rights in the alleged invention of the asserted ‘124 patent to Uropep Biotech GbR, years before any purported assignment by one of the named inventors to Plaintiff. The express language of a present assignment of the invention rights in the August 2011 assignment (Document 2) divested all the inventors (including Forssmann) of any legal title to the invention and immediately transferred legal title to the invention to Uropep Biotech GbR. *DDB Techs., L.L.C. v. MLB Advanced Media, L.P.*, 517 F.3d 1284, 1289-90 (Fed. Cir. 2008); *see also Speedplay, Inc. v. Bebop, Inc.*, 211 F.3d 1245, 1253 (Fed. Cir. 2000).

As any rights the inventors held were already assigned to another entity, none of the inventors (including Forssmann) had the right to execute a subsequent assignment to this Plaintiff. *DDB Technologies*, 517 F.3d at 1290. Consequently, the subsequent and litigation-

induced assignment in June 2015 is null and void. Plaintiff holds no rights to the '124 patent and has no standing to assert any rights against defendants stemming from the '124 patent. The present action must, therefore, be dismissed for lack of subject matter jurisdiction. *Paradise Creations*, 315 F.3d at 1309.

#### IV. CONCLUSION

For the foregoing reasons, the Court has no jurisdiction over the subject matter of this action, and, accordingly, pursuant to Federal Rule of Civil Procedure 12(b)(1), this case should be dismissed.

Dated: August 5, 2015

By: s/Jon B. Hyland

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**CERTIFICATE OF**  
**SERVICE**

The undersigned certifies that the foregoing document was filed electronically in compliance with Local Rule CV-5(a). As such, this motion was served on all counsel who are deemed to have consented to electronic service. Local Rule CV-5(a)(3)(A). Pursuant to Fed. R. Civ. P. 5(d) and Local Rule CV-5(d) and (e), all other counsel of record not deemed to have consented to electronic service were served with a true and correct copy of the foregoing by email and/or fax, on this the 5<sup>th</sup> day of August, 2015.

*/s/ Jon B. Hyland* \_\_\_\_\_

Jon B. Hyland