UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCK SHARP & DOHME LLC,
Petitioner

v.

POGONA, LLC,
Patent Owner.

Case No. IPR2026-00374
U.S. Patent No. 11,058,757

MERCK SHARP & DOHME LLC'S MOTION FOR JOINDER

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Petitioner Merck Sharp & Dohme LLC ("Merck") respectfully submits concurrently herewith a Petition for *inter partes* review ("IPR") of U.S. Patent No. 11,058,757 ("Petition") based on grounds identical to those that formed the basis for pending IPR proceeding in *Pfizer Inc. v. Pogona, LLC*, IPR2026-00189 (the "Pfizer IPR"). *See* Paper 16 (Institution of *Inter Partes* Review) (May 26, 2026), at 2. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.22, Merck respectfully requests and moves that its Petition be instituted and joined with the Pfizer IPR, for the exact same reasons previously considered by the Patent Trial and Appeal Board ("Board"), on the exact same trial schedule.

Merck submits that joinder is appropriate because: (a) Merck does not seek to add to or alter the grounds of unpatentability that the Board has already instituted in the Pfizer IPR; (b) joinder will have no impact on the existing schedule in the Pfizer IPR; and (c) joinder will promote the efficient resolution of issues related to U.S. Patent No. 11,058,757 ("the '757 patent"), specifically whether the '757 patent is anticipated and/or obvious over well-known prior art.

Absent joinder, Merck may be prejudiced because it has a significant interest in the underlying patentability determination at issue in the Pfizer IPR given the potential impact on litigation proceedings between Merck and Pogona, LLC ("Patent

Owner") in which Patent Owner has alleged infringement of the '757 patent against Merck.

Joinder would protect Merck's interests without affecting the scheduling or complexity of the pending Pfizer IPR, and without prejudice to Pfizer or Patent Owner. If joined, Merck will assume an understudy role in the IPR proceeding unless the Pfizer Petitioner ceases to participate in the instituted IPR. Thus, the proposed joinder will neither unduly complicate the IPR nor delay its schedule. As such, joinder will promote judicial efficiency in determining patentability in the IPR without prejudice to Patent Owner.

Merck's present motion for joinder is timely under 37 C.F.R. § 42.122(b) because it is submitted within one month of May 26, 2026, the date on which the Pfizer IPR was instituted. Accordingly, Merck respectfully requests that the Board grant this Motion for Joinder.

II. STATEMENT OF MATERIAL FACTS

1. Merck and Patent Owner are currently engaged in related district court litigation in *Pogona, LLC v. Merck Sharp & Dohme LLC*, No. 2:25-cv-15294-BRM-JBC (D.N.J.) (filed September 5, 2025) concerning the '757 patent.

2. On December 23, 2025, Pfizer Inc. filed a petition for *inter partes* review (IPR2026-00189) requesting cancellation of claims 1–19 of the '757 patent. *See* IPR2026-00189, Paper 3.

3. On January 26, 2026, Merck filed a petition for *inter partes* review (IPR2026-00221, the "Merck IPR") requesting cancellation of claims 1–19 of the '757 patent relying on different primary prior art references and different grounds. IPR2026-00221, Paper 2.

4. On May 19, 2026, the Director issued a Notice of Decisions on Institution, denying the Merck IPR on discretionary and non-merits considerations and referring the Pfizer IPR petition to be reviewed for merits and non-discretionary considerations. IPR2026-00189, Paper 15; IPR2026-00221, Paper 14.

5. On May 26, 2026, the Director granted institution of the Pfizer IPR. IPR2026-00189, Paper 16.

6. On June 1, 2026, contemporaneously with this Motion, Petitioner filed a Petition for *inter partes* review (IPR2026-00374) ("Merck's Petition") requesting cancellation of claims 1–19 of the '757 patent, which is substantively identical to the Pfizer IPR.

III. ANALYSIS OF THE PRECISE RELIEF REQUESTED

A. Legal Standard

The Board has the authority under 35 U.S.C. § 315(c) to join a properly filed *inter partes* review petition. *See* 35 U.S.C. § 315(c). A motion for joinder must be filed no later than one month after the institution date of the original *inter partes* review for which joinder is requested. *See* 37 C.F.R. § 42.122(b). In deciding

whether to exercise its discretion and permit joinder, the Board considers factors, including: (1) the reasons why joinder is appropriate; (2) whether the new petition presents any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15, at 4 (PTAB Apr. 24, 2013).

B. Merck's Motion for Joinder is Timely

This Motion for Joinder is timely because it is filed within one month of the May 26, 2026 institution decision of the Pfizer IPR. *See* 37 C.F.R. § 42.122(b).

C. Joinder is Appropriate

Joinder is appropriate in this case because it is the most expedient way to secure the just, speedy, and inexpensive resolution of the two related proceedings. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b). Merck's Petition is identical with respect to the grounds instituted in the Pfizer IPR—it relies on the same grounds and expert testimony. The only difference between Merck's Petition and the petition filed in the Pfizer IPR, aside from change of the names of the parties, is in the introductory paragraph and sections regarding Real Party-In-Interest, Related Matters, and Counsel, which have been appropriately updated.

Joinder would have no impact on the IPR, the schedule would not be affected, no additional briefing or discovery would be required, and no additional burdens

would be placed on any party or the PTAB, as detailed below. Given the duplicative nature of these petitions and Merck's significant interest in the underlying validity determination at issue, joinder of the related proceedings is appropriate and conserves Board resources.

1. No New Grounds of Unpatentability

Merck's Petition is identical to the Pfizer IPR petition, which the Board has instituted. It does not assert any new grounds of unpatentability and challenges the same claims (1–19) of the '757 patent based on the same arguments and analysis, prior art, evidence (including expert declarations), and eight grounds of unpatentability as the Pfizer IPR.

2. No Impact on the Schedule for the Existing IPR Proceeding

Because Merck's Petition raises no new grounds of unpatentability, and a Scheduling Order has not yet been established for the Pfizer IPR, joinder would have no impact on the schedule of the IPR. *See LG Electronics, Inc. v. Memory Integrity, LLC.*, IPR2015-01353, Paper 11, at 6 (PTAB Oct. 15, 2015) (granting IPR and motion for joinder where "joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]"). Merck will adhere to all applicable deadlines set in the Scheduling Order for the Pfizer IPR once issued.

As discussed further below, Merck will merely be an understudy in these proceedings. If the IPR is terminated with respect to the Pfizer Petitioner, then Merck intends to step in for the dismissed petitioner and materially participate in the joined proceedings based on the same grounds of unpatentability raised in the Pfizer IPR without adding any new art or grounds. Accordingly, for the reasons stated above, joinder of Merck to the Pfizer IPR will not affect the Board's ability to complete its review and final decision within the statutory time limits under 35 U.S.C. § 316(a)(11) and 37 C.F.R. § 42.100(c).

3. Briefing and Discovery Will be Simplified

Merck agrees that, if joined, the following conditions will apply so long as Pfizer remains an active party, as previously approved by the Board in other joinder circumstances:

(a) all filings by Merck in the joined proceeding will be consolidated with the filings of Pfizer, unless a filing solely concerns issues that do not involve Pfizer;

(b) Merck will not be permitted to raise any new grounds not instituted by the Board in the IPR, or introduce any argument not already introduced;

(c) With regard to taking of testimony, Merck will abide by 37 C.F.R. § 42.53 or any agreement between the Patent Owner and Pfizer. *See Mylan Pharms. Inc. v. Novartis AG*, IPR2015-00268, Paper 17, at 5–6 (PTAB Apr. 10, 2015) (finding the same proposed limitations "are consistent with the 'understudy' role that Petitioner

agrees to assume, as well as Petitioner's assertion that its presence would not require introducing any additional arguments, briefing, or discovery"). Merck will also accept any additional conditions the Board deems appropriate.

4. No Prejudice to Patent Owner

Joinder of Merck to the Pfizer IPR will not create any additional burden on the Patent Owner. The Patent Owner need not expend any additional resources above and beyond those required in the current IPR.

D. The Board Should Not Deny the Petition Under § 314(a)

In *General Plastic*, the Board set forth a series of factors that may be analyzed for follow-on petitions to help conserve the finite resources of the Board. *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, slip op. at 16 (PTAB Sept. 6, 2017) (Paper 19) (precedential as to § II.B.4.i). Here, the *General Plastic* factors weigh in favor of instituting the present IPR and permitting joinder. *See Celltrion, Inc. v. Genentech, Inc*., IPR2018-01019, Paper 11 at 8–11 (PTAB Oct. 30, 2018) (finding similar follow-on petition where petitioner agreed to participate in "understudy role" "obviate[d] any concerns of serial harassment and unnecessary expenditures of resources" even where earlier petitions had been filed challenging the same claims).

The first factor is whether Petitioner previously filed a petition directed to the same claims of the same patent. Although Merck previously filed a petition against

the '757 patent, that petition was not considered on the merits. IPR2026-00221, Paper 14. In *Code200*, the Board held that "[w]here the first-filed petition under factor 1 was discretionarily denied or otherwise was not evaluated on the merits, factors 1–3 only weigh in favor of discretionary denial when there are 'road-mapping' concerns under factor 3 or other concerns under factor 2." *Code200, UAB v. Bright Data Ltd.*, IPR2022-00862 (PTAB Aug. 23, 2022), Paper 18 at 4–7 (precedential). As outlined below, no such concerns under factors 2 and 3 exist. Moreover, the present petition is identical to the Pfizer petition. "'[R]oad-mapping' concerns are minimized when, as in this case, a petitioner files a later petition that raises unpatentability challenges substantially overlapping with those in the previously-filed petition and the later petition is not refined based on lessons learned from later developments." *Id.* at 5. Factor 1 therefore does not weigh in favor of discretionary denial of joinder/institution and is at least neutral.

The second factor is whether at the time of filing the first petition, the petitioner knew or should have known of the prior art asserted in the second petition. Merck's original IPR and the Pfizer IPR were filed within a month of each other. Moreover, the instant petition shares the same prior art because it is identical to the Pfizer IPR. Thus, there are no "road mapping" concerns of serial, tactical filings. This factor therefore weighs in favor of instituting the present IPR and permitting joinder.

The third factor is whether at the time of filing the second petition, the petitioner already received the Patent Owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition. Although the Patent Owner's preliminary response has been filed, Merck is submitting an identical petition to the instituted Pfizer petition and has not added to, or changed, any of the substantive arguments from the Pfizer petition. And the Board did not issue an institution decision on the merits of Merck's first petition. Thus, there are no "road mapping" concerns of serial, tactical filings. This factor therefore weighs in favor of instituting the present IPR and permitting joinder.

The fourth factor is the length of time elapsed between the time the petitioner learned of the prior art asserted in the second petition and filing of the second petition, and the fifth factor is whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent. Merck filed its Petition and this joinder motion within weeks of Merck's first IPR petition being discretionarily denied and well within the time period allowed under 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b). These factors therefore weigh in favor of instituting the present IPR and permitting joinder.

The sixth factor is the finite resources of the Board. Allowing Merck's joinder where Merck will merely serve an understudy role will not impact the Board's resources beyond those resources already allocated for the Pfizer IPR proceeding.

This factor therefore weighs in favor of instituting the present IPR and permitting joinder.

The seventh factor is the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review. As noted above, joining Merck will not impact the schedule. Accordingly, this factor weighs in favor of instituting the present IPR and permitting joinder.

For the reasons above, all of the *General Plastic* factors are either neutral or weigh in favor of instituting the present IPR and permitting joinder.

IV. CONCLUSION

Based on the factors discussed above, Merck respectfully requests that the Board institute Merck Sharp & Dohme LLC's Petition for *inter partes* review of the '757 patent and then grant joinder with *Pfizer Inc. v. Pogona, LLC*, IPR2026-00189.

Dated: June 1, 2026

Respectfully submitted,

/s/ Ben Haber
Ben Haber (Reg. No. 67,129)

CERTIFICATE OF SERVICE (37 C.F.R. §42.6(e)(1))

The undersigned hereby certifies that the above document was served on June 1, 2026, by filing this document through the Patent Trial and Appeal Board P-TACTS System, as well as delivering a copy via express mail upon the following attorneys of record for the Patent Owner:

Wolf Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210-2206

A courtesy copy was sent to the below counsel via electronic mail:

David Krinsky
Julie Tavares
Williams & Connolly LLP
680 Maine Avenue, S.W.
Washington, D.C. 20024
Phone: 202-434-5338
Fax: 202-434-5029
Email: dkrinsky@wc.com
Email: jtavares@wc.com

Sarah E. Spires
Steven W. Hartsell
Ryan A. Hargrave
SKIERMONT DERBY LLP
1601 Elm Street, Suite 4400
Dallas, Texas 75201
Tel: (214) 978-6600
Fax: (214) 978-6601
Email: Pogona_SDTeam@skiermontderby.com

Dated: June 1, 2026

Respectfully submitted,

/s/ Ben Haber

Ben Haber (Reg. No. 67,129)
O'Melveny & Myers LLP
400 South Hope Street, 18th Floor
Los Angeles, CA 90071
Telephone: (213) 430-6000
Fax: (213) 430-6407
E-Mail: bhaber@omm.com
Attorney for Petitioner