

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCK SHARP & DOHME LLC,
Petitioner,

v.

THE JOHNS HOPKINS UNIVERSITY,
Patent Owner.

IPR2024-00240 (Patent 11,591,393 B2)
IPR2024-00622 (Patent 10,934,356 B2)
IPR2024-00623 (Patent 11,325,974 B2)
IPR2024-00624 (Patent 11,325,975 B2)
IPR2024-00625 (Patent 11,339,219 B2)
IPR2024-00647 (Patent 11,649,287 B2)
IPR2024-00648 (Patent 11,643,462 B2)
IPR2024-00649 (Patent 11,629,187 B2)
IPR2024-00650 (Patent 11,634,491 B2)¹

Before DEBORAH KATZ, SHERIDAN K. SNEDDEN,
SUSAN L. C. MITCHELL, ROBERT A. POLLOCK, and
DEVON ZASTROW NEWMAN, *Administrative Patent Judges*.²

¹ This Order addresses issues common to each of these proceedings and we use this caption for efficiency. The parties may not use this style heading in any subsequent papers without authorization.

² This is not an extended panel.

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KATZ, *Administrative Patent Judge*.

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

On October 30, 2024, Patent Owner contacted the Board requesting a conference call regarding changes to the schedules in related *inter partes* review procedures and increased word counts in the briefs. (Ex. 3006.³) Petitioner opposes Patent Owner's proposals. (*See id.*)

A conference call was held on December 2, 2024, to discuss the issues. Preston Ratliff, Daniel Zeilberger, and Jessica Stauring were present for Petitioner. Nicholas Stephens, Grace J. Kim, and Dr. Casey M. Kraning were present for Patent Owner. Judges Katz, Newman, Pollock, Snedden, and Mitchell were present for the Board, as well as Patent Attorney Wood.

Schedule

In general, Patent Owner proposes that the nine related cases be divided into three groups based on asserted commonalities in the claimed subject matter of the challenged patents. (*See id.*) Patent Owner proposes that the three groups would

³ We refer to the exhibit in IPR2024-00240. The same exhibit is in the other cases.

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then proceed on different schedules, with separate oral arguments for each group, which Patent Owner argues is “warranted here under the APA and in accordance with due process due to the number of patents at issue and substantive differences between the claimed subject matter in each group.” (*Id.*)

Initially, Patent Owner proposed “aligning the schedule in IPR2024-00647 with the schedule in IPR2024-00240 due to the high degree of substantive similarities in the claims and the Petition grounds in these proceedings, which would enable a consolidated oral hearing for the ’287 and ’393 proceedings on the same day.” (*Id.*) However, during the call, Patent Owner withdrew this proposal, due to the late date in the ’647 proceeding.

We are not persuaded that any change in the schedule of any of the related proceedings is necessary to provide a fair opportunity for the parties to address the issues raised regarding all nine patents. Although some issues differ between Patent Owner’s grouping of proceedings, many issues are similar or the same. As Petitioner argued, the same reference, the “MSI-H Study Record,” is central to each of the challenges to the claims in each of the proceedings. Patent Owner could not articulate on the conference call what amount of time it required to argue these issues, nor why it required three different days of oral argument.

We are concerned that separating the oral arguments over three different sessions would invite significant repetition of argument and potential piecemeal consideration. Instead, it will likely be helpful to the Board in reaching an

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informed decision in each case to view all of the issues together in order to ensure that the final decisions are compatible. We are not persuaded that further separating the oral arguments on the significantly overlapping issues presented by the nine inter partes reviews will promote the “just, speedy, and inexpensive” resolution of all of the proceedings. *See* 37 C.F.R. § 42.1(b) (providing the policy of “secur[ing] the just, speedy, and inexpensive resolution of every proceeding.”)

Patent Owner argues that the burden of numerous declarations and corresponding depositions for each of nine cases is significant. We note that under the current schedules, the oral argument for IPR2024-00240 is approximately three months earlier than the oral arguments for the other cases and, therefore, will provide the parties with some ability to distribute the burden. We encourage the parties to continue work together to consolidate depositions across the different cases as appropriate. (*See* Ex. 3006 (Petitioner reporting that “[t]he Parties have been working cooperatively to address any adjustments to the schedule for briefing deadlines, and have reached agreement regarding streamlining of depositions, cross-use of deposition transcripts, and discovery.”).)

Word Counts

Patent Owner requests that the word count limits for the Patent Owner Responses and Petitioner Replies be increased by 25%, consistent with the increases previously authorized in IPR2024-00240. (*See* Ex. 3006; *see* IPR2024-00240, Paper 36.) Petitioner does not believe that an increase in the word count

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limit is necessary, but understands that the increase was authorized in the first of the nine related proceedings. (*See* Ex. 3006.)

In order to keep the nine proceedings consistent and for the reasons provided in IPR2024-00240, we grant Patent Owner's request to increase the respective word count limits by 25%.

Order

Accordingly,

It is ORDERED that no schedule changes are authorized in the cases;

It is further ORDERED that the word count limit of the Patent Owner Response to the Petition in each of the proceedings is increased by 3500 words to 17,500 words total in each proceeding;

It is further ORDERED that the word count limit of Petitioner's Reply to the Patent Owner Response in each of the proceedings is increased by 1400 words to 7,000 words total in each proceeding;

It is further ORDERED that no other changes to word count limits or briefing is authorized.

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