IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

GENENTECH, INC.,

Plaintiff,

v.

AMGEN INC.,

Defendant.

Case No. 18-924-CFC

[redacted]

PUBLIC VERSION FILED: October 24, 2019

PLAINTIFF'S LETTER BRIEF IN OPPOSITION TO DEFENDANT'S OCTOBER 4, 2019 DISCOVERY DISPUTE LETTER

Dated: October 11, 2019

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Dear Judge Connolly,

Genentech respectfully requests that the Court deny Amgen's requests set forth in its October 4, 2019 discovery dispute letter.

I. The Court Should Reject Amgen's Eleventh-Hour Attempt To Seek Fact Discovery Regarding A New And Untimely "Derivation" Defense.

Four of Amgen's requests seek untimely fact discovery in connection with an equally untimely "derivation" defense that Amgen raised for the first time last month.[1] Amgen never previously pleaded that defense, nor did it amend its pleadings to include that defense by the April 5, 2019 deadline. Amgen wants to argue that the asserted claims of U.S. Patent Nos. 6,627,196, 7,371,379, and 10,160,811 ("the Dosing Patents") were invented by Dr. Brian Leyland-Jones, one of the physicians who worked on the clinical trials, and not the named inventors. Amgen [redacted]

Now, less than nine weeks before trial, and with new trial counsel for Amgen having recently entered an appearance, Amgen is using the production of a single email authored by Dr. Sharon Baughman, one of the named inventors of the Dosing Patents, as its *sole* excuse to raise this new defense. Dr. Baughman testified at her deposition that [redacted] —and she testified at length and answered dozens of questions on that topic during her deposition. D.I. 397 at 2; Ex. 1 at 132:4-10. In order to avoid a discovery dispute over the email, which included privileged attorney-client communications, Genentech produced a redacted version of the document, reflecting the portion on which Dr. Baughman relied.

The Court should reject Amgen's belated effort to re-open fact discovery in order to fish for evidence to support its untimely "derivation" defense. Amgen has known of the facts underlying inventorship and the work leading up to the patents for months, if not years. With that information in hand, Amgen stopped pursuing many of the discovery requests that it now presses before the Court. For example, Amgen withdrew its notice of deposition of Dr. Leyland-Jones, stopped responding to Genentech's letters with respect to the Roche documents, and waited over a month before following up on Dr. Baughman's email to counsel. The facts on the ground have not changed. Dr. Baughman's redacted email does not reflect any new or previously unknown facts; [redacted] What has changed, apparently, is Amgen's desired trial strategy.

Allowing Amgen to chase its untimely "derivation" defense now would be unfairly prejudicial to Genentech. Genentech has not been given *any* opportunity to develop its own rebuttal fact or expert evidence, and cannot reasonably do so in the weeks remaining before trial, when the parties are deposing experts, preparing pretrial filings, and getting ready for the trial.

Genentech's opening letter brief, which seeks a protective order against Amgen taking Dr. Leyland-Jones's deposition, explains why Amgen's belated effort to take this discovery should be denied. D.I. 397 at 1-3. This response focuses on the specific arguments raised in Amgen's letter.

[1] Genentech intends to file a motion to strike this defense by the relevant deadline.

Unredacted Version of Dr. Baughman's Privileged Email. The Court should reject Amgen's request to compel production of an unredacted version of the email authored by Dr. Baughman, sent to litigation counsel during the pendency of this case, and clearly marked "Attorney-Client Privilege." Ex. 2. During her deposition, Dr. Baughman testified that [redacted] Dr. Baughman was asked [redacted]

After the deposition, Genentech wrote to Amgen to explain that Dr. Baughman's review of a privileged document that she herself wrote to refresh her own recollection is not discoverable, as it could not have impacted her testimony. *See, e.g.*, *In re Rivastigmine Patent Litig.*, 486 F. Supp. 2d 241, 243-44 (S.D.N.Y. 2007); *Sporck v. Peil*, 759 F.2d 312, 318 (3d Cir. 1985). Amgen did not respond for *over a month*, and when it did eventually respond, it took the position that the email was discoverable in its entirety. Ex. 3. To avoid a further dispute, Genentech produced a redacted version of the email containing [redacted]."

Even where a court finds it necessary in the interests of justice to require production of a privileged document relied upon by a witness at a deposition, *only* the portions the witness actually relied on need be produced. *See, e.g.*, *S&A Painting Co., Inc. v. O.W.B. Corp.*, 103 F.R.D. 407 (W.D. Pa. 1984) (privilege only waived as to portions actually referred to during deposition); *Valvoline Instant Oil Change Franchising v. RFG Oil, Inc.*, 2014 WL 12026073 (S.D. Cal. May 20, 2014) (same); *Adidas Am., Inc. v. TRB Acquisitions LLC*, 2018 WL 4849312, at *3 (D. Or. Oct. 5, 2018) (same). That is exactly what Genentech did here. Nothing more is required.

Second Deposition of Dr. Baughman. Amgen argues that it is entitled to "continue" Dr. Baughman's deposition, without seeking leave of court, because Amgen's counsel purportedly attempted to unilaterally hold the deposition open. But a party cannot unilaterally hold open a deposition under FRCP 30(a)(2)(A)(ii) or any other applicable rule. *See, e.g.*, *Johnson v. Charps Welding & Fabricating, Inc.*, 2017 WL 9516243, at *14 (D. Minn. Mar. 3, 2017); *Boerste v. Ellis, LLC*, 2019 WL 3225709, at *3 (W.D. Ky. July 17, 2019) ("no case law to support his assertion that he had the ability to unilaterally suspend a deposition and continue it again at a later date").

Amgen also cannot show good cause for a second deposition. Dr. Baughman already testified at length about [redacted] She also testified generally about [redacted]. Ex. 1 at 122:19-123:25; 130:25-131:2.

Amgen mischaracterizes the redacted email in suggesting that it [redacted]

[redacted][2] It does no such thing. The redacted email merely states, at a high level, that [redacted] Dr. Baughman explained [redacted] She explained that [redacted] D.I. 397 at 2. Thus, Dr. Baughman has already explained [redacted]

And, regardless, Amgen counsel had ample opportunity to conduct any follow-up with Dr. Baughman and question her about the extent of Dr. Leyland-Jones' further involvement (if any) in Genentech's work regarding three weekly dosing, but failed to do so. Dr. Baughman's email does not create an excuse for a second deposition.

Waived and Untimely Deposition of Dr. Leyland-Jones. As explained in Genentech's opening letter brief seeking a protective order, Amgen obtained ample discovery on inventorship of the Dosing Patents and on Dr. Leyland-Jones's involvement with the three-weekly dosing regimen and relevant clinical trial. D.I. 397 at 1-2. Moreover, [redacted] Ex. 1 to D.I. 397. Ultimately, Amgen chose to forgo that deposition. There is no excuse for Amgen to seek such a deposition now and, for the reasons above and in Genentech's motion for protective order, Dr. Baughman's redacted email does not provide any such excuse.

Waived and Untimely Request for Roche Documents. Amgen sought these very same documents during fact discovery. Genentech responded on April 12, 2019, and objected to the production of documents from Roche. Ex. 4 at 2. Amgen did not respond *at all* to Genentech's letter. Having sat on its hands for nearly 6 months, Amgen has waived any requests relating to Roche documents on the dosing patents and the BO15935 Clinical Trial. Moreover, the requested documents relate to research and clinical trial work from over 20 years ago. It would be unfair and unduly burdensome to require Genentech to search for those documents weeks before trial.

II. There Are No Non-Privileged Documents Relating To Genentech's Internal Decision-Making On Certain License Agreements And Their Terms.

With respect to Amgen's fifth discovery request, Genentech searched for non-privileged, responsive documents and has not identified any such documents. As Genentech has explained, [redacted] Ex. 5 at 2; Ex. 6 at 2-3; D.I. 222 at 4. There are no documents to produce, and providing a 30(b)(6) witness would be futile. Amgen seeks a privilege log, but many of the relevant discussions occurred during the pendency of this litigation, which the protective order states need not be logged. D.I. 50 at 2(e)(ii). Additionally, as Amgen itself has argued, it would be overly burdensome at this point to generate a log on this issue now, while the trial is just weeks away. Ex. 7 at 1; D.I. 266 at 10, n.5.

[2] Amgen also suggests that the named inventors testified they [redacted] They *did not* testify as such. In the quoted snippets in Amgen's letter, [redacted]

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