

EXHIBIT B

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

Civil Action
No. 05-12237-WGY

* * * * *

AMGEN, INC.,

Plaintiff,

v.

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

Defendants.

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MARKMAN HEARING

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BEFORE: The Honorable William G. Young,
District Judge

APPEARANCES:

DUANE MORRIS LLP (By Michael R. Gottfried,
Esq.), 470 Atlantic Avenue, Suite 500, Boston,
Massachusetts 02210
- and -
DAY CASEBEER MADRID & BATCHELDER, LLP (By
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- and -
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- and -
WENDY A. WHITEFORD, ESQ., Of Counsel,
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Oaks, California 91320-1789, on behalf of the
Plaintiff

1 Courthouse Way
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April 17, 2007

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1 you.

2 What does the patent tell us? If we look at the

3 specification as Dr. Torchilin did and brought to the

4 Court's attention exactly what the specification has to say

5 about this, if we look at the specification, the

6 specification is very clear that a diluent, an adjuvant or a

7 carrier can be in combination -- I'm sorry -- can be in

8 combination with or together with the erythropoietin. And

9 he points out that standard, that the patent describes

10 standard diluents such as serum, human serum albumin and

11 saline, both of which one of ordinary skill in the art would

12 readily recognize are complexed with, bind to, adhere to,

13 attach to human EPO.

14 So, you know, once again, when we deviate from the

15 tried and true analysis that the Federal Circuit has laid

16 down and this Court has mastered for construing claims,

17 looking at the claim language, looking at the specification,

18 looking at the prosecution history, and asking ourselves,

19 now, does the claim necessarily require this limitation that

20 the defendant is trying to read into the claim.

21 THE COURT: What do you say to her use of the word

22 mammals in place of humans in your proposal?

23 MR. DAY: Well, I think it's a question of what the

24 plain meaning of pharmaceutical composition is. And we

25 believe that the plain meaning of pharmaceutical composition

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1 is a composition that's administered to humans.

2 Dr. Flavell, defendants' expert, agrees. In his expert

3 report he says a pharmaceutical composition is a composition

4 that's suitable for administration to humans.

5 THE COURT: Well, I mean now at least, so the

6 television tells us, we have all sorts of pharmaceutical

7 compositions being administered by veterinarians to animals

8 of all sorts. And I had thought we were talking about

9 mammals here. Is that a mistake?

10 MR. DAY: Is it a mistake that we're talking about

11 mammals? Well, in the context of a pharmaceutical

12 composition --

13 THE COURT: You think so.

14 MR. DAY: Pardon me?

15 THE COURT: You think so.

16 MR. DAY: Well, I think, I think the specification,

17 the specification -- we're talking about column 33. In

18 particular in column 33 there is that very famous sentence

19 that your Honor knows very, very well. That sentence refers

20 to mammals. No question about it. But it doesn't talk

21 about pharmaceutical compositions. When we get to

22 pharmaceutical compositions the specification is very

23 clearly talking about patients.

24 THE COURT: Why did you put the word at least a

25 diluent, adjuvant or carrier in your proffer, in your

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1 proposal?

2 MR. DAY: Because of the word comprising, to make

3 clear that as, when you construe the word comprising that

4 you must have at least one of these. That doesn't mean you

5 can't have them all. That's the effect of comprising.

6 But the claim requires -- what does the claim

7 require? The analytical issue for the Court is what does

8 the claim require. It requires that there be at least --

9 THE COURT: Excuse me.

10 MR. DAY: -- an adjuvant, a diluent or a carrier.

11 THE COURT: Yes. But doesn't the word "or" carry

12 that, that meaning?

13 MR. DAY: That there can be more than one? Not

14 necessarily.

15 THE COURT: I see.

16 MR. DAY: I'm just trying to make it clear.

17 THE COURT: Containing --

18 MR. DAY: That --

19 THE COURT: Well --

20 MR. DAY: -- the effect of the word comprising is

21 that there can be more than one. That's the effect of the

22 word comprising. In giving that word meaning in this

23 construct that's why I put at least.

24 THE COURT: All right, thank you.

25 Here's, here's what we're going to go with for now.

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1 I'm going to construe the term as a composition suitable for

2 administration to humans containing a diluent, adjuvant or

3 carrier. As to this, as well as these other matters, I'll

4 take what's argued under advisement.

5 All right. Now, then we come to the '868 patent,

6 claim 2 and the '933 patent, claim 8 wherein said cells are

7 CHO cells. I don't see why we need the derived here. I am

8 disposed to go with a cell from the ovary of a Chinese

9 hamster. That's the language. I don't think we need to add

10 in anything. The claim said host cells are CHO cells. It

11 seems to me a cell from the ovary of a Chinese hamster. And

12 that is what I propose to do, but I'll hear you, Mr. Day,

13 because you have a different position. I don't know what

14 derived from adds.

15 MR. DAY: I think derived from is true to the

16 specification. And let me, again, I'm not trying to read

17 limitations into the claim. I'm trying to be true to the

18 specification.

19 And I'm not quite sure what defendants are arguing.

20 And there may be no issue or no dispute here for us to

21 resolve. But it appeared from the last submission that the

22 defendants made they were suggesting that, the fact that the

23 cell was taken from a Chinese hamster ovary meant that the

24 cell must be in the form that it would be found in a Chinese

25 hamster ovary.