

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

GENENTECH, INC.,

Plaintiff and Counterclaim Defendant,

V.

AMGEN INC..

Defendant and Counterclaim Plaintiff.

C.A. No. 18-924-CFC

PUBLIC VERSION FILED: August 8, 2019

**STIPULATION AND [PROPOSED] ORDER REGARDING JUDGMENT OF
NON-INFRINGEMENT OF U.S. PATENT NOS. 8,512,983 AND 9,714,293**

WHEREAS, Plaintiff Genentech, Inc. (“Genentech”) has asserted a claim of patent infringement against Defendant Amgen Inc. (“Amgen”) of claims 2 and 19 of U.S. Patent No. 8,512,983 (“the ’983 patent”) and of claims 72 and 73 of U.S. Patent No. 9,714,293 (“the ’293 patent”) (collectively, “the Asserted Claims”);

WHEREAS, in its Memorandum Opinion of June 14, 2019, D.I. 255, and accompanying Order, D.I. 256, the Court construed certain disputed terms in the Asserted Claims of the '983 and '293 patents;

WHEREAS, the Court rejected Genentech’s construction of the term “a glutamine-free production culture medium” to mean “a production culture medium that is essentially free of glutamine,” and instead determined that the term should be construed as “a culture medium used in the production phase that is not formulated or supplemented with glutamine;” D.I. 256 at 20; and

WHEREAS, the Court's construction of "a glutamine-free production culture medium" materially affects Genentech's infringement analysis for the asserted claims of the '983 and '293 patents;

WHEREAS, Genentech's position is that Amgen infringes the asserted claims of the '983 and '293 patents under Genentech's construction of "a glutamine-free production culture medium." Amgen disagrees with Genentech's position; and

WHEREAS, based on the evidence produced by Amgen in discovery, Genentech cannot sustain its burden of proof to establish infringement of the asserted claims of the '983 and '293 patents under the Court's construction of "a glutamine-free production culture medium."

NOW THEREFORE, Genentech and Amgen hereby stipulate, subject to the approval of the Court, as follows:

1. To conserve judicial resources and to avoid the time and expense of further litigation related to the '983 and '293 patents, the parties respectfully request that the Court enter judgment of non-infringement as to Counts 26 and 28 of Genentech's Second Amended Complaint, D.I. 79 in C.A. No. 18-924-CFC, asserting infringement of the '983 and '293 patents by Amgen in connection with Kanjinti.¹ Upon entry of final judgment resolving all claims in this action, Genentech reserves the right to appeal the judgment of non-infringement and the Court's claim construction ruling with respect to the phrase "a glutamine-free production culture medium."

2. Amgen accordingly stipulates to the dismissal of Counts 16 and 18 of its Counterclaims, D.I. 82, for declaratory judgments that the '983 and '293 patents are invalid,

¹ The judgment as to these claims will become final upon entry of judgment as to all remaining claims and counterclaims in these actions.

without prejudice to renewal in the event that the Court's claim construction ruling is altered on appeal or otherwise in this action.

Respectfully submitted,

MCCARTER & ENGLISH, LLP

/s/ Daniel M. Silver

Michael P. Kelly (No. 2295)
Daniel M. Silver (No. 4758)
Alexandra M. Joyce (No. 6423)
Renaissance Centre
405 N. King Street, 8th Floor
Wilmington, DE 19801
(302) 984-6300
mkelly@mccarter.com
dsilver@mccarter.com
ajoyce@mccarter.com

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
william.lee@wilmerhale.com
lisa.pirozzolo@wilmerhale.com
emily.whelan@wilmerhale.com
kevin.prussia@wilmerhale.com
andrew.danford@wilmerhale.com

Robert J. Gunther Jr.
WILMER CUTLER PICKERING
HALE AND DORR LLP
7 World Trade Center
250 Greenwich Street
New York, NY 10007
(212) 230-8800
robert.gunther@wilmerhale.com

SMITH KATZENSTEIN & JENKINS LLP

/s/ Eve H. Ormerod

Neal C. Belgam (No. 2721)
Eve H. Ormerod (No. 5369)
1000 West Street, Suite 1501
Wilmington, DE 19801
(302) 652-8400
nbelgam@skjlaw.com
eormerod@skjlaw.com

Of Counsel:

Michelle Rhyu
Susan Krumplitsch
Daniel Knauss
COOLEY LLP
3175 Hanover Street
Palo Alto, CA 94304-1130
(650) 843-5287
skrumplitsch@cooley.com
mrhyu@cooley.com
dknauss@cooley.com

Orion Armon
COOLEY LLP
380 Interlocken Crescent, Suite 900
Broomfield, CO 80021-8023
(720) 566-4119
oarmon@cooley.com

Eamonn Gardner
COOLEY LLP
4401 Eastgate Mall
San Diego, CA 92121-1909
(858) 550-6086
egardner@cooley.com

Attorneys for Defendant Amgen Inc

Daralyn J. Durie
Adam R. Brausa
DURIE TANGRI LLP
217 Leidesdorff St.
San Francisco, CA 94111
(415) 362-6666
ddurie@durietangri.com
abrausa@durietangri.com

*Attorneys for Plaintiffs Genentech, Inc. and
City of Hope*

DATED: August 2, 2019

IT IS SO ORDERED this _____ day of _____, 2019.

United States District Judge