IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

GENENTECH, INC and CITY OF HOPE, Plaintiffs, v. AMGEN INC., Defendant.	C.A. No. 18-00924-CFC

PLAINTIFFS' REPLY BRIEF IN SUPPORT OF THEIR MOTION TO DISMISS DEFENDANT'S UNENFORCEABILITY COUNTERCLAIMS AND TO STRIKE DEFENDANT'S ELEVENTH AFFIRMATIVE DEFENSE

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TABLE OF CONTENTS

TABLE OF AUTHORITIES

Page(s)

Cases

Statutes

Rules

I. INTRODUCTION

Amgen has not identified any factual dispute that would prevent the Court from disposing of its unenforceability defenses at the pleadings stage. For the '213 patent, Amgen argues that there is a factual dispute as to whether Genentech's statements to the patent examiner constituted permissible attorney argument or improper material misrepresentations. But Amgen's position cannot be reconciled with long-standing Federal Circuit precedent that an applicant's statements concerning the teachings of the prior art cannot, as a matter of law, support a claim of inequitable conduct so long as the patent examiner was capable of assessing the applicant's arguments on her own. Amgen has not pleaded any facts alleging that the patent examiner here was incapable of fully evaluating Genentech's statements concerning the prior art for herself, and Amgen's unenforceability counterclaim for the '213 patent and related Eleventh Affirmative Defense are therefore legally deficient. Indeed, Amgen does not even engage with the many cases dismissing a defendant's unenforceability counterclaims in exactly these circumstances, and the cases that Amgen does discuss only underscore the need to plead facts alleging that the patent examiner was incapable of evaluating the applicant's arguments (which Amgen has failed to do here).

For the remaining seventeen patents-in-suit, pursuant to Federal Rule of Civil Procedure Rule 8(a), Amgen is obligated to plead at least ***some*** facts supporting its counterclaims—and Amgen has pleaded none. Instead, Amgen asserts that there are "a number of ways" in which the patents-in-suit might be unenforceable—for example, based upon the recent or anticipated expiration of certain patents, or decisions in other proceedings concerning the validity of those patents. But Amgen does not dispute that an expired patent remains enforceable against past infringement occurring during the patent's term. And Amgen's speculation about future possible outcomes in other proceedings is not a basis for pleading unenforceability. The Court therefore should also dismiss Amgen's unenforceability counterclaims for the remaining patents-in-suit.

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