

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

CIVIL ACTION NO. 04-10339-RWZ

L-3 COMMUNICATIONS SECURITY AND
DETECTION SYSTEMS CORPORATION DELAWARE

v.

AMERICAN SCIENCE & ENGINEERING, INC.

MEMORANDUM OF DECISION

June 20, 2006

ZOBEL, D.J.

Plaintiff L-3 Communications Security and Detection Systems Corporation Delaware sued defendant American Science & Engineering, Inc. for declaratory judgment of non-infringement, invalidity and unenforceability as to two patents held by defendant concerning mobile x-ray technology, U.S. Patent Number 6,292,533 (the “533 patent”) and U.S. Patent Number 5,903,623 (the “623 patent”). Following its successful motion for summary judgment on invalidity of 36 claims of the ‘623 patent, plaintiff now moves for summary judgment on all remaining claims of that patent. Instead of opposing the motion, defendant moves for dismissal of the case for lack of jurisdiction, for attorneys’ fees, and for a stay of all proceedings.

This case arose from defendant’s refusal to covenant not to sue plaintiff on the two patents in question. Now, having lost on many claims of the ‘623 patent, defendant has provided a limited covenant not to sue plaintiff on these patents only as to three specific products by plaintiff. Defendant reasons that its covenant eliminates any

actual controversy between the parties and thereby deprives the court of jurisdiction. Plaintiff, not surprisingly, disagrees and refuses to accept the covenant as sufficient to dismiss the case unless it prohibits suit on the patents on all grounds, not just three systems. Clearly, defendant's proffered covenant has not eliminated the controversy in this case. Furthermore, the fact that plaintiff has succeeded on some of its claims does not foreclose its entitlement to proceed with the remainder of its original claims and does not provide a basis for sanctioning plaintiff for "continuing to press this litigation." (Def.'s Mem. in Support of Mot. to Dismiss 12). Defendant has identified no legitimate basis for staying the case.

Accordingly, defendant's Motion to Dismiss (#98 on the docket) is denied, and any opposition by defendant to plaintiff's pending Motion for Summary Judgment shall be filed by July 10, 2006.

06/20/06

DATE

/s/ Rya W. Zobel

RYA W. ZOBEL

UNITED STATES DISTRICT JUDGE