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 7 THE BOARD OF TRUSTEES OF THE LELAND STANFORD  
 JUNIOR UNIVERSITY and Counterclaim Defendant THOMAS  
 8 MERIGAN

9 UNITED STATES DISTRICT COURT  
 10 NORTHERN DISTRICT OF CALIFORNIA

11  
 12  
 13 THE BOARD OF TRUSTEES OF THE  
 14 LELAND STANFORD JUNIOR  
 UNIVERSITY,

15 Plaintiff,

16 v.

17  
 18 ROCHE MOLECULAR SYSTEMS, ET AL.,

19 Defendants.

20 ROCHE MOLECULAR SYSTEMS, ET AL.,

21 Counterclaimants,

22 v.

23  
 24 THE BOARD OF TRUSTEES OF THE  
 25 LELAND STANFORD JUNIOR  
 UNIVERSITY; AND THOMAS MERIGAN,

26 Counterclaim Defendants.  
 27

Case No. C 05 04158 MHP

**STANFORD UNIVERSITY AND DR.  
 MERIGAN'S RESPONSE TO DEFENDANTS'  
 PROPOSED DISCOVERY PLAN  
 REGARDING THE CONTRACT ISSUES**

1 **I. INTRODUCTION**

2 Pursuant to the Court's February 13, 2006 order, Stanford University and Dr. Merigan  
3 (collectively, "Stanford") identify herein the discovery and trial issues relevant to the contract  
4 assertions Roche has made. The identification of these issues makes clear that: (1) the discovery  
5 related to the contract issues is far from limited; (2) resolution of the issues will require discovery  
6 and examination of technical issues that overlap and are intertwined with the core patent issues in  
7 the case; and (3) the jury issues overlap with the core patent issues in the case, and thus a  
8 bifurcated trial would result in a violation of Stanford's right to a jury trial. Thus, this case  
9 should proceed expeditiously on all issues, under the patent local rules or the shorter schedule  
10 presented by Stanford.

11 Roche's submission does not provide a fair assessment of the time, expense, effort, and  
12 court involvement that would be required to resolve the contract issues. As shown below, even if  
13 all of the issues identified by Roche were resolved in its favor, it would not prevail on the contract  
14 issues or in the case. Further, a document recently—and reluctantly—produced by Roche  
15 demonstrates that Roche never even obtained the rights to the Merigan agreements that it claims  
16 were provided by its purchase of certain Cetus assets. Coupled with the fact that both Cetus and  
17 Roche have long known of the inventors' work, any bifurcation would serve only to needlessly  
18 increase the burden on the Court, third party witnesses, and Stanford and unnecessarily delay the  
19 resolution of this matter.

20 **II. ISSUES FOR RESOLUTION**

21 **A. Resolution of Issues that Would Bar Roche's Contract Defenses/Claims**

22 Roche's submission to the Court ignores Stanford's position that the contracts are not  
23 enforceable in the first place. Roche's purchase of Cetus assets did not even purport to pass the  
24 rights to two of the Merigan agreements that Roche claims it possess. Further, Roche and Cetus  
25 knew of the work of the inventors long ago and failed to assert any breach.<sup>1</sup> This failure to act

26 \_\_\_\_\_  
27 <sup>1</sup> For example, the inventors disclosed many aspects of the invention in a 1991 JCI article, almost  
28 15 years ago. (Rodriguez Decl. Ex. A.) This article was cited in subsequent articles on which  
key Roche employees were authors. (Lin *et al.*, Journal of Infectious Diseases, 170:553-62  
(1994) (*Id.* Ex. B); Coombs *et al.*, Journal of Infectious Diseases, 174:704-12 (1996) (*Id.* Ex. C).)

1 confirms that no breach has occurred, but also operates to bar Roche from asserting breach. Only  
 2 if Roche prevails on all of the issues below, would it be able to assert that a breach has occurred.

### 3 **1. Standing**

4 Roche identifies this as its last issue, but it should be the first. Roche must prove that it  
 5 obtained all of the rights to the contracts at issue.<sup>2</sup> Roche recently produced the contract by  
 6 which it purchased Cetus assets. *This contract shows that the 1984 and 1991 Merigan*  
 7 *agreements are not among the agreements Cetus transferred to Roche.* (See Purchase  
 8 Agreement, Rodriguez Decl. Ex. D at §§ 2.1(d) & (g).) At most, only the confidentiality  
 9 provisions of those agreements were transferred. (*Id.*) Standing is an issue for the Court to  
 10 decide. *4805 Convoy, Inc. v. City of San Diego*, 183 F.3d 1108, 1111 (9th Cir. 1999) (standing is  
 11 a question of law).

### 12 **2. Statute of Limitations**

13 In late 1991, the inventors published a scientific article that provided the details regarding  
 14 the invention (the “JCI Article”). By that date, and likely even before, Cetus knew or should have  
 15 known of all of the alleged breaches. Thus, the statute of limitations has long expired, precluding  
 16 assertion of a breach now. This is an issue for the Court to decide, based upon factual issues  
 17 resolved by the jury, if necessary. *See, e.g., Garter-Bare Co. v. Munsingwear, Inc.*, 723 F.2d 707,  
 18 710 (9th Cir. 1984) (statute of limitations issues are decided by the court based upon facts  
 19 determined by the jury). Based on the facts here, it is likely the Court could resolve this issue in  
 20 Stanford’s favor on summary judgment.

### 21 **3. Laches/Estoppel**

22 Cetus/Roche’s failure to timely allege a breach also precludes Roche’s contract arguments  
 23 under the doctrines of laches and estoppel. This is generally an issue for the Court to decide.

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24  
 25 <sup>2</sup> Contrary to Roche’s assertion, Roche must do more than merely prove that it qualifies as a  
 26 “successor-in-interest” to Cetus; it must prove that it complied with any legal requirements for  
 27 obtaining the rights, and that those rights were transferable to begin with. *In re CFLC, Inc.*, 89  
 28 F.3d 673, 679-680 (9th Cir. 1996) (patent license not assignable without express consent of patent  
 holder); *PPG Indus., Inc. v. Guardian Indus. Corp.*, 597 F.2d 1090, 1095 (6th Cir. 1979)  
 (rejecting argument that patent license automatically transferred to successor-in-interest after  
 merger).

1 *Gump's, Inc. v. Byers' Choice, Ltd.*, 22 U.S.P.Q.2d 1797, 1799 (N.D. Cal. 1992) (error to give  
 2 issue of equitable laches defense to jury); *Granite State Ins. Co. v. Smart Modular Techs., Inc.*, 76  
 3 F.3d 1023, 1027 (9th Cir. 1996) (equitable defenses, such as estoppel, are to be resolved by the  
 4 court not jury, except to the extent they involve issues common to the legal claims that are tried  
 5 by a jury).

#### 6 **4. Waiver**

7 Cetus/Roche's failure to timely allege a breach also precludes Roche's contract arguments  
 8 under the doctrine of waiver. This is an issue for the jury to decide. *Old Republic Ins. Co. v. FSR*  
 9 *Brokerage, Inc.*, 80 Cal. App. 4th 666, 679 (Cal. Ct. App. 2000) (waiver is question of fact to be  
 10 decided by jury).

#### 11 **5. Enforceability**

12 In order to comply with California law, the provisions in the contracts must either be  
 13 interpreted to preclude any rights in the patents in suit, or declared unenforceable. For example,  
 14 California law imposes severe restrictions on non-compete clauses or contract provisions that  
 15 have a similar effect. Cal. Bus. & Prof. Code § 16600. This is an issue for the jury to decide.  
 16 *Campbell v. Board of Trustees of the Leland Stanford Junior Univ.*, 817 F.2d 499, 503 (9th Cir.  
 17 1987) (holding that summary judgment improper because trial necessary to resolve factual issue  
 18 of whether contract restrained doctor from his profession, trade or business within the meaning of  
 19 Section 16600).

#### 20 **B. Issues Related to Roche's Allegations of Breach**

21 Roche's counterclaims and defenses are based on four contracts. It is unclear how Roche  
 22 can assert that the contracts present no issues for a jury to resolve. Breach is jury question.<sup>3</sup>  
 23 Examples of the jury issues are set forth below.<sup>4</sup> Further, as to each contract, Roche's submission  
 24 selectively quotes from the contract, fails to inform the Court of other key provisions, and fails to

25 <sup>3</sup> *Ctr. Found. v. Chicago Ins. Co.*, 227 Cal. App. 3d 547, 561 (Cal. Ct. App. 1991) (holding that,  
 26 because of factual issues, it was error for court to decide breach of contract issue as matter of law  
 27 and it was jury's role to decide if and when breach of contract occurred). Additionally, a jury  
 28 determines factual issues pertaining to interpretation where there is conflicting parol evidence.  
*Wolf v. Superior Court*, 114 Cal. App. 4th 1343, 1351 (Cal. Ct. App. 2004).

<sup>4</sup> This is not intended to be an exclusive list, since discovery will likely reveal additional issues.

1 attach the full text of the contract. The unabridged contracts have been attached for the Court’s  
2 reference.

3 **C. The April 13, 1984 Consulting Agreement**

4 **1. Issues relating to Stanford’s rights**

5 The sentence quoted by Roche is immediately followed by the following provisions:

6 *It is understood that nothing contained herein shall affect the rights or*  
7 *obligations of CONSULTANT, the Institution or the United States Government*  
8 *with respect to (x) any Inventions which are protected by Section 2870 of the*  
9 *California Labor Code, (y) any Inventions which are the products of*  
10 *CONSULTANT’s research undertaken in connection with his employment by*  
11 *the Institution, to the extent that such Institution shall have any rights in any*  
12 *such Invention in accordance with CONSULTANT’s existing agreement with*  
13 *such Institution or (z) any Inventions which are the products of*  
14 *CONSULTANT’s research as contemplated by Section 3.4, to the extent the*  
15 *Institution and/or the United States Government shall have any rights in such*  
16 *Inventions. Notwithstanding the immediately preceding sentence, in the event*  
17 *that an Invention made, conceived or completed by CONSULTANT in*  
18 *connection with his obligations to the Institution is the subject of a specific*  
19 *project to which CONSULTANT is assigned by CETUS, such Invention shall be*  
20 *the sole and exclusive property of CETUS in accordance with the first sentence of*  
21 *this paragraph, to the maximum extent possible.*

22 (1984 Agreement, Rodriguez Decl. Ex. E at 8-9 (emphasis added).) These provisions plainly give  
23 rights to Stanford even in instances where Dr. Merigan’s work falls under the 1984 Agreement.

24 **2. Issues relating to the details of Dr. Merigan’s work**

25 If Roche were to succeed in demonstrating that Stanford had no rights to Dr. Merigan’s  
26 work, then Roche would have to show a breach by proving that the patented inventions were:

- 27 (i) [] made, conceived or completed with equipment, supplies, facilities or  
28 Confidential Information of CETUS, its subsidiaries or affiliates, or (ii) are made,  
conceived or completed by CONSULTANT during hours in which  
CONSULTANT is performing services for CETUS or any of its subsidiaries or  
affiliates, or (iii) result from any work performed by CONSULTANT for CETUS  
or any of its subsidiaries or affiliates during the Consulting Period.

(Id. at 8.)

The issues to be resolved would include:

- whether the patents or applications at issue were “made, conceived or completed  
with equipment, supplies, facilities” or Confidential Information of CETUS;”

- 1 • whether they “result from any work performed by [Merigan] for Cetus or any of its
- 2 subsidiaries or affiliates;”
- 3 • whether they were “made, conceived or completed by [Merigan] during hours in
- 4 which” Merigan performed services for Cetus or its subsidiaries or affiliates; and
- 5 • whether information alleged to be confidential to Cetus was (1) disclosed or
- 6 known to Merigan “as a consequence of or through performance of services for
- 7 CETUS, its subsidiaries or affiliates;” (2) whether such information was “known
- 8 by the trade generally;” and (3) whether such information was public at the time
- 9 the invention was made.

10 (*See id.* at 8, 12-13.)

11 **D. The December 19, 1988 Materials Transfer Agreement (“MTA”)**

12 Roche’s submission omits the fact that the MTA contemplates a one-time transfer of  
13 material, and does not provide for an ongoing supply of material from Cetus. The MTA states:  
14 “The Material will be shipped as soon as possible upon receipt of this signed Agreement.” (*See*  
15 MTA, Rodriguez Decl. Ex. F at p. 4.) Further, because the MTA states that “[t]he Material  
16 [provided] is considered proprietary to Cetus” (*id.* at ¶ 2), it excludes publicly known  
17 information.

18 The MTA does contemplate the continued supply of confidential information. (*Id.* at ¶ 3.)  
19 However, the MTA states that all confidential information must be so “designated *in writing*” at  
20 the time of disclosure. (*Id.*)

21 Thus, issues to be resolved include:

- 22 • what material was actually shipped to Stanford;
- 23 • whether any of the material was not publicly known or available at the time it was
- 24 used;
- 25 • whether anything was designated in writing as “Confidential Information” under
- 26 the MTA; and
- 27 • the meaning and application of “research results related to the Material” and
- 28 “research involving the Material”.

1 (See *id.* at ¶¶ 7, 8.)

2 **E. Issues Regarding the February 14, 1989 Visitor’s Confidentiality Agreement**

3 Roche’s submission ignores a key provision of the agreement, that serves to limit the  
4 scope of the agreement to confidential information:

5 I may have access to and acquire techniques, know-how, or other information of a  
6 confidential nature concerning CETUS’ experimental and developmental work,  
7 trade secrets, secret procedures, business matters or affairs including, but not  
8 limited to, information relating to ideas, discoveries, inventions, disclosures,  
9 processes, methods, systems, formulas, patents, patent applications, machines,  
10 materials, research plans and activities, research results, and business marketing  
11 information, plans, operations, activities, and results. I WILL NOT DISCLOSE  
12 ANY SUCH INFORMATION TO ANY PERSON OR ENTITY OR USE ANY  
13 SUCH INFORMATION WITHOUT CETUS’ PRIOR WRITTEN CONSENT. Information shall, for purposes of this Agreement, be considered to be  
14 confidential if not known in the field generally, even though such information has  
15 been disclosed to one or more third parties pursuant to joint research agreements,  
16 consulting agreements, or other entered into by CETUS or any of its affiliates.  
*Excluded from the obligations of confidentiality and nonuse agreed to herein is information (i) that I can establish I knew prior to my acquiring it from CETUS; (ii) that I receive from a third party who, when providing it to me, is not under an obligation to CETUS to keep the information confidential; or (iii) that enters the public domain through no fault of mine.*

16 (1989 Holodniy Agreement, Rodriguez Decl. Ex. G at ¶ 2 (emphasis in bold/italics added).)

17 Thus, issues to be resolved include:

- 18 • whether any of the information allegedly used by Dr. Holodniy was publicly  
19 known or available at the time it was used;
- 20 • the meaning and application of the provision “as a consequence of my access to  
21 CETUS’ facilities and information,” and whether the provision complies with  
22 California law; and
- 23 • the meaning and application of “ideas, inventions and improvements thereof or  
24 know-how related thereto that relate in any manner to the actual or anticipated  
25 business of CETUS,” and whether the provision complies with California law.

26 (*Id.* at ¶ 3.)

27 **F. Issues Regarding the April 19, 1991 Consulting Agreement**

28 Roche fails to identify the following limitation in the consulting agreement: “Consultant

1 shall serve as a scientific consultant to Cetus and its subsidiaries and affiliates in the research and  
 2 development of therapeutic agents (the “Field”).” (1991 Agreement, Rodriguez Decl. Ex. H at ¶  
 3 2.) Thus, in addition to the issues raised by the paragraph quoted by Roche, the trier of fact must  
 4 also determine whether the inventions of the patents are within the field identified by the  
 5 agreement.

6 **G. Summary of Overlapping Jury Issues**

7 As Stanford indicated at the hearing, it is entitled to a trial by jury and does not waive that  
 8 right. The resolution of the same issues by two different juries, however, violates the right to a  
 9 jury trial. *Houseman v. United States Aviation Underwriters*, 171 F.3d 1117, 1126 (7th Cir.  
 10 1999) (two juries may examine overlapping evidence in a bifurcated trial, but may not both  
 11 decide common factual issues). Here, the substantial overlap between key jury issues necessary  
 12 for resolution of both the patent and contract issues would result in a violation of Stanford’s right  
 13 to a jury trial.

JURY ISSUE	RELEVANCE FOR CONTRACT ISSUES	RELEVANCE FOR PATENT ISSUES
Date of invention (conception and reduction to practice)	Contracts refer to the time when an invention was made	Inventorship, enablement, non-obviousness
State of the art as of the filing date	Contracts have an exclusion for information that is not confidential	Inventorship, enablement, non-obviousness
Roche/Cetus’ knowledge of the invention	Statute of limitations, laches, estoppel, waiver, Roche’s allegations of breach	Inventorship, willfulness
Dedication to the public by Cetus of the content of the JID article <sup>5</sup>	Roche’s breach allegations	Inventorship, enablement, non-obviousness

25  
 26  
 27 <sup>5</sup> The JID article was published in 1991 and includes both the inventors and Cetus employees as  
 28 authors. (See Rodriguez Decl. Ex. I.) It is prior art to the patented invention, and is cited within  
 the specification of the patents.

**III. DISCOVERY REQUIRED FOR OWNERSHIP/LICENSE PURSUANT TO CONTRACT**

**A. Written Discovery**

Stanford has served some initial Interrogatories and Requests for Production on Roche. Stanford intends to serve Requests for Admission on Roche. Merigan may also serve written discovery (Interrogatories, Requests for Production and Requests for Admission) on Roche. Both Stanford and Merigan have served some third-party subpoenas and will serve additional subpoenas as necessary.

**B. Testimony**

The following individuals would either be deposed, or would testify on behalf of Stanford<sup>6</sup>:

PERSON	PARTY	RELEVANCE TO CONTRACT ISSUES	RELEVANCE TO PATENT ISSUES
Clayton Casipit	3 <sup>rd</sup> Party	Statute of limitations, laches, estoppel, waiver, Roche's allegations of breach	Inventorship, state of the art (enablement, non-obviousness), willfulness
Sharon DeGroat	Roche	Statute of limitations, laches, estoppel, waiver, Roche's allegations of breach	Inventorship, state of the art (enablement, non-obviousness), willfulness
Susanne DeWitt	Roche	Statute of limitations, laches, estoppel, waiver, Roche's allegations of breach	Inventorship, state of the art (enablement, non-obviousness), willfulness
Robert A. Fildes	3 <sup>rd</sup> Party	Statute of limitations, laches, estoppel, waiver, Roche's allegations of breach	
Melinda Griffith	Cetus/ Roche	Statute of limitations, laches, estoppel, waiver, Roche's allegations of breach	Willfulness
Eric Groves, M.D., Ph.D.	3 <sup>rd</sup> Party	Statute of limitations, laches, estoppel, waiver, Roche's allegations of breach	Inventorship, state of the art (enablement, non-obviousness), willfulness
Dr. Mark Holodniy	Stanford	Inventor of patents-in-suit	Inventorship, state of the art (enablement, non-obviousness), willfulness

<sup>6</sup> All of the third parties are former Cetus employees who are not employed by Roche.

PERSON	PARTY	RELEVANCE TO CONTRACT ISSUES	RELEVANCE TO PATENT ISSUES
Dennis Israelski, M.D.	Stanford/ 3 <sup>rd</sup> Party	Work disclosed in the 1991 Journal of Clinical Investigation article, <i>Reduction in Plasma Human Immunodeficiency Virus Ribonucleic Acid after Dideoxynucleoside Therapy as Determined by the Polymerase Chain Reaction.</i>	Inventorship, state of the art (enablement, non-obviousness)
David Katzenstein, M.D.	Stanford	Inventor of patents-in-suit	Inventorship, state of the art (enablement, non-obviousness), willfulness
David Kellogg	3 <sup>rd</sup> Party	Statute of limitations, laches, estoppel, waiver, Roche's allegations of breach	Inventorship, state of the art (enablement, non-obviousness), willfulness
Michael Konrad	3 <sup>rd</sup> Party	Statute of limitations, laches, estoppel, waiver, Roche's allegations of breach	Inventorship, state of the art (enablement, non-obviousness), willfulness
Michael Kozal, M.D.	3 <sup>rd</sup> Party	Inventor of patents-in-suit	Inventorship, state of the art (enablement, non-obviousness), willfulness
Shirley Kwok	Roche	Statute of limitations, laches, estoppel, waiver, Roche's allegations of breach	Inventorship, state of the art (enablement, non-obviousness), willfulness
James H. Meade, Ph.D.	3 <sup>rd</sup> Party	Statute of limitations, laches, estoppel, waiver, Roche's allegations of breach	Inventorship, state of the art (enablement, non-obviousness), willfulness
Thomas Merigan, M.D.	Stanford	Inventor of patents-in-suit	Inventorship, state of the art (enablement, non-obviousness), willfulness
Jeffrey S. Price, Ph.D.	3 <sup>rd</sup> Party	Statute of limitations, laches, estoppel, waiver, Roche's allegations of breach	Inventorship, state of the art (enablement, non-obviousness), willfulness
Sohini Sengupta	3 <sup>rd</sup> Party	Work disclosed in the 1991 Journal of Clinical Investigation article, <i>Reduction in Plasma Human Immunodeficiency Virus Ribonucleic Acid after Dideoxynucleoside Therapy as Determined by the Polymerase</i>	Inventorship, state of the art (enablement, non-obviousness)

PERSON	PARTY	RELEVANCE TO CONTRACT ISSUES	RELEVANCE TO PATENT ISSUES
		<i>Chain Reaction.</i>	
John Sninsky	3 <sup>rd</sup> Party	Statute of limitations, laches, estoppel, waiver, Roche's allegations of breach	Inventorship, state of the art (enablement, non-obviousness), willfulness
Alice Wang	3 <sup>rd</sup> Party	Statute of limitations, laches, estoppel, waiver, Roche's allegations of breach	Inventorship, state of the art (enablement, non-obviousness)
Rule 30(b)(6) deposition of Roche	Roche	Statute of limitations, laches, estoppel, waiver, Roche's allegations of breach	N/A

**C. Expert Testimony**

Stanford may use expert witness testimony as shown on the following table:

ISSUE	RELEVANCE TO CONTRACT ISSUES	RELEVANCE TO PATENT ISSUES
Date of invention (conception/reduction to practice)	Contracts refer to the time when an invention was made	Inventorship, enablement, non-obviousness
State of the art	Contracts have an exclusion for information that is not confidential	Inventorship, enablement, non-obviousness
Comparison of 1991 JID and JCI articles to patents	Statute of limitations, laches, estoppel, waiver	Inventorship, enablement, non-obviousness
Claims construction issues	Contracts refer to invention; claims construction may be required to determine when various aspects of the invention were complete	All infringement and validity issues

**IV. ADDITIONAL CONSIDERATION: MULTIPLICATION OF DISCOVERY DISPUTES**

Roche has already started to withhold discovery by asserting that it is not relevant to the contract action. Thus, the bifurcation of the contract issues is likely to add another source of disagreement between the parties: the scope of discovery.

For example, Stanford's Interrogatory No. 3 requests the source of the documents Roche has and will produce. This information is plainly important to identifying the people and places most relevant to all the issues in the case, including the contract issues. Roche did not provide any answer to this interrogatory.

1 In response to Stanford's document requests, Roche produced only three documents. The  
 2 chart below provides some examples of documents that are critical to the contract issues that  
 3 Roche refused to produce.

DOCUMENTS NOT PRODUCED	RELEVANCE TO CONTRACT ISSUES
Documents showing Roche/Cetus' first awareness of the JCI article	Standing, the statute of limitations, laches, estoppel, waiver, and enforceability
Documents that make reference to any of the Merigan or Holodniy agreements	Standing, the statute of limitations, laches, estoppel, waiver, and enforceability
Documents showing any tasks assignments given to Dr. Merigan	Standing, the statute of limitations, laches, estoppel, waiver, and enforceability

4  
 5  
 6  
 7  
 8  
 9  
 10 The three documents Roche did produce were related to its purchase of certain assets of  
 11 Cetus. As explained above, these agreements contain critical information regarding Roche's  
 12 assertions that it succeeded in obtaining all rights to the 1984 and 1991 Merigan agreements.  
 13 Despite the grave nature of these documents, Roche agreed to produce them only after counsel for  
 14 Stanford initiated a call to the Court to discuss Roche's violation of the Court's order at the CMC  
 15 that the parties should timely respond to outstanding discovery. Roche had insisted that these  
 16 documents be produced on March 10, after the Court's March 6 hearing on the bifurcation issue.

17 This Court was very clear in requiring the parties to timely respond to outstanding  
 18 discovery. (February 13, 2006 Transcript, Rodriguez Decl. Ex. J at 24.) This Court was also very  
 19 clear that it would not tolerate gamesmanship. (*See id.*) The fact that Roche has decided to  
 20 violate both the letter and spirit of this Court's order further confirms that Roche's request for  
 21 bifurcation should be rejected.

## 22 V. CONCLUSION

23 Roche's insistence that the contract arguments will conserve resources is nothing more  
 24 than a distraction. Roche will not even be able to assert breach of the contracts, either because it  
 25 never had the rights to them, because any rights that did pass have expired long ago, or because  
 26 the work done by the inventors is well outside of the contracts. Further, as the foregoing shows,  
 27 the contract issues are not a discrete part of the case that can be pursued separately from the core  
 28 patent issues. There is substantial overlap in witnesses, many of whom are third parties, who

