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Sent: Thursday, March 12, 2026 10:36:11 AM

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Subject: RE: Merck v. Halozyme PGRs - Request for Board Clarification

Importance: Normal

Sensitivity: None

Counsel,

Given that both sides have already had ample opportunity to introduce evidence on the RPI dispute, neither side is authorized to enter new exhibits into the record other than those specifically authorized by the March 3, 2026 order (i.e., the declaration of Petitioner's witness and the transcript from Patent Owner's deposition of that witness). Patent Owner may introduce documents outside the record during that deposition to aid its cross-examination, but Patent Owner is not authorized to file those documents as exhibits in these proceedings absent express authorization pursuant to a particularized showing of good cause.

Regards,

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Sent: Wednesday, March 11, 2026 4:02 PM

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Subject: Merck v. Halozyme PGRs - Request for Board Clarification

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PGR2025-00003 // U.S. Patent No. 11,952,600
PGR2025-00004 // U.S. Patent No. 12,018,298
PGR2025-00006 // U.S. Patent No. 12,152,262
PGR2025-00009 // U.S. Patent No. 12,123,035
PGR2025-00017 // U.S. Patent No. 12,110,520
PGR2025-00024 // U.S. Patent No. 12,060,590
PGR2025-00030 // U.S. Patent No. 12,054,758
PGR2025-00033 // U.S. Patent No. 12,049,652
PGR2025-00039 // U.S. Patent No. 12,104,185
PGR2025-00042 // U.S. Patent No. 12,037,618
PGR2025-00046 // U.S. Patent No. 12,091,692
PGR2025-00050 // U.S. Patent No. 12,077,791
PGR2025-00052 // U.S. Patent No. 12,264,345
PGR2025-00053 // U.S. Patent No. 12,195,773

Your Honors,

Patent Owner seeks clarification on the Board's Order that "[n]o additional exhibits are authorized" regarding the RPI issue in these proceedings. Specifically, Patent Owner seeks the option of introducing new exhibits during the cross-examination of Petitioner's declarant to test the witness's testimony or impeach the witness. Petitioner opposes the introduction of new exhibits during the cross-examination of Petitioner's declarant.

After the Oral Hearing for the proceedings, the Board issued an Order (Paper 105, dated March 3, 2026) authorizing Petitioner to file a declaration "from a single witness addressing factual assertions in Petitioner's Opposition" to Patent Owner's motion to dismiss for failure to identify all RPI. The Board also Ordered that the parties coordinate to "promptly present its declarant for deposition," and authorized each party to file a brief "addressing the declarant's testimony and its relevance to the RPI issue." In that same Order, the Board stated that "No new exhibits are authorized."

Patent Owner's Position

Patent Owner respectfully seeks authorization to introduce new exhibits during the deposition of Petitioner's declarant specifically to test or impeach the witness's new testimony provided in these proceedings. Patent Owner's request is consistent with the Board's Order. The Board's Order requires "a fair opportunity to cross-examine [Petitioner's] declarant." A fair opportunity to cross-examine Petitioner's declarant requires the ability to test or impeach the declarant's testimony, and depending on the content of Petitioner's declaration, that may require new exhibits. Indeed, introducing exhibits during a deposition of a declarant is customary practice for properly cross-examining a witness. Had Petitioner not waited to request a declaration, Patent Owner would have had the opportunity to cross-examine the declarant with relevant exhibits before briefing on the issue was closed. Patent Owner should not be penalized for Petitioner's delay.

Rather than submit lengthy arguments in this email, Patent Owner respectfully requests an opportunity to discuss this matter on a conference call if the Board is inclined to deny Patent Owner's request.

Petitioner's Position

Petitioner opposes Patent Owner's request to introduce new exhibits during the deposition of Petitioner's declarant.

The Board's Order (Paper 109, dated March 3, 2026) is clear both on its face and in context of the RPI issue overall. This Order followed the denial of Patent Owner's motion for additional discovery, decided after the Board had reviewed *in camera* Petitioner's production, full briefing of Patent Owner's Motion to Terminate filed less than a month before the oral hearing, and oral argument. The sole and limited purpose of this declaration from Petitioner's witness is to address factual issues in dispute. The Board carefully cabined these issues by expressly asking Patent Owner if it disputed Petitioner's factual assertions at the hearing. The Board explained this purpose in its Order and concluded that: "No new exhibits are authorized."

Permitting Patent Owner to introduce new exhibits after the declaration is filed would undermine the finality of the record the Board's Order sought to close and would exceed the limited scope of cross-examination for which authorization was granted. This is the final stage of discovery on this single and limited issue. Exhibits used "to test or impeach the witness's new testimony provided in these proceedings" should already be in the record. Reopening the proceedings to new exhibits permits an unbounded scope of cross examination beyond its intended purpose.

Petitioner reads the Board's order evenhandedly to not permit new exhibits to be filed with the declaration. Authorizing Patent Owner to file new exhibits on cross examination, while not permitting Petitioner to do so on direct, would prejudice Petitioner as the party bearing the burden on the RPI issue. The most practical and efficient course of action is to confirm the Board's original order not authorizing new exhibits.

The parties greatly appreciate a resolution of this matter and are available at the Board's convenience for a call.

Respectfully submitted,

Louis P. Panzica, Jr.
Counsel for Patent Owner

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