

UNITED STATES DISTRICT COURT
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-12237WGY

) [REDACTED VERSION]

**APPENDIX A TO DEFENDANTS' MEMORANDUM IN SUPPORT OF ITS MOTION
TO COMPEL PRODUCTION OF DOCUMENTS IMPROPERLY WITHHELD ON
GROUNDS OF PRIVILEGE**

Dated: March 27, 2007
Boston, Massachusetts

Respectfully submitted,
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ROCHE DIAGNOSTICS GMBH, and
HOFFMANN-LA ROCHE INC.

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APPENDIX A

**Summaries of Excerpts of Deposition and Trial Testimony Cited in Memorandum
(Transcript Excerpts are in Appendix B)**

No.	Testimony	Transcript Pages in Appendix B	Subjects
1	REDACTED	Ex. 1, ITC Dep. Trans., 344	Inventorship

No.	Testimony	Transcript Pages in Appendix B	Subjects
2	REDACTED	Ex. 1, ITC Dep. Trans., 411-12	Inventorship Prosecution Strategy

No.	Testimony	Transcript Pages in Appendix B	Subjects
3	REDACTED	Ex. 1, ITC Dep. Trans., 413-14	Inventorship Prosecution Strategy

No.	Testimony	Transcript Pages in Appendix B	Subjects
4	<p style="text-align: center;">REDACTED</p>	<p>Ex. 1, ITC Dep. Trans., 58-59</p>	<p>Inventorship Patentability</p>
5	<p style="text-align: center;">REDACTED</p>	<p>Ex. 3, <i>Amgen v. Hoechst</i> Dep. Trans., 23-24</p>	<p>Inventorship Patentability</p>

No.	Testimony	Transcript Pages in Appendix B	Subjects
6	REDACTED	Ex. 1, ITC Dep. Trans., 403	Inventorship Patentability
7	REDACTED	Ex. 1, ITC Dep. Trans., 37	Inventorship Patentability
8	REDACTED	Ex. 1, ITC Dep. Trans., 38	Inventorship Patentability
9	REDACTED	Ex. 1, ITC Dep. Trans., 38-39	Inventorship Prosecution Strategy
10	REDACTED	Ex. 1, ITC Dep. Trans., 80	Inventorship Patentability

No.	Testimony	Transcript Pages in Appendix B	Subjects
11	REDACTED	Ex. 1, ITC Dep. Trans., 81	Inventorship Patentability
12	REDACTED	Ex. 1, ITC Dep. Trans., 44-45	Inventorship Patentability
13	REDACTED	Ex. 1, ITC Dep. Trans., 46-47	Inventorship Patentability
14	REDACTED	Ex. 6, Egrie Dep. Trans., 321	Inventorship Patentability
15	REDACTED	Ex. 1, ITC Dep. Trans., 47-60	Inventorship Patentability

No.	Testimony	Transcript Pages in Appendix B	Subjects
16	REDACTED	Ex. 1, ITC Dep. Trans., 47-49, 50-51	Inventorship Patentability
17	REDACTED	Ex. 1, ITC Dep. Trans., 55	Inventorship Patentability

No.	Testimony	Transcript Pages in Appendix B	Subjects
18	REDACTED	Ex. 1, ITC Dep. Trans., 307-11	Inventorship Prosecution Strategy
19	REDACTED	Ex. 3, <i>Amgen v. Hoechst</i> Dep. Trans., 24-25	Inventorship Prosecution Strategy
20	REDACTED	Ex. 1, ITC Dep. Trans., 78	Inventorship Patentability

No.	Testimony	Transcript Pages in Appendix B	Subjects
21	REDACTED	Ex. 1, ITC Dep. Trans., 59-60	Inventorship
22	REDACTED	Ex. 1, ITC Dep. Trans., 63	Inventorship Patentability
23	REDACTED	Ex. 1, ITC Dep. Trans., 64	Inventorship
24	REDACTED	Ex. 1, ITC Dep. Trans., 64	Inventorship
25	REDACTED	Ex. 1, ITC Dep. Trans., 79-80	Inventorship Patentability
26	REDACTED	Ex. 1, ITC Dep. Trans., 81-82	Inventorship Patentability

No.	Testimony	Transcript Pages in Appendix B	Subjects
27	REDACTED	Ex. 3, <i>Amgen v. Hoechst</i> Dep. Trans., 39-40	Inventorship Patentability Prosecution Strategy
28	REDACTED	Ex. 1, ITC Dep. Trans., 312-18.	Inventorship Patentability
29	REDACTED	Ex. 1, ITC Dep. Trans., 146	Inventorship
30	REDACTED	Ex. 1, ITC Dep. Trans., 300-01	Patentability
31	REDACTED	Ex. 1, ITC Dep. Trans., 435	Patentability
32	Borun testified at length to his impressions and analysis of Dr. Egrie's input file and the issue of the molecular weight discrepancy. In connection with this testimony, he discussed his decision to rely on Professor Cummings and detailed the scope of his research in connection with his representation of Amgen.	Ex. 4, <i>Hoechst v. Kirin-Amgen</i> Tr. Trans., 409, 417, 428, 433, 439-43	Patentability Prosecution Strategy
33	Borun provided testimony regarding his familiarity with and understanding of Dr. Egrie's research materials.	Ex. 4, <i>Hoechst v. Kirin-Amgen</i> Tr. Trans., 274-280	Patentability Prosecution Strategy
34	Borun testified regarding his impressions of whether results of Dr. Egrie's experiments were consistent with statements in the patent.	Ex. 4, <i>Hoechst v. Kirin-Amgen</i> Tr. Trans., 289-91	Patentability

No.	Testimony	Transcript Pages in Appendix B	Subjects
35	<p>In the course of providing trial testimony, Borun disclosed advice he provided to Amgen regarding patent prosecution as well as whether Amgen provided him with particular information in connection with patent prosecution.</p> <p>“I wasn’t aware of there being any picking. I wasn’t aware of there being any human cell expression work at that time. I was aware of the intention that I provided to Dr. Lin and Dr. Brown and others that I worked with on that project, that whenever a revision to the patent application was to be made, that is, whenever a continuation in part application was to be filed, the best mode for practicing the invention had to be disclosed. So, that sounds, the part of Dr. Lin’s testimony that you just quoted to me sounds like the result of a discussion concerning putting in the best data, but I was not aware that a picking had been done.”</p>	Ex. 2, <i>Amgen v. Hoechst</i> Tr. Trans. Vol. 21, 2896-97	Prosecution Strategy Patentability
36	<p>Borun disclosed communications with Dr. Lin demonstrating the exchange of information in the pursuit of legal advice.</p> <p>“That is my recollection. I had enquired of Dr. Lin, as I usually did every time the application was to be revised basically what is new, what new information you have and are you sure you are providing the best mode known for practicing the invention. That is also very important under US law and has no counterpart, as I understand it, in Europe.”</p>	Ex. 4, <i>Hoechst v. Kirin-Amgen</i> Tr. Trans., 260	Prosecution Strategy

No.	Testimony	Transcript Pages in Appendix B	Subjects
37	REDACTED	Ex. 1, ITC Dep. Trans., 57	Prosecution Strategy
38	Borun testified regarding receiving information from Amgen employees in the course of prosecuting the '008 patent.	Ex. 2, <i>Amgen v. Hoechst</i> Tr. Trans. Vol. 21, 2846-50	Prosecution Strategy

No.	Testimony	Transcript Pages in Appendix B	Subjects
39	<p>Borun testified regarding his close work with Dr. Lin and the impressions he formed as a result of their interactions with respect to patent prosecution.</p> <p>“I can speak for myself in relating directly that <u>each and every draft, and there were four iterations of this patent application, was the subject of very thorough joint analysis involving Dr. Lin and me.</u> In each instance, any new material added, any changes that were made in original material, were gone over very carefully personally with Dr. Lin. <u>I got the impression that Dr. Lin appreciated that as the sole inventor and then as the leader of the research and development project at Amgen, having to do with erythropoietin, he bore a significant responsibility for the accuracy of materials in the patent application.</u> That may not have been the same view he had with respect to publications where everyone was anxious to pitch his name in at the end or at the beginning. <u>It was certainly my experience with him with regard to the patent applications. He was aware of the significance of the patents.</u> That is my position in response to the suggestion that he was less than careful in reviewing the applications.”</p>	Ex. 4, <i>Hoechst v. Kirin-Amgen</i> Tr. Trans., 239	Prosecution Strategy Inventorship Patentability
40	REDACTED	Ex. 3, <i>Amgen v. Hoechst</i> Dep. Trans., 25-29; 35-39	Prosecution Strategy

No.	Testimony	Transcript Pages in Appendix B	Subjects
41	REDACTED	Ex. 1, ITC Dep. Trans., 65	Prosecution Strategy
42	REDACTED	Ex. 1, ITC Dep. Trans., 65	Prosecution Strategy
43	REDACTED	Ex. 1, ITC Dep. Trans., 66-67	Prosecution Strategy Patentability
44	REDACTED	Ex. 1, ITC Dep. Trans., 68	Prosecution Strategy Patentability

No.	Testimony	Transcript Pages in Appendix B	Subjects
45	REDACTED	Ex. 1, ITC Dep. Trans., 68	Prosecution Strategy Patentability
46	REDACTED	Ex. 1, ITC Dep. Trans., 68-69	Prosecution Strategy Patentability
47	REDACTED	Ex. 1, ITC Dep. Trans., 70	Prosecution Strategy Patentability
48	REDACTED	Ex. 1, ITC Dep. Trans., 298-99	Prosecution Strategy Patentability Novelty
49	In the course of providing trial testimony, Borun disclosed Amgen's strategic decisions not to correct data in the patent application.	Ex. 2, <i>Amgen v. Hoechst</i> Tr. Trans. Vol. 21, 2854-60	Prosecution Strategy Patentability

No.	Testimony	Transcript Pages in Appendix B	Subjects
50	<p>Borun's testimony in the Court of Chancery proceedings in the U.K. disclosed data analysis and strategic considerations in evaluating the results of experiments and presenting data.</p> <p>"We knew we could not rely on it if you are referring to the carbohydrate data. We knew we would not rely on the hexose value to establish a difference because there was a question about the validity. It was just a bad experiment. There was too much material out rather than came in. <u>We certainly did not want to rely on the data reflecting fucose content.</u> There the data was wrong both with respect to urinary and recombinant EPO. That was completely missed on O-glycosylation. That was not the difference. <u>We would not have relied on it in any event.</u> 0 and 0 are the same, not different. We could not rely on the hexose."</p>	Ex. 4, <i>Hoechst v. Kirin-Amgen</i> Tr. Trans., 450	Prosecution Strategy Patentability
51	REDACTED	Ex. 3, <i>Amgen v. Hoechst</i> Dep. Trans., 63-64	Prosecution Strategy
52	REDACTED	Ex. 3, <i>Amgen v. Hoechst</i> Dep. Trans., 65	Prosecution Strategy Inventorship

No.	Testimony	Transcript Pages in Appendix B	Subjects
53	REDACTED	Ex. 3, <i>Amgen v. Hoechst</i> Dep. Trans., 138	Prosecution Strategy
54		Ex. 3, <i>Amgen v. Hoechst</i> Dep. Trans., 138	Prosecution Strategy
55	Borun disclosed that conversations with Dr. Lin revealed issues concerning the biological activity of erythropoietin.	Ex. 4, <i>Hoechst v. Kirin-Amgen</i> Tr. Trans., 287	Prosecution Strategy Patentability
56	REDACTED	Ex. 1, ITC Dep. Trans., 179	Prosecution Strategy
57	REDACTED	Ex. 1, ITC Dep. Trans., 173-86	Prosecution Strategy Patentability Prior Art
58	REDACTED	Ex. 1, ITC Dep. Trans., 281	Prosecution Strategy Patentability

No.	Testimony	Transcript Pages in Appendix B	Subjects
59	Amgen's inside patent counsel Stuart Watt disclosed prosecutions strategy by discussing the purpose of disclosing two articles by Dr. Goldwasser.	Ex. 5, <i>Amgen v. Hoechst</i> Tr. Trans., 2953-54	Prosecution Strategy Patentability
60	Borun testified regarding Dr. Egrie's report of her experiments and his work in incorporating it into the patent application.	Ex. 4, <i>Hoechst v. Kirin-Amgen</i> Tr. Trans., 297-98	Prosecution Strategy Patentability
61	REDACTED	Ex. 3, <i>Amgen v. Hoechst</i> Dep. Trans., 71-72	Prosecution Strategy Patentability
62	REDACTED	Ex. 3, <i>Amgen v. Hoechst</i> Dep. Trans., 74-77	Prosecution Strategy Patentability
63	REDACTED	Ex. 1, ITC Dep. Trans., 120-24	Prosecution Strategy Patentability Obviousness
64	Borun testified regarding statements made and strategies employed for overcoming prior art.	Ex. 4, <i>Hoechst v. Kirin-Amgen</i> Tr. Trans., 251-52, 256-57	Prosecution Strategy Patentability

No.	Testimony	Transcript Pages in Appendix B	Subjects
65	<p>Borun disclosed patent prosecution strategy with respect to developing representations to the USPTO regarding differences between uEPO and rEPO.</p> <p>“We were seeking to put in information concerning differences between recombinant products and urinary-derived EPO products irrespective. You see, Dr. Strickland is prior art neutral. He does experiments. He does experiments, and was doing experiments, to get into the Patent Office.... Excuse me, to get things through, apart from scientific curiosity, I have to attribute to him, because he is here, but to get things through the FDA. He does experiments. There is experimental data available to us as patent attorneys who are, what.... We are prior art sensitive. I am not going to cut and paste an entire study of isoelectricfocusing based on two different materials, one prior art and one not and fail to put in, now that I am prior art sensitive, the one that is not prior art and then be accused at some later day of saying, ‘Ha, you put in less than all the experiments on isoelectricfocusing.’”</p>	Ex. 4, <i>Hoechst v. Kirin-Amgen</i> Tr. Trans., 310-11	Prosecution Strategy Patentability
66	Borun discussed the strategy he employed for Amgen to overcome prior art such as Miyake.	Ex. 4, <i>Hoechst v. Kirin-Amgen</i> Tr. Trans., 306	Prosecution Strategy Patentability Prior Art
67	Borun explained his understanding of the Miyake reference.	Ex. 4, <i>Hoechst v. Kirin-Amgen</i> Tr. Trans., 423-26	Prosecution Strategy Patentability Prior Art

No.	Testimony	Transcript Pages in Appendix B	Subjects
68	<p>Borun's testimony in the Court of Chancery proceedings in the U.K. disclosed strategy and advice provided to Amgen regarding attempting to overcome prior art in the course of patent prosecution.</p> <p><u>"We appreciated that there might be a difficulty with novelty and considered a number of auxiliary requests that incorporated prior amendments such as taking out the antibody claims."</u></p>	Ex. 4, <i>Hoechst v. Kirin-Amgen</i> Tr. Trans., 448	Prosecution Strategy Patentability
69	REDACTED	Ex. 1, ITC Dep. Trans., 285-92	Prosecution Strategy Patentability Obviousness Prior Art
70	REDACTED	Ex. 1, ITC Dep. Trans., 296-97	Prosecution Strategy Patentability
71	REDACTED	Ex. 1, ITC Dep. Trans., 388	Prosecution Strategy Patentability
72	Borun disclosed his mental impressions and legal conclusions regarding the Sugimoto reference	Ex. 4, <i>Hoechst v. Kirin-Amgen</i> Tr. Trans, 255	Prior Art
73	Borun disclosed his opinion regarding the coverage of the claims with respect to the length of polypeptide chains.	Ex. 2, <i>Amgen v. Hoechst</i> Tr. Trans. Vol. 21, 2883-85	Claim Construction Infringement
74	REDACTED	Ex. 1, ITC Dep. Trans., 223	Claim Construction Double Patenting

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75	REDACTED	Ex. 1, ITC Dep. Trans., 263-65	Claim Construction
76	REDACTED	Ex. 1, ITC Dep. Trans., 82, 86, 87	Claim Construction
77	REDACTED	Ex. 1, ITC Dep. Trans., 114	Claim Construction
78	REDACTED	Ex. 1, ITC Dep. Trans., 118-20	Claim Construction Prior Art Patentability
79	REDACTED	Ex. 1, ITC Dep. Trans., 128-30	Claim Construction
80	REDACTED	Ex. 1, ITC Dep. Trans., 132	Claim Construction
81	REDACTED	Ex. 1, ITC Dep. Trans., 133-57	Claim Construction Prior Art Patentability
82	REDACTED	Ex. 1, ITC Dep. Trans., 161-72	Claim Construction

No.	Testimony	Transcript Pages in Appendix B	Subjects
83	REDACTED	Ex. 1, ITC Dep. Trans., 204-217; 369-71	Claim Construction Double Patenting
84	REDACTED	Ex. 3, <i>Amgen v. Hoechst</i> Dep. Trans., 69	Patentability Molecular Weight
85	REDACTED	Ex. 3, <i>Amgen v. Hoechst</i> Dep. Trans., 69	Patentability Molecular Weight
86	REDACTED	Ex. 3, <i>Amgen v. Hoechst</i> Dep. Trans., 70	Patentability Prior Art

No.	Testimony	Transcript Pages in Appendix B	Subjects
87	REDACTED	Ex. 3, <i>Amgen v. Hoechst</i> Dep. Trans., 71	Patentability Molecular Weight
88	REDACTED	Ex. 3, <i>Amgen v. Hoechst</i> Dep. Trans., 91	Patentability
89	REDACTED	Ex. 3, <i>Amgen v. Hoechst</i> Dep. Trans., 94-95	Patentability Prosecution Strategy

No.	Testimony	Transcript Pages in Appendix B	Subjects
90	REDACTED	Ex. 7, <i>Amgen v. Roche</i> Dep. Trans., 201-202	Inventorship
91	Borun disclosed that Amgen's test data submitted to the FDA, was not contained in the Strickland declaration but instead, he argued, was in references in the Strickland Declaration.	Ex. 2, <i>Amgen v. Hoechst</i> Tr. Trans., 2876-78	Prosecution Strategy
92	REDACTED	Ex. 3, <i>Amgen v. Hoechst</i> Dep. Trans., 221-24	Prosecution Strategy
93	REDACTED	Ex. 8, <i>Amgen v. Hoechst</i> Strickland Dep. Trans., 394-96	Prosecution Strategy