

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

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 February 28, 2025, Patent Owner contacted the Board seeking authorization to file new Exhibit 2410 with its sur-reply, which was due the same day. (*See* Ex. 3009.) Patent Owner, however, had a chance to present a full response, with evidence, to the Petition, and at this late point in the proceeding, fails to explain adequately why Exhibit 2410 is now necessary. *See* 37 C.F.R. § 42.23(b) (“A sur-reply may only respond to arguments raised in the corresponding reply and may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness.”). At best, Patent Owner contends the “exhibit is appropriate to provide a full record of the deposition and to provide context for the Board to evaluate Dr. Oberstein’s testimony.” Ex. 3009. We also find it troubling that Patent Owner fails to explain why it delayed its request until the day the Sur-Reply was due.

Patent Owner references *Ascend Performance Materials Operations LLC v. Samsung SDI Co., Ltd.*, IPR2020-00349, Paper 53 at 11-13 (P.T.A.B. July 15, 2021), as providing “guidance,” but that opinion is neither precedential nor informative. It is not binding on the panel under the circumstances of this case.

Because Patent Owner does not have persuaded us that Exhibit 2410 is necessary to our evaluation of the issues before us in this proceeding, we DENY Patent Owner’s request. Because it was filed without authorization, Exhibit 2410 will be expunged from the record. Reference to Exhibit 2410 in the Patent Owner’s Sur-Reply will not be considered.

ORDER

Accordingly, it is

ORDERED that Exhibit 2410 be expunged from the record.

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