From:	Trey Powers
To:	Peterson, Leif; Kushan, Jeffrey P.; Tyler Liu; "leif.peterson@sidley.com"; "sue.wang@sidley.com"; "khelm@dechert.com"; "Blaine.Hackman@dechert.com"; "christine.engen@sidley.com"; "abhatla@sidley.com"; "Brian.Goldberg@dechert.com"; "mark.stewart@merck.com"; Halozyme PGRs
Cc:	Lauren Martin; Jennifer Chagnon; David J. Kappos; Aubrey Haddach; David H. Holman; Josh Mack; Mark Snyder; Zach Summers; Louis Panzica; Eldora L. Ellison; "amy.mahan@sidley.com"; Bill Flanigen
Subject:	RE: Merck v. Halozyme PGRs
Date:	Tuesday, January 6, 2026 9:05:39 PM
Attachments:	image001.png image002.png

Leif,

Thanks for your email. We are at an impasse regarding the propriety of Petitioner's redactions and must move forward with our motion for additional discovery seeking unredacted versions of the documents you've already produced.

As we have informed you, we disagree that anything in 37 C.F.R. § 42.51(b)(2) or § 42.224 allows a producing party to selectively redact information from otherwise relevant documents. We have also reviewed the two cases you cited in support of your extensive and unilateral redactions. They are inapposite. First, the decision in *Unified Patents, LLC v. American GNC Corp*., IPR2019-00505, Paper 20 (PTAB Apr. 12, 2019), does not address whether a producing party can unilaterally redact portions of a document it deems to be irrelevant in an otherwise relevant document. Clearly, Petitioner thought the produced documents were relevant to Halozyme's requests but then chose to redact portions of those documents without adequately explaining why. You merely assert the redactions correspond to "sensitive information that has no bearing on the RPI issue," as judged by Petitioner alone. Surely you must understand that we would like to evaluate the documents, in full, for ourselves. You have not alleged that the redacted portions are privileged. And you have not articulated any prejudice that would come to Petitioner from providing the unredacted documents under the protective order.

You also cited *New World Medical, Inc. v. MicroSurgical Tech.*, Inc., IPR2020-01573, Paper 13 (PTAB Dec. 10, 2020). This case is also unhelpful to your position, and if anything supports Halozyme's position. In *New World Medical*, Patent Owner argued that the University of Colorado was an unnamed RPI by pointing to the existence of an exclusive license agreement between Petitioner and the University. However, the Board noted that the agreement did not have any terms even in its redacted form that required or provided for any collaboration or partnership between the unnamed University and Petitioner. This was ascertainable because, as the Board noted, "very little is masked by redaction" and that "[a]lmost all of the language of the license agreement is accessible, *with only the most specific financial terms redacted*." *Id*. at 6 (emphasis added). *New World Medical* is therefore in sharp contrast to this case, where Petitioner's redactions are extensive and clearly go well beyond specific financial terms. It is not surprising that in *New World Medical* the Board would not authorize additional discovery into solely financial terms. Regardless, as we have maintained from the beginning, Halozyme does not seek discovery of specific dollar amounts.

You also stated that we have changed our position in a manner that was "inappropriate," with respect to the type of material we stated could be redacted from Mr. Stewart's employment offer letter. Not at all. Given the liberties Merck has taken with redactions, we merely sought to clarify that appropriate redactions should be limited to actual compensation amounts to Mr. Stewart. Especially given Petitioner's excessive redactions, and your admission that Mr. Stewart's letter discussed compensation [redacted] which remain behind your redactions), our clarification was hardly "inappropriate." Instead, we continued to try to work toward resolution of these issues without the need for motion practice. By maintaining your inadequately explained and excessive redactions, unfortunately, Merck has made a motion for additional discovery necessary.

Finally, for the first time on Friday afternoon, you asked Halozyme to identify the publicly available documents that support its position that Merck and Co. should have been named as an RPI in these PGRs. Below, please find a list of publicly available documents that indicate Merck and Co. is a proper RPI. We, of course, reserve our right to rely on additional evidence.

Document	Website link
Merck & Co's November 5, 2025, 10-Q: Quarterly report for quarter ending September 30, 2025	https://www.sec.gov/ix?doc=/Archives/edgar/data/0000310158/000031015825000059/mrk-20250930.htm
MSD LLC - SEC Company Information	https://www.sec.gov/edgar/browse/?CIK=64978
Merck & Co. Inc. – SEC Company	https://www.sec.gov/edgar/browse/?CIK=310158&owner=exclude

Halozyme EX2401
Merck v. Halozyme
PGR2025-00039

Information	
MSD LLC's Executive Leadership Webpage	https://www.msd.com/company-overview/leadership/executive-team/
Merck & Co's Executive Leadership Webpage	https://www.merck.com/company-overview/leadership/executive-team/
MSD LLC's Board of Directors Webpage	https://www.msd.com/company-overview/leadership/board-of-directors/
Merck & Co's Board of Directors Webpage	https://www.merck.com/company-overview/leadership/board-of-directors/
Contact us – MSD	https://www.msd.com/contact-us/
Contact us – Merck	https://www.merck.com/contact-us/
Who we are – MSD	https://www.msd.com/company-overview/
Who we are – Merck	https://www.merck.com/company-overview/
Intellectual Property Owners Association, Board of Directors	https://ipo.org/index.php/board-of-directors/
ChIPs Global Summit Speaker Details – Laura Ginkel	https://chipsnetwork.swoogo.com/2020ChIPsGlobalSummit/speaker/161523/laura-ginkel
Petition for IPR2024-00240	
Petition for IPR2024-00622	
Petition for IPR2024-00623	
Petition for IPR2024-00624	
Petition for IPR2024-00625	
Petition for IPR2024-00647	
Petition for IPR2024-00648	

Best regards,
Trey

R. Wilson "Trey" Powers III, Ph.D.
Director
Sterne, Kessler, Goldstein & Fox P.L.L.C.
Email: tpowers@sternekessler.com
Direct: 202.772.8876

Administrative Assistant: Cheryl Wagner
Direct: 202.772.8961 **Main:** 202.371.2600

From: Peterson, Leif <leif.peterson@Sidley.com>
Sent: Friday, January 2, 2026 4:01 PM
To: Trey Powers <TPOWERS@sternekessler.com>; Kushan, Jeffrey P. <jkushan@sidley.com>; Tyler Liu <TLIU@sternekessler.com>; 'leif.peterson@sidley.com'; 'sue.wang@sidley.com'; 'khelm@dechert.com'; 'Blaine.Hackman@dechert.com'; 'christine.engen@sidley.com'; 'abhatla@sidley.com'; 'Brian.Goldberg@dechert.com'; 'mark.stewart@merck.com'; Halozyme PGRs <HalozymePGRs@sidley.com>
Cc: Lauren Martin <laurenmartin@quinnemanuel.com>; Jennifer Chagnon <JChagnon@sternekessler.com>; David J. Kappos <dkappos@cravath.com>; Aubrey Haddach <ahaddach@halozyme.com>; David H. Holman <DHOLMAN@sternekessler.com>; Josh Mack <jmack@halozyme.com>; Mark Snyder <msnyder@halozyme.com>; Zach Summers <zachsummers@quinnemanuel.com>; Louis Panzica <LPanzica@sternekessler.com>; Eldora L. Ellison <EELLISON@sternekessler.com>; 'amy.mahan@sidley.com'
Subject: RE: Merck v. Halozyme PGRs

EXTERNAL EMAIL: Use caution before clicking links or attachments.

Trey,

Petitioner has been cooperative in addressing Patent Owner's discovery requests and has nothing further to provide.

Petitioner's voluntary responses to Patent Owner's requests are entirely proper pursuant to 37 C.F.R. § 42.51(b)(2). That rule expressly limits discovery in PTAB proceedings to information "directly related" to factual assertions at issue in the proceedings. Your repeated intimations that Petitioner and its counsel have used redactions to conceal information relevant to the RPI issue are unfounded and not well taken. We supplied Patent Owner with sufficient information—including by email and in unredacted text in the documents themselves—to demonstrate the redacted text is not directly related to the RPI analysis. Moreover, Patent Owner has the burden to establish that the redacted information is within the scope of permitted additional discovery. Speculation about the redacted text cannot support a motion for additional discovery. *See, e.g.*, *Unified Patents, LLC v. American GNC Corp.*, IPR2019-00505, Paper 20 (PTAB Apr. 12, 2019) ("[T]he possibility of uncovering relevant evidence is not sufficient to establish evidence or reasoning tending to show beyond speculation that something useful will be uncovered."); *New World Medical, Inc. v. MicroSurgical Tech., Inc.*, IPR2020-01573, Paper 13 (PTAB Dec. 10, 2020) (rejecting Patent Owner's request for additional discovery where a document "even in its redacted form, is clearly without any terms that require or provide" a basis to establish an unnamed party is an RPI).

The information you are requesting from Mr. Stewart's offer letter is inconsistent with the redactions that Patent Owner itself acknowledged were appropriate in its November 11 email. Your attempt to change that position now by limiting redactions to "monetary information" and "specific dollar amounts" is inappropriate. Nevertheless, Petitioner's response provided information regarding the redacted [redacted] compensation provision in Mr. Stewart's offer letter in good faith so that Petitioner could accurately represent to Patent Owner that none of the redacted information in its document production is relevant to the RPI issue, including because the redacted portions do not refer to MCI or any particular Merck entity other than MSD LLC, with this one exception.

Finally, we note that your response again refers to "publicly available documents" that allegedly support Patent Owner's RPI position. Yet, as has been the case since Patent Owner's original email on November 11, 2025, you have failed to identify what that information is or how it allegedly supports Patent Owner's baseless RPI arguments. Please do so immediately. In any event, the fact that Patent Owner's RPI theory apparently contradicts Petitioner's interrogatory responses shows that the theory is erroneous.

Petitioner voluntarily and completely complied with Patent Owner's discovery requests. There is no basis for Patent Owner to persist with moving for additional discovery on the RPI issue.

Thanks,
Leif

LEIF E. PETERSON II

SIDLEY AUSTIN LLP
+1 312 853 7190
leif.peterson@sidley.com

From: Trey Powers <TPOWERS@sternekessler.com>
Sent: Thursday, January 1, 2026 10:06 AM
To: Peterson, Leif <leif.peterson@Sidley.com>; Kushan, Jeffrey P. <jkushan@sidley.com>; Tyler Liu <TLIU@sternekessler.com>; 'leif.peterson@sidley.com'; 'sue.wang@sidley.com'; 'khelm@dechert.com'; 'Blaine.Hackman@dechert.com'; 'christine.engen@sidley.com'; 'abhatla@sidley.com'; 'Brian.Goldberg@dechert.com'; 'mark.stewart@merck.com'; Halozyme PGRs <HalozymePGRs@sidley.com>
Cc: Lauren Martin <laurenmartin@quinnemanuel.com>; Jennifer Chagnon <JChagnon@sternekessler.com>; David J. Kappos <dkappos@cravath.com>; Aubrey Haddach <ahaddach@halozyme.com>; David H. Holman <DHOLMAN@sternekessler.com>; Josh Mack <jmack@halozyme.com>; Mark Snyder <msnyder@halozyme.com>; Zach Summers <zachsummers@quinnemanuel.com>; Louis Panzica <LPanzica@sternekessler.com>; Eldora L. Ellison <EELLISON@sternekessler.com>; 'amy.mahan@sidley.com'
Subject: RE: Merck v. Halozyme PGRs

Lief,

We disagree with your assertion that Petitioner's document production has mooted Patent Owner's motion for additional discovery or demonstrates that Merck and Co., Inc. is not a proper RPI in these proceedings.

First, as to the interrogatory responses, they appear to conflict with publicly available documents that, under the *Corning* precedent, indicate that Merck and Co., Inc. should have been named as an RPI.

Second, your only justification for Petitioner's extensive redactions appears to hinge on a misreading of 37 C.F.R. § 42.51(b)(2). Nothing in that rule permits a producing party to selectively redact information within documents that are otherwise relevant. Your very production of the documents concedes that the documents are responsive to our discovery requests and therefore relevant. Accordingly, we disagree that your production has been "fully consistent with this rule." To the contrary, to allow a producing party unilaterally to pick and choose redactions based on its own perception of relevance would frustrate the very purpose of discovery and severely prejudice the receiving party's ability to evaluate the document for itself. Here, where the parties have already agreed to abide by a protective order, you have provided no good faith basis for the extensive redactions. The presence of the protective order moots any justification based on any "sensitive" nature of the redacted information. And you have not alleged that any of your redactions obscure privileged information.

You also represented that none of the redacted materials refer to any "particular" Merck entity, "with one exception." We would like to evaluate for ourselves whether any of the redacted materials refer to Merck entities collectively or in any way whatsoever. And we would like to do it with the benefit of the full context of the documents. This is another reason why your redactions are unwarranted, prejudicial to Patent Owner, and do not moot our forthcoming motion for additional discovery. For example, it is important that we see the entirety of the Sidley Austin and Dechert engagement agreements, [redacted]. We need to determine for ourselves whether redacted portions are relevant to the issue of RPI. It is insufficient to expect us to simply rely on your assessment, without seeing the entirety of relevant documents ourselves.

As to the "one exception," you indicate that Mr. Stewart's Offer Letter, MERCK_PGR00467-473) "redacts a compensation-related provision under which Mr. Stewart [redacted] This type of information, provided by email only now, underscores why Patent Owner needs to see the entirety of the Offer Letter, with the exception of actual compensation amounts and information entirely personal to Mr. Stewart, such as his social security number or home address. Based on what you have told us, it appears you have redacted information that is highly relevant to Mr. Stewart's relationship and interaction with Merck & Co.

Beyond that, you addressed two other specific documents in your December 30, 2025 email. With respect to Mr. Stewart's payroll statement (MERCK_PGR00465), you stated that "the redaction under Mr. Stewart's name is to his home address, and the redaction to the header contains internal filing information associated with this particular payroll statement. Other redactions are to compensation, tax, and bank account information." Please confirm that there are no redactions to any other information besides the precise types of information in your quote immediately above. Moreover, in view of the protective order, we see no basis for redacting "internal filing information associated with this particular payroll statement."

With respect to MERCK_PGR00042, please explain your basis for redacting the "system ID, matter number, work area, and organizational unit." Again, we see no reason why, in view of the protective order, these redactions are warranted.

We are hopeful that the parties will be able to come to an accord on Petitioner's production and avoid burdening the Board. However, as we continue to indicate, we cannot abide by the extensive redactions Petitioner has made solely based on its own judgment of lack of relevance. We ask again for you to provide unredacted versions of all documents except to the extent they contain privileged information or present specific dollar amounts in relation to Mr. Stewart's compensation. And they should be narrowly tailored to such monetary information. To the extent any information remains redacted on either basis, please indicate each document by bates numbers, the redactions that remain, and exact basis for each redaction.

We plan to email the Board in response to your December 30th emails to it. Your response to this email will determine our response. Please reply promptly.

Thank you and Happy New Year.

Trey

R. Wilson "Trey" Powers III, Ph.D.
Director
Sterne, Kessler, Goldstein & Fox P.L.L.C.
Email: tpowers@sternekessler.com
Direct: 202.772.8876

Administrative Assistant: Cheryl Wagner
Direct: 202.772.8961 **Main:** 202.371.2600

From: Peterson, Leif <leif.peterson@Sidley.com>
Sent: Tuesday, December 30, 2025 2:06 PM
To: Trey Powers <TPOWERS@sternekessler.com>; Kushan, Jeffrey P. <jkushan@sidley.com>; Tyler Liu <TLIU@sternekessler.com>; 'leif.peterson@sidley.com'; 'sue.wang@sidley.com'; 'khelm@dechert.com'; 'Blaine.Hackman@dechert.com'; 'christine.engen@sidley.com'; 'abhatla@sidley.com'; 'Brian.Goldberg@dechert.com'; 'mark.stewart@merck.com'; Halozyme PGRs <HalozymePGRs@sidley.com>
Cc: Lauren Martin <laurenmartin@quinnemanuel.com>; Jennifer Chagnon <JChagnon@sternekessler.com>; David J. Kappos <dkappos@cravath.com>; Aubrey Haddach <ahaddach@halozyme.com>; David H. Holman <DHOLMAN@sternekessler.com>; Josh Mack <jmack@halozyme.com>; Mark Snyder <msnyder@halozyme.com>; Zach Summers <zachsummers@quinnemanuel.com>; Louis Panzica <LPanzica@sternekessler.com>; Eldora L. Ellison <EELLISON@sternekessler.com>; 'amy.mahan@sidley.com'
Subject: RE: Merck v. Halozyme PGRs

EXTERNAL EMAIL: Use caution before clicking links or attachments.

Trey,

We disagree that there was anything improper about Petitioner's document production, which has mooted both Halozyme's request for additional discovery and any possible allegation that MCI is an RPI to these proceedings.

First, our responses to all 6 of your interrogatories establish that MCI is not an RPI to these proceedings. As you have identified no deficiencies in those responses, there is no basis for Halozyme to seek further additional discovery via interrogatory.

Second, the only issue you have raised with Petitioner's document production is with respect to redactions. We thus understand that Halozyme's only basis for pursuing additional discovery is with respect to discovery of that redacted information.

Third, no further discovery of the redacted information is warranted. No authority prohibits Petitioner from producing documents in a form that redacts sensitive information that has no bearing on the RPI issue raised by Halozyme. 37 C.F.R. § 42.51(b)(2) expressly states that "in post-grant reviews… additional discovery is ***limited to evidence directly related to factual assertions advanced by either party*** in the proceeding." (emphasis added); *see also* 37 C.F.R. § 42.224 (same). Petitioner's documents were produced in a manner that is fully consistent with this rule, i.e., with redactions to information that is sensitive to Petitioner, its employees, and its counsel, but which is not "directly related to factual assertions advanced by [Halozyme]" regarding RPI (or any other issue in these proceedings). The fact that certain of this information may not be privileged or expressly related to compensation is irrelevant.

Petitioner represents and confirms that, with one exception, none of the redacted materials refer to any particular Merck entity other than Petitioner, MSD LLC. The lone exception is with respect to Mr. Stewart's Offer Letter, MERCK_PGR004676, which redacts a compensation-related provision under which Mr. Stewart [redacted]. Those redactions were fully in line with Halozyme's own proposal that Mr. Stewart's employment agreement could be redacted to remove information "relating to compensation or other information unrelated to a job title, description, or obligation." November 11, 2025 Email Liu to Kushan. As such, the redactions were appropriate and none of the redacted materials are an appropriate basis for Additional Discovery under 37 C.F.R. § 42.51(b)(2).

As to your specific complaints, as you concede in your email, Petitioner intentionally left unredacted the top-level headers in its produced agreements, which confirm that the redacted information has no relevance to the RPI issue belatedly raised here. All portions of the produced documents having any potential relevance to Halozyme's RPI assertions were

left unredacted in their entirety.

- The extent to which any of these agreements extend to any affiliates of MSD LLC is revealed in the unredacted portions of the produced documents.
- With respect to Mr. Stewart's payroll statement (MERCK_PGR00465), the redaction under Mr. Stewart's name is to his home address, and the redaction to the header contains internal filing information associated with this particular payroll statement. Other redactions are to compensation, tax, and bank account information. None of that information is relevant to Halozyme's RPI assertions.
- With respect to MERCK_PGR00042, the redacted information relates to Dechert LLP's internal accounting information.

Your email identifies no basis for Halozyme to continue its pursuit of additional RPI discovery.

We intend to inform the Board promptly that Petitioner has voluntarily provided Halozyme with all requested discovery and has therefore mooted Halozyme's motion.

Thanks,
Leif

LEIF E. PETERSON II

SIDLEY AUSTIN LLP
+1 312 853 7190
leif.peterson@sidley.com

From: Trey Powers <TPOWERS@sternekessler.com>
Sent: Monday, December 29, 2025 4:05 PM
To: Kushan, Jeffrey P. <jkushan@sidley.com>; Tyler Liu <TLIU@sternekessler.com>; 'leif.peterson@sidley.com'; 'sue.wang@sidley.com'; 'khelm@dechert.com'; 'Blaine.Hackman@dechert.com'; 'christine.engen@sidley.com'; 'abhatla@sidley.com'; 'Brian.Goldberg@dechert.com'; 'mark.stewart@merck.com'; Halozyme PGRs <HalozymePGRs@sidley.com>
Cc: Lauren Martin <laurenmartin@quinnemanuel.com>; Jennifer Chagnon <JChagnon@sternekessler.com>; David J. Kappos <dkappos@cravath.com>; Aubrey Haddach <ahaddach@halozyme.com>; David H. Holman <DHOLMAN@sternekessler.com>; Josh Mack <jmack@halozyme.com>; Mark Snyder <msnyder@halozyme.com>; Zach Summers <zachsummers@quinnemanuel.com>; Louis Panzica <LPanzica@sternekessler.com>; Eldora L. Ellison <EELLISON@sternekessler.com>; 'amy.mahan@sidley.com'
Subject: RE: Merck v. Halozyme PGRs

Jeff,

Thanks for your production of December 23. However, after review, we disagree that Petitioner has fully complied with our discovery requests. Therefore, we disagree that this resolves Halozyme's motion for additional discovery. Petitioner's redactions to the produced documents were quite liberal and appear to redact non-privileged and non-compensation-related information.

For example, MERCK_PGR00006-034 and MERCK_PGR00056-85, Master Agreements with Sidley Austin LLP and Dechert LLP respectively, include redactions to entire sections of the agreements that appear non-privileged. These include, for example, sections entitled: [redacted]. It is unclear what, if anything, is privileged in any of these redacted sections of the agreements.

Similarly, we are unable to determine whether Exhibits 1 and 2 attached to both Sidley Austin LLP and the Dechert LLP Master Agreements contain privileged or compensation related information. For example, in both agreements, Petitioner has redacted large sections of Exhibit 1 (including Appendices B - F) and all of Exhibit 2. It is unclear why these redacted portions are privileged, or how they could relate to Mr. Stewart's compensation.

In addition, the expert retainer letters for Dr. Hecht (MERCK_PGR00052-055) and Dr. Park (MERCK_PGR00086-89)

are heavily redacted. For example, the [redacted] sections of these agreements do not appear to contain privileged information.

As another example, Mark Stewart's December 12, 2025 (MERCK_PGR00465-466) payroll statement includes redactions to sections that do not appear to contain privileged or compensation-related information. For example, Petitioner has redacted a section under Mark Stewart's name and also redacted a header at the top of the payroll statement above "MERCK SHARP & DOHME LLC." It is unclear what, if anything, is privileged or contains compensation related information in these redacted portions of Mark Stewart payroll statement.

Finally, we are unclear as to what MERCK_PGR00042 is showing and, importantly, why Petitioner has redacted information relating to [redacted]

Naturally, we cannot abide by Petitioner's selective redaction of non-privileged information. And furthermore, our offer to allow Petitioner to redact Mr. Stewart's compensation-related information in his employment agreement was made as a courtesy. We did not intend for it to provide a license for Petitioner to selectively redact other kinds of non-privileged information in other types of documents. Especially in view of the parties' agreement on use of the PTAB's default protective order in these cases, such broad redactions of apparently non-privileged information are inappropriate.

Please provide unredacted versions of the produced documents. For any redaction Petitioner maintains, please explain in an appropriately detailed privilege log why each redaction contains *only* privileged information as well as the basis for the alleged privilege. Please provide your response no later than COB this Wednesday, December 31st.

Thanks very much,
Trey

R. Wilson "Trey" Powers III, Ph.D.
Director
Sterne, Kessler, Goldstein & Fox P.L.L.C.
Email: tpowers@sternekessler.com
Direct: 202.772.8876

Administrative Assistant: Cheryl Wagner
Direct: 202.772.8961 **Main:** 202.371.2600

From: Kushan, Jeffrey P. <jkushan@sidley.com>
Sent: Tuesday, December 23, 2025 3:33 PM
To: Trey Powers <TPOWERS@sternekessler.com>; Tyler Liu <TLIU@sternekessler.com>; 'leif.peterson@sidley.com'; 'sue.wang@sidley.com'; 'khelm@dechert.com'; 'Blaine.Hackman@dechert.com'; 'amy.mahan@sidley.com'; 'christine.engen@sidley.com'; 'abhatla@sidley.com'; 'Brian.Goldberg@dechert.com'; 'mark.stewart@merck.com'; Halozyme PGRs <HalozymePGRs@sidley.com>
Cc: Lauren Martin <laurenmartin@quinnemanuel.com>; Jennifer Chagnon <JChagnon@sternekessler.com>; David J. Kappos <dkappos@cravath.com>; Aubrey Haddach <ahaddach@halozyme.com>; David H. Holman <DHOLMAN@sternekessler.com>; Josh Mack <jmack@halozyme.com>; Mark Snyder <msnyder@halozyme.com>; Zach Summers <zachsummers@quinnemanuel.com>; Eldora L. Ellison <EELLISON@sternekessler.com>; Louis Panzica <LPanzica@sternekessler.com>
Subject: RE: Merck v. Halozyme PGRs

EXTERNAL EMAIL: Use caution before clicking links or attachments.

Contains Information Designated PROTECTIVE ORDER MATERIAL pursuant to the Board's Default Protective Order

Counsel,

As we have previously explained, Petitioner Merck Sharp & Dohme LLC maintains its position that information we provided in response to your original emails demonstrates that Halozyme's assertions about Petitioner's RPI designation in the proceedings are baseless. We also maintain that discovery into Halozyme's RPI allegations concerning Merck & Co., Inc. is unwarranted.

To avoid burdening the Board with the necessity of considering Halozyme's motion for additional discovery into this issue, and without waiving any applicable privileges and/or work product protections concerning the manner in which Petitioner has conducted these PGR proceedings, Petitioner provides the following responses to each of the discovery requests Halozyme articulated to Petitioner concerning these issues. For convenience, Petitioner repeats each of Halozyme's requests, without conceding the accuracy of any factual assertions contained therein. Petitioner's responses are also responsive as to Petitioner's co-counsel in these proceedings (Dechert LLP).

Initially, we accept your proposal to operate under the terms of the Board's Default Protective Order. The responses we provide with this email thus are designated PROTECTIVE ORDER MATERIAL under the PTAB's Default Protective Order, are to be maintained as confidential, and are being provided pursuant to the terms of the PTAB's Default Protective Order.

Because Petitioner has responded to all of Halozyme's discovery requests, we believe this moots Halozyme's request for additional discovery and the associated briefing requested and granted by the Board. We believe it appropriate for the parties to inform the Board that the briefing they authorized is no longer required. Please let us know if you agree. We intend to inform the Board of this development promptly.

Petitioner responds to Halozyme's discovery requests as follows:

<u>Interrogatories</u>

For each of the interrogatories below asking to identify individuals, for each such person, identify the person by name, corporate affiliation, and title.

1. Identify all individuals from Petitioner's parent, subsidiary, and/or affiliate companies that have ever provided direction to Petitioner's counsel of record (at Sidley Austin, Dechert or Mark Stewart) or reviewed or approved the filing of the petitions and any other papers before the Board in the 14 PGR proceedings brought by Petitioner against Halozyme.

Response: Petitioner confirms that there are no such individuals.

2. Identify all individuals (excluding Petitioner and Petitioner's counsel at Sidley Austin and Dechert) that have provided support in the form of drafting or reviewing and commenting on the petitions or any other papers filed in any of the 14 PGR proceedings brought by Petitioner against Halozyme.

Response: Petitioner confirms that there are no such individuals.

3. Identify all individuals and entities to whom Petitioner's counsel of record submits its invoices or bills in relation to any of the 14 PGR proceedings brought by Petitioner against Halozyme.

Response: Petitioner's counsel of record in these proceedings (Sidley Austin LLP and Dechert LLP) submit their invoices in relation to the PGR proceedings brought against Halozyme directly to Merck Sharp & Dohme LLC via that entity's [redacted] e-billing system. [redacted] Mark Stewart (Vice President, Global Intellectual Property Litigation, Merck Sharp & Dohme LLC) is the Matter Authorizing Contact for the PGR matters, and is responsible for approving payment of such invoices. [redacted]

After a reasonable investigation, Petitioner confirms that the only individuals who have reviewed and/or authorized payment of invoices submitted by counsel of record to Merck Sharp & Dohme LLC in connection with these proceedings are Mark Stewart, [redacted].

Petitioner is producing concurrently herewith redacted exemplary records from Merck Sharp & Dohme LLC's [redacted] e-billing system showing payment of invoices associated with these proceedings, as well

as a record showing the reviewers for an exemplary invoice processed in connection with these proceedings. Petitioner is also producing redacted exemplary records showing payment remittance by Merck Sharp & Dohme LLC of invoices to counsel of record.

4. Identify all individuals and entities who pay bills from Sidley Austin and Dechert in relation to any of the 14 PGR proceedings brought by Petitioner against Halozyme.

Response: Merck Sharp & Dohme LLC pays all invoices from counsel of record (including Sidley Austin LLP and Dechert LLP) in relation to the PGR proceedings brought by Petitioner against Halozyme. [redacted] Petitioner is producing concurrently herewith redacted exemplary records showing payment remittance by Merck Sharp & Dohme LLC of invoices to counsel of record.

5. Identify Mark Stewart's official titles with all Merck entities and identify the entity or entities that pay him.

Response: Mark Stewart's official title is "Vice President, Global Intellectual Property Litigation" at Merck Sharp & Dohme LLC. Mr. Stewart holds no titles with any other Merck entity. Mr. Stewart is paid by Merck Sharp & Dohme LLC. No other Merck entity makes payments to Mr. Stewart.

6. Identify all individuals whom Sidley Austin and Dechert contact or have contacted regarding instructions, strategy, and funding as it relates to any of the 14 PGR proceedings brought by Petitioner against Halozyme, and identify what specific entity employs each of them.

Response: Petitioner identifies the following individuals, all of whom are employed by and hold titles within the legal department of Merck Sharp & Dohme LLC:

- Mark Stewart, Vice President, Global Intellectual Property Litigation
- [redacted]

Petitioner is producing concurrently herewith records pulled from its [redacted] human resources system showing that each of the above-identified individuals are employed by Merck Sharp & Dohme LLC. [redacted]

Documents:

1. Produce representation/engagement letter(s) sent by or to Sidley Austin regarding all of the 14 PGR proceedings brought by Petitioner against Halozyme.

Response: Petitioner is producing herewith a redacted copy of Sidley Austin LLP's and Dechert LLP's engagement agreements that govern the PGR proceedings against Halozyme.

2. Produce engagement letters with declarants Hecht and Park for all of the 14 PGR proceedings brought by Petitioner against Halozyme.

Response: Petitioner is producing herewith the redacted engagement letters of Drs. Hecht and Park that govern the PGR proceedings against Halozyme.

3. Produce all of Mark Stewart's employment agreement(s) in place within the past two years with any Merck affiliated company and any such employment agreements currently in place. The requested documents may redact information relating to compensation or other information unrelated to a job title, description, or obligation.

Response: Petitioner is producing herewith Mark Stewart's redacted offer of employment, which is his only such agreement in place currently or within the past two years with any Merck affiliated company. Petitioner is also producing Mr. Stewart's [redacted] organizational affiliation records, reflecting that the only company with which he is affiliated is Merck Sharp & Dohme LLC, and an exemplary redacted paystub showing payment of Mr. Stewart's salary by Merck Sharp & Dohme LLC.

4. Produce any documents that Petitioner foresees relying on in opposing a motion to

terminate any of the 14 PGRs for failure to name all RPIs.

Response: Petitioner is producing herewith documents it reasonably and currently foresees relying on in opposing any motion to terminate in the PGR proceedings for alleged failure to name all RPIs. Petitioner reserves the right to rely upon additional materials, including in response to any evidence or arguments that may be presented in such a motion by Halozyme.

Sincerely,

Jeff Kushan

JEFFREY P. KUSHAN

SIDLEY AUSTIN LLP
+1 202 736 8914
jkushan@sidley.com

From: Kushan, Jeffrey P. <jkushan@sidley.com>
Sent: Tuesday, November 25, 2025 1:08 PM
To: Trey Powers <TPOWERS@sternekessler.com>; Tyler Liu <TLIU@sternekessler.com>; 'leif.peterson@sidley.com'; 'sue.wang@sidley.com'; 'khelm@dechert.com'; 'Blaine.Hackman@dechert.com'; 'amy.mahan@sidley.com'; 'christine.engen@sidley.com'; 'abhatla@sidley.com'; 'Brian.Goldberg@dechert.com'; 'mark.stewart@merck.com'; Halozyme PGRs <HalozymePGRs@sidley.com>
Cc: Lauren Martin <laurenmartin@quinnemanuel.com>; Jennifer Chagnon <JChagnon@sternekessler.com>; David J. Kappos <dkappos@cravath.com>; Aubrey Haddach <ahaddach@halozyme.com>; David H. Holman <DHOLMAN@sternekessler.com>; Josh Mack <jmack@halozyme.com>; Mark Snyder <msnyder@halozyme.com>; Zach Summers <zachsummers@quinnemanuel.com>; Eldora L. Ellison <EELLISON@sternekessler.com>; Louis Panzica <LPanzica@sternekessler.com>
Subject: RE: Merck v. Halozyme PGRs

Trey,

We have inserted Merck's position into your draft email to the Board, and have added dates where we would be available for a call with the Board. As you are aware, Dr. Petsko's deposition is on December 4th in Boston, and there are travel days that are required next week, which has limited availability.

Jeff

>>>>>>

Your Honors,

Patent Owner Halozyme requests a conference call with the Board to seek authorization to file a motion for additional discovery on the issue of real party-in-interest ("RPI") as it relates to PGR Nos.:
PGR2025-00003;
PGR2025-00004;
PGR2025-00006;
PGR2025-00009;
PGR2025-00017;
PGR2025-00030;
PGR2025-00024;
PGR2025-00033;
PGR2025-00039;
PGR2025-00042;
PGR2025-00046;
PGR2025-00050;

PGR2025-00053;
PGR2025-00052; and
PGR2025-00087

Petitioner Merck Sharp & Dohme LLC ("MSD LLC"), a wholly-owned subsidiary of Merck & Co, Inc. ("MCI"), has filed 15 Post-Grant Review (PGR) Petitions in the cases noted above. Each of these 15 Petitions identify MSD LLC as the sole RPI. Patent Owner seeks authorization to file a motion for additional discovery to confirm its current understanding that MCI should also have been named as a RPI in all 15 proceedings.

Patent Owner also anticipates seeking authorization to file a motion to dismiss all 15 proceedings for failure to identify all RPI in each Petition after considering all information Petitioner provides in connection with Patent Owner's discovery requests.

These requests are prompted by Director Squires' recent October 28, 2025 precedential designation of Corning Optical Commc'ns RF, LLC v. PPC Broadband, Inc., IPR2014-00440, Paper 68 (P.T.A.B. Aug 18, 2015). The requests also are supported by evidence uncovered by Patent Owner after Corning was designated, including relevant MCI SEC filings and information on MCI's websites, indicating that MCI should have been identified as an RPI in all 15 proceedings under now-binding law. Patent Owner first requested additional discovery from Petitioner on November 11 but Petitioner has refused to provide the requested discovery.

Patent Owner has conferred with Petitioner, and Petitioner has confirmed that it opposes Patent Owner's requests for authorization to file any motions on the issue of RPI.

Petitioner's position

Petitioner disagrees that MCI is an RPI and that discovery is warranted into this belatedly-raised issue. To date, Patent Owner has not identified to Petitioner any "evidence" supporting its contention that MCI is an RPI to these proceedings. Upon receiving Patent Owner's request for RPI discovery, in a good faith effort to avoid burdening the Board with this discovery dispute, Petitioner provided Patent Owner with the following confirmations that Petitioner contends are dispositive of the RPI issue: (i) All of the in-house counsel directing or participating in these proceedings are employees solely of MSD LLC; (ii) MSD LLC alone has paid all fees and costs associated with these proceedings; and (iii) MCI [redacted] and is not directing or participating in these proceedings. Petitioner also explained that Patent Owner had waived the RPI issue by not raising it in its PORs for the first four proceedings, even though it was informed of the subsidiary-parent relationship between MSD LLC and MCI several months ago in parallel district court proceedings. Patent Owner did not respond to any of Petitioner's points, and instead insisted that the parties contact the Board.

Counsel for both parties are available for a teleconference with the Board at the following dates and times, at the Board's convenience:

December 1: 11 to 1 pm eastern.
December 5: 1:30 pm to 5 pm.
December 10: 9 am to 5 pm.

JEFFREY P. KUSHAN

SIDLEY AUSTIN LLP
+1 202 736 8914
jkushan@sidley.com

From: Trey Powers <TPOWERS@sternekessler.com>
Sent: Monday, November 24, 2025 7:03 PM
To: Kushan, Jeffrey P. <jkushan@sidley.com>; Tyler Liu <TLIU@sternekessler.com>; 'jkushan@sidley.com'; 'leif.peterson@sidley.com'; 'sue.wang@sidley.com'; 'khelm@dechert.com'; 'Blaine.Hackman@dechert.com'; 'amy.mahan@sidley.com'; 'christine.engen@sidley.com'; 'abhatla@sidley.com'; 'Brian.Goldberg@dechert.com'; 'mark.stewart@merck.com'; Halozyme PGRs <HalozymePGRs@sidley.com>

Cc: Lauren Martin <laurenmartin@quinnemanuel.com>; Jennifer Chagnon <JChagnon@sternekessler.com>; David J. Kappos <dkappos@cravath.com>; Aubrey Haddach <ahaddach@halozyme.com>; David H. Holman <DHOLMAN@sternekessler.com>; Josh Mack <jmack@halozyme.com>; Mark Snyder <msnyder@halozyme.com>; Zach Summers <zachsummers@quinnemanuel.com>; Eldora L. Ellison <EELLISON@sternekessler.com>; Louis Panzica <LPanzica@sternekessler.com>
Subject: RE: Merck v. Halozyme PGRs

Jeff,

Below is a draft of the email we intend to send the Board tomorrow afternoon. Please provide any non-argumentative statement Petitioner would like to include in the "Petitioner's position" section noted below. Please respond no later than 1 pm EST tomorrow, 11/25.

Thanks very much,
Trey

Your Honors,
Patent Owner Halozyme requests a conference call with the Board to seek authorization to file a motion for additional discovery on the issue of real party-in-interest ("RPI") as it relates to PGR Nos.:
PGR2025-00003;
PGR2025-00004;
PGR2025-00006;
PGR2025-00009;
PGR2025-00017;
PGR2025-00030;
PGR2025-00024;
PGR2025-00033;
PGR2025-00039;
PGR2025-00042;
PGR2025-00046;
PGR2025-00050;
PGR2025-00053;
PGR2025-00052; and
PGR2025-00087

Petitioner Merck Sharp & Dohme LLC ("MSD LLC"), a wholly-owned subsidiary of Merck & Co, Inc. ("MCI"), has filed 15 Post-Grant Review (PGR) Petitions in the cases noted above. Each of these 15 Petitions identify MSD LLC as the sole RPI. Patent Owner seeks authorization to file a motion for additional discovery to confirm its current understanding that MCI should also have been named as a RPI in all 15 proceedings.

Patent Owner also anticipates seeking authorization to file a motion to dismiss all 15 proceedings for failure to identify all RPI in each Petition after considering all information Petitioner provides in connection with Patent Owner's discovery requests.

These requests are prompted by Director Squires' recent October 28, 2025 precedential designation of *Corning Optical Commc'ns RF, LLC v. PPC Broadband, Inc.*, IPR2014-00440, Paper 68 (P.T.A.B. Aug 18, 2015). The requests also are supported by evidence uncovered by Patent Owner after *Corning* was designated, including relevant MCI SEC filings and information on MCI's websites, indicating that MCI should have been identified as an RPI in all 15 proceedings under now-binding law. Patent Owner first requested additional discovery from Petitioner on November 11 but Petitioner has refused to provide the requested discovery.

Patent Owner has conferred with Petitioner, and Petitioner has confirmed that it opposes Patent Owner's requests for authorization to file any motions on the issue of RPI.

Petitioner's position

Counsel for both parties are available for a teleconference with the Board at the following dates and times, at the Board's convenience:

[[Please provide all Petitioner availability from 11/26-12/4]]

R. Wilson "Trey" Powers III, Ph.D.
Director
Sterne, Kessler, Goldstein & Fox P.L.L.C.
Email: tpowers@sternekessler.com
Direct: 202.772.8876

Administrative Assistant: Cheryl Wagner
Direct: 202.772.8961 **Main:** 202.371.2600

From: Kushan, Jeffrey P. <jkushan@sidley.com>
Sent: Monday, November 24, 2025 1:21 PM
To: Tyler Liu <TLIU@sternekessler.com>; 'jkushan@sidley.com'; 'leif.peterson@sidley.com'; 'sue.wang@sidley.com'; 'khelm@dechert.com'; 'Blaine.Hackman@dechert.com'; 'amy.mahan@sidley.com'; 'christine.engen@sidley.com'; 'abhatla@sidley.com'; 'Brian.Goldberg@dechert.com'; 'mark.stewart@merck.com'; Halozyme PGRs <HalozymePGRs@sidley.com>
Cc: Lauren Martin <laurenmartin@quinnemanuel.com>; Trey Powers <TPOWERS@sternekessler.com>; Jennifer Chagnon <JChagnon@sternekessler.com>; David J. Kappos <dkappos@cravath.com>; Aubrey Haddach <ahaddach@halozyme.com>; David H. Holman <DHOLMAN@sternekessler.com>; Josh Mack <jmack@halozyme.com>; Mark Snyder <msnyder@halozyme.com>; Zach Summers <zachsummers@quinnemanuel.com>; Eldora L. Ellison <EELLISON@sternekessler.com>; Louis Panzica <LPanzica@sternekessler.com>
Subject: RE: Merck v. Halozyme PGRs

EXTERNAL EMAIL: Use caution before clicking links or attachments.

Counsel,

We are surprised that Patent Owner still thinks the RPI issue is relevant to the proceedings after our email. Please send us your proposed email to the Board so that we may add our availability for a call and, if needed, our position before the call. Sending a single email will avoid unnecessarily burdening the Board.

Sincerely,

Jeff Kushan

JEFFREY P. KUSHAN

SIDLEY AUSTIN LLP
+1 202 736 8914
jkushan@sidley.com

From: Tyler Liu <TLIU@sternekessler.com>
Sent: Friday, November 21, 2025 2:58 PM
To: Kushan, Jeffrey P. <jkushan@sidley.com>; 'jkushan@sidley.com'; 'leif.peterson@sidley.com'; 'sue.wang@sidley.com'; 'khelm@dechert.com'; 'Blaine.Hackman@dechert.com'; 'amy.mahan@sidley.com'; 'christine.engen@sidley.com'; 'abhatla@sidley.com'; 'Brian.Goldberg@dechert.com'; 'mark.stewart@merck.com'; Halozyme PGRs <HalozymePGRs@sidley.com>
Cc: Lauren Martin <laurenmartin@quinnemanuel.com>; Trey Powers <TPOWERS@sternekessler.com>; Jennifer Chagnon <JChagnon@sternekessler.com>;

David J. Kappos <dkappos@cravath.com>; Aubrey Haddach <ahaddach@halozyme.com>; David H. Holman <DHOLMAN@sternekessler.com>; Josh Mack <jmack@halozyme.com>; Mark Snyder <msnyder@halozyme.com>; Zach Summers <zachsummers@quinnemanuel.com>; Eldora L. Ellison <EELLISON@sternekessler.com>; Louis Panzica <LPanzica@sternekessler.com>
Subject: RE: Merck v. Halozyme PGRs

Jeff,

Thank you for your email. We intend to seek a call with the Board to request authorization to file a motion for additional discovery. Please provide your availability for a call with the Board on the following days:

1. Tuesday, November 25
2. Wednesday, November 26
3. Monday, December 1
4. Tuesday, December 2

Best,
Tyler

Tyler Liu
Counsel
Sterne, Kessler, Goldstein & Fox P.L.L.C.
Email: tliu@sternekessler.com
Direct: 202.772.8641

Administrative Assistant: Joselyn Ugalde
Main: 202.371.2600

From: Kushan, Jeffrey P. <jkushan@sidley.com>
Sent: Friday, November 21, 2025 1:49 PM
To: Tyler Liu <TLIU@sternekessler.com>; 'jkushan@sidley.com'; 'leif.peterson@sidley.com'; 'sue.wang@sidley.com'; 'khelm@dechert.com'; 'Blaine.Hackman@dechert.com'; 'amy.mahan@sidley.com'; 'christine.engen@sidley.com'; 'abhatla@sidley.com'; 'Brian.Goldberg@dechert.com'; 'mark.stewart@merck.com'; Halozyme PGRs <HalozymePGRs@sidley.com>
Cc: Lauren Martin <laurenmartin@quinnemanuel.com>; Trey Powers <TPOWERS@sternekessler.com>; Jennifer Chagnon <JChagnon@sternekessler.com>; David J. Kappos <dkappos@cravath.com>; Aubrey Haddach <ahaddach@halozyme.com>; David H. Holman <DHOLMAN@sternekessler.com>; Josh Mack <jmack@halozyme.com>; Mark Snyder <msnyder@halozyme.com>; Zach Summers <zachsummers@quinnemanuel.com>; Eldora L. Ellison <EELLISON@sternekessler.com>; Louis Panzica <LPanzica@sternekessler.com>
Subject: RE: Merck v. Halozyme PGRs

EXTERNAL EMAIL: Use caution before clicking links or attachments.

Counsel,

I write in response to your email of November 11, 2026, in which you contend that RPI discovery is warranted by "questions" about the RPI designation in Petitioner's 14 PGR petitions based on the recent designation of the Board's 2015 decision in Corning Optical Communications RF as precedential.

You are incorrect. For there to be a "question" warranting discovery, Halozyme must identify a legitimate basis for alleging that Petitioner's RPI designation in the 14 petitions is incorrect. You have not identified any such basis, and have not provided any evidence supporting your contention that Merck & Co. Inc. ("MCI") is an RPI and that discovery is warranted into this issue. Instead, you simply point out that Petitioner, Merck Sharpe & Dohme LLC ("MSD LLC"), is a wholly owned

subsidiary of MCI, and that "your review of public information to date" somehow gives you reason to believe MCI should have been listed as an RPI in the 14 petitions. The mere existence of a parent-subsidiary corporate relationship does not make the parent company an RPI of the subsidiary. You also do not identify the "public information," explain why it leads you to believe that MCI is an RPI of Petitioner and nowhere explain why Halozyme failed to act on this information earlier in these proceedings.

The parent-subsidiary corporate relationship here is undisputed and has long been known to Halozyme. For example, Halozyme has known of the corporate relationship between MSD LLC and MCI since at least July of this year, when MSD LLC filed its corporate disclosure statement in the co-pending litigation (attached). This also is the second time that Halozyme has made errors about Merck entities, and its allegations here conflict with its prior actions in the district court. As you know, Halozyme incorrectly named "Merck Sharp & Dohme Corp." as the defendant in its complaint in the District of New Jersey. In the interest of avoiding a waste of judicial and party resources with this error, Merck informed Halozyme that the named entity no longer exists, and Merck permitted Halozyme to amend its complaint to name Petitioner, MSD LLC, as the sole defendant. Halozyme has never alleged a cause of action exists against MCI.

For Halozyme to now allege that another Merck entity should be named as an RPI, at the further unnecessary expense of Board and party resources, is inappropriate and not countenanced by Corning Optical. Halozyme waived its ability to raise the RPI issue by failing to raise the issue in its PORs in the -00003, -00004, -00006 and -00009 proceedings. See, e.g., PGR2025-00003, Paper 26, 9. By repeatedly failing to raise the RPI issue in multiple PORs, Halozyme has also waived its opportunity to raise RPI for the other proceedings.

We also inform you, after a reasonable investigation, of the following facts:

1. All of the in-house counsel directing or participating in these proceedings are employees solely of MSD LLC.
2. MSD LLC alone has paid all fees and costs associated with these proceedings.
3. MCI [redacted], and is not directing or participating in these proceedings.

There is no basis for Halozyme to pursue its allegation that MCI as an RPI. Should Halozyme persist in pursing this matter further, Merck reserves its right to pursue all available relief.

Sincerely,

Jeff Kushan

JEFFREY P. KUSHAN

SIDLEY AUSTIN LLP
+1 202 736 8914
jkushan@sidley.com

From: Tyler Liu <TLIU@sternekessler.com>
Sent: Monday, November 17, 2025 5:03 PM
To: 'jkushan@sidley.com'; 'leif.peterson@sidley.com'; 'sue.wang@sidley.com'; 'khelm@dechert.com'; 'Blaine.Hackman@dechert.com'; 'amy.mahan@sidley.com'; 'christine.engen@sidley.com'; 'abhatla@sidley.com'; 'Brian.Goldberg@dechert.com'; 'mark.stewart@merck.com'; Halozyme PGRs <HalozymePGRs@sidley.com>
Cc: Lauren Martin <laurenmartin@quinnemanuel.com>; Trey Powers <TPOWERS@sternekessler.com>; Jennifer Chagnon <JChagnon@sternekessler.com>; David J. Kappos <dkappos@cravath.com>; Aubrey Haddach <ahaddach@halozyme.com>; David H. Holman <DHOLMAN@sternekessler.com>; Josh Mack <jmack@halozyme.com>; Mark Snyder <msnyder@halozyme.com>; Zach Summers

<zachsummers@quinnemanuel.com>; Eldora L. Ellison <EELLISON@sternekessler.com>; Louis Panzica <LPanzica@sternekessler.com>
Subject: RE: Merck v. Halozyme PGRs

Jeff,

It has been nearly one week since we emailed you regarding our request for limited discovery. Please provide Merck's position on whether it will agree to our discovery request by COB tomorrow.

Best,
Tyler

Tyler Liu
Counsel
Sterne, Kessler, Goldstein & Fox P.L.L.C.
Email: tliu@sternekessler.com
Direct: 202.772.8641

Administrative Assistant: Joselyn Ugalde
Main: 202.371.2600

From: Kushan, Jeffrey P. <jkushan@sidley.com>
Sent: Wednesday, November 12, 2025 2:33 PM
To: Tyler Liu <TLIU@sternekessler.com>; Peterson, Leif <leif.peterson@Sidley.com>; Wang, Sue <sue.wang@sidley.com>; brian.goldberg@dechert.com; mark.stewart@merck.com; Halozyme PGRs <HalozymePGRs@sidley.com>
Cc: Lauren Martin <laurenmartin@quinnemanuel.com>; Trey Powers <TPOWERS@sternekessler.com>; Jennifer Chagnon <JChagnon@sternekessler.com>; David J. Kappos <dkappos@cravath.com>; Aubrey Haddach <ahaddach@halozyme.com>; David H. Holman <DHOLMAN@sternekessler.com>; Josh Mack <jmack@halozyme.com>; Mark Snyder <msnyder@halozyme.com>; Zach Summers <zachsummers@quinnemanuel.com>; Eldora L. Ellison <EELLISON@sternekessler.com>; Louis Panzica <LPanzica@sternekessler.com>
Subject: RE: Merck v. Halozyme PGRs

EXTERNAL EMAIL: Use caution before clicking links or attachments.

Tyler,

Merck will respond in due course to your questions. We will need to consult with our client, and due to travel and other logistical issues, it is unlikely we will be able provide an answer to you by tomorrow.

Jeff
JEFFREY P. KUSHAN

SIDLEY AUSTIN LLP
+1 202 736 8914
jkushan@sidley.com

****
This e-mail is sent by a law firm and may contain information that is privileged or confidential.
If you are not the intended recipient, please delete the e-mail and any attachments and notify us immediately.
****

From: Tyler Liu <TLIU@sternekessler.com>
Sent: Tuesday, November 11, 2025 4:26 PM
To: Kushan, Jeffrey P. <jkushan@sidley.com>; Peterson, Leif <leif.peterson@Sidley.com>; Wang, Sue <sue.wang@sidley.com>; brian.goldberg@dechert.com; mark.stewart@merck.com; Halozyme PGRs <HalozymePGRs@sidley.com>

Cc: Lauren Martin <laurenmartin@quinnemanuel.com>; Tyler Liu <TLIU@sternekessler.com>; Trey Powers <TPOWERS@sternekessler.com>; Jennifer Chagnon <JChagnon@sternekessler.com>; David J. Kappos <dkappos@cravath.com>; Aubrey Haddach <ahaddach@halozyme.com>; David H. Holman <DHOLMAN@sternekessler.com>; Josh Mack <jmack@halozyme.com>; Mark Snyder <msnyder@halozyme.com>; Zach Summers <zachsummers@quinnemanuel.com>; Eldora L. Ellison <EELLISON@sternekessler.com>; Louis Panzica <LPanzica@sternekessler.com>
Subject: Merck v. Halozyme PGRs

Counsel,

As you likely know, the USPTO recently designated as precedential *Corning Optical Communications RF, LLC v. PPC Broadband, Inc.*, IPR2014-00440, Paper 68 (PTAB Aug. 18, 2015) (precedential, except for § II.E.1), a PTAB decision addressing the issue of real parties-in-interest (RPI) in AIA proceedings. The designation of *Corning* as binding authority on the Board is highly relevant to our on-going 14 PGRs.

Corning raises the question of whether the 14 PGR petitions should be dismissed for Petitioner's failure to name all RPIs. All 14 PGR petitions list Merck Sharp & Dohme LLC ("MSD LLC" or "Petitioner") as the only RPI. We understand, however, that MSD LLC is a wholly owned subsidiary of its parent company, Merck & Co, Inc. ("Merck & Co"). Based on our review of public information to date, we have reason to conclude, at minimum, that Petitioner should have listed Merck & Co as an RPI in each of the 14 PGR petitions.

As such, we seek limited discovery from Petitioner on this important issue. We hope that the parties can come to an agreement on this discovery quickly, and avoid burdening the Board with motions practice on this issue. With this in mind, we request the following answers to interrogatories and production of the listed documents by COB on Monday, November 17, 2025. We further request that Petitioner provide its position on whether or not it will agree to this request by COB on Thursday, November 13, 2025. This limited request is not overly burdensome and is specifically tailored to the issue at hand.

Interrogatories:

For each of the interrogatories below asking to identify individuals, for each such person, identify the person by name, corporate affiliation, and title.

1. Identify all individuals from Petitioner's parent, subsidiary, and/or affiliate companies that have ever provided direction to Petitioner's counsel of record (at Sidley Austin or Mark Stewart) or reviewed or approved the filing of the petitions and any other papers before the Board in the 14 PGR proceedings brought by Petitioner against Halozyme.
2. Identify all individuals (excluding Petitioner and Petitioner's counsel at Sidley Austin) that have provided support in the form of drafting or reviewing and commenting on the petitions or any other papers filed in any of the 14 PGR proceedings brought by Petitioner against Halozyme.
3. Identify all individuals and entities to whom Petitioner's counsel of record submits its invoices or bills in relation to any of the 14 PGR proceedings brought by Petitioner against Halozyme.
4. Identify all individuals and entities who pay bills from Sidley Austin in relation to any of the 14 PGR proceedings brought by Petitioner against Halozyme.

5. Identify Mark Stewart's official titles with all Merck entities and identify the entity or entities that pay him.
6. Identify all individuals whom Sidley Austin contacts or has contacted regarding instructions, strategy, and funding as it relates to any of the 14 PGR proceedings brought by Petitioner against Halozyme, and identify what specific entity employs each of them.

Documents:

1. Produce representation/engagement letter(s) sent by or to Sidley Austin regarding all of the 14 PGR proceedings brought by Petitioner against Halozyme.
2. Produce engagement letters with declarants Hecht and Park for all of the 14 PGR proceedings brought by Petitioner against Halozyme.
3. Produce all of Mark Stewart's employment agreement(s) in place within the past two years with any Merck affiliated company and any such employment agreements currently in place. The requested documents may redact information relating to compensation or other information unrelated to a job title, description, or obligation.
4. Produce any documents that Petitioner foresees relying on in opposing a motion to terminate any of the 14 PGRs for failure to name all RPIs.

We are amenable to using the Board's default protective order to govern treatment of the discovery we seek. If a phone call would be helpful, we would be happy to schedule one this week.

We look forward to hearing from you.

Best,
Tyler

Sterne Kessler
STERNE KESSLER GOLDSTEIN & FOX

Tyler Liu
Counsel
Sterne, Kessler, Goldstein & Fox P.L.L.C.
1101 K Street NW, 10th Floor, Washington, DC 20005

Email: tliu@sternekessler.com
Direct: 202.772.8641
Administrative Assistant: Joselyn Ugalde
Main: 202.371.2600

Notice: The information in this electronic transmission (including any attachments) may contain confidential or legally privileged information and is intended solely for the individual(s) or entity(ies) named above. If you are not an intended recipient or an authorized agent, you are hereby notified that reading, distributing, or otherwise disseminating or copying, or taking any action based on the contents of this transmission is strictly prohibited. Any unauthorized interception of this transmission is illegal under the law. If you have received this transmission in error, please immediately notify the sender by return email and then destroy all copies of the transmission.