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Subject: RE: IPR2024-00240 - Request for authorization for sur-reply exhibit filing
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Attachments: [image001.png](#)

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Your Honors,

Patent Owner shared a draft email to the Board with Petitioner, but then materially changed its email after Petitioner provided its position for inclusion in Patent Owner's email. For example, Patent Owner changed the number of exhibits it is proposing for entry into the record with its sur-reply and well as its comments regarding the same. As such, Petitioner is compelled to provide the following updated position regarding Patent Owner's request:

On Wednesday, February 26 afternoon – about 48 hours ago – Patent Owner first raised this issue of submitting new exhibits with its sur-reply. At that time and earlier today, Patent Owner stated that three new exhibits (Ex2408, Ex2409, and Ex2410) should be entered into the record. Now, it appears that Patent Owner believes that at least one new exhibit (Ex2410) should be entered into the record with its sur-reply. Petitioner opposes Patent Owner's request. 37 C.F.R. 42.23(b) provides that "[a] sur-reply ... may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness." In addition, the proposed new JHU exhibit (Ex2410) as well as two additional new JHU exhibits (Ex2408 and Ex2409) that JHU stated it wanted to include with its sur-reply do not provide context for Dr. Oberstein's deposition as he "repeatedly testified that he had not seen the exhibits." See *Netflix Inc. v. DivX, LLC*, IPR2020-00511, Paper 46 (Aug. 13, 2021). It appears that Patent Owner intends to rely on at least new exhibit 2410 to make new argument. Petitioner objects to such new argument as improper and based on incomplete evidence that neglects to reveal other related information. If the Board authorizes Patent Owner's request, Petitioner respectfully requests that Patent Owner be required to file additional materials that Petitioner has identified to Patent Owner in the context of Patent Owner's request and that are inconsistent with Patent Owner's apparent position based on the documents Patent Owner wants to submit. Further, the additional materials were known to Patent Owner long before the time it filed its POR and never once did Patent Owner question the source of these materials or what they show.

Respectfully,
Preston K. Ratliff II
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**PAUL
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Subject: [EXT] IPR2024-00240 - Request for authorization for sur-reply exhibit filing

Your Honors,

Patent Owner, the Johns Hopkins University, writes to request the Board's authorization to file with its sur-reply today one exhibit marked at the deposition of Petitioner Merck's rebuttal declarant, Dr. Paul Oberstein. This exhibit (EX2410) is an amendment to an agreement between the parties and is therefore already in Petitioner's possession. JHU submits that this exhibit is appropriate to provide a full record of the deposition and to provide context for the Board to evaluate Dr. Oberstein's testimony. See *Ascend*

Performance Materials Operations LLC v. Samsung SDI Co., Ltd., IPR2020-00349, Paper 53 at 11-13 (P.T.A.B. July 15, 2021). JHU's request is inspired by the desire to provide notice to the Board and Petitioner Merck of its proposal to submit this additional exhibit with its sur-reply as part of the deposition record, but JHU acknowledges that Merck would retain the ability to object to any exhibit submitted with the sur-reply in accordance with ordinary process after the sur-reply is filed.

The parties have conferred extensively by email. Petitioner Merck requested that its position be provided as follows:

Petitioner opposes Patent Owner's request. 37 C.F.R. 42.23(b) provides that "[a] sur-reply ... may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness." The exhibits also do not provide context for Dr. Oberstein's deposition as he "repeatedly testified that he had not seen the exhibits." See *Netflix Inc. v. DivX, LLC*, IPR2020-00511, Paper 46 (Aug. 13, 2021). It appears that Patent Owner intends to rely on the new exhibits to make new argument. Petitioner objects to such new argument as improper and based on incomplete evidence that neglects to reveal other related information. If the Board authorizes Patent Owner's request, Petitioner respectfully requests that Patent Owner be required to file additional materials that Petitioner has identified to Patent Owner in the context of Patent Owner's request and that are inconsistent with Patent Owner's apparent position based on the documents Patent Owner wants to submit.

Patent Owner JHU responds that Merck has mischaracterized JHU's position. JHU confirmed to Merck that JHU intends to make no new argument with this document. Further, JHU is unaware of any process for JHU to file an exhibit on behalf of Merck. JHU requested guidance from Merck on such process, and Merck declined to answer. We have reviewed Merck's proposed exhibit. We disagree that it reveals any inconsistency in JHU's position, and moreover believe that, if at all, it should have been submitted with Merck's Reply. Further, we also requested that Merck identify the source of the document and basis for why they assert these were payments made in conjunction with JHU's clinical trial, but Merck declined to respond.

JHU recognizes and apologize for the lateness of this request as we have been engaged in negotiations with Merck on this issue for several days. Absent further instruction from the Board by 6pm ET today, JHU intends to proceed with filing the additional exhibit with its sur-reply today based on our belief that the present facts are consistent with the guidance in *Ascend*. As noted above, JHU acknowledges that Merck would retain the ability to object to any exhibit submitted with the sur-reply in accordance with ordinary process after the sur-reply is filed.

Respectfully submitted,
Casey Kraning, admitted *pro hac vice*

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Pronouns: she | her | hers

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