

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.)	
_____)	

**DEFENDANTS’ MOTION FOR PARTIAL RECONSIDERATION OF THE COURT’S
AUGUST 27, 2007 ORDER REGARDING OBVIOUSNESS-TYPE DOUBLE
PATENTING OF CLAIM 7 OF THE ‘349 PATENT**

Defendants F. Hoffmann-La Roche Ltd, Roche Diagnostics GmbH, and Hoffmann-La Roche Inc. (collectively “Roche”) respectfully submit this motion for partial reconsideration of the Court’s August 27, 2007 Order (“the Order”) granting Amgen’s Motion for Summary Judgment of No Obviousness-Type Double Patenting of claim 7 of the ‘349 patent.¹

Roche respectfully maintains that the Order is clearly erroneous under 35 U.S.C. § 121 and will result in manifest injustice to Roche and the public at large in light of the following:

- During prosecution of the ‘349 patent, Amgen explicitly told the PTO that the process claim that has since issued as claim 7 “was not included in the original claims of” the patent application. Because the claim did not even exist at the time of the 1986 restriction requirement, the claim could not have been subject to the restriction requirement and is not protected from an obviousness-type double patenting defense under Section 121.
- Although during prosecution of the ‘349 patent Amgen originally relied on the restriction requirement for the vertebrate cells of Group IV (and not the process claims of Group II) , the vertebrate cell claims were later amended so that they no

¹ The Court’s Order also dismissed Roche’s obviousness-type double patenting claims with respect to the Lai ‘016 patent, the ‘422 patent and the ‘933 patent. This motion does not ask reconsideration of these issues as, without the Court’s opinion, Roche is unaware of the basis for the Order and therefore reserves its rights.

longer belonged in Group IV. Having made amendments to the vertebrate cell claims, when the Examiner raised the possibility of a double patenting rejection, Amgen no longer relied on the restriction requirement and responded to the double patenting issue on the merits.

Accordingly, Roche respectfully requests that the Court grant Roche's Motion For Partial Reconsideration of the Court's August 27, 2007 Order Regarding Obviousness-Type Double Patenting of Claim 7 of the '349 Patent. In support of this motion, Roche relies on the accompanying Memorandum of Law.

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 was reached.

DATED: Boston, Massachusetts
August 31, 2007

Respectfully submitted,

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

By their Attorneys,

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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/ Kimberly J. Seluga
Kimberly J. Seluga

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