

1 this is the --

2 Q. This right here?

3 A. Yes. This is a great place to start. Literature  
4 taught that it's cheap, available in really large scale. It  
5 has the number of carbons that you would need to build the  
6 -- call it the left-hand ring of bis-THF. In fact, it is  
7 the left hand of bis-THF, and you could stitch on the  
8 right-hand side. That's what Pezechk, Ghosh, the Erickson  
9 patent I think is '506, Ghosh again five years later is  
10 still working with it in '99, and Uchiyama showed a really  
11 interesting way to make it that was a pretty good advance.  
12 I think the literature taught that this is a great place to  
13 start.

14 Q. So by 2001, one of ordinary skill would start with the  
15 dihydrofuran ring; is that right?

16 A. I think that's actually obvious.

17 Q. Dr. Ganem testified that he thought the approaches  
18 starting with the dihydrofuran ring and building a second  
19 ridge was, quote, "illogical." What's your view?

20 A. I disagree.

21 Q. And indeed, we've seen evidence of how Tibotec  
22 actually worked, and that's Exhibit 404 in evidence. And  
23 just very briefly, how did Tibotec approach the problem?

24 A. Tibotec, if you go from top to bottom, which is the  
25 order in which they presented their ideas in this memo, does

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1 Q. In what respects?

2 A. Both yield and purity.

3 Q. Okay. Bottom line on the '411 patent, what's your  
4 view? Is it inventive?

5 A. It is.

6 Q. Is it not -- is it obvious to one of ordinary skill as  
7 of the invention date in 2003?

8 A. It is nonobvious.

9 Q. Okay. Let's switch gears to the '015 patent briefly,  
10 and that focuses on bis-THF; is that right?

11 A. That's correct.

12 Q. And what's your view as to the challenge of  
13 manufacturing bis-THF on commercial scale as of 2001?

14 A. My view is that it was incredibly complex and  
15 formidable. That's the word I would use: Formidable.

16 Q. Now, did the prior art teach the method taught in the  
17 '015 patent?

18 A. It did not.

19 Q. You were asked some questions about Dr. Ghosh's  
20 testimony. I'd just like to orient us to it.

21 This is his '94 article, which I don't have the  
22 exhibit number for, but I think the record's clear what the  
23 '94 article is and -- well, I don't know what it is.

24 This is his '94 communication; is that right?

25 A. That's correct.

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1 Q. And I think you said something on your examination  
2 that -- something about its publication by allowing -- Merck  
3 allowing its publication gave some clues as to Merck's views  
4 on the project? I'd just like you to explain that.

5 A. Generally, at Merck, we would agree to publication of  
6 material when the project had either died or we had  
7 abandoned the concept, so we would then be free to lecture  
8 and to publish.

9 Q. Okay. Was that your inference from the publication in  
10 '94 by Ghosh?

11 A. It is. It's actually my knowledge from the fact that  
12 I was on part of the committee that would allow things to be  
13 published. Vice presidents --

14 THE COURT: So you published either upon death or  
15 abandonment --

16 THE WITNESS: Yes.

17 THE COURT: -- is that what you said?

18 All right. Thank you.

19 MR. DISKANT: That's PTX91, Your Honor.

20 THE WITNESS: And I will clarify. We would after  
21 a certain number of years also publish for successful  
22 things, many successful projects. But while the project was  
23 within the -- a reasonable time frame when the competition  
24 was interested, we would only publish if the program had  
25 either been abandoned or died.

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1 THE COURT: All right.

2 Q. Now, the Ghosh '94; of these two methods on the slide,  
3 which is the '94 method?

4 A. '94 is the diethyl malate.

5 Q. And that is starting from a chiral material making two  
6 rings?

7 A. That's correct.

8 Q. Is that a complicated procedure?

9 A. It is.

10 Q. Counsel showed you Dr. Ghosh's testimony, and I don't  
11 think you actually had a chance to read it before she  
12 questioned you about it, and we looked at it a couple times.  
13 I'm not going to read it out loud again, but I would like  
14 you to read it with care.

15 And counsel asked you whether --

16 THE COURT: Page and line.

17 Q. This is from Ghosh's deposition, lines -- page 77,  
18 line 22, through page 78, line 14, and what I'd like you to  
19 pay particular attention to is, what is he talking about  
20 when he's talking about this literature?

21 MS. MAZZOCHI: Your Honor, can he read --

22 THE COURT: Let him read it first. Then I'll hear  
23 you. All right?

24 MS. MAZZOCHI: Okay.

25 A. What Ghosh is referring to --

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1 THE COURT: wait. Have you read it?

2 THE WITNESS: I have.

3 THE COURT: Ms. Mazzochi.

4 MS. MAZZOCHI: The way the question was phrased,  
5 he's asking what was Dr. Ghosh himself thinking, which I  
6 don't think is appropriate for this witness to opine on  
7 Dr. Ghosh's state of mind.

8 THE COURT: I didn't know someone's state of mind,  
9 but go ahead.

10 MR. DISKANT: I'm just responding to a question  
11 which she asked which I hesitate to show because -- well, I  
12 don't want to lead the witness in any way --

13 THE COURT: I know you don't want to do that,  
14 Mr. Diskant. I know that. I know it plagued you.

15 MR. DISKANT: It plagued me, Judge.

16 THE COURT: But at the same time, I thought you  
17 asked him to read that.

18 MR. DISKANT: I did.

19 THE COURT: And what was the purpose of your  
20 having him read it?

21 MR. DISKANT: Because I wanted to ask him his  
22 understanding of what Ghosh is talking about when he says --

23 THE COURT: I thought he meant what were you  
24 saying, not necessarily what he was thinking.

25 THE WITNESS: Well, Ghosh is referring to the

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