

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 MAKING
ASSERTIONS THAT CONTRADICT STATEMENTS MADE IN SPECIFICATIONS OF
PATENTS-IN-SUIT**

Based on the positions taken in interrogatory responses and advanced by its experts in their expert reports, plaintiff Amgen Inc. (“Amgen”) intends to offer evidence, expert testimony and attorney argument at trial in support of its current assertion that the claims of the patents-in-suit¹ are not obvious in light of prior art disclosed in the now expired U.S. Patent No. 4,703,008 and U.S. Patent Nos. 5,441,868; 6,618,698; 5,756,349; 5,955,422; 5,547,933; and 5,621,080 (“Amgen’s EPO patents”). Many of these arguments and much of the proposed evidence and testimony directly contradict statements made in the common specification of the patents-in-suit regarding prior art. Amgen should not be permitted to represent one thing to the Patent Office to

¹ The patents-in-suit are U.S. Patent Nos. 5,441,868; 6,618,698; 5,756,349; 5,955,422; 5,547,933; and 5,621,080.

distinguish its “invention” and obtain a patent, only to later disavow those statements in this Court when it becomes convenient for litigation.

In accordance with the facts and the principles of law set forth above, Roche respectfully requests that this Court preclude Amgen from offering evidence, testimony or argument that contradicts Amgen’s statements made in the specifications of the patents-in-suit regarding prior art. Roche submits an accompanying memorandum of law, and a declaration of Kregg T. Brooks 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 13, 2007
Boston, Massachusetts

Respectfully submitted,

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

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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