

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA**

AMGEN INC. and AMGEN MANUFACTURING, LIMITED,)	Civil Action
)	
Plaintiffs,)	No. 17-cv-01235-MRH
)	
v.)	
)	<u>Electronically Filed</u>
MYLAN INC., MYLAN PHARMACEUTICALS INC., MYLAN GMBH and MYLAN N.V.,)	
)	
Defendants.)	

JOINT STATUS REPORT

Pursuant to the Court’s August 4, 2019 Order (ECF No. 278) and July 9, 2019 Order (ECF No. 273), the parties conferred in person on August 9, 2019 regarding whether, given the precedential decision of the U.S. Court of Appeals for the Federal Circuit in *Amgen Inc. v. Coherus BioSciences, Inc.*, 2018-1993 (July 29, 2019), and on what basis, if any, the claims of infringement in this action as to U.S. Patent No. 8,273,707 (“the ’707 Patent”) can proceed in good faith. The parties agree that under the Federal Circuit’s decision in *Amgen v. Coherus* and this Court’s claim constructions (ECF Nos. 171 and 172), Amgen can no longer maintain its claim of infringement against Mylan with respect to the ’707 patent. Accordingly, the parties respectfully submit a Stipulation and [Proposed] Order for Entry of Judgment Regarding U.S. Patent No. 8,273,707, attached as Exhibit A.

In addition, Sandoz filed on July 29, 2019 its response to Amgen’s petition for rehearing en banc in *Amgen, Inc. v. Sandoz Inc.*, Nos. 2018-1551, 2018-1552 (Fed. Cir.). Amgen’s petition remains pending before the Federal Circuit. In light of the pending decision in the *Sandoz* appeal, the recent *Coherus* decision, and for the reasons that Mylan previously raised with the Court, Mylan requests that the Court extend the stay of all pending proceedings, motions, deadlines, and

obligations to engage in discovery in this case an additional 30 days. Amgen does not oppose Mylan's request so long as it does not delay the anticipated trial date, as discussed on the June 10, 2019 call with the Court.

Date: August 9, 2019

Respectfully submitted,

s/ Kent E. Baldauf, Jr.

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Amgen Inc. et al. v. Mylan Inc. et al.,
C.A. No 17-01235 (MRH) (W.D. Pa.)

EXHIBIT A

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA**

AMGEN INC. and AMGEN)	Civil Action
MANUFACTURING, LIMITED,)	
)	No. 17-cv-01235-MRH
Plaintiffs,)	
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v.)	
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MYLAN INC., MYLAN)	
PHARMACEUTICALS INC., MYLAN)	
GMBH and MYLAN N.V.,)	
)	
Defendants.)	

**STIPULATION AND [PROPOSED] ORDER FOR ENTRY
OF JUDGMENT REGARDING U.S. PATENT NO. 8,273,707**

WHEREAS Amgen Inc. and Amgen Manufacturing, Limited (collectively, “Amgen”) filed a complaint against Mylan Inc., Mylan Pharmaceuticals Inc., Mylan GmbH, and Mylan N.V. (collectively, “Mylan”) in the Western District of Pennsylvania on September 22, 2017 (ECF No. 1), and a first amended and supplemental complaint on February 7, 2019 (ECF No. 210), alleging, among other things, infringement of U.S. Patent Number 8,273,707 (the “’707 Patent”);

WHEREAS Mylan has appeared and denied infringement, and Mylan has counterclaimed for declaratory judgment of non-infringement and invalidity of the ’707 Patent (ECF Nos. 27, 220);

WHEREAS Amgen provided its Disclosure of Asserted Claims and Infringement Contentions on March 7, 2018 and its First Amended Disclosure of Asserted Claims and Infringement Contentions on September 20, 2018, asserting that Mylan literally infringes and infringes under the doctrine of equivalents claims 1, 2, 6, 8, 10, and 11 of the ’707 Patent (“Asserted Claims”);

WHEREAS Mylan provided its Non-Infringement Contentions regarding the ’707 Patent and its Invalidity Contentions regarding the ’707 Patent on March 28, 2018;

WHEREAS the Court issued a Claim Construction Order and Claim Construction Opinion construing certain terms of the Asserted Claims on November 20, 2018 (ECF Nos. 171, 172);

WHEREAS Amgen provided its Second Amended Disclosure of Asserted Claims and Infringement Contentions on December 12, 2018 “applying the Court’s claim constructions” and asserting infringement under the doctrine of equivalents of the Asserted Claims of the ’707 Patent;

WHEREAS Mylan provided its Amended Non-Infringement Contentions regarding the ’707 Patent and its Amended Invalidity Contentions regarding the ’707 Patent on January 11, 2019;

WHEREAS Amgen maintains its right to appeal in this action after a final judgment is entered pursuant to 28 U.S.C. §§ 1291 & 1292(c)(2);

WHEREAS on July 29, 2019, the Federal Circuit affirmed the Delaware district court’s judgment of non-infringement in the appeal captioned *Amgen Inc. et al. v. Coherus BioSciences Inc.*, No. 2018-1993 on the ground that “prosecution history estoppel bars Amgen from succeeding on its infringement claim under the doctrine of equivalents” because Amgen “clearly and unmistakably surrendered salt combinations other than the particular combinations recited in the claims [of the ’707 Patent].”

THEREFORE Amgen and Mylan agree that:

1. Amgen and Mylan stipulate that, under the Federal Circuit decision in *Amgen Inc. et al. v. Coherus BioSciences Inc.*, No. 2018-1993, precluding application of the doctrine of equivalents, Mylan does not infringe the Asserted Claims of the ’707 Patent within the meaning of any provision of 35 U.S.C. § 271 in light of the Court’s Claim Construction Order and Claim Construction Opinion (ECF Nos. 171, 172).

2. Amgen and Mylan stipulate that the Court may enter a judgment of non-infringement in favor of Mylan and against Amgen for the First and Second Counts of Amgen’s

First Amended and Supplemental Complaint filed on February 7, 2019 (ECF No. 210) and the First Count of Mylan's Answer, Defenses and Counterclaims to First Amended and Supplemental Complaint (ECF No. 220) filed on February 28, 2019.

3. Amgen and Mylan stipulate that Mylan's Second Count of Mylan's Answer, Defenses and Counterclaims to First Amended and Supplemental Complaint (ECF No. 220) filed on February 28, 2019 for a declaratory judgment of invalidity of the '707 Patent will be dismissed without prejudice and that Mylan will be allowed to assert its Second Count in the event this matter is remanded for further consideration following any appeal.

4. Amgen maintains its right to seek appeal of any final judgment regarding the '707 Patent in this litigation (including underlying decisions such as the Claim Construction Order and Claim Construction Opinion (ECF Nos. 171, 172)) pursuant to 28 U.S.C. §§ 1291 & 1292(c)(2).

5. Mylan maintains its right to seek fees or costs regarding the '707 Patent in this litigation.

6. No party will conduct any further discovery or pretrial activities related to allegations of liability or damages regarding the '707 Patent, including any activity related to Mylan's alleged defense and counterclaim that the '707 Patent is invalid.

7. This stipulation has no impact on the claims, defenses, or prayer for relief of either party related to the validity of, infringement of, or relief available for the '997 Patent.

Date: August 9, 2019

Respectfully submitted,

s/ Kent E. Baldauf, Jr.

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SO ORDERED this _____ day of _____, 2019.

Chief United States District Judge