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April 16, 2017

BY E-FILE AND HAND DELIVERY

The Honorable Gregory M. Sleet
United States District Court of Delaware
844 North King Street
Wilmington, DE 19801

Re: *Genentech, Inc. v. Amgen Inc.*
C.A. No.: 17-165-GMS

Dear Judge Sleet:

We write on behalf of Amgen, Inc. in response to Genentech's letter to the Court dated April 14, 2017. As an initial matter, Genentech did not confer with Amgen prior to submitting its letter, wherein, curiously, it requests that the Court reenter the order of dismissal it has already entered, rearguing points that it already argued during the hearings before the Court.¹ Rather than file an amended Complaint seeking a declaratory judgment of patent infringement within the 45 day period it requested, Genentech produced to Amgen on March 24 its disclosure under 42 U.S.C. § 262(l)(3)(A) ("§ 262(l)(3)(A)"). Accordingly, the parties are moving through the "patent dance" as contemplated under the BPCIA. The Court need not reenter its order of dismissal and this action is now terminated.

As Genentech acknowledges in its letter, the Court ordered the dismissal of this action on March 1, 2017 (D.I. 16; 17, at 27:6-10).

In response to the Court's dismissal and invitation to amend its Complaint to seek declaratory judgment of patent infringement, Genentech's counsel requested 45 days to amend. (D.I. 17, at 31:16-25). As a result, a discussion ensued between the Court and the parties regarding whether, in view of Genentech's request for 45 days to amend, Genentech still needed to address its "patent dance" obligation under § 262(l)(3)(A), which became due on March 24, within Genentech's requested 45 day window for amendment. Genentech's counsel emphasized that he understood that Genentech would need to decide by March 24 whether to comply with its § 262(l)(3)(A) obligation:

¹ Although styled as a "[PROPOSED] Judgment," Genentech's proposal does nothing more than order that the case be dismissed, which the Court already did on March 1.

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THE COURT: But Mr. Gutman is going to, I think, respond that the 24th is still there. What you are essentially asking me to do is, again, make an advisory ruling that somehow, under the circumstances, given your reading of the statute, you need not act by the 24th of March. Mr. Gutman

—

MR. GAFFNEY: Your Honor, I must have been unclear. That's not what I intended to say. I understand that your decision today, with the dismissal of the leave to amend, does not change anything about the March 24th deadline. I have got to deal with that. But that's separate and apart from having to get a new complaint on file. So you can imagine my team is going to be working long hours up until the 24th to evaluate the material we have got. Then after that I need a little bit of time to prepare an amended complaint.

D.I. 17, at 32:1-18.

Genentech failed to inform the Court in its April 14 letter that it elected to provide its disclosure under § 262(l)(3)(A) and continue with the “patent dance” instead of amending its Complaint within the 45 day window it requested.

There is nothing left for the Court to do and it need not entertain Genentech's request to *again* dismiss this action.

Respectfully,

/s/ Melanie K. Sharp

Melanie K. Sharp (No. 2501)

MKS:as

cc: Michael P. Kelly, Esquire (by e-mail)
Daniel M. Silver, Esquire (by e-mail)

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