

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

AMGEN INC.,)	
)	
Plaintiff,)	
)	
v.)	
)	CIVIL ACTION No.: 05-CV-12237WGY
F. HOFFMANN-LA ROCHE LTD)	
ROCHE DIAGNOSTICS GmbH)	
and HOFFMANN-LA ROCHE INC.)	
)	
Defendants.)	

**ROCHE’S MOTION *IN LIMINE* TO PRECLUDE AMGEN INC.
FROM CONTRADICTING ARGUMENTS IT MADE IN
PRIOR ADMINISTRATIVE AND JUDICIAL PROCEEDINGS**

Leora Ben-Ami (*pro hac vice*)
Mark S. Popofsky (*pro hac vice*)
Patricia A. Carson (*pro hac vice*)
Thomas F. Fleming (*pro hac vice*)
Howard S. Suh (*pro hac vice*)
Christopher T. Jagoe (*pro hac vice*)
Peter Fratangelo (BBO# 639775)
Krista M. Rycroft (*pro hac vice*)
Kaye Scholer LLP
425 Park Avenue
New York, New York 10022
Tel. (212) 836-8000

Lee Carl Bromberg (BBO# 058480)
Timothy M. Murphy (BBO# 551926)
Julia Huston (BBO# 562160)
Keith E. Toms (BBO# 663369)
Nicole A. Rizzo (BBO# 663853)
Kregg T. Brooks (BBO# 667348)
Bromberg & Sunstein LLP
125 Summer Street
Boston, MA 02110
Tel. (617) 443-9292

Dated: Boston, Massachusetts
August 10, 2007

*Counsel for Defendants
F. Hoffmann-La Roche LTD, Roche
Diagnostics GmbH, and
Hoffmann-La Roche Inc.*

Roche respectfully moves this Court for an order precluding Amgen from presenting evidence, expert testimony and arguments in support of its current assertion that the claims of the patents-in-suit are not obvious variations of the claims of the expired U.S. Patent No. 4,703,008 (“the ‘008 patent”).

Amgen’s proposed arguments and purported evidence squarely contradict arguments and representations Amgen successfully relied upon in prior administrative and judicial proceedings, including Interference No. 102,097 (“the ‘097 Interference”) between Fritsch and Lin and various proceedings in Europe. For example, Amgen has been successful in prior proceedings in making arguments that the DNA sequence (*i.e.* the subject matter of the expired ‘008 patent) was the point of novelty of its invention, and that further steps in the process of producing recombinant erythropoietin were obvious and routine. Amgen’s current position -- that the process claims of the ‘868, ‘698 and ‘349 patents are not obvious over the ‘008 patent claims -- directly contradicts Amgen’s prior position. Courts, including this Court, have consistently prohibited parties from making such intentionally contradictory assertions through the application of the doctrine of judicial estoppel. To allow such intentional contradiction would offend the integrity of the judicial system and allow Amgen to play fast and loose with the court system.

Based on the foregoing, Roche respectfully requests that this Court invoke that doctrine and preclude Amgen from offering evidence, testimony or attorney argument that contradicts assertions made in procuring favorable judgments in prior judicial proceedings, including that Amgen should be precluded from arguing:

- (1) that the Lin process claims of the ‘868, ‘698 and ‘349 patents are not obvious over the ‘008 patent claims;

(2) that the use of mammalian host cells for expression of EPO confers patentability to the asserted claims of the patents-in-suit;

(3) that isolation of the EPO glycoprotein product from mammalian host cell expression confers patentability to the asserted claims of the patents-in-suit;

(4) that purported differences in glycosylation linkages confers patentability to the asserted claims of the patents-in-suit; and

(5) that the asserted claims are patentable because production of a biologically active protein was an “unexpected result.”

In support of this motion, Roche submits an accompanying memorandum of law, and declaration of Krista M. Rycroft including exhibits.

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 that no agreement could be reached.

Dated: August 10, 2007
Boston, Massachusetts

Respectfully submitted,

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

By their Attorneys

/s/ Kregg T. Brooks
Lee Carl Bromberg (BBO# 058480)
Timothy M. Murphy (BBO# 551926)
Julia Huston (BBO# 562160)
Keith E. Toms (BBO# 663369)
Nicole A. Rizzo (BBO# 663853)
Kregg T. Brooks (BBO# 667348)
BROMBERG & SUNSTEIN LLP
125 Summer Street
Boston, MA 02110
Tel. (617) 443-9292
kbrooks@bromsun.com

Leora Ben-Ami (*pro hac vice*)
Mark S. Popofsky (*pro hac vice*)
Patricia A. Carson (*pro hac vice*)
Thomas F. Fleming (*pro hac vice*)
Howard S. Suh (*pro hac vice*)
Christopher T. Jagoe (*pro hac vice*)
KAYE SCHOLER LLP
425 Park Avenue
New York, New York 10022
Tel. (212) 836-8000

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/ Kregg T. Brooks
Kregg T. Brooks

Roche respectfully moves this Court for an order precluding Amgen from presenting evidence, expert testimony and arguments in support of its current assertion that the claims of the patents-in-suit are not obvious variations of the claims of the expired U.S. Patent No. 4,703,008 (“the ‘008 patent”).

Amgen’s proposed arguments and purported evidence squarely contradict arguments and representations Amgen successfully relied upon in prior administrative and judicial proceedings, including Interference No. 102,097 (“the ‘097 Interference”) between Fritsch and Lin and various proceedings in Europe. For example, Amgen has been successful in prior proceedings in making arguments that the DNA sequence (*i.e.* the subject matter of the expired ‘008 patent) was the point of novelty of its invention, and that further steps in the process of producing recombinant erythropoietin were obvious and routine. Amgen’s current position -- that the process claims of the ‘868, ‘698 and ‘349 patents are not obvious over the ‘008 patent claims -- directly contradicts Amgen’s prior position. Courts, including this Court, have consistently prohibited parties from making such intentionally contradictory assertions through the application of the doctrine of judicial estoppel. To allow such intentional contradiction would offend the integrity of the judicial system and allow Amgen to play fast and loose with the court system.

Based on the foregoing, Roche respectfully requests that this Court invoke that doctrine and preclude Amgen from offering evidence, testimony or attorney argument that contradicts assertions made in procuring favorable judgments in prior judicial proceedings, including that Amgen should be precluded from arguing:

- (1) that the Lin process claims of the ‘868, ‘698 and ‘349 patents are not obvious over the ‘008 patent claims;

- (2) that the use of mammalian host cells for expression of EPO confers patentability to the asserted claims of the patents-in-suit;
- (3) that isolation of the EPO glycoprotein product from mammalian host cell expression confers patentability to the asserted claims of the patents-in-suit;
- (4) that purported differences in glycosylation linkages confers patentability to the asserted claims of the patents-in-suit; and
- (5) that the asserted claims are patentable because production of a biologically active protein was an “unexpected result.”

In support of this motion, Roche submits an accompanying memorandum of law, and declaration of Krista M. Rycroft including exhibits.

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 that no agreement could be reached.

Dated: August 10, 2007
Boston, Massachusetts

Respectfully submitted,

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

By their Attorneys

/s/ Kregg T. Brooks
Lee Carl Bromberg (BBO# 058480)
Timothy M. Murphy (BBO# 551926)
Julia Huston (BBO# 562160)
Keith E. Toms (BBO# 663369)
Nicole A. Rizzo (BBO# 663853)
Kregg T. Brooks (BBO# 667348)
BROMBERG & SUNSTEIN LLP
125 Summer Street
Boston, MA 02110
Tel. (617) 443-9292
kbrooks@bromsun.com

Leora Ben-Ami (*pro hac vice*)
Mark S. Popofsky (*pro hac vice*)
Patricia A. Carson (*pro hac vice*)
Thomas F. Fleming (*pro hac vice*)
Howard S. Suh (*pro hac vice*)
Christopher T. Jagoe (*pro hac vice*)
KAYE SCHOLER LLP
425 Park Avenue
New York, New York 10022
Tel. (212) 836-8000

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/ Kregg T. Brooks
Kregg T. Brooks