UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
Alexandria Division

TRIANTAFYLLOS TAFAS, Plaintiff, v. JON W. DUDAS, et al., Defendants.	)	Civil Action No. 1:07cv846(L) (JCC/TRJ)

CONSOLIDATED WITH

SMITHKLINE BEECHAM CORPORATION, et al., Plaintiffs, v. JON W. DUDAS, et al., Defendants.	)	Civil Action No. 1:07cv1008 (JCC/TRJ)

DEFENDANTS' RESPONSE TO PLAINTIFF TRIANTAFYLLOS TAFAS'S OBJECTION TO DEFENDANTS' WITHDRAWAL OF ITS PARTIAL MOTION TO DISMISS BEING WITHOUT PREJUDICE

Citing absolutely no legal authority, Plaintiff Triantafyllos Tafas has filed an "Objection to Defendants' Withdrawal of Its Partial Motion to Dismiss Being Without Prejudice," Dkt. No. 58, complaining that he will suffer "burden and expense" if he is required to respond at the summary judgment stage to the arguments raised in Defendant Jon Dudas and the United States Patent and Trademark Office's (the "USPTO's") withdrawn Partial Motion to Dismiss. Objection, p. 2. Dr. Tafas's objection is plainly without merit and must be overruled.

Dr. Tafas's argument that "[i]t would be unfair for Defendants to put Dr. Tafas through another expensive process of briefing the issues raised in the withdrawn Partial Motion to dismiss given that Dr. Tafas has been through at [sic] expensive process already" defies logic. Id. Given that Dr. Tafas's lawyers have already briefed the arguments at the motion to dismiss stage, Dr. Tafas would incur no further burden or expense from his lawyers "cutting and pasting" those same arguments into a summary judgment brief. Dr. Tafas simply will not be prejudiced by the USPTO's withdrawal of its motion.

In any event, the USPTO cannot be barred from later raising again its jurisdictional challenges to standing and ripeness. See Def. Partial Motion to Dismiss, Dkt. Nos. 17, 18. It is firmly established that arguments concerning lack of subject matter jurisdiction cannot be waived and may be raised by a party or the court itself at any stage of proceedings. United States v. Cotton, 535 U.S. 625, 630 (2002) ("Subject-matter jurisdiction, because it involves the court's power to hear a case, can never be forfeited or waived."); Fed. R. Civ. P. 12(h)(3). Moreover, as Dr. Tafas himself observed in "Plaintiffs' Memorandum in Opposition to Defendants' Partial Motion to Dismiss," Dkt. No. 31, a different amount of evidentiary proof is required to establish standing at the motion to dismiss and motion for summary judgment stages. Id. at 4 (citing Bennett v. Spear, 520 U.S. 154, 168 (1997); Lujan v. Defenders of Wildlife, 504 U.S. 555, 561 (1992)). Thus, even assuming arguendo that Dr. Tafas sufficiently established standing at the motion to dismiss stage by responding to the USPTO's Partial Motion to Dismiss with a declaration that addressed some of the jurisdictional defects in his amended complaint, see Dkt. No. 31-2, the USPTO would still be allowed to challenge whether he had met his burden to establish standing at the summary judgment stage. See, e.g., Mgmt. Ass'n for Private Photogrammetric Surveyors v. United States, 492 F. Supp. 2d 540, 542 (E.D. Va. 2007) (granting

summary judgment on grounds of lack of standing after denying motion to dismiss on standing grounds).

Even as to the non-jurisdictional arguments in the USPTO's Partial Motion to Dismiss, Dr. Tafas points to absolutely no authority suggesting that arguments made by a party but withdrawn before a Court rules on them may never be raised again. Such authority appears not to exist. In fact, even if this Court had ruled upon and rejected the merits of the USPTO's arguments, which it did not, the USPTO could still raise its arguments again at the summary judgment stage, albeit facing an uphill battle in convincing the Court to change course.

In the end, the USPTO's withdrawal of its Partial Motion to Dismiss reflects the sea-change that occurred in the posture of this case between the time the USPTO filed its Partial Motion to Dismiss on October 4, 2007 and when it withdrew its motion on November 5, 2007. In this one month span, the case went from a single suit by a solo inventor who agreed not to seek a preliminary injunction, to a consolidated suit involving the second largest pharmaceutical company in the world, which succeeded in having this Court preliminarily enjoin the USPTO's final rules concerning claims and continuations practice. See generally, SmithKline Beecham Corp. et al. v. Dudas, 1:07cv1008, Dkt. Nos. 1-65. In the face of this dramatic shift, as well as a nearly forty-page Memorandum Opinion by this Court setting out its preliminary views on the Final Rules, see 1:07cv1008, Dkt. No. 64, the USPTO cannot be faulted for wanting to reevaluate its arguments for dismissal before asking this Court to pass on them. There is simply no basis for preventing the USPTO from later raising any of its arguments at the summary judgment stage.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on November 14, 2007, I electronically filed the foregoing with the Clerk of the Court using the CM/ECF system, which will send a notification of such filing (NEF) to the following:

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