

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

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WISCONSIN ALUMNI RESEARCH  
FOUNDATION,

Plaintiff,

v.

INTERNATIONAL BUSINESS MACHINES  
CORPORATION,

Defendant.  
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ORDER

04-C-867-C

Plaintiff Wisconsin Alumni Research Foundation has moved to strike the expert report of defendant International Business Machines Corporation's expert, Gerald J. Mossinghoff. It appears from the report that defendant intends to produce Mossinghoff as an expert in patent prosecution, the handling of patent applications by the Patent and Trademark Office and the duty of candor and good faith owed the Patent and Trademark Office by applicants.

The motion to strike is GRANTED. Testimony about the duty of candor is irrelevant because defendant never alleged fraud on the patent office. Such a claim must be set forth with particularity, not smuggled into a complaint as part of a general defense of patent unenforceability.

Even if the claim had been pleaded properly, Mossinghoff's report would be stricken. Fraud on the patent office is an equitable claim that is tried to the court. It is not necessary

to have an expert educate a judge about the duty of candor or about the handling of patent applications by the patent office.

Entered this 29th day of August, 2005.

BY THE COURT:

/s/

BARBARA B. CRABB

District Judge