

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

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

Plaintiffs,

v.

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

Defendants.  
-----

ORDER

10-cv-251-bbc

Plaintiffs Novozymes A/S and Novozymes North America, Inc. have filed a motion for reconsideration of the portion of the summary judgment order related to the “whole broth” products made and sold by defendants Danisco A/S, Genecor International Wisconsin, Inc., Danisco US Inc. and Danisco USA Inc. Dkt. #425. I am granting the motion, vacating the relevant portions of the summary judgment order and setting the matter for trial. In addition, I am granting plaintiffs’ motion to compel discovery related to the “whole broth” products, dkt. #419, and denying defendants’ motion to present their evidence first during the liability phase of the trial. Dkt. #414.

Plaintiffs are suing defendants for infringement of U.S. Patent No. 7,713,723, which discloses a variant of an enzyme called an alpha-amylase. In an opinion dated July 7, 2011, dkt. #399, I concluded that plaintiffs were entitled to summary judgment on their claims that defendants are infringing the '723 patent with respect to all of the accused products except for Spezyme Alpha WB, GC 133, and Clearflow WB, which the parties referred to as the "whole broth" products. I granted defendants' motion for summary judgment as to those products on the ground that they did not include an "isolated variant," as required by the asserted claims in the '723 patent. In particular, after construing "isolated" to mean "separated," I noted that plaintiffs had failed to adduce any evidence to rebut defendants' testimony that Spezyme Alpha WB, GC 133, and Clearflow WB do not go through any separation process. Dkt. #399, at 23-24. This order resolved all infringement claims as a matter of law, leaving only defendants' invalidity defenses for trial.

In their motion, plaintiffs point to new evidence that they say undermines defendants' testimony about the "whole broth" products. In particular, plaintiffs cite documents they received after summary judgment briefing was completed showing that the "whole broth" products undergo a filtering process that plaintiffs believe may satisfy the "isolated variant" limitation as construed by this court.

Defendants do not deny that they failed to discuss the filtering process in their summary judgment materials. However, they say that plaintiffs had documents in their

possession before summary judgment that would have allowed them to make this determination on their own. In the alternative, they argue that the new evidence is not material because the filtering process does not “separat[e] the active enzyme from cell materials and therefore does not ‘isolate’ the enzyme as required by the patent-in-suit.” Dfts.’ Br., dkt. #439, at 6.

Defendants’ first argument has some merit. They cite two emails they produced to plaintiffs in October 2010 that mention a “filter sock” and “filter hosing” used to strain “black particles” from Spezyme Alpha WB. Dkt. #440, exhs. A and B. Plaintiffs point out in their reply brief that the emails relate to testing done before the patent issued, but even if the emails left open questions about the extent to which defendants currently included a filtering step in the manufacturing process, this would mean that plaintiffs should have undertaken follow up discovery, not ignored the emails.

One explanation for plaintiffs’ failure to investigate the issue further may be that plaintiffs believed in good faith at that point that defendants were not denying that their products met the “isolated variant” limitation. When plaintiffs first asked defendants in interrogatories which elements of the claims they were challenging, the “isolated variant” was not one of them. Dkt. #427-2. It was not until March 2011 that defendants amended their interrogatory responses to raise that issue. Dkt. #427-3. This explanation is not entirely convincing, however, because it is ultimately plaintiffs’ burden to prove infringement with

respect to each element of the claims, not defendants' burden to disprove it. Plaintiffs cannot shift the burden through a contention interrogatory.

More persuasive is plaintiffs' argument that defendants did not identify the filtering step even when plaintiffs asked them in a March 2011 interrogatory to "describe in detail the process by which [defendants] manufactur[e] each Accused Product," dkt. #427-5, and that defendants did not include that step in their proposed findings of fact in which they described the manufacturing process. Defendants have not provided any justification for omitting that information. Although plaintiffs may bear some of the blame because they failed to understand the importance of documents in their possession and did not focus on this issue in discovery as much as they should have, I think that the equities favor plaintiffs. Defendants' discovery responses and summary judgment materials were incomplete and potentially misleading. Parties should not be encouraged to win their cases by suppressing relevant information.

Defendants may be correct that the filtering step in the "whole broth" does not produce an "isolated variant" as construed by this court, but it would be premature to resolve the question now. Plaintiffs are entitled to complete discovery on this issue before it is decided. Accordingly, I am granting plaintiffs' motion to compel defendants to (1) produce one or more witnesses who can testify on behalf of defendants about topics 9 (b-e), 14 and 16-17 of the Rule 30(b)(6) deposition notice with respect to the "whole broth" GC358

products; and (2) produce all nonprivileged documents relating to the process by which defendants manufacture each of the GC358 “whole broth” products that are responsive to Plaintiffs’ Request for Production No. 92. The only argument defendants develop in opposition to plaintiffs’ motion to compel is that the discovery sought is not relevant in light of the summary judgment order dismissing plaintiffs’ claims as to the “whole broth” products. Because I am vacating that portion of the summary judgment order and defendants do not develop an argument regarding the scope of plaintiffs’ motion to compel, I am granting the motion in full.

Trial is now less than two months away, which means that the schedule does not permit another round of summary judgment. Accordingly, the parties will have to make their arguments regarding the “whole broth” products to the jury in the first instance. If either side believes it is entitled to judgment as a matter of law after the evidence has been presented on those products, then those parties may file a motion under Fed. R. Civ. P. 50.

Finally, I am denying defendants’ motion to reverse the normal order of trial to allow them to present their evidence first. Although this request would make sense if invalidity were the only remaining issue to be tried, now that the trial will include issues related to infringement, there is no reason to depart from the standard order of proof.

## ORDER

IT IS ORDERED that

1. Plaintiffs Novozymes A/S's and Novozymes North America, Inc.'s motion for reconsideration, dkt. #425, is GRANTED. The portion of the July 7, 2011 order, dkt. #399, granting the motion for summary judgment filed by defendants Danisco A/S, Genecor International Wisconsin, Inc., Danisco US Inc. and Danisco USA Inc., with respect to plaintiffs' claims that Spezyme Alpha WB, GC 133, and Clearflow WB infringe claims 1-5, 8-13 and 15-16 of U.S. Patent No. 7,713,723, is VACATED.

2. Plaintiffs' motion to compel, dkt. #419, is GRANTED. Defendants are directed to (1) produce one or more witnesses who can testify on behalf of defendants about topics 9(b-e), 14 and 16-17 of the Rule 30(b)(6) deposition notice with respect to the "whole broth" GC358 products; and (2) produce all nonprivileged documents relating to the process by which defendants manufacture each of the GC358 "whole broth" products that are responsive to Plaintiffs' Request for Production No. 92.

3. Defendants' motion to alter the order of proof at trial, dkt. #414, is DENIED.

Entered this 24th day of August, 2011.

BY THE COURT:

/s/

BARBARA B. CRABB

District Judge