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July 3, 2019

VIA CM/ECF & HAND DELIVERY

The Honorable Colm F. Connolly
J. Caleb Boggs Federal Building
844 N. King Street
Wilmington, DE 19801-3555

Re: **Genentech, Inc. v. Amgen Inc., C.A. No. 17-1407-CFC (Consolidated) & Genentech, Inc. v. Amgen Inc., C.A. No. 18-924-CFC**

Dear Judge Connolly:

I write on behalf of Genentech regarding the Court's June 28, 2019 order.

The most efficient course is to hear live expert testimony regarding indefiniteness of the '869 patent during the December 2019 bench trial in the Herceptin case (18-cv-924-CFC). This approach will conserve party and judicial resources because the experts who address indefiniteness will likely also address infringement and Amgen's other invalidity defenses. The Court may evaluate the expert testimony in context of the parties' overall presentations regarding the '869 patent, and avoid duplication of effort where the same evidence may be relevant to infringement and validity.

A separate September 2019 hearing would disrupt an already-compressed expert discovery schedule, and would not streamline the case or save resources.¹ The Herceptin case will be in the midst of expert discovery, having exchanged opening reports on July 26, 2019 and rebuttal reports on September 6, 2019. The Avastin case is also currently scheduled to be in expert discovery at that time. A separate September 2019 hearing would not spare the parties any effort on expert

¹ Indeed, fact discovery is still ongoing in both cases and likely will be for some time, notwithstanding the existing scheduling orders. Amgen has failed to comply with the Court's Order regarding the production of documents within the scope of the privilege waiver related to the '869 patent and has unilaterally cancelled relevant depositions.

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reports and may in fact create additional work by disrupting the current expert discovery schedule.

The possible efficiencies of addressing indefiniteness prior to the December 2019 Herceptin trial do not outweigh the inefficiencies of a separate hearing focused solely on indefiniteness just three months before the Herceptin trial. In *HIP, Inc. v. Hormel Foods Corp.*, 2019 WL 2579266 (D. Del. June 24, 2019), indefiniteness was case-dispositive because there was only one patent-in-suit. Here, however, there are additional patents-in-suit in both cases that would remain regardless of an earlier indefiniteness hearing. Moreover, should the Court reject Amgen's indefiniteness defense, the same witnesses would need to return to address infringement and Amgen's other indefiniteness defenses during the Herceptin trial.

Respectfully Submitted,

/s/ Daniel M. Silver

Daniel M. Silver (#4758)

Word Count: 344

cc: Counsel of record (via CM/ECF and electronic mail)