

1 UNITED STATES DISTRICT COURT
 2 SOUTHERN DISTRICT OF INDIANA
 INDIANAPOLIS DIVISION

3 IN RE RECOMBINANT DNA TECHNOLOGY)
 PATENT AND CONTRACT LITIGATION)
 4) MDL Docket No. 912
 THE REGENTS OF THE UNIVERSITY OF)
 5 CALIFORNIA)
)
 6 Plaintiff,)
)
 7 -vs-) CAUSE NO. IP 92-224-C D/G
) Indianapolis, Indiana
) August 25, 1995
 8 ELI LILLY AND COMPANY,)
)
 9 Defendant.)

10 Before the

11 HONORABLE S. HUGH DILLIN

12 TRANSCRIPT OF PROCEEDINGS AT TRIAL

13 APPEARANCES:

14 For the Plaintiff: Arthur I. Neustadt
 15 Jean-Paul Lavalleye
 16 Marc R. Labgold
 17 William J. Healey
 Amy Levinson
 18 Kevin Bell
 Susan B. Tabler

19 For the Defendant: Donald R. Dunner
 20 Charles E. Lipsey
 Amy E. Hamilton
 21 John C. Jenkins
 Jeffrey Karceski

22 Court Reporter: Patricia A. Cline, CM
 23 Antonette Thompson, RPR-CSR
 24

25 PROCEEDINGS TAKEN BY MACHINE SHORTHAND
 COMPUTER-AIDED TRANSCRIPT

1 (The Court recessed from 12:00 p.m. to 1:30 p.m.)

2 THE COURT: We have a new witness.

3 PLAINTIFF'S WITNESS, LORANCE L. GREENLEE, SWORN

4 DIRECT EXAMINATION

5 BY MR. HEALEY:

6 Q. Good afternoon, Dr. Greenlee.

7 A. Good afternoon.

8 Q. Would you state and spell your complete name for the
9 record.

10 A. Lorance, L-O-R-A-N-C-E, Greenlee G-R-E-E-N-L-E-E.

11 Q. And Dr. Greenlee, what is your occupation?

12 A. I'm a patent attorney. I'm currently the major
13 stockholder of Greenlee, Winner, which is the law firm in
14 Boulder, Colorado, specializing in intellectual property
15 law, primarily patents.

16 Q. And I'd like to go through your education with you,
17 please. Tell us where you went to college starting with
18 your bachelor's.

19 A. I received a Bachelor's in Chemistry from the
20 University of Colorado; a Ph.D. in Biochemistry from Duke
21 University.

22 Q. In what year was that?

23 A. My bachelor's was in 1957; my Ph.D. was in 1962.

24 I then did a year of postdoctoral work at Duke
25 University; followed that with three years of postdoctoral

1 work at California Institute of Technology, that would have
2 been from 1963 to '66.

3 Q. What research area was your postdoctoral study in?

4 A. My postdoctoral research was in the field of Bacterial
5 Virus DNA Replication. I worked with Dr. Robert
6 Sinsheimer, S-I-N-S-H-E-I-M-E-R.

7 Q. And where did you go after you left your postdoc?

8 A. I took a position at the University of Utah, originally
9 as an assistant professor with a career development award
10 from the National Institute of Health.

11 Q. In which department were you a professor?

12 A. At the time I believe it was called the Department of
13 Molecular Biology, and later merged and is now the
14 Department of Biology.

15 Q. How long did you continue as a professor at the
16 University of Utah?

17 A. I continued as a professor until 1973, as associate
18 professor at that time. I then decided to go to law
19 school, and I went to the University of Utah Law School and
20 graduated in 1976.

21 Q. Where did you go to work after you graduated law
22 school?

23 A. My first job was in Washington, D.C. with the firm of
24 Irons and Sears.

25 Q. Was it difficult to find a job with your educational

1 background?

2 A. Jobs certainly didn't fall into my lap. I finally
3 elected to go to Washington to concentrate my job search
4 there. I wasn't searching specifically for a position in
5 patent law, although that was clearly an option, but what I
6 was interested in was any sort of form of legal practice
7 that could somehow make use of my background in science.

8 Q. What type of work did you do at Irons and Sears?

9 A. I began almost immediately doing patent prosecution. I
10 started, did a variety of things; searching in the patent
11 office, writing applications, doing legal research and
12 memoranda for the senior partners. And I believe I may
13 have even been involved in some document production work in
14 relation to litigation.

15 Q. How long did you stay at Irons and Sears?

16 A. I remained at Irons and Sears until late November of
17 1979.

18 Q. Why did you leave?

19 A. The situation at Irons and Sears led me to feel that
20 there wasn't a good opportunity for advancement there.

21 Furthermore, I wanted to look for a firm where I could have
22 a more congenial atmosphere to work in.

23 Q. Did you have another job in patent law when you left
24 Irons and Sears?

25 A. Not immediately, no.

1 Q. Where did you go?

2 A. I went to Keil and Witherspoon.

3 Q. And there was a lag in between leaving Irons and
4 Sears --

5 A. Well, it was a pretty minor lag. I was unemployed over
6 the Thanksgiving holidays was my recollection.

7 Q. And what did you do at Keil & Witherspoon?

8 A. Continued to do patent prosecution work.

9 Q. In which technical field?

10 A. Well, primarily in the field of biotechnology. The
11 University of California patent work, which I began working
12 on at Irons and Sears, continued at Keil and Witherspoon.
13 And that occupied a fairly large portion of my time,
14 although I did work on other things, primarily chemical
15 patents.

16 Q. When did you leave Keil and Witherspoon?

17 A. In October of 1982.

18 Q. Where did you go?

19 A. I took the position as chief patent counsel for
20 Agrigenetics Corporation, A-G-R-I-G-E-N-E-T-I-C-S, which
21 was located in Golden, Colorado, subsequently relocated to
22 Boulder, Colorado.

23 Q. When did you leave Agrigenetics?

24 A. I left Agrigenetics in 1987.

25 Q. What did you do when you left Agrigenetics?

1 A. I then established the firm that is now Greenlee
2 Winter.

3 MR. HEALEY: Your Honor, I'd like to offer into
4 evidence Defendant's Exhibit 3585 which is Dr. Greenlee's
5 CV.

6 THE COURT: It will be received.

7 MR. DUNNER: No objection, Your Honor.

8 (Defendant's Exhibit(s) 3585 received in evidence.)

9 Q. Was there an active biotech patent practice at Irons
10 and Sears when you joined them in 1976?

11 A. In the sense we've been talking about biotechnology in
12 this case, no. I began working on cases involving
13 immunoassays for diagnostic purposes. However, at that
14 time there was really not any other recombinant DNA
15 technology other than the Cohen-Boyer work had, to my
16 knowledge, come to the point where it was being patented.

17 Q. So were you aware that Cohen and Boyer had a pending
18 patent application when you started working at Irons and
19 Sears?

20 A. Yes, I was.

21 Q. How were you aware of that?

22 A. Probably from reading the newspaper. I don't think it
23 was much of a secret that they had a patent application.

24 Q. Did you have any contact with the attorney who was
25 prosecuting the Cohen and Boyer patent?

1 A. Yes, I did. I contacted him at the time of my job
2 search, and I also contacted him -- corresponded with
3 him --

4 Q. And who are you referring to?

5 A. His name a Bert Roland. Corresponded with him while I
6 was at Irons and Sears. While I was at Irons and Sears, I
7 began doing a lot of research and thinking about the
8 patentability of microorganisms and of DNA. These were
9 issues that were apparently going to come to the attention
10 of patent attorneys in the patent office. And I was trying
11 to develop a way of thinking about these so that I kept
12 thinking about how to claim what would be patentable, why
13 would it be patentable, what should be considered
14 patentable subject matter. All of these things were in
15 debate at that time and were very -- everybody was
16 speculating. I was trying to understand what kinds of case
17 law could be applied to this new technology. So I actually
18 wrote to Bert Roland and asked him what his thoughts were
19 on the subject.

20 Q. So the technology we've been talking about so far this
21 week, you're saying that in 1976 it was still an open
22 question whether any of this work would be patentable?

23 A. That's correct.

24 Q. Had any biotech patents in recombinant DNA or cloning
25 issued as of 1977?

1 A. Not to my knowledge.

2 Q. How did you prepare yourself to prosecute recombinant
3 DNA applications if none were available for you to work
4 from or study?

5 A. Well, the reason that it would be, the closest analogy
6 was the chemical patent law. And I elected decisions in
7 the chemical patent law to see how they might be applied.
8 Interestingly enough, Irons had written an article about
9 patentability of microorganisms, which I think was
10 published in 1975.

11 Q. Was Mr. Irons knowledgeable in recombinant DNA
12 technology?

13 A. I would say not.

14 Q. What was his technical background if you know it?

15 A. To the best of my knowledge or recollection, it was
16 chemistry.

17 Q. Did he share your interest in the patentability of
18 recombinant DNA?

19 A. I would say that he was interested in this subject, but
20 I don't think that he, beyond researching the article that
21 he wrote, did any more -- we did not participate together
22 in working on these ideas.

23 Q. Did you work closely with Mr. Irons otherwise while you
24 were at Irons and Sears?

25 A. On occasion, yes.

1 Q. What was your first contact with the University of
2 California?

3 A. The sequence of events is a bit hazy to me. I was
4 contacted by Josephine Opalka who was head of University of
5 California Patent Department at that time.

6 Q. Why did she contact you?

7 A. She asked me to undertake to do patent application for
8 the work of Rutter, et al., which was at that time the
9 cloning of the rat insulin gene.

10 Q. Was there a deadline involved in this work?

11 A. There was. An article had been submitted for
12 publication in Science when she first contacted me, which
13 was around -- well, the exact date I don't recall off the
14 top of my head, but it was about a week before that article
15 was to be published.

16 Q. I'd like to refer you to Plaintiff's Exhibit 468, which
17 is in the binder in front of you. I'll also show that on
18 the monitor.

19 Can you identify this exhibit for me?

20 A. I've seen this exhibit. I don't specifically recall it
21 now. But it appears to be the letter of engagement or
22 instruction to me to prepare this patent application
23 covering recombinant bacterial plasmids containing the
24 coding sequences of insulin gene.

25 Q. Were you concerned about being able to meet the

1 deadline as set forth in this letter, which in the first
2 paragraph indicates that the paper will be released on May
3 30th, 1977; was that a concern to you?

4 A. It was going to be a terrific job. It was going to be
5 extremely hard to do.

6 Q. First, could you explain the necessity for filing a
7 patent application when a publication is coming?

8 A. Yes. The University was concerned that the publication
9 would act as a bar for any future foreign patent
10 applications. And so in order to prevent that, they wanted
11 the application to be on file in the U.S. in order to have
12 a priority date preceding the date of the Science article.

13 Q. Does this happen to you a lot where you get papers that
14 are about to issue that have to be filed as patent
15 applications?

16 A. In university practice, which I've now done quite a bit
17 of, it seems to happen with depressing frequency. The
18 investigators are anxious to publish their work, and they
19 do so often without -- particularly if they're not
20 particularly experienced in patent matters, they publish
21 and then think about patenting. So we frequently get --
22 I've frequently gotten applications that have a short fuse
23 and have to be filed quickly.

24 Q. What information did U.C. provide you with in order to
25 prepare this patent application?

1 A. As I recall, they sent me either a manuscript of
2 preprint or galley proof, I'm not sure which, of the
3 Ullrich, et al. paper which ultimately appeared in Science.

4 Q. Is that a manuscript that ultimately accompanied this
5 letter?

6 A. I don't recall.

7 MR. HEALEY: Your Honor, I'd like to offer
8 Plaintiff's Exhibit 468.

9 MR. DUNNER: No objection, Your Honor.

10 THE COURT: It will be received.

11 (Plaintiff's Exhibit(s) 468 received in evidence.)

12 Q. I'd now like to refer you to PX2, which has already
13 been admitted. It's in your book.

14 A. Yes.

15 Q. Could you identify this for me?

16 A. This appears to be a patent which issued from the
17 disclosure that was sent to me.

18 Q. Now, I'd like you to explain for us how you take a
19 manuscript or how you took a manuscript in this situation,
20 and turned it into a patent application. Specifically what
21 did you have to add to the manuscript to turn it into a
22 patent application?

23 A. The easiest way perhaps to do that is to do it through
24 the various sections.

25 MR. HEALEY: Your Honor, as I'm referring to this

1 patent, I'll refer to the column numbers, and there are two
2 column numbers per page.

3 Q. Referring you to column 1, Dr. Greenlee, let's just go
4 through the subheadings and explain those.

5 A. Beginning with the background of the invention, this is
6 a section that was designed to acquaint the reader with the
7 basics of the principles involved of molecular biology as
8 they were understood at the time. In particular, there
9 were some abbreviations that were used throughout; defined
10 those.

11 There was a good deal of information about DNA, what it
12 is, what its chemistry is, what 5' and 3' ends are; the
13 principles of base pairing, which have already been talked
14 about here; the sizes of the molecules involved; the
15 biological significance of the base sequence of DNA.

16 Going on to through column 3, the relationship,
17 functional relationship, the structural relationship
18 between DNA, RNA; the coding relationships by which the
19 information in DNA is translated into protein structure.

20 Q. This information goes on for how many columns?

21 A. It goes on through an evalua -- insulin goes on through
22 into the middle of part of column 8.

23 Q. And I would like to clarify for the Court, we're
24 looking at what is actually a continuation in part
25 application of your initial application, so not all the

1 material we're looking at in the background was necessarily
2 in the first draft; is that correct?

3 A. I believe that's correct.

4 Q. Where did you get the information that you put into the
5 background of the invention?

6 A. Much of the information came out of my knowledge and
7 understanding of the field, coupled with, of course,
8 reviewing what had transpired since I got out of science
9 and became a lawyer. So there were some things that I had
10 to catch up on.

11 Q. Did you do your own literature search?

12 A. Yes, I did. I also spoke to the inventors in
13 particular with regard to specifics relating to insulin.

14 Q. Let's go on to column 8.

15 A. Yes.

16 Q. If you can describe that section for me.

17 A. This is the summary of the invention, is basically a
18 synopsis of the results that were described in further
19 detail.

20 Q. Dr. Greenlee, you can refer to the monitor. You don't
21 have to look at the book.

22 A. Is that more helpful to you?

23 Q. I don't want you to struggle with the notebooks if you
24 don't have to. Just give me a brief, brief background of
25 what's in the summary.

1 A. There's a lot of definitions there with regard to
2 microorganisms, and a general description of how cDNA is
3 produced and then how it's cloned.

4 Q. Now I'd like to refer you to column 9, and that will
5 also come up on the screen.

6 A. This is the beginning of the detailed description of
7 the invention. This includes not only the -- not only the
8 experimental details that the inventors provided, but also
9 what are termed broad enabling statements that are used to
10 generalize the procedures, to make it clear that
11 procedures, steps and principles that are generated by the
12 specific embodiments of the invention and reduced to
13 practice, that those principles can be applied to in other
14 ways as well.

15 Q. Does this contain information that was provided to you
16 by the inventors?

17 A. It contains an enormous amount of information provided
18 by the inventors, particularly further on in the example
19 section.

20 Q. We can go to the examples. I believe that starts on
21 page 15 -- or rather column 15.

22 Where does the information in the examples come from?

23 A. Now, this information came almost entirely from the
24 Ullrich paper, the experimental section of that.

25 Q. So this is just an exact description of the work they

1 published?

2 A. Yes. I spoke to several of the inventors -- I don't
3 recall how many or who precisely at this time -- to get
4 explanations of some of the things that were written in the
5 Science article regarding these procedures. Sometimes
6 they're written in a way that's really only cognizable to
7 other scientists in the field. In some cases I thought
8 might be helpful to expand those. Sometimes I needed
9 explanations because I didn't understand them.

10 Q. But we still end up with a pretty complicated document
11 here, don't we, Dr. Greenlee?

12 A. There's a lot of information in it, yes.

13 Q. Let's refer now to column 20, which is where the claim
14 section begins. Just tell me briefly what a claim is.

15 A. Claims are intended, as Mr. Conlin testified to, to set
16 forth the metes and bounds of the invention. This is a
17 patent attorney's way of describing it. At this time it
18 was not at all clear, as I said before, of what could be
19 patentable and how broadly it could be claimed. So the
20 original file claims contained a number of broad claims
21 that were intended to be of a scope that I believed would
22 be reasonably patentable given my understanding of the laws
23 that applied to this technology.

24 Q. Did anyone assist you in the drafting of this patent
25 application?

1 A. Anyone at Irons and Sears?

2 Q. Yes.

3 A. I did have some consultations about some legal points
4 with Mr. Irons and probably had some conversations with
5 other people in the office, but primarily I did it myself.

6 Q. Had you drafted any patent applications before this
7 one?

8 A. I had.

9 Q. How many?

10 A. Well, it's hard to remember, but I had only been there
11 since from September to May, so I may have drafted maybe
12 five or six applications. I don't know for sure.

13 Q. And were any of those in the field of recombinant DNA
14 technology?

15 A. No.

16 Q. This was the first?

17 A. That's right, this was the first.

18 Q. Were you able to do good work on this application
19 despite the rush you were in?

20 A. Well, I believe I did an excellent job. I'm tooting my
21 own horn, but you asked the question.

22 This was a very exciting piece of work, a very exciting
23 piece of science, a very exciting piece of legal
24 ground-breaking in the sense that we now had the
25 opportunity to put before the patent office a patent

1 application covering a very important new technology. So
2 it was very exciting for me to, A, be involved in this
3 work, have the advantage to take advantage of my background
4 to apply the patent law; and also a tremendous
5 responsibility to try to get it right.

6 Q. Do you know which examiner this application went to
7 when you filed it?

8 A. Ultimately this application went to Examiner
9 Tanenholtz.

10 Q. Did you have other cases before Examiner Tanenholtz?

11 A. I don't think prior to that time I had any contact with
12 Tanenholtz.

13 Q. And subsequently?

14 A. Subsequently I prepared a file of a number of
15 University of California cases. And to my knowledge, at
16 least through up to about 1980, to my recollection at
17 least, they all went to Tanenholtz.

18 Q. So all these applications you filed went to the same
19 examiner?

20 A. I believe so.

21 Q. Were you filing other recombinant DNA patent
22 applications for other clients?

23 A. No, not for other clients.

24 Q. Was there already an established art unit in the patent
25 office for recombinant DNA patents when you filed this

1 application?

2 A. I need to make a bit of a disclaimer that I didn't
3 really have a clear understanding of how the examining
4 group was organized in the patent office, but it's my
5 impression that Mr. Tanenholtz was a part of a larger group
6 that handled a variety of other things. I did learn from
7 him that he also was the examiner for the Boyer patent --
8 or patent application. And it's my belief that he was the
9 only one handling this technology at that time.

10 Q. To your knowledge, did Lilly at some point obtain an
11 interest in the U.C. '525 patent application?

12 A. Yes.

13 Q. And was Lilly involved in the U.S. patent prosecution?

14 A. Lilly was not involved directly in the U.S. patent
15 prosecution. When Lilly and University of California came
16 to an agreement to support, give Rutter support -- or give
17 Rutter and Goodman support for their research and to help
18 the University pay for the patent prosecution, we kept
19 Lilly informed of what was going on in the U.S., but they
20 did not help direct it or have direct contact with it.

21 Q. How about in foreign patent prosecution, was Lilly
22 involved in that?

23 A. That was different. When it came time to file the
24 first foreign patent applications, Lilly brought me up to
25 Indianapolis to meet with Cal Sparrow, who is the head of

1 the Lilly foreign patent department. They wanted to --
2 Lilly wanted to file this case in 37 different countries.
3 Sparrow was a highly experienced attorney in the field of
4 foreign patent prosecution. I spent a couple of days
5 working with him initially. He was a very knowledgeable,
6 informative man. I basically learned at his knee a great
7 deal of what I today know about foreign practice.

8 Q. So you worked very closely with Dr. Sparrow?

9 A. I worked closely with Dr. Sparrow and the people in his
10 office, and basically took instruction from Lilly as to the
11 manner of prosecuting the U.C. cases abroad.

12 Q. Did you, in fact, file 37 foreign patent applications?

13 A. Yes.

14 Q. And did you work on the prosecution of those cases?

15 A. Yes.

16 Q. Were you assisted by anyone at Lilly in the prosecution
17 of those cases?

18 A. Yes.

19 Q. I'd like to refer you to PX653, which will be on the
20 monitor. It's also in your book. Can you identify this
21 letter for me?

22 A. Again, I don't actually remember it, but it appears to
23 be, it's a letter from -- well, I can see on my copy my
24 signature, from me to Cal Sparrow in regard to foreign
25 filing Philippines, the counterpart of this original Rutter

1 case.

2 Q. Did you look to Mr. Sparrow for instructions on how to
3 proceed in foreign patent prosecution?

4 A. Yes. We worked together. My contribution was
5 primarily to help devise arguments based around what I
6 understood the technology -- arguments in the event of
7 rejection by those offices. And also -- but then
8 Mr. Sparrow or somebody in his office would instruct us to
9 procedural matters as to how to amend claims, claim
10 language, what kinds of claim language were acceptable in
11 which countries, that sort of thing.

12 Q. Did you work with anyone else at Lilly besides
13 Dr. Sparrow?

14 A. Yes, I worked with some people in his office.

15 Q. I'd like to refer you to PX459. Can you describe this
16 letter for me?

17 A. Yes. This is a letter to me from Karen Kimble. That's
18 regarding a matter for the same case I had filed in Canada.

19 Q. How can you identify that it's the same case?

20 A. The docket number, UC-1B.

21 Q. Who's docket number is that?

22 A. That was the docket number that I had -- that I put on
23 these cases. UC-1, and 1 with a letter following it was
24 the docket number that related to this case and subsequent
25 divisions and continuations and continuations in part.

1 Q. Was Ms. Kimble's letter that is PX459 instructing you
2 what to do in a foreign prosecution? And this example was
3 Canada.

4 A. Yes. She's instructing me with regard to claim
5 practices. The examiner agreed to maintain the claims
6 generic to insulin. I'm not going to read the whole letter
7 here.

8 Q. Was it unusual for a licensee to have such -- this type
9 of involvement in foreign patent prosecution?

10 A. I don't know. It was my first experience.

11 Q. Whose interests were you representing when you were
12 caring out this foreign patent prosecution, Lilly's or
13 U.C.?

14 A. I felt that I was carrying out the interests of both
15 parties and that the interests were common interests.

16 Q. Whom did you bill for the work in foreign patent
17 prosecution?

18 A. At Irons and Sears, I wasn't privy to the way billing
19 was done. So I could only speak to the time that I was at
20 Keil and Witherspoon and I recall that we billed Eli Lilly
21 directly for the foreign prosecution.

22 MR. HEALEY: Your Honor, I'd like to offer
23 Plaintiff's Exhibit 653 and 459.

24 MR. DUNNER: No objection, Your Honor.

25 THE COURT: They will be received.

1 Q. Dr. Greenlee, I'd now like to refer you to Defendant's
2 Exhibit 3449. Can you identify this document for me?

3 A. I don't recall it. It appears to be a letter from me
4 to a French associate requesting copies of European patent
5 applications 1929, 1930 and 1931.

6 Q. Do you remember requesting these published patent
7 applications?

8 A. No, I don't.

9 Q. And can you note the date on this letter for me?

10 A. June 6, 1979.

11 Q. And does this letter indicate to you which matter for
12 U.C. you were requesting these patents?

13 A. No, it doesn't.

14 Q. I'd like to refer you to DX3450. Can you identify this
15 document for me?

16 A. It appears to be a document signed by me requesting --
17 thanking the associate for sending copies of referenced
18 European patent applications and requesting copies of U.S.
19 priority applications for the same documents.

20 Q. Do you remember receiving copies of the listed European
21 patent applications 1929, 1930 and 1931?

22 A. No, I don't.

23 Q. Can you note the date on this letter for me, please?

24 A. June 26, 1979.

25 Q. Please refer to Defendant's Exhibit 3452. That's also

1 up on the screen; can you identify this letter for me?

2 A. It appears to be a letter to Roger Ditzel from me.

3 Q. Who is Roger Ditzel?

4 A. Roger Ditzel was a successor to Josephine Opalka.
5 California administrator, patent administrator for the
6 University system.

7 Q. Do you remember sending Mr. Ditzel copies of European
8 applications being 1929, 1930 and 1931?

9 A. No, I don't.

10 Q. Did you retain a copy of any of those applications for
11 your records?

12 A. I don't recall.

13 Q. Please note the date on this letter as well.

14 A. This is June 29, 1979.

15 Q. Now, as of that date, Dr. Greenlee, had you received
16 any information or disclosure from the University of
17 California on their human proinsulin cloning work?

18 A. Not that I recall.

19 Q. I'd like to refer you to Plaintiff's Exhibit 331. Can
20 you identify this for me?

21 A. This is a letter to me from Stanley Lerner of the Board
22 of Patents at the University dated July 31, 1979,
23 requesting -- sending a disclosure from Dr. Rutter and
24 requesting me to provide preliminary opinion on
25 patentability.

1 Q. We'll ask for the third page of this document to be
2 brought up on the screen.

3 THE COURT: I've just been advised that reporters
4 upstairs cannot hear the witness even though he's wearing a
5 mike, I believe.

6 THE WITNESS: I am wearing a mike. I'll speak
7 louder.

8 THE COURT: That's better, okay.

9 THE WITNESS: I thought since I had the mike, I
10 didn't need to do that.

11 MR. HEALEY: I thought that yesterday too. It
12 didn't work.

13 THE WITNESS: Tried to work within the realm of
14 logic.

15 Q. If you refer to the screen, can you identify a page 3
16 on this document for me?

17 A. From this page, I must say I can't identify it.

18 Q. Please refer to the document in your binder, then?

19 A. Yes, this appears to be the -- a copy of the manuscript
20 that was enclosed by Mr. Lerner in this letter.

21 Q. And was this letter dated July 31, 1979, the first
22 information you had from U.C. that they were interested in
23 filing a patent application on human proinsulin? I'll
24 clarify that based on their loaning of the human proinsulin
25 gene.

1 A. Would you repeat the question.

2 Q. Sure. This document dated July 31, 1979, was this the
3 first indication you had from U.C. that they were
4 interested in having you file a patent application based on
5 their cloning of the gene for human proinsulin.

6 THE COURT: You know, you're whispering more than
7 anybody. Can you bring it up a little bit.

8 MR. HEALEY: Absolutely, sir.

9 A. I'll answer your question in this way: I believe that
10 the first time that I learned about the -- about this
11 subject matter and was asked to, was at the time I was
12 asked to do this patentability opinion. And the reason I'm
13 a bit hesitant here is that each of the pages on this
14 exhibit seem to have different dates and I'm a little bit
15 confused about that. The first page has a date of July 31.
16 The second page has a date of July 27. And then the copy
17 of the submitted article appears to have a received stamp
18 from Irons and Sears of July 18.

19 Q. So on page 3 you have the earliest date that's
20 indicated is July 18, 1979. Do you remember having any
21 information on the cloning of human proinsulin by U.C.
22 prior to July 18, 1979?

23 A. Prior to the receipt of this manuscript, no.

24 Q. Did you keep separate files for separate matters that
25 you were working on for U.C.?

1 A. Yes.

2 Q. How many cases were you working on for U.C. at this
3 time, July 1979?

4 A. Well, I believe that I was probably -- this case became
5 my docket number UC-8, but the actual number of cases were
6 more than 8 because some of the original cases had several
7 divisional and continuation parts filed from them. So
8 there were about a dozen cases at that time as well as
9 working on other matters for the University. So I had a
10 lot of files on my desk being piled high.

11 Q. You had other clients as well, didn't you?

12 A. I had other clients.

13 Q. Did you have many files in your office?

14 A. I had a very highly stacked deck -- desk.

15 MR. HEALEY: Your Honor, I'd like to offer
16 Plaintiff's Exhibit 331.

17 MR. DUNNER: No objection, Your Honor.

18 THE COURT: It will be received.

19 Q. Did you, in fact, file a patent application based on
20 this disclosure that you received from U.C. that is PX331?

21 A. Yes, I did.

22 Q. Were you more experienced by this point in biotech
23 patent progression?

24 A. I was much more experienced in preparing and filing
25 cases, yes, and in prosecution.

1 Q. And you, yourself, worked on prosecution of this case?

2 A. Yes, I did.

3 Q. Was Eli Lilly involved in the foreign prosecution of
4 foreign patents related to this case as well?

5 A. Eventually Eli Lilly was involved. At the time it came
6 to foreign filing of this case in the same way as other
7 cases were filed for Lilly.

8 Q. Did the U.C. cases go with you when you left the firm
9 of Irons and Sears?

10 A. Yes, they did.

11 Q. Including the patent application based on PX331 which
12 became the '740 application?

13 A. Yes, including that one.

14 Q. Do you know today what EPA-1929 is, Dr. Greenlee?

15 A. Yes, I know today a great deal about it from this
16 trial.

17 Q. Did you consider prior to the '740 patent issuing
18 whether or not EPA-1929 should be cited to the Patent
19 Office?

20 A. I have no recollection of considering that document.

21 Q. Had you seen or known of the so-called Irons opinion
22 before the '740 patent issued?

23 A. No.

24 Q. Dr. Greenlee, do you take the duty of disclosure to the
25 patent office seriously?

1 A. Yes, I do.

2 Q. Has a client ever asked you to withhold a reference
3 from the patent office?

4 A. Yes, they have.

5 Q. What was your response?

6 A. I tell them that that can't be done. They have to
7 disclose the invention fully. They can't omit critical
8 details. Sometimes upon hearing this the client decides to
9 keep the matter trade secret. Sometimes they decide to
10 comply.

11 Q. Have you ever withheld a reference that you thought was
12 material from the patent and trademark office?

13 A. No, I have not.

14 Q. And one final question: Do you currently represent the
15 University of California?

16 A. No, I do not.

17 MR. HEALEY: Thank you. I have no further
18 questions.

19 THE WITNESS: Thank you.

20 (Discussion off record.)

21 MR. DUNNER: Your Honor, we are making available
22 the deposition transcripts of Dr. Greenlee. In the past
23 you've indicated you were not necessarily interested in
24 those. Would you like a set?

25 THE COURT: No, not really, because you're just

1 going to read from them.

2 MR. DUNNER: That's true, Your Honor.

3 THE COURT: And I can hear you.

4 CROSS-EXAMINATION

5 BY MR. DUNNER:

6 Q. Good afternoon, Dr. Greenlee.

7 A. Good afternoon.

8 MR. DUNNER: Your Honor, apparently there is a
9 problem with the on-line display.

10 THE COURT: Yes, I can see that it's stuck or
11 behind.

12 MR. DUNNER: Shall we proceed nevertheless?

13 THE COURT: Yes, I think we can get along without
14 it. We've done it for several hundred years.

15 MR. DUNNER: Thank you, Your Honor.

16 Q. Dr. Greenlee, you were a member of the patent bar
17 before the '740 patent application was filed, correct?

18 A. Correct.

19 Q. Just for point of reference, that application was filed
20 in September of 1979; does that conform to your memory?

21 A. Yes, it does.

22 Q. And as a member of the patent bar, you had to take an
23 exam to be admitted to practice before the patent and
24 trademark office, correct?

25 A. Yes.

1 Q. And in order to pass that exam, you and others
2 similarly situated were required to be familiar with the
3 patent and trademark office rules, correct?

4 A. Yes.

5 Q. And I gather since you passed the exam, you felt you
6 had a reasonably good grasp of those rules, correct?

7 A. Yes.

8 Q. And one of those rules involved the duty of disclosure,
9 did it not?

10 A. Yes.

11 Q. That rule, every patent lawyer knows, is Rule 56,
12 correct?

13 A. Correct.

14 Q. And you were familiar with the fact that because patent
15 applications are prosecuted before the patent office on an
16 ex parte basis, the patent office required applicants and
17 their attorneys to be particularly candid with the patent
18 office in their dealings with the patent office; isn't that
19 correct?

20 A. Yes.

21 Q. And you were also familiar with a document called The
22 Manual of Patent Examining Procedure, correct?

23 A. Yes.

24 Q. And that document was a guide to examiners prepared by
25 the patent office to indicate how patent applications were

1 to be examined and prosecuted, correct?

2 A. Yes.

3 Q. And in fact, attorneys such as yourself used that
4 manual to guide them in their own dealings with the patent
5 office, correct?

6 A. Correct.

7 Q. And you had a copy of that, did you not?

8 A. Yes.

9 Q. I suspect you would agree that most of the patent
10 lawyers you knew and know have a copy of that who prosecute
11 before the patent office, correct?

12 A. Correct.

13 Q. Now, this duty of disclosure that we've talked about
14 and which is embodied in Rule 56 required the disclosure to
15 the patent office during prosecution of the case of all
16 material information, correct?

17 A. I believe so, yes.

18 Q. And material information was defined at the time the
19 '740 patent was prosecuted as information which a
20 reasonable examiner would feel was relevant to whether or
21 not that examiner should allow or not allow a case; isn't
22 that right? Is that a fair statement?

23 A. Well, I don't have the rule memorized, so I couldn't
24 corroborate without seeing.

25 Q. But is that your basic understanding? If the

1 information would be felt by a reasonable examiner to be
2 important to that examiner in deciding whether to allow a
3 case, that was the kind of information that you felt Rule
4 56 obligated you to disclose; isn't that a fair statement?

5 A. As I say, I don't have the rule in front of me.

6 Q. Are you able to tell me in your own words what you feel
7 Rule 56 indicates you should do in the way of disclosing
8 material information? You cannot tell us now today what it
9 required?

10 A. I don't have it memorized, no.

11 Q. Pardon?

12 A. I don't have it memorized. I cannot quote it.

13 Q. I don't want the quote. I want to know what you feel
14 the essence of that rule is which guides you in what
15 material information is that should be disclosed in patent
16 infringement law.

17 A. Well, I believe that the standard has changed somewhat
18 over the years.

19 Q. I'm talking about in 1979.

20 A. In 1979. I guess I don't have a present recollection
21 of exactly how that standard was defined at that time.

22 Q. Why don't we look at Exhibit 3543. It's in your book.
23 Do you have a big black book?

24 A. Oh, yes.

25 THE COURT: Is this in evidence?

1 MR. DUNNER: Your Honor, I will tell you in a
2 second. No, Your Honor. Your Honor, this is an extract
3 from the -- my notes say it is in evidence, but I've been
4 told it isn't. It's DX3543. I would like to introduce it
5 in evidence.

6 THE COURT: I'm told it is in evidence.

7 MR. DUNNER: You are told it is?

8 THE COURT: Right.

9 MR. DUNNER: My initial instruction was correct.
10 I went through each of these, Your Honor, to try to do that
11 to assist the Court.

12 MR. HEALEY: I would just like to clarify that
13 he's asking about the standard of 1979, and the document
14 indicates that this is a revision from 1980.

15 MR. DUNNER: Well, Mr. Greenlee -- I'd like to
16 introduce it into evidence anyway, Your Honor.

17 THE COURT: I'm told it's already in evidence.

18 MR. DUNNER: Thank you, Your Honor.

19 Q. Dr. Greenlee, just so the record will be clear, this
20 version which is reproduced at page 500.14 in 2001, which
21 is the third page of the document, this was in force during
22 the time that you were handling the '740 prosecution,
23 correct? Do you see at the bottom where it says revision
24 April 1980?

25 A. Yes. What page are you talking about?

1 Q. It's the third page of the document, sir. Yes, third
2 page of the document, the first page of text after the
3 table of contents. Do you see it says revision April of
4 1980?

5 A. Yes, I see that. It's on all the pages.

6 Q. And that was in force very early in the prosecution of
7 the '740 patent application, correct?

8 A. That's correct.

9 Q. And you will agree with me, will you not, Dr. Greenlee,
10 that that rule governed your dealings with the patent and
11 trademark office during the prosecution of the '740
12 application?

13 A. Yes.

14 Q. And do you see it has a definition of materiality in it
15 toward the bottom of Rule 56, and it says, "Such
16 information is material where there is a substantial
17 likelihood that a reasonable examiner would consider it
18 important in deciding whether to allow the application to
19 issue as a patent"?

20 A. I'm not sure -- oh, yes. Yes, I see it. Yes.

21 Q. Do you agree with that?

22 A. Yes.

23 Q. And though you didn't --

24 A. You have read it correctly.

25 Q. Though you couldn't remember the exact words, is it

1 reasonable to say that you were aware of the thrust of this
2 requirement during the prosecution of the '740 patent
3 application?

4 A. Yes.

5 Q. And you knew that if you had a piece of art, that a
6 reasonable examiner would consider to use these words,
7 "important in deciding whether to allow the application"
8 you should have cited it to that examiner, correct?

9 A. Yes.

10 Q. And that is true whether the examiner was Mr.
11 Tanenholtz or any other examiner, correct?

12 A. Yes. Excuse me. My microphone fell off.

13 Q. Now, not only did you know the duty of disclosure, but
14 you discussed the duty of disclosure with the University of
15 California inventors; is that not right?

16 A. Yes, that is right.

17 Q. Including the inventors, one or more of them, involved
18 in the '740 case, correct?

19 A. Absolutely.

20 Q. And you discussed it with them, and you also yourself
21 knew that there was a special requirement discussed in the
22 manual about the prosecution of foreign counterparts of
23 U.S. cases, did you not?

24 A. Do you want to point me to that one?

25 Q. I will, but first I'd like to ask you a question: Did

1 you not know that when prior art was cited in a foreign
2 counterpart of a U.S. application, you had to pay special
3 attention to such prior art?

4 A. Again, if you want to read the rule, I'll --

5 Q. We'll get to that. It's in the manual. I just want to
6 know. If you can't answer it, then that's fine too. I
7 just want to know what you know of your own knowledge, then
8 we'll go to the rules or the manual.

9 A. Yes, I don't have a specific recollection of what the
10 rule said.

11 Q. I'm not suggesting it was a rule. I'm suggesting did
12 you not have an understanding during the prosecution of
13 this case that you were aware of a duty that you had to
14 cite references from foreign counterparts of U.S.
15 applications?

16 A. I was aware of a duty as it is set forth in the rule.

17 Q. In Rule 56?

18 A. In Rule 56, yes.

19 Q. I'm going beyond the specific language of the rule and
20 I'm asking you, didn't you know during the prosecution of
21 the '740 case that you were aware of the duty to cite
22 references to the U.S. Patent and Trademark Office of prior
23 art cited in foreign counterparts of that U.S. case?

24 A. I was aware generally that there was such a principle,
25 yes.

1 Q. In fact, you so said so in your deposition, didn't you?

2 A. I don't recall.

3 Q. Well, let's look at the manual now, 3543. This is the
4 manual extract that we looked at before. And I'd like you
5 to look specifically at 2001.06A, which is at page 500.17.

6 A. Yes.

7 Q. And just so the record will be clear, it's a short
8 section, it says, "Applicants and other individuals as set
9 forth in section 1.56 --" that's the Rule 56 we've been
10 talking about?

11 A. Yes, it is.

12 Q. "Have a duty to bring to the attention of the office
13 any material, prior art or other information cited or
14 brought to their attention in any related foreign
15 application. The inference that such prior art or other
16 information is material is especially strong where it is
17 the only prior art cited or where it has been used in
18 rejecting the claims in the foreign application."

19 Were you aware of that provision during the period that
20 the '740 application was being prosecuted?

21 A. Yes.

22 Q. Now, it is true, is it not, that you were particularly
23 interested during the period prior to the filing of the
24 '740 application in foreign applications, or whatever,
25 filed on behalf of Genentech, correct?

1 A. I don't recall specifically.

2 Q. Do you remember being interested specifically in
3 applications filed in the names of Itakura and Riggs and
4 Boyer?

5 A. No.

6 Q. You don't remember writing to foreign associates
7 saying, Please as soon as possible conduct searches on
8 applications related to those individuals that were filed
9 abroad?

10 A. No, I don't.

11 Q. And you don't remember getting copies of those
12 applications?

13 A. No, I don't.

14 Q. And you don't remember sending copies of those
15 applications to Mr. Ditzel?

16 A. No, I don't.

17 Q. And you don't remember being particularly interested in
18 what has come to be discussed in this case as EPA-1929?

19 A. No, I don't.

20 Q. You don't remember that at all?

21 A. I don't remember being particularly interested, no.

22 Q. Do you remember being interested in it at all?

23 A. I have a recollection of those documents that was
24 refreshed by Mr. Lipsey showing them to me in my
25 deposition. My memory of them is primarily as the

1 Riggs-Itakura expression patents. And that's about all I
2 remember about them.

3 Q. Why don't we look through some of the history and let's
4 see whether you can be refreshed. I'd like you to look at
5 DX3438. Now, 3438, I will warn you, is a difficult-to-read
6 document. It's a series of Telexes that were sent to
7 unidentified addressees, but each of which contains the
8 typed signature "Lorance Greenlee." I assume you are
9 Lorance Greenlee. You would be the Lorance Greenlee in
10 these Telexes, correct?

11 A. I don't think anybody else spells Lorance the way I do
12 except other members of my family, correct.

13 Q. Now, just so that we can read these, I suggest you look
14 at an enlarged copy of 22961. There are several versions
15 of that, but one of them is larger than the other. And if
16 you try to read the smaller one, you will not be terribly
17 successful, I suspect. It has what looks like a Bates
18 number as 22961. It also has another Bates No. 0503. Do
19 you see it?

20 A. Yes,

21 Q. I'd like to read it to you and get your confirmation
22 that I am reading it correctly. It does say at the bottom,
23 "Thank you, Lorance Greenlee, Irons and Sears." But going
24 to the top, it says after the salutation, "Please --" can
25 you read the second word?

1 A. No, I can't.

2 Q. That's the only word I cannot read. "Please," and then
3 it says something, "the following searches for published
4 patents/applications, in West Germany one filed in the name
5 of Genentech Corporation or City of Hope National Medical
6 Center with any of Keiichi Itakura, Arthur Riggs or Herbert
7 Boyer as inventors." And I'm not reading the two, but have
8 I read that correctly?

9 A. As near as I can make out, you have.

10 Q. Now, there's another document in this batch with the
11 number 22960 that is in larger type than some of the
12 others. And if you find it, it has 22960 and 0502 on it as
13 numbers. I would just like to ask you a question about it.

14 A. I believe I have it.

15 Q. Now, again, this is Lorance Greenlee, Irons and Sears,
16 at the bottom, correct?

17 A. Yes.

18 Q. And I submit to you that it is identical in wording to
19 the other one I just read, except instead of saying West
20 Germany it says Belgium and France. Do you agree? Do you
21 want to take a second to look at it?

22 A. There's a thing that's highlighted and underlined here.
23 Frankly, I can't read it.

24 Q. You can't read it?

25 A. I cannot.

1 Q. Incidentally, I've been told that the missing word, the
2 second word of this, is "begin." Does that look correct to
3 you?

4 A. I couldn't say.

5 Q. Well, in any event, you say you can't read this. Let's
6 go back to the 22961, the West Germany one.

7 THE COURT: Pardon me. Does anyone know where the
8 original of this is?

9 MR. DUNNER: I don't know, Your Honor. These are
10 the only copies we have gotten.

11 THE COURT: Well, I understand these are copies
12 and they're lousy copies, but there must be an original
13 someplace.

14 MR. DUNNER: These came from U.C., so perhaps they
15 can answer you.

16 MR. HEALEY: This is the best copies we have
17 available, sir.

18 THE COURT: I understand it's the best copy you
19 have available. My question is, where is the original?

20 MR. HEALEY: We don't have an original. U.C. only
21 had a copy.

22 Q. Is it fair to say, Dr. Greenlee, that this is a Telex
23 that you sent to a foreign associate to do a search for you
24 on the subject matter of these Telexes?

25 A. Yes. To the extent they're legible, that's what they

1 appear to be.

2 Q. And you'll agree that both of these came from you?

3 A. That's what they appear.

4 Q. I'd like you to look at 3710.

5 MR. DUNNER: Your Honor, before we go to 3710, I
6 would like to move the admission of DX3438 into evidence.

7 MR. HEALEY: No objection.

8 THE COURT: It will be received.

9 (Defendant's Exhibit(s) 3438 received in evidence.)

10 Q. 3710 consists of several letters, one of which is to
11 you, from a firm called Beil, B-E-I-L, and it's got several
12 other names, dated October 1978. That is directed to you,
13 correct?

14 A. Yes.

15 Q. And the next one is a letter from Cabinet,
16 C-A-B-I-N-E-T, Lavoix, L-A-V, as in Victor, O-I-X, dated
17 October 11, 1978; again it's to you, correct?

18 A. Yes.

19 Q. And the next one is another letter from Beil, the Beil
20 firm, dated October 10, 1978, also to you, correct?

21 A. Yes.

22 MR. DUNNER: I'd like to move these into evidence,
23 Your Honor, this exhibit, the exhibit number is DX3710.

24 MR. HEALEY: No objection.

25 THE COURT: It will be received.

1 (Defendant's Exhibit(s) 3710 received in evidence.)

2 Q. Now, let's just look at the first one, October 1978,
3 from the Beil firm to you. You notice it says it's in
4 response to your Telex of October 5, 1978; do you see that?

5 A. Yes.

6 Q. And it talks about West German -- searches for West
7 German patents?

8 A. Yes.

9 Q. And it also then has two categories, Genentech and City
10 of Hope, with Itakura, Riggs or Boyer as inventors; do you
11 see that under 1?

12 A. Yes.

13 Q. Now, actually in the earlier exhibit we did not go into
14 2, but I suggest if you do, you will see the same names
15 under Regents of the University of California. What I want
16 to ask you is can we agree, Dr. Greenlee, that this letter
17 is a response to the exhibit we have just identified,
18 namely DX3438, at least the one dealing with West Germany?

19 A. I have no recollection to confirm that or deny it.

20 Q. I'm not asking you to recall, but do you have any doubt
21 in your mind, even any remote reasonable doubt, that this
22 is a response to the Telex that we have just identified as
23 3438?

24 MR. HEALEY: Objection, Your Honor. He's already
25 said he doesn't recall.

1 MR. DUNNER: Your Honor, it seems clear beyond a
2 reasonable doubt that anybody who wants to be reasonable
3 could answer my question.

4 MR. HEALEY: He's already moved in this exhibit.
5 He can make his argument from the exhibit. The witness has
6 already said he doesn't recall. You get nothing further
7 from badgering the witness like this.

8 THE COURT: I'll sustain the objection; however, I
9 can draw my own conclusions, I presume.

10 MR. DUNNER: Thank you, Your Honor.

11 Q. And the second letter from Cabinet Lavoix also refers
12 to a Telex dated October 5 concerning French patents; do
13 you see that?

14 A. French and Belgium patents?

15 Q. French and Belgium patents, correct. Do you know
16 whether that document has any relation to the Telex that
17 dealt with France and Belgium in DX3438?

18 A. No, I don't.

19 Q. And the third one, which was the October 10th letter,
20 is merely acknowledgement of your Telex, so we'll pass that
21 one for now.

22 Let us look at 3447.

23 A. Okay.

24 Q. This is a document from Cabinet Lavoix to you dated
25 June 1, '79, correct?

1 A. Yes.

2 MR. DUNNER: I'd like to move this into evidence,
3 Your Honor.

4 MR. HEALEY: No objection.

5 THE COURT: It will be received.

6 (Defendant's Exhibit(s) 3447 received in evidence.)

7 Q. And in this letter you are advised that they have been
8 able to ascertain the publication of three European patent
9 applications, 1929, 1930 and 1931, published in the names
10 of Genentech, Itakura and Riggs as inventors. Do you
11 agree?

12 A. Yes.

13 Q. Is it fair to say, Dr. Greenlee, that you learned about
14 the existence of and the content of EPA-1929 at or about
15 this time or shortly thereafter?

16 A. As I say, I have no recollection of receiving these.

17 Q. Now, in this letter you are asked, "Should you wish to
18 obtain copies of said applications, please advise us
19 accordingly." Do you see that?

20 A. Yes.

21 Q. And in fact, not long after this you expressed an
22 interest in getting copies of these European patent
23 applications as soon as possible; isn't that right?

24 A. I don't recall.

25 Q. Well, let us look at 3449. This is a letter from you

1 to Cabinet Lavoix in response to the June 1st, 1979 letter
2 that we just looked at as 3447, correct?

3 A. Yes.

4 THE COURT: It's 3448, isn't it?

5 MR. DUNNER: I believe it was 3447, but you could
6 be right. 3447, Your Honor.

7 THE COURT: You said let us look at 3449.

8 MR. DUNNER: We're looking at 3449 now.

9 THE COURT: No, we're not, if you're talking about
10 a letter from --

11 MR. DUNNER: I think I can clear it up, Your
12 Honor. I may have confused you. We are now talking about
13 a letter which is 3449 which contains a reference to a
14 letter of June 1st which, in fact, is 3447. And I may have
15 confused you by referring to both of them at the same time.

16 THE COURT: Okay. 3449 is a letter of June 6,
17 1979?

18 MR. DUNNER: Correct, Your Honor.

19 THE COURT: Okay. Go ahead.

20 MR. DUNNER: Sorry for the confusion.

21 I'd like to introduce into evidence 3449, please.

22 MR. HEALEY: No objection.

23 THE COURT: It will be received.

24 (Defendant's Exhibit(s) 3449 received in evidence.)

25 Q. Now, just so we can get back to where we were, this

1 June 6, 1979 letter, which is 3449, was actually a response
2 to the June 1st letter which was 3447, correct?

3 A. It is a response to a letter of June 1st. I don't have
4 any recollection that it was the letter of 3447.

5 Q. I will not belabor the point, but I would like to ask
6 you one more question on it: Is there any doubt in your
7 mind as to whether there is a relationship between 3450 and
8 3447?

9 MR. HEALEY: Objection. He is belaboring the
10 point. The witness has already said he doesn't recall.

11 THE COURT: The question is does he have any doubt
12 in his mind. And I'll overrule the objection.

13 A. No.

14 Q. And in this letter, which is the 3449 letter, you say,
15 "As soon as possible please forward copies of European
16 patent applications." And you include in there 1929,
17 correct?

18 A. That's correct.

19 Q. So you were anxious at this time, June 6, 1979, to get
20 those applications, correct?

21 A. Again, the characterization "anxious," I don't know. I
22 don't recall.

23 Q. Isn't it true, Dr. Greenlee -- I'm sorry.

24 A. I apparently asked for them in this letter, but I don't
25 recall.

1 Q. When you ask for somebody to send you something as soon
2 as possible, don't you do that when you're anxious to get
3 what you're asking for? Isn't that your normal practice?

4 A. Not necessarily.

5 Q. So you may have asked them as soon as possible and been
6 indifferent as to when they responded to you; is that what
7 you're telling us?

8 A. It may have been as a matter of course.

9 THE COURT: I don't see any need to characterize
10 his state of mind which he can't recall as being anxious.
11 What difference does it make?

12 MR. DUNNER: All right, Your Honor. I'll proceed.

13 Q. Now, let's look at 3450. 3450 is another letter from
14 Lorance L. Greenlee to Cabinet Lavoix dated June 26, 1979.
15 Is that letter from you?

16 A. It appears to be. It's my signature.

17 MR. DUNNER: Your Honor, I'd like to introduce
18 this into evidence.

19 MR. HEALEY: No objection.

20 THE COURT: It will be received.

21 (Defendant's Exhibit(s) 3450 received in evidence.)

22 Q. Isn't it true that at or about June 26, 1979 you not
23 only asked for copies of the U.S. documents corresponding
24 to 1929 but, in fact, received them shortly thereafter?

25 A. I don't recall when we received them.

1 Q. Do you see next to 1929 there is a serial number
2 849692?

3 A. Yes.

4 Q. Do you agree that is the U.S. patent application in the
5 name of Itakura and Riggs that ultimately issued as the
6 '362 patent?

7 A. I don't know.

8 Q. Now, isn't it true that you do recall, without regard
9 to this specific letter, you do recall that you became
10 aware of European published applications from foreign
11 associates in this case?

12 A. In which case?

13 Q. Well, at or about the time we're talking about, 1979.

14 A. No, I don't.

15 Q. Isn't it true that you were aware of the text of
16 EPA-1929 in the 1979 time period?

17 A. I can't remember when I became aware of it. I do have
18 a recollection of it, but I have no recollection of when I
19 became aware of it.

20 Q. You became aware of it in 1979. Let us look at your
21 deposition. You have copies of your depositions there?

22 A. Yes.

23 Q. I'd like you first to look at the July 13, 1991
24 transcript at page 190.

25 A. Which date?

1 Q. July 13, 1991, page 190.

2 A. Now, what was the page again?

3 Q. 190.

4 A. Okay.

5 Q. Now, do you see it says on line 16, I'd just like to
6 ask you whether you gave this answer to this question:

7 "Were you aware at the time you were evaluating this
8 application, of the text of these application to which I
9 have referred --"

10 MR. HEALEY: Can I object here and say lack of
11 foundation. It's not clear at all starting on line 16 what
12 these applications refer to.

13 MR. DUNNER: Well, that is true, Your Honor. I'll
14 have to ask another question. But first I want to
15 establish what he said. We'll go back. If he doesn't
16 remember, we'll go back.

17 Q. "Were you aware at the time you were evaluating these
18 applications of the text of these applications to which I
19 have referred?

20 "Answer: I believe so, yes.

21 "You were speaking of at the time that the December 7th
22 letter, Exhibit 231, was written?

23 "Answer: Yes."

24 First of all, do you recall giving those answers to
25 those questions?

1 A. No, I don't.

2 Q. But those are the answers that you gave, correct?

3 A. Yes, I believe so.

4 Q. Do you remember what applications you're talking about
5 here?

6 A. No.

7 Q. I'd like you to look back up at 186 of that same
8 transcript. And do you see starting at line 10 there is a
9 discussion of EPA-1929? Do you see that, going down to
10 line 16?

11 A. Yes.

12 Q. And if you read -- if you go down to page 188, he's
13 talking again about the European patent application
14 published on May 16, 1979; he's still talking about
15 EPA-1929, is he not?

16 A. I think when he refers to Exhibit 268, he's referring
17 to EPA-1929.

18 Q. And as you read this, is it not clear that when you
19 said you knew of the text of the applications, you were
20 referring to, among others, EPA-1929; is that correct?

21 A. On which page?

22 Q. Then if you want, I can read the text. Starting at
23 188 -- why don't I do it. Starting at 188, line 10, it
24 says, "Okay. Now, you said you recalled seeing this
25 European patent application, which we have marked as

1 Exhibit 268." And you just said, "That is 1929." Correct?

2 A. Yes.

3 Q. "Can you describe the circumstances under which you
4 came to see it?

5 "Answer: No, I can't recall.

6 "Question: This European patent application was
7 published on May 16, 1979, according to the face of the
8 document; is that right?

9 "Answer: My copy is a bit obscure, but I believe
10 that's correct.

11 "Question: And that was before the filing date of the
12 Bell application in September of 1979, right?

13 "Answer: When was the Bell patent filed?

14 "Question: That's Defendant's Exhibit 16, right?"

15 Then you go on: "Question: Now, on Exhibit 268, would
16 you turn to the page bearing Bates number," and then
17 there's a Bates number. And it goes on to describe the
18 content of the plasmids, which we may come back to later.

19 And then it follows: "Were you aware at the time you
20 were evaluating these applications of the text of these
21 applications to which I have referred?" And there you say,
22 "I believe so. You are speaking of at the time the
23 December 7th letter, Exhibit 231, was written."

24 Now, do you have any doubt that what they're talking
25 about there is EPA-1929?

1 A. I believe that's what he's talking about, yes.

2 Q. When they're talking about December 7th, they're
3 talking about December 7th, 1979, correct?

4 A. I don't know.

5 Q. All right. You're making me work for my money.

6 A. I just don't remember what it was.

7 Q. Let's look at 179, line 13. Do you have that page?

8 A. I'm getting there. Okay.

9 Q. Do you see where it says, "Will you take a look at
10 Defendant's Deposition Exhibit 231, please? For starters,
11 I would like you to confirm that Exhibit 231 is, in fact,
12 an opinion letter written by you on or about December 7,
13 1979." Do you see that?

14 A. Yes.

15 Q. So can we now agree that you knew of the text of
16 EPA-1929 at least by December 1979?

17 A. Yes.

18 Q. Now, you then sent at some point in time, even before
19 December of 1979, you sent a copy of that to Mr. Ditzel,
20 correct?

21 A. I don't recall exactly when I sent it to Mr. Ditzel.

22 Q. Let's look at 3452. Now, 3452 is a document to which
23 U.C. counsel referred in his direct examination of you, so
24 I won't spend much time on it, it's a letter dated June 29,
25 1979 to Mr. Roger Ditzel from Lorance L. Greenlee, correct?

1 A. Yes.

2 Q. And you are the Lorance L. Greenlee of that letter,
3 correct?

4 A. Yes.

5 MR. DUNNER: I'd like to have this moved into
6 evidence, Your Honor.

7 MR. HEALEY: No objection.

8 THE COURT: It will be received.

9 (Defendant's Exhibit(s) 3452 received in evidence.)

10 Q. Now, in this letter it states that you're sending him
11 three published European applications based on U.C. filings
12 from Genentech, and note the date is June 29, not very long
13 after -- in fact, days after -- the correspondence you've
14 had from Cabinet Lavoix. And just so you will know, 3450,
15 "Thanks, Cabinet Lavoix," on June 26, three days before
16 3452, for sending them copies of European patent
17 applications.

18 Do you agree that, in fact, on or about this date, June
19 29, 1979, you sent copies of the European applications,
20 including EPA-1929, to Mr. Ditzel?

21 A. Again, I don't recall.

22 Q. I'd like to ask you the same question I asked you
23 before: Do you have any reasonable doubt that, in fact,
24 you did that?

25 A. I was having a lot of correspondence with Mr. Ditzel.

1 I was sending him lots of documents. So I just don't know
2 what these referred to or not.

3 Q. Mr. Ditzel was your principal contact at the University
4 of California, correct?

5 A. As to administrative matters related to the patent
6 prosecution, that's correct.

7 Q. So as to matters relating to the '740 prosecution, he
8 was your principal contact, correct?

9 A. Depends on what aspect of the prosecution you're
10 talking about. If it was technical issues, I would be
11 talking to the inventors. If it was administrative
12 matters, I would be talking to Mr. Ditzel. And I would be
13 corresponding and sending him copies of correspondence to
14 and from the patent office.

15 Q. And you kept him informed, did you not?

16 A. That's correct.

17 Q. So other than the inventors, he was your principal
18 contact with the University of California in connection
19 with the '740 application?

20 A. Other than the inventors, that's correct.

21 Q. Now, I note you say here you've requested copies of the
22 basic priority documents U.S. applications, but they are
23 not yet received. Shortly or sometime after this did you
24 receive those U.S. priority documents?

25 A. I don't remember.

1 Q. Let us look at 3458. And 3458 is a letter from Cabinet
2 Lavoix to you dated July 23, 1979. Are you the Lorance
3 Greenlee mentioned in this letter?

4 A. Yes.

5 MR. DUNNER: I'd like to move this in evidence,
6 Your Honor.

7 MR. HEALEY: No objection.

8 THE COURT: It will be received.

9 (Defendant's Exhibit(s) 3458 received in evidence.)

10 Q. And here he says at the beginning, "In response to your
11 letter, copies of U.S. patent applications corresponding to
12 the EPA applications, including 1929, are being sent
13 separately to you."

14 Do you have any doubt, given this letter, that not long
15 after this letter you received, in fact, the U.S.
16 counterparts of the EPA applications, including 1929?

17 A. I think that's a reasonable assumption, yes.

18 Q. Then let us go -- before we get there, is it not true,
19 Dr. Greenlee, that in this general timeframe, you were
20 carefully studying the Genentech applications on behalf of
21 U.C.? And when I say the "Genentech applications," I'm
22 talking about EPA-1929 and its U.S. counterpart, as well as
23 EPA-1930 and 1931 and their counterparts.

24 A. Was I carefully studying them at that time; is that
25 your question? I'm sorry.

1 Q. Yes. Were you actually reviewing those applications on
2 behalf of Genentech basically to see what it is that you
3 might do with them in the way of, perhaps, dealing with
4 overlap between those cases and your own? If I said on
5 behalf of Genentech, I meant U.C. I may have misspoke.
6 Let me restate that. I don't want to confuse you.

7 Were you at or about this time evaluating the Genentech
8 Itakura and Riggs applications, the ones we have been
9 talking about, for purposes of advising the University of
10 California as to what to do in connection with possible
11 overlap between the Genentech applications on the one hand
12 and the U.C. cases on the other hand?

13 A. I don't have a specific recollection of what we were
14 doing with them.

15 Q. Well, let us look at 3453. This is a document dated
16 July 3, 1979 to LLG from ESI. Do you see that?

17 A. Yes.

18 Q. Are you the LLG in that memo?

19 A. I believe so.

20 Q. And is the ESI Edward S. Irons?

21 A. I believe so.

22 MR. DUNNER: I'd like to move this into evidence,
23 Your Honor.

24 MR. HEALEY: No objection.

25 THE COURT: It will be received.

1 (Defendant's Exhibit(s) 3453 received in evidence.)

2 Q. Now, I notice it refers in the beginning to, "We are
3 now in possession of three Genentech patent applications,
4 each filed in the United States on August 11, 1977." Do
5 you see that?

6 A. Yes.

7 Q. Now, I would just like you to look back for a moment at
8 3047.

9 A. Okay.

10 Q. 3047 is the EPA-1929, correct?

11 A. Yes.

12 Q. Now, do you agree that, in fact, the applications
13 referred to in 3453 include one or more U.S. applications
14 corresponding to EPA-1929? And I will note just for your
15 edification the fact that the date referred to in 3453 is
16 August 11, 1977; and the date, the priority date, on
17 EPA-1929 is 8-11-77. And I draw that to your attention
18 merely because the common European custom, as we've heard,
19 is to invert the day and the month. And I don't want to
20 mislead you, and that's why I'm telling you that.

21 My question is do you agree that the applications
22 referred to in 3453 are, in fact, the U.S. counterparts of
23 EPA-1929 and related applications that we've talked about?

24 A. My copy of the 1929 doesn't have a legible date.

25 Q. It doesn't have a what?

1 A. A legible date.

2 Q. Is that correct?

3 A. On the priority -- I can't read it.

4 Q. It's in the box next to number -- under the line on the
5 left-hand side of the page. You cannot read that?

6 A. Not on my copy, Mr. Dunner.

7 MR. DUNNER: Your Honor, may I just approach the
8 witness?

9 THE COURT: Yes, you may.

10 (Discussion off record.)

11 Q. All right. Dr. Greenlee, what is your response? I
12 guess the question is, just so we'll have a fresh question
13 on the record, the question is do you have any reasonable
14 doubt that the Genentech patent applications referred to on
15 3453 are, in fact, the corresponding U.S. applications that
16 we've been talking about relating to EPA-1929 and related
17 applications?

18 A. I think that's a reasonable assumption.

19 Q. Now, in this document 3453, the second paragraph talks
20 about a significant overlap between the subject matter
21 disclosed and claimed in these Genentech patent
22 applications, and one or more of the applications which
23 this office has filed on behalf the Regents of the
24 University of California. Do you see that?

25 A. Yes.

1 Q. And do you see further at the very last page of this
2 document, it says, "One completely unsatisfactory scenario
3 would contemplate the issuance by the patent office of
4 Genentech's applications followed by a rejection of the
5 University of California's applications on the Genentech's
6 patents as prior art." What did you mean by that?

7 A. I didn't write this.

8 Q. Did you discuss this letter with Mr. Irons?

9 A. I don't recall a specific way. I don't recall
10 discussing the text of this letter. No, I don't think I
11 discussed it with him.

12 Q. Do you remember what your understanding of that
13 paragraph I just read was?

14 A. Only in a general way that it related to a University
15 of California application that had been filed on
16 expression.

17 Q. Can we agree from this document and from the other
18 documents thus far that you were very interested at this
19 time period -- this takes us at any length through July of
20 1979 -- in the patent activities of Genentech, and
21 particularly of Itakura and Riggs; that, in fact, you had
22 gotten copies of one or more applications including
23 EPA-1929; that you had a copy and was aware of the text of
24 it at least by December, 1979? Can you agree with all of
25 that?

1 MR. HEALEY: Objection, lack of foundation. He's
2 testified repeatedly that he doesn't recall what he knew
3 and when he knew it.

4 THE COURT: I'll overrule the objection.

5 A. Will you read back the question, please.

6 (The requested material was read back by the reporter.)

7 A. No.

8 Q. Why not?

9 A. The only recollection that I have with respect to these
10 is, as I stated before, that I remember these applications
11 of Genentech as related to expression.

12 Q. You didn't know that they dealt with human proinsulin?

13 A. I don't recall that, no.

14 Q. You, in fact, were advised that they dealt with human
15 proinsulin, were you not?

16 A. I don't recall that.

17 Q. Do you recall that you were advised not only that it
18 dealt with human proinsulin, but that one or more foreign
19 patent offices felt the disclosure of the Itakura and Riggs
20 patent application EPA-1929 was particularly relevant to
21 the foreign counterpart of '740?

22 A. I don't recall that.

23 Q. Well, let us look at the record. Let us look at 3064.
24 This is a letter to you from a foreign associate of yours,
25 correct?

1 THE COURT: I don't believe -- 3064, is that what
2 we're talking about?

3 MR. DUNNER: Yes, Your Honor. Dated January 21,
4 1981.

5 THE WITNESS: Yes.

6 MR. DUNNER: I'd like to move this in evidence,
7 Your Honor.

8 MR. HEALEY: No objection.

9 THE COURT: It will be received.

10 (Defendant's Exhibit(s) 3064 received in evidence.)

11 Q. And in this letter you are being sent a copy of the
12 search report issued by the European Patent Office in an
13 application called UC-8, correct?

14 A. That's correct.

15 Q. And you will agree with me, will you not, Dr. Greenlee,
16 that UC-8 is indeed the reference that has been used for
17 the '740 patent applications in this case?

18 A. That's correct.

19 Q. And so this letter dealt with a search report in the
20 European patent application which had been filed as the
21 counterpart to the '740 patent application, correct?

22 A. That appears to be correct, yes.

23 Q. Now, you will note that the second paragraph of the
24 letter expressly says, "A copy of each citation except the
25 first is also enclosed. The list of citations has a

1 category column to its left. The most relevant category is
2 X; do you see that?

3 A. Yes.

4 Q. And you were aware, were you not, that in foreign
5 countries, or at least in the European Patent Office, when
6 you got search reports they helped you by telling you what
7 they thought was the most relevant and which applications
8 they might be citing might not be as relevant; isn't that
9 right?

10 A. They categorized them in various categories, yes.

11 Q. And one of them was the most relevant category,
12 correct?

13 A. Yes.

14 Q. That was the highest category of relevancy that they
15 had, correct, most relevant?

16 A. Most relevant, that's what it's called.

17 Q. Now, let us now go on to DX3091. This document is in
18 evidence. This document is the search report that we've
19 just been talking about, is it not?

20 A. I'm sorry. How would I identify it?

21 Q. Well, I think you can identify it by looking at the
22 European application itself filed by U.C.

23 A. Filed by U.C.?

24 Q. Yes. Just hold it a second. I'll help you.

25 A. Okay.

1 Q. If you look at the RE of 3064, you will see a number
2 80303195, do you see that, .4?

3 A. Oh, yes.

4 Q. And if you look at 3091 in the upper right-hand corner,
5 you will see EP and then you will see a series of numbers,
6 80303195, and there may be something after that. But do
7 you see that number?

8 A. Yes.

9 Q. Do you agree that is a search report in connection with
10 U.C.'s European application?

11 A. Yes.

12 Q. Corresponding to the '740 patent?

13 A. Yes.

14 Q. And you will agree further that this search report is
15 the one referred to in 3064, correct?

16 A. I think that's a safe assumption. It only mentions the
17 first reference cited. It doesn't reference any others.

18 Q. Pardon?

19 A. The letter in 3064 only mentions specifically one
20 reference which is DE2822568.

21 Q. And that's the very first one mentioned in the search
22 report?

23 A. That's the very first one. It doesn't mention any
24 others.

25 Q. And in fact, in the letter of 3064 it says that that

1 is, in fact, the first citation, correct?

2 A. Yes.

3 Q. So can we agree this is, in fact, the search report
4 that you received with that letter, correct?

5 A. Yes.

6 Q. Now, the letter 3064 is dated January 21, 1981,
7 correct?

8 A. Yes.

9 Q. And by that time -- whatever this letter said to you,
10 by that time you long since had received a copy of 1929 and
11 were familiar with its text. We talked about that before,
12 right? I read to you from your deposition.

13 A. Again, I don't recall receiving it.

14 Q. But you said that at your deposition, didn't you?

15 A. Excuse me?

16 Q. You said at your deposition you were aware of the text
17 of 1929 --

18 A. Oh, yes.

19 Q. -- in December of 1979?

20 A. Yes.

21 Q. Now, you were asked on direct whether certain
22 correspondence that you had with Roger Ditzel and with
23 Cabinet Lavoix, and in particular, 3452 and 3450 and 3449,
24 you were asked whether those dates were before you filed
25 the '740 patent application, and you said yes. But in

1 fact, whatever inference one would draw from those
2 questions and those answers, in fact, you knew about
3 EPA-1929 and you knew about its text before you received
4 this first search report, correct?

5 A. I believe that's correct, yes.

6 Q. Now, looking at 3091, the second entry shows EPA-1929,
7 correct?

8 A. Yes.

9 Q. And more significantly, it shows that it's got category
10 X, correct?

11 A. Yes.

12 Q. And if you look at the lower right-hand corner, it says
13 particularly relevant, correct?

14 A. Yes.

15 Q. And in fact, aside from the very first entry which they
16 didn't send you, that is more relevant than every other
17 category mentioned in this letter, correct?

18 A. I think that's generally correct, yes.

19 Q. Now, in fact, it is more relevant than a number of
20 applications that were cited during the prosecution of the
21 '740 patent application; is that not correct?

22 A. As stated here in this document, you mean?

23 Q. Yes, as stated here in this document.

24 A. Yes.

25 Q. I didn't mean to -- it's not a trick question. As

1 stated in this document.

2 A. Yes.

3 Q. And that includes at the very bottom of the first page
4 of 3091 the Science article by Ullrich. That was one of
5 the documents involved in the prosecution of the '740
6 patent application, correct?

7 A. I don't recall if it was.

8 Q. Well, I'd like to make sure that you do; and therefore,
9 let us look. 3029, if you look at 3029, do you have that?

10 A. Yes.

11 Q. If you look at page 141.

12 A. Okay.

13 Q. I've been told that what we're looking at now is 3029K,
14 which is a portion of the prosecution history which
15 otherwise has been identified by different numbers.

16 MR. DUNNER: I'd like to introduce this exhibit
17 into evidence, Your Honor, 3029K.

18 MR. HEALEY: Your Honor, the whole document is
19 already admitted into evidence as PX3.

20 MR. DUNNER: Your Honor, I believe that is true.
21 The only reason we've done this is I believe this relates
22 to the period of time when Dr. Greenlee was associated with
23 this case, so it's particularly useful to have a smaller
24 document in evidence.

25 MR. HEALEY: I have objection. I just wanted to

1 clarify that.

2 THE COURT: Are you offering the entire 3029K or
3 just the part beginning at page 84?

4 MR. DUNNER: The entire document, Your Honor.

5 THE COURT: That exhibit will be received again.

6 (Defendant's Exhibit(s) 3029K received in evidence.)

7 Q. Now, If you look at 141, you will see an office action
8 from the examiner dated March 31, '81?

9 A. Yes.

10 Q. And you will see further if we go to page 142, there is
11 a rejection of the claims 1 to 11, and he mentions Crea, et
12 al. --

13 A. Yes.

14 Q. -- Cohen, et al.; do you see that?

15 A. I see where you're talking, yes, third paragraph.

16 Q. And he mentions Ullrich, et al. and Villa-Komaroff,
17 correct?

18 A. Correct.

19 Q. And just so you know, the Ullrich, et al., if we look
20 at page 145, we see two Ullrich, et als.; one is Ullrich
21 Proceedings and one is Ullrich Science. Do you see that?

22 A. Yes.

23 Q. And do you agree that the Science citation in 3091,
24 which is the European Patent Office search report, is, in
25 fact, the Ullrich Science mentioned in the examiner's

1 office action?

2 A. Well, I don't think that's clear.

3 Q. Well, look at the page numbers, 1313 to 1319, Volume
4 196.

5 A. Well, what the European examiner cited is clear. It's
6 the Ullrich Science article.

7 Q. Yes.

8 A. But you're asking me to compare it with what the U.S.
9 examiner cited, and I'm not sure which Ullrich, et al. that
10 is.

11 Q. Isn't it true that the examiner in the United States
12 cited both Ullrichs?

13 A. I can't tell. I mean, I don't recall.

14 Q. You can't tell?

15 A. I can't supplement what's here from my recollection.

16 Q. You don't need to. I'll show you how.

17 A. I can't answer the question.

18 Q. Look at the third paragraph on page 142. Do you see
19 where the ninth line, it says Ullrich, et al. (both the
20 Symposium and the Science article)?

21 A. Yes, I see that.

22 Q. So the examiner is citing both, correct?

23 A. Yes.

24 Q. And in fact, the Science article is the very Science
25 article cited in the European search report, correct?

1 A. Yes.

2 Q. I missed that. Did you say yes?

3 A. I said yes.

4 Q. And the designation he puts next to that, DA, is
5 document -- D is document cited in the application, and A
6 is technological background, correct?

7 A. Yes.

8 Q. Both of those are less relevant, at least in the eyes
9 of this examiner, than EPA-1929, agreed?

10 A. Yes.

11 Q. All right. Let us look on the next page of the
12 European search report. And we see Villa-Komaroff, do you
13 see that, the last citation?

14 A. Yes.

15 Q. Do you agree that's the Villa-Komaroff cited by the
16 examiner?

17 A. Yes.

18 Q. And that too has a DA indication category, which is
19 less relevant than the EPA-1929 X category, correct?

20 A. That's correct.

21 Q. Now, you'll notice that, in fact, the examiner cites
22 Claims 1, 2 and 6 of 1929 on the first page of his search
23 report in support of his rejection.

24 A. Yes.

25 Q. And what he's doing there, do you agree, is he's citing

1 the portions of that reference on which he is relying for
2 his conclusions on the search report, correct?

3 A. Yes.

4 Q. I'd like you to look briefly at 3047. 3047 is 1929.
5 I'd like you to look in particular in that case at the page
6 immediately following page 41.

7 A. Yes.

8 Q. And if you look at that page and you see Claim 6, Claim
9 6 specifically mentions, among others, human proinsulin,
10 correct?

11 A. Correct.

12 Q. And do you see the examiner also talks in that same
13 office action in 3091 -- the same search report rather, he
14 mentions claims of your application 1, 2, 4, 5, 7 and 8.

15 A. Yes. Is that a question?

16 Q. Well, I just wanted you to acknowledge that.

17 A. Yes.

18 Q. Are you aware that Claim 2 in that application was a
19 very broad claim?

20 A. I don't remember the claims.

21 Q. Let us look at 3087, which I believe is in a separate
22 volume.

23 THE COURT: I think it's in the volume we've just
24 been looking at.

25 MR. DUNNER: No, it's in a separate stand-alone

1 volume, Your Honor. It was too voluminous. It's listed as
2 Conlin Volume 4, I've been told.

3 Q. Do you see there's a page, the application shows --
4 well, first shall we establish -- do you agree that 3087 is
5 the European counterpart of '740?

6 A. Yes, it appears to be.

7 Q. Would you look at -- I do not see the number, but it
8 looks like 34086 in the lower right-hand corner. It's
9 about midway into this document, which is 3087. And you'll
10 see a page 28. It's at the end of the application, and it
11 has a Claim 2.

12 A. Okay. I've got it.

13 Q. Now, that Claim 2, which defines a DNA transfer vector
14 comprising a deoxynucleotide sequence coding for human
15 proinsulin, that claim includes every DNA sequence that one
16 can write down using the genetic code which codes for human
17 proinsulin, does it not?

18 A. Are you asking me to interpret the claim?

19 Q. Didn't you draft that claim?

20 A. Yes, I believe I did.

21 Q. I'm asking you to tell me whether you agree that it
22 covers what I just said.

23 A. Would you restate the question?

24 Q. Yes.

25 MR. DUNNER: Would you please reread it.

1 (The requested material was read back by the reporter.)

2 A. I believe it does.

3 Q. And in that sense it covers the same number of DNA
4 sequences covered by Claim 5 of the issued '740 patent,
5 does it not, shown on Exhibit 7 -- the exhibit that's in
6 your book as 3000, corresponds to PX1.

7 A. In which claim?

8 Q. 5.

9 A. I believe they're essentially the same scope.

10 Q. Now, you mentioned before that when I asked you a
11 rather long question about what you knew by the end of
12 1979, you said -- the answer to my question was no and I
13 asked you to explain it. You said, well, what you knew
14 about the European patent application 1929 had something to
15 do with expression; is that a fair characterization? Is
16 that correct?

17 A. Yes.

18 Q. Now, in fact, your '740 patent application and the
19 patent as it issued also dealt with expression, didn't it?

20 A. Yes. Expression was not the focus of it.

21 Q. But it dealt with expression?

22 A. Expression was included within it, yes.

23 Q. In fact, it expressly discloses expression?

24 A. It discloses expression.

25 Q. Thank you. Now, having received -- having expressed

1 your interest in these European patent applications, having
2 received a copy of them by at least December 1979, having
3 looked at the text at least by that date, having received
4 U.S. counterparts of those applications, and having
5 received a search report which indicates that that
6 application was particularly relevant to a disclosure, to a
7 claim corresponding to in terms of the number of DNA
8 sequences Claim 5 of the issued patent, you nevertheless
9 did not cite EPA-1929 ever, ever, to the U.S. Patent
10 Office, did you?

11 A. I believe that.

12 Q. And in fact, as we sit here today, you don't have a
13 single excuse for not having done that, do you?

14 A. Well, I don't recall why I didn't do it.

15 Q. So the answer to my question is you don't have a single
16 excuse for why you didn't do it, correct?

17 A. Not that I recall.

18 Q. And moreover, you knew in at least by 1979 or 1980 that
19 published patent applications of others prior to the filing
20 date of the U.S. application was available as evidence of
21 prior art, correct?

22 A. Yes.

23 Q. Now, you also knew that at some point following the
24 office action -- the search report, in fact, the European
25 Patent Office rejected claims, including that Claim 2 that

1 we talked about, of the European counterpart to '740,
2 correct?

3 A. I have no recollection of that.

4 Q. Well, let us look at the record. Let us look at 3065.
5 3065 is a letter to you from your foreign associate dated
6 August 2, 1982. Is the Lorange Greenlee mentioned there
7 you?

8 A. Yes.

9 MR. DUNNER: I'd like to move this into evidence,
10 Your Honor.

11 MR. HEALEY: No objection.

12 THE COURT: 3065 will be received.

13 (Defendant's Exhibit(s) 3065 received in evidence.)

14 Q. And do you agree that in this letter of August 2, 1982
15 your foreign associate actually transmitted to you a copy
16 of a letter from the European Patent Office in connection
17 with the European counterpart of '740 that we've been
18 talking about?

19 A. He enclosed a copy of the official letter.

20 Q. So the answer to my question is yes?

21 A. Yes.

22 Q. And he also is sending you copies of the rules of the
23 European Patent Office that apply to examination before the
24 European Patent Office, correct?

25 A. Copies of the articles and rules.

1 Q. And that is something that this foreign associate and
2 others do in order to assist their U.S. correspondents in
3 evaluating what is said in them, correct? Isn't that why
4 they do it?

5 A. Sometimes they do and sometimes they don't.

6 Q. But when they do it, that's the purpose is assist you
7 in evaluating what they've done?

8 A. Presumably.

9 Q. Now, let us look at the attachment to that, and you
10 will see on the third page a copy of the office action. In
11 paragraph 1 it says, "The wish to have available DNA
12 transfer vectors comprising a DNA coding for human
13 proinsulin and human proinsulin is known from," and then
14 they mention EPA-1929, Claim 6. Claim 6 was the one
15 dealing with proinsulin, human proinsulin among others,
16 correct? Is that what he showed you before?

17 A. Yes.

18 Q. And then he goes on to say, "Therefore, Claims 1 and
19 2," and Claim 2 was that claim we just evaluated which
20 corresponds, at least in scope of DNA inserts, to Claim 5
21 of the '740 patent, correct?

22 A. Yes.

23 Q. And he's taking that and he is saying, "Claims 1 and 2
24 which represent only problem claims are not patentable
25 under articles 54-1 and 2, correct?"

1 A. That's what it says.

2 Q. Now, attached to that are a series of excerpts from the
3 rules governing examinations before the European patent
4 office. And if you look four pages beyond that, you'll see
5 article 54 novelty. And I'll assist you by telling if you
6 go to 3065A, for the convenience of our witness and the
7 Court and opposing counsel, not to mention me, we have
8 enlarged that particular document. Do you see that?

9 A. Yes.

10 Q. And that is article 54 novelty, correct?

11 A. Yes.

12 Q. And novelty means -- is the U.S. equivalent of
13 anticipation, correct?

14 A. I don't believe so, no.

15 Q. How do you characterize novelty?

16 A. I understand it to have a different interpretation of
17 European law.

18 Q. What is the interpretation of European law concerning
19 novelty?

20 A. Well, I don't really purport to be an expert on
21 European law.

22 Q. Well, what is it, whatever --

23 A. But I believe there is a difference.

24 Q. Tell me as best you know what the difference is.

25 A. I believe that under European law a document can be

1 cited for novelty even though it does not contain the
2 entire invention within the four corners of the document.

3 Q Are you sure of that?

4 A No.

5 Q Let me ask you a second question: You will agree with
6 me, will you not, Dr. Greenlee, that your duty to disclose
7 a reference described in a foreign counterpart, a reference
8 used to reject a foreign counterpart of a U.S. application,
9 is not modified, however you define the word "novelty"; do
10 you agree with that?

11 A I think that may have some effect on the materiality of
12 a document.

13 Q Do you agree that when a reference is cited as
14 particularly relevant to and used to reject an application,
15 foreign counterpart, that the duty of disclosure imposed by
16 Rule 56 is not eliminated, is not satisfied, even if the
17 examiner overseas had said it's an obviousness rejection
18 rather than a novelty rejection; you still have a duty of
19 disclosure if that reference is otherwise relevant to your
20 U.S. case or material, to use the word; don't you agree?

21 A We have a duty of disclosure, but it's not a per se
22 rule that you have to submit everything the European cites
23 as an X reference.

24 Q I'm not suggesting that, but what I am suggesting is
25 that the duty of disclosure does not only apply to

1 anticipatory references, does it?

2 A I don't believe so, no.

3 Q It also applies even when patentability is not knocked
4 out, what we call a but-for test? The duty of disclosure
5 even applies to references that don't meet that but-for
6 test?

7 A I agree.

8 Q In fact, that has been the law since you started to
9 practice, correct?

10 A I believe so.

11 Q And you're not standing here telling the Court that you
12 didn't cite EPA-1929 to the U.S. Patent Office because of
13 your interpretation, whatever it was, of the word "novelty"
14 in this search report?

15 A No, I'm not. I don't recall the circumstances why I
16 didn't cite it.

17 Q Dr. Greenlee, in fact, there came a time when you had
18 in front of you at the very same time the European search
19 report that we've just been looking at and what we call an
20 office action, a response from the patent office, in the
21 U.S. '740 application; isn't that correct? You had them
22 both before you at the very same time.

23 A I don't know. I don't recall.

24 Q Let's look at the record. Let's look at 3076.

25 MR. DUNNER: Your Honor, I have not -- I am

1 advised to introduce 3087 into evidence. I would like to.

2 MR. HEALEY: No objection.

3 THE COURT: All right. It will be received.

4 (Defendant's Exhibit(s) 3087 received in evidence.)

5 THE COURT: How about 3065A?

6 MR. DUNNER: Your Honor, I appreciate that. I
7 would like to introduce that into evidence.

8 MR. HEALEY: No objection.

9 THE COURT: It will be received.

10 (Defendant's Exhibit(s) 3065A received in evidence.)

11 Q Let us look at 3076. That is a letter dated October
12 21, 1981 from Lorance L. Greenlee to a Finland firm. Is
13 that your signature and name?

14 A Yes, I believe so.

15 MR. DUNNER: I'd like to introduce this into
16 evidence, Your Honor.

17 MR. HEALEY: No objection.

18 THE COURT: It will be received.

19 (Defendant's Exhibit(s) 3076 received in evidence.)

20 Q Now, this letter in its first paragraph refers to the
21 fact that you're transmitting to this Finnish associate a
22 copy of the only office action received in one of the
23 applications leading to the '740 patent, correct?

24 A Yes.

25 Q And in fact, the subject of this letter, UC-8, is the

1 Finnish counterpart of the '740 patent, correct?

2 A Yes.

3 Q And in the second letter you say you're enclosing
4 copies of the European search report, plus official actions
5 in Taiwan and U.S.S.R., citing art; do you see that?

6 A Yes.

7 Q And that included at least the European search report
8 we've just been talking about, correct?

9 A I have no reason to think otherwise.

10 Q Thank you.

11 A So in this single letter you had before you at a single
12 point in time both the European search report citing
13 EPA-1929 as particularly relevant, and an office action in
14 the U.S. application of the '740 patent, correct?

15 A Yes.

16 Q Now, you were asked questions on direct about your
17 caseload during the time you were at Irons and Sears and
18 maybe Keil and Witherspoon. Do you remember those
19 questions?

20 A Yes.

21 Q You were asked questions about whether you only had
22 eight applications because UC-8 only went up to number 8,
23 or whether you had more; and you said you had a lot more,
24 you had a big pile to be responsible for, correct?

25 A About a dozen, I believe.

1 Q Pardon?

2 A About a dozen U.C. applications pending at that time, I
3 believe.

4 Q And you said you were also doing work with some other
5 people as well?

6 A Yes.

7 Q Are you telling the Court that you think your duty of
8 disclosure disappears because you had a high workload?

9 A No, sir.

10 Q Are you relying on your high workload to excuse you
11 from citing EPA-1929 to the U.S. Patent Office?

12 A No.

13 Q Now, you knew at the time you were prosecuting these
14 cases, the '740 patent, that it was the patent office's
15 position that practitioners such as you and me and all the
16 lawyers in this courtroom couldn't presume that an examiner
17 in the patent office was aware of material prior art cited
18 in other applications; is that correct?

19 A Yes.

20 Q And in fact, there's a manual provision, a provision of
21 The Manual of Patent Examining Procedure which says just
22 that, and I'd like you to look at it, 3543, which is in
23 evidence. In particular, I'd like you to look at 500.18,
24 section 200106B.

25 A B?

1 Q B as in Baker.

2 A Thank you.

3 Q And I'd like just to read to you part of the text and
4 ask you whether you understood at the time that this was
5 the patent office policy: "The individuals covered by
6 37CFR1.56(A) have a duty to bring to the attention of the
7 examiner or other office official involved with the
8 examination of a particular application, information within
9 their knowledge as to whether co-pending United States
10 applications which are material to the examination of the
11 application in question." Do you see that?

12 A Yes.

13 Q And you are one of those people covered by 1.56(A) as
14 far as the '740 application is concerned, correct?

15 A Yes.

16 Q Then it goes on to say, "As set forth by the Court in
17 Armour vs. Swift, we think that it's unfair that the busy
18 examiner, no matter how diligent and well-informed he may
19 be, to assume that he retains details of every pending file
20 in his mind when he's reviewing a particular application.
21 The applicant has a burden of presenting the examiner with
22 a complete and accurate record to support the allowance of
23 letters patent." Do you see that?

24 A Yes.

25 Q You knew about this fact and this view during the

1 prosecution of the '740 application, did you not?

2 A Yes.

3 Q And it goes on to say, "Accordingly, the individuals
4 covered by 1.56(A) cannot assume that the examiner of a
5 particular application is necessarily aware of other
6 applications material to the examination of the application
7 in question, but must instead bring such other applications
8 to the attention of the examiner."

9 And then it goes on, and I'm skipping a little -- if
10 anybody wants me to read it, I will -- but going on, it
11 says, "Similarly the prior art references for one
12 application must be made of record in other co-pending,
13 application if said prior art references are material to
14 the examination of the co-pending application."

15 You felt bound by this policy at the time you
16 prosecuted the '740 patent application, didn't you?

17 A Yes, I understood that policy.

18 Q And moreover, it was your belief at the time during
19 your prosecution that pending applications of different
20 inventors could not be cited as prior art against an
21 application of other inventors, correct? That was your
22 belief?

23 A Could I hear that question again?

24 (The requested material was read back by the reporter.)

25 A I don't recall exactly what my belief was on that

1 point. I've heard quite a bit of discussion with
2 Mr. Conlin about the patent office practices with respect
3 to provisional rejections. I don't have a recollection of
4 what the practice was. I'm not sure I was aware of what
5 the practice was with respect to provisional rejections at
6 that time.

7 Q Let me refer you to your deposition dated June 21 '94
8 on page 491. Do you have that page? June 21, '94. I know
9 it's a little confusing. There are multiple depositions
10 there.

11 A What page?

12 Q Page 491.

13 A Okay.

14 Q I'd like to read to you a brief excerpt from it and ask
15 if you gave this answer to this question; the reporter is
16 repeating the question, and it reads starting at line 1:
17 "Did you understand at the time that you were representing
18 the University of California at Keil and Witherspoon that
19 an examiner couldn't use a pending patent application filed
20 by a different group of inventors as evidence of the prior
21 art unless and until it was issued as a patent?"

22 And your answer was "yes." Did you give that answer to
23 that question?

24 A Yes.

25 Q Now, are you familiar with an application known as

1 UC-3?

2 A Yes, in a general way.

3 Q Now, UC-3 is actually filed in the -- it's actually
4 referred to in the text of your '740 patent, which you
5 might look at, DX3000, just to give us a point of
6 reference. And if you look in particular at column 7 of
7 the '740 patent, you will see the second full paragraph on
8 the left starting with the word "expression" --

9 A Column 7?

10 Q Yes, column 7.

11 A I'm sorry. Yes, I see it.

12 Q Column 7. Do you see on line 35 there is a reference
13 to 933035?

14 A Yes.

15 Q That is UC-3, correct?

16 A I'm not going to quibble with that. I believe that's
17 correct.

18 Q I will represent to you that it is. In your belief it
19 is as well? I can show you a document which --

20 A I don't recall specifically that it is.

21 Q 3018, I'm advised, let's just look at 3018 which is in
22 your book, do you see a letter from Lorange Greenlee to
23 John Baxter dated September 14, 1978?

24 A Yes.

25 Q And it says UC-3, 933035. So UC-3 is, in fact, the

1 application referred to in column 7, line 35, correct?

2 A Yes.

3 Q Now, do you know who the inventors were on UC-3? Let
4 us look again at 3018. Do you see in the third page of
5 that, there is a communication with the title block of that
6 case?

7 A Yes.

8 Q And we have Rutter, Goodman and Baxter?

9 A Yes.

10 Q And we all know, do we not, that the applicants in the
11 '740 patent, while they include Rutter and Goodman, they
12 also include Bell and Pictet who are not named in UC-3,
13 correct?

14 A Correct.

15 Q And UC-3 has Baxter who is not named in '740, correct?

16 A Correct.

17 Q And so we have here what we refer to in the patent
18 field as different inventive entities, correct?

19 A Yes.

20 Q And was your belief at the time you were prosecuting
21 these cases that that could not be cited as prior art,
22 correct, while it was an application?

23 A Evidently.

24 Q So your failure to have cited EPA-1929 to the U.S.
25 Patent Office could not possibly have been because you

1 thought UC-3 was as relevant or more relevant, agree?

2 MR. HEALEY: Objection, assumes a fact not in
3 evidence. There is no failure to cite. He's
4 characterizing it as a failure, and we haven't established
5 that there was any acknowledgment that he considered the
6 reference and decided not to cite it. And a lack of citing
7 it I think is different to characterize it than as failure
8 to cite it.

9 THE COURT: Gentlemen, I think it's true. I'll
10 sustain the objection.

11 Q So your not having cited EPA-1929 could not possibly
12 have been because you thought UC-3 was as relevant or more
13 relevant, agreed?

14 A I don't recall. I don't recall.

15 Q I'm not asking you to recall. I'm asking you if you
16 did not believe it was prior art. It necessarily follows,
17 I suggest and I'd like to ask you whether you agree, that
18 you're not having cited EPA-1929 to the Patent Office in
19 the United States could not have been because you thought
20 UC-3 was as a relevant prior art reference or a more
21 relevant prior art reference, agreed?

22 A I don't know what I could have thought. I don't agree.

23 Q Because you don't know what you thought?

24 A That's correct.

25 Q In other words, you're only disagreeing because you

1 don't know what your thought process was, correct?

2 A That's right.

3 THE COURT: Were you planning on concluding this
4 today?

5 MR. DUNNER: Your Honor, at this pace, I do not
6 believe so.

7 THE COURT: Well, in that case, why don't we just
8 declare a little bonus and come back Monday morning at
9 9:00.

10 MR. DUNNER: Your Honor, I never reject a gift
11 horse.

12 THE COURT: For my information, how close to
13 schedule are we?

14 MR. DUNNER: Your Honor, I would guess, judging
15 from the other witnesses they've identified, that we're
16 pretty well on schedule. I would guess, and it's just a
17 guess, that U.C.'s case will probably conclude sometime
18 Tuesday. You can tell me if I'm wrong. Is that correct?

19 MR. HEALEY: Correct.

20 MR. DUNNER: I would further guess we're trying to
21 streamline our case given what has happened. We're
22 regrouping. We're in the process of preparing now our
23 witnesses which I know will delight the Court and everybody
24 else. And I would hope we could finish not next week, but
25 the week of Labor Day with our case. And if I had to take

1 a wild guess, I would hope that we'll finish Tuesday or
2 Wednesday of the week of Labor Day. Labor Day I think is
3 September the 4th. That would be the 5th or the 6th. I
4 would hope you won't hold me to it, but that's going to be
5 our target.

6 THE COURT: I thought when we started on Monday,
7 it was represented that you all were going to be home for
8 Labor Day.

9 MR. DUNNER: That was U.C.'s representation, Your
10 Honor.

11 MR. HEALEY: That was our understanding, Your
12 Honor.

13 MR. DUNNER: I would like that to be the case.
14 But if they don't finish until Tuesday, I think it's
15 unlikely we'll finish by Labor Day.

16 MR. HEALEY: Your Honor, the only reason we won't
17 be finished today is because they've consistently gone
18 longer on every single witness on cross-examination than
19 they've represented to us. I think we've been moving along
20 fairly rapidly and any delay is due to the defense.

21 MR. DUNNER: Your Honor, I'm not blaming anybody.
22 I'm just responding to your question.

23 THE COURT: Well, I will observe that both you and
24 Mr. Lipsey have a habit of taking the exhibit and then
25 asking the witness if he can read what's in it. That's

1 unnecessary. Of course, he can read what's in it if he can
2 read. And more to the point, I can read what's in it so if
3 you cut that out, I think we would get out of here maybe
4 next Wednesday.

5 MR. DUNNER: Your Honor, you have spoken and we've
6 heard.

7 THE COURT: Good, commit it to memory. Court is
8 adjourned until 9:00 Monday morning.

9 (The court recessed at 4:20 p.m.)

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