

IN THE UNITED STATES DISTRICT COURT  
FOR THE 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 12237 WGY

U.S. District Judge William G. Young

**ORAL ARGUMENT REQUESTED****DECLARATION OF KEITH E. TOMS IN SUPPORT OF DEFENDANTS'  
MOTION FOR SUMMARY JUDGMENT THAT AMGEN IS ESTOPPED  
FROM ASSERTING INFRINGEMENT UNDER THE DOCTRINE OF  
EQUIVALENTS OF THE ASSERTED CLAIMS OF THE '933 AND '422 PATENTS**Leora Ben-Ami (*pro hac vice*)  
Patricia A. Carson (*pro hac vice*)  
Thomas F. Fleming (*pro hac vice*)  
Howard S. Suh (*pro hac vice*)  
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Timothy M. Murphy (BBO# 551926)  
Julia Huston (BBO# 562160)  
Keith E. Toms (BBO# 663369)  
Nicole A. Rizzo (BBO# 663853)  
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125 Summer Street  
Boston, MA 02110  
Tel: (617) 443-9292Counsel for Defendants  
F. HOFFMANN-LA ROCHE, LTD,  
ROCHE DIAGNOSTICS GMBH, and  
HOFFMANN-LA ROCHE INC.

Dated: July 3, 2007

I, Keith E. Toms, hereby declare under penalty of perjury that:

1. I am an attorney admitted to the Bars of the States Massachusetts and the United States District Court for the District of Massachusetts, and am an attorney at Bromberg & Sunstein LLP, counsel for Defendants in the above-captioned case.

2. I make this Declaration in Support of Defendants' Motion For Summary Judgment That Amgen Is Estopped From Asserting Infringement Under The Doctrine Of Equivalents Of The Asserted Claims Of The '933 And '422 Patents, dated July 3, 2007.

3. Exhibit 1, attached hereto, is a true and correct copy of '178 application file history, application claims at 97, 101, 102.

4. Exhibit 2, attached hereto, is a true and correct copy of '178 application file history, Paper 11, 6/2/89 Amendment at 1, at 3.

5. Exhibit 3, attached hereto, is a true and correct copy of '178 application file history, Paper 13, 6/14/89 Office Action at 3.

6. Exhibit 4, attached hereto, is a true and correct copy of '178 application file history, Paper 19, 1/10/90 Amendment at 1, at 5, at 6.

7. Exhibit 5, attached hereto, is a true and correct copy of '178 application file history, Paper 4, 6/2/86 Office Action at 3-5.

8. Exhibit 6, attached hereto, is a true and correct copy of '178 application file history, Paper 6, 12/1/88 Amendment and Reply at 3.

9. Exhibit 7, attached hereto, is a true and correct copy of '178 application file history, Paper 9, 2/10/89 Office Action.

10. Exhibit 8, attached hereto, is a true and correct copy of '422 file history, Paper 33, 4/20/99 Amendment at 5.

11. Exhibit 9, attached hereto, is a true and correct copy of '422 file history, Paper 26, 3/31/95 patent office communication.

12. Exhibit 10, attached hereto, is a true and correct copy of '422 file history, Paper 42, 02/16/95 Applicant's Amendment and Request for Reconsideration under 37 CFR 1111 and 1115, at 11.

13. Exhibit 11, attached hereto, is a true and correct copy of '422 File History, Paper 2, 11/6/90 Preliminary Amendment at p. 9.

14. Exhibit 12, attached hereto, is a true and correct copy of '422 File History, Paper 20, 5/26/94 office action at 2, 4.

15. Exhibit 13, attached hereto, is a true and correct copy of '774 application file history, 12/20/95, Paper 50, Second Preliminary Amendment and Remarks.

16. Exhibit 14, attached hereto, is a true and correct copy of '874 application file history, Paper 37, 6/13/94 Preliminary Amendment.

17. Exhibit 15, attached hereto, is a true and correct copy of '874 application file history, Paper 38, 8/16/94 office action at 9.

18. Exhibit 16, attached hereto, is a true and correct copy of '874 application file history, Paper 42, 2/16/95 Amendment and Request for Reconsideration at 11.

19. Exhibit 17, attached hereto, is a true and correct copy of U.S. Patent No. 4,703,008.

20. Exhibit 18, attached hereto, is a true and correct copy of U.S. Patent No. 5,547,933.

21. Exhibit 19, attached hereto, is a true and correct copy of U.S. Patent No. 5,955,422.

22. Exhibit 20, attached hereto, is a true and correct copy of Plaintiff's Supp. Response to Defendants First Set of Interrogatories at 3-4.

23. Exhibit 21, attached hereto, is a true and correct copy of Markman Hearing Transcript, 4/17/07, at 27:8-10, 34:7-10.

24. Exhibit 22, attached hereto, is a true and correct copy of Amgen's Post Hearing Brief at AM-ITC 00852559-63.

Signed under pains and penalties of perjury this 3<sup>rd</sup> day of July, 2007.

/s/ Keith E. Toms

Keith E. Toms

### **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 (NEF) and paper copies will be sent to those indicated as non registered participants on the above date.

/s/ Keith E. Toms

Keith E. Toms

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