

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner,

v.

MERCK SHARP & DOHME CORP.,
Patent Owner.

Case No. IPR2020-00040
U.S. Patent No. 7,326,708

DECLARATION OF ANTHONY H. SHEH

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I, Anthony H. Sheh, hereby declare as follows.

I. INTRODUCTION

1. I am more than 18 years of age and competent to present this declaration based on my personal knowledge of the facts set forth herein.

2. I understand that this declaration is being submitted in support of Patent Owner's Supplemental Brief Regarding *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020). It is intended to provide a limited supplement to the evidentiary record related to the Board's request for additional briefing and evidence regarding the factors articulated in *Apple v. Fintiv*. See Paper 17 at 3 ("FURTHER ORDERED that the filing of limited additional evidence (only that which is absolutely necessary) to address the *Fintiv* factors is authorized; no other new evidence is permitted.").

3. I am a member of the bar of the U.S Patent & Trademark Office, have been an associate at Williams & Connolly since October 2017, and have been designated as backup counsel for Patent Owner in this proceeding.

4. I am actively engaged in the representation of Patent Owner Merck Sharp & Dohme Corp. ("Merck") in this case and in related matters in federal district courts, including the assertion of U.S. Patent No. 7,326,708 (EX1001, "the '708 patent") in *Merck Sharp & Dohme Corp. v. Mylan Pharmaceuticals Inc.*, C.A. No. 19-cv-101-IMK (N.D. W. Va.); *In re Sitagliptin Phosphate ('708 & '921)*

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Patent Litigation, MDL No. 19-2902-RGA (D. Del.); and related cases. I have personal knowledge of the matters referenced below.

5. EX2015 is a true and correct copy of the docket sheet for *In re Sitagliptin Phosphate ('708 & '921) Patent Litigation*, MDL No. 19-2902-RGA (D. Del.), as of April 13, 2020.

6. EX2016 is a true and correct copy of a Stipulation and [Proposed] Order to Amend Scheduling Order, *In re Sitagliptin Phosphate ('708 & '921) Patent Litigation*, MDL No. 19-2902-RGA (D. Del. Mar. 16, 2020), ECF No. 83.

7. EX2017 is a true and correct copy of the docket sheet for *Merck Sharp & Dohme Corp. v. Mylan Pharms. Inc.*, C.A. No. 19-cv-101-IMK (N.D. W. Va.), as of April 13, 2020.

8. EX2018 is a true and correct copy of Defendant's Answer to Plaintiff's Complaint and Counterclaims, *Merck Sharp & Dohme Corp. v. Mylan Pharms. Inc.*, No. 19-cv-101-IMK (N.D. W. Va. May 31, 2019), ECF No. 32.

9. EX2019 is a true and correct copy of Merck and Mylan's Joint Quarterly Status Report, *Merck Sharp & Dohme Corp. v. Mylan Pharms. Inc.*, No. 19-cv-101-IMK (N.D. W. Va. Jan. 3, 2020), ECF No. 50.

10. EX2020 is a true and correct copy of the REDACTED VERSION, Brief in Support of Mylan Pharmaceuticals Inc. and Mylan Inc.'s Motion to Dismiss for Improper Venue and Failure to State a Claim, *Merck Sharp & Dohme*

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Corp. v. Mylan Pharmaceuticals Inc., No. 19-315-RGA (D. Del. Mar. 28, 2019), ECF No. 15.

11. EX2021 is a true and correct copy of the docket sheet for *In re Sitagliptin Phosphate ('708 & '921) Patent Litigation*, MDL No. 2902 (J.P.M.L.), as of April 13, 2020.

12. EX2022 is a true and correct copy of Merck's Memorandum in Support of Motion to Transfer, *In re Sitagliptin Phosphate ('708 & '921) Patent Litigation*, MDL No. 2902 (J.P.M.L. May 15, 2019), ECF No. 1-1.

13. EX2023 is true and correct copy of *In re Sitagliptin Phosphate ('708 & '921) Patent Litigation*, 402 F. Supp. 3d 1366 (J.P.M.L. 2019).

14. EX2024 is a true a correct copy of the docket sheet for *Plastic Omnium Advanced Innovation & Research v. Donghee America Inc.*, No. 16-cv-187-LPS (D. Del.), as of April 13, 2020.

15. Discovery is ongoing in the Delaware MDL proceedings on the issues of infringement and validity of the '708 patent. No MDL defendant has stipulated to infringement of any claim of the '708 patent.

16. To date, Merck has received and objected and/or responded to 14 interrogatories, over 120 requests for production, and 8 requests for admission from the MDL defendants relating to the '708 patent. Merck has propounded a total of 72 interrogatories and 936 requests for production to the MDL defendants,

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and has served a third-party subpoena relating to the '708 patent. The parties have expended substantial time and resources attempting to narrow and/or resolve their discovery disputes.

17. Substantial completion of document production in the Delaware proceedings is due on April 22, 2020. *See* EX2015 (docket entry dated March 17, 2020, so ordering the stipulation at docket entry 83, EX2016).

18. To date, Merck has produced 1,922,357 pages of documents to defendants in MDL No. 19-2902-RGA; Mylan has produced 23,605 pages; and the remaining defendants have produced at least 699,347 pages.

* * *

I hereby declare that all statements made herein of my own knowledge true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Dated: April 14, 2020



Anthony H. Sheh