


**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

GENENTECH, INC.,)	
)	
Plaintiff,)	
)	
v.)	C.A. No. 18-924-CFC
)	
AMGEN INC.,)	
)	
Defendant.)	PUBLIC VERSION FILED: December 2, 2019
)	
)	

**REPLY BRIEF IN SUPPORT OF GENENTECH’S MOTION TO
STRIKE AMGEN’S ELEVENTH AND TWELFTH AFFIRMATIVE
DEFENSES (AND DISMISS, OR ALTERNATIVELY, STRIKE
ASSOCIATED COUNTERCLAIMS)**

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TABLE OF AUTHORITIES

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Coppola v. Smith,
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Unigene Labs., Inc. v. Apotex, Inc.,
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Virginia Innovation Scis., Inc. v. Samsung Elecs. Co.,
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Fed. R. Civ. P. 16(b)7, 9, 15

Other Authorities

3 James Wm. Moore et al., *Moore’s Federal Practice* § 15.17[6] (3d
ed. 2012)5

INTRODUCTION

Amgen's new defenses should be stricken because Amgen could have pursued discovery into the facts underlying those defenses well before the deadline for amended pleadings and the close of fact discovery.

Amgen essentially seeks to relitigate this Court's prior ruling rejecting Amgen's effort to pursue that discovery. D.I. 395 at 1, 412 at 1. In denying those requests, the Court rightly noted that the individual Amgen contends was an inventor—Dr. Brian Leyland-Jones—was “in [Amgen's] employ. [Amgen] could have issued ... a litany of subpoenas to depose everybody that he said he had conversations with and worked on in connection with his role in the inventorship but [Amgen] didn't do it. So the application [for discovery] is untimely and therefore, it's denied.” *See* Ex. 1 (Oct. 16, 2019 Hearing Tr.) at 207:4-9. The Court likewise rejected Amgen's reliance on an email authored by one of the named inventors—Dr. Sharon Baughman—which Amgen argued suggested Dr. Leyland-Jones conceived of the invention. *Compare* D.I. 412 at 1; Ex. 1 at 204:18-205:2 (“[Genentech's Counsel:] She didn't say he was the inventor. . . THE COURT: I agree with you.”) *with* D.I. 456 at 15. Nor did the Court credit Amgen's assertion that it could not have investigated its defenses until it learned of Dr. Baughman's email or took the deposition of one of Genentech's experts, Dr. Karen Gelmon. *Compare* D.I. 412 at 1-2 *with* D.I. 456 at 17, 19. The Court

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