## Form E6-2. Affirmative Defenses and Counterclaim for Declaratory Judgment: Patent Claiming NHI-Derived Subject Matter

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**Use.** Issue E6 concludes that claims covering subject matter conceived by a non-human intelligence are unpatentable because no named person "invent[ed] or discover[ed]" it (35 U.S.C. §§100(f), 101, 115), that the defect cannot be cured by correction under §256 because no human inventor exists to substitute, and that a willful false declaration of original inventorship can render the patent unenforceable. The pleading below asserts those defenses and a matching counterclaim. It assumes the defendant has non-classified evidence (for example, released government records, public testimony, or the patentee's own statements) that the claimed design was observed in or taken from a recovered artifact or attributed by the patentee to a non-human source.

**When to use.** A defendant in a patent infringement suit who believes the patent claims NHI-derived subject matter. **Not for:** Facts counsel cannot support under Rule 11.

**Deadlines.** Answer within 21 days of service, or 60 days if service was waived (Fed. R. Civ. P. 12(a)).

**UNITED STATES DISTRICT COURT**
**FOR THE [_____] DISTRICT OF [_____]**

| | |
|---|---|
| [PATENTEE],<br>Plaintiff,<br><br>v.<br><br>[DEFENDANT],<br>Defendant. | Civil Action No.<br>[_____]<br><br>**DEFENDANT'S ANSWER, AFFIRMATIVE DEFENSES, AND COUNTERCLAIM [excerpts]** |

. . .

**AFFIRMATIVE DEFENSES**

**[Second] Defense: Invalidity for lack of a human inventor (35 U.S.C. §§100(f), 101, 115, 282(b)(2))**

1. Each asserted claim of U.S. Patent No. [__] (the "'[__] patent") is invalid because no person named as an inventor invented or discovered the claimed subject matter. A patent may be obtained only by "[w]hoever invents or discovers" the subject matter (35 U.S.C. §101), an "inventor" is the individual "who invented or discovered the subject matter of the invention" (§100(f)), and only natural persons may be inventors. *Thaler v. Vidal*, 43 F.4th 1207, 1211-12 (Fed. Cir. 2022).

2. On information and belief, the subject matter of claims [__] was conceived by a non-human intelligence and embodied in [describe the artifact or source in non-classified terms, e.g., "a recovered object described in (released record, date)"] before any named inventor had any idea of it. [Allege facts: the named inventor's access to the artifact or records; dates; the correspondence between the claim limitations and the artifact as described in (source); the patentee's own public statements attributing the design to a non-human source.]

3. Because no human conceived the claimed subject matter, inventorship cannot be corrected under 35 U.S.C. §256, and the claims are invalid.

**[Third] Defense: Invalidity under 35 U.S.C. §§102 and 103** [if the artifact or its description became public before the effective filing date]

4. Claims [__] are anticipated by, or obvious over, [the description of the artifact published on (date) at (source)] and [other references], which disclose each limitation of the claims.

**[Fourth] Defense: Invalidity under 35 U.S.C. §101 (law of nature)**

5. Claims [__] are directed to [the physical principle] and add no inventive concept beyond it. *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71-72 (2012).

**[Fifth] Defense: Invalidity under 35 U.S.C. §112(a)**

6. The specification does not enable a person of ordinary skill to make and use the full scope of claims [__] without undue experimentation, because [describe: e.g., it does not disclose how to make the claimed material or why the claimed mechanism operates].

**[Sixth] Defense: Unenforceability for inequitable conduct**

7. The '[__] patent is unenforceable. With particularity: (a) **who:** [named inventor(s)] [and prosecuting counsel]; (b) **what:** each named inventor executed a declaration under 35 U.S.C. §115 on [date] stating a belief that he or she was "the original inventor or an original joint inventor" of the claimed invention, and [failed to disclose / affirmatively misstated] that the claimed subject matter was [taken from / observed in] [source];

(c) **when and where:** [dates of declarations and filings; application no.]; (d) **how:** but for the misrepresentation the examiner would have rejected claims [__] under 35 U.S.C. §§101 and 115, and filing a false declaration is affirmative egregious misconduct (*Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276, 1292 (Fed. Cir. 2011) (en banc)); and (e) **intent:** [allege specific facts supporting a reasonable inference that the declarants knew the source of the subject matter and intended to deceive the USPTO, e.g., the inventor's contemporaneous statements, program access records, or public statements].

**COUNTERCLAIM**

8. Defendant incorporates its affirmative defenses.

9. **Parties, jurisdiction, venue.** [Allege.] The Court has jurisdiction under 28 U.S.C. §§1331, 1338(a), and 2201-2202. An actual controversy exists because Plaintiff has sued Defendant for infringement of the '[__] patent.

**Count I: Declaratory judgment of invalidity.** 10. Defendant is entitled to a declaration that claims [__] of the '[__] patent are invalid under 35 U.S.C. §§101, 102, 103, 112, and 115.

**Count II: Declaratory judgment of unenforceability.** 11. Defendant is entitled to a declaration that the '[__] patent is unenforceable for inequitable conduct.

**PRAYER**

Defendant asks the Court to dismiss the complaint with prejudice; declare the asserted claims invalid and the '[__] patent unenforceable; find this case exceptional and award attorney's fees under 35 U.S.C. §285; and grant such other relief as is just.

Dated: [_____] Respectfully submitted,

[signature block]

**Drafting notes**

- **Evidence and classification.** The defense will likely require discovery of the inventor's program access and lab records. If the patentee or the government asserts that the facts of conception are classified, consider moving for a protective order (Form A1-1) and arguing that a party may not enforce a patent while withholding the facts of its conception; the state secrets privilege can end the case for both sides (*Geospatial*, *Clift*; Issue E2). Consider notifying the Department of Justice early if the government's interests are implicated.
- **Burden.** Invalidity must be proved by clear and convincing evidence. Derivation doctrine requires proof of "prior conception of the invention by another and communication of that conception to the patentee" (*Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1576 (Fed. Cir. 1997)), which is hard to show for a non-human conceiver. The Second Defense is framed instead around the named inventor's lack of conception, which can be proved through the inventor's own records and access.
- **Open legal question.** Whether lack of a human inventor is a §282(b) invalidity defense after the repeal of former §102(f) is undecided. The USPTO treats §§101 and 115 as the source of the rule (90 Fed. Reg. 54636, 54637 (Nov. 28, 2025)). Plead §§101 and 115 together and preserve the issue.
- **Post-grant review.** Within nine months of grant, a petition for post-grant review may raise any §282(b)(2)-(3) ground (35 U.S.C. §321(b)-(c)) and may be a cheaper forum.
- Related: Issue E6, E2, A1; Forms E6-1, E6-3, A1-1.