IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

VANDERBILT UNIVERSITY, *

Plaintiff, *

Case No: 1:05-cv-00506-SLR

v. *

ICOS CORPORATION, *

Defendant. *

* * * * * * * * * * * * *

PLAINTIFF, VANDERBILT UNIVERSITY'S
MOTION FOR ISSUANCE OF LETTER ROGATORY (AND STATEMENT
PURSUANT TO D. DEL. LR 7.1.1)

Plaintiff, The Vanderbilt University ("Vanderbilt"), by and through its undersigned attorneys, moves the Court for an order directing the issuance of a letter rogatory, pursuant to Rule 28(b)(2) of the Federal Rules of Civil Procedure, to any judge or tribunal having jurisdiction of civil actions in the United Kingdom, to take the deposition of Dr. Barry Clive Ross, who is a citizen of the United Kingdom, on the grounds that Dr. Ross has knowledge of facts material and necessary for the prosecution of this action.

This case arises from Vanderbilt University's claim that three of its scientists contributed to Glaxo, Inc.'s conception of inventions reflected in two U.S. patents, which include the compound Tadalafil, currently marketed as "Cialis." Those patents name one of Glaxo, Inc.'s scientists as the sole inventors of both patents. Those patents were assigned by Glaxo, Inc. to ICOS Corporation and currently still list the Glaxo, Inc. scientist as the sole inventor. Vanderbilt's Complaint requests that the Court issue an order to correct the two patents pursuant to 35 U.S.C. § 256 by adding the three Vanderbilt scientists as co-inventors of the patents.

Dr. Ross is a former Glaxo, Inc. employee who resides in the U.K. Vanderbilt believes that Dr. Ross possesses information that is critical to Vanderbilt's claim that the Vanderbilt scientists are co-inventors of the patents. Vanderbilt intends to request discoverable information from Dr. Ross on at least the following subjects:

1. ICOS Corporation's collaboration with Glaxo relating to research and development of phosphodiesterase inhibitors.

2. All communications Dr. Ross has had with Vanderbilt University and/or Jackie Corbin, PHd, Sharron Francis, PHd and Sekhar Raja Konjeti PHd.

3. Any information related to the invention of tadalafil.

On information and belief, Dr. Ross is a retiree of Glaxo, Inc. and Glaxo, Inc. has implied to the undersigned that it will not willingly make available any of its current or former employees for depositions in this proceeding. As a result, pursuant to 28 U.S.C. § 1781 and Fed. R. Civ. P. 28(b)(2), Vanderbilt has prepared a Letter Rogatory, attached hereto. Vanderbilt has retained a British solicitor who will forward the letter to the appropriate British court for the issuance of a commission to take the deposition of Dr. Ross.[1]

As required by D. Del. LR 7.1.1, undersigned counsel made a reasonable effort to reach agreement with the opposing attorneys on the matters set forth in this motion prior to the filing of this motion.

For the foregoing reasons, Vanderbilt respectfully requests that the Court grant this

[1] Given the discovery deadline of November 17, 2006, transmitting the letter rogatory through the Department of State would not be practical. As a result, the British solicitor will act as Vanderbilt's agent in obtaining the commission from the appropriate British court pursuant to 28 U.S.C. § 1781.

motion, and execute the attached Letter Rogatory.

Dated: October 27, 2006

BIFFERATO, GENTILOTTI,
BIDEN & BALICK, L.L.C.

Vincent A. Bifferato, Jr. (#2465)
Ian Connor Bifferato (#3273)
Joseph K. Koury (#4272)
1308 Delaware Avenue
Wilmington, Delaware 19806
(302) 429-1900

-and-

Robert S. Brennen
Donald E. English, Jr.
Aaron C. Storm
MILES & STOCKBRIDGE P.C.
10 Light Street
Baltimore, Maryland 21202
(410) 727-6464

Attorneys for Plaintiff,
Vanderbilt University