IN THE UNITED STATES DISTRICT COURT

FOR THE WESTERN DISTRICT OF WISCONSIN

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NOVOZYMES A/S and
NOVOZYMES NORTH AMERICA, INC.,

Plaintiffs,

ORDER

10-cv-251-bbc

v.

DANISCO A/S,
GENECOR INTERNATIONAL WISCONSIN, INC.,
DANISCO US INC. and DANISCO USA INC.,

Defendants.

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Defendants Danisco A/S, Genecor International Wisconsin, Inc., Danisco US Inc. and Danisco USA Inc. have filed an appeal of the magistrate judge's June 30, 2011 order, dkt. #398, in which he denied their "Motion to Compel 30(b)(6) Deposition Topics 27 to 32." I am denying the motion because the magistrate's order is not clearly erroneous or contrary to law. 28 U.S.C. § 636(b).

Topics 27 to 32 relate to applications for U.S. Patent No. 7,498,158 and U.S. Patent 6,410,295, which defendants own but are not asserting in this case. However, like the asserted patent (U.S. Patent No. 7,713,723) the '158 patent and the '295 patent disclose

alpha-amylases that are altered at particular positions in their amino acid sequence. Defendants wish to explore through the deposition of a witness under Fed. R. Civ. P. 30(b)(6) the "research efforts" that led to the identification of the claimed positions in the '158 and '295 patents. The magistrate judge denied the motion because he concluded that the burden of discovery on these matters greatly outweighed any potential relevance they have.

In their objection to the magistrate judge's order, defendants argue that the depositions they are seeking are relevant to their invalidity defenses under 35 U.S.C. § 102(f) (inventorship) and 35 U.S.C. § 112, ¶ 1 (written description). They summarize their argument as follows: "the fact that Novozymes listed over 450 positions as stability increasing in two other patent filings involving the same inventors around the same time as the '723 patent applications tends to make less likely those inventors' claim to have invented 33 specific positions [in the specification for the '723 patent] they knew would lead to increased thermostability." Dfts.' Br., dkt. #401, at 3.

This argument sets up a strawman. The magistrate judge was not asked to determine the admissibility of the '158 or '295 patents or the applications leading up to those patents. If there is a dispute on that issue, it can be resolved in the motions in limine. The question before the court is whether defendants are entitled to explore *the reasons* defendants chose particular positions in two patents that are not being asserted in this case. I agree with the

magistrate judge that any relevance of such evidence is greatly outweighed by the burden of producing it. Because defendants have not cited any authority that requires a contrary conclusion, I see no reason to overrule the magistrate judge's decision.

ORDER

IT IS ORDERED that the motion filed by defendants Danisco A/S, Genecor International Wisconsin, Inc., Danisco US Inc. and Danisco USA Inc. to overturn the magistrate judge's June 30, 2011 discovery order, dkt. #401, is DENIED.

Entered this 5th day of August, 2011.

BY THE COURT:

/s/

BARBARA B. CRABB
District Judge