IN THE UNITED STATES DISTRICT COURT

FOR THE WESTERN DISTRICT OF WISCONSIN

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GENETIC TECHNOLOGIES LIMITED,

                                            ORDER

                Plaintiff,

                                   10-cv-69-bbc

      v.

ORCHID CELLMARK, INC. and PIC USA, INC.,

                Defendants.

- -

      In this case for patent infringement, the parties have filed cross motions for the construction of several terms in United States Patent No. 5,612,179. These motions will be denied because the parties have not shown that their proposed constructions will help resolve any claims or defenses at issue in this case.

      In the magistrate judge's preliminary pretrial conference order, dkt. #111, 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 purpose of that requirement is 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

1

authority beyond constitutional bounds. U.S. Const. art. III, § 2." Socha v. Pollard, 621 F.3d 667, 670 (7th Cir. 2010).

At this stage, the parties have not shown that they are asking for anything other than an advisory opinion. In its brief, plaintiff says that it "is mindful that the parties must persuade the Court that the construction of one, some or all of the disputed terms is necessary to resolve a disputed infringement or validity issue before the Court will construe them." Plt.'s Br., dkt. #149, at 5. However, plaintiff does not actually identify any issues that will be resolved by its proposed constructions.

Defendants do a bit more in their brief, including a section for each term called, "[c]onstruction will resolve a disputed issue of infringement or invalidity." The problem is that defendants fail to specify *how* their proposed constructions will do this. With respect to each term, they repeat the same boilerplate, conclusory assertion that construction of the term will allow defendants to move for summary judgment on noninfringement or "greatly expand" the prior art that may be applicable to invalidate the asserted claims. However, they never explain why they believe their proposed construction will show noninfringement or invalidity.

The court cannot simply take defendants' word that each of their nine proposed constructions will advance the case. 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.

District courts have an obligation to construe terms when it is necessary to resolve a genuine and material legal dispute between the parties. O2 Micro Intern. Ltd. v. Beyond Innovation Technology Co., Ltd., 521 F.3d 1351, 1361-62 (Fed. Cir. 2008). If a party shows at summary judgment or at trial that construction is needed to resolve a material dispute, the court will provide it. However, courts have no obligation to provide constructions simply because the parties request them; the parties must demonstrate that the construction is both necessary and correct. Id.; see also E-Pass Techs., Inc. v. 3Com Corp., 473 F.3d 1213, 1219 (Fed. Cir. 2007) ("[A]ny articulated definition of a claim term ultimately must relate to the infringement questions that it is intended to answer.").

Because the parties have failed to meet their burden to show that any terms require construction, I am denying their motions. The parties are free to request construction again in the context of a motion for summary judgment or at trial.

ORDER

IT IS ORDERED that the motions requesting claim construction filed by plaintiff Genetic Technologies Limited, dkt. #149, and defendants Orchid Cellmark, Inc. and PIC

USA, Inc. are DENIED.

Entered this 24th day of January, 2011.

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