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February 27, 2020

By CM/ECF

Hon. Peter R. Marksteiner
Clerk of Court
U.S. Court of Appeals for the Federal Circuit
717 Madison Place, NW
Washington, DC 20439

Re: *Amgen Inc. v. Watson Laboratories, Inc.*, Nos. 2019-1650, 2019-1770

Dear Col. Marksteiner:

Under FRAP 28(j), Amgen responds to Watson's submission of *Amgen Inc. v. Amneal Pharmaceuticals, LLC*, No. 18-2414 (Fed. Cir. Jan. 7, 2020) (ECF No. 107).

Watson's letter only reaffirms that its underlying infringement dispute with Amgen is not moot. Watson has a different accused product than Piramal, and Watson admitted infringement to settle its own dispute *after* the district court ruled in Piramal's favor and submitted a consent judgment reflecting the same. As Watson understood, therefore, a Piramal ruling does not shield Watson. The Court should direct entry of the consent judgment to fully effectuate the Amgen/Watson settlement agreement.

Even if the Court considers the merits, Watson's supplemental arguments fail. First, *Amneal* does *not* categorically hold, as Watson contends, that "Amgen surrendered equivalent but unclaimed binders and disintegrants." As explained in Amgen's pending petition for rehearing, that statement merely reflects *the presumption* that a patentee surrenders the territory between the narrowed and original claim, not that Amgen did in fact surrender all such territory. Pet. for Reh'g at 3, 11-12 (ECF No. 120). At minimum, Amgen's petition requests clarity to prevent exactly the kind of over-reading of *Amneal* that Watson now advocates. The Court should not enter a ruling on prosecution history estoppel that the district court never addressed as to Watson here. See ECF No. 78 at 30 (citing APPX44).

Second, *Amneal's* reasoning is irrelevant to Watson. *Amneal* concluded that Amgen was estopped from claiming Piramal's starch as a binder, because that was "a use taught by [the prior art] Creekmore and Hsu," the claim amendment was made to overcome the prior art, and such an amendment cannot be tangential. Slip op. at 24-25. Amgen's rehearing petition takes issue with

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that holding, but, regardless, it has no applicability to Watson: Watson's equivalent disintegrant (L-HPC) is *not* taught as a disintegrant in the cited prior art.

Finally, Watson contends that *Amneal's* claim construction reversal is inapplicable, but as Amgen explained previously, the erroneous focus on listed disintegrants there narrowed the district court's view of Watson's product and provides an independent basis for vacatur. *See* ECF No. 78 at 31.

Respectfully submitted,

/s/ Bradford J. Badke
Bradford J. Badke

cc: All counsel of record (by ECF)

CERTIFICATE OF SERVICE

I hereby certify that on this 27th day of February, 2020, I caused the foregoing document to be electronically filed with the Clerk of the Court for the U.S. Court of Appeals for the Federal Circuit using the CM/ECF System, which will send notice of such filing to all registered CM/ECF users.

/s/ Bradford J. Badke
Bradford J. Badke