

**IN IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA**

MALIBU MEDIA, LLC, Plaintiff,	CIVIL ACTION NO. 12-2078
v.	
JOHN DOES 1, 13, and 16, Defendants.	

ORDER

AND NOW, this 18th day of April, 2013, upon careful consideration of Plaintiff's Motion to Dismiss John Doe 16's Amended Counterclaims (ECF 116) and Defendant John Doe 16's Response in Opposition (ECF 119), it is hereby ORDERED that Plaintiff's Motion to Dismiss John Doe 16's Amended Counterclaims (ECF 116) is DENIED. Both Amended Counterclaims (ECF 109), for a declaration of non-infringement and for abuse of process, state plausible claims to relief under Fed. R. Civ. P. 12(b)(6).

As to the former, the Court has discretion to allow a counterclaim for a declaratory judgment of non-infringement to proceed. See 28 U.S.C. § 2201(a) (granting courts discretion to hear actions for declaratory judgments); Wilton v. Seven Falls Co., 515 U.S. 277, 288 (1995) (holding a district court's decision to dismiss an action for a declaratory judgment is reviewed for abuse of discretion). There is no Third Circuit precedent of which the Court is aware requiring dismissal of Doe 16's counterclaim seeking a declaration of non-infringement, just because it is encompassed in Defendants' affirmative defenses or is the converse of Plaintiff's cause of action. While some district courts have exercised their discretion in such a manner – dismissing counterclaims that are duplicative of affirmative defenses – there are also decisions in the opposite direction. Wright & Miller advise that in the analogous field of patent infringement,

courts should allow counterclaims for declarations of non-infringement to proceed, because such enables “the defendant [] to obtain a declaration of the patent’s status.” Wright & Miller, 6 Fed. Prac. & Proc. Civ. § 1406 (3d ed.).

As to the Counterclaim for abuse of process, the Counterclaim asserts fact about Plaintiff’s handling of this case which may, if Plaintiff’s claims are unsuccessful, entitle Defendant to recover damages.

BY THE COURT:

/s/ Michael M. Baylson

Michael M. Baylson, U.S.D.J.