

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

UNITED THERAPEUTICS)	
CORPORATION,)	
)	
Plaintiff,)	
)	
v.)	C.A. No. 20-755 (RGA)
)	
LIQUIDIA TECHNOLOGIES, INC.,)	
)	
Defendant.)	

**PLAINTIFF’S OPENING BRIEF IN SUPPORT OF ITS
MOTION TO DISMISS DEFENDANT’S COUNTERCLAIM**

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Plaintiff United Therapeutics Corporation (“UT”) moves under Fed. R. Civ. P. 12(b)(6), or, alternatively, under Fed. R. Civ. P. 12(b)(1), to dismiss Defendant Liquidia Technologies, Inc.’s (“Liquidia”) counterclaim for a declaration of invalidity of U.S. Patent No. 10,716,793 (the “’793 patent”) and related defenses (*see* D.I. 23 at pp. 10-11, 16-18) under the doctrine of assignor estoppel.

I. NATURE AND STAGE OF PROCEEDINGS

On June 4, 2020, UT filed a complaint for patent infringement (“Complaint”) against Liquidia based on the notice of paragraph IV certification letter that UT received from Liquidia on or about April 27, 2020. D.I. 1 ¶¶ 18-19. UT amended its Complaint on July 22, 2020 to add infringement claims for the newly issued ’793 patent. D.I. 16. On August 5, 2020, Liquidia filed an Answer to the Amended Complaint and Counterclaims. D.I. 23.

II. SUMMARY OF THE ARGUMENT

Assignor estoppel bars Liquidia from asserting that the ’793 patent is invalid because Dr. Robert Roscigno, a named inventor on the ’793 patent who assigned his rights in the patent to UT, is in privity with Liquidia by virtue of his role as Liquidia’s Senior Vice President, Product Development and his substantial equity interest in Liquidia. Assignor estoppel is “an equitable doctrine that prevents one who has assigned the rights to a patent (or patent application) from later contending that what was assigned is a nullity ... [and] operates to bar other parties in privity with the assignor....” *Diamond Sci. Co. v. Ambico, Inc.*, 848 F.2d 1220, 1224 (Fed. Cir. 1988). This case presents the classic assignor estoppel scenario.

The Court should dismiss Liquidia’s invalidity counterclaims and defenses directed to the ’793 patent under Federal Rule of Civil Procedure 12(b)(6). In the alternative, if the Court chooses not to take judicial notice of the additional facts that demonstrate assignor estoppel for the motion

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