

From: [Baumgarten, Elise](#)
To: [Zullov, Keith A](#); [Faegenburg, Russell W.](#); [Wong, Jovial](#); [Malik, Jitty](#)
Cc: [Pacchioli, Alissa M.](#); [West, Christopher W.](#); [Radeke, Heike Simone](#); [Van Buskirk, Tedd W.](#); [Teschner, Michael H.](#); [Fundakowski, Claire](#); [Fischer, Sarah](#); [Merck-Sitagliptin](#); [Rapalino, Emily L.](#)
Subject: RE: IPR2020-00040, IPR2020-01045, IPR2020-01060, IPR2020-01072
Date: Tuesday, July 21, 2020 5:19:35 PM

Counsel,

I write to follow up on our meet and confer call from earlier today:

1. With respect to expediting briefing on the Motions for Joinder, Merck agrees to Joinder Petitioners' proposal that they submit one joint reply brief on July 29 with a page limit of 7 pages.
2. As stated on the call, Merck does not agree to withdraw its opposition to the Motions for Joinder in the absence of an agreement from all petitioners to sequence discovery and adjust the schedule so that Merck has the opportunity to seek party discovery in advance of deposing Mylan's expert and submitting its Patent Owner Response. This is supported by the law, as the Board has denied joinder of "me too" petitions that raise discovery issues. *See, e.g., Unified Patents, Inc. v. Personalweb Techs. et al.*, IPR2014-00702, Paper 12 at 4-6 (P.T.A.B. July 24, 2014). Merck understands that Mylan opposes any adjustment to the schedule, and joinder petitioners believe such an adjustment is premature.
3. With respect to other conditions of joinder, Merck believes that the parties have resolved several issues concerning the understudy role.
 - a. First, on the call, Joinder Petitioners agree to withdraw permanently their currently submitted expert reports immediately after Dr. Chorgade is deposed. As long as Mylan remains the lead petitioner, Joinder Petitioners will not rely on any of their own experts. If Mylan ceases participating in the IPR, Joinder Petitioners reserve the right to have the new lead Joinder Petitioner submit and rely on its own expert testimony. But, at no point, should the Joinder Petitioners be allowed to rely on an expert report that they have previously withdrawn. With these clarifications, Merck believes that Merck and the Joinder Petitioners are in agreement.
 - b. Second, Mylan and Joinder Petitioners stated that they both intend to abide by all word count limits that apply to single parties within the PTAB rules. Merck thus believes that Merck and the Joinder Petitioners are in agreement.
 - c. Third, Joinder Petitioners agree to seek prior Board authorization to file any paper or to take any action on their own in the Mylan IPR. Merck thus believes that Merck and the Joinder Petitioners are in agreement.
 - d. Fourth, Joinder Petitioners agree that that they will generally not participate in a speaking role in any telephonic conference or oral argument before the Board in the Mylan IPR. Joinder Petitioners, however, reserve the right to address any party specific

discovery issues. Merck does not oppose Joinder Petitioners right to oppose Merck's requests for party specific discovery. Merck, however, reserves its right to oppose Joinder Petitioners participation in any substantive argument that should be handled by lead petitioner, even if related to party discovery.

- e. Fifth, Merck understands that Joinder Petitioners reserve the right to serve discovery requests on Merck, if Merck serves discovery on Joinder Petitioners. Merck does not agree. It is Merck's position that any discovery requests to Merck should be made by the lead petitioner.

Please let me know if any of this requires clarification.

Elise

Elise M. Baumgarten

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From: Zullow, Keith A <KZullow@goodwinlaw.com>

Sent: Friday, July 17, 2020 11:15 AM

To: Baumgarten, Elise <Ebaumgarten@wc.com>; Faegenburg, Russell W. <rfaegenburg@lerner david.com>; Wong, Jovial <JWong@winston.com>; Malik, Jitty <jitty.malik@katten.com>

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Elise: Teva/Watson, Sun and DRL are available to meet and confer on Tuesday – other than before 11:00 am or from 1:00-3:00 pm.

Regards,

Keith

From: Baumgarten, Elise <Ebaumgarten@wc.com>

Sent: Friday, July 17, 2020 9:33 AM

To: Zullow, Keith A <KZullow@goodwinlaw.com>; Faegenburg, Russell W. <rfaegenburg@lerner david.com>; Wong, Jovial <JWong@winston.com>; Malik, Jitty <jitty.malik@katten.com>