

**UNITED STATES DISTRICT COURT  
DISTRICT OF MASSACHUSETTS**

AMGEN, INC.,	)	
	)	
Plaintiff,	)	
	)	
v.	)	Civil Action No. 05 CV 12237 WGY
	)	
F. HOFFMANN-LAROCHE LTD., a Swiss	)	
Company, ROCHE DIAGNOSTICS	)	
GMBH, a German Company, and	)	
HOFFMANN LAROCHE INC., a New	)	
Jersey Corporation,	)	
	)	
Defendants.	)	

**BRIEF IN SUPPORT OF AMGEN'S MOTION *IN LIMINE* NO. 15:  
EXCLUDE TESTIMONY OF ROCHE'S IN-HOUSE COUNSEL GEORGE JOHNSTON  
BECAUSE HIS TESTIMONY IS IRRELEVANT AND ROCHE FAILED TO IDENTIFY  
HIS TESTIMONY PURSUANT TO FED. R. CIV. P. 26(a) DURING DISCOVERY**

## **I. INTRODUCTION**

George Johnston is in-house counsel for defendant Hoffman-La Roche, Inc., and is identified as a witness expected to testify on behalf of the Roche defendants (hereinafter “Roche”) at trial. Mr. Johnston should be precluded from testifying at trial because his testimony will not be relevant to any facts or issues in this case and because Roche has not disclosed him as a witness or any evidence pertinent to his testimony during discovery.

Roche has admitted that Amgen has not asserted any claim of willful infringement, so testimony as to Roche’s state of mind is not relevant to any facts and issues in the case. Furthermore, pursuant to FRCP 26(a) and 37(c)(1), the testimony of a witness presented at trial should be limited to that which was identified during discovery. Also, Roche refused to produce any opinions or the results of any patent investigations in response to Amgen discovery requests. Roche cannot now introduce opinion or investigation testimony from its in-house counsel, Mr. Johnston, after having denied Amgen discovery on this topic.

Amgen will be prejudiced by Mr. Johnston’s irrelevant testimony because it will confuse the jury and because Roche’s non-disclosure prevents Amgen from preparing for Mr. Johnston’s testimony. Accordingly, Amgen requests that Mr. Johnston, Roche’s in-house counsel, be precluded from testifying at trial.

## **II. ARGUMENT**

### **A. Roche Admits That Its State of Mind is Not at Issue in This Case so Johnston’s Testimony is Irrelevant**

There is no claim of willful infringement in this case. Roche admits that its state of mind

is not at issue in this case.<sup>1</sup> Mr. Johnston 's testimony therefore cannot be relevant to any disputed facts or issues regarding invalidity or infringement. Mr. Johnston is in-house counsel for Roche and is not a fact witness, an expert witness, or a patent law expert in this case. He could testify about Roche's opinion about the patents-in-suit but since, as Roche admits, willfulness is not at issue, Mr. Johnston 's expected testimony about Roche's good faith efforts to investigate the patents-in-suit is not relevant and should be excluded under FRE 402.

Amgen will be prejudiced by Mr. Johnston 's irrelevant testimony because of the potential confusion it will cause the jury. Roche's state of mind is not at issue and the jury should not be misled into thinking that it is. Mr. Johnston can say nothing that will help the jury better understand the facts and issues of the case and his testimony should be excluded.

**B. Roche Improperly Seeks Testimony of Mr. Johnston Despite Never Disclosing Him As a Witness Nor Any Evidence Relevant to His Testimony During Discovery**

Pursuant to FRCP 37(c)(1), a party is not permitted to use as evidence any information or witness not disclosed as required in FRCP 26, unless the failure to disclose was harmless. Roche did not disclose Mr. Johnston as a potential witness in its 26(a) disclosures. Nor do any of its responses to Amgen's numerous discovery requests list or discuss Mr. Johnston as having knowledge of relevant information in this case.

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<sup>1</sup> *Amgen Request No. 262*: All documents and things relating to any investigation, study, evaluation, opinion, meeting minutes, or project reports concerning any alleged lack of patentability, invalidity, or unenforceability of the patents-in-suit. *Roche Response to Amgen Request No. 262*: Roche objects to this Request as overly broad, unduly burdensome, vague, ambiguous, harassing and not reasonably calculated to lead to the discovery of admissible evidence, ***particularly as Amgen has not asserted any claim of willful infringement.*** Additionally, Roche objects to this Request to the extent it is duplicative of Amgen's Request for Production No. 198. Moreover, Roche objects to this request to the extent it calls for claim construction and no Markman hearing has been conducted yet in this case. Roche objects to this Request to the extent it calls for a legal conclusion or expert opinion. Roche also objects to this Request as seeking information protected from disclosure by the attorney-client privilege and the attorney work product doctrine and therefore will not produce any such documents (emphasis added).

Whenever Amgen asked specifically for evidence of Roche's investigation into or opinion about the patents-in-suit, Roche objected that the request sought information that was privileged. For example, in response to Amgen's Request for Production No. 197,<sup>2</sup> Roche objected on the grounds that the request sought "information protected from disclosure by the attorney-client privilege and the attorney work product doctrine. Moreover, Roche objects to this Request to the extent it calls for a legal conclusion."<sup>3</sup> Roche offered no insight into its investigations into the patents-in-suit during discovery.

After failing to disclose Mr. Johnston as a witness who may know information relevant to this case and after failing to identify any documents or other evidence that provides the bases for Mr. Johnston's testimony, Roche cannot now rely upon his testimony at trial. That would be unfairly prejudicial to Amgen because it has been prevented from preparing for Mr. Johnston's trial testimony.

### **III. CONCLUSION**

For the foregoing reasons, Amgen respectfully requests that Mr. Johnston, Roche's in-house counsel, be precluded from testifying at trial.

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<sup>2</sup> *Amgen Request No. 197*: All documents and things relating to any investigation, opinion, testing, evaluation, or analysis as to whether any claim of Amgen's patents-in-suit was or is or will be infringed by the manufacture, importation, use, offer for sale, or sale of peg-EPO, including but not limited to oral or written opinions of an attorney (other than investigation(s), opinion(s), testing, evaluations(s), or analysis by counsel of record in this action after ROCHE received notice that the Complaint had been filed in this action), or any other person [Docket No. 167-5 at p. 28-29].

<sup>3</sup> Roche's Response to Amgen's Request for Production No. 197 [Docket No. 167-5 at p. 29].

Respectfully Submitted,

Date: August 24, 2007

AMGEN INC.,  
By its attorneys,

Of Counsel:

STUART L. WATT  
WENDY A. WHITEFORD  
MONIQUE L. CORDRAY  
DARRELL G. DOTSON  
KIMBERLIN L. MORLEY  
ERICA S. OLSON  
AMGEN INC.  
One Amgen Center Drive  
Thousand Oaks, CA 91320-1789  
(805) 447-5000

/s/ Michael R. Gottfried  
D. DENNIS ALLEGRETTI (BBO#545511)  
MICHAEL R. GOTTFRIED (BBO#542156)  
PATRICIA R. RICH (BBO#640578)  
DUANE MORRIS LLP  
470 Atlantic Avenue, Suite 500  
Boston, MA 02210  
Telephone: (857) 488-4200  
Facsimile: (857) 488-4201

LLOYD R. DAY, JR. (*pro hac vice*)  
DAY CASEBEER  
MADRID & BATCHELDER LLP  
20300 Stevens Creek Boulevard, Suite 400  
Cupertino, CA 95014  
Telephone: (408) 873-0110  
Facsimile: (408) 873-0220

WILLIAM GAEDE III (*pro hac vice*)  
McDERMOTT WILL & EMERY  
3150 Porter Drive  
Palo Alto, CA 94304  
Telephone: (650) 813-5000  
Facsimile: (650) 813-5100

KEVIN M. FLOWERS (*pro hac vice*)  
MARSHALL, GERSTEIN & BORUN LLP  
233 South Wacker Drive  
6300 Sears Tower  
Chicago IL 60606  
Telephone: (312) 474-6300  
Facsimile: (312) 474-0448

**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 and paper copies will be sent to those indicated as non-registered participants on August 24, 2007.

*/s/ Michael R. Gottfried*  
Michael R. Gottfried