

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MERCK SHARP & DOHME LLC,  
Petitioner,

v.

THE JOHNS HOPKINS UNIVERSITY,  
Patent Owner.

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IPR2024-00240  
Patent 11,591,393 B2

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Before DEBORAH KATZ, ROBERT A. POLLOCK, and  
DEVON ZASTROW NEWMAN, *Administrative Patent Judges*.

KATZ, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
37 C.F.R. § 42.5

On November 20, 2024, Petitioner contacted the Board asking that Patent Owner be compelled to make a named inventor, Dr. Pardoll, available for a deposition. (*See* Ex. 3007.) Patent Owner opposes. (*See id.*)

A conference call was held on December 2, 2024, to discuss the issue. Preston Ratliff, Daniel Zeilberger, and Jessica Stauring were present for Petitioner (“Merck”). Nicholas Stephens, Grace J. Kim, and Casey Kraning were present for Patent Owner (“JHU”). Judges Katz, Newman, Pollock, Snedden, and Mitchell<sup>1</sup> were present for the Board, as well as Patent Attorney Wood.

Petitioner argues that throughout its Patent Owner’s Response, Petitioner relies on a declaration executed by Dr. Pardoll and submitted to the Patent Office during prosecution of the challenged patent. (*See* Ex. 3007 (citing Paper 40 at 42–43, 51, 52, 73).) Specifically, Petitioner points to the citations of Exhibit 1002, pages 205–206 in the Patent Owner Response and to the citations to Dr. Pardoll’s declaration within Dr. Lonberg’s declaration. (*See id.* (citing Ex. 2072 ¶ 73, which cites Ex. 1002 pp. 199–210).) Petitioner argues that because Patent Owner seeks the Board’s determination that Dr. Pardoll’s cited testimony deserves weight in regard to issues in dispute between the parties, Petitioner should have an opportunity to cross-examine Dr. Pardoll in a deposition as part of routine discovery. (*See* Ex. 3007.)

Patent Owner opposes Petitioner’s request for compelled testimony, arguing that this deposition would not be routine discovery. Patent Owner argues that 37 C.F.R. § 42.51(b)(1) provides only for “[c]ross examination of affidavit

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<sup>1</sup> Judges Snedden and Mitchell were present because during the conference call other issues pertaining to other proceedings with panels that include Judges Snedden and Mitchell were discussed.

testimony prepared for the proceeding,” whereas the declaration of Dr. Pardoll on which Patent Owner relies was prepared for prosecution, not for this proceeding. (*See id.*) Patent Owner further argues that the cited portions of Dr. Pardoll’s testimony are “largely cumulative to other evidence in the record and recite facts not in dispute.” (Ex. 3007.) Patent Owner argues that Petitioner has not explained why a deposition of Dr. Pardoll is in the interests of justice or warranting additional discovery as discussed in *Garmin Int’l v. Couzzo Speed Techs, LLC*, IPR2012-00001, Paper 26 (March 5, 2013) (*See id.*)

During the conference call, both parties had an opportunity to be heard on the merits of Petitioner’s request. We are persuaded that cross-examination of Dr. Pardoll on the subject matter to which he testified during prosecution that is cited by Patent Owner is warranted. Even if a deposition of Dr. Pardoll is not routine discovery, we are persuaded that it is in the interests of justice because Patent Owner relies on Dr. Pardoll’s opinions to establish certain facts currently disputed by the parties. *See* 35 U.S.C. § 316(a)(5) (providing for discovery of relevant evidence limited to “what is otherwise necessary in the interest of justice . . .”); *see* 37 C.F.R. § 42.51(b)(2) (“Where the parties fail to agree, a party may move for additional discovery. The moving party must show that such additional discovery is in the interests of justice, . . . . The Board may specify conditions for such additional discovery.”).

Regardless of the other support Patent Owner cites for such facts, it is in the interests of justice to allow Petitioner to question a witness on his or her opinions about facts Patent Owner seeks to establish by citing to the sworn testimony of that witness. Without such an opportunity, Petitioner would be prejudiced in challenging such facts and the Board would be limited in evaluating the veracity of such facts. We agree with Petitioner that the best way to challenge Dr. Pardoll’s

opinions and testimony is by cross-examination. *See, e.g., Garmin*, at 6 (“Ability To Generate Equivalent Information By Other Means”). Patent Owner fails to suggest another means to do so.

The declaration of Dr. Pardoll on which Patent Owner relies was not prepared for this proceeding and it was included along with the file history submitted as evidence by Petitioner, but Patent Owner chose to cite certain portions of the declaration in support of specific, disputed facts. Thus, Patent Owner must present Dr. Pardoll for cross-examination on this testimony.

Accordingly,

It is ORDERED that Patent Owner must present Dr. Pardoll for a deposition limited to the testimony Patent Owner cites in the Patent Owner’s Response (including Exhibit 1002, pages 199–210), as well as Dr. Pardoll’s qualifications, preparation, and other relevant background matters;

It is further ORDERED that the deposition be no longer than three (3) hours, with an additional one (1) hour for Patent Owner to elicit redirect testimony;

It is further ORDERED that no other discovery is authorized.

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