

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

GENENTECH, INC. and CITY OF HOPE,

Plaintiffs,

v.

AMGEN INC.,

Defendant.

Case No. 18-924-CFC

~~PROPOSED~~ ORDER GRANTING PLAINTIFFS' MOTION TO COMPEL

Upon consideration of Plaintiffs Genentech, Inc. and City of Hope's Motion to Compel Amgen to Produce Documents and Witnesses, *and for the reasons stated during the June 18, 2019 hearing,*

IT IS HEREBY ORDERED that Defendant Amgen, Inc.'s production of its opinion letters concerning (i) infringement and/or validity of U.S. Patent No. 8,574,869 ("the '869 patent"); and (ii) validity of U.S. Patent Nos. 6,627,196 ("the '196 patent"), 7,371,379 ("the '379 patent"), and/or 10,160,811 ("the '811 patent") (collectively, "the Opinion Letters") has effected a subject matter waiver of Amgen's attorney-client privilege concerning (i) infringement and validity of the '869 patent; and (ii) validity of the '196, '379, and '811 patents. The waiver extends to communications pre-dating the Opinion Letters and extends to Amgen's in-house counsel. *The waiver does not extend to communications with outside trial counsel.* ~~To the extent that Amgen's trial counsel communicated, directly or indirectly, concerning (i) infringement or validity of the '869 patent; or (ii) validity of the '196, '379, or '811 patents with Laura Brand or other Amgen employees involved in Amgen's decisions whether to make, use, sell, offer to sell, or import Kanjinti, ABP 980, or trastuzumab, the waiver also extends to such communications.~~

Accordingly, Amgen shall produce ~~within seven days~~ *on a rolling basis and no later than July 2, 2019!*

1. All documents relating to assessments of (i) infringement or validity of the '869 patent; or (ii) validity of the '196, '379, or '811 patents;
2. All documents relating to amendments to Amgen's proposed label for Kanjinti based upon assessments of the validity of the '196, '379, or '811 patents or the outcome of inter partes review proceedings involving those patents;
3. All documents relating to any experimentation, testing, or analysis to alter Amgen's manufacturing processes to avoid Genentech's allegations of infringement of the '869 patent;
4. All documents relating to communications with and among Amgen's in-house counsel concerning the Opinion Letters or any other assessments of (i) infringement or validity of the '869 patent; or (ii) validity of the '196, '379, or '811 patents; and
- ~~5. All documents relating to communications with outside trial counsel concerning the Opinion Letters or any other assessments of (i) infringement or validity of the '869 patent; or (ii) validity of the '196, '379, or '811 patents, to the extent that such advice was provided directly or indirectly to Amgen's business decisionmakers.~~

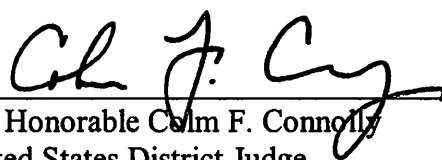
IT IS FURTHER ORDERED that Amgen shall:

6. Make available for deposition any in-house counsel involved in (i) obtaining the Opinion Letters; or (ii) providing advice with respect to (a) infringement or validity of the '869 patent or (b) the validity of '196, '379 or '811 patents to any business decisionmakers at Amgen; and
7. Make available for deposition any witnesses who were previously instructed not to answer questions at their depositions in this case relating to the subjects of paragraph 1-3

above on the basis of privilege, including: (1) Jennifer Khiem; (2) Shane Hall; (3) Benjamin Dionne; (4) Purvi Lad; and (5) Amy Nehring. These depositions shall be limited to no more than three hours on the record. ~~Amgen shall pay Genentech's costs and attorneys' fees in connection with such depositions.~~

As the parties previously agreed before the discovery hearing, Amgen shall produce (i) all communications with opinion counsel related to (a) non-infringement and/or invalidity of the '869 patent; and (b) the invalidity of the '196, '379, and '811 patents; (ii) any files from opinion counsel shared with Amgen; (iii) all underlying documents and drafts of the Opinion Letters shared with Amgen; (iv) all communications regarding the opinion letters exchanged between Amgen in-house counsel and outside opinion counsel and/or any Amgen decisions makers who relied upon the opinions; and (v) any other opinion letters obtained by Amgen related to (a) non-infringement and/or invalidity of the '869 patent; and (b) the invalidity of the '196, '379, and '811 patents. The Court hereby ORDERS that this production be completed ~~within seven days.~~ ^{by July 2, 2019,}

SO ORDERED this 20th day of June, 2019.


The Honorable Colm F. Connolly
United States District Judge