IN THE UNITED STATES DISTRICT COURT

FOR THE WESTERN DISTRICT OF WISCONSIN

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EPPENDORF AG,

Plaintiff,

v.

BIO-RAD LABORATORIES, INC.,
MJ GENEWORKS, INC., and
MJ RESEARCH, INC.

Defendants.

ORDER

07-cv-623-bbc

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In this civil case for patent infringement, plaintiff Eppendorf AG alleges that defendants Bio-Rad Laboratories, MJ Geneworks, Inc. and MJ Research, Inc. are infringing claims 2 and 3 of its United States Patent No. 6,767,512 (the '512 patent). On June 18, 2008, Magistrate Judge Stephen L. Crocker entered an order striking the claims construction hearing set for July 18, 2008 and informed the parties that, pursuant to this court's new claims construction procedure, the parties would have to request construction of claim terms and a hearing if desired. The order stated that a party requesting construction of claim terms had to move for such relief and had the "burden to persuade the court that construction of each specified term is necessary to resolve a disputed issue concerning infringement or

invalidity." Order, June 18, 2008, Dkt. #31.

Both sides have requested construction of certain claim terms. Before turning to the parties' requests for construction, a note about procedure is in order. Rather than file a *motion* for construction of claim terms, plaintiff labeled the filing an initial claims construction brief (dkt. #36). Defendants, on the other hand, filed a motion separate from the brief in which it argued for specific construction of the terms. In the future, to avoid confusion and clutter, counsel should file a single document, labeled a motion, in which it requests construction of certain claim terms, explains how each term is necessary to resolve a disputed issue and submits its proposed constructions and all supporting arguments.

Defendants request construction of eight terms. Of the eight terms, defendant explains that four were important to shaping the scope of the patent during prosecution history and will be important to issues of invalidity and infringement. Dfts.' Mot., dkt. #43, at 2. Those terms are: "a temperature gradient in one direction across the thermostated block"; "arranged in an area contact with the contact side"; "opposite the at least two heat regulating devices"; and "arranged one after another in the direction of the temperature gradient." I am persuaded that construction of these terms may be necessary to resolve disputed issues related to infringement and invalidity, and will therefore grant defendants' motion as to these terms.

However, as for the remaining four terms for which defendants seek construction,

defendants expect that "the parties will not dispute their meaning which can be determined by reference to the specifications and common definitions." Dfts.' Mot., dkt. #43, at 2. Nonetheless, defendants believe they are entitled to a construction of the terms because "these elements use terms and phrases which may not be commonly understood by a jury." They cite O2 Micro International, Ltd. v. Beyond Innovation Technology Co., 521 F.3d 1351, 1361-63 (Fed. Cir. 2008), for the proposition that terms should be construed even if they have a common and ordinary meaning. This is not what O2 Micro says. Id. at 1361 (claim term may need construction when reliance on ordinary meaning does not resolve parties' dispute). O2 Micro requires only that a district court construe those claims for which "the parties present a fundamental dispute regarding the scope" or meaning of a claim term. Id. at 1362. Here, defendants admit that they expect no dispute for these terms, but want to prepare the jury. To the extent the parties believe that instructions construing claim terms presently not disputed are necessary to aid the jury, they can propose those instructions before trial. Construing the terms now is unnecessary and not a productive use of the court's or the parties' time.

Plaintiff requests construction of two claim terms found in claim 2 of the '512 patent: "At least two heat regulating devices . . . arranged at the contact side of the body in an area contact with the contact side" and "wherein at least half a number of all the wells provided in the wells side are located opposite the at least two heat regulating devices." Although

plaintiff has chosen to seek construction of larger blocks of text, it is clear the constructions relate to the same issues for which defendants seek construction with the terms: "arranged in an area contact with the contact side" and "opposite the at least two heat regulating devices." Therefore, plaintiff's motion for construction of the claim terms will be granted. I am persuaded that construction of these terms may be necessary to resolve disputed issues related to invalidity. Plt.'s Br., dkt. #36, at 6-7, 13; Plt.'s Resp. Br., dkt. #49, at 3, 8.

Having determined that construction is necessary for six claim terms, I next consider whether a claims construction hearing is necessary. Plaintiff says the court should not hold a hearing because plaintiff has not requested one and defendants have failed to explain why one is necessary. However, the hearing is for the court's benefit, not the parties'. The technology and legal arguments are sufficiently complex that a hearing would likely inform my construction of the claim terms. Therefore, a claims construction hearing will be set for its original date, July 18, 2008 at 9:00 a.m. Each side shall have 90 minutes to present all evidence and argument.

ORDER

IT IS ORDERED that:

1. Plaintiff Eppendorf AG's motion for construction of claim terms (dkt. #36) is GRANTED and defendants Bio-Rad Laboratories, MJ Geneworks, Inc. and MJ Research,

Inc. motion for construction of claim terms and a hearing is GRANTED in part and DENIED in part. The court will construe the following terms:

- "a temperature gradient in one direction across the thermostated block";
- "arranged in an area contact with the contact side";
- "opposite the at least two heat regulating devices";
- "arranged one after another in the direction of the temperature gradient."
- "at least two heat regulating devices . . . arranged at the contact side of the body in an area contact with the contact side"
- "wherein at least half a number of all the wells provided in the wells side are located opposite the at least two heat regulating devices."

2. A hearing will be held on Friday, July 18, 2008 at 9:30 a.m. at which the parties' may present evidence and argument related to the construction of any or all of the terms listed above.

Entered this 11th day of July, 2008.

BY THE COURT:

Barbara B. Crabb

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BARBARA B. CRABB
District Judge