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Your Honors,

Petitioner Merck writes to respectfully request the Board compel Patent Owner JHU to make its named inventor Dr. Drew Pardoll available for deposition. Dr. Pardoll submitted a declaration to the Patent Office during prosecution of the challenged '393 patent. JHU relies upon certain statements and opinions contained in Dr. Pardoll's declaration throughout its POR and the accompanying Declaration of Dr. Nils Lonberg that JHU submitted with its POR. (See POR at 42-43, 51-52, 73; Lonberg Declaration (Ex. 2072) ¶73.) Because JHU would like the Board to accord weight to those statements and opinions of Dr. Pardoll, Merck seeks his deposition. JHU, however, refuses to make Dr. Pardoll available for deposition, stating it is not required to do so and that it was Merck that first introduced his declaration into the record. While Merck cites Dr. Pardoll's declaration in its Petition as one would expect given that it is part of the challenged patent's prosecution history, JHU relies on portions of his declaration in the same way it does for its other POR declarants. (See POR at 42-43, 51-52, 73.)

JHU should not be permitted to refuse Merck the opportunity to depose Dr. Pardoll while at the same time insisting that the statements and opinions relied upon by JHU be accorded weight by the Board. Accordingly, Merck's request constitutes routine discovery under 37 CFR § 42.51(b)(1). In the alternative, Merck requests that the Board allow Merck to file a motion for additional discovery under 37 CFR § 42.51(b)(2) or confirm that it will accord no weight to JHU's arguments relying on statements and opinions contained in Dr. Pardoll's declaration if JHU chooses to not make him available for deposition. See, e.g., *Amneal Pharms., LLC v. Endo Pharms. Inc.*, IPR2014-00360, Paper 39, at 4 (P.T.A.B. Dec. 3, 2014); *Ikaria, Inc. v. Geno LLC*, IPR2013-00253, Paper 20, at 2 (P.T.A.B. April 1, 2014); see also *Praxair Dist., Inc. v. INO Theras. LLC*, IPR2015-00529, Paper 33, at 2 (P.T.A.B. Dec. 22, 2015).

The Parties have met and conferred regarding Merck's request and JHU opposes. JHU's position is reflected below:

Merck's email is argumentative and highly improper. See, e.g., *Hewlett-Packard Co. v. U.S. Phillips Corp.*, IPR2015-01505, Paper 15 (PTAB Dec. 16, 2015) ("The parties are reminded that 37 C.F.R. § 42.20(b) expressly prohibits the filing of a motion without prior authorization. Substantive e-mails to the Board merely act as an attempt to circumvent this rule."). JHU therefore requests a conference with the Board to rebut Merck's mischaracterization of the record and of the parties' meet and confers. At the outset, JHU disagrees that Merck's request constitutes routine discovery, as the rule that Merck relies upon, 37 CFR § 42.51(b)(1), was amended after the Board's decision in *Ikaria v. Geno* to clarify that only "cross examination of affidavit testimony **prepared for the proceeding** is authorized[.]" It is undisputed that Dr. Pardoll's declaration was submitted during prosecution and thus was not prepared for IPR2024-00240. Further, despite JHU's request, to date Merck has not explained to JHU why Dr. Pardoll's deposition is in the interests of justice warranting additional discovery, specifically how the *Garmin* factors are allegedly met. As JHU told Merck during meet and confer, JHU believes that the Board can determine on its own what weight to accord to Dr. Pardoll's declaration without this unnecessary motion practice. Additionally, JHU disagrees with Merck's characterization of JHU's limited citations to Dr. Pardoll's declaration, which are largely cumulative to other evidence in the record and recite facts that are not in dispute.

Respectfully,
Daniel Zeilberger
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