

**IN THE UNITED STATES DISTRICT COURT  
IN AND FOR THE DISTRICT OF MASSACHUSETTS**

AMGEN INC., )  
 )  
 Plaintiff, )  
 )  
 v. )  
 )  
 F. HOFFMANN-LA ROCHE LTD, a )  
 Swiss Company, ROCHE DIAGNOSTICS )  
 GMBH, a German Company, and )  
 HOFFMANN LA ROCHE INC., a New )  
 Jersey Corporation, )  
 )  
 Defendants. )  
 )

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Civil Action No.: 1:05-cv-12237 WGY

**PLAINTIFF AMGEN INC.’S MOTION *IN LIMINE* NO. 24 TO PRECLUDE EVIDENCE  
FOR OBVIOUSNESS THAT VIOLATES 35 U.S.C § 103 PROHIBITION  
THAT “PATENTABILITY SHALL NOT BE NEGATED BY THE MANNER  
IN WHICH THE INVENTION WAS MADE” AND WHICH REFLECTS THE  
SUBJECTIVE BELIEFS OF THE INVENTOR**

Plaintiff Amgen Inc. ("Amgen") requests under Federal Rules of Evidence 402 and 403 that this Court preclude Defendants F. Hoffman-La Roche Ltd., Roche Diagnostics GmbH, and Hoffman-La Roche Inc. (collectively "Roche") from referring or introducing evidence for obviousness that would violate the prohibitions of 35 U.S.C. § 103 and case law thereunder interpreting the statute relating to the inadmissibility of the subjective beliefs of the inventor and evidence of conception and reduction to practice to establish obviousness. Roche seeks to introduce such evidence through testimony of its experts, particularly Dr. Lowe, and through the eliciting of such testimony from Amgen witnesses, particularly Dr. Lin.

The last sentence of 35 U.S.C. § 103(a) states: “Patentability shall not be negated by the manner in which the invention was made.” Roche seeks to introduce evidence on the manner in which the invention was made. This evidence would cause the Jury to focus on the wrong persons perspective, to focus on the wrong inquiry, and to assess obviousness at the wrong point in time thereby leading the Jury into reversible legal error.

Further, 35 U.S.C. § 103(c)(1) states that “subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of Section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

Accordingly, Amgen requests that this Court preclude Roche from referring to or offering any evidence at trial any evidence for obviousness that violates 35 U.S.C. § 103.

In support of this motion, Amgen submits a brief with an accompanying declaration from William G. Gaede III and exhibits thereto.

DATED: September 5, 2007

Respectfully Submitted,

Of Counsel:

AMGEN INC.,

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 G. 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 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 no agreement was reached.

/s/ Michael R. Gottfried

Michael R. Gottfried

**CERTIFICATE OF SERVICE**

I hereby certify that this document filed through the Electronic Case Filing (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/ Michael R. Gottfried

Michael R. Gottfried