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**

AMGEN'S RESPONSIVE LETTER TO GENENTECH'S MOTION TO COMPEL PRODUCTION OF DOCUMENTS

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Dear Judge Connolly:

In response to Genentech's opening brief, Amgen respectfully requests that the Court (i) deny Genentech's request for a protective order blocking the deposition of Dr. Brian Leyland-Jones; and (ii) deny Genentech's motion to compel Amgen's production of certain test results obtained at the direction of outside trial counsel. The parties have resolved Genentech's request for deposition time for damages discovery.

I. GENENTECH'S MOTION FOR PROTECTIVE ORDER TO PREVENT THE DEPOSITION OF COOPERATIVE THIRD PARTY FACT WITNESS DR. LEYLAND-JONES SHOULD BE DENIED

Amgen has diligently sought discovery of inventorship of the Dosing Patents, but Genentech has not been forthright or timely in responding to Amgen's discovery requests, causing Amgen prejudice in its ability to prove the invalidity of these patents. Only because of Amgen's persistence are the facts starting to emerge. Neither Dr. Baughman nor Dr. Shak [redacted] In a late-produced document, Dr. Baughman [redacted] (*See* Op. Ltr at 1, and Amgen Ex. 3.) In her deposition, she recalled c [redacted] Amgen Ex. 15 (Baughman Depo Tr.) at 71:2-23.) As recently as this past Monday, Genentech's expert Dr. Karen Gelmon gave sworn fact testimony that [redacted] Now that the fact of Dr. Leyland-Jones' [redacted] are finally coming to light, Genentech seeks to prevent the deposition of Dr. Leyland-Jones on the basis of delay Genentech itself caused. The late-produced Baughman email is good cause for the Court to allow the deposition of Dr. Leyland-Jones, which Amgen noticed on July 30[1], and for the other focused discovery sought in Amgen's opening brief. (*See* Amgen Ex. 14 (Subpoena to Dr. Brian Leyland-Jones, July 30, 2019).)

Genentech should not be allowed to prevent Amgen from obtaining evidence from a cooperating third party to support Amgen's defense that the Dosing Patents are invalid for improper inventorship. Amgen has diligently sought the specific discovery needed to corroborate a theory of incorrect inventorship since early in the case, including by seeking documents involving the named inventors and third parties such as Dr. Leyland-Jones. (*See* Op. Ltr. at 1, identifying document requests.) From the moment in her deposition that Dr. Baughman [redacted] Amgen asked Genentech to produce the email. Amgen held the deposition open and pursued the email through follow-up letters. (*See id.* at 2.) After two months of unexplained refusal, Genentech finally produced the document on July 23, long after close of fact discovery. (*See id.* at 1-2.) It is Genentech who created the need for deposing Dr. Leyland-Jones after the close of fact discovery.

[1] Pursuant to Local Rule 30.2, Amgen agreed to postpone the deposition of Dr. Leyland-Jones, scheduled for August 8, 2019, after Genentech said it would be moving for a protective order. (*See* Ex. 16 (Aug. 5, 2019 Email from Daniel Knauss re deposition of Dr. Leyland-Jones).)

Genentech's claim that Amgen should have taken Dr. Leyland-Jones' deposition earlier because of his knowledge of the Herceptin clinical trial is also incorrect. The Herceptin clinical trial document cited by Genentech does not name Dr. Leyland-Jones (*see* GNE Op. Ltr. at 2, Ex. 3), and although Dr. Leyland-Jones was publicly associated with the trial, [redacted] (*see* Op. Ltr. at 1-2), [redacted] If Genentech succeeds on this motion, it is Amgen who will be prejudiced by Genentech's discovery abuse because Genentech will have successfully concealed facts in its possession that are relevant to the validity of the patents until after fact discovery closed, and then used its late production to shield the witness most knowledgeable about those facts from deposition.

Dr. Leyland-Jones's deposition is further warranted by new facts injected into the case by Genentech's expert Dr. Karen Gelmon. In her rebuttal expert report addressing Amgen's invalidity arguments and in her deposition earlier this week, Dr. Gelmon testified [redacted] (*See* Ex. 17 (Gelmon Reb. Rpt.), ¶¶ 19, 88; Ex. 18 (Gelmon Oct. 7, 2019 Depo. Tr.) at 17:18-18:11; 18:24-19:1; 55:18-57:14; 58:10-59:3; 60:5-15.) In a previous deposition, Dr. Gelmon testified [redacted] (*See* Ex. 19 (Gelmon Hospira IPR Depo. Tr.) at 16:17-17:20; 24:17-22; 25:11-13.) The meeting about which Dr. Gelmon testified occurred at least five months before the conversation that Dr. Baughman testified [redacted] Ex. 15 at 71:2-23.)

These new facts, introduced months after the close of discovery, provide corroborating evidence that the named inventors were not the true inventors of the Dosing Patents.[2] Amgen should be allowed to ask Dr. Leyland-Jones about these new facts.

Good cause supports the deposition of Dr. Leyland-Jones. Courts in this District have allowed depositions after the close fact discovery when the requesting party has not acted in bad faith, and the objecting party will not face significant burden or prejudice. *See Sepracor Inc. v. Dey L.P.*, No. 06-113-JJF, 2009 WL 2970467 (D. Del. Sept. 15, 2009.) Good cause also exists when new facts are obtained and the movant is otherwise diligent. *See ICU Med., Inc. v. RyMed Techs., Inc.*, 674 F. Supp. 2d 574, 577-578 (D. Del. 2009) (finding good cause under Rule 16(b)(4) for Defendant to amend its answer past the scheduling deadline when new facts came to light one

[2] Dr. Gelmon's testimony in the IPR proceedings did not apprise Amgen of the prior invention. In that deposition, she testified that she knew the Toronto meeting took place "in the second half of 1999," suggesting it was after the August 1999 priority date of the Dosing Patents. (*See* Ex. 19 at 15:18-17:20, 323:17-324:9.) In her latest testimony, she stated [redacted] – well before the first filing date of the patents. (Ex. 18 at 45:20-25; 55:18-56:18; 104:25-105:22.)

month prior); *see also TC Tech. LLC v. Sprint Corp.*, No. 16-153-RGA, 2019 WL 529678, at *2 (D. Del. Feb. 11, 2019). In contrast to the current facts, in each of the cases Genentech cites, the parties seeking discovery failed to provide *any* justification for lack of diligence, and neither request was triggered by the opposing party's late-produced discovery. *See Guilfoil v. Johnson*, No. 15-733-GMS, 2017 WL 3473848, at *6 (D. Del. Aug. 11, 2017) (Plaintiff provided *no justification* for the late discovery requests); *see also Walker v. Centocor Ortho Biotech, Inc.*, 558 F. App'x 216, 222 (3d Cir. 2014) (Plaintiff's knowledge of the proposed deponent's role in the case for nearly six years showed lack of diligence.)

Genentech's arguments concerning time constraints and resulting prejudice are founded on exaggeration. Genentech has three law firms working on this case. This dispute concerns a single deposition of a witness well-known to Genentech. Because inventorship is a purely fact-based inquiry, no expert testimony is necessary. Finally, Genentech's reference to prior consulting relationships between Dr. Leyland-Jones and both Amgen and Genentech is irrelevant – Dr. Leyland-Jones has now been identified as a key fact witness, and his deposition is both necessary and appropriate. Genentech cannot sit on critical evidence until the end of the fact discovery period and then claim prejudice to prevent Amgen from obtaining follow-up discovery related to that evidence.

II. THE COURT SHOULD DENY GENENTECH'S MOTION TO COMPEL TEST RESULTS PREPARED AT THE DIRECTION OF OUTSIDE LITIGATION COUNSEL

The relief sought by Genentech contravenes the Court's waiver Order. The June 20, 2019 order expressly stated that "[t]he waiver does not extend to communications with outside trial counsel." (D.I. 259). Yet, Genentech demands communications with trial counsel about testing conducted solely at the direction of outside trial counsel.

Contrary to Genentech's assertion, the test results are not simply "facts that Amgen's employees themselves generated." GNE Op. Ltr. at 3. Rather, outside trial counsel requested and directed the testing to facilitate the rendering of legal advice and to develop its case. *See* GNE Op. Ltr., Ex. 11 at 65:8-23; Gardner Declaration, ¶¶ 3–4. Amgen is not seeking to shield otherwise discoverable information merely by disclosing it to its attorney. Instead, the information Genentech is seeking would not exist if trial counsel had not requested that it be created. *Kimberly-Clark Corp. v. Tyco Healthcare Retail Grp.*, No. 05-C-985, 2007 WL 1246411, at *1 (E.D. Wis. Apr. 27, 2007) (holding that the information related to testing was privileged because the testing was performed in the context of seeking and rendering legal advice). "Although the attorney-client privilege is designed to shield attorney-client *communications*, its breadth extends to tests or materials produced in order to facilitate the attorney's giving of legal advice." *Id.*

Respectfully submitted,

/s/ Neal C. Belgam

Neal C. Belgam (#2721)

Enclosures
cc: Clerk of Court (via hand delivery)
All Counsel of Record (via email)

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