Trials@uspto.gov
571-272-7822

Paper 37
Entered: February 9, 2026

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCK SHARP & DOHME LLC,
Petitioner,

v.

HALOZYME, INC.,
Patent Owner.

PGR2025-00003 (11,952,600 B2)	PGR2025-00046 (12,091,692 B2)
PGR2025-00004 (12,018,298 B2)	PGR2025-00024 (12,060,590 B2)
PGR2025-00006 (12,152,262 B2)	PGR2025-00030 (12,054,758 B2)
PGR2025-00009 (12,123,035 B2)	PGR2025-00052 (12,264,345 B1)
PGR2025-00017 (12,110,520 B2)	PGR2025-00042 (12,037,618 B2)
PGR2025-00033 (12,049,652 B2)	PGR2025-00050 (12,077,791 B2)
PGR2025-00039 (12,104,185 B2)	PGR2025-00053 (12,195,773 B2)

Before JEFFREY N. FREDMAN, SUSAN L. C. MITCHELL, CYNTHIA M. HARDMAN, and MICHAEL A. VALEK, *Administrative Patent Judges*.[1]

PER CURIAM.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5

---

[1] This Order addresses issues in each of the identified proceedings. We exercise our discretion to issue one Order to be filed in each proceeding. The parties are not authorized to use this style heading in subsequent papers. This is not a decision by an expanded panel of the Board. Rather, the listed judges are paneled on various of the listed cases.

Patent Owner Halozyme Inc. filed an authorized motion for additional discovery. Paper 63[2] ("Mot."). Petitioner Merck Sharp & Dohme LLC filed an opposition. Paper 65 ("Opp."). To enable full consideration of Patent Owner's Motion, we order Petitioner to produce certain documents for *in camera* review, as discussed below. Additionally, the parties are ordered to meet and confer on a briefing schedule for Patent Owner's requested motion to terminate, and the panels herein schedule a conference call to discuss the briefing schedule, as further elaborated below.

ANALYSIS

Patent Owner's Pending Discovery Motion

Patent Owner argues that although the Petition names Merck Sharp & Dohme LLC ("MSD") as Petitioner's sole real party-in-interest ("RPI") in the subject proceedings, Petitioner also should have named Merck & Co., Inc. ("MCI"), MSD's corporate parent, as an RPI. Mot. 1. The parties met and conferred, culminating in Petitioner voluntarily producing to Patent Owner various documents requested during the meet and confer process, including (1) payment records relating to funding of these proceedings, (2) agreements showing who retained outside counsel and experts, and (3) internal employment and payroll records. *See* Opp. 1.

Patent Owner contends that Petitioner's document production contains impermissible redactions, and therefore the Motion requests production of unredacted versions of Exhibits 2402–2406, 2426–2430, 2436–2441, and 2443–2444, except to the extent the redacted information is privileged, reflects specific dollar amounts in relation to payment remittances or

[2] We cite Papers and Exhibits in PGR2025-00003. Similar papers and exhibits were filed in all other captioned proceedings.

counsel's compensation, or contains information entirely personal to counsel, such as social security number or home address. Mot. 5–6. Petitioner responds that "[t]he redacted information has no bearing on the RPI issue but contains sensitive information about issues unrelated to the RPI inquiry, like employment terms, outside counsel engagement terms, compensation, accounting records, and personal information." Opp. 6. Petitioner offers to produce the documents for *in camera* review. *Id.* n.2.

After reviewing the parties' briefing and cited documents, we find that Patent Owner fails to sufficiently explain what information it expects to obtain from many of those documents. Based on our review, several documents contain redactions that do not appear to relate to information relevant to whether MCI is an unnamed RPI. For example, Exhibits 2426–2429, 2436–2441, and 2443–2444 are billing and payment records that redact limited information such as account numbers, invoice numbers, payment numbers, matter numbers, and dollar amounts. Exhibit 2430 is an employee earnings statement that appears to redact the employee's address, hours worked, employee ID number, bank details, and payment amount. Patent Owner does not explain—and we do not ascertain—how the redacted information is pertinent to RPI issues.

Exhibit 2404 is an Employment Offer Letter for Petitioner's in-house counsel, Mr. Stewart. Petitioner acknowledges that it has redacted from this document a stock compensation provision, among other information. *See* Mot. 5. We agree with Petitioner that Patent Owner fails to explain why such a provision is relevant to the RPI issue. Opp. 5. Patent Owner also fails to explain—and we do not ascertain—how the other redacted information in this document (relating to compensation and employment benefits) is pertinent to RPI issues. We also agree with Petitioner that Patent

Owner "does not explain how an 'OED document' (Mot., 9) could usurp Mr. Stewart's actual employment agreement" and the other information Petitioner already produced about Mr. Stewart's affiliation with Petitioner MSD. For these reasons, we see no need to order Exhibits 2404, 2426–2429, 2436–2441, and 2443–2444 for *in camera* review and intend to deny Patent Owner's motion to the extent it seeks unredacted versions of the documents in these exhibits.

However, on the current record, we are unable to reach a conclusion regarding the redactions in the following documents:

- Exhibits 2402, 2403 (Engagement Letters for Petitioner's two outside law firms).
- Exhibits 2405, 2406 (Retainer letters for Petitioner's declarants Dr. Hecht and Dr. Park).

For these documents, Patent Owner has offered plausible reasoning why the redactions could, depending on their specific content, contain information that bears on the RPI issue. At the same time, and again depending on the specific content, Petitioner's redactions may be entirely justified. Accordingly, to permit full consideration of Patent Owner's request for production of unredacted versions of these documents, we order that Petitioner file unredacted versions of the documents in Exhibits 2402, 2403, 2405, and 2406 as Board access only, to permit the panels to perform *in camera* inspection of the same.[3] These documents shall be filed no later than **noon ET on Wednesday, February 11, 2026**.

[3] For expediency, Petitioner shall file the documents only in PGR2025-00003 and PGR2025-00033. This will permit each of the paneled judges to access the documents. For purposes of this Order, the panels will consider the documents to have been filed for *in camera* review in each of the above-captioned cases.

Patent Owner's Request for Authorization to File a Motion to Terminate and Conference Call

By email dated February 5, 2026 (of record), Patent Owner requested leave to file a motion to terminate the Petition in each of the above-captioned proceedings for failure to name all RPI. We intend to grant that request and would like to have the briefing in advance of the first of the upcoming hearings (currently set for March 2, 2026 in four of the above-captioned cases). To this end, we ask that the parties meet and confer on a briefing schedule designed so that briefing on the motions is complete by the close of business on February 27, 2026.

The panels hereby set a conference call for **1 pm ET on Thursday, February 12, 2026,** to discuss the issues above and a briefing schedule for the motion to terminate. The Board will send dial-in information to counsel via email in advance of the call. To the extent the parties agree on a briefing schedule (or have competing proposals) after meeting and conferring, please send a joint email to the Board detailing such in advance of the conference call in order to facilitate discussion during that call.

ORDER

It is hereby:

ORDERED that Petitioner shall file Exhibits 2402, 2403, 2405, and 2406 for *in camera* inspection no later than **noon ET on Wednesday, February 11**; and

FURTHER ORDERED that the parties meet and confer regarding a briefing schedule on Patent Owner's motion to terminate as set forth above;

FURTHER ORDERED that a conference call is set for **1 pm ET on Thursday, February 12, 2026**.

FOR PETITIONER:

Jeffrey Kushan
SIDLEY AUSTIN LLP
jkushan@sidley.com

Mark Stewart
MERCK SHARP & DOHME LLC
mark.stewart@merck.com

FOR PATENT OWNER:

Eldora Ellison
Trey Powers
Jennifer Chagnon
Tyler Liu
David Holman
Louis Panzica
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
eellison-ptab@sternekessler.com
tpowers-ptab@sternekessler.com
jchagnon-ptab@sternekessler.com
tliu-ptab@sternekessler.com
dholman-ptab@sternekessler.com
lpanzica@sternekessler.com

Aubrey Haddach
Joshua Mack
HALOZYME, INC.
ahaddach@halozyme.com
jmack@halozyme.com

David Kappos
CRAVATH, SWAINE & MOORE
dkappos@cravath.com

Lauren Martin
QUINN EMANUEL URQUHART & SULLIVAN, LLP
laurenmartin@quinnemanuel.com