

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

DECLARATION OF DARALYN J. DURIE

I, Daralyn J. Durie, Esq., declare as follows:

1. I am an attorney at the law firm of Durie Tangri LLP, counsel to Plaintiff Genentech, Inc. in the above-captioned action. I respectfully submit this declaration for the purpose of transmitting certain documents filed in support of Plaintiffs' Opening Brief in Support of its Motion for Sanctions.
2. Attached as **Exhibit 1** is a true and correct copy of a letter dated June 3, 2019 from Andrew J. Danford regarding Amgen's Production of Opinions of Counsel.
3. Attached as **Exhibit 2** is a true and correct copy of a letter dated June 11, 2019 from Eamonn Gardner regarding Discovery regarding Opinions of Counsel.
4. Attached as **Exhibit 3** is a true and correct copy of the sealed June 18, 2019 hearing transcript.
5. Attached as **Exhibit 4** is a true and correct copy of a Notice of Electronic Filing for D.I. 259 regarding Order granting Plaintiff's Motion to Compel.
6. Attached as **Exhibit 5** is a true and correct copy of a Notice of Electronic Filing for D.I. 488 & D.I. 345 regarding Memorandum Order.

7. Attached as **Exhibit 6** is a true and correct copy of document AMGKAN03002837 - 03002856.

8. Attached as **Exhibit 7** is a true and correct copy of document AMGKAN03002583 - 03002612.

9. Attached as **Exhibit 8** is a true and correct copy of document AMGKAN02999058 - 02999097.

10. Attached as **Exhibit 9** is a true and correct copy of document AMGKAN02988860 – 02988899.

11. Attached as **Exhibit 10** is a true and correct copy of document AMGKAN02989139 - 02989225.

12. Attached as **Exhibit 11** is a true and correct copy of the September 17, 2019 deposition transcript of Lois Kwasigroch.

13. Attached as **Exhibit 12** is a true and correct copy of the September 23, 2019 deposition rough mini-transcript of Stuart Watt.

14. Attached as **Exhibit 13** is a true and correct copy of the September 10, 2019 deposition transcript of Mark Izraelewicz.

I declare under penalty of perjury that the foregoing is true and correct to the best of my knowledge.

EXECUTED this 24th day of September, 2019.

/s/ Daralyn J. Durie

Daralyn J. Durie

EXHIBIT 1

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June 3, 2019

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Michelle Rhyu
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Re: Amgen's Production of Opinions of Counsel

Counsel,

We have received Amgen's May 31, 2019 production of two opinions of counsel: [REDACTED]

We were surprised by the timing of this production, given that fact discovery is about to close and Amgen has consistently asserted privilege over these matters, including during depositions that occurred last week immediately before Amgen chose to disclose these opinions. Amgen's belated decision to waive privilege raises many new issues that will need to be addressed, and we are prejudiced by Amgen's delay in disclosing these opinions until ten days before the close of fact discovery.

As an initial matter, Amgen's production of the opinion letters alone is insufficient. By producing these letters, Amgen has waived privilege as to the subject matter of these opinions. *See In re EchoStar Commc'ns Corp.*, 448 F.3d 1294 (Fed. Cir. 2006) (waiver extends to "any attorney-client communications relating to the same subject matter"). Amgen should have produced all documents falling within the scope of Amgen's privilege waiver at the time that it produced the opinion letters. Plaintiffs therefore expect that Amgen will immediately provide the following documents:

1. All documents from and correspondence with [REDACTED] regarding these opinions, including any files from opinion counsel and correspondence with opinion counsel;
2. All underlying documents and drafts of the opinion letters; and

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Michelle Rhyu
June 3, 2019
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3. All documents relating to the subject matter of these opinion letters, including communications with and among any in-house counsel at Amgen, and any other opinions or advice of counsel given or received relating to the subject matter

Also, as a subject matter waiver, Amgen's waiver of privilege is not limited to this case. To the extent that Amgen has received opinions relating to the same subject matter in other litigations (*e.g.*, in connection with C.A. 17-cv-1407-CFC), we expect that Amgen will provide those opinions to us, as well as any documents encompassed by Amgen's privilege waiver. We also expect that Amgen will withdraw its privilege objections to (1) Plaintiffs' Request for Production Nos. 36, 51, and 92; and (2) Plaintiffs' 30(b)(6) Topic Nos. 21, 24, 25, 26, 36, 37, 55, and 56 in view of its waiver of privilege. To the extent that Amgen has clawed back documents relating to the subject matter of Amgen's waiver (including with respect to Amgen's label changes or efforts to design around the '869 patent), we expect those documents to be produced to us again.

To the extent that Amgen is withholding or redacting any documents relating to (1) the validity of U.S. Patent Nos. 6,627,196, 7,371,379, and 10,160,811 or (2) the validity and/or infringement of U.S. Patent No. 8,574,869, we expect that Amgen will provide a supplemental privilege log identifying all documents being withheld and/or redacted by Amgen through the present date so that we can evaluate the scope of Amgen's privilege waiver. The privilege log should include all communications internal to Amgen, as well as with any outside counsel, including litigation counsel.

Amgen's waiver of privilege also affects the scope of the deposition discovery remaining in this case. Below are several deposition-related issues that we need to address:

1. Please provide deposition dates for [REDACTED]. We also intend to take depositions of any in-house counsel at Amgen involved in obtaining these opinion letters;
2. Amgen has previously asserted privilege and instructed its witnesses not to answer questions concerning the subject matter addressed in these opinion letters during the following depositions: [REDACTED]. Amgen's waiver also affects the deposition testimony of [REDACTED]. We intend to reopen those depositions now that Amgen has waived privilege. Please provide their availability to be deposed;
4. Please provide a designee on Plaintiffs' Rule 30(b)(6) topic 84 relating to opinions of counsel; and

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