Amgen Inc. v. F. Hoffmann-LaRoche LTD et al Doc. 579 Att. 3

EXHIBIT C

Godfrey Decl. in Support of Amgen's Memorandum to it's Motion for Summary Judgment of No Obvious Type Double Patenting

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1 Exhibits: 1-8 Volume 1, Pages 1-281

2 UNITED STATES DISTRICT COURT

3 FOR THE DISTRICT OF MASSACHUSETTS

4 Civil Action No. 05 Civ. 12237 WGY

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AMGEN INC.

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Plaintiff

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vs.

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F. HOFFMANN-LA ROCHE LTD.,

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ROCHE DIAGNOSTICS GmbH, and

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HOFFMANN-LA ROCHE INC.

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Defendants

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VIDEOTAPED DEPOSITION OF

14 EDWARD E. HARLOW, JR., Ph.D.

15 Wednesday, June 20, 2007, 8:52 a.m.

]

16 Duane Morris LLP

470 Atlantic Avenue

17 Boston, Massachusetts

18

** TRANSCRIPT DESIGNATED CONFIDENTIAL ***

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25 ALAN H. BROCK, RDR, CRR

1 A. I don't know.

2 Q. Now, you've offer the opinion that Dr.

3 Lin's claims in suit are obvious over the

4 Strickland-Lai '016 patent; correct?

5 A. Yes.

6 Q. So your opinion regarding the

7 obviousness of Lin's patents in suit is based on a

8 one-way test; correct?

9 A. That's my understanding. Again, I'm

10 sort of at the edge here.

11 Q. In other words, you offer no opinion in

12 your report as to whether the claims of the

13 Lai-Strickland '016 patent are obvious in light of

14 Dr. Lin's claims in suit.

15 A. I have not offered an opinion on that.

16 Q. And so if the Court determines that a

17 two- way test should apply in lieu of a one-way

18 test, you have no opinion that addresses that

19 scenario, do you?

20 A. I haven't formed one yet, no.

21 Q. You anticipated my question: Do you

22 have an opinion as to whether the Lai patent is

23 obvious over the Lin patents in suit?

24 A. I don't.

25 Q. Do you know if Dr. Lin taught a method

1 EPO has a definition. It demands knowledge of the

2 clone. When you've got the clone, one of skill in

3 the art knows how to make recombinant EPO.

4 Q. The words "recombinant EPO" did not

5 instruct or teach one of skill in the art how to

6 isolate or clone the EPO gene from the human genome,

7 did it?

8 A. I don't know.

9 Q. You don't know?

10 A. Don't know.

11 Q. You don't know if with the words

12 "recombinant EPO" alone one of skill in the art

13 could have isolated and cloned human EPO DNA?

14 A. Don't know. Haven't formed an opinion.

15 Haven't been asked to.

16 Q. Are you aware of any disclosure other

17 than Dr. Lin's patent that identifies the isolated

18 EPO DNA sequence as of December 1983?

19 A. I don't know of any other.

20 Q. Your opinions that the claims in suit

21 are obvious and that making a recombinant EPO

22 protein would have been obvious assumes the

23 availability of the EPO DNA sequence; correct?

24 A. Yes.

25 Q. And are you aware of any source other

1 than Dr. Lin's '008 patent that would have made that
2 EPO DNA sequence available to one of skill in the
3 art?
4 A. I don't.
5 Q. So you assume that Dr. Lin's '008 patent
6 can be used as part of the prior art in assessing
7 the obviousness of the claims in suit; correct?
8 MR. BROMBERG: Objection.
9 A. Let's make sure we know exactly what
10 origin. So would you try it one more time?
11 Q. You assume that Dr. Lin's '008 patent
12 can be used as prior art against Dr. Lin's claims in
13 suit for purposes of your obviousness opinions;
14 correct?
15 MR. BROMBERG: Objection.
16 A. Yes.
17 Q. Why do you assume that?
18 A. The comparison of the claim language
19 from the patents in suit back on '008.
20 Q. I understand. So you understand that
21 the '008 patent is a progenitor to each of the
22 claims in suit; correct?
23 A. I do understand that.
24 Q. Okay. My question is, why do you assume
25 that the '008 patent is available as prior art

1 the subject we were discussing this morning, which

2 is your opinion that claim 10 of the '016 patent

3 would have rendered obvious Dr. Lin's claims in

4 suit. Okay? Do you have that in mind?

5 A. Yes.

6 Q. Now, your opinion that as of December

7 1983 one of skill in the art could have produced

8 recombinant EPO in mammalian cell culture based only

9 on the words of claim 10 of the '016 patent assumes

10 the availability of the isolated EPO DNA; correct?

11 MR. BROMBERG: Objection.

12 A. Assumes the availability of the EPO DNA,

13 yes.

14 Q. And if it turns out that the '008

15 patent, Dr. Lin's '008 patent cannot be used as

16 prior art, cannot be used as prior art against the

17 claims in suit, there would be no identification or

18 isolation of EPO DNA available as prior art to one

19 of skill in the art for purposes of your '016

20 opinion; correct?

21 MR. BROMBERG: Objection.

22 A. I haven't spent any time thinking about

23 that.

24 Q. Your opinion of obviousness in light of

25 the '016 patent depends on one of skill in the art

1 having available to him or her the EPO DNA sequence?

2 A. Yes.

3 Q. And if it turns out that the EPO DNA

4 sequence is not part of the prior art or public

5 knowledge as of December 1983, you have no opinion

6 as to whether or not the claims in suit would be

7 obvious in light of claim 10 of the '016 patent;

8 correct?

9 A. I haven't considered that at all. I

10 don't know the answer to that.

11 Q. So you don't have an opinion on it.

12 A. That's correct.

13 Q. Now, the '016 patent and the claims of

14 the '016 patent are to a purification of recombinant

15 EPO; correct?

16 A. That's correct.

17 Q. Before the Lai and Strickland patent,

18 though, there were prior-art methods known for the

19 purification of EPO from natural sources; correct?

20 A. That's my understanding, yes.

21 Q. The patents in suit and the '933

22 specification in front of you refers to a Miyaki

23 seven-step protocol for the purification of EPO.

24 Does that sound familiar?

25 A. It could be. I don't recall.