

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

THIRD WAVE TECHNOLOGIES, INC.,

Plaintiff,

v.

ERAGEN BIOSCIENCES, INC.,

Defendant.

ORDER

02-C-0507-C

This patent infringement case is before the court on the motion of plaintiff Third Wave Technologies, Inc. to strike defendant Eragen Biosciences, Inc.'s affirmative defenses and counterclaim of invalidity. Plaintiff contends that defendant is precluded from raising any challenge to the validity of plaintiff's patents because its chief scientific officer, Dr. James Prudent, was an inventor and assignor of the patents to plaintiff while he was employed by plaintiff. Plaintiff argues that the doctrine of assignor estoppel bars defendant from defending against the infringement suit on the ground of invalidity of the patents allegedly infringed. Defendant denies that the doctrine applies, arguing that Prudent is not in privity with defendant, that even if defendant is estopped from attacking both of the patents in dispute, it is not barred from attacking the '314 patent because Prudent was not

an inventor on that patent but was named as one without his knowledge and that plaintiff's improper post-assignment conduct before the United States Patent and Trademark Office deprives plaintiff of the right to claim assignor estoppel.

I can appreciate why plaintiff would like to have the matter of assignor estoppel decided early in this litigation. However, there are good reasons why courts do not favor motions to strike. 5A Charles Alan Wright & Arthur Miller, Federal Practice and Procedure § 1380, p. 647 (2d ed. 1990). In this instance, plaintiff's motion to strike depends upon a number of highly disputed matters outside the pleadings. Although it would be possible to convert it to a motion for summary judgment, id. at 658, I doubt that doing so would advance the determination of the validity of the affirmative defenses and counterclaim, given the number of disputes. If, however, plaintiff thinks that it has a chance of prevailing on such a motion and wants to file one, it may do so, following the requirements of this court's Procedures for Filing Summary Judgments. In plaintiff does file a motion for summary judgment, event, defendant may have the usual three weeks for a brief and proposed findings of fact in opposition and plaintiff may have ten days for a reply.

ORDER

IT IS ORDERED that the motion of plaintiff Third Wave Technologies, Inc. to strike affirmative defenses and counterclaim is DENIED on the ground that it relies on matters

outside the pleadings and should properly be brought as a motion for summary judgment.

Entered this 16th day of December, 2002.

BY THE COURT:

BARBARA B. CRABB
District Judge