IN THE UNITED STATES DISTRICT COURT

FOR THE WESTERN DISTRICT OF WISCONSIN

- -

EMD CROP BIOSCIENCE INC.,
EMD CROP BIOSCIENCE CANADA INC.
and MCGILL UNIVERSITY,

Plaintiffs,

v.

BECKER UNDERWOOD, INC.,

Defendant.

ORDER

10-cv-283-bbc

- -

In this case for monetary and injunctive relief, plaintiffs EMD Crop Bioscience Canada Inc. and McGill University contend that defendant Becker Underwood, Inc. is infringing plaintiffs' United States Patent No. 6,979,664 (the '664 patent). Defendant has filed a motion requesting construction of nine terms in the patent. (Plaintiff has not requested claims construction but has proposed constructions for five of the terms requested by defendant). I will grant defendant's motion with respect to four terms.

In the magistrate judge's preliminary pretrial conference order, dkt. #38, he explained that it would be each "party's burden to persuade the court that construction of each specified term is necessary to resolve a disputed issue concerning infringement or invalidity."

Id. at 2. The court imposes that requirement to avoid deciding abstract questions that have no bearing on the lawsuit. "If [an] order represents a mere advisory opinion not addressed to resolving a 'case or controversy,' then it marks an attempted exercise of judicial authority beyond constitutional bounds. U.S. Const. art. III, § 2." Socha v. Pollard, 621 F.3d 667, 670 (7th Cir. 2010).

Defendant has explained how construction of the following four terms would help resolve clearly disputed issues of infringement: "strain that expresses a lipo chitooligosaccharide"; "effective amount"; "enhancing/enhances"; and "breaking of the dormancy or quiescence." Therefore, I will grant defendant's motion with respect to those terms.

Defendant has not explained why construction of the terms "immediate vicinity"; "incubating"; "providing"; "seed germination"; and "seedling emergence" is necessary, beyond statements such as "the parties disagree as to the scope of the claim term," dft.'s br., dkt. #68, at 26, or that the terms are "the heart of the '664 invention," id. at 38. In addition, defendant fails to explain *how* its proposed constructions of these five terms would resolve an issue as to infringement or invalidity. Without a specific explanation, it is impossible for the court to determine whether claim construction will be a useful exercise. Far too often, construing claim terms in a vacuum leads to additional disputes about the meaning of the court's construction at summary judgment or to revision when the context of the dispute is

revealed. Therefore, I will deny defendant's motion to construe these five terms. If defendant believes that construction of additional terms is necessary, it may ask for construction of those terms in the context of a motion for summary judgment or at trial.

Also, defendant requests a claims construction hearing, but does not "specify which terms require a hearing and provide grounds why a hearing actually is necessary for each specified term," as required by the magistrate judge's preliminary pretrial conference order. Dkt. #38, at 2. Defendant states only that "[o]ral argument will allow the parties to provide additional background on the relevant inoculant technology and answer the Court's questions with the goal of focusing the disputes. . . ." Dft.'s Br., dkt. #68, at 39. Without further explanation, such a statement does not persuade me that a hearing is necessary to resolve the parties' disputes. As plaintiffs note in their brief, "[a]lthough the [patent] is in a technically advanced area of plant biology, the asserted claims use simple, clear, and generally non-technical language." Plfs.' Br, dkt. #69, at 1. Moreover, the explanations and interpretations provided in the written briefs and their accompanying documents are understandable. Accordingly, although I will construe four of the terms put forward by defendant, there will be no claims construction hearing; the terms will be construed using the parties' written submissions.

ORDER

IT IS ORDERED that

1. Defendant Becker Underwood, Inc.'s motion for construction of claim terms, dkt. #68, is GRANTED in part and DENIED in part. The court will construe the following terms:

a. "strain that expresses a lipo chitooligosaccharide" as used in claims 22, 33 and 34;

b. "effective amount" as used in claims 1 and 17;

c. "enhancing/enhances" as used in claims 1, 9, 16, 22, 27, 28, 33 and 34; and

d. "breaking of the dormancy or quiescence" as used in claim 17.

2. No claims construction hearing will be held; the terms listed above will be construed using the parties' written submissions.

Entered this 14th day of February, 2011.

BY THE COURT:
/s/
BARBARA B. CRABB
District Judge