IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

GENENTECH, INC and CITY OF HOPE, Plaintiffs, v. AMGEN INC., Defendant.	C.A. No. 18-00924-GMS

PLAINTIFFS' REPLY BRIEF IN SUPPORT OF THEIR MOTION TO DISMISS DEFENDANT'S UNENFORCEABILITY COUNTERCLAIMS AND TO STRIKE DEFENDANT'S ELEVENTH AFFIRMATIVE DEFENSE

Of Counsel:

William F. Lee
Lisa J. Pirozzolo
Emily R. Whelan
Kevin S. Prussia
Andrew J. Danford
WILMER CUTLER PICKERING
HALE AND DORR LLP
60 State Street
Boston, MA 02109
(617) 526-6000

Robert J. Gunther, Jr.
WILMER CUTLER PICKERING
HALE AND DORR LLP
7 World Trade Center
250 Greenwich Street
New York, NY
(212) 230-8800

Daralyn J. Durie
Adam R. Brausa
DURIE TANGRI LLP
217 Leidesdorff Street
San Francisco, CA 94111
(415) 362-6666

MCCARTER & ENGLISH, LLP

Michael P. Kelly (#2295)
Daniel M. Silver (#4785)
Renaissance Centre
405 North King Street, 8th Floor
Wilmington, DE 19801
(302) 984-6300
mkelly@mccarter.com
dsilver@mccarter.com

Counsel for Plaintiffs Genentech, Inc. and City of Hope

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I. INTRODUCTION

Amgen has not identified any factual dispute that would prevent the Court from disposing of its unenforceability defenses at the pleadings stage. For the '213 patent, Amgen argues that there is a factual dispute as to whether Genentech's statements to the patent examiner constituted permissible attorney argument or improper material misrepresentations. But Amgen's position cannot be reconciled with long-standing Federal Circuit precedent that an applicant's statements concerning the teachings of the prior art cannot, as a matter of law, support a claim of inequitable conduct so long as the patent examiner was capable of assessing the applicant's arguments on her own. Amgen has not pleaded any facts alleging that the patent examiner here was incapable of fully evaluating Genentech's statements concerning the prior art for herself, and Amgen's unenforceability counterclaim for the '213 patent and related Eleventh Affirmative Defense are therefore legally deficient. Indeed, Amgen does not even engage with the many cases dismissing a defendant's unenforceability counterclaims in exactly these circumstances, and the cases that Amgen does discuss only underscore the need to plead facts alleging that the patent examiner was incapable of evaluating the applicant's arguments (which Amgen has failed to do here).

For the remaining seventeen patents-in-suit, Amgen asserts that it need not meet the heightened pleading requirements of Federal Rule of Civil Procedure 9(b) because there are ways besides inequitable conduct that a patent may be unenforceable. But that does not relieve Amgen of its obligation to plead at least ***some*** facts supporting its counterclaims, and Amgen does not dispute that it has pleaded none. Instead, Amgen asserts that there are "a number of ways" in which the patents-in-suit might someday become unenforceable—for example, based upon the anticipated expiration of certain patents, or potential future decisions in other proceedings concerning the validity of those patents. But that is pure speculation about future events, and even Amgen cannot say today what its theory of unenforceability for any particular

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