UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Merck Sharp & Dohme LLC, Petitioner,

v.

Halozyme Inc., Patent Owner.

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Case No. PGR2025-00017 U.S. Patent No. 12,110,520

Declaration of Michael Hecht, Ph.D.

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I. Introductory Matters

A. Background and Qualifications

1. My educational background, career history, and other relevant qualifications are summarized below. I attach to this Declaration my curriculum vitae, which provides a full and accurate description of my educational background, professional experience, and qualifications.

2. I received my Ph.D. in Biology from Massachusetts Institute of Technology in 1984. My Ph.D. thesis was on the topic of "The Effect of Amino Acid Replacement on the Structure and Stability of the N-terminal Domain of λ-Repressor." I received a Bachelor of Arts in Chemistry from Cornell University in 1977. For my B.A., I wrote a Thesis regarding Studies of the α -helical Propensities of Amino Acids in Synthetic Copolymers. I completed my Post-Doctoral work at Duke University from 1986 to 1989 in the Department of Biochemistry, where I conducted research on the Design of Novel Proteins.

3. I currently serve as Professor of Chemistry at Princeton University. I have been a professor at Princeton since 1990. I served as Associate Chair of the Chemistry Department from 2004-2007. From 2011-2008 I was Director of Undergraduate Studies for the Department of Chemistry. I was Master (Head) of Forbes College at Princeton from 2010-2018.

4. I am currently teaching courses in General Chemistry and Principles of Macromolecular Structure: Protein Folding, Structure and Design.

5. I have over 4 decades of experience in the field of protein structure and design. My research interests include de novo protein design, synthetic biology, and protein folding and design. In my laboratory, we explore protein design and synthetic biology to explore novel proteins. Since 1978, I have authored over 90 peer-reviewed publications, most of which are directed to these topics.

Petitioner Merck 6. In 2024, one half of the Nobel Prize in chemistry was awarded to David Baker for "computational protein design," and the other half went to Demis Hassabis and John Jumper for their work in "protein structure prediction," specifically their AI model called AlphaFold2. The Nobel committee's write-up of other notable contributions in the field of protein design included a description of my earlier work. See https://www.nobelprize.org/uploads/2024/10/advancedchemistryprize2024.pdf ("Four-helix bundles thus became common targets for protein design in the early years of this field, and the concept of a 'binary code' with hydrophobic and hydrophilic amino acid residues was further elaborated by Hecht and coworkers. These researchers conducted a large library of synthetic genes coding for the same pattern of polar and nonpolar residues and showed that most of the designed protein sequences folded into compact α -helical structures.")

EX1003, p. 2

(citing my 1993 paper entitled "Protein design by binary pattering of polar and nonpolar amino acids" in Science, 262, 1680-1685).

7. Since 2003, I have been on the Editorial Advisory Board of Protein Science and Protein Engineering, Design & Selection. In 2014, I organized a National Science Foundation Workshop on the Future of Protein Engineering & Design.

8. I was a National Science Foundation Graduate Fellow from 1979- 1983, and a Life Sciences Research Foundation Burroughs-Wellcome Postdoctoral Fellow from 1986-1989. I won the Protein Society's Kaiser Award in 2003.

9. Since 1991, I have supervised 14 post-doctoral researchers, 32 graduate students in chemistry and molecular biology, and the senior thesis of 75 undergraduate students in chemistry and molecular biology.

B. Compensation

10. I am being compensated for my time at the rate of \$700 per hour for my work in connection with this matter. I am being reimbursed for reasonable and customary expenses associated with my work in this investigation. This compensation is not dependent in any way on the contents of this Declaration, the substance of any further opinions or testimony that I may provide, or the ultimate outcome of this matter.

C. Person of Ordinary Skill in the Art

11. I understand that my analysis and opinions are to be provided using the perspective of a person of ordinary skill in the art in the timeframe before December 29, 2011. I will refer to this as the "2011 timeframe" in this declaration.

12. The scientific field of the patent concerns proteins, and more particularly, protein structures and modification of them. I am very familiar with this field, and the individuals who work within it, including in the 2011 timeframe.

13. I have been informed by counsel that a person of ordinary skill in the art is a hypothetical person who is presumed to have the typical skills and knowledge of someone working in the field of the invention. Based on my review of the patent and my experience, I believe a person of ordinary skill in the art (who I may refer to as "a skilled artisan") would have had an undergraduate degree, a Ph.D., and post-doctoral experience in scientific fields relevant to study of protein structure and function (*e.g.*, chemistry, biochemistry, biology, biophysics). From training and experience, the person would have been familiar with factors influencing protein structure, folding and activity, production of modified proteins using recombinant DNA techniques, and use of biological assays to characterize protein function, as well with techniques and tools used to analyze protein structure (*i.e*., sequence searching and alignments, protein modeling software, etc.).

14. In the 2011 timeframe, I had at least the qualifications I outline above for a person of ordinary skill in the art. The opinions I provide in this declaration are provided from the perspective of a person of ordinary skill in the art in the 2011 timeframe as I have described it above.

D. Terminology Used in this Declaration; Patent Documents

15. I will use the following abbreviations and terminology in this declaration:

- (a) "PH20" refers to the human PH20 protein. In its full-length form (including its 35 amino acid signal sequence) it has 509 amino acids. Its amino acid sequence was first published in 1993 .¹ Its sequence also is reported as:
	- UniprotKB Accession ID P38567;
	- SEO ID NO:1 in U.S. Patent No. 7,767,429; and
	- SEQ ID NO:6 in U.S. Patent No. 12,110,520.
- (b) When I refer to the "mature" protein sequence of PH20, I am referring to the form of the protein without the signal sequence. So, for example, the mature form of PH20 having amino acids from positions

 \overline{a} ¹ EX1029 (Gmachl), 546, Fig. 1.

36 to 509 of Uniprot ID: P38567, would have numbering that starts at position 1 and ends at position 474.

- (c) I will use "PH20_{1-n}" to refer to a human wild-type PH20 polypeptide sequence that starts at position 1 and terminates at position "n" of the PH20 sequence. If I do not indicate otherwise, the sequence that is being referred to is the mature form of the protein without the signal sequence. For example, $PH20₁₋₄₄₇$ means the polypeptide starting at position 1 and ending at position 447 of the mature human wild-type PH20 sequence (which would be 36 to 482 if numbering includes the signal sequence).
- (d) "AxxxB" refers to an amino acid substitution at position xxx, where the wild-type residue is A and the residue after the substitution is B.

16. I was asked to assess two patent documents. One is an issued U.S. Patent, which has the number 12,110,520, which I refer to as the '520 Patent (EX1001). The other is a U.S. patent application having the number 13/694,731, which I will refer to as the '731 Application (EX1026).

17. I understand that the disclosure of a patent consists of a narrative section called the specification, often includes drawings, and may contain sequence listings, which are nucleotide or amino acid sequences. I understand that each

sequence in the patent will be assigned a number for easy reference (*e.g.*, SEQ ID NO: 3). I understand that patents end with claims that define the invention.

18. I reviewed the contents of the '520 Patent, as well as the '731 application. I also reviewed a redline comparison of the specifications of the '520 Patent and the '731 application (EX1045). Based on that review, the two specifications appear to be substantively the same. Because the two patent documents have the same disclosures, I will refer to the two of them together as the "common disclosure" in this declaration. For convenience, citations will be the disclosure in the '520 Patent.

E. Materials Considered

19. My opinions are based on my years of education, research, and experience, as well as my investigation and study of relevant materials. I reviewed a number of publications in the course of my assessment, including those listed in the Exhibit List. I also relied on my extensive familiarity with the scientific literature in this field.

20. I also reviewed a declaration by Dr. Sheldon Park provided to me by counsel (EX1004). Based on my review, Dr. Park's declaration provides an accurate description of how a person of ordinary skill in the art in the 2011 timeframe would have approached the task of identifying single amino acid substitutions in non-essential regions of PH20 that would have been expected to be

tolerated by the protein, and is the type of analysis I would rely upon from others working in my lab in evaluating mutated proteins. Dr. Park's declaration also provides an accurate description of the techniques that were being used in the 2011 timeframe to find structurally similar proteins, analyze them using sequence alignment tools, identify conserved and evolutionarily varying positions in the related proteins, and use protein structure models to assess the tolerance of the protein to individual amino acid substitutions.

21. I reviewed Dr. Park's discussion of the tools he used in his analysis, such as BLAST, Clustel Omega, SWISS-MODEL and PyMol. See EX1004 (Park Dec.), ¶¶ 20-24, 154-179. I am familiar with these tools. I also agree with Dr. Park that while the tools in their modern incarnation have different forms and additional capabilities relative to the versions of the tools that existed in 2011, the analyses Dr. Park performed using them relied on features that would have been present in the versions that existed in the 2011 timeframe. For example, sequence alignments performed by the Clustal Omega tool rely on algorithms that were largely developed in the 1990s and produce outputs that are typically evaluated manually by the user to confirm the accuracy of the alignments.

22. Like Dr. Park, I also would have expected that structural models produced by the SWISS-MODEL tool today for PH20 would be very similar the models for PH20 that would have been produced by that tool in the 2011

timeframe. EX1004 (Park Dec.), ¶¶ 161-174. As Dr. Park points out, the template that SWISS-MODEL used to produce the PH20 models was the HYAL1 structure published by Chao et al. in 2007 (EX1006) (structure ID: 2PE4). I also agree with Dr. Park's observation that even if there were subtle differences in the positioning of certain side chains in the PH20 model relative to a model generated in the 2011 timeframe, those differences would not have affected the overall assessment that a scientist would have made, which are based on a visual assessment of individual substitutions within the PH20 structure.

F. Legal Principles

23. I am not a lawyer and am not offering opinions on the law. However, I have been provided a general explanation of some of the legal requirements for obtaining a patent.

24. I have been informed that a patent's disclosure consists of the information in the specification, along with any drawings and sequence listings that accompanied the patent application. When I use the term "patent disclosure," I am using it with this understanding.

25. I have been informed that a patent claiming a set (or "genus") of chemical compounds (*e.g*., polypeptides) must be supported by the patent disclosure, and that there are two distinct disclosure requirements, as summarized in the following paragraphs.

26. I have been informed that one of the disclosure requirements is that the patent disclosure provide a sufficient written description of the claimed set of polypeptides ("written description" requirement). I have been informed that this can be achieved by a patent disclosure that describes either (i) "a representative number of species falling within the scope of the genus" or (ii) "structural features common to the members of the genus," with either being such that "one of skill in the art can 'visualize or recognize' the members of the genus." I have been informed that an adequate written description of a genus of polypeptides "requires a precise definition, such as by structure, formula, chemical name, physical properties, or other properties, of species falling within the genus sufficient to distinguish the genus from other materials." I also have been informed that a description that is *"*merely drawing a fence around the outer limits of a purported genus is not an adequate substitute for describing a variety of materials constituting the genus and showing that one has invented a genus and not just a species."

27. I have been informed a second disclosure requirement is that the patent disclosure provide a description that enables a skilled artisan to practice the claimed invention without engaging in undue experimentation ("enablement" requirement").

28. I have been informed that if a patent claims an entire class of compounds (*e.g.*, polypeptides), the patent's specification must enable a person

skilled in the art to make and use the entire class, which means the specification must enable the full scope of the invention as defined by its claims. I have also been informed that a research plan that requires a skilled artisan to perform trial and error procedures in order to discover which members of a large class of polypeptides have a desired functional property is not sufficient to satisfy the enablement requirement.

29. I have also been informed that factors such as the breadth of the claims, unpredictability in the field, the degree of guidance in the prior art and in the patent disclosure, and the level of skill of the skilled artisan are factors, among others, that are considered in assessing the question of enablement.

30. I have been informed that a separate patentability requirement is that an invention must not have been obvious to a person of ordinary skill in the art in view of what was known in the prior art before the filling date of the patent. I also have been informed that if a patent claim encompasses a compound that would have been obvious in light of the prior art, that claim is unpatentable.

31. I have been informed that for a claimed compound to be found obvious, a person of ordinary skill in the art must have found a reason in the prior art to make that compound, and must have had a reasonable expectation of success in achieving the claimed invention. I have been informed this does not require the skilled artisan to have absolute certainty about achieving a desired result, and that

an invention can be found obvious if a result is expected but still requires some experimentation to confirm.

32. I have been informed that if a particular compound exhibits unexpected properties, that evidence can support a finding that the compound is not obvious. For a claim defining a large class of compounds, the members of the class must share the unexpected property to support a finding that the class of compounds is not obvious. A claim defining a large class of compounds cannot benefit from evidence showing only one compound exhibits a particular unexpected property. Instead, the evidence must demonstrate that the unexpected property is shared by the entire class of claimed compounds.

II. Scientific Principles

33. The common disclosure discusses modified forms of a human hyaluronidase enzyme called PH20, which is one of five related hyaluronidase enzymes found to occur in humans.

34. The focus of the patent claims, as I explain below, are modified PH20 polypeptides that have incorporated at least one amino acid substitution at position 324, and optionally may incorporate 20 to 41 additional substitutions at any other position in the wild-type sequence of 37 different PH20 polypeptides of varying length, depending on the parameters of each claim.

35. The scientific fields relevant to the subject matter of the patent are protein structure and engineering. Two textbooks that provide a useful orientation to protein structure principles are: (i) Brandon & Tooze (EX1014) (chapters 1-6 and 17) and (ii) Alberts (EX1039) (chapter 3). $²$ </sup>

A. Protein Structure Basics

36. Proteins are formed by sequences of amino acids, but the feature of each protein that confers its unique biological function(s) is its overall threedimensional structure.³ That overall structure results from folding of the amino acid sequence of the protein (its "primary structure"). The sequences initially fold into regions of characteristic "secondary structures" (*e.g*., alpha-helices, betastrands, loop regions). Sets of secondary structures then are positioned and arranged to form structural motifs, and those motifs and other sequences pack together to form compact globular units called domains, of which there may be one or several in the protein. That higher order structure is the "tertiary structure" of the protein. Multiple polypeptides can also form complexes, referred to as the "quaternary structure" of the protein. PH20 consists of a single polypeptide chain.

² Brandon & Tooze (EX1014) ("Brandon") is a textbook which I have used in the graduate course that I teach for many years.

³ EX1014 (Brandon), 3-11.

37. Amino acids are generally classified based their chemical attributes, which are dictated by the side chain of the amino acid. Amino acids can be classified in different ways. For example, at a high-level, amino acids can be classified as being polar or non-polar, with subsets of polar residues being charged (positively or negative) or uncharged.⁴ Amino acids also have varying sizes, which can influence their ability to fit into defined protein structures.

POLAR AMINO ACIDS

NONPOLAR AMINO ACIDS -

Figure 3-2 The 20 amino acids found in proteins. Each amino acid has a three-letter and a one-letter abbreviation. There are equal numbers of polar and nonpolar side chains; however, some side chains listed here as polar are large enough to have some non-polar properties (for example, Tyr, Thr, Arg, Lys). For atomic structures, see Panel 3-1 (pp. 128-129).

⁴ EX1039 (Alberts), 127.

38. Some amino acids have diverse chemical characteristics. For example, lysine (K) and arginine (R) have terminal amine groups (which are hydrophilic) and long aliphatic chains (which have a hydrophobic character).⁵ Other amino acids incorporate ring structures (*e.g*., tryptophan (W), phenylalanine (F), tyrosine (Y), histidine (H), proline (P)), which are rigid and may be aromatic. Cysteine (C) has the unique ability to form covalent disulfide bonds with other cysteines, which confers significant structural stability to areas of protein structure. The diversity of characteristics of amino acid side chains contributes to the incredible diversity of structures that proteins have.

39. Folded proteins generally are arranged to have a hydrophobic interior and a hydrophilic surface. The backbone or primary chain has a polar character,

⁵ EX1014 (Brandon), 6-7.

which is hydrophilic and not energetically favored within a hydrophobic environment.⁶

40. Secondary structures formed out of characteristic patterns of amino acids, however, offset this intrinsically polar character of the backbone chain within the hydrophobic interior of proteins. Secondary structures form energetically favored structures within the backbone via hydrogen bonding between backbone NH and C'=O groups. The secondary structures then pack together to form motifs and higher order structures, both of which further stabilize the interior of the protein structure.

41. There are two general classes of secondary structures: (i) the alphahelix (α -helix), and (ii) the beta-sheet (β -sheet) (illustrated below).⁷

⁶ EX1014 (Brandon), 14.

⁷ EX1039 (Alberts), 134-135.

Figure 3-7 The regular conformation of the polypeptide backbone in the α helix and the β sheet. <GTAG> <TGCT> (A, B, and C) The α helix. The N-H of every peptide bond is hydrogen-bonded to the C=O of a neighboring peptide bond located four peptide bonds away in the same chain. Note that all of the N-H groups point up in this diagram and that all of the C=O groups point down (toward the C-terminus); this gives a polarity to the helix, with the C-terminus having a partial negative and the N-terminus a partial positive charge. (D, E, and F) The ß sheet. In this example, adjacent peptide chains run in opposite (antiparallel) directions. Hydrogen-bonding between peptide bonds in different strands holds the individual polypeptide chains (strands) together in a β sheet, and the amino acid side chains in each strand alternately project above and below the plane of the sheet. (A) and (D) show all the atoms in the polypeptide backbone, but the amino acid side chains are truncated and denoted by R. In contrast, (B) and (E) show the backbone atoms only, while (C) and (F) display the shorthand symbols that are used to represent the α helix and the β sheet in ribbon drawings of proteins (see Panel 3-2B).

42. There are numerous variants of each class of secondary structure, each associated with characteristic patterns, spacing and types of amino acids in the polypeptide sequence. The structures are, to varying degrees, sensitive to the positioning and patterns of residues, as well as to the types of amino acids that may be in those positions.⁸ For example, certain amino acids tend to favor being within a helical structure (*e.g*., leucine), while others disfavor such structures if incorporated into a sequence that would ordinarily form an α -helix or β -sheet.⁹

43. The side chains of amino acids participating in a α -helix or β -sheet will either be directed to the interior of the secondary structure or directed to the

⁸ See generally, EX1014 (Brandon), 16-20; EX1039 (Alberts), 131-135.

⁹ EX1014 (Brandon), 353-4.

exterior of it. The interior is hydrophobic, while the exterior will generally be solvent accessible. However, when the secondary structures are packed together, the exterior facing side chains may interact with side chains of amino acids in other secondary structures (which may be a hydrophobic environment), and the effects of those interactions may be stabilizing or destabilizing.

44. Structural motifs form from combinations and arrangements of secondary structures, and those structural motifs, in turn, pack together to form the higher order structure that characterizes a protein domain. There are numerous influences on how these structural motifs are formed and stabilized.

45. For example, sequences that form secondary structures are often separated by stretches of amino acids of varying lengths. The nature and length of those intervening sequences influence how secondary structures on either end of the intervening sequence can interact with each other or with other secondary structures in the protein. To illustrate this, consider the figures below, which shows schematically how different lengths of intervening sequences between β sheet secondary structures influence the packing of pairs of beta sheets and then the structural motifs created by those pairs into a higher order structure.¹⁰

¹⁰ EX1014 (Brandon), 77-78.

46. The specific amino acids in specific positions of an amino acid sequence also play a critical role in inducing the folding of the protein into its destined structure, as well as in maintaining that structure.¹¹

B. Protein Engineering

1. Rational Design vs. Directed Evolution

47. Protein engineering aims to create novel proteins not found in nature with desired properties. At a conceptual level, there are two approaches for

 \overline{a} ¹¹ EX1039 (Alberts), 125-130.

creating engineered proteins, referred to as "rational design" and "directed evolution."¹²

48. "Rational design" involves an in-depth study of the structural features of a protein and their contribution to the stability and function(s) of the protein. The insights derived from that study are used with knowledge of protein structure principles to devise a modified sequence that will alter the protein's structural features in an intended manner to yield a protein that meets the goal of the engineering project (*e.g.*, greater stability, higher activity).¹³

49. Various computational tools are used in rational protein design. For example, an important part of the analysis of a protein is one focused on evolutionary-related, homologous proteins. Creating an alignment of homologous proteins helps to identify conserved residues and positions where variation in the residue occurs (and thus is tolerated in the proteins).¹⁴ The other important tool is the structural model of the protein, which can be generated using automated procedures, such as the SWISS-MODEL server. The protein engineer used these

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¹² EX1059 (Leisola), 1225-1227; EX1018 (Chica), 378-379; EX1017 (Green), 223.

¹³ EX1018 (Chica), 378.

¹⁴ EX1017 (Green), 224-228.

models to visualize parts of the protein structure, and consider spatial interactions between the different residues.¹⁵

50. There were limits to using rational design techniques in the 2011 timeframe.¹⁶ For example, modifying a known protein to incorporate a single amino acid change in a sequence responsible for a known secondary structure that was not essential to the protein's functions was fairly straightforward. In that setting, one determines the interactions of the new amino acid with other residues in the static environment of the position being changed. In contrast, devising a sequence incorporating 10 substitutions into a region where the set of ten can influence each other or several discrete structures in the protein was an exponentially more challenging exercise. There, the environment of each change is not static and will likely be influenced by the other changes being made. The

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¹⁶ EX1018 (Chica), 378 (rational design "requires an in-depth knowledge of the structural features of the enzyme active site and their contribution to function. The complexity of the structure/function relationship in enzymes has proven to be the factor limiting the general application of rational design."); EX1059 (Leisola), 1225-1226.

¹⁵ EX1017 (Green), 227-230.

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complexity escalates rapidly with the number of changes being made, with a corresponding increase in the magnitude of work that must be performed.

51. Directed evolution arose out of the limits of rational design.¹⁷ It has the same goal of producing a protein with a modified sequence that gives it desired properties. However, it aims to bypass the complexity and difficulty of devising that modified sequence *a priori*. In "directed evolution," one generates large libraries of mutant proteins with randomly distributed mutations using genetic methods, then screens those libraries to find mutants having the desired properties. The mutants with those properties are then isolated and characterized. Those mutant proteins with enhanced properties are then chosen and the modified amino acid sequence of the mutant protein is recorded.

52. The challenge with directed evolution is scale.¹⁸ One has to identify the successful mutant out of an immense number of possibilities, which presents

- ¹⁷ EX1059 (Leisola), 1225-1226 ("However, because the difficulty is likewise indisputable, any approach that might succeed sooner is worth exploring. That realization has motivated work at the other end of the spectrum, where the emphasis is on finding what works rather than predicting what works.").
- ¹⁸ EX1018 (Chica), 378 ("Because large numbers of mutants must generally be screened to obtain a significant, desired effect on enzyme activity, the main

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different kinds of challenges. Most significantly, it requires sophisticated methodologies for generating mutations likely to yield beneficial changes, highly efficient, rapid and accurate screening methods that identify mutants which have desired properties (and which avoid those that do not), and efficient recovery and characterization techniques. It also depends on the science—the desired function must be physically possible in the protein, and it must be possible for a protein to incorporate mutations that deliver that function. A 2009 paper summarizes factors first articulated by Dr. Francis Arnold at Caltech that provide a good description of these requirements for a successful directed evolution campaign:

1. The desired function must be physically possible.

2. The function must also be biologically or evolutionarily feasible. In practice, this means that there exists a mutational

limitation of directed evolution is the necessity of developing a highthroughput screening methodology that allows identification of the desired property under relevant conditions. Not all enzyme activities are readily amenable to developing a high-throughput screening method, nor are all screening methodologies easy to implement at the required scale."); EX1059 (Leisola), 1227 ("You must have a rapid screen or selection that reflects the desired function.").

pathway to get from here to there through ever-improving variants.

3. You must be able to make libraries of mutants complex enough to contain rare beneficial mutations.

4. You must have a rapid screen or selection that reflects the desired function.¹⁹

53. A concise summary of the two alternative approaches was provided in a 2009 paper by Leisola and Turunen:

> At one end is an approach commonly referred to as a rational design, which aims to understand the principles of protein structure and function well enough to apply them in designing new properties or even novel proteins using de novo design. The value of this approach in purely scientific terms is indisputable. However, because the difficulty is likewise indisputable, any approach that might succeed sooner is worth exploring. That realization has motivated work at the other end of the spectrum, where the emphasis is on finding what works rather than predicting what works.²⁰

¹⁹ EX1059 (Leisola), 1226-1227.

²⁰ EX1059 (Leisola), 1226, Figure 1.

2. Challenges with Predicting the Effects of Multiple Mutations in Proteins

54. Introducing a single mutation into a protein's sequence can be highly impactful if the substituted residue plays a critical role in the function of the protein (*e.g*., a residue involved in catalysis mediated by the protein) or is a conserved amino acid necessary to an essential structure or function of the protein. By contrast, single amino acid substitutions at positions that are fully solvent exposed (*i.e*., interacts primarily with water molecules rather than other residues of the protein) or at a non-conserved position that varies extensively within a set of homologous, naturally occurring variants of the protein are often tolerated. Of course, each change needs to be assessed on a case-by-case basis that considers each amino acid's unique characteristics and the environment within the protein where the change is being made.

55. Introducing multiple mutations into the amino acid sequence of a protein is a different story. Because so many secondary structures are dependent on particular patterns of amino acids with the correct spacing and character of amino acids at different positions, changing many amino acids simultaneously risks disrupting the pattern necessary to induce formation of the original secondary

structure. Eliminating or altering a secondary structure can prevent the protein from folding and be highly destabilizing to the overall protein structure.²¹

56. Introducing multiple substitutions into a protein's amino acid sequence will introduce many new steric and/or chemical interactions between amino acids that can influence the protein's overall structure. There are a variety of such interactions possible depending on each pair of amino acids being considered (illustrated in figure below).²² Any single substitution may impact numerous interactions, and potentially with competing effects (*e.g*., some beneficial and some adverse to the protein's stability). Examples of non-covalent interactions that occur between residues within a protein structure are listed below:

- (a) Hydrogen bonds: These occur between a hydrogen atom and an electronegative atom like oxygen or nitrogen and are energetically favorable.
- (b) Ionic interactions: Also known as salt bridges, these occur between positively and negatively charged side chains and are energetically
- ²¹ EX1046 (Beasley), 2034. *Also* EX1047 (Xiong), 6349, 6352 ("the choice between α -helical and β -sheet secondary structure is controlled by the sequence periodicity of polar and nonpolar amino acids.")
- ²² EX1039 (Alberts), 126-127, 130.

favorable. Where the side chains have the same charge, interactions between those side chains are energetically unfavorable.

- (c) Van der Waals forces: These are weak interactions that occur between all atoms when they are in close proximity and are energetically favorable.
- (d) Hydrophobic interactions: These occur between nonpolar side chains, driving them to the interior of the protein to avoid water. Where both residues are hydrophobic, the interactions are energetically favorable. If one residue is hydrophobic and the other is polar, the interaction is energetically unfavorable.
- (e) Pi-pi interactions: These occur between aromatic side chains, such as those of phenylalanine, tyrosine, and tryptophan, and are energetically favorable.
- (f) Cation-pi interactions: These occur between a positively charged side chain and an aromatic side chain and are energetically favorable.

57. In any region of a protein structure, there are myriad interactions that occur between residues in the protein that define the structure of the protein in that region. The collective effect of those interactions dictates the stability and thus maintenance of that region of the protein structure.

58. Introducing one substitution in a region of a protein can create a new set of interactions with neighboring amino acids in that position that are favorable

to the stability of the protein. Introducing nine more substitutions in that region along with the first one, where some of the other nine causes unfavorable interactions, may collectively destabilize that region of the protein structure, despite the positive contribution of the first substitution. There are approximately 6 x 10¹² different scenarios of 10 substitutions in just this one example (*i.e*., 10 positions, with 19 different alternative amino acids, or 19¹⁰).

59. The folding of secondary structures and higher order structures is often sensitive to the correct positioning of parts of the polypeptide chain during the folding process. Multiple substitutions made in a sequence may alter that timing and the presentation of those portions of the polypeptide chain that are necessary to form secondary structures or position them to form higher order structures. Introducing multiple amino acid changes simultaneously in this example could prevent the folding of sequences into secondary structures and structural motifs and can destabilize those structures if they do form.

Petitioner Merck EX1003, p. 29 60. Making multiple changes to an amino acid sequence can also cause formation of different types of secondary structures within the protein, which are highly disruptive to the original structure of the protein. For example, a group at Yale demonstrated that changing 28 residues caused a domain of a protein having a fold made up of four-stranded β sheet and one α -helix structures to adopt a different fold made up of all α -helical structures. In this example, the investigators

had the starting structure and the ending structure and engaged in experiments to convert one into the other. $2³$

61. An enzyme, like PH20, with one amino acid substitution that exhibits increased enzymatic activity does not prove that the same protein with 9 more changes in addition to the first will also do so. The other 9 substitutions may individually or collective disrupt the structure of the enzyme in a way that causes it to exhibit decreased activity or to be rendered inactive. That effect may occur independently of the effect of the first substitution, or the other 9 changes may collectively disturb the environment of the first substitution in a way that negates the first change's effect. The effects caused by one substitution in a protein like PH20 thus cannot predict the effects on a modified form of that protein that incorporates 5, 10, 15 (or more) substitutions. A skilled artisan would not view the first, single amino acid substituted PH20 to as be representative of all modified PH20 proteins having that one substitution, along with 5, 10, 15, or more additional substitutions.

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²³ EX1014 (Brandon), 368-370.

C. The Stability of a Protein Is Measured by Assessing the Free Energy Difference Between Its Folded and Unfolded States

62. Many proteins, particularly globular ones like PH20, are inherently

unstable. Slight changes in pH or in temperature can convert a properly folded and active protein into an unfolded and inactive form (figure below).²⁴

Figure 6.1 A polypeptide chain is extended and flexible in the unfolded, denatured state whereas it is globular and compact in the folded, native state.

63. The stability of a protein corresponds to the energy required to induce a transition from an unfolded state (an ensemble of disordered chains) to the folded state.²⁵ For many proteins, the total energy difference between the two states (the "free energy" difference) is small (*e.g.*, 5-15 kcal/mol), which is not much greater than the energy contribution of a single hydrogen bond.²⁶

- ²⁵ EX1014 (Brandon), 90; EX1039 (Alberts), 126.
- ²⁶ EX1014 (Brandon), 90.

 \overline{a} 24 EX1014 (Brandon), 90.
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64. There are two major contributors to the energy difference between the folded and unfolded states of a protein: enthalpy and entropy. Entropy derives from the second law of thermodynamics, which holds that energy is required to create order. Enthalpy is the energetic contribution that provides order and is the net result of a myriad of non-covalent interactions that occur between the residues within the folded form of the protein.

65. There are numerous types of non-covalent interactions that can occur between residues in a protein structure, and each can contribute to or detract from the net stability of the protein. For example, non-covalent interactions occur between atoms within the side chains of amino acids that are near each other within the protein structure. The interactions can be energetically favorable or unfavorable, and each can vary in magnitude of its energetic contribution. These interactions also are not static, as the residues within proteins are in continuous motion, and that motion varies in response to the environment of the protein (*e.g*., changes in pH, temperature, salts, etc.). 27

66. The "free energy" difference of a protein can be determined using a variety of experimental techniques. Generally, these techniques expose the protein to varying concentrations of a denaturing agent (urea, guanidine HCL) or varying

²⁷ EX1039 (Alberts), 126-131; EX1014 (Brandon), 13-14.

temperatures, and then detect the transition point between the folded and unfolded states of the protein using a scientific instrument (illustrated below).²⁸ For example differential scanning calorimetry (DSC) measures the heat capacity of the protein as it is heating, which allows one to determine the melting temperature and the enthalpy change associated with unfolding. Other instruments that can be used to measure the folding-to-unfolded transition include circular dichroism, fluorescence or nuclear magnetic resonance (NMR) spectrophotometers.

D. Activity Is Not Synonymous with Stability

67. Portraying an increase or decrease in biological activity of a mutated form of a protein as being indicative of a change in the stability of a specific aspect of a protein relative to the unmodified form of the protein is unwarranted without some direct basis for connecting the change in activity to the change in stability. To determine if a mutation affects the stability of a protein, it is necessary to use an

²⁸ EX1039 (Alberts), 130-131.

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appropriate experimental technique to assess the stability of protein structure, which is one that compares the energy required for state transitions for the wildtype and mutant proteins. Without some evidence that directly connects a change in activity to a change in the stability of the protein, it is not appropriate to simply equate a change in biological activity with a change in stability.

68. The common disclosure makes this mistake. It provides two tables measuring the effects on hyaluronidase activity of 409 mutants at two temperatures $(4^{\circ}$ C and 37° C), and in the presence of a preservative (a "phenophile" called mcresol).²⁹ One table (Table 11) reports measured hyaluronidase activities of the mutants while the other table (Table 12) divides the measured hyaluronidase activities for each mutant at two different conditions (*i.e*., activity of a mutant at 37°C vs. 4°C, or activity of a mutant at 37°C with m-cresol vs. without m-cresol at 4° C or 37° C).

69. No direct thermodynamic assessment is provided for 408 of the 409 mutants that would indicate that the measured activity under the tested conditions is due to increased stability, or is due to other factors, such as more efficient catalysis within an equivalently stable protein. The tables show that most of the

²⁹ EX1001 ('520 Patent), 257:6-258:56, Tables 11, 12; *also* Appendix A-6 (Table 12 w/ colors).

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tested mutants showed a significant reduction in activity in the presence of mcresol, with the vast majority showing less than 20% activity. The common disclosure also does not characterize the effects of any particular mutation on the structural features of PH20, such as, for example, the catalytic site, substrate binding site, or other portions of the protein known to be important to hyaluronidase activity (discussed further below). There is also no discussion of whether particular mutations affected the secondary structure or structural motifs within PH20 proteins, and whether and why such structural changes would impact stability or hyaluronidase activity of the protein.

70. A second problem with the data presented in Tables 11 and 12 is that the positive control showed significant variability in the assays being used. I note that the patent as printed does not make clear what the last set of values in Tables 11/12 is referring to, but the originally filed '731 patent application does. They are values for the positive control (EX1026) (comparison below for Table 11):³⁰

 30 The positive control was also used in additional testing of the F204P mutant. EX1001 ('520 Patent), 277:7-17 ("The positive control (WT PH20-OHO) showed a reduction in activity of 75% and 83% on the day of the assay (as assayed from two different OHO transfections). This demonstrated that the

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TABLE 11-continued

71. The data from Table 11 was used to recreate the % activity values in Table 12 for the positive controls. The colors indicate ranges of activity. The activity ranges, averages and mean values for the control unmodified PH20₁₋₄₄₇ are summarized below. Also, the values are plotted in Appendix A-8.

F204P phenophile was able to retain 60% to 90% or greater of its activity above the residual activity of the wildtype PH20 control enzyme.")

72. As the tables and plots (Appendix A-8) show, the positive control exhibited a significant amount of variation in its measured activity, which raises serious doubts about how probative or instructive the values for individual tested mutants are that fall within the range of variability observed for the control. There are also no statistical measurements of the data that is reported. A skilled artisan

would not view a measured value that is in the range of values of the control to a reliable indicator of a difference.

73. The common disclosure also suggests that 37° C is a denaturing temperature for $PH20³¹$ That, however, is the normal human body temperature in which PH20 exists naturally. It is unsurprising that single-replacement $PH20_{1-447}$ polypeptides showed higher activity at 37°C than at 4°C, given that PH20 exists at that temperature in humans. Also, only 5 out of 17 of the duplicate #1 runs for the positive control, and 4 out of 17 of the duplicate #2 runs showed significant decreased activity for the wild-type $PH20_{1-447}$ polypeptide at 37 \degree C vs 4 \degree C. Given the variability of the data for the control, portraying 37°C as a denaturing condition is not warranted. Instead, most of the relative activity values at 37°C vs. 4°C cannot be meaningfully differentiated from the control.

74. The common disclosure identified just two mutants (F204P and V58R mutants) out of 409 that were tested that retained more than 70% of their activity in the presence of m-cresol preservative in both of the tested duplicates. In Example 9 (Table 15), the data shows the F204P variant remained active over a longer period (4 weeks to 6 days) than the wild-type in the presence of m-cresol. In Example 11 (Table 22), both mutants retained more activity over time with m-

³¹ EX1001 ('520 Patent), 171:11-20.

cresol than the unmodified control. The data as a whole is not indicative of a broader trend of stability in the 409 PH20 mutants.

75. The one direct assessment of stability is in Example 13 and it tested only one mutant: F204P PH20₁₋₄₄₇. This example reported that F204P PH20₁₋₄₄₇ had a melting point (Tm) that was 9 $\rm{^{\circ}C}$ higher than unmodified PH20₁₋₄₄₇. If the data were generated by experimentally valid procedures, that would suggest that the F204P PH20₁₋₄₄₇ is more stable than unmodified PH20₁₋₄₄₇. It is not possible to determine if it was, because experimental details were omitted. The higher stability also does not tell the skilled artisan *why* it is more stable, or whether it will retain this increased stability if other substitutions are made to the F204P PH20₁₋₄₄₇. Other mutations may and usually do independently influence stability, which can be near the structure containing F204P or somewhere else in the protein that, in the aggregate, offsets the reported stabilizing effect of F204P.

76. Overall, the data for testing the 409 mutants reported in Tables 11 and 12 does not provide any meaningful guidance to a skilled artisan about the types of mutations would improve the stability of PH20 polypeptides generally, or for the PH20₁₋₄₄₇ form specifically. It also does not provide insights for the skilled artisan regarding the impact of multiple substitutions on the PH20 structure in addition to one of the tested changes because there are no mutants being evaluated with more than a single amino acid change. In fact, the data on single-substitutions is

inconsistent between the two duplicate experiments for many individual mutants, and few show changes outside the range seen for the positive control. The increased activity (where it is observed) cannot be ascribed solely to improved stability and does not meaningfully guide a skilled artisan in how to create a more stable multiply-modified PH20 polypeptide, or a multiply-modified PH20 polypeptide that will exhibit increased resistance to or stability under any denaturing conditions.

E. Hyaluronidases and PH20

77. PH20 is a member of a family of five human hyaluronidase enzymes and is similar to hyaluronidase enzymes found in a wide range of organisms (*e.g.*, bacterial, fungal, insect, mammalian).³² PH20 selectively catalyzes the hydrolysis of β 1,4 glycosidic bonds in hyaluronan (also called "HA" or hyaluronic acid) (below). It does not act on β 1,3 glycosidic bonds in HA.

³² EX1008 (Stern), 819.

Figure 1. Chemical structures of (A) hyaluronan and (B) unsulfated chondroitin and chondroitin sulfates. The substrate structures differ only in the anomericity at the C4 position of the N-acetyl-Dglycosamine, N-acetyl-D-glucosamine in hyaluronan, and N-acetyl-D-galactosamine in chondroitin. Potential sulfation sites within the chondroitin molecule are indicated by italicized hydroxyl groups and asterisks. Both glycans are substrates for the human hyaluronidase enzymes. For Hyal-1 and -2, HA is the predominant substrate. However, binding and degradation of Ch/ChS also occurs, albeit at a slower rate, as observed experimentally in vitro. Hyal-4 appears to be a chondroitinase, with high specificity for Ch and ChS.

1. Characterization of Hyaluronidases

78. An early study (Arming (EX1011)) reported a number of conserved residues between human PH20 and bee venom hyaluronidase ("bvH"). Arming also reported that mutating five different residues individually resulted in a significant loss of activity ("This indicated that three of the mutants, [Glnl13]PH-20, [Gln249]PH-20, and [Thr252]PH-20 were devoid of enzymatic activity, while the two other mutants, [Asnlll]PH-20 and [Gly176]PH-20, had residual activities in the range of one to a few percent of wild-type PH-20 hyaluronidase." 33

³³ EX1011 (Arming), 813.

79. Arming also identified a number of conserved cysteine residues in the PH20 protein, which are identified in Figure 1 of Arming.³⁴ These conserved cysteines are also highlighted in a later alignment of the human hyaluronidases reported in Chao.³⁵ From Arming and Chao it was known that these cysteine residues are critical residues because they form disulfide bonds necessary to main the structure of PH20 and other hyaluronidases.

80. The first experimentally determined structure of a hyaluronidase was of bvH, both alone and in complex with HA (published in 2007). Markovic-Housley identified the catalytic site and residues involved in catalytic activity using this structure.³⁶ It also provided a sequence alignment comparing PH20, human HYAL1, human HYAL2 and bvH which identified conserved residues between the proteins.³⁷

³⁴ EX1011 (Arming), 811.

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- 35 EX1006 (Chao), 6916.
- ³⁶ EX1033 (Markovic-Housley), 1028-1031 (PDB identifiers: 1FCU, 1FCQ).
- ³⁷ EX1033 (Markovic-Housley), 1026.

2. Chao Reports Structure of Human HYAL1 and the Hyal-EGF Domain

81. A structure for human HYAL1 was published by Chao and Herzberg in 2007 ("Chao") (EX1006). The Chao paper compared the human HYAL1 structure with the bvH structure that had previously been reported and observed that the two proteins had extensive overall structural similarity (Figure 2C, Chao). 38

82. Chao also compared the catalytic sites of the two proteins, and found that they also exhibited extensive structural similarity (Figure 4A, Chao)³⁹:

³⁸ EX1006 (Chao), 6915.

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³⁹ EX1006 (Chao), 6917.

83. Chao provided an annotated alignment of the five human

hyaluronidase enzymes which identified conserved residues among the set of five related proteins, identified cysteine residues involved in disulfide bonds, and included annotations identifying secondary structures with the proteins $(i.e., \alpha$ helices indicated by coiled illustration, and β -sheets by an arrow).⁴⁰

⁴⁰ EX1006 (Chao), 6916.

FIGURE 3: Structure-based sequence alignment of human hyaluronidases. Invariant residues are shown in blue except for three key catalytic residues that are colored red. Cysteine residues are colored yellow. The hHyal-1 N-glycosylated asparagines residues are colored turquoise. Residues exhibiting conservative replacements are blocked in blue. Pairs of cysteine residues that form disulfide bonds are indicated by stars with matching colors. Secondary structure units are labeled as in Figure 2B.

84. A notable finding in Chao was its identification of the "Hyal-EGF" domain in the C-terminal region of human hyaluronidases. Chao observed that the C-terminal region of mammalian hyaluronidases does not exhibit significant homology but does contain a cysteine-rich pattern of residues recognized by sequence analysis tools as an epidermal growth factor (EGF)-like motif (below).

Chao identified the pattern of sequences that generates this Hyal-EGF structural motif (*i.e*., "x4Cx0-48Cx3-12Cx1-70Cx1-6Cx2Gax0-21Gx2C, where "a" denotes a hydrophobic residue, "x" denotes any residue, and the gaps between cysteine residues vary in length as indicated by the subscripts.").⁴¹ This is a good illustration of how a pattern of amino acids shared within a family of related proteins can induce formation of a similar structural motif in those family members.

85. Below is an excerpt from the Chao alignment annotated to show the location of the sequences that constitute the Hyal-EGF domain (*i.e*., positions 337- 409 in PH20), which Dr. Park identified. The constituent cysteines of the pattern are at positions 341, 346, 352, 400, 402, and 408, while the constituent glycines are

⁴¹ EX1006 (Chao), 6912.

at positions 350, 377, 378, and 384.⁴² Appendix A-9 also shows the substitutions that were classified as "active" or "inactive" mutants in Tables 3 and 5 of the common disclosure at positions between 337-409, plus 410-412.

Hyal-EGF Domains in Human Hyaluronidases

86. The Chao paper provided new, highly relevant information for evaluating structural features of PH20, particularly by someone interested in modifying the structure of PH20. For example, its sequence alignment identified secondary structures and sites of conserved amino acids in both PH20 and HYAL1. Its structure of HYAL1 provided important insights, such as the existence of the Hyal-EGF domain, and provided a template to use in more accurate modeling of PH20. I did not find any discussion of Chao in the common disclosure of the patents, even though Chao was published many years before those patents were first filed in late 2011.

⁴² EX1004 (Park Dec.), ¶ 98.

87. A 2009 paper by Zhang et al. (EX1010) reported that deleting the portion of the HYAL1 sequence containing its Hyal-EGF domain substantially eliminated HYAL1's hyaluronidase activity (*i.e.*, activity of $\sim 6\%$).⁴³ It also tested the effects of mutating residues in proximity to the HA substrate within the active site. It identified those ligand-interacting residues by overlaying the HYAL1 structure on the bvH structure in complex with HA ligand, and measured distances to different residues indicative of interactions. This comparison was possible because of the highly conserved structure of the active site of hyaluronidases. Zhang also showed that single substitution mutants at each of these identified positions in HYAL1 rendered the enzyme inactive or significantly reduced its hyaluronidase activity (summarized in Table 1) (below).⁴⁴

⁴³ EX1010 (Zhang), 9437-9439.

⁴⁴ EX1010 (Zhang), 9435-9438, Table 1.

TABLE 1 Summary of Hyal1 wild-type (WT) and mutant kinetic constants

^a NA indicates no measurable activity at any HA concentration.

 b Indicates extrapolated value from saturable curve fit.</sup>

 c NS, not saturable, indicates data do not fit a saturation curve.

 d Values measured at 125 μ M HA.

88. Thus, before 2011, a number of residues within the region of the catalytic site in PH20 or HYAL1 had been experimentally shown to be necessary or important to the catalytic activity of hyaluronidases. For example, Arming (EX1011) identified positions D111, E113, R176, E249, and R252. Zhang (EX1010) identified positions in HYAL1 corresponding to D111, D113, D184, S227, Y229, R246, W304, and N333 in PH20, as well as the Hyal-EGF domain from 337-409 in PH20 identified by Chao.

3. Modifications at the C-Terminus of PH20 Were Poorly Understood in the 2011 Timeframe

89. A patent filed by Halozyme in 2004 and issued in 2010 (the '429

Patent) reported that a soluble, neutral active form of PH20 could be produced by

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truncating the PH20 sequence just before the start of the glycosylphosphatidyl inositol (GPI) anchor sequence in the protein (position $N483$).⁴⁵

90. Data in the '429 Patent and a 2007 paper by Frost (EX1013) also showed that truncations of varying length at the C-terminus of PH20 caused significant variations in hyaluronidase activity (below).⁴⁶ For example, both observed that when the PH20 protein was terminated at position 443 (mature protein), it only had 10% of the mutants that terminate at positions 443 or 448. Also, Frost reported that PH20 had to terminate between 442 and 448 to recover "soluble hyaluronidase activity" and the '429 Patent reported that only a narrow range of truncation mutants (*i.e.*, those terminating between 438 and 448) "defined the minimally active domain" of PH20. Figure 2 from Frost is shown below.

⁴⁶ EX1005 ('429 Patent), 87:52-88:24; EX1013 (Frost), 430-432, Fig. 2.

⁴⁵ EX1005 ('429 Patent), 86:18-26 ("…the GPI anchor cleavage site was located around amino acid position N 483 in the full-length GPI-anchored protein."); 3:51-62.

91. The data reported in the '429 Patent and Frost show that C-terminal truncations of varying length had an unusual effect on activity (below). If the data is to be believed, the activity of two mutants $(PH20₁₋₄₄₆$ and $PH20₁₋₄₄₈)$ with one more and one fewer residue was more than twice the activity of the $PH₁₋₄₄₇$ truncation mutant. The terminal residues of these mutants are phenylalanine (F446), tyrosine (Y447), and asparagine (N448). This is highly unusual behavior for three highly similar mutants, but no explanation is provided.

92. The '429 Patent and Frost report that certain of the PH20 truncation mutants had no hyaluronidase activity. Several of these terminate within the region of PH20 that was later identified by Chao as containing the Hyal-EGF domain (which is at positions 337-409 in the mature PH20 sequence), and one $(PH20₁₋₄₁₂)$ terminates three residues downstream from the end of the Hyal-EGF domain (indicated in table below). The truncation mutants within the Hyal-EGF domain terminate at positions 312, 337, 359, 378, and 395. The Zhang paper reported that a truncation just upstream of the start of the Hyal-EGF domain in HYAL1 reduced its activity to $\sim 6\%$.

93. The common disclosure references these experimental results and reports that PH20 must contain residues that extend at least to position 429 in the mature protein (position 464 w/signal sequence) to have hyaluronidase activity:

> A mature PH20 polypeptide lacking the signal sequence and containing a contiguous sequence of amino acids having a Cterminal amino acid residue corresponding to amino acid residue 464 [429] of SEQ ID NO:6 (*e.g*., amino acid residues corresponding to positions 36-464 [1-429] of the amino acid sequence set forth in SEQ ID NO:6) is the minimal sequence required for hyaluronidase activity [citing '429 Patent].⁴⁷

94. The common disclosure also refers to the truncation mutants of PH20 discussed in the '429 Patent and Frost paper but does not discuss the unusual

⁴⁷ EX1001 ('520 Patent), 70:2-11.

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variations in the activity of those C-terminal truncations.⁴⁸ Neither the scientific literature existing by 2011 nor the common disclosure provides an explanation why these PH20 truncation mutations that differ by one residue (*i.e.*, PH201-446 vs. $PH20₁₋₄₄₇$ vs. $PH20₁₋₄₄₈$ exhibit variability in their activity.

95. Before 2011, a skilled artisan would have connected the dots between the data reported in the '429 Patent and the Chao report of the existence of the Hyal-EGF domain. He or she would have reasoned that the loss in activity of truncation mutants ending below position 430 was likely due to disruption of the Hyal-EGF domain structure. That would have been reinforced by the experimental results reported in Zhang in 2009 that showed that deletion of the entire Hyal-EGF domain substantially eliminated hyaluronidase activity in HYAL1.

96. The data in the patent (particularly Tables 3 and 5 for "active mutants" and "inactive mutants," respectively) shows that making single amino acid substitutions in the region from 337-409 resulted in both active mutants and

⁴⁸ EX1001 ('520 Patent), 74:13-19 ("Soluble PH20 enzymes also include truncated forms of non-human or human membrane-associated PH20 hyaluronidases that lack one or more amino acid residues of a … (GPI) anchor attachment signal sequence and that retain hyaluronidase activity (see e.g., U.S. Pat. No. 7,767,429…).").

inactive mutants for most of the range of positions. See Appendix A-9. In the aggregate, there appear to be somewhat more single mutations that result in inactive mutants than those that result in active mutants, but that is a qualitative assessment. Unsurprisingly, mutations that changed the cysteine residues (which are also highly conserved) were uniformly inactive. The varying effects of changing residues in the Hyal-EGF region of PH20 show that a skilled artisan's belief that changes in this region would be unpredictable were warranted and would be more so if multiple changes were made concurrently.

97. Overall, there was uncertainty in the scientific literature about the activity of truncation mutants in the C-terminal region of PH20 (*i.e*., between positions 337 and 448). Truncations into the C-terminal region of the wild-type PH20 corresponding to the Hyal-EGF domain rendered the protein inactive, and those at its terminus (446-448) caused unpredictable changes in activity. Because there are no examples in the common disclosure testing the effects of introducing one or more substitutions into a PH20 polypeptide truncated to a position below position 447 (*e.g*., 433, 430 or within the Hyal-EGF region at 337 to 409), there is no basis for predicting what might happen if one made such mutants, especially if that truncated form of the wild-type sequence was inactive. Also, the examples of single substitutions in $PH20_{1-447}$ are not analogous to substitutions in $PH20$ proteins truncated below 433, given the latter's reduced or ablated activity.

III. The Common Disclosure Defines Two Mutually Exclusive Types of Modified PH20 Polypeptides

A. Two Types of Modified PH20 Polypeptides Are Differentiated Based on Possession or Absence of Hyaluronidase Activity

1. The Common Disclosure Draws a Clear Line Between Two Alternative Types of Modified PH20 Polypeptides

98. The common disclosure describes two, mutually exclusive types of modified PH20 polypeptides. First, it says "active mutants" are those having at least 40% hyaluronidase activity of the unmodified form of PH20.⁴⁹ Then, it says that "inactive mutants" are mutants that do not have significant hyaluronidase activity, which it indicates is 20% or less of the activity of the unmodified PH20.⁵⁰ This is a fairly straightforward delineation of two categories of proteins that either have or do not have an activity (here hyaluronidase activity).

99. Each type of mutant is addressed in a different section. The "active mutants" section runs from column 79, line 28 to column 115, line 40 and includes a compilation of the "active mutants" that were produced in Table 3, all of which have a single amino acid replacement in the $PH20_{1.447}$ wild-type sequence. The patent also lists single-replacement $PH20_{1.447}$ "active mutants" in Table 9 with reports of their relative activity to unmodified PH201-447.

⁴⁹ EX1001 ('520 Patent), 79:28-44.

⁵⁰ EX1001 ('520 Patent), 115:41-47.

100. The common disclosure consistently uses the 40% activity threshold to classify a mutant as an "active mutant." For example, it classified individual modified PH20 polypeptides in Table 3 ("active mutants") "so long as the resulting modified PH20 polypeptide exhibits at least 40% of the hyaluronidase activity of the corresponding PH20 polypeptide not containing the amino acid replacement."⁵¹ It similarly explains in connection with Table 9 that "[a]ctive mutants were selected whereby at least one duplicate sample exhibited greater than 40% of wildtype activity when normalized to SEAP activity."⁵²

101. "Inactive mutants" are discussed from column 115, line 41 to column 123, line 20 in the common disclosure. Examples of "inactive mutants" are compiled in Tables 5 and 10. The specification explains that "inactive mutants" are mutants with 20% or less of the activity of unmodified PH20, explaining:

> Provided herein are modified PH20 polypeptides that contain one or more amino acid replacements in a PH20 polypeptide and that are inactive, whereby the polypeptides do not exhibit hyaluronidase activity or exhibit low or diminished hyaluronidase activity. The modified PH20 polypeptides provided herein that are inactive generally exhibit less than 20%,

⁵¹ EX1001 ('520 Patent), 79:28-82:11.

⁵² EX1001 ('520 Patent), 228:7-9.

such as less than 10%, of the hyaluronidase activity of a wildtype or reference PH20 polypeptide…⁵³

102. Example 4 reports that "inactive mutants" were experimentally confirmed to be inactive. These so-called "dead mutants" are compiled in Table 10^{54}

> The other mutants that exhibited less than 20% hyaluronidase activity of wildtype PH20, in at least one of the duplicates, were rescreened to confirm that the dead mutants are inactive. To confirm the inactive mutants, the hyaluronidase activity assay described in Example 3 was modified to incorporate an overnight 37° C. substrate-sample incubation step prior to measurement of enzymatic activity. The modified assay is intended to detect PH20 activities below 0.2 U/mL.

2. The Experimental Results Classify Single Replacement Mutants of PH201-447 as Active or Inactive Mutants

103. The common disclosure provides a compilation of all the mutants that apparently were produced by the inventors in Table 8. There are 6,753 entries in this table. These are all mutants generated by substituting one amino acid from

 \overline{a} ⁵³ EX1001 ('520 Patent), 115:41-48.

⁵⁴ EX1001 ('520 Patent), 259:1-11, 259:29-32, Table 10 runs from column 251, line 34 to the end of 256.

PH20₁₋₄₄₇. There are 2,537 entries in Table 9. Table 10 contains a compilation of tested "inactive mutants" with 3,380 entries in it. The common specification thus provides test results for 5,917 mutants but does not report test results for the 836 other mutants that were apparently made.

104. The numbers of "active mutants" listed in Table 3 does not match the number of "active mutants" tested and shown to have at least 40% activity in Table 9 (*i.e*., 2,516 vs. 2,376). Table 3 also does not match the total number of entries in Table 9 (*i.e*., 2,516 vs. 2,536). Similarly, the number of "inactive mutants" listed in Table 5 does not match the number of tested inactive mutants $(< 20\%$ activity) listed in Table 10 (*i.e*., 3,368 vs. 3,380). There is no explanation for these discrepancies in the common disclosure.

105. The table and graph below show that most of the single-replacement $PH20₁₋₄₄₇$ mutants that were tested exhibited less activity than the unmodified PH201-447 (*i.e*., 57.1% were inactive, and 29.4% others had activity <100%).

Petitioner Merck 106. The relative activities reported are difficult to assess because the specification does not provide measured values for the activity of the unmodified PH20₁₋₄₄₇ used as the reference for percentages reported in Table 9. There are also

EX1003, p. 60

no indications about how many replicates of each test were performed, and there is no statistical analysis of the data provided. That is a concern because the values of the positive control reported in Table 11 and 12 varied so extensively from run to run. If the control (the unmodified $PH20_{1-447}$) used as the reference assay for these relative activity measurements exhibits a variation of $+/- 25\%$ or more in its replicates, it would be difficult to meaningfully differentiate mutants exhibiting 125% vs 75% from the unmodified PH20.

107. Overall, between the explanations provided in the common specification and the approach it uses to classify mutants based on measured activity levels, a skilled artisan reading the common disclosure would have understood it to be describing two, mutually exclusive types of modified PH20 polypeptides: (i) active mutants are those with significant levels of hyaluronidase activity (*i.e*., above 40% of the activity of unmodified PH20), and (ii) inactive mutants, which do not exhibit significant hyaluronidase activity (*i.e*., less than 20% of the activity of the unmodified PH20).

B. Proposed Uses for Active Mutant Modified PH20 Polypeptides Are Different from Those for Inactive Mutants

108. The common disclosure identifies different uses for "active" and "inactive" mutants. For example, columns 174-188 are devoted to therapeutic uses of modified PH20 polypeptides that have the ability to degrade hyaluronan (HA),

which requires the protein to have meaningful hyaluronidase activity, which is why those uses are associated with "active mutant" modified PH20 polypeptides that have at least 40% of the activity of the unmodified PH20 (*e.g.*, PH20₁₋₄₄₇).

109. By contrast, one paragraph suggests using "inactive enzymes" in contraceptive vaccines:

> Modified PH20 polypeptides provided herein can be used as vaccines in contraceptive applications. … Immunization with PH20 has been shown to be an effective contraceptive in male guinea pigs (Primakoff et al. (1988) Nature 335:543-546, Tung et al. (1997) Biol. Reprod. 56:1133-1141). It also has been shown to be an effective contraceptive in female guinea pigs due to the generation of anti-PH20 antibodies that prevent sperm and egg binding. In examples herein, the modified PH20 polypeptides can be inactive enzymes, such as any described in Sections C.2. …⁵⁵

110. I am aware of publications subsequent to the two publications that the patent portrays as demonstrating that inactive PH20 polypeptides can be used as the immunogen in a contraceptive vaccine (apparently in humans). These subsequent publications reported negative results in experiments attempting to

⁵⁵ EX1001 ('520 Patent), 188:8-27.

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induce contraceptive by immunizing mammals (rats, mice) with PH20.⁵⁶ For example, Hardy reported from its experiments that "recombinant mPH20 is not a useful antigen for inclusion in immunocontraceptive vaccines that target mice."

111. I also reviewed publications reporting on the human testing of Hylenex® (wild-type $PH20_{1-447}$). One (a 2015 paper) reported that some subjects given Hylenex produced detectable antibodies $(2.5-18\%)$.⁵⁷ It also addressed possible concerns that such antibodies target cells involved in reproduction and affect fertility. The authors, which included scientists from Halozyme, reported that the results from the clinical trials alleviated that concern:

> These observations serve to alleviate potential concerns raised by the apparent binding (although not neutralization) of a treatmentinduced antibody to an endogenous protein involved in aspects of reproduction and are further supported by published reports in

- ⁵⁶ EX1019 (Hardy), 325; EX1020 (Pomering), 181 ("immunization [of rabbits] with reproductive antigens expressed only in the reproductive tract using routes which induce predominantly plasma IgG are unlikely to result in reduced fertility…"); EX1021 (Baba), 30310 ("PH-20 is not essential for fertilization, at least in the mouse, suggesting that the other hyaluronidase(s) may play an important role in sperm penetration…").
- ⁵⁷ EX1024 (Rosengren), 1146, 1147 (Table II reporting antibody production),

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which several attempts were made to immunize males with PH20 as an immunocontraceptive approach in animal models. These studies involved rabbits (45,46), mice (47), and guinea pigs (48), and only the latter experienced infertility following PH20 immunization with a crude testicular extract that resulted in autoimmune orchitis (49). Furthermore, sperm from mice lacking PH20 were able to fertilize eggs, albeit in a somewhat delayed manner $(50)^{58}$

112. The reports on the lack of contraceptive effects of PH20 proteins in mice and rabbits were published before December 2011, while the reports on clinical testing of Hylenex were published in 2015 and 2018. They all suggest that PH20 does not appear to induce formation of antibodies that affect fertility in many rodents or in humans. The brief suggestion in the common disclosure about possibly using inactive mutant forms of PH20 as the immunogen of a contraceptive vaccine does not seem credible given these other experimental results.

⁵⁸ EX1061 (Rosengren-2015), 1154; *also* EX1024 (Rosengren), 87 ("Although some antisperm antibodies are associated with decreased fertility [], no evidence of negative effects on fertility could be determined in rHuPH20 reactive antibody-positive subjects of either sex.")

113. Additionally, I note that the common disclosure does not identify any mutated PH20 proteins that were shown to be effective in contraceptive vaccines. It also does not provide guidance regarding how to identify candidate inactive PH20 mutants that may be useful as contraceptive vaccines (such as by identifying common structural or functional characteristics that would be shared by such inactive mutants). A skilled artisan could not predict from the common disclosures' limited discussion of contraceptive vaccines which, if any, mutated PH20 polypeptides would confer contraceptive effect in humans. And more generally, a skilled artisan would have believed inactive forms of an enzyme, like PH20, have no utility at all.

IV. The Claims Capture an Immense Number of Distinct PH20 Polypeptides

A. The Claims Define Large Sets of Modified PH20 Polypeptides Using Sequence Identity Parameters

114. I reviewed the claims of the '520 Patent. Claims 1-2, 6-15, 22, and

25-26 (below) define slightly different sets of modified PH20 polypeptides.

What is claimed:

1. A modified PH20 polypeptide, comprising one or more amino acid modifications in an unmodified PH20 polypeptide, wherein:

the unmodified PH20 polypeptide consists of the amino acid sequence selected from the group consisting of SEQ ID NO: 3, 7 and 32-66;

amino acid modifications are selected from the group consisting of amino acid replacements(s), deletion(s), and/or insertion (s) :

- the modified PH20 polypeptide comprises an amino acid replacement at a position corresponding to residue 324, with reference to amino acid positions set forth in SEQ ID $NO: 3$:
- the replacement at the position corresponding to residue 324 is selected from the group consisting of A, D, H, M, N , R and S ;
- corresponding amino acid positions are identified by alignment of the PH20 polypeptide with the polypeptide having the amino acid sequence of SEQ ID NO: 3; and
- the modified PH20 polypeptide has at least 91% sequence identity to a polypeptide having the amino acid sequence selected from the group consisting of SEQ ID NO: 3, 7 and 32-66.

2. The modified PH20 polypeptide of claim 1, wherein the modified PH20 polypeptide has at least 95% sequence identity to the amino acid sequence selected from the group consisting of SEQ ID NO: 3 , 7 , and $32-66$.

6. The modified PH20 polypeptide of claim 1, wherein the replacement at the position corresponding to residue 324 is D.

7. The modified PH20 polypeptide of claim 1, wherein the replacement at the position corresponding to residue 324 is N or R.

8. The modified PH20 polypeptide of claim 1, wherein the unmodified PH20 polypeptide consists of the amino acid sequence selected from the group consisting of SEQ ID NO: 3 and 32-66.

9. The modified PH20 polypeptide of claim 7, wherein the unmodified PH20 polypeptide consists of the amino acid sequence selected from the group consisting of SEQ ID NO: 3 and 32-66.

10. The modified PH20 polypeptide of claim 6, wherein the unmodified PH20 polypeptide consists of the amino acid sequence selected from among the group consisting of SEQ ID NO: 3 and 32-66.

11. The modified PH20 polypeptide of claim 1, wherein the unmodified PH20 polypeptide consists of the amino acid sequence of SEO ID NO:35.

12. The modified PH20 polypeptide of claim 1, wherein the unmodified PH20 polypeptide consists of the amino acid sequence of SEQ ID NO:32.

13. The modified PH20 polypeptide of claim 6, wherein the unmodified PH20 polypeptide consists of the amino acid sequence of SEQ ID NO:35.

14. The modified PH20 polypeptide of claim 6, wherein the unmodified PH20 polypeptide consists of the amino acid sequence of SEQ ID NO:32.

15. The modified PH20 polypeptide of claim 1, comprising a sequence of amino acids that exhibits at least 91% sequence identity to the sequence of amino acids selected from the group consisting of SEQ ID NO: 3, and 32-66 and that contains an amino acid replacement D at the residue corresponding to residue 324 with reference to SEQ ID NO: 3.

22. The modified PH20 polypeptide of claim 1, further comprising a heterologous signal sequence, wherein the unmodified PH20 polypeptide consists of the amino acid sequence selected from the group consisting of SEQ ID NO: 3 and 32-66.

25. The modified PH20 polypeptide of claim 6, wherein: the unmodified PH20 polypeptide consists of the amino

acid sequence of SEQ ID NO:32; and

the amino acid sequence of the modified PH20 polypeptide has at least 95% sequence identity to the amino acid sequence of SEO ID NO:32.

26. The modified PH20 polypeptide of claim 6, wherein: the unmodified PH20 polypeptide consists of the amino

acid sequence of SEQ ID NO:35; and

the amino acid sequence of the modified PH20 polypeptide has at least 95% sequence identity to the amino acid sequence of SEQ ID NO:35.
115. The claims address two aspects of the modified PH20 polypeptides in each set defined by the claims.

- First, they require the wild-type glutamic acid (E) at position 324 to be replaced with one of seven amino acids: alanine (A), aspartic acid (D), histidine (H), methionine (M), asparagine (N), arginine (R), or serine (S). Claim 6 requires the amino acid at position 324 to be aspartic acid (D). Claim 7 requires the amino acid at position 324 to be asparagine (N) or arginine (R).
- Second, they permit (but do not require) the modified PH20 polypeptide to contain a certain number of additional changes besides the replacement at position 324.

116. The number of additional changes that each claim permits besides the replacement at position 324 varies but is defined via a percentage sequence identity calculation. This involves counting up the total number of changes in the modified PH20 relative to the unmodified (wild-type) sequence, and then dividing that number by the total number of amino acids in the unmodified PH20 sequence being referenced.

117. For example, claim 1 requires the modified PH20 polypeptide to have at least 91% sequence identity to one of 37 unmodified PH20 sequences (SEQ ID

NOs: 3, 7, or 32-66) having between 430 and 474 amino acids.⁵⁹ This means the maximum number of changes each PH20 polypeptide can have is equal to 9% of the number of amino acids in the unmodified PH20 (*i.e.*, 9% of $430 = 38$, 9% of $465 = 41,9%$ of $447 = 40,9%$ of $474 = 42$). Claim 2 tightens the sequence identity requirement to 95% as compared to the same unmodified PH20 sequences, which somewhat reduces the maximum number of changes each PH20 polypeptide can have (*i.e.*, 5% of 430 = 21, 5% of 465 = 23, 5% of 447 = 22, 5% of 474 = 23). Claims 8, 9, 10, 15, and 22 remove SEQ ID NO: 7 (length 474) from the reference unmodified sequences that may be used for the sequence identity comparison. Because SEQ ID NO: 7 is the longest of the reference unmodified sequences, the maximum number of amino acid changes permitted by these claims is slightly smaller (41 vs. 42) (*i.e.*, 9% of 430 = 38, 9% of 465 = 41, 9% of 447 = 40). In each of these scenarios, one change is accounted for by the required replacement at position 324.

118. Claims 11, 12, 13, 14, 25, and 26 specify the reference unmodified sequence to be used as either SEQ ID NO: 32 (claims 12, 14, 25) or SEQ ID NO: 35 (claims 11, 13, 26). SEQ ID NO: 32 has a length of 430 amino acids, and so

⁵⁹ SEQ ID NO:32 has 433 residues, SEQ ID NO:66 has 465 residues, and SEQ ID NO:3 has 447 residues.

permits either 21 changes (95% sequence identity) or 38 changes (91% sequence identity). SEQ ID NO: 35 has a length of 433 amino acids, and so permits either 21 changes (95% sequence identity) or 38 changes (91% sequence identity). Again, in each of these scenarios, one change is accounted for by the required replacement at position 324.

119. The claim language does not require the additional changes (besides the position 324 change) to be restricted to any region of the polypeptide. In addition, the common disclosure explains that changes can be additions, deletions or replacements, and for replacements, can be at any position in the sequence and to any other amino acid (*i.e.*, 19 alternatives). 60

 60 EX1001 ('520 Patent), $60:61-61:1$ ("Such differences can be represented as point mutations randomly distributed over the entire length of an amino acid sequence or they can be clustered in one or more locations of varying length up to the maximum allowable, e.g., 10/100 amino acid difference (approximately 90% identity). Differences can also be due to deletions or truncations of amino acid residues."), 47:43-47 ("As used herein, modification is in reference to modification of a sequence of amino acids of a polypeptide or a sequence of nucleotides in a nucleic acid molecule and includes deletions, insertions, and replacements of amino acids and nucleotides, respectively."),

120. The sequence identity language causes the claims to encompass an immense number of distinct PH20 polypeptides. This is the consequence of the claims allowing up to 21-42 changes, with each additional change (except at position 324) being to 1 of 19 other amino acids. But the up to 21-42 changes also can be at any of between 430 and 465 (or, in the case of the broadest claims, 474) different positions depending on which unmodified PH20 sequence is used.

121. The Alberts textbook illustrated the scale of amino acid sequences captured by the language used in the patent claims:

> Since each of the 20 amino acids is chemically distinct and each can, in principle, occur at any position in a protein chain, there are $20 \times 20 \times 20 \times 20 = 160,000$ different possible polypeptide chains four amino acids long, or $20ⁿ$ different possible polypeptide chains n amino acids long. For a typical protein length of about 300 amino acids, a cell could theoretically make more than 10^{390} (20³⁰⁰) different polypeptide chains. This is such

^{47:56-58} ("The modification can be an amino acid replacement (substitution), insertion (addition) or deletion of one or more amino acid residues."); 42:2-8 ("[T]he plurality of modified enzymes are such that the amino acid at each modified position is replaced by up to 1-19 other amino acids other than the original amino acid at the position…").

an enormous number that to produce just one molecule of each kind would require many more atoms than exist in the universe.⁶¹

122. I have reviewed the analysis performed by Dr. Park of the number of distinct PH20 polypeptides that meet the parameters in claims 1-2, 6-15, 22, and 25-26.⁶² Similar to the illustration in Alberts (above), the calculation permits 19 choices at up to 41 positions in the protein, and accounts for the fact that the 41 positional changes can be at any of between 430 and 474 positions in the reference protein. It also accounts for the fact that one change must be at position 324, and must be to one or one of seven alternatives. Consistent with my expectations, his calculations yielded immense numbers of distinct modified PH20 polypeptides based on the different sets of parameters used in claims 1-2, 6-15, 22, and 25-26 (reproduced below).

⁶¹ EX1039 (Alberts), 136-137.

⁶² EX1004 (Park Dec.), ¶¶ 180-184, Appendix F-1, F-2.

123. One way to put this scale into perspective is to consider the aggregate weight of one set of these mutants from the '520 Patent claims, where one assumes one molecule of each mutant is in the set. The weight in grams of 1 molecule of an unmodified PH20₁₋₄₄₇ is ~8.94 x 10⁻²⁰ grams.⁶³ For simplicity, assume that all the modified PH20 polypeptides have the same weight. With that assumption, the aggregate weight of the smallest set containing one molecule of each of the PH20 mutants would be 4.40 x 10^{59} x 8.94 x 10^{-20} = 3.93 x 10^{40} kg. The weight of Earth is "only" \sim 5.97 x 10²⁴ kg.⁶⁴

124. I also published on a similar topic years ago. As my colleague, James Beasley, and I explained:

> [F]or a relatively short sequence of 100 residues composed of the 20 naturally occurring amino acid, there are 20^{100} possibilities.

- 63 The Expasy website (https://web.expasy.org/compute pi/) calculated the molecular weight of a polypeptide having residues 1-447 of SEQ ID NO:3 of the '520 Patent as 53870.95 Daltons. The weight of one molecule of that polypeptide is determined by multiplying 53870.95 D by 1.66063906660 x 10- ²⁴ g/D, or approximately 8.94 x 10^{-20} grams.
- ⁶⁴ *See* "Earth Fact Sheet" available from NASA web site (*i.e.*, https://nssdc.gsfc.nasa.gov/planetary/factsheet/earthfact.html).

This number is so large $(20^{100} > 10^{130})$ that if one synthesized a single molecule of each sequence and put the entire collection into a box, the resulting box would be larger than Avogadro's number of universes.⁶⁵

125. The calculations by Dr. Park show a minimum of 4.40×10^{59} potential sequences encompassed by the narrowest of the claims, which is certainly smaller than Avogadro's number of universes. Yet even this relatively "smaller" number is still astronomical in size.

B. The Claims Would Be Understood to Concern Active Mutant PH20 Modified Polypeptides

126. As I explained in ¶¶ 98-102, the common disclosure portrays modified PH20 polypeptides as being either "active mutants" or "inactive mutants." The former are mutants that exhibit meaningful hyaluronidase activity (>40% of the unmodified PH20). The latter are enzymatically inactive proteins (less than 20% activity of the unmodified PH20).

127. The claims require each set of modified polypeptides to contain a substitution of the glutamic acid at position 324 to a different amino acid. The claims allow for varying numbers of alternative amino acid choices at position 324: (i) claims 6 and 15 each permit one alternative, aspartic acid (E324D), (ii)

⁶⁵ EX1046 (Beasley), 2031.

claim 7 permits two alternatives, either asparagine (E324N) or arginine (E324R), and (iii) claim 1 permits seven alternatives, alanine (E324A), aspartic acid (E324D), histidine (E324H), methionine (E324M), asparagine (E324N), arginine (E324R), or serine (E324S). The common disclosure identifies the activity of each of these substitutions when the mutation is incorporated as the only change in the $PH20₁₋₄₄₇$ sequence.⁶⁶ As the table below shows, the common disclosure classified all seven substitutions as "active mutants," but only three of these single-mutation PH20₁₋₄₄₇ enzymes (E324D, E324N, and E324R) exhibited increased hyaluronidase activity relative to the unmodified form of PH201-447.

TABLE 9-continued

⁶⁶ EX1001 ('520 Patent), column 231 (Table 9).

128. The common disclosure also says that "modified PH20 polypeptides contain an amino acid replacement at one or more amino acid positions identified as being associated with increased hyaluronidase activity."⁶⁷ The common disclosure then explains that a modified PH20 polypeptide with a mutation associated with increased hyaluronidase activity "can contain other modifications … so long as the resulting modified PH20 polypeptide exhibits increased hyaluronidase activity compared to the PH20 not containing" those modifications.⁶⁸

129. The common disclosure reiterates several times this point about preserving hyaluronidase activity in a PH20 polypeptide that has incorporated a first change that causes it to be an "active mutant" when making additional changes to the protein (citations to EX1001 ('520 Patent), emphases added):

> As used herein, "modified PH20 polypeptide" or "variant PH20 polypeptide" refers to a PH20 polypeptide that contains at least one amino acid modification, such as at least one amino acid replacement as described herein, in its sequence of amino acids compared to a reference unmodified PH20 polypeptide. A modified PH20 polypeptide can have up to 150 amino acid

⁶⁷ EX1001 ('520 Patent), 97:34-37.

⁶⁸ EX1001 ('520 Patent), 97:34-46.

replacements, *so long as the resulting modified PH20 polypeptide exhibits hyaluronidase activity*. [48:38-46]

The modifications described herein can be in any PH20 polypeptide, including, including precursor, mature, or Cterminal truncated forms, *so long as the modified form exhibits hyaluronidase activity*. [76:7-10]

The C-terminal truncation can be a truncation or deletion of [8- 50] or more amino acids at the C-terminus, *so long as the resulting C-terminally truncated polypeptide exhibits hyaluronidase activity* and is secreted from cells (e.g., into the media) when expressed. [77:2-9]

In particular examples, the amino acid replacement(s) can be at the corresponding position in a PH20 polypeptide as set forth in any of SEQ ID NOs: 2, 3, 6-66, 68-72, 856-861, 869 or 870 or a variant thereof having at least 75%, 80%, 81%, 82%, 83%, 84%, 85%, 86%, 86%, 88%, 89%, 90%, 91%, 92%, 93%, 94%, 95%, 96%, 97%, 98%, 99% or more sequence identity thereto, *so long as the resulting modified PH20 polypeptide exhibits at least 40% of the hyaluronidase activity* of the corresponding PH20 polypeptide not containing the amino acid replacement. … In one example, any one or more of the replacements are in SEQ ID NO:3, *so long as the resulting modified PH20 polypeptide exhibits at least 40% of the hyaluronidase activity* of the PH20 polypeptide set forth in SEQ ID NO:3. [81:3-82:11]

130. The common disclosure does not show any examples of a modified PH20 polypeptide (regardless of its length) that (i) incorporates one amino acid substitution that causes it to have hyaluronidase activity or increased hyaluronidase activity, and then (ii) introduces additional changes that render that multiplymodified PH20 protein an "inactive mutant." I can identify no scientific or practical reason it would because a skilled artisan would not pursue such a path. It makes no sense for a skilled artisan to go to the effort of making a modified PH20 with hyaluronidase activity (or greater activity than the unmutated protein), and then intentionally introduce additional mutations to make that modified protein inactive. If the goal were to make inactive mutants, the skilled artisan would have started by selecting one of the thousands of examples of PH20 polypeptides reported as having one amino acid replacement that produced inactive mutants.

131. The inventors appear to have stopped after making only singlereplacement mutants. For example, there are no mutants with a first mutation that led to its classification as an "active mutant" and that then acquired a second mutation. More importantly, there are no "double" or "triple" (or more) mutants that combined sets of single mutations classified as causing both "active" mutants" and "inactive" mutants or were within particular regions of the PH20 sequence. Consequently, there is no meaningful guidance in the common disclosure on what

happens when different kinds of mutations are combined, or different mutations in a region of the PH20 are combined.

132. There is also a dependent claim that affirmatively requires the modified PH20 polypeptide to have increased hyaluronidase activity. Specifically, claim 4 requires that the modified PH20 polypeptide exhibit increased hyaluronidase activity compared to the unmodified PH20 polypeptide that does not contain the amino acid replacement at position 324.

133. I have been informed and understand that a dependent claim inherits all of the requirements of its parent claim, which for claim 4 is claim 1. I understand that also means that all of the modified PH20 polypeptides within the scope of claim 4 are also included in the scope of the set defined by claim 1.

134. I therefore believe a skilled artisan would have understood the claims to necessarily cover modified PH20 polypeptides that are active mutants and would not view them as including inactive mutants.

135. Even if the claims are interpreted to encompass inactive mutants, they would still include an immense number of "active mutant" modified PH20 polypeptides. As I discuss further below, it is my opinion that the common disclosure does not describe or enable this immense number of "active" mutants.

C. All of the Claims Encompass a Single-Replacement PH201-447 Mutant Where E at Position 324 is Changed to D, N, or R

136. I also was asked to consider whether three particular modified PH20 polypeptides, each with a single amino acid substitution (*i.e.*, E324D, E324N, or E324R in $PH20_{1-447}$, meet the sequence identity percentage parameters in the claims. Each does.

- Each mutant meets the requirements of claims 1, 2, 8, 9, and 10. That is because each of these claims encompasses a modified PH20 polypeptide that has only one amino acid difference from SEQ ID NO:3, which can be to any amino acid at any position in that sequence. The E324D, E324N, and E324R $PH20₁₋₄₄₇$ mutants meet that requirement: they each have only one difference from SEQ ID NO: 3 and are 99.7% identical (*i.e*., 446 /447 = 99.7%).
- Each mutant also meets the requirements of claims 11 and 12, each of which depend from claim 1. Claim 11 requires a comparison of the mutant 447-residue sequence (*e.g*., E324D, E324N, or E324R in $PH20₁₋₄₄₇$) to the 433-residue unmodified PH20 (SEQ ID NO:35). That translates into a total of up to 15 changes (447-433) (*i.e*., 1 change for E324D, E324N, or E324R plus 14 more changes due to deletions), which make the E324D, E324N, or E324R PH20 $_{1-447}$

proteins 3.5% different, or 96.5% identical, to SEQ ID NO:35. Claim 12 requires a comparison of the three mutants to SEQ ID NO:32, which has 430 residues. That translates into $17 + 1$ or 18 total differences, which is 4.1% different and 95.9% identical to the unmodified 430 residue PH20. Each mutant thus has more than 91% identity to each of SEQ ID NO: 32 and SEQ ID NO: 35.

- Claim 6 depends from claim 1 and adds the requirement for a E324D substitution in a modified PH20 polypeptide. Claims 13, 14, 25 and 26 then add the requirement that the reference unmodified PH20 sequence be either SEQ ID NO: 35 or SEQ ID NO: 32. The E324D $PH20₁₋₄₄₇$ mutant meets the E to D substitution requirement, and, because it only has one change, it meets the at least 91% or 95% sequence identity requirement relative to SEQ ID NO: 35 and 32 (as I explained above).
- Claim 7 depends from claim 1 and requires a substitution at position 324 from E to either N or R. The E324N or E324R $PH20₁₋₄₄₇$ mutants both meet that additional requirement.

137. All of the other claims have structural limitations similar to those described above, and therefore would capture either the E324D, E324N, or E324R PH20₁₋₄₄₇ mutants (or all three). I address these particular PH20 mutants in \S VI, below.

V. Observations on the Common Disclosure

- **A. The Common Disclosure Does Not Identify the Modified PH20 Polypeptides with Multiple Amino Acid Substitutions Encompassed by the Sequence Identity Parameters in the Claims**
	- **1. The Data from Testing Single Replacement PH201-447 Mutants Does Not Identify a Correlation Between PH20 Polypeptides with 2-42 Substitutions and PH20 Proteins Having > 40% Hyaluronidase Activity**

138. The common disclosure provides a report on a random mutagenesis experiment that generated a large number of single substitutions within the human PH201-447 sequence. The disclosure utilizes what would be considered a directed evolution approach to making and testing single-mutated proteins. The data showed that \sim 40% of the mutations were tolerated, resulting in PH20₁₋₄₄₇ mutants retaining at least 40% of the hyaluronidase activity of the unmodified parent, while \sim 57% were not tolerated, with no or <20% hyaluronidase activity. See ¶[[103](#page-62-0) to [107.](#page-65-0) A significant number of the mutants $(\sim 12\%)$ made were not characterized, and around 2.7% of the mutants had activity between 20% and 40%.

139. Random mutagenesis experiments like the one reported in the common disclosure provide empirical results. Typically, they are followed by additional analyses and experimentation to understand why the results were

observed, and to determine what changes influenced discrete structures within the protein. This work, if it was performed, is not documented or discussed in the common disclosure beyond experiments concerning two specific mutants (F204P and V58R). See ¶¶ [74](#page-42-0)[-75.](#page-43-0) There are no observations from the experimental results on any specific secondary structures or structural motifs within the PH20 protein that were influenced (positively or negatively) by individual mutations. There also is no guidance regarding additional mutations that could be made to further enhance or alter the characteristics of these mutants.

140. The common disclosure does not provide any information that a skilled artisan could use to predict the effect of incorporating into a PH20 protein the myriad different sets of between 2 and 42 substitutions drawn from the thousands of individual mutations in PH201-447 listed in the common disclosure. It does not, for example, suggest that incorporating one of the specific single substitutions that caused that $PH20_{1.447}$ mutant to exhibit increased activity will cause a similar increase in the activity of any other PH20 polypeptide that contains additional substitutions, regardless of their number, location, or identity. That also would not be scientifically plausible. In other words, the functional and other characteristics of a PH20 protein that incorporates a first single amino acid substitution cannot be extrapolated to modified PH20 polypeptides that incorporate the myriad sets of combinations of multiple substitutions in addition to the first.

141. As I discussed above (§ [II.B.2\)](#page-29-0), including additional substitutions after a first may adversely impact the structure modified by the first substitution, may affect the region of the protein having that first change, or may introduce impactful changes in an unrelated part of the protein. Because the common disclosure has no examples of any PH20 with multiple substitutions and does not characterize the effects of the mutations on the PH20 protein structure, a skilled artisan could not realistically predict whether an effect observed in an active single-modified PH20 polypeptide would be observed the trillions and trillions of modified PH20 polypeptides that incorporate that first mutation plus the myriad other sets of 2 to 41 additional substitutions.

Petitioner Merck EX1003, p. 85 142. The positions of any particular set of substitutions and the identity of the amino acids being inserted at those positions can dramatically influence the structure of the PH20 protein. For example, multiple substitutions could be made at locations within a sequence in PH20 responsible for forming an α -helix that will disrupt the pattern necessary to form that α -helix, or even convert it into a different secondary structure, like a β -sheet. See \P [55](#page-29-1) to [60,](#page-33-0) above. The effects of such a dramatic change in one or more of the secondary structures of PH20 could not have been predicted in 2011 based on the guidance in the common disclosure. And because the claims encompass making up to 21 to 42 substitutions at any positions in PH20 (and, except at position 324, changing wild type residues to any of the

other amino acids at these positions), there are many, many billions (and more) of possible scenarios where the changes may materially affect the folding and maintenance of the secondary structure(s) within the PH20 polypeptide.

143. The results of the random mutagenesis study are simply compiled in in the common disclosure. Those results by themselves do not identify any defined correlation between PH20 polypeptides having sets of 2 to 42 amino acid substitutions and PH20 polypeptides that retain 40% or more of the hyaluronidase activity of the unmodified form of the PH20 polypeptide. As the reported data confirms, the individual substitutions did not yield PH20 mutants with consistently observed effects; rather, the effects observed were random and unexplained among the tested mutants. The examples of single-replacement $PH20₁₋₄₄₇$ mutants are not representative of the incredible diversity of possible modified PH20 polypeptides having different sets of 1 to 41 *additional* substitutions that are within the scope of the claims.

2. The Common Disclosure Does Not Identify Any Specific PH20 Polypeptides Having 2-42 Substitutions that Retain >40% Hyaluronidase Activity

144. With one exception (addressed in \S [V.A.3\)](#page-92-0), there are no examples of any modified PH20 polypeptide with between 2 and 22 amino acid substitutions described in the common disclosure. It also does not identify any specific sets of 2 to 42 single amino acid substitutions that will, in combination, confer improved

stability or activity on PH20 proteins, even with respect to the $PH20₁₋₄₄₇$ polypeptide.

145. The common disclosure lists ranges of sequence identity percentages relative to a set of PH20 sequences (*i.e*., SEQ ID NO:3, SEQ ID NO: 7, or any of SEQ ID NO: 32 to 66). It also includes lists of total numbers of amino acid substitutions, which are the mathematical consequence of applying those percentage-based sequence identity parameters to PH20 polypeptides of different lengths.⁶⁹ Stating these parameters governing possible sets of PH20 polypeptides does not identify any specific PH20 polypeptides, much less identify those that retain >40% activity (or increased activity). That is because this general language does not restrict the positions into which substitutions can be made or which amino acid(s) can be incorporated into those different position(s). The sequence identity percentages and limits on total changes are simply identifying the boundaries of an immense group of different modified PH20 polypeptides, not modified PH20 polypeptides that will all share common structural or functional characteristics.

⁶⁹ EX1001 ('520 Patent), 9:19-27.

3. The Common Disclosure Says to Avoid Changing Certain Residues Involved in Glycosylation

146. The only examples of a PH20 polypeptides with more than one substitution that are discussed in the common disclosure are combinations of substitutions that the disclosures say to *not* include in modified PH20 polypeptides:⁷⁰

> [W]here the modified PH20 polypeptide contains only two amino acid replacements, the amino acid replacements are *not* P13A/L464W, N47A/N131A, N47A/N219A, N131A/N219A or N333A/N358A. In a further example, where the modified PH20 polypeptide contains only three amino acid replacements, the amino acid replacements are *not* N47A/N131A/N219A.

147. Several of these positions are asparagine residues that were known to be glycosylation sites in PH20 and other hyaluronidases (N47A, N131A, N219A, N333A, N358A).⁷¹ No other explanation is provided why these combinations should be excluded from modified PH20 polypeptides.

⁷⁰ EX1001 ('520 Patent), 77:47-59 (emphases added).

⁷¹ EX1001 ('520 Patent), 49:30-35; EX1007 (WO297), 36:11-26.

4. The Common Disclosure Says to Not Include Substitutions that Rendered PH201-447 Inactive in Modified PH20 Polypeptides that Are Active Mutants

148. The common disclosure says that substitutions that rendered $PH20_{1-447}$ an inactive mutant as a single amino acid replacement should be avoided in modified PH20 polypeptides intended to have hyaluronidase activity. It also makes these statements without regard to how many additional substitutions or other changes might be incorporated into the mutant. As it states:

> To retain hyaluronidase activity, modifications *typically are not made* at those positions that are less tolerant to change or required for hyaluronidase activity. For example, generally modifications are not made at a position corresponding to position … *[96 positions]* … with reference to amino acid positions set forth in SEQ ID NO:3. Also, in examples where modifications are made at any of *[… 313 positions …]* with reference to amino acid positions set forth in SEQ ID NO:3, the modification(s) is/are not the corresponding amino acid replacement(s) set forth in Table 5 or 10 herein, which are amino acid replacements that result in an inactive polypeptide.⁷²

⁷² EX1001 ('520 Patent), 80:15-57 (emphasis added).

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149. A number of the single substitutions that the common disclosure reports as rendering PH20₁₋₄₄₇ inactive were known to be conserved residues in hyaluronidase proteins. As it observes:

> …confirm the requirement of PH20 amino acid residues corresponding to positions 25, 111, 113, 176, 189, 203, 246, 249, 252, 316, 341, 346, 352, 400, 402, 408, 423 and 429 of the sequence of amino acids set forth in a mature PH20 lacking the signal sequence such as set forth in SEQ ID NO: 3 or 7 for hyaluronidase activity, since mutagenesis of these residues results in an enzyme that is not active (e.g., it is not expressed or is inactive when expressed, see e.g., Tables 5 and 10). The exception is that amino acid replacement corresponding to R176K and C316D resulted in mutants that generated some residual hyaluronidase activity.⁷³

150. A skilled artisan would not have been surprised that single amino acid replacements at highly conserved positions in the PH20 sequence would have an adverse effect on the protein's activity. The common disclosure, however, does

⁷³ EX1001 ('520 Patent), 70:49-59. The common disclosure does not refer to or discuss the findings reported before 2011 in Chao and Zhang about residues involved in the catalytic site of hyaluronidases. EX1006 (Chao), 6914-6916; EX1010 (Zhang), 9435-38.

not provide any explanation for why substitutions at positions outside of these highly conserved residues were rendered inactive.

151. The absence of any explanation why single amino acid substitutions of non-conserved residues rendered the $PH20₁₋₄₄₇$ inactive limits the insights one can draw from the patent's disclosure. For example, there is no discussion of the effect on any secondary or other structure within the PH20 protein of the substitution. The insights one can draw from this set of data is even more limited relative to PH20 proteins that incorporate multiple substitutions. It is what the common disclosure says, which is to not include any of the substitutions in Tables 5 and 10 that rendered $PH20_{1-447}$ inactive as part of a set of substitutions in a multiply modified PH20 polypeptides that is intended to have activity, regardless of the length of the PH20 polypeptide or the number of additional amino acid replacements.

5. The Prior Art and the Common Disclosure Indicate that C-Terminal Truncations Can Render PH20 Polypeptides Inactive

152. Another type of change the common disclosure says to avoid is a truncation at the C-terminus that results in a PH20 sequence with fewer than 429 residues, as such a protein would be inactive:

> A mature PH20 polypeptide … containing a contiguous sequence of amino acids having a C-terminal amino acid residue

corresponding to amino acid residue 464 of SEQ ID NO:6 [position 429] … *is the minimal sequence required for hyaluronidase activity*. 74

153. As I explained earlier (§ [II.E.3\)](#page-53-0), by 2011, there was substantial uncertainty surrounding truncations and other modification at the C-terminal region of PH20. The illustration below compiles this existing knowledge regarding truncations in C-terminal region of the PH20 and HYAL1 proteins.

154. A skilled artisan in 2011 would have approached making changes in the C-terminal region of PH20 with caution, as truncations resulting in PH20 polypeptides that terminate before position 430 yielded inactive proteins, and changes terminating at positions between 430 and 442 were not characterized,

⁷⁴ EX1001 ('520 Patent), 70:2-11 (emphasis added).

other than at position 432 (which exhibited \sim 27% of the activity of PH20₁₋₄₄₇).⁷⁵ Yet, as I discuss below, the claims purport to encompass mutated proteins truncated below all of these positions.

B. The Sequence Identity Parameters in the Claims Encompass Enzymatically Active Multiply-Modified PH20 Polypeptides the Common Specification Does Not Identify, Says to Not Make and For Which It Provides No Meaningful Guidance

155. The roughly 2,500 single-replacement $PH20₁₋₄₄₇$ polypeptides with hyaluronidase activity disclosed in the patent are an infinitesimally small fraction of the number of modified PH20 polypeptides encompassed by the sequence identity parameters used in the claims $(e.g., 2500 / 4.40 \times 10^{59})$ for the smallest group). In most settings, that fraction would be considered zero.

156. The remaining portion of the set of modified PH20 polypeptides captured by the sequence identity claim language is immense and will encompass PH20 polypeptides that incorporate 5, 10, 15, or more (for some claims upwards of 42) substitutions into the protein's structure. Many of these mutants will have multiple changes in the same region of the protein structure, which can cause energetically disfavored interactions not present in the native PH20 protein, disrupt patterns necessary for secondary structure formation and stability, induce changes

⁷⁵ EX1005 ('429 Patent), 87:52-88:24.

in positioning of secondary structures and structural motifs, impede folding of structurally significant regions of the protein, and any of a large number of other consequences that will disrupt the protein's structure.

157. The common disclosure does not even explain the effects that single amino acid substitutions had on the PH20 protein's native structure, let alone predict the effect additional amino acid substitutions proximate to the previously made single-substitutions would have on protein structure and activity. The common disclosure also does not identify any common structural features shared by the "active mutant" forms of the single-substitution $PH20₁₋₄₄₇$ polypeptides, or common structural features that should be shared by "active mutant" forms of multiple-modified PH20 polypeptides generally.

Petitioner Merck 158. The effects of these myriad sets of combinations of multiple substitutions within PH20 could not have been predicted by a skilled artisan in the 2011 timeframe using the tools that were available then. For example, while the PH20 protein structure models Dr. Park used provided reliable insights when modeling the change of a single residue at a position where the model was, they cannot provide reliable insights when the modeled sequence incorporates many (*e.g*., more than ~5) substitutions not found in a naturally occurring protein. That is because (i) if the modeled sequence incorporates multiple changes, it no longer has validity as a naturally occurring sequence, and (ii) the changes significantly

diminish the reliability of other positions of the model used to assess the change because they are no longer based on the structural positioning of residues within the template structure used to generate the model. Thus, a skilled artisan would have had to discover which combinations of substitutions to the PH20 protein would result in mutants that do exhibit hyaluronidase activity by making and testing all of them, an impossibly large undertaking.

159. Because of the complicated interactions multiple amino acid substitutions may have within a protein, the activity of multi-substituted polypeptides having sets of 5, 10, 15, or more changes could not generally be predicted from data regarding the activity of mutants containing only a single amino acid substitution. Put differently, the single-replacement $PH20₁₋₄₄₇$ polypeptides reported in the common disclosure are not representative of all the types of mutated $PH20_{1-447}$ polypeptides that have a particular substitution at position 324 and sets of between 1 and 41 *additional* substitutions at any of hundreds of positions within the PH20 protein.

160. Another problem caused by the use in the claims of sequence identity language to define the sets of proteins is that it captures many multiply-modified PH20 polypeptides with changes that common disclosure says are deleterious or eliminate hyaluronidase activity in PH20 enzymes.

161. First, the sequence identity language, read literally, would capture multiply-modified PH20 polypeptides that include substitutions listed in Tables 5 and 10. These are the substitutions that, when made as a single substitution in $PH20₁₋₄₄₇$, rendered the $PH20₁₋₄₄₇$ protein inactive. Also, there are no examples of any multiply-modified PH20 polypeptides in the specification, much less ones that combine substitutions that rendered the protein inactive from Tables 5 and 10 with other substitutions that together cause $PH20₁₋₄₄₇$ to have hyaluronidase activity (or increased levels of that activity).

162. In fact, the common disclosure instructs skilled artisans to not include substitutions from Table 5/10 in any PH20 polypeptides with hyaluronidase activity, including those with multiple substitutions. See § [V.A.4.](#page-93-0) To make all the multiply-modified PH20 polypeptides covered by the claims' sequence identity parameters, the skilled artisan would have to disregard the guidance in the common disclosure indicating that substitutions listed in Tables 5/10 should not be included in PH20 polypeptides intended to have hyaluronidase activity.

163. Second, the sequence identity language in the claims captures the six modified PH20 polypeptides with two or three specific combinations of substitutions that the common disclosure says to not make. See ¶¶ [146](#page-92-1) to [147.](#page-92-2)

164. Third, the sequence identity language causes the claims to capture multiply-mutated PH20 polypeptides with C-terminal truncations that truncate the

sequence below position 429 and thus (according to the common disclosure) render the PH20 proteins inactive.⁷⁶ This happens when you apply the $91\%/95\%$ sequence identity language criteria to shorter reference PH20 sequences (*i.e*., SEQ ID NO: 32 with 430 residues, and SEQ ID NO: 35 with 433 residues), as is permitted by the claims.

165. To illustrate this, consider a hypothetical modified PH20 polypeptide truncated to position 419 of PH20 (below).

166. Truncating PH20 to position 419 would require 11 changes relative to SEQ ID NO:32 (430 residues), and 14 changes relative to SEQ ID NO: 35 (433 residues). Applying the 95% identity requirement in claims 2 and 25 to SEQ ID NO:32 permits 21 total changes, of which 11 would be for the truncation and one for E324D, allowing 9 additional substitutions at any of 419 positions to any of 19 other amino acids. Similar claims that allow 91% sequence identity to SEQ ID NO: 32 (for example, claims 1, 6-10, 12, 14, 15, 22) would also capture this

⁷⁶ EX1001 ('520 Patent), 70:2-11.

truncated PH20 with an E324D substitution (in the case of claim 6) or either E324N or E324R substitutions (in the case of claim 7). For claim 25, the truncation to 419 consumes 14 of the 17 allowed changes at 95% sequence identity, and the position 324 substitution takes one more, leaving 2 additional substitutions across 419 positions to any of 19 amino acids. Similar claims that allow 91% sequence identity to SEQ ID NO: 35 (for example, claims 1, 6-11, 13, 15, and 22) would also capture this truncated PH20 with an E324D substitution (in the case of claim 6) or either E324N or E324R substitutions (in the case of claim 7).

167. The common disclosure describes no multiply-modified "active mutant" PH20 polypeptides, including those having fewer than 447 residues and provides no guidance about making enzymatically active mutants based on PH20 sequences ending before position 447 and containing 2 or more substitutions.

Petitioner Merck 168. The common specification also did not report an experiment showing that introduction of an E324D, E324N, or E324R mutation into an inactive $PH20₁$ ⁴¹⁹ polypeptide would restore its hyaluronidase activity. There is no basis from the common specification or the scientific literature existing in late 2011 that would suggest that such a change would restore activity. The skilled artisan also could not predict whether any combinations of up to 9 or up to 2 additional (or more) substitutions could be made anywhere in the $PH20₁₋₄₁₉$ sequence or comparably

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truncated PH20 polypeptide that would restore hyaluronidase activity to an inactive E324D, E324N, or E324R containing PH20₁₋₄₁₉ mutant.

169. In other words, the common disclosure not only does not help the skilled artisan identify which of the trillions of possible PH20 polypeptides of varying length with 2 to 42 substitutions have hyaluronidase activity; to practice the full scope of the claims it requires the skilled artisan to ignore what little guidance is in the specification about single-substitutions and truncations that render PH20 polypeptides inactive.

C. A Skilled Artisan Would Have to Engage in an Impossible Scale of Experimentation to Make and Identify All the Multiply-Modified PH20 Proteins with Hyaluronidase Activity Within the Sequence Identity Parameters of the Claims

170. Making and identifying all of the multiply-modified PH20 polypeptides that are within the immense set of polypeptides (between 10^{59} and 10¹¹² distinct mutants) defined by the claims' sequence identity parameters would require not only an undue amount of experimentation, it likely is impossible.

171. The common disclosure contains a mixture of information that had been reported in the pre-2011 scientific literature. It also provided a description of the production, characterization and results from testing a library of singlereplacement $PH20₁₋₄₄₇$ mutants, and as well as additional characterization and testing of two mutants (F204P and V58R). None of this information provides any

meaningful guidance to a skilled artisan that can be used to identify which of the myriad possible combinations of 5, 10, 15, or more substitutions can be incorporated into a PH20 protein to yield an enzymatically active protein.

172. The remainder of the common disclosure is largely hypothetical. This includes its descriptions about possible PH20 polypeptides that include one of the tested single substitutions, but then might have numerous additional, unidentified changes. Unlike its description of single-replacement $PH20₁₋₄₄₇$ mutants, the common disclosure identifies no examples of PH20 polypeptides with multiple amino acid substitutions at different positions (*i.e*., specific amino acids being inserted into two or more different positions of the same PH20 polypeptide) that rendered active proteins. This appears to be the case because no such multiplymodified PH20 polypeptides appear to have actually been made or tested. That seems consistent with the common disclosure's description of a theoretical way of making such multiply-substituted PH20 polypeptides. That description is essentially a research plan that someone might use to discover multiply-modified PH20 polypeptides that retain hyaluronidase activity (through extensive time and effort), and not a description that demonstrates the inventors had already identified and were in possession of any such multiply-modified, active proteins.

1. The Common Disclosure Provides Only a Research Plan for Discovering Multiply-Modified, Enzymatically Active PH20 Polypeptides

173. The common disclosure's description of how to make modified PH20 polypeptides, including those with more than one amino acid substitution, are found in a section of the patent titled "Methods for Identifying Modified Hyaluronan-Degrading Enzymes with Altered Properties or Activities."⁷⁷ This section is describing a directed evolution experiment. A majority of this section is simply describing at a very general level the well-known techniques for using mutagenesis techniques to produce and screen libraries of mutated proteins.⁷⁸ The methodology being described in this section is best described as a research plan, as it generally outlines the types of steps one might take to carry out a mutagenesis and screening research program.

174. The part of this research plan that might be pursued to create multiplymodified PH20 polypeptides involves an iterative process of mutagenesis, screening and selection steps. An excerpt is provided below.

> The method can be performed a plurality of times, whereby the steps of the method are repeated 1, 2, 3, 4 or 5 times. The method provided herein also is iterative. In one example, after

⁷⁷ EX1001 ('520 Patent), 44:1-3.

⁷⁸ EX1001 ('520 Patent), 127-20-65, 128:7-129:49, 130:9-134:52.

the method is performed, any identified modified hyaluronandegrading enzyme can be modified or further modified to increase or optimize the activity.⁷⁹

175. The mutagenesis methodology being described involves performing site-directed mutagenesis in which "single amino acid residues" are replaced at "target positions one-by-one, such that each individual mutant generated is the single product of each single mutagenesis reaction."⁸⁰ It says these techniques also can be configured to introduce any of 10 to 19 alternative amino acids in these single mutations.⁸¹

176. The screening clearly is geared to finding modified PH20 polypeptides that have hyaluronidase activity. For example, the common disclosure suggests that mutants can be screened to find those that retain hyaluronidase activity "…whereby the activity of the enzyme is indicative of the stability of the enzyme as a measure of its resistance to denaturation.⁸² It also

⁸⁰ EX1001 ('520 Patent), 129:57-62.

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- ⁸¹ EX1001 ('520 Patent), 129:50-130:7.
- ⁸² EX1001 ('520 Patent), 133:1-5. *Also* EX1001 ('520 Patent) 133:16-21 ("In examples of the methods herein, the activity of the modified hyaluronan

⁷⁹ EX1001 ('520 Patent), 127:66-128:4.

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suggests using cutoffs for relative activity, and that a mutant may be assumed to exhibit stability "if any detectable activity is measured or assessed upon exposure or incubation with a denaturation condition or denaturing agent."⁸³

177. The common disclosure provides two general plans for producing modified PH20 polypeptides that may contain multiple substitutions. Each proposes using successive rounds of mutagenesis and screening to introduce single amino acid changes "one-by-one." In one, mutants are to be selected if they are "exhibiting stability, such as increased stability [that] can be modified or further modified to increase or optimize the stability." Then, a "secondary library can be created by introducing additional modifications in a first identified modified hyaluronan-degrading enzyme" and then testing that secondary library "using the assays and methods described herein."84

degrading enzyme is assessed upon exposure to a first denaturation condition and also assessed upon exposure to a second condition that is a control or nondenaturation condition, and the resulting hyaluronidase activities [are] compared.").

⁸³ EX1001 ('520 Patent), 133:40-54.

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⁸⁴ EX1001 ('520 Patent), 134:54-67.
178. The second approach proposes starting with mutants that "are identified as not exhibiting stability such as increased stability (e.g., such that they are not active or do not have increased activity under [] a denaturation condition)" and "can be further modified and retested for stability under a denaturation condition."⁸⁵ The targeting of these further mutations is described as follows:

> The further modifications can be targeted near particular regions (e.g., particular amino acid residues) associated with activity and/or stability of the molecule. For example, residues that are associated with activity and/or stability of the molecule generally are critical residues that are involved in the structural folding or other activities of the molecule. Hence, such residues are required for activity, generally under any condition. Critical residues can be identified because, when mutated, a normal activity of the protein is ablated or reduced. For example, critical residues can be identified that, when mutated in a hyaluronandegrading enzyme, exhibit reduced or ablated hyaluronidase activity under a normal or control assay condition.⁸⁶

179. This largely conceptual, trial-and-error research plan assumes that "ablated or reduced" enzymatic activity identifies critical residues "associated with

⁸⁵ EX1001 ('520 Patent), 135:1-6.

⁸⁶ EX1001 ('520 Patent), 135:1-19.

activity and/or stability of the molecule."⁸⁷ This assumption is not warranted. The loss of activity, as I explained previously, is not a direct measure of stability. It may be caused by mutations the influence the rate of catalysis without altering the overall stability of the protein (*e.g*., influencing presentation or catalysis of the substrate). Conversely, changes that do affect the stability of the protein may not materially impair the activity of the catalytic active site.

180. The common disclosure's theoretical research plan is also largely meaningless when it is applied to the data in the common disclosure. The plan proposes to introduce modifications "near particular regions (e.g., particular amino acid residues) associated with activity and/or stability of the molecule." The data reported in Tables 5 and 10 show that at least one substitution at each of 405 different positions between positions 1 and 444 of the sequence rendered the 447 amino acid PH20 polypeptide inactive. $88\,$ In other words, under the logic of the common disclosure's research plan, the skilled artisan should "target" mutations to positions "near" 90% of the protein sequence. Thus, the research plan provides little to no guidance on how to design and/or choose mutations in this protein.

⁸⁷ EX1001 ('520 Patent), 135:1-19.

⁸⁸ EX1001 ('520 Patent), Tables 5, 10.

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181. As I explained above (§ II.B.1, ¶¶ 50-52), the major challenge in using directed evolution techniques in protein engineering is scale. It is critical that each phase of the process is designed to navigate the challenge of making and screening such a huge scale of mutants.

182. For example, mutagenesis techniques must be focused on regions of the PH20 that are likely to productive mutations. The common disclosure does not provide any real guidance on this part of the process. It basically leaves the entire protein open as a target for mutagenesis.

183. When the mutagenesis methodology is unfocused as it is here, the importance of rapid, efficient and accurate screening and selection assays is paramount. The assays have to identify a characteristic of the mutated PH20 proteins that will narrow the massive collection of proteins in a productive manner. The assays described in the common disclosure do not do that. They instead say the mutants "can be tested using the assays and methods described herein." EX1001 ('520 Patent), 135:24-26. The only example in the patent showing a screening assay being applied to a library of mutants is in Examples 3 and 4.⁸⁹ This assay is based on a simple hyaluronidase activity screen, which selects active

⁸⁹ EX1001 ('520 Patent), 225:11-227:28 (Example 3), 227:30-228:35 (Example 4).

mutants if they show at least 40% of the hyaluronidase activity of a control. As I pointed out previously, the control values seen with this type of SEAP assay had a very wide range of activity. The assay being described is not one that would remedy the problems of the unfocused mutagenesis methodology of this procedure.

184. A scientist following this iterative mutagenesis and screening research plan cannot know in advance of conducting multiple rounds of experiments, whether modified PH20 polypeptides will be produced that have sets of 5, 10, 15, or more substitutions and retain sufficient activity that will be selected for the next round of the process. More directly, until a modified polypeptide with multiple substitutions is identified and characterized, the structural or functional properties of that mutant protein are not known (beyond possession of some threshold of relative activity used to select it). In other words, a skilled art cannot know *which* combinations of amino acids in *which* positions will be in the sequence of a modified PH20 polypeptide that is enzymatically active until that mutant is actually made, tested, isolated and characterized.

Petitioner Merck 185. Likewise, until multiply-mutated PH20 polypeptides are actually made, isolated, characterized and tested, the skilled artisan could not know which of them would yield modified PH20 polypeptides with particular functional profiles, such as exhibiting more than 100% of the activity of the unmodified PH20 polypeptides or exhibiting increased stability or resistance in denaturing conditions

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relative to unmodified forms of the protein. There is no guidance in the patents that helps the skilled artisan predict which particular combinations of 2 to 42 amino acid substitutions will yield modified PH20 polypeptides with these types of functional profiles (let alone why any particular combination of changes would yield increased activity and/or stability).

2. Discovering All the Active Mutant Multiply-Modified PH20 Polypeptides Within the Scope of the Claims Is Impossible

186. The directed evolution methodology used in the common disclosure to create mutant PH20 polypeptides, as I have discussed, was not new in the 2011 timeframe. The technique, however, is the quintessential "make and test" trial and error technique. By definition, the scientist carrying out a directed evolution protocol does not know which of the potentially trillions of possible mutants might incorporate a substitution that causes the protein to exhibit an improved characteristic, whether that is measured as increased stability, activity or something else.

187. As I explain in the preceding section, the common disclosure suggests that one can use an iterative, single mutation mutagenesis methodology to make modified PH20 polypeptides that would contain more than one substitution. In that process, a first set of mutants with one substitution are created, screened and those with some level of activity are selected. Then, the process is repeated, but here a

second single substation is introduced into each of the singly-substituted mutants that were selected in the first round, that set of "doubly-substituted" mutants is screened, and the doubly-substitute mutants above the cutoff activity threshold are selected.

188. To produce a set of multiply-modified PH20 polypeptides matching the limits of substitutions defined by the sequence parameters in the claims (*i.e.*, up to between 21 and 42 substitutions) pursuant to the methodology in the common disclosure, its process would be repeated 20-41 times (assuming one starts with a E324D, E324N, or E324R mutant in the first round). This methodology conceptually would narrow the number of n-substituted mutants in the (n)-library being screened in each step, like an inverted funnel. At the end of this iterative process, there may be one, none or some unidentified number of mutants having 21 to 41 single substitutions that was active. But because each step (n) of the process will have eliminated some (unknowable) number of (n)-substituted PH20 polypeptides during its activity screening step, the $(n+1)$ round of the process will introduce single substitutions in a (presumably) smaller set of $(n+1)$ -substituted PH20 polypeptides. In other words, after performing between 20 and 41 rounds of this iterative mutate/screen/select process, one would not have all the multiplysubstituted PH20 polypeptides with activity, they would have only those that survived the screening steps in each round of the sequence.

189. Given the massive number of possible distinct PH20 polypeptides having between 2 and 42 substitutions that the sequence identity parameters of the claims capture, one would have to repeat this iterative process innumerable times to identify all of the enzymatically active multiply-mutated PH20 polypeptides in the scope of the claims. As I noted earlier, the aggregate mass of the collection of individual modified PH20 polypeptides covered by the claims (all of which have one of the three specified position 324 mutations of the narrowest claims) that would have to be produced and screened is greater than the mass of the earth. This task is simply impossible!

Petitioner Merck 190. The common disclosure does not provide guidance that a skilled artisan could have used to identify which of the trillions of possible combinations of 2 to 42 substitutions in PH20 would retain 40% of the activity of the unmodified parent PH20 polypeptide. It also does not provide any guidance that would enable a skilled artisan to identify the subset of that massive (and unknowable) set of enzymatically active PH20 polypeptides having the myriad possible combinations of between 2 and 42 substitutions that result in the PH20 polypeptide having greater than 100% of the activity of the parent unmodified PH20. A skilled artisan, for example, could not, as a practical matter, use rational design techniques to assess all these possible variant sequences of PH20. There is not enough time in a person's lifetime to do that. Also, protein structural models available in the 2011

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timeframe would not be able to reliably assess sequences that incorporated more than a few variant residues in one region of the protein.

191. Also, a skilled artisan would not have assumed that a singlysubstituted PH20 polypeptide that exhibited increased activity would retain that activity if 1 to 41 *additional* substitutions were incorporated into any arbitrary position of its sequence. One can readily imagine scenarios where additional substitutions are made in portions of a sequence responsible for particular secondary structures of the protein, and which would disrupt those structures. See § II.B.2, above. Changes could also be made in the region of the first substitution that would have disruptive effects on secondary structure.

192. For example, position 324 is located near the middle of the " α 8" α helix structure in PH20 based on the information reported in Chao's alignment (below). As I have explained in my publications in the scientific literature, α helices typically require a characteristic pattern of polar and non-polar residues to form and maintain the helical structure.⁹⁰ Introducing random amino acids could disrupt that pattern, which could have a range of effects in this region of the helical structure.

⁹⁰ EX1046 (Beasley), 2031-2032; EX1047 (Xiong), 6349, 6351.

193. The absence of any experimental characterization of any examples of multiply-substituted PH20 polypeptides here is fatal to being able to predict the effects of making 1 to 41 additional substitutions beyond the E324D, E324N, or E324R substitutions. The skilled person would have to perform innumerable rounds of mutagenesis and screening, a "make-and-test" type of experimental protocol, to discover all possible multiply-substituted, enzymatically active mutants in the scope of the claims.

VI. The E324D, E324N, and E324R PH201-447 Mutants Would Have Been Obvious

194. As I have explained above, the effects of making numerous substitutions to a naturally occurring protein, particularly when they are proximate to each other or are in related or proximate structures in the protein, would have been unpredictable in 2011. By contrast, it was possible, by studying a particular protein structure, to assess whether a single amino acid substitution within a

defined structure would be likely to be tolerated or not. This is the essence of the rational design methodology used in protein engineering.

A. The '429 Patent Suggests Making Single-Amino Acid Substitutions in Non-Essential Regions of PH201-447

1. The '429 Patent Describes PH201-447, Its Production and Its Uses

195. I reviewed the '429 Patent, which is owned by the same company that owns the '520 Patent (Halozyme) and which produces the Hylenex® human PH20 biological product that was approved in 2005. I understand that Hylenex® consists of the human PH20 protein having residues 1-447 of the mature form of PH20 (*i.e*., without the signal sequence).⁹¹ Because the PH20₁₋₄₄₇ form of PH20 was already an approved therapeutic product, it would be a focus of interest by persons of ordinary skill in the art in 2011 investigating therapeutic uses of human hyaluronidase enzymes.

196. The '429 Patent describes production of soluble, neutral active PH20 human hyaluronidase proteins, which it refers to using the abbreviation "sHASEGPs."⁹² It explains these proteins can be made soluble by truncating the PH20 sequence before the start of the GPI anchor sequence of the protein, which it

 91 EX1049 (Hylenex sequence), 1.

⁹² EX1005 ('429 Patent), 3:51-56.

identifies as being at position 483 in the full-length sequence (including the signal sequence).⁹³ One of these soluble, neutral, truncated proteins is $PH20_{1-447}$, which consists of residues 36 to 482 of the full-length PH20 sequence.⁹⁴

197. The '429 patent explains PH20 enzymes must be glycosylated to exhibit their catalytic activity.⁹⁵ As it states:

> N-linked glycosylation of the sHASEGP's are critical for their catalytic activity and stability. While altering the type of glycan modifying a glycoprotein can have dramatic affects on a protein's antigenicity, structural folding, solubility, and stability, most enzymes are not thought to require glycosylation for optimal enzyme activity. sHASEGPs are thus unique in this regard, that removal of N-linked glycosylation can result in near complete inactivation of the Hyaluronidase activity.

198. A skilled artisan would have taken away from this observation that PH20 polypeptides should be produced in mammalian host cells to ensure they are glycosylated and retain enzymatic activity. The '429 Patent also describes conventional methods of producing enzymatically active PH201-447 in CHO cells

⁹⁵ EX1005 ('429 Patent), 7:9-20.

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⁹³ EX1005 ('429 Patent), 3:58-3, 86:7-88:24.

⁹⁴ EX1005 ('429 Patent), 87:52-88:10.

transfected with a bicistronic vector containing a DNA sequence encoding the 1- 182 sequence of PH20.⁹⁶

199. The '429 Patent explains that human PH20 enzymes (including PH201-447) are useful in various human therapeutic applications and provides a lengthy list of those therapeutic uses at columns 54 to 83. These various therapeutic uses of PH20 enzymes are based on the ability of the PH20 enzyme to selectively degrade hyaluronic acid/hyaluronan, a class of negatively charged polysaccharides.⁹⁷ Some of the therapeutic uses of enzymatically active PH20 polypeptides that the '429 Patent describes address a hyaluronan-associated disease or condition, and involve administering the PH20 polypeptide to the subject, and include the following:

reversing the inhibition caused by chondroitin sulfate proteoglycans in glial scars and promoting axon regeneration following injury;⁹⁸

⁹⁸ EX1005 ('429 Patent), 71:48-72:6.

⁹⁶ EX1005 ('429 Patent), 89:53-61 (describing HZ24 vector containing "DNA encoding 1-482 of human PH20 hyaluronidase"); 90:19-91:67 (production of CHO cell expressing HZ24); 92:1-40 (expression and recovery of $PH20_{1-447}$).

 97 EX1005 ('429 Patent), 2:11-16, 26:11-14, 70:38-41.

- treatment of herniated disks;⁹⁹
- removal of the cumulus cells surrounding an egg in connection with in vitro fertilization procedures;¹⁰⁰
- treating various ophthalmic disorders (*e.g*., injuries or increased eye pressure following cataract surgery); 101
- during organ transplantation, treating interstitial edemas and degrading accumulated glycosaminoglycans; 102
- treating pathologic accumulations of glycosaminoglycans in the brain or in cardiovascular disease;¹⁰³ and
- treating cysts or infiltrations of the skin by glycosaminoglycans. 104
- 200. The '429 Patent also portrays PH20 enzymes (including $PH20_{1-447}$)

and pharmaceutical compositions that contain them as being useful in the treatment

⁹⁹ EX1005 ('429 Patent), 72:15-31.

- ¹⁰⁰ EX1005 ('429 Patent), 72:62-73:3.
- ¹⁰¹ EX1005 ('429 Patent), 77:54-78:33, 81:21-82:29.
- ¹⁰² EX1005 ('429 Patent), 78:60-79:22.
- ¹⁰³ EX1005 ('429 Patent), 79:23-80:43.
- ¹⁰⁴ EX1005 ('429 Patent), 80:7-52.

of cancer.¹⁰⁵ One example is to use PH20 to increase the sensitivity of cancers to chemotherapeutic agents or treating cancers with decreased to undetectable hyaluronidase activity.¹⁰⁶ Another example is using soluble, enzymatically active forms of hyaluronidase in combination with "anti-cancer agents" (*e.g.*, chemotherapeutic agents or other cancer treatments, such as antibodies, peptides, or gene therapies).¹⁰⁷ It also indicates that hyaluronidase enzymes can be used as a "delivery or 'spreading' agent in combination with a second active compound, such as a drug or prodrug, to facilitate delivery of or to enhance the activity of the second active ingredient," and particularly for subcutaneous administration and

¹⁰⁵ EX1005 ('429 Patent), 73:4-74:58.

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- ¹⁰⁶ EX1005 ('429 Patent), 73:21-58.
- ¹⁰⁷ EX1005 ('429 Patent), 73:4-16.

delivery of therapeutically active proteins.¹⁰⁸ It points out this is useful when subcutaneously injecting these therapeutic agents.¹⁰⁹

201. The '429 Patent also describes pharmaceutical compositions that contain a PH20 protein, either by itself or in combination with another therapeutic agent.¹¹⁰ One benefit the '429 Patent identifies for combining a PH20 polypeptide with another therapeutic agent in a pharmaceutical composition is to facilitate "delivery or 'spreading'" of the therapeutic agent.¹¹¹ As it explains, the inclusion

- 108 $EX1005$ ('429 Patent), 56:34-57:21 (contemplating co-formulation of PH20 enzymes with "various chemotherapeutics"). Other examples include chemotherapeutic agents, anti-inflammatory agents, analgesic agents, etc. EX1005 ('429 Patent), 60:38-61:4.
- ¹⁰⁹ EX1005 ('429 Patent), 63:41-44 (contemplating "[p]arenteral administration of the sHASEGP or a soluble human hyaluronidase domain thereof, generally characterized by injection, either subcutaneously, intramuscularly or intravenously"); EX1005 ('429 Patent), 76:18-77:37.
- ¹¹⁰ EX1005 ('429 Patent), 54:40-65 ("The sHASEGP polypeptide and a second agent can be packaged as separate compositions for administration together or sequentially or intermittently" or "as a single composition").
- ¹¹¹ EX1005 ('429 Patent), 56:66-57:21.

of the PH20 in the pharmaceutical composition with the other therapeutic agent is done "to increase diffusion of other injected molecules less than 200 nm in diameter," and that this enables the combined pharmaceutical compositions to be injected subcutaneously into patients.¹¹²

202. The '429 Patent portrays the therapeutic uses and pharmaceutical compositions I discuss in ¶¶ [199](#page-119-0)[-201](#page-122-0) as being shared by the class of hyaluronidase enzymes that the patent refers to as "sHAGEGPs," which include both the wildtype, C-terminally truncated (soluble) forms of PH20 and variants having a single amino acid substitution in a non-essential region of that protein.¹¹³

203. I note that conventional procedures relating to production of the wildtype PH201-447 protein that are described in the '429 Patent could be applied to produce forms of PH201-447 that incorporate a single amino acid substitution (*e.g*., the E324D, E324N, or E324R substitutions I discuss below) with little effort.¹¹⁴ It involves using the conventional techniques of creating a modified nucleotide sequence encoding the $PH20_{1-447}$ sequence with the single amino acid change,

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¹¹² EX1005 ('429 Patent), 1:16-27, 8:1-10, 8:60-9:4, 76:18-38.

¹¹³ See ¶ 206, below; EX1005 ('429 Patent), 39:54-40:1-20, 39:8-16, 10:6-13; *also* 16:4-13.

¹¹⁴ See EX1005 ('429 Patent), 39:54-40:21.

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inserting it into the vector described in the common disclosure, and then using the vector to transfect a CHO cell, again as is described in the common disclosure.¹¹⁵ The '429 Patent also indicates that different heterologous signal sequences can be used when expressing PH20 sequences, and was generally a known technique.¹¹⁶ The modified $PH20_{1-447}$ proteins would be C-terminally truncated and therefore would be expected to be soluble.

204. The '429 Patent reports that expressing $PH20₁₋₄₄₇$ mutants in a CHO cell yields a glycosylated form of the protein that is enzymatically active.¹¹⁷ The '429 Patent explains that PH20 must be glycosylated to exhibit enzymatic activity, and that its techniques of expressing the wild-type $PH20₁₋₄₄₇$ protein in CHO cells yielded enzymatically active forms of that protein. There is no reason to believe the E324D, E324N, or E324R PH20 $_{1-447}$ mutants would not be equivalently glycosylated.

205. The '429 Patent describes modifying $PH20₁₋₄₄₇$ mutant proteins to "prolong its half life by way of masking the protein with polyethylene glycol" and that "[c]hemical modifications of a sHASEGP with polymers such as polyethylene

¹¹⁵ EX1005 ('429 Patent), 89:51-90:16 (Example 6), 90:19-91:67 (Example 7).

¹¹⁶ EX1005 ('429 Patent), 6:50-55, 14:1-55, 15:19-54, 37:21-36.

¹¹⁷ EX1005 ('429 Patent), 89:43-91:67 (Example 7).

glycol and dextran are provided."¹¹⁸ It also explains that sHASEGPs can be conjugated with "one or more targeting agents," joined with other proteins to yield "fusion proteins," or conjugated to a drug or prodrug.¹¹⁹ Targeting agents include multimerization domains, such as Fc domains. $PH20₁₋₄₄₇$ mutant proteins can also comprise a "chimeric protein."¹²⁰ I would expect that single-substitution $PH20_{1-447}$ mutants including the E324D, E324N, and E324R single substitution mutants, could be similarly modified and/or conjugated, following the guidance in the examples in the '429 Patent.

2. The '429 Patent Says to Make Single Amino Acid Substitutions in Non-Essential Regions of PH20

206. The '429 Patent describes a class of soluble neutral active PH20 hyaluronidases that it calls "sHASEGP" proteins, including variants with "protein

- ¹¹⁹ EX1005 ('429 Patent), 18:33-52, 54:20-37.
- ¹²⁰ EX1005 ('429 Patent), 51:11-41.

¹¹⁸ EX1005 ('429 Patent), 3:64-4:1, 4:45-53; *also* EX1005 ('429 Patent), 26:20- 28:4 (describing conjugation of modified PH20 proteins to polymers, including PEG).

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level" modifications, particularly amino acid substitutions that "do not substantially alter biological activity of" the proteins.¹²¹ It also indicates that:

> Suitable substitutions, including, although not necessarily, conservative substitutions of amino acids, are known to those of skill in this art and can be made without eliminating the biological activity, such as the catalytic activity, of the resulting molecule.¹²²

207. The '429 Patent then explains that a skilled artisan would "recognize that, in general, single amino acid substitutions in non-essential regions of polypeptides" (like PH20) "do not substantially alter biological activity" (*i.e*.,

¹²² EX1005 ('429 Patent), 10:9-13; *also* 40:1-20, 39:6-16, 10:6-13, *also* 16:4-13 ("For purposes herein, amino acid substitutions can be made in any of sHASEGPs and Hyaluronidase domains thereof provided that the resulting protein exhibits Hyaluronidase activity. Amino acid substitutions contemplated include conservative substitutions, such as those set forth in Table 1, which do not eliminate proteolytic activity.").

¹²¹ EX1005 ('429 Patent), 39:6-16, 9:46-52, 10:6-13.

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hyaluronidase activity).¹²³ In other words, the '429 Patent is explaining the prevailing beliefs among skilled artisans that making a single amino acid substitution within a non-essential region of PH20 would be tolerated by the enzymatically active forms of PH20 being described in the '429 Patent. Those would be the forms that contain the "minimally active domain" (*i.e*., terminating at residues 438 to 448). A skilled person would have generally agreed with this explanation in the 2011-timeframe, particularly with respect to the $PH20_{1-447}$ protein that was shown to be enzymatically active. That person thus would expect that the $PH20_{1-447}$ protein incorporating a single amino acid substitution in a nonessential region would retain much of its activity, depending on the position of the substitution and the amino acid being substituted into that position. A skilled artisan also would have expected that the PH201-447 protein incorporating a single amino acid substitution in a non-essential region would generally have the same therapeutic uses and utilities as described with respect to the $PH20₁₋₄₄₇$ protein (discussed above).¹²⁴

¹²³ EX1005 ('429 Patent), 16:4-21; *also* 9:47-52 ("Those of skill in this art recognize that, in general, single amino acid substitutions in non-essential regions of a polypeptide do not substantially alter biological activity…")

¹²⁴ EX1005 ('429 Patent), 56:66-57:21, 73:4-74:29.

208. A skilled artisan also would not have read the '429 Patent as suggesting that the only amino acid substitutions that should be considered for non-essential positions in PH20 are the "conservative" substitutions are those listed in Table 1. The '429 Patent describes those as only being examples and explains that "other substitutions are also permissible and can be determined empirically or in accord with known conservative substitutions."¹²⁵ In any event, I note that aspartic acid (D) is identified as being a conservative amino acid substitution for glutamic acid (E) in Table 1 of the '429 Patent. A skilled artisan following this guidance in Table 1 of the '429 Patent would have viewed the E324D substitution in PH20₁₋₄₄₇ to be an example of what the '429 Patent is describing to be a conservative substitution that would maintain the enzymatic activity of the PH201-

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¹²⁵ EX1005 ('429 Patent), 16:24-36.

⁴⁴⁷ protein (below).

TABLE 1 Original residue Conservative substitution Ala (A) Gly; Ser, Abu Arg (R) Lys, orn Asn (N) Gln; His Cys (C) Ser Gin (Q) Asn Glu (E) ASP Gly (G) Ala; Pro His (H) Asn; Gin Ile (I) Leu; Val; Met; Nle; Nva Leu (L); Val; Met; Nle; Nv Lys (K) Arg; Gin; Glu Met (M) Leu; Tyr; Ile; NLe Val Ornitine Lys; Arg Phe (F) Met; Leu; Tyr Ser (S) Thr Thr (T) Ser $Trp(W)$ Tyr Tyr (Y) Trp; Phe Val (V) ILE; Leu; Met; Nle; Nv Other substitutions are also permissible and can be determined empirically or in accord with known conservative substitutions.

B. The Skilled Artisan Would Consider Chao for Structural Insights into Making Modified PH20 Polypeptides

209. In 2011, a skilled artisan interested in producing modified PH20

polypeptides as the '429 Patent proposes would have certainly reviewed the Chao

paper (EX1006) in conjunction with the '429 Patent.

210. A skilled artisan would have viewed the Chao paper as being highly

relevant to process of implementing single amino acid substitutions in non-

essential regions of $PH20₁₋₄₄₇$ because it contains the type of information they

would use to carry out a rational design project, particularly an experimentally-

determined structure for the human HYAL1 hyaluronidase protein. It also

provided extensive discussion on structural similarities among human and non-human hyaluronidase proteins.¹²⁶ See § [II.E.2.](#page-47-0)

211. Chao also provided an annotated sequence alignment of the five human hyaluronidase enzymes. In that alignment, Chao identified: (i) 76 invariant conserved positions (blue), (ii) 3 residues involved in catalysis (red), (iii) 10 conserved cysteine residues that form disulfide bonds (gold) and (iv) 3 conserved asparagine residues that are glycosylated (turquoise).¹²⁷ This type of information, again, was the type of information used routinely to perform rational design protein engineering in the 2011 timeframe.

C. The Skilled Artisan Would Have Identified Non-Essential Regions in PH20 and Suitable Amino Acid Substitutions Using a Multiple Sequence Alignment of Homologous Hyaluronidase Proteins

212. As I explained in § [VI.A.2](#page-125-0), the '429 Patent would have encouraged a skilled artisan to make modified PH20 proteins having single amino acid substitutions in non-essential regions. The skilled artisan would have understood these non-essential regions to be the regions between the conserved residues within PH20, which are residues that are generally considered essential to the structure and functions of proteins like hyaluronidase enzymes. The skilled artisan also

 126 EX1006 (Chao), 6915.

 127 EX1006 (Chao), 6916.

would assess the conserved residues using sequences of homologous hyaluronidase proteins that were available in 2011.

213. To identify conserved residues, and thereby simultaneously identify the non-essential regions of PH20, the skilled artisan would have produced and analyzed a multi-sequence alignment based on protein sequences having significant sequence homology to PH20. Protein scientists routinely used sequence alignments, and particularly multiple sequence alignments, to identify conserved residues within families of related proteins.¹²⁸ For example, both the '429 Patent and Chao discuss using sequence alignments in their analyses.¹²⁹

214. A multiple-sequence alignment also identifies the different amino acids that occur in non-essential positions in a protein and allows one to calculate the frequency with which each amino acid occurs at each position in the set of proteins being aligned. It is important to remember that these different amino acids are found in actual, naturally occurring proteins that have evolved over

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¹²⁹ EX1005 ('429 Patent), 12:46-49 ("By sequence identity, the numbers of conserved amino acids is determined by standard alignment algorithms programs, and are used with default gap penalties established by each supplier."); EX1006 (Chao), 6913, 6915-16, Figure 3.

¹²⁸ EX1014 (Brandon & Tooze), 351.

millions of years. The presence of these amino acids at the non-essential positions in hyaluronidase enzymes from different species demonstrates that proteins containing them are stable enough to survive evolutionary pressure that would have been eliminated from the genomes of organisms if they were not stable or were inactive.

215. I reviewed Dr. Park's report and its analyses (EX1004). Dr. Park performed an analysis that I believe a skilled artisan would have performed in 2011. His methodology included (i) using a multiple-sequence alignment to identify non-essential regions of PH20 (including position 324), (ii) identifying the amino acids that occur at those non-essential regions in the proteins in the set used for the alignment, and (iii) assessing whether amino acid substitutions appearing in nature at position 324 would be tolerated by PH20.

216. I believe Dr. Park's techniques and analysis—which follow a rational design approach to analyzing mutated proteins—were used by scientists I worked with in the 2011 timeframe in similar projects. I am familiar with these types of analyses. I also would have obtained these types of analyses and compilations of data from a similarly qualified colleague in 2011 when engaged in such a project. I found Dr. Park's analyses to be objective, thorough, useful, and reliable.

D. Both Chao and a Multi-Sequence Alignment of Proteins Homologous to PH20 Would Have Identified Position 324 Being in a Non-Essential Region and Suggested Aspartic Acid (D), Asparagine (N), and Arginine (R) as a Single Substitution at Position 324

217. Position 324 is within a non-essential region of the PH20 sequence,

based on my review of Dr. Park's analysis¹³⁰ and the sequence alignment in Chao.

The nearest conserved residues to position 324 are C316 and L327. Chao

identifies the region between C316 and L327 as containing 10 non-conserved

residues, which includes glutamic acid at position 324. This region and position

324 are annotated in the excerpt from Figure 3 of Chao below.

218. Dr. Park's report identifies the frequencies of amino acids that occur in sequences homologous to PH20 as of December 2011. As shown below, at positions corresponding to 324 in PH20, the most prevalent amino acid is aspartic

¹³⁰ EX1004 (Park Dec.), ¶¶ 31-32, 106-107 and appendices thereto.

acid (D), which appears in approximately 25% of the proteins homologous to PH20. Threonine is the second-most prevalent amino acid at this position (13.6%, 12 homologous proteins), while the wildtype amino acid (*i.e.*, glutamic acid) is the third-most prevalent amino acid (approximately 12.5%, 11 homologous proteins). Asparagine (N) and arginine (R) appeared in 7% (6 proteins) and 6% (5 proteins) of the set of homologous proteins, respectively.

219. Chao identifies the glutamic acid at position 324 of the wild-type PH20 sequence as being located near the middle of the α -helix secondary structure designated α 8.¹³¹ Dr. Park's MSA shows that that a large number (12) of other amino acids occur in homologous proteins at positions corresponding to position 324 in PH20. It also shows that these alternative amino acids have diverse properties (*e.g.*, polar vs. non-polar, small vs. large side chains, charged or uncharged residues, etc.).

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¹³¹ EX1006 (Chao), Figure 3.

220. A skilled artisan, in 2011, would have readily identified position 324 as being in one of the non-essential regions of $PH20₁₋₄₄₇$ contemplated by the '429 Patent. A skilled artisan also would have considered aspartic acid, asparagine, and arginine to be obvious choices for substitutions for glutamic acid at position 324 under the rationale of the '429 Patent in 2011. There are several reasons for this conclusion.

- (a) Dr. Park's multiple sequence alignment of hyaluronidase proteins homologous to PH20 available in December of 2011 identifies aspartic acid, asparagine, and arginine as being amino acids that are tolerated at positions corresponding to position 324 in PH20 in many homologous hyaluronidase proteins.¹³²
- (b) Aspartic acid was the most prevalent amino acid observed to occur in the 88 published homologous sequences. Aspartic acid also occurs in a position corresponding to 324 in one other human hyaluronidase enzyme (Hyal1) as Chao illustrates.¹³³

¹³² EX1006 (Chao), 6916, Figure 3; EX1004 (Park Dec.), $\P\P$ 106, 111; Appendix D.

¹³³ EX1006 (Chao), 6916, Figure 3.

- (c) The environment at position 324 is solvent exposed, which favors hydrophilic residues like aspartic acid, asparagine, and arginine.¹³⁴
- (d) Table 1 of the '429 Patent identifies aspartic acid as a conservative substitution for glutamic acid, which would have provided another reason to substitute aspartic acid for glutamic acid at position 324.¹³⁵

221. The skilled artisan also would have reasonably expected, consistent with the '429 Patent's guidance and their knowledge of protein structure, that substituting aspartic acid (D), asparagine (N) or arginine (R) for glutamic acid (E)at position 324 of PH20₁₋₄₄₇ would not substantially alter the biological activity of $PH20_{1-447}$ protein. In other words, the skilled artisan would have expected the E324D, E324N, and E324R PH20₁₋₄₄₇ mutants to retain most of the hyaluronidase activity of the unmodified $PH20_{1-447}$ protein. As I noted above, position 324 in PH20 is solvent accessible and many different amino acids are tolerated at it in naturally occurring homologous hyaluronidase proteins. In addition, there a large number of homologous hyaluronidase proteins that have aspartic acid, asparagine, and arginine at positions corresponding to 324 in PH20: aspartic acid occurs in that position in 22 such proteins and 1 other human hyaluronidase enzyme while

¹³⁴ EX1004 (Park Dec.), ¶ 110.

¹³⁵ EX1005 ('429 Patent), 16:7-36.

asparagine (N) and arginine (R) appear at that position in 6 and 5 homologous proteins, respectively. The probability that aspartic acid, asparagine, or arginine would not be tolerated in the PH20 structure around position 324 is very low, given the high degree of homology that a single-substitution PH20 mutant containing any of those three amino acids would have with the enzymatically active wild-type PH20 protein and the homologous proteins that do include them at positions corresponding to position 324. A skilled artisan thus would have expected that the E324D, E324N, and E324R substitutions in $PH20₁₋₄₄₇$ to be tolerated, and the resulting mutant would exhibit comparable activity to the unmodified $PH20_{1-447}$ enzyme, as the '429 Patent suggests.

222. A skilled artisan would have expected a $PH20₁₋₄₄₇$ protein containing any of these three single substitutions at position 324 (*i.e*., the E324D, E324N, or E324R mutants) to retain the general properties of the wildtype $PH20₁₋₄₄₇$ protein. Given this, a skilled artisan would have expected the E324D, E324N, or E324R single substituted $PH20_{1-447}$ proteins to have the same therapeutic uses that were identified in the '429 Patent for the wildtype $PH20_{1.447}$ protein.¹³⁶ In addition, the person would have expected the E324D, E324N, and E324R $PH20₁₋₄₄₇$ proteins to

¹³⁶ EX1005 ('429 Patent), 56:66-57:21, 73:4-74:29.

be soluble, which results from truncating the PH20 protein sequence before the start of the GPI anchor sequence in it at around position 448.¹³⁷

E. Inspection of the E324D, E324N, and E324R Substitutions in a PH20 Structural Model Confirms that Each Substitution Would be Tolerated in PH201-447

223. I believe the availability of an experimentally-determined structure of human HYAL1 would have prompted a skilled artisan in 2011 to produce a PH20 structural model and use it to assess single amino acid substitutions in $PH20₁₋₄₄₇$. This precise point is made in the Brandon & Tooze textbook, which captured prevalent thinking in the field in the 2011 timeframe. As it explains:

> If significant amino acid sequence identity is found with a protein of known crystal structure, a three-dimensional model of the novel protein can be constructed, using computer modeling, on the basis of the sequence alignment and the known threedimensional structure. This model can then serve as an excellent basis for identifying amino acid residues involved in the active site or in antigenic epitopes, and the model can be used for protein engineering, drug design, or immunological studies.¹³⁸

¹³⁷ EX1005 ('429 Patent), 3:58-3, 86:7-88:24.

¹³⁸ EX1014 (Brandon), 348.

224. Dr. Park explains in his report that he produced a PH20 structural model using Chao's HYAL1 structure as a template with the SWISS-MODEL tool.¹³⁹ Dr. Park's use of a HYAL1 structure to develop a model of PH20 in SWISS-MODEL is justified given Chao's observation that the HYAL1 sequence shares a high degree of sequence identity with PH20.

225. To assess the tolerability of a single amino acid change using a protein structural model, a skilled artisan would use the model to visualize the environment of the change and determine the nature of interactions the new amino acid in a position would have with its neighboring residues (both in the modeled sequence and in the experimental protein structure). Relevant types of interactions include: (1) whether the substitution will change the hydrophobicity or hydrophilicity of the environment; (2) whether the new residue has the potential to change secondary structure at the position; (3) whether the new residue would result in steric clashes within the protein environment; (4) whether the new residue would have tertiary interactions with neighboring residues; and (5) whether the substitution is made at a position that is solvent exposed or buried within the protein structure.¹⁴⁰

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¹³⁹ EX1004 (Park Dec.), ¶¶ 161-163.

¹⁴⁰ EX1004 (Park Dec.), ¶¶ 45-52.

226. Dr. Park also indicates that he did this type of analysis.¹⁴¹ He assessed the interactions between the wild-type residue (E) and the substituted amino acids aspartic acid (D) , asparagine (N) and arginine (R) with neighboring residues around position 324 in PH20. He also documented the interactions that he observed based on his analysis of the E324D, E324N, and E324R substitutions, and provided his assessment of how those factors collectively would have influenced the tolerability of aspartic acid, asparagine, or arginine at position 324 of PH20.

227. Dr. Park's analysis is similar to assessments of substituted residues that were described in peer-reviewed publications from scientists working in this field in the 2011 timeframe. For example, Dr. Moult's lab at UMBI published work with single nucleotide polymorphisms that created single amino acid mutations in human proteins. They explain that they used a very similar methodology of building protein model, visually assessing the interactions between a substituted amino acid and its neighboring residues at a defined position in the model, and ranking the substitution based on an assessment of the interactions.¹⁴²

¹⁴¹ EX1004 (Park Dec.), ¶¶ 53-83, 104, 113, 122, 130.

¹⁴² EX1031 (Yue), 460, 462-463.

228. I note that there were limits to using protein structural models in 2011 to assess the effects of modifications to a modeled protein structure. Dr. Park explained some of those limitations in his report.¹⁴³ One was that the model could provide reliable insights only for those portions of the model that were based on the experimentally determined structure, and which was within quality metrics for the model as a whole and for local regions of the model. For the PH20 model based on the HYAL1 structure, this limited use of the model beyond position 403 of PH20, as there is no corresponding sequence (and thus no structure) in HYAL1 for that part of PH20. Dr. Park also limited the N-terminal assessments to position 7 and higher. A second limitation is that the PH20 model built with SWISS-MODEL could not reliably assesses multiple amino acid changes, and would have very low reliability when assessing modified sequences containing 10-20 or more concurrent changes. This is because each additional amino acid change from the originally modeled structure will significantly degrade the ability of the model to predict the modified structure, as the model is no longer based on the existing, known structure or a naturally occurring sequence. Multiple amino acid changes in proximity to each other further reduce the reliability of the model, as interactions

¹⁴³ EX1004 (Park Dec.), ¶¶ 164-165, 172-174.

between changes caused by each amino acid change become more and more complex.

229. I reviewed Dr. Park's assessment of the single amino acid substitutions E324D, E324N, and E324R in $PH20₁₋₄₄₇$ and agree with his conclusion that, based on modeling techniques available in 2011, the E324D and E324N substitutions would each be expected to be a neutral change, while the E324R substitution would be expected to be a beneficial change.¹⁴⁴ As such, a skilled artisan would have expected the E324D, E324N, and E324R substitutions in $PH20_{1-447}$ to each be tolerated, with each yielding a mutant that maintains comparable hyaluronidase activity to the wild-type $PH20₁₋₄₄₇$ protein.

230. Dr. Park's model shows that the side chain of the glutamic acid at position 324 is solvent exposed (below).¹⁴⁵ The hydrophilic side chains of aspartic acid, asparagine, and arginine, if they were substituted at position 324 in PH20, would be positioned equivalently to the hydrophilic side chain of glutamic acid at position 324 in a solvent environment.¹⁴⁶ As such, one would expect the structure

¹⁴⁵ EX1004 (Park Dec.), ¶ 110.

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¹⁴⁶ EX1004 (Park Dec.), ¶¶ 116, 124, 132.

¹⁴⁴ EX1004 (Park Dec.), ¶¶ 121, 129, 137.
around position 324 to accommodate replacing the glutamic acid (a hydrophilic residue) at position 324 with aspartic acid, asparagine, or arginine.

231. Dr. Park's modeling shows that position 324 is near a proline residue at position 329 within the α 8 helix of PH20.¹⁴⁷ When a proline residue occurs within an α -helix sequence, it typically disrupts the alpha-helix structure. The proline at position 329 in PH20 disrupts the α 8 helix structure including around position 324. As the model shows, P329 introduces a "kink" or bend into the α 8 structure.¹⁴⁸

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¹⁴⁸ EX1004 (Park Dec.), ¶ 109.

¹⁴⁷ EX1004 (Park Dec.), ¶ 109.

232. The disruption of the alpha-helix structure within the α 8 helix in PH20 caused by the proline at position 329 makes the position 324 residue more solvent exposed, which is favorable to hydrophilic residues like arginine, aspartic acid, and arginine. It also lessens the importance of the amino acid at position 324 having a high helix propensity, as that residue will not need to support the helix structure to the same degree it might need to if there were no disruption of the alpha-helix structure.

233. Dr. Park's model shows that the side chain of the wild-type glutamic acid plays a role in restricting solvent access to the phenylalanine (F) residue at position 380 (below).¹⁴⁹ This appears to be due to the residue at position 324 sterically obstructing access by solvent to the F380 residue. That is consistent with the fact that many different amino acids with varying sizes and chemical

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¹⁴⁹ EX1004 (Park Dec.), ¶ 111.

characteristics are found at positions corresponding to position 324 in PH20, as it is more likely that these residues limit solvent access to F380 by their size or positioning, rather than due to the charge or polarity of their side chains.

234. Dr. Park's models show that the side chains of aspartic acid,

asparagine, and arginine would play a similar role in sterically obstructing solvent access to the F380 residue if any of those amino acids were substituted at position 324 in PH20. This is illustrated by the images below, which model the structures at position 324 with the D324, R324, and N324 single substitutions in PH20.¹⁵⁰

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¹⁵⁰ EX1004 (Park Dec.), ¶¶ 117, 125, 134.

235. Dr. Park also analyzed the QMEAN score associated with the PH20 model, including when assessing changes at position 324.¹⁵¹ The QMEAN scores Dr. Park observed for the entire protein and for the changes at position 324 indicate that the model was of acceptable quality.

236. Based on the assessment above, it is my opinion that one of skill in the art would reasonably expect that the E324D, E324N, and E324R substitutions in PH20 would each be tolerated, yielding a protein that exhibits at least comparable hyaluronidase activity as unmodified PH201-447.

237. Finally, I note that Dr. Park's analysis of the substitution to position 324 appears to have been done with no pre-existing knowledge or review of the '520 Patent,¹⁵² yet his conclusions regarding the tolerability of the substitutions

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¹⁵¹ EX1004 (Park Dec.), ¶¶ 120, 128, 136, 163-165.

¹⁵² EX1004 (Park Dec.), Exhibit List.

E324D, E324N, and E324R are consistent with the '520 Patent's report that the

E324D, E324N, and E324R substitutions resulted in an "active mutant."¹⁵³

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¹⁵³ EX1001 ('520 Patent), Table 9 (col. 231).

I, Michael Hecht, do hereby declare and state, that all statements made herein of my own knowledge are 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, under Section 1001 of Title 18 of the United States Code.

Michael Healt

Executed on: January 16, 2025

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Exhibit List

The list of exhibits that I relied upon in forming my opinions is below.

APPENDIX A

Data, Tables, and Analysis from U.S. Patent 12,110,520

Source(s) – Tables 3, 5, 8-12

APPENDIX A-1

Activity Distribution – Total Mutants

Source(s) – Tables 3, 5, 8-10

Totals from Table 9 and 10

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APPENDIX A-2

Composite List of Active Mutants

Source(s) – Tables 3, 9

APPENDIX A-3

Composite List of Inactive Mutants

Source(s) – Tables 5, 10

APPENDIX A-4

List of Active Mutant Activity Data (Original)

Source(s) – Table 9

40% - 79% < 40%

KEY Coloration of Percent (%) Activity Values > 200% 120% - 200% 80% - 119%

120% - 200% 80% - 119% 40% - 79% < 40%

> 200%

KEY

Coloration of Percent (%) Activity Values

< 40%

Coloration of

KEY

> 200% 120% - 200% 80% - 119% 40% - 79%

80% - 119% 40% - 79% < 40%

> 200% 120% - 200%

KEY Coloration of

> 200%

Percent (%) Activity Values

KEY

80% - 119% 40% - 79% < 40%

< 40%

KEY Coloration of Percent (%) Activity Values > 200% 120% - 200% 80% - 119%

120% - 200% 80% - 119% 40% - 79% < 40%

KEY

Percent (%) Activity Values > 200%

< 40%

Coloration of Percent (%) Activity Values > 200% 120% - 200% 80% - 119%

KEY

0.90

1.12

APPENDIX A-5

List of Active Mutant Activity Data – Sorted by High Activity to Low Activity

Source(s) – Table 9

KEY

Percent (%) Activity Values $> 200%$

 $< 40%$

< 40%

KEY

Percent (%) Activity Values $> 200%$

< 40%

KEY

Percent (%) Activity Values $> 200%$

KEY

<mark>200% -</mark>
120% - 200<mark>%</mark>

Mutant SEQ ID Activity | Mutant SEQ ID | Activity | Mutant SEQ ID | Activity

APPENDIX A-6

List of Active Mutant Activity Data Under Temperature and Phenophilic Conditions

Source(s) – Table 12

APPENDIX A-7

Composite Table and Plots of Active Mutants Grouped by Activity Under Temperature and Phenophilic Conditions

Source(s) – Table 12

APPENDIX A-8

Table and Plots of Positive Control Activity Data Under Temperature and Phenophilic Conditions

Source(s) – Table 12

*Data taken from '731 App., at 302-303 (and confirmed against T12 in '520 Patent)

APPENDIX A-9

Table of Amino Acid Residues Comprising the Hyal-EGF Region and Impact of Residue Substitution on Activity

Source(s) – Tables 3, 5

Key:

Orange Fill - Hyal-EGF Cysteine ("C") Residue Green Fill - Hyal-EGF Glycine ("G") Residue

APPENDIX B

C.V. of Michael Hecht, Ph.D

MICHAEL H. HECHT, PH.D.

Department of Chemistry, Princeton University, Princeton, NJ 08544-1009

PHONE: 609-258-2901 FAX: 609-258-6746 EMAIL: hecht@princeton.edu WEB: https://hecht.princeton.edu

EDUCATION

POST-DOCTORAL

FACULTY POSITIONS

HONORS AND AWARDS

RESEARCH INTERESTS

- Synthetic Biology: Artificial proteomes and genomes
- Protein Engineering
- *De novo* protein design
- Origin of life
- **Astrobiology**
- Protein folding and stability
- Combinatorial methods
- Alzheimer's disease, Amyloid, protein misfolding and aggregation

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SERVICE – CHEMISTRY DEPARTMENT & PRINCETON UNIVERSITY

SERVICE – SCIENTIFIC COMMUNITY

TEACHING

→ Taught from the scientific literature. Taken by graduate students & upper-level undergrads

TRAINING OF STUDENTS

Hecht CV - page 2 Petitioner Merck Ex. 1003, p. 228

- Joshua Mancini 2017-2018
- Shlomo Zharzitsky 2015-2020
- Sarangan Chari 2010- *(Visiting scientist / Departmental guest)*

2012-2016

• John Sakizadeh 2023-

GRADUATE STUDENTS

UNDERGRADUATE (SENIOR THESIS) STUDENTS

Hecht CV - page 3 Petitioner Merck Ex. 1003, p. 229

Hecht CV - page 4 Petitioner Merck Ex. 1003, p. 230

MICHAEL H. HECHT, PH.D. – PUBLICATIONS

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MICHAEL H. HECHT, PH.D. – INVITED LECTURES

- Berkeley Structural Biology Symposium, University of California, Berkeley, CA, January 10-12, 1990
- Bristol-Myers Squibb, Princeton, NJ, March 21, 1991
- The Peptide/Protein Bridge Conference, Toronto, Canada, June 10-14, 1991
- Rutgers University Molecular Biophysics Program, Piscataway, NJ, November 26, 1991
- FEBS (Federation of European Biochemical Societies) 21st Annual meeting, Dublin, Ireland, August 9-14, 1992
- Duke University, Department of Biochemistry, Durham, NC, October 23, 1992
- NIH, Laboratory of Mathematical Biology Molecular Structure Section, Bethesda, MD, January 12, 1993
- University of Pennsylvania, Department of Chemistry, Philadelphia, PA, February 11, 1993
- American Cyanamid Corporation, Princeton, NJ, February 24, 1993
- University of Delaware, Department of Chemistry and Biochemistry, Newark, DE, May 17, 1993
- Gordon Research Conference on Proteins, Tilton, NH, June 13-19, 1993
- Protein Society Annual Symposium, San Diego, CA, July 24-28, 1993
- University of California Berkeley, Structural Biology Program, Berkeley, CA, October 18, 1993
- University of California San Francisco, Department of Biophysics, San Francisco, CA, October 19, 1993
- Symposium on Molecular Recognition, CABM, Rutgers University, Piscataway, NJ, October 21-22, 1993
- Indiana University, Division of Biochemistry Dept. of Chemistry, Bloomington, IN, November 19, 1993
- University of Toronto, Department of Biochemistry, Toronto, Canada, November 22, 1993
- University of Rochester, Department of Biochemistry, Rochester, NY, December 2, 1993
- Rutgers University, Department of Biochemistry, Piscataway, NJ, December 10, 1993
- City College of New York, Department of Chemistry, New York, NY, February 1, 1994
- National Institutes of Health, Laboratory of Chemical Physics, Bethesda, MD, February 10, 1994
- Gordon Research Conference on the Chemistry and Biology of Peptides, Ventura, CA, February 13-18, 1994
- International Congress on the Design and Modification of Biomolecular Structure, Logan, UT, March 2-4, 1994
- University of Massachusetts Medical School, Department of Pharmacology, Worcester, MA, April 11, 1994
- Bristol-Myers Squibb Research Institute, Dept. of Macromolecular Modeling, Princeton, NJ, April 25, 1994
- University of California San Francisco, Department of Biochemistry, San Francisco, CA, May 3, 1994
- Stanford University, Departments of Cell Biology & Biochemistry, Stanford, CA, May 4, 1994
- Albert Einstein College of Medicine, Department of Physiology and Biophysics, Bronx, NY, May 12, 1994
- American Chemical Society, Middle Atlantic Regional Meeting, Univ. of Maryland (Baltimore), May 27, 1994
- University of Toronto / Ontario Cancer Institute, Toronto, Canada, June 23, 1994

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- Indiana University, Department of Chemistry, Bloomington, IN, September 1, 1994
- IBC Conference on Artificial Antibodies and Enzymes, San Diego, CA, September 19-20, 1994
- Columbia University, Dept. of Biochemistry and Molecular Biophysics, New York, NY, September 30, 1994
- Office of Naval Research: "Biomolecular Recognition at ONR", Berkeley Springs, WV, October 26-30, 1994
- 39th Annual Meeting of the Biophysical Society, San Francisco, CA, February 12-16, 1995
- NEC Corporation, Princeton, NJ, March 7, 1995
- Texas A&M University, Department of Biochemistry and Biophysics, College Station, TX, May 3, 1995
- The Protein Society First European Symposium, Davos, Switzerland, May 28 June 1, 1995
- Center for Advanced Biotechnology and Medicine, Rutgers University, Piscataway, NJ, June 7, 1995
- The Karolinska Institute. Center for Structural Biochemistry, Stockholm, Sweden, September 12, 1995
- Pharmacia Pharmaceuticals Inc., Division of Structural Biochemistry, Stockholm, Sweden, September 13, 1995
- Annual Meeting of the Swedish Society for Biochemistry and Molecular Biology (Plenary address), Linkoping, Sweden, September 14-15, 1995
- Symposium on Protein Folding and Design, University of Minnesota, Minneapolis, MN, October 19-20, 1995
- Tulane University, Department of Biochemistry, New Orleans, LA, October 23, 1995
- Advances in Protein Science Symposium, Mount Sinai Medical School, New York, NY, November 8, 1995
- University of Texas Austin, Department of Chemistry and Biochemistry, Austin, TX, November 10, 1995
- Brandeis University, Department of Biochemistry, Waltham, MA, November 15, 1995
- Cornell Univ. Medical School, Dept. of Biochemistry and Structural Biology, New York, NY, December 4, 1995
- University of Washington, Department of Biochemistry, Seattle, WA, December 14, 1995
- Pacifichem International Chemical Congress, Honolulu, HA, December 17-22, 1995
- University of California San Diego, Department of Chemistry and Biochemistry, La Jolla, CA, January 23, 1996
- Scripps Research Institute, La Jolla, CA, January 25, 1996
- Haverford College, Department of Biology, Haverford, PA, February 1, 1996
- Fox Chase Cancer Research Institute, Philadelphia, PA, February 6, 1996
- University of Rochester, Department of Biochemistry, Rochester, NY, March 6, 1996
- Weizmann Institute of Science, Department of Biochemistry, Rehovot, Israel, March 19, 1996
- University of Maryland (CARB) and National Institutes of Standards &Technology, Rockville, MD, April 16, 1996
- International Conference on Protein Folding & Design, Fogerty Center NIH, Bethesda, MD, April 23-26, 1996
- Washington University, Department of Chemistry, St. Louis, MO, May 9, 1996
- Beckman Institute Symposium: Beyond Protein Structure, Univ. of Illinois, Urbana-Champaign, IL, June 6-9, 1996
- NEC Symposium in Biophysics, NEC Corporation, Princeton, NJ, June 23-27, 1996

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- Washington University Medical School, Department of Biochemistry, St. Louis, MO, July 22, 1996
- FASEB Summer Research Conference on Protein Folding & Assembly, Saxtons River, VT, July 27-August 1, 1996
- University of Alberta, Department of Biochemistry, Edmonton, Alberta, Canada, October 10, 1996
- University of Michigan, Department of Chemistry, Ann Arbor, MI, October 23, 1996
- 76th Statistical Mechanics Conference, Rutgers University, New Brunswick, NJ, December 15-17, 1996
- Nature Biotechnology Symposium on Biomolecular Design, Form & Function. Miami, FL, February 1-5, 1997
- Wistar Institute, University of Pennsylvania, Philadelphia, PA, February 18, 1998
- DIMACS Workshop on Molecular Selection, Princeton University, Princeton, NJ, March 15-17, 1998
- Sigma Xi Lecture, Princeton, NJ , March 30, 1998
- Symposium on Structural Biology, University of Texas Medical School, Galveston, TX, April 3-5, 1998
- Symposium on Computational Chemistry & the Living World: From Sequence to Function, Chambery, France, April 20-24, 1998
- Gordon Research Conference on Biopolymers, Salve Regina University Newport, RI, June 14 18, 1998
- University of Virginia, Department of Chemistry, Charlottesville, VA, September 11, 1998
- Symposium on Principles of Protein Design: Theory, Experiments & Applications, Durham, NC, Nov. 19-21, 1998
- Rutgers University, Department of Chemistry, Newark NJ, January 11, 1999
- Weizmann Institute of Science, Department of Biological Chemistry, Rehovot, Israel, February 23, 1999
- Weizmann Institute of Science, Department of Chemistry, Rehovot, Israel, March 8, 1999
- American Chemical Society National Meeting, Anaheim, California, March 23, 1999
- Second Israeli Symposium on Computational Aspects of Molecular Biology, The Hebrew University, Jerusalem, Israel, April 28, 1999
- Tel Aviv University, Structural Biology Program, Ramat Aviv, Israel, June 22, 1999
- Symposium on Self-assembling Peptides in Biology, Engineering & Medicine, Crete, Greece, July 1-6, 1999
- New Jersey Center for Biomaterials 3rd Annual Retreat, Rutgers University, Piscataway, NJ , October 13, 1999
- American Physical Society National Meeting, Minneapolis, MN, March 20-24, 2000
- Naval Research Laboratory Center for Bio/Molecular Science and Engineering, Washington, DC, May 5, 2000
- American Chemical Society, Mid-Atlantic Regional Meeting, University of Delaware, May 17, 2000
- Duke University, Department of Biochemistry, Durham, NC, May 16, 2000
- National Cancer Institute Laboratory of Experimental & Computational Biology. Frederick, MD June 13, 2000
- DARPA Focus 2000 Conference on the Intersection of Bio:Info:Physical Systems, Chantilly, VA, June 29-30, 2000
- Gordon Research Conference on Tetrapyrroles, Salve Regina University, Newport, RI, July 16-21, 2000
- Plenary Lecture Annual Meeting of the German Society for Biochemistry & Molecular Biology, Munich, Germany - October 10-13, 2000 (Unable to attend due to family illness)

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- Swiss/US Forum on NanoBioSciences, Princeton NJ, December 14-15, 2000
- University of Lausanne, Switzerland (Troisieme Cycle 2001 3 Lecture Series) Feb. 12 Feb. 14, 2001
- University of Bern, Switzerland (Troisieme Cycle 2001 2 Lecture Series), Feb. 15 Feb. 16, 2001
- MIT, Department of Chemistry, Cambridge, MA, March 8, 2001
- NEC Corporation, Princeton, NJ, March 30, 2001
- Wesleyan University, Department of Chemistry, Middletown, CT, May 4, 2001
- Hyseq Inc., Sunnyvale, CA , May 16, 2001
- Genencor Inc., Palo Alto, CA, May 17, 2001
- University of California, Santa Barbara, Program in Bioengineering, Santa Barbara, CA, May 18, 2001
- Symposium on Disorders of Protein Misfolding and Aggregation, Helsinki, Finland, June 6-10, 2001
- Dupont Corporation, Wilmington, DE, June 27, 2001
- Second Symposium on Self-assembling Peptides in Biology, Engineering & Medicine, Crete, July 13-17, 2001
- IBM, Blue Gene Deep Computing Project, IBM Watson Research Center, Yorktown Heights, NY, Sept. 6, 2001
- DARPA Workshop on Applications of Biologically Based Nanostructures. Arlington, VA, October 16, 2001
- Carnegie Institute, Baltimore, MD, December 17, 2001
- AstraZeneca Pharmaceuticals Inc, Wilmington, DE, June 18, 2002
- Brookhaven National Laboratory, Department of Biology, Brookhaven NY, July 11, 2002
- Wyeth Corporation, Princeton, NJ January 20, 2003
- Emory University, Department of Chemistry, Atlanta, GA, March 10, 2003
- University of Washington, Department of Chemistry, Seattle, WA, April 4, 2003
- Hunter College, City University of New York, Department of Chemistry, New York, NY, April 11, 2003
- American Chemical Society, Middle Atlantic Regional Meeting, Princeton, June 10, 2003
- 3 rd Peptide Engineering Meeting. (cancelled because of SARS concerns) Toronto, Canada, July 16-18, 2003
- Protein Society Annual Symposium Kaiser Award Lecture. Boston, MA, July 26-30, 2003
- 3rd Symposium on Self-Assembling Peptides in Biology, Engineering & Medicine, Crete, Greece, Aug. 1-5, 2003
- American Chemical Society National Meeting, New York, NY, Sept. 7-11, 2003
- DARPA Workshop on Protein Design Processes, Seattle, WA, Oct. 29, 2003
- Rutgers University, Department of Chemistry, Piscataway, NJ, Feb. 3, 2004.
- Symposium on "Protein Misaggregation: From Biomolecules to Neurodegeneration" Boston MA, Feb. 9-11, 2004
- City College of New York, Department of Chemistry. New York, NY, March 10, 2004
- Georgia Institute of Technology (GA Tech), Department of Chemistry. Atlanta, GA, March 23, 2004
- Materials Research Society, National Meeting, San Francisco, CA, April 16, 2004

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- Foundations of Nanoscience Conference, Snowbird Utah, April 21-23, 2004
- University of Illinois, Department of Microbiology, Champaign, IL, May 4, 2004
- St Jude Research Hospital, Department of Structural Biology, Memphis, TN, May 11, 2004
- Symposium on 'Proteins: Structure, Folding and Disease', University of Toronto, Canada, June 3-4, 2004
- Bioorganic Gordon Conference, Proctor Academy, NH, June 13-18, 2004
- Symposium on Proteins: Folding, *De novo* Design and Interactions CUNY Institute for Macromolecular Assemblies, New York, NY, November 9, 2004.
- New York NanoScience Discussion Group, Department of Chemistry, New York University, February 8, 2005.
- Symposium on Protein Design University of Pennsylvania, Department of Chemistry, and Department of Biochemistry and Biophysics, Philadelphia, PA, March 10, 2005.
- Invitrogen Molecule Probes Inc., Eugene, Oregon, March 15, 2005
- University of North Carolina, Department of Biochemistry, Chapel Hill, NC, April 5, 2005
- Ben Gurion University, Department of Biotechnology Engineering, Beer-Sheva, Israel, May 2, 2005
- Symposium on The Design, Engineering, and Selection of Novel Proteins, Institute for Advanced Studies, Hebrew University, Jerusalem, Israel, May 5-10, 2005
- Princeton University, Department of Chemistry. Alumni Reunions, Keynote Speaker. May 27, 2005.
- 4th Symposium on Self-Assembling Peptides in Biology, Engineering & Medicine, Crete, Greece, June 25-28, 2005
- Bristol-Myers Squibb Research Institute, Lawrenceville, NJ, July 28, 2005.
- Cornell University, Department of Chemistry Chemical & Biomolecular Engineering, August 29, 2005.
- Swarthmore College, Department of Chemistry and Biochemistry, Swarthmore, PA, February 9, 2006
- Keystone Conference on Protein Misfolding Diseases, Breckenridge, Colorado, February 21-26, 2006.
- Johns Hopkins University, Department of Chemical & Biomolecular Engineering, March 16, 2006.
- Hebrew University, Department of Biological Chemistry, Jerusalem, Israel, April 2, 2006.
- Weizmann Institute of Science, Department of Biological Chemistry, Rehovot, Israel, April 4, 2006.
- Tel Aviv University, Department of Molecular Microbiology and Biotechnology, Tel Aviv, Israel, April 5, 2006.
- Faculty of Medicine, Hebrew Univ., Dept. of Molec. Genetics & Biotechnology, Jerusalem, Israel, May 11, 2006.
- Symposium in Honor of Ephraim Katzir's 90th Birthday, Weizmann Institute, Rehovot, Israel, May14-15, 2006
- American Chemical Society Mid-Atlantic Regional Meeting, Hershey, PA, June 4-7 2006,
- Biopolymers Gordon Research Conference, Salve Regina University, Newport, RI, June 11-16 2006.
- Centocor, Inc. Radnor, PA, August 3, 2006.
- *Biotech 2006* Symposium, Philadelphia, PA "*Therapeutic Interventions for Alzeheimer's Disease"* Oct. 17, 2006.
- University of Massachusetts, Department of Chemistry, Amherst, MA, November 2, 2006.
- University of Pennsylvania, Department of Anesthesiology, Philadelphia, PA, January 11, 2007.

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- City University of New York (CUNY), Department of Chemistry & Biochemistry, February 9, 2007.
- American Chemical Society National Meeting, Chicago, IL, March 25-29, 2007
- Polytechnic University, Department of Chemical and Biological Sciences, Brooklyn, NY, May 22, 2007.
- ExSAR Inc., Monmouth Junction, NJ, June 7, 2007.
- University of Cambridge, Department of Chemistry, Cambridge, UK July 5, 2007.
- Symposium on Protein Assembly in Materials, Biology, and Medicine, Crete, Greece, July 8-11, 2007.
- National Institutes of Health, Translational Research on Alzheimer's Disease. Bethesda, MD. Sept. 17-18, 2007.
- Rutgers University, Department of Chemistry and Chemical Biology. Piscataway, NJ, October 30, 2007.
- International Conference on Alzheimer's Disease, Chicago, IL, July 26-31, 2008.
- Arizona State University, Department of Chemistry, Tempe, AZ, October 31, 2008.
- Duke University, Department of Chemistry, Durham, NC, December 16, 2008.
- University of Toronto, Mississauga Campus, Department of Chemistry, Toronto, Canada, January 22, 2009.
- University of Toronto, Downtown Campus, Department of Chemistry Toronto, Canada, January 23, 2009.
- AD/PD Conference on Alzheimer's Disease & Parkinson's Disease, Prague, Czech Republic, March 11-15 2009.
- Columbia University, Department of Chemistry, "Grandpierre Memorial Lecture" New York, NY, March 26, 2009.
- University of Kentucky, Department of Chemistry, Naff Symposium Lecture, Lexington, KY, April 24, 2009.
- University of Maryland, Department of Chemistry & Biochemistry, College Park, MD, May 5, 2009.
- Workshop on Protein Misfolding in the Test Tube and in Disease, Hagoshrim, Israel, May 13-15, 2009.
- New York University, Department of Chemistry, New York, NY, September 11, 2009.
- Princeton University, The Lewis-Sigler Institute for Integrative Genomics, Princeton, NJ, December 1, 2009.
- American Chemical Society Central NJ Section, Princeton, NJ, February 24, 2010.
- Quest University, Squamish British Columbia, Canada, March 18, 2010
- Rockefeller University, Center for Studies in Physics and Biology, New York, NY, May 11, 2010.
- Synthetic Biology Workshop, St Anne's College, University of Oxford, United Kingdom, July 12-14 2010.
- Pacifichem International Chemical Congress, Honolulu, HA, December 15-20, 2010.
- Los Alamos Nat'l Laboratory: "Synthetic Biology: From Protein Design to Artificial Genomes" March 16, 2011.
- Los Alamos Nat'l Lab: "Alzheimer's disease: Molecular Underpinnings & Search for Therapeutics" Mar. 17, 2011.
- ECI Conference on Biochemical & Molecular Engineering, Seattle, Washington, June 26-30, 2011.
- Massey University, Auckland, New Zealand, August 16, 2011.
- BioInteractions Conference, Crown Plaza Hotel, Queenstown, New Zealand, Aug 28, 2011.
- Queenstown Molecular Biology Conference, Queenstown, New Zealand, Aug 29-31, 2011.
- Origin of Life Gordon Research Conference, Galveston, TX, January 8-13, 2012.

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- NASA Headquarters, Astrobiology Institute Director's Seminar, Washington, DC, March 5, 2012.
- AbSciCon 2012 NASA Astrobiology Conference, Atlanta, GA, April 16-20.
- DARPA workshop on Protein Synthesis, Arlington, VA, May 17, 2012,
- DuPont De Nemours Experimental Station, Central Research and Development, Wilmington, DE, June 22, 2012.
- Q-Bio (Quantitative Biology) Conference, Santa Fe, NM, August 8-12, 2012.
- University of Minnesota, Dept. of Biochemistry, Molecular Biology & Biophysics, St. Paul, MN, Sept. 5, 2012.
- UCLA, Molecular Biology Institute, Los Angeles, CA, January 10, 2012.
- Princeton Origin of Life Conference, Center for Theoretical Science, Princeton, NJ, January 21-24, 2013.
- University of Missouri, Department of Biochemistry, Columbia, MO, March 1, 2013.
- The Helix Center for Interdisciplinary Investigation. New York, NY, May 11, 2013.
- Conference on Emergence in Chemical System. Univ. of Alaska, Anchorage, AK, June 17-20, 2013.
- Conference on Proteomics and BioInformatics, Philadelphia, PA. July 15-17, 2013.
- NSF Workshop on Design, Engineering, & Selection of Novel Proteins (Organizer), Arlington VA, May 12-13, 2014.
- Protein Society Annual Symposium, San Diego, CA, July 27-30, 2014.
- American Chemical Society Central NJ Section, Princeton, NJ, November 19, 2014.
- Bristol Myers Squibb / Princeton University Joint research Symposium, Princeton, NJ, December 4, 2014.
- University of Pennsylvania, Department of Biochemistry & Biophysics, Philadelphia, PA, February 19, 2015.
- Yale University, Department of Genetics, New Haven, CT, May 26, 2015.
- International Workshop: Frontiers in Protein Folding, Evolution & Function, Oaxaca, Mexico, November 3-7, 2015
- Lawrence Berkeley National Laboratory, Berkeley CA, January 19, 2016.
- TEDx, Princeton NJ. March 26, 2016.
- Mosbacher Kolloquium: Protein Design. Mosbach, Germany, March 31 April 2, 2016.
- Protein Engineering Conference, Ottawa, Canada, June 17-19, 2016.
- Protein Society Annual Symposium, Baltimore, MD, July 16-19, 2016.
- Rutgers University, Center for Integrative Proteomics Research and Institute for Quantitative Biomedicine, Piscatawy, NJ. January 25, 2017.
- Symposium: Life Together? Examining Our Assumptions. Stellenbosch Institute for Advanced Studies, South Africa, February 13-15, 2017.
- Linderstrøm-Lang Center for Protein Science, Department of Biology, University of Copenhagen, Denmark. February 20, 2017.
- AbSciCon 2017 (NASA Astrobiology Conference), Mesa AZ, April 24-28, 2017.
- University of California at Davis, Department of Chemistry, Davis, CA, May 2, 2017.
- IGEM Meeting, Ludwig-Maximilian University, Munich, Germany, July 20-22, 2018.

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- Synthetic Biology III, Landshut, Germany, July 23-25, 2018.
- Society for Industrial Microbiology Annual Meeting, Chicago, IL, August 12-14, 2018.
- Syracuse University, Department of Chemistry, Syracuse, NY, November 27, 2018.
- Earth-Life Science Institute (ELSI), Tokyo Institute of Technology, Tokyo, Japan, March 7, 2019.
- Symposium on BioDesign and BioEngineering (*Keynote speaker*), Tokyo, Japan, March 8, 2019.
- Symposium on New Frontiers in Chemistry and Synthetic Biology (*Keynote speaker*), Shinshu University, Ueda, Japan, March 13, 2019.
- Symposium on New Frontiers in Protein Design and Engineering (*Keynote speaker*), Institute of Molecular Science, Okazaki, Japan, March 15-16, 2019.
- Nara Institute of Science and Technology (NAIST), Nara, Japan, March 20, 2019.
- Conference on Computational Design of Protein-Cofactor Complexes, Galilion, Israel, March 25 -28 2019.
- Hebrew University, Institute of Life Sciences, Jerusalem, Israel, April 1, 2019.
- Ben Gurion University of the Negev, Department of Life Sciences, , Beer-Sheva, Israel, April 8, 2019.
- Weizmann Institute of Science, Department of Biomolecular Sciences, Rehovot, Israel, April 15, 2019.
- ETH Zürich, Department of Chemistry and Applied Biosciences, Zürich, Switzerland, April 30, 2019.
- Uppsala University, Department of Cell and Molecular Biology, Uppsala, Sweden, May 3, 2019.
- University of Cambridge, Department of Chemistry, Cambridge, UK, May 8, 2019.
- Oxford Global SynGen Symposium on Synthetic Biology, Boston, MA, May 14-15, 2019.
- Gordon Research Conference on Proteins, Holderness, NH, June 16-21, 2019.
- Rutgers University, Department of Physics, Piscataway, NJ, September 18, 2019.
- Georgia Tech University, Astrobiology Program, Atlanta, GA, February 21, 2020.
- Defense Threat Reduction Agency, Fort Belvoir, VA, (via Zoom), November 2, 2020.
- Life in the Universe: Breakthrough Initiatives Program. Cape Town, South Africa (via Zoom), November 4-5, 2020
- Truman State University, Department of Chemistry. Kirksville, MO, (via Zoom), February 11, 2022
- Rutgers University, ENIGMA Program in Astrobiology, Piscataway, NJ, December 12, 2022.
- University of Colorado, Dept. of Molecular, Cellular & Developmental Biology, Boulder, CO, March 16, 2023.
- MIT, Retirement Symposium for Prof. Robert T. Sauer, Cambridge, MA, June 1-2, 2024.
- Protein Society Annual Symposium, Vancouver, BC, Canada, July 23-26, 2024.
- Wake Forest University, Department of Physics, Winston-Salem, NC, August 29, 2024

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