

**UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS**

AMGEN INC.,)	
)	
Plaintiff,)	
)	Civil Action No.: 1:05-CV-12237 WGY
v.)	
)	
F. HOFFMANN-LA ROCHE LTD, a)	
Swiss Company, ROCHE DIAGNOSTICS)	
GMBH, a German Company, and)	
HOFFMANN LA ROCHE INC., a New)	
Jersey Corporation,)	
)	
Defendants.)	

**AMGEN’S BENCH MEMORANDUM FOR A CLARIFYING PRELIMINARY
JURY INSTRUCTION RELATING TO ROCHE’S PATENT ON
PEGYLATED ERYTHROPOIETIN**

Pursuant to Fed. R. Civ. P. 402 and 403, Amgen requests that this Court issue to the Jury a preliminary instruction on the effect of Roche’s peg-EPO patent on whether Roche infringes Amgen’s patent. The proposed jury instruction comes from the Federal Circuit Bar Association Model Jury Instruction No. 8.11¹ and states:

Roche contends that its MIRCERA product and process accused of infringement represents an improvement to the inventions described in the Lin patent claims. Proof of this fact does not necessarily mean that the Roche’s accused MIRCERA product and process do not infringe Dr. Lin’s patent claims. Furthermore, MIRCERA may infringe the Lin patent claims whether or not Roche has a patent that Roche claims covers MIRCERA. Improvements may be separately patentable, yet still infringe another’s patent.

The tests for infringement remain as I have instructed you. As long as you find that Roche’s MIRCERA product and process include all of the limitations of at least one of the asserted patent claims, either literally or under the doctrine of equivalents, then you must find that the patent claim(s) will be infringed by Roche’s product and process, despite what Roche contends to be improvements.

Roche’s expert reports show that Roche will argue at trial that because MIRCERA is separately patented, it does not infringe Amgen’s prior patents. Separate patentability is not *per se* relevant

¹ Attachment 1 hereto.

and Courts have properly excluded such evidence as prejudicial.² The risk of prejudice is high here. This Court has determined that MIRCERA literally infringes claim 1 of the '422 Patent despite Roche's patent, and Amgen's other allegations of infringement rest on literal infringement. The Jury may be confused by Roche's patent and reach the wrong result. This is particularly true where, as here, this Court has already adjudicated that Roche literally infringes claim 1 of the '422 Patent.

Accordingly, Amgen requests that the foregoing preliminary jury instruction be given.

DATED: October 1, 2007

Respectfully Submitted,

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² See *Fiskars, Inc. v. Hunt Mfg. Co.*, 221 F.3d 1318, 1324 (Fed. Cir. 2000).

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CERTIFICATE OF SERVICE

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

/s/ Michael R. Gottfried

Michael R. Gottfried