

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

GENENTECH, INC.,

Plaintiff,

v.

AMGEN INC.,

Defendant.

C.A. No. 18-924-CFC

PUBLIC VERSION FILED: October 4, 2019

**OPENING BRIEF IN SUPPORT OF GENENTECH, INC.'S MOTION FOR SANCTIONS
PURSUANT TO FEDERAL RULE OF CIVIL PROCEDURE 37(b)**

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I. INTRODUCTION

Plaintiff Genentech, Inc. (“Genentech”) respectfully moves for an order holding Defendant Amgen Inc. (“Amgen”) in contempt of this Court’s June 20, 2019 Order Granting Plaintiff’s Motion to Compel (D.I. 259) (hereinafter, the “Order”) and entering sanctions pursuant to Rule 37(b) of the Federal Rules of Civil Procedure by deeming certain facts established.

Amgen asserts the advice of counsel as a defense to willful patent infringement. It seeks to use privileged communications as a sword, and the Court correctly held that it therefore cannot assert privilege as a shield. Amgen has waived privilege regarding the subject matter of its opinion letters.

The Court twice rejected Amgen’s attempt to limit the scope of its waiver to exclude in-house counsel communications and work product that were not shared with Amgen’s “decisionmakers.” The Court correctly held that Amgen seeks to use privileged communications as a sword, and Amgen—as a corporate entity—has placed its supposed good-faith reliance on such communications at issue. Amgen itself includes Amgen’s in-house counsel, and the Court thus expressly included Amgen’s in-house counsel within the scope of the waiver in its Order. The Court affirmed its ruling when it rejected Amgen’s motion for re-argument on this issue.

Amgen has deliberately defied this Court’s Order. It produced heavily redacted documents on September 4, 2019, and then began producing witnesses for depositions. During the deposition of Lois Kwasigroch—one of Amgen’s in-house counsel [REDACTED]—Amgen instructed the witness not to answer any questions to the extent they called for communications or work product not conveyed to a small set of individuals that Amgen has chosen to dub the company’s business “decisionmakers.”

These instructions violated the Court's Order. They prevented Genentech from exploring Ms. Kwasigroch's state of mind, and prevented discovery into whether *Amgen*, not merely a handful of carefully curated individuals, had a good faith belief that the asserted patents were invalid and/or not infringed. Amgen should therefore be held in contempt, and the Court should issue sanctions deeming certain facts admitted at trial relating to Ms. Kwasigroch's knowledge of and opinions regarding the validity of certain patents-in-suit that fall within the scope of the Court's Order, as set forth in the enclosed Proposed Order.

II. BACKGROUND

A. Amgen's Attempts to Limit the Scope of the Privilege Waiver

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Amgen announced its intention to rely on these opinions of counsel in an effort to defend itself from a charge of willful infringement. Genentech then requested the production of documents to test whether Amgen in fact was relying on those opinions in good faith. Declaration of Daralyn J. Durie ("Durie Decl.") Ex. 1, Letter from Danford to Rhyu (June 3, 2019). Amgen produced a limited set of documents, but refused to produce communications with and among Amgen's in-house counsel and related work product that were not provided to the specific individuals who were supposedly making the ultimate decision to launch Kanjinti. *See* Durie Decl. Ex. 2, Letter from Gardner to Danford

[REDACTED]

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