

Cooley Godward LLP

June 5, 2006

VIA ELECTRONIC MAIL AND U.S. MAIL

Jeremy Burns, Esq.
Quinn Emanuel Urquhart Oliver & Hedges LLP
555 Twin Dolphin Drive, Suite 560
Redwood Shores, CA 94065

Re: Stanford v. Roche, Case No. C 05-04158

Dear Jeremy:

I am available Thursday at 4:00 p.m. and Friday at 11:00 a.m. to meet and confer regarding discovery issues, although it is likely that many of these issues can be resolved this week without an in-person meet and confer. Our positions on the subject areas you have outlined, as well as additional issues to address, are below:

Deposition Schedule

We will have our available dates for Drs. Sengupta and Holodniy by Thursday. We will consider your request regarding the scheduling of Dr. Holodniy's deposition, but scheduling will ultimately depend on Dr. Holodniy. He has been contending with significant health issues over the past six weeks, and though he is feeling better, the disruption caused by these issues has resulted in a tight schedule going forward. I also look forward to discussing availability of 30(b)(6) witnesses. Attached is a detailed list of the topics to be covered in Roche's 30(b)(6) deposition.

Laboratory Notebooks

We have proceeded with scanning the Stanford laboratory notebooks that you requested.

As to the parties' obligations to provide the best copy of the notebooks, our review of the notebooks produced by Roche finds that many of them are illegible or have significant portions that are illegible. We suspect that much of the illegibility comes from the fact that the majority of the notebooks were produced 2 pages or more to one produced page. (See, e.g., RMS3952-4130). Please confirm that you will provide a legible production set of every such notebook, so that one notebook page corresponds to one produced 8.5 x 11 page. Please also confirm that, for notebooks that have been produced 1:1, you will provide cleaner production copies of select illegible pages as we identify them.

We will be prepared to exchange our respective notebook productions on an agreed upon date.

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Roche's Amended Counterclaims

We are willing to stipulate to your Amendment, with some minor revision to your proposed stipulation. Our edits to your stipulation are also attached.

Chiron Documents and Correspondence

We requested in my June 1, 2006 letter to Brian Cannon that you send us copies of your correspondence with Chiron. We wish to resolve this without resort to issuing a subpoena to Quinn. Please let us know your position.

Witness Interviews

We seek to complete interviews on the following individuals within the next two weeks: Clayton Casipit, Sharon DeGroat, Susanne DeWitt, Eric Groves, Ernie Kawasaki, Michael Konrad, Shirley Kwok, Alice Wang, William Gerber, George Gould, George Jen, Rick Kentz, Thomas McMahon, Michael Ostrach, Jeffrey Price, Stacey Sias, and Jon Sninsky. We suggest scheduling the bulk of interviews for two or three days, with each interview scheduled for 1 hour. We are willing to agree that the interviews will not be recorded or transcribed, other than the notes of the attorneys. We are willing conduct the face-to-face interviews at Quinn. Please let me know which of the following days would work for the interviews: June 9, 13, 14 or 15.

Sincerely,

/s/
Michelle S. Rhyu

MSR:gdb

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EXHIBIT A

2 I. DEFINITIONS

3 1. "You", "your", or "Roche" means Roche Molecular Systems, Inc., Roche
 4 Diagnostics Corporation, and/or Roche Diagnostics Operations, Inc., its directors, officers,
 5 employees, attorneys, accountants, consultants, representatives, agents, divisions, or subsidiaries,
 6 past or present, including, Roche Diagnostic Systems, Inc., and Hoffmann-La Roche, Inc., any
 7 partnership or joint ventures to which it is a party and any other person or entity acting on its
 8 behalf.

9 2. "Cetus" refers to the former Cetus Corporation, which was acquired in-part by
 10 Roche.

11 3. "Person" means any natural person and any other cognizable entity, including
 12 (without limitation) corporations, proprietorships, partnerships, joint ventures, consortiums, clubs,
 13 associations, foundations, governmental agencies or instrumentalities, societies and orders.

14 4. "PCR" means polymerase chain reaction.

15 5. "HIV" means human immunodeficiency virus.

16 6. "Accused Products" means any product that uses PCR to monitor the clinical
 17 progression of HIV infection and its response to antiretroviral therapy, including, but not limited
 18 to, your AMPLICOR HIV-1 MONITORTM Test.

19 7. As used herein, "asserted patents" means U.S. Patent Nos. 5,968,730 and
 20 6,503,705 assigned to Stanford.

21 8. As used herein, "subject patents" means the asserted patents, U.S. Patent Nos.
 22 5,631,128, 5,856,086, RE38,352 E, and 5,650,268, as well as U.S. Patent Application Publication
 23 Nos. 2001/0018181 A1 and 2003/0118986 A1.

24 9. The "Materials Transfer Agreement" means the Materials Transfer Agreement
 25 bearing the date December 19, 1988, between Dr. Merigan, Dr. Schwartz, and The Board of
 26 Trustees of the Leland Stanford Junior University, on the one hand, and Cetus, on the other.

27 10. The "1984 Consulting Agreement" means the Consulting Agreement between
 28 Cetus and Dr. Merigan, dated April 13, 1984.

1 **11.** The “1991 Non-Exclusive Consulting Agreement” means the Non-Exclusive
 2 Consulting Agreement between Cetus and Dr. Merigan, dated April 19, 1991.

3 **12.** The “1989 Visitor’s Confidentiality Agreement” means the Visitor’s
 4 Confidentiality Agreement between Cetus and Dr. Holodniy, dated February 14, 1989.

5 **13.** The connectives “and” and “or” shall be construed either disjunctively or
 6 conjunctively, as necessary to bring within the scope of the discovery request all responses that
 7 might otherwise be construed to be outside of its scope.

8 **14.** The word “each” as used herein includes the word “every,” and the word “every”
 9 herein includes the word “each,” as necessary to bring within the scope of the discovery request
 10 all responses that might otherwise be construed to be outside of its scope.

11 **15.** The word “any” as used herein includes the word “all,” and the word “all” herein
 12 includes the word “any,” as necessary to bring within the scope of the discovery request all
 13 responses that might otherwise be construed to be outside of its scope.

14 **16.** The word “all” as used herein includes the word “each,” and the word “each”
 15 herein includes the word “all,” as necessary to bring within the scope of the discovery request all
 16 responses that might otherwise be construed to be outside of its scope.

17 **17.** The term “relating to” shall mean relating to, referring to, concerning, mentioning,
 18 reflecting, pertaining to, evidencing, involving, describing, depicting, discussing, commenting on,
 19 embodying, responding to, supporting, contradicting, or constituting (in whole or part), as the
 20 context makes appropriate.

21 **II. SUBJECTS REQUIRING TESTIMONY**

22 **1.** The factual basis, including all evidence, for your claim in your Fourth
 23 Affirmative Defense that you are the owner of each of the subject patents.

24 **2.** The factual basis, including all evidence, for your claim in your Sixth Affirmative
 25 Defense that you hold a license to each of the subject patents.

26 **3.** The factual basis, including all evidence, for your claim in your Seventh
 27 Affirmative Defense that Stanford lacks standing as plaintiff in this case.

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1 4. The factual basis, including all evidence, for your Eighth Affirmative Defense of
 2 Estoppel.

3 5. The factual basis, including all evidence, for your Ninth Affirmative Defense of
 4 Laches.

5 6. The factual basis, including all evidence, for your Tenth Affirmative Defense of
 6 Waiver.

7 7. Facts and circumstances of the interaction or relationship between Dr. Thomas
 8 Merigan and Cetus from 1979 through 1993.

9 8. Facts and circumstances of the interaction or relationship between Dr. Mark
 10 Holodniy and Cetus from 1988 through 1993.

11 9. The Materials Transfer Agreement between Dr. Merigan, Dr. Schwartz, and The
 12 Board of Trustees of the Leland Stanford Junior University, on the one hand, and Cetus, on the
 13 other, bearing the date December 19, 1988 ("MTA"), including without limitation identification
 14 of every item, whether information, techniques, products, materials, substances, data, or know
 15 how, transferred under the MTA to Stanford, Dr. Merigan, and/or Dr. Schwartz, and the facts,
 16 circumstances and evidence of such transfer.

17 10. Facts and circumstances surrounding the use or uses of information, techniques,
 18 products, materials, substances, data, and/or know how, transferred under the MTA that resulted
 19 in "invention[s] or substance[s] that may be commercially useful" as stated in Paragraph 8 of the
 20 MTA, including identification of any steps taken between the use and the resulting invention or
 21 substance, and Roche's first knowledge of the use, the result, and the invention or substance.

22 11. Facts and circumstances and all documents relating to any license obtained by
 23 CETUS or you under the MTA.

24 12. Facts and circumstances and all documents relating to the transfer and/or
 25 assignment of rights under the MTA from Cetus to Roche.

26 13. The April 13, 1984 Consulting Agreement between Cetus and Dr. Merigan ("1984
 27 Consulting Agreement"), including without limitation the facts and circumstances and all
 28 evidence supporting your claim that any of Dr. Merigan's inventions falls within Paragraph 6.1 or

1 any other paragraph of the 1984 Consulting Agreement, and Roche's first knowledge of such
 2 inventions.

3 **14.** Exhibits to the 1984 Consulting Agreement.

4 **15.** Facts and circumstances and all documents relating to the transfer of Confidential
 5 Information to Dr. Merigan under the 1984 Consulting Agreement.

6 **16.** Facts and circumstances and all evidence relating to the transfer and/or assignment
 7 of rights under the 1984 Consulting Agreement from Cetus to Roche.

8 **17.** The Non-Exclusive Consulting Agreement between Cetus and Dr. Merigan dated
 9 April 19, 1991 ("1991 Non-Exclusive Consulting Agreement"), including without limitation the
 10 facts and circumstances and all evidence supporting your claim that any of Dr. Merigan's
 11 inventions falls within Paragraph 5 or any other paragraph of the 1991 Non-Exclusive Consulting
 12 Agreement, and Roche's first knowledge of such inventions.

13 **18.** Facts and circumstances and all documents relating to any transfer of Confidential
 14 Information to Dr. Merigan under the 1991 Non-Exclusive Consulting Agreement.

15 **19.** Facts and circumstances and all evidence relating to the transfer and/or assignment
 16 of rights under the 1991 Non-Exclusive Consulting Agreement from Cetus to Roche.

17 **20.** The Visitor's Confidentiality Agreement entered into on February 14, 1989
 18 between Cetus and Dr. Holodniy ("1989 Visitor's Confidentiality Agreement"), including without
 19 limitation the facts and circumstances and all evidence supporting your claim that any of Dr.
 20 Holodniy's inventions falls under this Agreement, and Roche's first knowledge of such
 21 inventions.

22 **21.** Facts and circumstances and all documents relating to any transfer of confidential
 23 techniques, know-how, or other confidential information to Dr. Holodniy under the 1989 Visitor's
 24 Confidentiality Agreement.

25 **22.** Facts and circumstances and all evidence relating to the transfer and/or assignment
 26 of rights under the 1989 Visitor's Confidentiality Agreement from Cetus to Roche.

27 **23.** All agreements entered into between Cetus, on the one hand, and Stanford, Dr.
 28 Merigan, and/or Dr. Holodniy, on the other hand, related to polymerase chain reaction technology

1 or methods, HIV research using polymerase chain reaction technology and/or methods, and/or the
 2 subject matter claimed in any of the subject patents, and the facts and circumstances relating to
 3 work under such agreements.

4 **24.** Facts, circumstances and any evidence related to any work done, at Cetus related
 5 to any of the subject patents.

6 **25.** To the extent that any of Roche's ownership claims arise from Roche's claims of
 7 work done by former Cetus employees, the facts, circumstances and evidence related to that
 8 work.

9 **26.** Facts and circumstances related to the acquisition by Hoffmann-La Roche Inc. and
 10 F. Hoffmann-La Roche Ltd. of certain assets from Cetus Corporation, including, without
 11 limitation:

- 12 a. the assets purchase agreement entered into on July 19, 1991 between Hoffman-La
 13 Roche Inc. and F. Hoffman-La Roche Ltd. (RMS 05916 – RMS 06271);
- 14 b. the transfer and/or assignment of the Materials Transfer Agreement, 1984
 15 Consulting Agreement, the 1991 Non-Exclusive Consulting Agreement, and the
 16 1989 Visitor's Confidentiality Agreement from Cetus to Roche;
- 17 c. the due diligence performed for the acquisition; and
- 18 d. the 1997 Assignment of Agreement (RMS 06289) between Hoffman-La Roche
 19 Inc. and Roche Molecular Systems, Inc. and any documents related thereto.

20 **27.** Facts and circumstances related to any PCR-related rights and/or assets that were
 21 retained by Cetus and subsequently transferred to Chiron Corp. pursuant to its merger with Cetus.

22 **28.** Facts and circumstances related to Roche Molecular Systems, Inc., Roche
 23 Diagnostics Corporation, and/or Roche Diagnostic Operations, Inc.'s first knowledge of any of
 24 the subject patents and/or the applications on which they are based.

25 **29.** Facts and circumstances related to any communications between Roche and
 26 Laboratory Corporation of America relating to any of the asserted patents or subject patents,
 27 including without limitation any communication related to RMS00492.

28 **30.** Roche's knowledge, including, without limitation, the date of its first knowledge,

1 of the research disclosed in the papers entitled: (1) Quantification of HIV-1 RNA in Serum and
 2 Correlation with Disease Status Using the Polymerase Chain Reaction, VI International
 3 Conference on AIDS, San Francisco, CA, 1990; (2) Detection and Quantification of Human
 4 Immunodeficiency Virus RNA in Patient Serum by Use of the Polymerase Chain Reaction, 163 J.
 5 Infect. Dis., 862-66 (Apr. 1991); (3) Inhibition of Human Immunodeficiency Virus Gene
 6 Amplification by Heparin, 29 J. Clin. Microbiol., 676-79 (Apr. 1991); (4) Reduction in Plasma
 7 Human Immunodeficiency Virus Ribonucleic Acid After Dideoxynucleoside Therapy as
 8 Determined by the Polymerase Chain Reaction, 88 J. Clin. Invest., 1755-59 (Nov. 1991); (5)
 9 Quantitative RNA and DNA Gene Amplification Can Rapidly Monitor HIV Infection and
 10 Antiviral Activity in Cell Cultures, 1 PCR Methods and Appl., 257-62 (May 1992); and (6)
 11 Plasma Viremia in Human Immunodeficiency Virus Infection: Relationship to Stage of Disease
 12 and Antiviral Treatment, 5 J. Acquir. Immune Defic. Syndr., 107-12 (1992).

13 **31.** Communications between Defendants and anyone else, including other Roche
 14 entities and/or Stanford, relating to the subject patents, their underlying patent applications,
 15 and/or the inventions that are the basis of the subject patents.

16 **32.** Facts and circumstances surrounding submission, evaluation, and processing of the
 17 Invention Disclosure for Patent ID # CE-90-003 (RMS 00226 – RMS 00228) dated January 9,
 18 1990, and any intellectual property rights arising from that Disclosure.

19 **33.** The factual basis for each and every denial by Roche of the allegations contained
 20 in Stanford's Complaint as set forth in Defendants' Answer and Counterclaims.

21 **34.** The factual basis for the Third, Fourth, Fifth, Sixth, Seventh, Eighth, Ninth, Tenth,
 22 Eleventh, and Twelfth counterclaims by Roche as set forth in Defendants' Answer and
 23 Counterclaims.

24 **35.** The factual basis for Defendants' responses to Stanford's interrogatories in
 25 Defendants' Objections and Responses to Plaintiff's First Set of Interrogatories [Nos. 1-3] and
 26 Defendants' Supplemental Objections and Responses to Plaintiff's First Set of Interrogatories
 27 [Nos. 1-3].

28 **36.** The organizational structure of Roche, including, without limitation, the

1 relationship between F. Hoffmann-La Roche, Ltd. and the Roche defendants in this case, the
2 Roche defendants' respective roles in the development, clinical research, manufacturing, and
3 marketing of the accused products, and individuals who participate or have participated in
4 development, clinical research, manufacturing, and marketing of the accused products.

5 **37.** Facts and circumstances surrounding any interactions between Cetus and Roche
6 relating to development, clinical research, manufacturing, and marketing of accused products.

7 **38.** The individuals listed in Defendants' Second Amended Initial Disclosures
8 Pursuant to Federal Rule of Civil Procedure 26(a)(1), including, without limitation, their
9 connection to Roche and the reason they are listed as individuals likely to have discoverable
10 information.

11 **39.** Roche's search for and production of documents in this lawsuit, including, without
12 limitation, the location of any documents produced, the individuals who were contacted for
13 documents, the search of electronic documents, and the search of documents filed or submitted
14 related to prior lawsuits.

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