

UNITED STATES DISTRICT COURT
DISTRICT OF NEW JERSEY
(973) 776-7700

CHAMBERS OF
JAMES B. CLARK, III
UNITED STATES MAGISTRATE JUDGE

U.S. COURTHOUSE
50 WALNUT STREET, ROOM 2060
NEWARK, NJ 07102

July 23, 2026

LETTER ORDER

Re: Pogona, LLC v. Merck Sharp & Dohme LLC
Civil Action No. 25-15294 (BRM)

Dear Counsel,

Presently pending before the Court is a motion by Defendant/Counter-Claimant Merck Sharp & Dohme LLC (hereinafter, “Merck”) seeking a stay of this action pending the United States Patent Trial and Appeal Board’s (“PTAB”) *inter partes* review (“IPR”) of the patent-in-suit that is the subject of this action, U.S. Patent No. 11,058,757 (the “757 Patent”), which is wholly owned by Plaintiff/Counter-Defendant Pogona LLC (hereinafter, “Pogona”). Dkt. No. 30, *see also generally* Compl., Dkt. No. 1. After Merck filed its motion to stay, the Court entered an Order staying discovery on February 25, 2026 pending disposition of Merck’s motion. Dkt. No. 31. Pogona filed an Opposition to Merck’s motion on March 16, 2026, and Merck replied on March 30, 2026. Dkt. Nos. 34; 35.

Following full briefing on Merck’s motion to stay, Merck filed a supplemental letter regarding its motion on May 20, 2026. Dkt. No. 36. The letter provided a status update concerning “recent developments” in PTAB’s IPR review of the 757 Patent. *See id.* Specifically, the letter explained that two separate IPR petitions challenging every claim of the 757 Patent had been filed

before the PTAB: (1) Merck’s petition and (2) a petition by non-party pharmaceutical company Pfizer Inc.(“Pfizer”). *Id.* p. 1. The letter further explained that, on May 19, 2026, the PTAB issued a decision discretionarily denying institution of Merck’s petition. *Id.* pp. 1-2. The PTAB did, however, refer Pfizer’s IPR petition for an institutional decision on the merits. *Id.* pp. 1-2. Merck asserted that the PTAB’s denial of its own IPR petition “does not materially alter the analysis favoring a stay of this litigation . . . [,]” essentially because Pfizer’s IPR petition remains pending before the PTAB and continues to challenge the validity of the 757 Patent. *Id.* p. 2.

On the next day, Pogona filed a responsive letter arguing that, contrary to Merck’s assertion, “the PTAB’s discretionary denial of Merck’s IPR petition materially alters the analysis and weighs against a stay of this litigation.” *See* Dkt. No. 37. Pogona clarified that, notwithstanding the PTAB’s continued consideration of Pfizer’s IPR petition on the merits, “[b]ecause Merck’s petition was denied, Merck will not be estopped from asserting in this litigation the same invalidity arguments contained in Pfizer’s separate IPR petition.” *Id.* p. 1. In other words, Pogona claims that, notwithstanding the PTAB’s decision on Pfizer’s IPR petition, Merck may raise the same invalidity contentions here even if the PTAB ultimately finds that the 757 Patent is invalid in at least some respects.

On May 26, 2026, Merck submitted an additional supplemental letter to the Court, responding to the contentions raised by Pogona in its May 21, 2026 letter. *See* Dkt. No. 39. The Court responded by directing a continued stay of discovery in this litigation pending disposition of the pending motion to stay. Dkt. No. 39. The Court also allowed for supplemental submissions of five or less pages following issuance of an institutional decision on Pfizer’s IPR, as the PTAB decision regarding Pfizer’s IPR was expected by no later than July 6, 2026. *Id.* On June 2, 2026, Pogona filed a formal supplemental opposition to Merck’s motion to stay because

the PTAB issued a May 26, 2026 notice of decision of institution on Pfizer's IPR which stated that Pfizer's petition has shown at least "a reasonable likelihood of prevailing with respect to at least one of the [invalidity] claims challenged in the petition[.]" *See* Dkt. No. 40. p. 4.

Pogona's supplemental opposition raises new several new contentions based upon the aforesaid developments regarding both Merck's and Pfizer's IPR petitions. The supplemental opposition is fourfold, arguing that: (1) the denial of Merck's own IPR petition eliminates the primary basis for a stay; (2) Merck has not been granted joinder and, as such, Merck is not bound in this case by the PTAB's decision on the merits concerning Pfizer's IPR; (3) the PTAB's institution of Pfizer's IPR does not demonstrate that the IPR is guaranteed to simplify the issues in this case; and (4) a continued stay of this litigation would unduly burden Pogona because Merck is actively infringing on its 757 Patent through its sale of Capvaxive. *See generally id.* On the same day, Merck also submitted supplemental briefing, arguing that it is indeed entitled to a stay of the litigation pending the PTAB's decision on the merits for Pfizer's IPR petition. Merck further argues that statutory estoppel is not a prerequisite to the issuance of a stay, and also advanced several other supplemental arguments in support of its request for a stay. *See* Dkt. No. 41.

With this background in mind, the Court finds that there have been several material changes in circumstances regarding the PTAB's underlying review of the 757 Patent since the initial filing of Merck's motion. Moreover, considering the numerous submissions by the parties regarding the appropriateness of a stay of this litigation, the Court concludes, in the interests of efficiency and for purposes of clarifying the issues with respect to Merck's motion to stay, that the parties are to refile their briefs on the issue of whether a stay of this litigation is appropriate. Merck shall refile its motion to stay by no later than **August 14, 2026**, and Pogona shall file its response by **August 25, 2026**. Merck shall file its reply, if any, by **September 1, 2026**. The parties shall include all

relevant issues in their briefing, paying particular attention to the paramount issue of whether the PTAB's review of the 757 Patent will "will simplify the issues in question and trial in the case," *see Depomed Inc. v. Purdue Pharma L.P.*, No. 13-571, 2014 WL 3729349, at *2 (D.N.J. July 25, 2014). In addressing the simplification factor, the parties shall directly address the issues of statutory estoppel and joinder. Merck's motion to stay [Dkt. No. 30] is therefore **ADMINISTRATIVELY TERMINATED.**

IT IS SO ORDERED.

s/ James B. Clark, III
JAMES B. CLARK, III
United States Magistrate Judge