

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS**

AMGEN, INC.,

Plaintiff,

v.

F. HOFFMANN-LA ROCHE, LTD.,
ROCHE DIAGNOSTICS GMBH, and
HOFFMANN-LA ROCHE, INC.

Defendants.

Civil Action No. 05-CV-12237 WGY

**ROCHE'S BENCH MEMORANDUM NO. 2 THAT DR. ORKIN SHOULD BE
PRECLUDED FROM TESTIFYING TO A CLAIM-BY-CLAIM ANALYSIS OF
THE PATENTS-IN-SUIT AND/OR OFFERING AN OPINION ON THE
ULTIMATE ISSUE OF VALIDITY BECAUSE
THESE OPINIONS ARE NOT IN HIS EXPERT REPORTS**

Neither of the two expert reports submitted by Dr. Orkin in the present action includes (1) a claim-by-claim analysis of the patents-in-suit, such as any discussion of the subject matter or limitations of any specific claim or (2) any opinion on the ultimate issue of validity. In keeping with the clear bounds of expert testimony set by the Court, Dr. Orkin should not now be allowed to testify as to these (or any) opinions that were not disclosed in his expert reports.

Throughout these proceedings, the Court has been very clear to both parties that, in the interest of fairness, expert witnesses may not offer direct testimony on opinions that are outside the scope of their expert reports. The Court has been "very strict" (Trial Tr. 1021:14) on keeping the direct testimony of experts to within the bounds of what was disclosed in the expert reports, and has recognized that "that's the only fair way" for direct examination to proceed. (Trial Tr. 728:12).

In the present case, Dr. Orkin not only submitted a first rebuttal report (*see* Rebuttal Expert Statement of Stuart H. Orkin, M.D., dated May 11, 2007), but also submitted a second report, specifically designed to supplement the first. (*See* Supplemental Rebuttal Expert Statement of Stuart H. Orkin, M.D., dated June 1, 2007). Dr. Orkin had ample opportunity in these multiple reports to disclose any and all opinions that he intended to offer at trial. Roche therefore respectfully requests that Dr. Orkin be precluded from offering opinions on or testifying about specific claims, including the subject matter and inventions claimed therein, and also that Dr. Orkin be precluded from offering opinions on the ultimate issue of validity.

DATED: September 26, 2007

F. HOFFMANN-LA ROCHE LTD,
ROCHE DIAGNOSTICS GMBH,
and
HOFFMANN-LA ROCHE INC.

By its attorneys,

/s/ Thomas F. Fleming

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CERTIFICATE OF SERVICE

I hereby certify that this document filed through the ECF system will be sent electronically to the registered participants as identified on the Notice of Electronic Filing (NEF) on the above date.

/s/ Thomas F. Fleming
Thomas F. Fleming