

February 19, 2020

***Via CM/ECF***

Hon. Peter R. Marksteiner  
Circuit Executive & Clerk of Court  
United States Court of Appeals  
for the Federal Circuit  
717 Madison Place, NW  
Room 401  
Washington, DC 20005-7700

**Re: Notice of Supplemental Authority in *Amgen, Inc. v. Watson Laboratories, Inc.* (Fed. Cir. Nos. 2019-1650, -1770)**

Dear Mr. Marksteiner:

Pursuant to Appellate Rule 28(j), Watson Laboratories, Inc. submits *Amgen, Inc. v. Amneal Pharmaceuticals, LLC*, No. 18-2414 (Fed. Cir. Jan. 7, 2020) as supplemental authority.

This appeal involves the same appellant and same patents as *Amneal*, but different accused products. At trial, the district court held that Watson did not infringe Amgen’s patents under the doctrine of equivalents. Opposing Amgen’s appeal, Watson demonstrated that the district court’s non-infringement ruling was correct, and explained that this Court could also affirm on the alternative ground of prosecution history estoppel (Watson Resp. Br. at 36–57)—an issue on which the district court granted judgment of non-infringement as to defendant-appellee Piramal, but did not reach as to Watson.

In *Amneal*, this Court affirmed the district court’s judgment that Amgen’s claim of infringement under the doctrine of equivalents against appellee Piramal was barred by prosecution history estoppel, holding that “Amgen surrendered equivalent but unclaimed binders and disintegrants.” Slip op. at 24. That surrender also forecloses Amgen’s infringement claims against Watson, which were also based on an “equivalent but unclaimed binder.” *Id.* Amgen has never attempted to

explain why the estoppel that bars its claims against Piramal does not also bar its claims against Watson. Nor could it do so: there is no meaningful difference between the claims.

The *Amneal* court also reversed the district court's claim construction ruling, resulting in vacatur of the non-infringement judgment in favor of appellee Amneal. As Watson explained in its brief, however, the claim-construction error has no effect on the judgment in favor of Watson. The district court's construction erred by excluding from the patent's coverage "formulations with additional unlisted ingredients." Slip op. at 19. Because Amgen has conceded that "the district court's noninfringement judgment as to Watson ... did not involve any unlisted disintegrant" (Amgen Op. Br. at 52), this Court's reversal of the claim construction has no effect on Watson's judgment of non-infringement. That judgment should be affirmed.

Respectfully Submitted,

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## CERTIFICATE OF SERVICE

I hereby certify that on February 19, 2020, the foregoing document was electronically filed with the Clerk of the Court for the United States Court of Appeals for the Federal Circuit using the appellate CM/ECF system. All participants are registered CM/ECF users and service will be accomplished by the appellate CM/ECF system.

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