

**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

**AMGEN'S ANSWERING BRIEF IN OPPOSITION TO GENENTECH'S  
MOTION FOR SANCTIONS PURSUANT TO  
FEDERAL RULE OF CIVIL PROCEDURE 37(b)**

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## I. INTRODUCTION

Genentech's motion for discovery sanctions<sup>1</sup> should be denied because it is based on Genentech's improper attempt to reach trial counsel's work product and trial counsel's direct and indirect privileged communications with Amgen. The Court's Order included an important and appropriate limitation on the scope of waiver of the attorney-client privilege resulting from Amgen's reliance on opinions of counsel as a defense to Genentech's allegation of willful infringement: that waiver did *not extend* to outside trial counsel's work product or trial counsel's direct or indirect privileged communications with Amgen. D.I. 259. The *en banc* Federal Circuit firmly established in *Seagate* that reliance on opinions of counsel does not waive work product immunity with respect to trial counsel. See *In re Seagate Tech., LLC*, 497 F.3d 1360, 1376 (Fed. Cir. 2007) ("relying on opinion counsel's work product does not waive work product immunity with respect to *trial counsel*." (emphasis added), *abrogated on other grounds by Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 136 S. Ct. 1923 (2016)).

Nonetheless, Genentech attempted to obtain deposition testimony from Ms. Kwasigroch that unavoidably would have exposed trial counsel's invalidity and non-infringement work product that Ms. Kwasigroch received from (or developed with) Amgen's outside trial counsel. Ms. Kwasigroch is the Amgen in-house counsel representing Amgen in this litigation, has responsibility for managing the case, is admitted *pro hac vice* by the Court and is bound by the Protective Order. In reliance on *Seagate* and the Court's limited waiver Order, Amgen's counsel appropriately objected to some of the questions posed during Ms. Kwasigroch's deposition and instructed Ms. Kwasigroch to protect trial counsel's work-product immunity and privilege.

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<sup>1</sup> Genentech filed a motion and supporting brief in lieu of utilizing the Court's discovery dispute resolution procedure, so Amgen is responding in kind.

Genentech turned a blind-eye to the important limitations in the Court’s Order, provoking this unnecessary and inappropriate motion for sanctions. The motion—and Genentech’s attempts to break Amgen’s trial counsel work product immunity and privilege (together, Amgen’s “trial counsel privilege”)—should be denied for three reasons.

First, Genentech failed to lay a foundation during Ms. Kwasigroch’s deposition to establish that Ms. Kwasigroch fell within the scope of the waiver defined by the Court’s Order. Ms. Kwasigroch’s testimony demonstrated that she does *not* fall within the scope of the waiver defined by the Court. Counsel’s objections and instructions reflected Genentech’s failure to lay the required foundation, so there was no violation of the Order.

Second, counsel’s privilege objections and instructions to Ms. Kwasigroch were consistent with the Court’s Order and appropriate under *Seagate*. Ms. Kwasigroch’s mental impressions concerning the non-infringement and invalidity of the patents-in-suit were created by receiving and refining trial counsel’s work product. Ms. Kwasigroch could not testify about those mental impressions without waiving the trial counsel privilege—and *Seagate* squarely holds that Amgen is entitled to maintain its trial counsel privilege notwithstanding its reliance on opinions of counsel.

Third, Genentech’s proposed findings of fact are *wrong*: the proposed findings are contradicted by Ms. Kwasigroch’s sworn testimony. Therefore, regardless of how the Court views the merits of the parties’ positions on the scope of the privilege waiver, it would be wrong for the Court to adopt Genentech’s proposed findings.

Genentech’s motion should be denied for each of the foregoing reasons, which are explained in more detail below.

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