

**UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS**

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

**PLAINTIFF AMGEN INC.’S MOTION TO CORRECT THE FILE HISTORY
OF THE ‘868 PATENT BY ADDING A DOCUMENT THAT WAS MISSING**

Plaintiff respectfully requests that this Court allow it to correct the file history of the ‘868 Patent by adding as Exhibit 2012A a document that was part of the file history but was missing from the version of the file history admitted into evidence (Tr. Exhibit 2012).¹ Exhibit 2012A is a computerized search report of prior art conducted by prosecution counsel for Amgen Inc. and provided to the Patent Office as an attachment to Amgen Inc.’s Second Preliminary Amendment (the “Amendment”).²

¹ Roche acknowledged that Amgen reserved its right to introduce additional prosecution –related documents and that it did not stipulate that the file histories put on the numbered exhibit list were complete or the only existing versions of the file histories.

² See Affidavit of Steven M. Odre filed herewith, at ¶¶ 4 and 5 and Exhibit 3 thereto.

In connection with prosecuting the '868 Patent, on or about May 24, 1988, Amgen Inc. provided the Amendment to the Patent Office. The Amendment is stamped received by the Patent Office on June 1, 1988.³

Thereafter, on or about July 27, 1988, the Patent Office issued an Office Action, which among other things, indicated that the Patent Office did not have Exhibit E (the search report) in its file.⁴ Upon receiving this Office Action, Amgen Inc. submitted a Reply Under 37 C.F.R. 1.111.⁵ Amgen Inc. attached a copy of Exhibit E to its Reply.⁶ The Reply was stamped received by the Patent Office on September 27, 1988, indicating it received the Reply with Exhibit E..⁷ Accordingly, Exhibit E was part of the file history of the '868 Patent and should be added to Exhibit 2012 as Exhibit 2012A.

Based on the foregoing, the Court should allow Amgen to correct the '868 file history by adding a copy of Exhibit E.

³ See Declaration of Odre at ¶ 4 and Exhibit 1. This document is contained within Tr. Exhibit 2012.

⁴ See Odre Dec. at ¶6 and Exhibit 2, p. 3.

⁵ See Odre Dec. at ¶8 and Exhibit 4. A copy of Exhibit 4 is contained within TR. Exhibit 2012.

⁶ See Odre Dec. at ¶8 and Exhibit 4, p. 3.

⁷ See Odre Dec. at ¶8 and Exhibit 3.

Dated: October 4, 2007

Respectfully Submitted,

AMGEN INC.,
By its attorneys,

/s/ Michael R. Gottfried

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CERTIFICATE PURSUANT TO LOCAL RULE 7.1

I certify that counsel for the parties have conferred in an attempt to resolve or narrow the issues presented by this motion and no agreement was reached.

/s/ Michael R. Gottfried
Michael R. Gottfried

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 and paper copies will be sent to those indicated as non-registered participants on October 4, 2007.

/s/ Michael R. Gottfried
Michael R. Gottfried