

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

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

AMGEN INC.'S OPPOSITION TO ROCHE'S MOTION IN LIMINE TO PRECLUDE
TESTIMONY BY DR. VLADIMIR TORCHILIN REGARDING
ISSUES PERTAINING STRICTLY TO INVALIDITY

Despite its title, Roche's Motion in Limine to preclude Dr. Torchilin from providing
testimony regarding issues pertaining strictly to invalidity, in fact, seeks much more. Roche
attempts to preclude Dr. Torchilin from testifying on anything and everything mentioned in his
Second Report, merely because the statements are contained in the report.1 Roche's motion
would improperly and prejudicially preclude Dr. Torchilin from testifying with respect to
information relevant to infringement contained in his First and Third Reports

For matters of convenience, Dr. Torchilin incorporated by reference in his Third Report
limited sections of his Second Report related to general principles of pegylation and pegylation
technologies.2 This information is directly related to whether Roche's peg-EPO is materially

1 Roche's motion states that "the Court should preclude Dr. Torchilin from offering any
testimony regarding the opinions set forth in his Second Expert Report of May 1, 2007."

2 Paragraph 5 of Dr. Torchilin's Third Report states "I incorporate by reference into this report
all of my First Expert Report and exhibits hereto, as well as paragraphs 10-29, 46-58, and 60-64
(and exhibits thereto) of my Second expert Report that discuss the state of the art of pegylation
and technologies, as well as the demonstrative exhibits that are cited to in both Expert Reports. I
reserve the right to use the documents and opinions of these paragraphs for any new issues or
facts raised by Roche in support of its noninfringement positions that were not disclosed until
May 11, 2007."

changed from EPO. Dr. Torchilin should not be precluded from testifying on these issues merely because the information was contained in his Second Report as well as his Third Report.

Roche also asks the Court to preclude Dr. Torchilin from using several demonstratives, including VT38, because they allegedly are cited only in his validity reports. Contrary to Roche's representations, demonstrative VT38 is a screen shot from an animation specifically referenced in paragraph 58 of Dr. Torchilin's First Report and explained in detail in that report.³ The animation is also incorporated by reference in paragraph 5 of Dr. Torchilin's Third Report.⁴ Demonstrative VT38 concerns comparing EPO to Roche's peg-EPO, an issue directly related to infringement. Dr. Torchilin should not be precluded from using VT38 in his testimony.

CONCLUSION

Pursuant to the foregoing, Amgen respectfully requests Roche's Motion *in Limine* To Preclude Testimony by Dr. Vladimir Torchilin Regarding Issues Pertaining Strictly to Invalidity be denied.

DATED: October 4, 2007

Respectfully Submitted,

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³ Paragraph 58 of Dr. Torchilin's April 6, 2007 expert report states "Roche's attachment of a 30 kDa PEG molecule to the amino group at EPO's N-Terminus or at certain Lysines does not materially change the amino acid sequence, the secondary structure, the tertiary structure, or the carbohydrate structure of EPO. I have attached two animations to my report which show PEG attached to EPO, and a comparison of EPO to peg-EPO. (Exs. 136 and 137, 01 8W A_O.mov; 014wa_l-h264.mov 4/3/2007.) These animations are representations of the general spatial behavior of PEG and EPO."

⁴ As mentioned above, paragraph 5 of Dr. Torchilin's Third Report states "I incorporate by reference into this report all of my First Expert Report and exhibits hereto."

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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