

From: [Faegenburg, Russell W.](#)
To: [Fisher, Stanley](#); [Malik, Jitty](#); [Mahaffy, Shaun](#); [Pacchioli, Alissa M.](#); [West, Christopher W.](#); [Radeke, Heike Simone](#); [Pacchioli, Alissa M.](#); [Van Buskirk, Tedd W.](#); [Teschner, Michael H.](#); [Wong, Jovial](#); [Fundakowski, Claire](#) (CFundakowski@winston.com); [Fischer, Sarah](#); [Zulow, Keith A](#)
Cc: [Merck-Sitagliptin](#)
Subject: RE: IPR2020-00040, IPR2020-01045, IPR2020-01060, IPR2020-01072
Date: Wednesday, July 1, 2020 12:22:38 PM

Stan,

This is in response to your June 26, 2020 letter concerning the joinder motions filed by Teva, DRL and Sun (“Joinder Petitioners”). Our firm represents DRL, but I write on behalf of all three Joinder Petitioners.

Joinder Petitioners agree to a “silent understudy” role as previously stated, and with respect to items 2, 5 and 6 of your letter, Joinder Petitioners agree as follows:

2. Joinder Petitioners will withdraw their respective experts once Dr. Chorghade has submitted all necessary declarations (including any reply declaration) and has been deposed with respect to all of them. In that instance, Joinder Petitioners intend to rely solely on Dr. Chorghade’s opinions and testimony. (Joinder Petitioners have the same comments in response to item 5.b.)

5.a. Joinder Petitioners will not raise any new grounds not already instituted by the Board in the Mylan IPR.

5.c. Joinder Petitioners will not present any additional arguments or IPR briefs. To the extent there is a party-specific issue, each Joinder Petitioner reserves the right to address that issue with its own evidence.

5.d. Mylan will be Lead Petitioner, file all substantive written submissions, conduct all argument at hearings and examine and defend witness depositions. Joinder petitioners will not file additional pages to Mylan’s papers. The deposition timeframes for one party will apply. Joinder petitioners will be bound by discovery agreements between Mylan and Merck. Joinder petitioners will not serve objections to discovery requests served on Mylan and will not serve discovery requests in the Mylan IPR.

All of these conditions regarding item 5.d. apply other than with respect

to party discovery on Joinder Defendants or any issue involving a Joinder Petitioner that is specific to that Petitioner. For example, although Joinder Petitioners generally agree not to file substantive papers in the Mylan IPR, each Joinder Petitioner reserves the right to file papers relating to any party-specific issue that applies to that Petitioner, and will seek Board authorization to file any such paper or to take any action on its own. Likewise, if Merck were to seek party discovery from one of the Joinder Petitioners, that Petitioner would reserve the right to respond appropriately, including by resisting such discovery and by issuing its own request for discovery.

6. Joinder Petitioners confirm that if Mylan is no longer a party, they will meet and confer to select a new Lead Petitioner to step into Mylan's shoes and Joinder Petitioners will be bound by the same conditions already in place.

With respect to items 1, 3 and 4 of your letter, Joinder Petitioners disagree that Merck has identified any basis to seek party discovery, and the discovery matters you discuss are, therefore, premature and not pertinent to the joinder inquiry.

You have only purported to identify a basis for discovery from Teva, not from either DRL or Sun. Even as to Teva, you have not identified specifically what you are seeking beyond documents and testimony readily available from public patent office proceedings, or even how any of the information from such proceedings is inconsistent with Teva's invalidity arguments in the present IPR. Teva is willing to further meet and confer with Merck to understand the specific discovery Merck will be seeking from Teva.

Given that Merck has not yet established any right to party discovery, and its ability to obtain party discovery is speculative, Merck has not established a basis to alter the schedule in the Mylan IPR based on proposed joinder. As stated above, and in Joinder Petitioners' motion papers, Joinder Petitioners are "me too" Petitioners and have agreed to the same "understudy" conditions on which the Board has previously relied in permitting joinder. If Merck wishes to pursue discovery, either now or at some time in the future, it is free to make a motion for discovery and, if it chooses, to make an application to extend the IPR schedule. Joinder Petitioners, if joined, will comply with any change that the Board orders with respect to the schedule in the Mylan IPR.

Sincerely yours,

Russ

From: Fisher, Stanley [mailto:SFisher@wc.com]
Sent: Wednesday, July 1, 2020 8:54 AM
To: Malik, Jitty; Mahaffy, Shaun; Pacchioli, Alissa M.; West, Christopher W.; Radeke, Heike Simone; Pacchioli, Alissa M.; Van Buskirk, Tedd W.; Teschner, Michael H.; Faegenburg, Russell W.; Wong, Jovial; Fundakowski, Claire (CFundakowski@winston.com); Fischer, Sarah; Zullo, Keith A
Cc: Merck-Sitagliptin
Subject: RE: IPR2020-00040, IPR2020-01045, IPR2020-01060, IPR2020-01072

[EXTERNAL E-MAIL]
Counsel,

Merck reserves all rights to oppose joinder, and if joinder is ordered, to seek party discovery in advance of the deposition of Dr. Chorghade, along with a reasonable adjustment to the schedule to accommodate party discovery. Do any of the other Petitioners (Teva, Sun, or DRL) intend to respond to my June 26 letter, which was an attempt to narrow the issues and potentially obviate an opposition to joinder?

Assuming the Board denies the joinder motions, Merck has no objection to a remote deposition for Dr. Chorghade at the end of July. July 22 does not work for Merck; we are available the following week on any of July 29-31. Please let me know if one of those days works for Mylan to tentatively schedule Dr. Chorghade's deposition.

Thank you,
Stan

Stanley E. Fisher
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From: Malik, Jitty <jitty.malik@katten.com>
Sent: Monday, June 29, 2020 1:35 PM
To: Mahaffy, Shaun <SMahaffy@wc.com>; Pacchioli, Alissa M. <alissa.pacchioli@katten.com>; West, Christopher W. <christopher.west@katten.com>; Radeke, Heike Simone <heike.radeke@katten.com>; Pacchioli, Alissa M. <alissa.pacchioli@katten.com>; Van Buskirk, Tedd W. <tvanbuskirk@lernerdavid.com>; Teschner, Michael H. <mteschner@lernerdavid.com>; Faegenburg, Russell W. <rfaegenburg@lernerdavid.com>; Wong, Jovial <JWong@winston.com>; Fundakowski, Claire (CFundakowski@winston.com) <CFundakowski@winston.com>; Fischer, Sarah <SFisher@goodwinlaw.com>; Zullo, Keith A <KZullo@goodwinlaw.com>
Cc: Merck-Sitagliptin <MerckSitagliptin@wc.com>
Subject: RE: IPR2020-00040, IPR2020-01045, IPR2020-01060, IPR2020-01072

Counsel,

Mylan is in receipt of your letter. To that end, and speaking only on behalf of Mylan, Mylan remains opposed to any change in the current schedule. See IPR2020-00040 (Paper 32). To that end, Dr. Chorghade will be made available for his deposition on July 22nd. Due to the current COVID pandemic, and for the health and safety off all concerned, Dr. Chorghade will be made available only for a remote deposition. Please let Mylan know if Merck has any objection to proceeding on this date.

Thanks,

Jitty

Jitendra (“Jitty”) Malik Ph.D.

Partner

Katten

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From: Mahaffy, Shaun <SMahaffy@wc.com>

Sent: Friday, June 26, 2020 5:22 PM

To: Malik, Jitty <jitty.malik@katten.com>; Pacchioli, Alissa M. <alissa.pacchioli@katten.com>; West, Christopher W. <christopher.west@katten.com>; Radeke, Heike Simone <heike.radeke@katten.com>; Malik, Jitty <jitty.malik@katten.com>; Pacchioli, Alissa M. <alissa.pacchioli@katten.com>; Van Buskirk, Tedd W. <tvanbuskirk@lerner david.com>; Teschner, Michael H. <mteschner@lerner david.com>; Faegenburg, Russell W. <rfaegenburg@lerner david.com>; Wong, Jovial <JWong@winston.com>; Fundakowski, Claire <CFundakowski@winston.com> <CFundakowski@winston.com>; Fischer, Sarah <SFischer@goodwinlaw.com>; Zullo, Keith A <KZullo@goodwinlaw.com>

Cc: Merck-Sitagliptin <MerckSitagliptin@wc.com>

Subject: IPR2020-00040, IPR2020-01045, IPR2020-01060, IPR2020-01072

EXTERNAL EMAIL – EXERCISE CAUTION

Counsel,

Please see the attached correspondence.

Regards,
Shaun

Shaun P. Mahaffy

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