

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN

STEMINA BIOMARKER DISCOVERY, INC.,

Plaintiff,

v.

METABOLON, INC.,

Defendant.

ORDER

12-cv-494-bbc

In an order entered December 17, 2012, I dismissed some of plaintiff Stemina Biomarker Discovery, Inc.'s claims for declaratory judgment of noninfringement and invalidity of defendant Metabolon, Inc.'s patents. Dkt. #40. In particular, I dismissed plaintiff's claims relating to defendant's United States Patents Nos. 7,433,787; 7,561,975; 7,884,318; 7,949,475; 8,131,473; 8,175,816; 7,329,489; 7,635,556; 7,682,783; and 7,947,453, concluding that plaintiff had not shown that an actual controversy existed between the parties regarding those patents. Now before the court is plaintiff's motion for reconsideration with respect to the '489, '556, '783 and '453 patents. Dkt. #45. Although plaintiff contends that there is an actual controversy between the parties with respect to these four patents, plaintiff has provided no additional facts or legal arguments in support of its contentions and its argument remains unpersuasive. Therefore, I am denying plaintiff's motion.

The four patents at issue are part of defendant's "method patents" portfolio. As plaintiff points out, defendant has accused plaintiff of infringing the method patents generally on several occasions. In December 2011, defendant's president and CEO told plaintiff that it needed a

license for the methods patents, without specifying any particular patent numbers. In January 2012, defendant's outside patent counsel notified plaintiff that it believed plaintiff's technology used defendant's method patents, "including at least" the 7,550,258 and 7,910,301 patents. Dkt. #14-4. The parties began negotiating a possible license to defendant's portfolio of method patents. The draft licenses that were negotiated included language stating that defendant "ha[d] notified [plaintiff] that it is using [defendant's] Metabolomics Methods Patents and requires a license under those Patents." Dkt. #14-15. Later, after negotiations fell apart, plaintiff sued for a declaration of noninfringement and invalidity of all of defendant's patents (including its method patents and other patents).

Although defendant accused plaintiff generally of using its method patents, nothing in the record suggests that plaintiff operates in areas related to the dismissed patents. Instead, the facts suggest that defendant simply was referring to its method patents portfolio generally because defendant intended to license the patents as a portfolio. Defendant has conceded that plaintiff's research does not cover all areas in the methods patents, Dft.'s Br., dkt. #50, at 2, and plaintiff has adduced no facts suggesting that its products or research are related to the methods covered by the dismissed patents. Plaintiff has made no attempt to explain why it believes defendant could or might assert infringement claims for patents unrelated to plaintiff's research or products, or how the court could evaluate the claims of the dismissed patents to products or processes that do not exist. The parties have exchanged infringement contentions and defendant continues to assert only the three patents that remain in this case.

In sum, plaintiff has not supported its assertion that a case or controversy exists with respect to the dismissed method patents. Therefore, I am denying its motion for

reconsideration.

ORDER

IT IS ORDERED that plaintiff Stemina Biomarker Discovery, Inc.'s motion for reconsideration, dkt. #45, is DENIED.

Entered this 11th day of February, 2013.

BY THE COURT:

/s/

BARBARA B. CRABB

District Judge